O/0963/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004214954 BY CITISPACE GROUP LIMITED TO REGISTER:



AS A TRADE MARK IN CLASSES 36 & 37

AND

IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. OP000456833

BY

CITYSPACE CONSULT LLP

BACKGROUND AND PLEADINGS

1. On 6 June 2025, Citispace Group Limited ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK ("the applicant's mark"). The applicant's mark was published on 20 June 2025 and registration is sought for the following services:

   Class 36: Property management; leasing of property; real property letting; rental of property; management of rental properties.

   Class 37: Building construction; property maintenance; construction of property; cleaning of property; maintenance of property; renovation of property; property development services; advisory services relating to the renovation of property; car cleaning and valeting services; information, consultancy and advisory services relating to all of the above services.

2. On 19 September 2025, the applicant's mark was opposed by Cityspace Consult LLP ("the opponent"). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").[1]

3. For the purposes of its claims under sections 5(2)(b) and 5(3), the opponent relies upon the following earlier trade mark:

Earlier mark	Details
CITYSPACE Cityspace (series of two)	UK registration no. 3196140 Filing date: 10 November 2016 Registration date: 27 January 2017

[1] 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.

	Relying on: **Class 37:** Construction and fitting out services; office fitting out; redevelopment and variation of building lay-outs; redevelopment and variation of office lay-outs; installation of fixtures and fittings including furniture and equipment. **Class 42:** Consulting services in the field of interior design and planning; interior design services; interior office planning; feasibility studies relating to premises; advice and information on interior buildings usage including suitability for an intended use.

4. Under section 5(2)(b), the opponent claims that the marks are highly similar and that the respective services are identical or similar, with the result that there is a likelihood of confusion. The opponent completed a statement of use in respect of the earlier mark.

5. Under section 5(3), the opponent claims that the earlier mark has a reputation in the United Kingdom for the services relied upon. It claims that use of the applicant's mark, without due cause, would take unfair advantage of, and be detrimental to, the distinctive character and repute of the earlier mark.

6. Under section 5(4)(a), the opponent relies upon the series of two signs CITYSPACE and Cityspace, which it claims to have used throughout the United Kingdom since December 1989 in relation to the class 37 and 42 services listed above. It claims that use of the applicant's mark would be liable to be prevented under the law of passing off.

7. The applicant filed a counterstatement denying the grounds of opposition and requesting proof of use of the earlier mark. I note however that the applicant has made several concessions in its submissions in lieu. I will address these accordingly throughout the decision.

8. The opponent is represented by Maucher Jenkins, and the applicant is represented by Sonder & Clay.

9. Both parties filed evidence during the proceedings. No hearing was requested and only the applicant filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

EVIDENCE

10. The opponent's evidence in chief consists of the witness statement of Andrew Seward, dated 16 February 2026, together with exhibits 1 to 8. Mr Seward is the Managing Director of Cityspace Consult LLP. His evidence is directed to the history of the business, the nature and scale of the services supplied under the earlier mark, the use made of that mark and the reputation and goodwill claimed by the opponent.

11. The applicant's evidence consists of a witness statement of Robert Kidd, dated 10 April 2026, together with exhibits RK1 to RK4. Mr Kidd is the Managing Director of Citispace Group Limited. His evidence is principally directed to the history of the applicant's business and its claimed use of CITISPACE since 2004.

12. I do not intend to summarise the evidence and submissions in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Proof of use

13. The opponent's mark qualifies as an earlier trade mark under section 6 of the Act by virtue of its earlier filing date. As it completed its registration process more than five years before the filing date of the applicant's mark, it is subject to the use provisions in section 6A of the Act.

14. Within its counterstatement, the applicant indicated that it would require the opponent to provide proof of use in relation to its earlier mark. However, in its submissions in lieu, the applicant accepted that the opponent had proven genuine use in relation to its class 37 services. I note however, that no concession was made in relation to the class 42 services.

15. Although the applicant has only expressly conceded genuine use in relation to the opponent's class 37 services, I consider it necessary to determine whether the opponent may also rely upon its class 42 services. This is because I am of the view that some of those services represent a stronger case when compared with the applicant's services in class 36.

16. The relevant statutory provision is 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."

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. 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, 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]."

19. Section 6A of the Act (cited above) sets out that the relevant period for the present assessment is the five-year period prior to the filing date of the applicant's mark, being 6 June 2025. The relevant period is, therefore, 7 June 2020 to 6 June 2025 ("the relevant period").

