**O/0977/26**

**TRADE MARKS ACT 1994**

**UK TRADE MARK APPLICATION NO. 4085337**

**IN THE NAME OF A2DOMINION HOUSING GROUP LIMITED**

**TO REGISTER**

# ARTISI

**FOR SERVICES IN CLASS 36, 37, 41**

**AND**

**OPPOSITION NO. 600003497 THERETO**

**BY**

**GWENAN O'CONNOR**

## BACKGROUND AND PLEADINGS

1. A2Dominion Housing Group Limited ("**the Applicant**") seeks to register the following trade mark:

ARTISI

("**the Contested Mark**")

**Filing Date:** 8 August 2024
Publication date: 23 August 2024

The services applied for are set out in detail later in this Decision, but, in approximate terms, are as follows:

**Class 36**: services relating to property (real estate)
**Class 37**: building construction and repair services
**Class 41**: *Provision of gymnasium facilities* (precisely)

2. The trade mark application is opposed by Gwenan O'Connor ("**the Opponent**"), who is the registered proprietor of the following trade mark:

ARTISTA

("**the Earlier Mark**")

**Registration No:** 3879527
**Filing Date**: 17 February 2023
**Registration date**: 12 May 2023

The services of the Earlier Mark relied on by the Opponent are as follows:[1]

1 My underlining of certain terms in the table has no significance beyond drawing the eye to some indicative points of comparison with the services applied for.

| Class 35 |
| --- |
| *Advertising; business management; business administration; office functions; facilities management business services; project management for building, construction and civil engineering projects; organisation and management of sub-contractors; business management services for all types of construction, maintenance, installation and repair of buildings and civil engineering structures; marketing, promotion, publicity and advertising of real estate including commercial and residential real estate; exhibitions relating to real estate development; promotion of industrial and technology parks and of commercial and residential property; management services for industrial and commercial buildings and property undertakings; business consultancy and advisory services; management and operation of commercial and residential property, including apartments and general retail space; the bringing together for the benefit of others, of a variety of retail outlets, entertainment, restaurant, health and beauty, leisure, sport and fitness, bar, financial, dry cleaning, estate agency, telecommunications and photographic services, enabling customers to conveniently view and purchase goods and services and make use of such facilities in a shopping centre, mall or residential environment.* |
| **Class 36** |
| *Real estate management services for others; arranging of leases and rental agreements for real estate; assessment and management of real estate; classified real estate listings of apartment rentals and housing rentals; commercial real estate agency services; evaluation of real property; land acquisition, namely, real estate brokerage; lease of real estate; leasing of real estate; leasing of real property; providing a database of information about residential real estate listings in different neighbourhoods and communities; providing an internet website portal offering information in the fields of real estate concerning the rental, purchase and sale of apartments, condos, villas, and cabins; providing information in the field of real estate by means of linking the web site to other web sites featuring real estate information; providing information in the field of real estate via the internet;* |

*providing real estate listings and real estate information via the internet; real estate equity sharing, namely, managing and arranging for co-ownership of real estate; real estate consultancy; real estate investment trust management services; real estate management consultation; real estate listing services for apartments, condos, villas, and cabin; real estate management of vacation apartments, condos, villas, and cabins; real estate service, namely, rental property management; real estate services, namely, rental of apartments, condos, villas, and cabins using pay per click advertising on a global computer network; real estate services, namely, rental of short-term furnished apartments, condos, villas, and cabins; real estate services, namely, leasing and management for others of residential condominiums located within hotel developments; real estate services, namely, apartments, condos, villas, and cabins rental management services; real estate services, namely, rental, brokerage, leasing and management of apartments, condos, villas, and cabins; real estate services, namely, condominium management services; real estate time-sharing; vacation real estate time-sharing; rental of apartments, condos, villas, and cabins; real estate agency and brokerage services, real estate service namely providing real estate listings for facilitating condominium and other real estate transactions; hotel condominium management services; hotel condominium financial asset management*

**Class 37**

*Real estate development; housing services, namely, development of real property, namely, repair, improvement, and new construction; providing information and commentary in the field of real estate development; real estate development and construction of hotel, resort, casino, restaurant, bar, and nightclub property; real estate site selection; real estate property cleaning, repair and maintenance services; refurbishing of hotels, resorts, casinos, restaurants, bars, and nightclubs. Building construction and repair; installation services; advisory services relating to building refurbishment; advisory services relating to development of property; advisory services relating to property development; advisory services relating to the renovation of property; apartment refurbishment services; building refurbishment services; cleaning of property; commercial retail property*

*development services; property development; development of buildings; development of land, being construction services; housing development; information services relating to the refurbishment of buildings; interior refurbishment of buildings; property maintenance; real estate development; refurbishment and services of property development; interior decoration services; restoration of architectural works.*

**The pleadings**

3. The Opposition is based solely on grounds under Section 5(2)(b) of the Trade Marks Act 