Evidence of use

20. I note the following from the opponent's evidence:

a) Mr Seward states that services have been offered under the CITYSPACE mark since December 1989 and that, since that date, the business has managed over 1,650 commercial office design, fit-out and relocation projects, with a particular focus on London and the Southeast. He identifies the customers for the services as businesses and corporate clients requiring commercial office design, fit-out, relocation and interior planning services.

b) Exhibit 1 contains accounts for Cityspace Consult LLP covering the relevant period. The members' reports describe the principal activity of the LLP as the provision of "consultancy, design and management services". The accounts also record that its turnover was attributable to activity carried out wholly within the UK.

c) UK turnover figures have been provided and are as follows:

Year	Total turnover figures
2020	£4,370,207
2021	£1,841,343
2022	£4,003,418
2023	£5,078,966
2024	£10,350,641
2025	£4,306,730

d) Exhibit 2 contains archived extracts from the CITYSPACE website from within the relevant period. A December 2021 capture describes the business as providing design and fit-out of bespoke office interiors and refers to a “truly consultative approach”. It also offers assistance to businesses looking to move premises and states that an “Evaluation Report” can provide information concerning options, potential costs, timeframe and logistics. The website identifies “Office Evaluation” and “Design Consultancy” among the services offered under CITYSPACE. Similar material appears in archived website captures from 2023, 2024 and March 2025. An example from 12 March 2023 is now reproduced below:



INTELLIGENT WORKPLACE DESIGN SINCE 1989

At Cityspace, we're the market leader in design and fit out of bespoke, collaborative and flexible office interiors. Our track record is second to none - over the past 30 years we have never delivered a project late or over budget.

We offer the most experienced team in the market and the people you meet are the people who will work on your business. And we work differently to others, with a truly consultative approach to deliver the office that is right for you.

e) I also note that the printouts include two client testimonials which are as follows:

"Great design work by Cityspace Management and our Raymond James team for our new Raymond James UK Head Office at Ropemaker Place. Love the look and feel of the collaborative workspaces."

"We have worked with Cityspace for a number of years, covering small to high level projects, often with very limited timescales. The process which is adopted is completely collaborative. Good sense, with an overriding wealth of experience gives the client a holistic solution. From project management to design, the team at Cityspace are dedicated, hardworking and there for you as a client"

f) Exhibit 3 contains 35 invoices and three credit notes issued under the CITYSPACE mark, dated between 4 November 2020 and 26 March 2025. The invoices predominantly concern services in Class 37, including construction works, office fit-out, furniture installation and associated works.

g) Mr Seward provides annual UK advertising expenditure between 2021 and 2025 which is as follows:

Year	**Amount**
2021	£22,658
2022	£16,203
2023	£33,785
2024	£39,649
2025	£45,148

h) Exhibit 4 consists of examples of promotional products bearing the CITYSPACE mark. These include pens, a tote bag and a high-vis vest. Mr Seward states that promotional materials carrying the mark were provided to customers during the relevant period.[2]

[2] Paragraphs 12 and 13 of the witness statement of Andrew Seward.

i) Exhibit 5 contains project packs concerning commercial office projects undertaken during the relevant period. By way of example, the material relating to Sciens Capital includes a contract dated 19 January 2021, together with a construction cost plan, programme of works, drawings and a design presentation. The cost plan separately identifies fees for concept design and the selection of finishes, as well as the production of detailed working drawings. The accompanying presentation identifies services including building appraisals, workplace consultancy and interior design and contains proposed office layouts, design concepts and details of the finishes, furniture and lighting selected for the premises. The programme also identifies a number of pre-construction stages, including the presentation and review of the concept design, approval of the final design and the production and review of working drawings.

j) Exhibit 6 includes a CITYSPACE presentation with metadata recording a creation date of June 2024 which Mr Seward says have been provided to consumers. The presentation describes a consultative service provided at the early stages of planning an office refurbishment. In particular, an evaluation report includes a full building appraisal and feasibility plan, together with a space-plan test fit intended to determine whether the office has the appropriate configuration for the client's requirements. A maximum-density plan is also produced to identify the future growth potential of the space. The report is accompanied by cost planning and interior design options.

k) Mr Seward states that CITYSPACE maintains LinkedIn and Instagram accounts which are used to promote its services. Exhibit 7 shows that the LinkedIn account has approximately 1,000 followers and the Instagram account approximately 245 followers. However, the material exhibited does not identify the dates or reach of these posts. I note the following overview from the LinkedIn profile:



Overview

We are the market leaders in the design, construction and fit-out of commercial office spaces, designing people-centric workspaces that empower, connect and inspire.

Our long-standing team of interior designers, project and site managers oversee that relocations and refurbishments happen with precision, ensuring every project meets the highest standards. For 36 years and for over 2,000 projects, our team have ensured 100% completion to time and within budget.

Partnering with Cityspace means transparent pricing, detailed evaluation reporting and a structured process that guides you from planning and design through to final fit-out of your new work space.

Proudly ISO 9001 and ISO 14001 certified.

l) Mr Seward also draws my attention to the opponent's accreditation and an award nomination. Exhibit 8 contains ISO 9001 and ISO 14001 certificates with an initial registration date of 26 February 2023. The scope of registration is described as "the design, contract management, construction and internal refurbishment for commercial clients". The exhibit also contains an article from the opponent's website dated 23 July 2020 stating that CITYSPACE was shortlisted as a finalist in the Mixology2020 Awards for the design and fit-out of the Raymond James office.

Assessment of the evidence

21. 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.[3] 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.

22. I recognise that much of the opponent's activity appears to be focused on London and the Southeast and that the turnover figures have not been broken down by individual service. In *W Sternoff LLC v Peter Kertels (Eros Bodyglide),* the Appointed Person commented on the limited assistance that can be derived from

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

global figures covering a number of goods or services.[4] However, I do not consider the absence of a breakdown to be fatal in the present case. The turnover figures must be considered alongside the evidence as a whole. In particular, the accounts describe the opponent's principal activity as consultancy, design and management services; the archived website consistently advertises office evaluation and design consultancy; and the project packs contain examples of concept design, interior design, office planning, working drawings, building appraisal and feasibility planning. There is, therefore, sufficient narrative and documentary evidence from which I can infer that a proportion of the turnover relates to the class 42 services.

23. Taking the evidence as a whole, including the turnover and advertising figures, the website extracts and, importantly, the detailed project and presentation material, I am satisfied that the opponent has demonstrated genuine use in relation to its class 42 services. Although the examples shown predominantly concern commercial office premises, I do not consider that a narrower specification is warranted. This is because a fair specification should reflect how the average consumer would describe the services actually provided, without reducing the specification to every individual activity shown in the evidence. The services shown in the evidence are fairly described by the registered terms and I am satisfied that the opponent may rely upon its class 42 specification in full.

Section 5(2)(b)

24. Section 5(2)(b) of the Act is as follows:

> "(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,

[4] *W Sternoff LLC v Peter Kertels (Eros Bodyglide)*, BL O/0984/25, paragraphs 26-27.

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

25. Section 5A states:

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

Section 5(2) case law

26. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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; and

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

Comparison of services

27. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the 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."

28. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

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

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

29. In *Gérard Meric v OHIM,*[5] ("*Meric*"), the General Court ("GC") held that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

30. The services to be compared are as follows:

[5] Case T-133/05

Opponent's services	Applicant's services
Class 37: Construction and fitting out services; office fitting out; redevelopment and variation of building lay-outs; redevelopment and variation of office lay-outs; installation of fixtures and fittings including furniture and equipment. Class 42: Consulting services in the field of interior design and planning; interior design services; interior office planning; feasibility studies relating to premises; advice and information on interior buildings usage including suitability for an intended use.	Class 36: Property management; leasing of property; real property letting; rental of property; management of rental properties. Class 37: Building construction; property maintenance; construction of property; cleaning of property; maintenance of property; renovation of property; property development services; advisory services relating to the renovation of property; car cleaning and valeting services; information, consultancy and advisory services relating to all of the above services.

Class 36

31. In respect of *property management* and *management of rental properties*, I consider the opponent's closest services to be *information on interior buildings usage including suitability for an intended use*. The respective services differ in nature and purpose. The applicant's services concern the management of property on behalf of an owner or landlord, whereas the opponent's services are concerned with assessing premises and advising upon their use and suitability. They are not in competition, nor are they complementary. However, there is an overlap in users, since property owners, landlords and others responsible for the management of premises may also require advice about the suitability and use of those premises. There is also, in my view, some potential overlap in trade channels, since undertakings advising upon the management and use of property may also provide or arrange consultancy concerning the suitability and efficient use of

premises. Taking these factors into account, I find there to be a low to medium degree of similarity.

32. Turning to *leasing of property; real property letting* and *rental of property*, the closest comparison is with the opponent's *advice and information on interior buildings usage including suitability for an intended use*. The nature and purpose of the services differ. The services are neither in competition nor are they complementary in the strict sense. However, their users may overlap. For example, a business considering taking premises may require advice as to whether those premises are suitable for its intended use, whilst a landlord or property owner seeking to let premises may require advice concerning how the space can be used. I also consider there to be some potential overlap in trade channels in the wider property consultancy market. Balancing those factors, I find the services similar to a low degree.

Class 37

33. I remind myself that in its defence and counterstatement the applicant admitted similarity between the respective services in class 37. However, as the applicant did not specifically comment on the level of similarity, I will proceed to conduct my own comparison whilst keeping in mind, the applicant's concession.[6]

34. The applicant's *building construction* and *construction of property* are encompassed by the opponent's broader term *construction […] services.* They are therefore identical in line with *Meric.*

35. I consider there to be a clear overlap in nature and purpose, users, providers and channels of trade for the applicant's *renovation of property and property development services* and the opponent's *construction and fitting out services*. They may also be used as part of the same project. However, renovation and property development are broader in scope than fitting out and may involve

[6] *BEAK* BL O/0096/25 at [20] and *ARD* BL O/0245/25 at [15].

different stages and types of work. As such, I find these services to be similar to a medium degree.

36. *Advisory services relating to the renovation of property* are most closely comparable with the opponent's *construction and fitting out services*. Although one is advisory in nature and the other concerns the carrying out of physical works, the services have closely related purposes and may be provided by the same undertaking to the same consumers as part of a renovation project. I also find there to be a degree of complementarity. I find them similar to a medium degree.

37. I find the closest comparator to the applicant's *property maintenance* and *maintenance of property* is *construction and fitting out services*. The respective services differ in their primary purpose, with maintenance services generally concerned with keeping property in an appropriate condition, whereas construction and fitting out services concern constructing or adapting premises. However, there may be some overlap in nature where maintenance involves repairs or replacement of fixtures and fittings. The services may also share users, providers and channels of trade. Taking these factors into account, I find the services similar to a low to medium degree.

38. Turning to *cleaning of property*, the closest comparator remains *construction and fitting out services*. The respective services differ in nature and purpose and are neither in competition nor complementary. Whilst their users may overlap and there may be some limited overlap in providers and channels of trade, I consider these factors insufficient to give rise to anything more than a low degree of similarity.

39. *Car cleaning and valeting services* differ in nature, purpose, users and usual channels of trade from the opponent's *construction and fitting out services*. There is no meaningful competitive or complementary relationship between them. However, the applicant has expressly conceded that its class 37 services are similar to the opponent's class 37 services. In light of that concession, I will proceed on the basis that car cleaning and valeting services are similar to the opponent's services to a low degree.

40. The applicant's *information, consultancy and advisory services relating to all of the above services* are broad terms which relate back to the applicant's various class 37 services. To the extent that they concern building construction, construction, renovation, development or maintenance, there will be overlap in users, purpose and trade channels with the opponent's *construction and fitting out services*. There would also be a degree of complementarity. I therefore find these services similar to a medium degree overall. Insofar as they relate to *car cleaning and valeting services*, I proceed on the basis that they are similar to a low degree in light of the applicant's concession.

The average consumer and the purchasing process

41. As the case law above indicates, it is necessary to determine who the average consumer is for the services at issue. I must then determine the manner in which the services are likely to be selected by the average consumer.

42. 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.

43. In *Iconix* (cited above), the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

> (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
>
> (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

44. The average consumer of the services will include both members of the general public and professional consumers, such as property owners, landlords, developers and businesses. The cost and frequency of the purchase will vary considerably across the specification. However, the selection of property management, letting, construction, renovation and development services is liable to involve consideration of factors such as price, the nature and extent of the services required and the experience and suitability of the provider. In my view, the average consumer will therefore pay a high degree of attention during the purchasing process. Cleaning and valeting services are likely to involve a less considered purchase, although factors such as price, convenience and the suitability of the provider will still be taken into account. For those services, the average consumer will pay at least a medium degree of attention.

45. The services are likely to be selected following consideration of websites, advertisements, quotations and other promotional material. The visual impact of the marks is therefore likely to play an important role. However, given that the services may also be discussed with providers before being commissioned, I do not discount the aural impact of the mark.

Comparison of the marks

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

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

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

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

49. The respective trade marks are shown below:

The earlier mark	The applicant's mark
CITYSPACE Cityspace	citispace

50. The earlier mark is a series of two word-only marks which differ only in capitalisation. Nothing turns on this difference so I shall refer to these marks in the singular. The overall impression resides in CITYSPACE as a whole. Although CITY and SPACE will be recognised, they combine naturally and neither dominates.

51. The applicant's mark consists of CITISPACE presented in a lightly stylised lower-case typeface. The use of different colours means that the consumer will perceive the mark as the joined elements CITI and SPACE, which carry equal weight in the overall impression. The stylisation and colour contribute to the overall impression but the verbal element remains dominant.

Visual comparison

52. Visually, the marks share eight of nine letters in the same order. They differ only through the substitution of I for Y and the colour and stylisation of the applicant's mark. Although the applicant's mark also uses colour and stylisation, the earlier mark is a word-only mark which means it is the word that is protected, irrespective of colour, form or typeface.[7] Keeping in mind my findings regarding the overall impression, I find the marks to be visually similar to a high degree.

Aural comparison

53. Both marks will be pronounced as "city space". They are therefore aurally identical.

[7] see *LA Superquimica v European Union Intellectual Property Office* (EUIPO), Case T-24/17, paragraph 39

Conceptual comparison

54. The earlier mark will be understood as referring to space in or connected with a city. Despite the spelling “citi”, the applicant’s mark will be understood as a fanciful misspelling of “city”. I therefore consider that the marks convey the same message and are conceptually identical.

Distinctive character of the earlier mark

55. 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).”

56. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use, and I note that the opponent has filed evidence of use for its earlier mark. I will, therefore, consider whether this is sufficient to give rise to a finding that the distinctiveness of the opponent's mark has been enhanced through use. Before doing so, I will consider the inherent position.

57. The opponent's mark consists solely of the combined words "CITYSPACE". While this is not directly descriptive of the opponent's services, I consider that "CITY" and "SPACE" will be readily understood and, in combination, allude to the provision, development or adaptation of space in an urban environment. It is therefore allusive in relation to the earlier services. I find the earlier mark is inherently distinctive to a low to medium degree.

58. I now turn to consider the position with regard to an enhanced degree of distinctive character. The relevant date for this assessment is the filing date of the applicant's mark, being 6 June 2025, and the relevant market for assessing enhanced distinctiveness is the UK market.

59. I have already outlined the opponent's evidence when assessing genuine use. I do not intend to reproduce that evidence in full but have borne it in mind in reaching my decision on enhanced distinctiveness.

60. The evidence shows longstanding use of CITYSPACE, together with substantial turnover, continued investment in advertising and numerous commercial projects undertaken under the mark. I also bear in mind the supporting evidence concerning its accreditation and award nomination.

61. However, there is no evidence of the opponent's share of the relevant market, nor is there evidence showing the proportion of the relevant public which identifies the services as originating from the opponent because of the mark. Whilst the

turnover figures are sizeable, I bear in mind the relatively high cost of the services provided. For example, the Sciens Capital project had a contract value of approximately £240,000, excluding furniture. The opponent's activities also appear to have been focused particularly on London and the Southeast. Although the evidence demonstrates some social media activity, there is limited evidence concerning its reach and little evidence of wider press or media coverage which might assist me in assessing the extent to which the mark has become known amongst the relevant public.

62. Taking the evidence as a whole, I am satisfied that the use made of the earlier mark has enhanced its distinctive character. However, for the reasons set out above, I consider that its distinctive character has been enhanced to no more than a medium degree in relation to *construction and fitting out services* in class 37 and *advice and information on interior buildings usage including suitability for an intended use* in class 42.

Likelihood of confusion

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

64. Earlier in this decision I found the similarity of the services ranges from low to identical. I concluded that the average consumer would comprise both members of the general public and professional consumers. A high degree of attention will be paid when selecting the property-related services, whilst at least a medium degree of attention will be paid when selecting cleaning and valeting services. 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 aurally and conceptually identical and visually similar to a high degree. I found the opponent's mark to hold a low to medium degree of inherent distinctiveness, which has been enhanced through use, albeit to no more than a medium degree in relation to *construction and fitting out services* in class 37 and *advice and information on interior buildings usage including suitability for an intended use* in class 42.

65. In its submissions in lieu, the applicant relies upon its use of CITISPACE since 2004 and the absence of any known instances of confusion between the parties. However, honest concurrent use was not pleaded in the applicant's counterstatement. If the applicant intended to rely upon honest concurrent use, it should have pleaded that case in its Form TM8 so that the opponent was aware of the case it had to meet. I therefore do not consider that honest concurrent use is properly before me.[8]

66. Even if I were to take the applicant's evidence of concurrent use into account, I do not consider that it would alter my conclusion. In *Aceites del Sur-Coosur SA v OHIM*, Case C-498/07 P, the CJEU recognised that peaceful coexistence may, together with other factors, diminish the likelihood of confusion. In *Budejovický Budvar NP v Anheuser-Busch Inc*, Case C-482/09, almost 30 years of parallel trade under identical marks had resulted in consumers being well aware that the goods originated from different undertakings. More recently, in *Match Group LLC v Muzmatch Ltd* [2023] EWCA Civ 454, Arnold LJ confirmed that honest

[8] I note that a similar approach was taken by the Hearing Officer in *MARQUEE*, BL O/0413/26

concurrent use is not a separate defence. What is relevant is whether substantial parallel trade over a long period has resulted in the relevant public understanding the marks as denoting the goods or services of more than one trader.

67. Turning to the evidence, Mr Kidd states that CITISPACE has been used since 2004 and has been operating in the field of letting, sales and management of property. The activity includes both residential and retail property. Mr Kidd goes on to explain that his company operates a residential and retail complex which it constructed in 2005. The complex consists of approximately 400 flats, 90 of which are still owned by the applicant together with 12 retail units and 60 parking spaces which are also owned by the applicant.

68. In support of this, Mr Kidd provides archived printouts of the applicant's website with the earliest date being 23 December 2005. I note the webpage says "The Citispace Urban Apartment concept is the result of intensive research into the real sustainable requirements of those wanting and needing to live in the centre of today's fast-paced moving cities."

69. Mr Kidd also provides turnover figures for the years 2021 to 2025, in relation to rental and management income which is as follows:

Year	Turnover
2021	£1,038,418
2022	£1,754,240
2023	£2,450,613
2024	£1,905,191
2025	£2,031,538

70. Finally, Mr Kidd states he is unaware of any instances of confusion between the parties.

71. Having considered the applicant's evidence, I am of the view that it does not establish the sort of substantial parallel trade described in *Budweiser* and *Match Group*. Although I have found that the parties' services may share users and, in some cases, trade channels, there is insufficient evidence showing the extent to which the parties have actually traded alongside one another or been encountered by the same consumers. The applicant's historical evidence principally concerns its activities in Leeds, whereas the opponent's evidence indicates a particular focus on London and the Southeast. There is no evidence from which I can conclude that the relevant public has regularly encountered both marks and become accustomed to distinguishing between the respective undertakings.

72. I also bear in mind Mr Kidd's assertions that he is unaware of any actual confusion. However, as explained in *Roger Maier v ASOS* [2015] EWCA Civ 220, the absence of actual confusion may carry little weight where there has been limited opportunity for confusion to occur. In the absence of evidence from consumers or trade professionals who have encountered both businesses, or other evidence demonstrating meaningful parallel trade, I do not consider the absence of reported confusion to be a reliable indication of what would occur upon notional and fair use of the marks across the full breadth of the respective specifications.

73. Having clarified all of the above, I now turn to the likelihood of confusion.

74. I first assess confusion on the basis of the high degree of attention paid when selecting the property-related services. That degree of attention, together with the earlier mark possessing no more than a medium degree of distinctive character, points away from confusion. However, the marks are visually similar to a high degree, aurally identical and conceptually identical. The only difference in their verbal elements is the substitution of "I" for "Y" in CITY/CITI. In my view, this difference is liable to be overlooked or imperfectly recalled, particularly as it has no effect on the pronunciation or conceptual message of the marks. The stylisation of the applicant's mark is not sufficiently striking to counteract these similarities. Taking all of the relevant factors into account, and allowing for the interdependency principle, I consider that the average consumer may mistake one mark for the other, even where the services are similar only to a low degree. The

same conclusion applies where at least a medium degree of attention is paid to the selection of cleaning and valeting services. I therefore find there to be a likelihood of direct confusion.

75. The opposition under Section 5(2)(b) succeeds in its entirety.

Section 5(3)

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

> "(3) 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".

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

> "(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".

78. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case C-252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

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

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors*, paragraph 26*.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63*.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42*.*

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

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

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

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74*.*

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such

a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV,* paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure).*

79. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are identical or similar. Secondly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public throughout the relevant territory. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods or services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. The relevant date for the assessment under section 5(3) is the filing date of the applicant's mark, being 6 June 2025.

Reputation

80. In *General Motors,* Case C-375/97, the CJEU held that:

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
>
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

81. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it."

82. The opponent claims a reputation in respect of all of the class 37 and class 42 services relied upon. However, for the purposes of my assessment I will focus upon *construction and fitting out services* in class 37 and *advice and information on interior buildings usage including suitability for an intended use* in class 42. These are the services which I considered to represent the opponent's strongest position when comparing the parties' services under section 5(2)(b). I do not

consider that assessment of the remaining services would place the opponent in any materially better position.

83. I have already considered the opponent's evidence when assessing the distinctive character of the earlier mark and do not intend to reproduce it in full here. Whilst I acknowledge that reputation and enhanced distinctive character are different assessments, there is considerable overlap in the factors and evidence relevant to each.[9] For the same reasons as given earlier in this decision at paragraphs 58-62, I am satisfied that the opponent's mark had a qualifying reputation at the relevant date, but only to a modest degree and in relation to *construction and fitting out services* in class 37 and *advice and information on interior buildings usage including suitability for an intended use* in class 42.

Link

84. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

I have already found that the marks are aurally and conceptually identical and visually similar to a high degree.

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

I have found the similarity of the services at issue to range from identical to similar to a low degree. I apply the same findings in relation to the relevant public and purchasing process as set out above in paragraphs 44 and 45.

[9] *O2 Worldwide Limited v CX02.COM (UK) Limited*, BL O/393/19, paragraph 39

The strength of the earlier mark's reputation

The earlier mark enjoys a modest reputation in relation to *construction and fitting out services* in class 37 and advice and *information on interior buildings usage including suitability for an intended use* in class 42.

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

As set out previously, I find the opponent's mark to hold a low to medium degree of inherent distinctive character. I am satisfied, however, that the mark's distinctiveness has been enhanced to no more than a medium degree in respect of *construction and fitting out services* in class 37 and advice and *information on interior buildings usage including suitability for an intended use* in class 42.

Whether there is a likelihood of confusion

Earlier in my decision I found a likelihood of direct confusion between the parties' marks in respect of all the applied for services.

85. Taking these factors together, I am satisfied that the relevant public will make the necessary link between the marks. Whilst the reputation of the earlier mark is only modest, the marks are aurally and conceptually identical and visually similar to a high degree. I have also found the respective services to be identical or similar to varying degrees, with an overlap in the relevant public. In my view, these factors are sufficient for the earlier mark to be brought to mind when the applicant's mark is encountered.

Damage

86. I must now consider whether any of the possible damage which has been pleaded will arise.

Unfair advantage

87. In its statement of grounds, the opponent submits as follows in respect of unfair advantage:

> "The applicant's mark calls to mind the earlier mark and is likely to create a link to the earlier mark in the mind of the average consumer […] to benefit from the positive image built up by the opponent in the earlier mark and to ride the coattails of the opponent's investment in the use and promotion of the earlier mark."

88. I note that in *Argos Limited v Argos Systems Inc* [2018] EWCA Civ 2211, the Court of Appeal held that a change in the economic behaviour of the customers for the goods and/or services offered under the later trade mark was required to establish unfair advantage. This may be inferred where the later trade mark would gain a commercial advantage from the transfer of the image of the earlier trade mark to the later mark: see *Claridges Hotel Limited v Claridge Candles Limited & Anor* [2019] EWHC 2003 (IPEC).

89. Unfair advantage does not require proof of a subjective intention by the applicant to benefit from the reputation of the opponent's mark. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. (as he then was) considered the earlier case law and concluded that:

> "80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the

reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill."

90. I have already found a likelihood of direct confusion, whereby consumers may mistake one mark for the other. Whilst that finding does not, of itself, establish unfair advantage, it is relevant to the opponent's pleaded case. In circumstances where consumers believe that services offered under CITISPACE originate from the opponent, or from an undertaking commercially connected with it, the applicant would be liable to benefit from the recognition and reputation already established under CITYSPACE. That perceived connection may make the applicant's services more attractive or reduce the effort required to establish an independent commercial identity. Taking into account the exceptionally close marks, the proximity of the services and the opponent's modest reputation, I am satisfied that there is a real, rather than hypothetical, risk of unfair commercial advantage.

91. As I have found there to be unfair advantage, I do not consider it necessary to assess the other pleaded heads of damage.

Due cause

92. Within its written submissions in lieu, the applicant submits that the use of its mark is with due cause. This is because the applicant's mark was adopted in 2004, approximately 12 years before the filing of the opponent's earlier mark.[10]

93. If the applicant intended to rely upon due cause as a defence, it should have pleaded that case in its Form TM8 so that the opponent was aware of the case it had to meet. I therefore do not consider that due cause is properly before me.

[10] Paragraph 33 of the applicant's submissions in lieu.

However, for completeness, I will consider whether the applicant's evidence would have been sufficient to establish due cause had the point been properly pleaded.

94. In *Leidseplein Beheer BV v Red Bull*, Case C-65/12 the CJEU held that:

> "60. Consequently, it follows from all of the foregoing considerations that the answer to the question referred is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the proprietor of a trade mark with a reputation may be obliged, pursuant to the concept of 'due cause' within the meaning of that provision, to tolerate the use by a third party of a sign similar to that mark in relation to a product which is identical to that for which that mark was registered, if it is demonstrated that that sign was being used before that mark was filed and that the use of that sign in relation to the identical product is in good faith. In order to determine whether that is so, the national court must take account, in particular, of:
>
> • how that sign has been accepted by, and what its reputation is with, the relevant public;
>
> • the degree of proximity between the goods and services for which that sign was originally used and the product for which the mark with a reputation was registered; and
>
> • the economic and commercial significance of the use for that product of the sign which is similar to that mark."

95. I have already summarised the applicant's evidence of longstanding use of CITISPACE when considering honest concurrent use and do not repeat it here. I remind myself that Mr Kidd claims that use of its mark commenced in 2004 and evidence shows use dating from 2005 in relation to the applicant's property business, together with substantial rental and management income. I also bear in mind Mr Kidd's evidence that he was unaware of the opponent until the present proceedings.

96. In relation to the class 36 services, I consider the factors identified in *Leidseplein* to weigh in the applicant's favour. Its use substantially predates the filing of the earlier mark, is longstanding and economically significant, and relates closely to the property management, letting and rental services covered by the application. On the evidence before me, that use also appears to have been adopted in good faith. Balancing the respective interests of the parties, I would have been satisfied that the applicant had due cause for use of CITISPACE in relation to its class 36 services. Had due cause been distinctly pleaded, the section 5(3) opposition would therefore have failed in relation to those services. However, as due cause was not pleaded, that conclusion does not alter the outcome of this ground.

97. I reach a different conclusion in relation to class 37. The applicant's evidence does not demonstrate comparable longstanding use of CITISPACE as a trade mark for the provision of construction, renovation, maintenance or related services. I would not, therefore, have found due cause established in relation to those services.

98. In light of my findings, the opposition under Section 5(3) succeeds in its entirety.

Section 5(4)(a)

99. Section 5(4)(a) of the Act states as follows:

> "5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –
>
> a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
>
> aa)…
>
> b)…

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

100. Subsection (4A) of section 5 of the Act states:

""(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

101. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (*per Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

Relevant date

102. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC (now KC), as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.' "

103. The prima facie relevant date is the filing date of the application, namely, 6 June 2025. However, the applicant relies upon use of CITISPACE which predates that date. Mr Kidd states that the applicant first began advertising its property complex under CITISPACE in 2004 but the earliest public use supported by documentary evidence is an archived webpage dated 23 December 2005. As explained by the Appointed Person in *CASABLANCA*, BL O/349/16, it is not necessary for the applicant to demonstrate that it had acquired goodwill at that point.[11] I will therefore assess the position at 23 December 2005, being the date on which the behaviour complained of is first established, and consider whether the position would have been different at the prima facie relevant date of 6 June 2025.

Goodwill

104. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (at 223-224):

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

[11] See paragraphs 35-37

105. I have already considered the opponent's evidence in some detail and do not intend to repeat it here. Mr Seward states that services have been offered under CITYSPACE since December 1989 and that, since the business was founded, it has managed over 1,650 commercial office design, fit-out and relocation projects. This is supported to some extent by the archived website evidence, which describes the business as providing "INTELLIGENT WORKPLACE DESIGN SINCE 1989" and confirms that its services are offered under the CITYSPACE brand. Whilst the documentary and financial evidence concerning the scale of the business is concentrated on a much later period, taking the evidence as a whole, I am satisfied that by 23 December 2005 the opponent had acquired a protectable level of goodwill under CITYSPACE in relation to commercial office design and fit-out services and that CITYSPACE was distinctive of that goodwill.

106. The evidence also establishes that the opponent's goodwill continued to the prima facie relevant date and had increased in scale by that time. I do not consider that the position on misrepresentation would have been materially different at 6 June 2025. I will therefore assess misrepresentation at the earlier date, which represents the applicant's strongest position.

107. However, the passing-off assessment must be based upon the opponent's actual goodwill and the applicant's conduct at the relevant date. At that time, the opponent's goodwill related to commercial office design and fit-out, whilst the applicant's documented use concerned its urban apartment development. Although those activities were not identical, both concerned the development and use of property and the signs were exceptionally close. I must therefore determine whether, in those circumstances, a substantial number of the opponent's customers or potential customers would have understood the applicant's use as indicating a commercial connection with the opponent.

108. I remind myself that, under section 5(2)(b), I found there to be a likelihood of direct confusion between the parties' marks in respect of all of the applied-for services. I recognise that the tests for likelihood of confusion and misrepresentation are not identical. However, in *Comic Enterprises Ltd v*

Twentieth Century Fox Film Corporation [2016] EWCA Civ 41, Kitchin LJ observed that it was doubtful whether the difference between those legal tests would, all other factors being equal, produce different outcomes. In the present case, I have found the marks to be aurally and conceptually identical and visually similar to a high degree. Taking those findings into account, together with the proximity between the respective services and the opponent's goodwill, I am satisfied that a substantial number of the opponent's customers or potential customers would be likely to believe that services provided under CITISPACE originate from, or are commercially connected with, the opponent. I therefore find that there would be a misrepresentation.

109. Having reached that conclusion, I consider that damage to the opponent's goodwill through diversion of custom is a reasonably foreseeable consequence. I am therefore satisfied that the requirements of passing off are met and the opposition under section 5(4)(a) succeeds.

CONCLUSION

110. The opposition under sections 5(2)(b), 5(3) and 5(4)(a) of the Act has succeeded. Subject to any appeal against this decision, the application will be refused for all of its applied-for services.

COSTS

111. The opponent has succeeded 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 **£1400** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing the statement of grounds and considering the counterstatement:	£400
Filing evidence:	£800

Official fees:	£200
Total:	**£1400**

112. I therefore order Citispace Group Limited to pay Cityspace Consult LLP the sum of **£1400**. 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 26th day of October 2026

Catrin Williams
For the Registrar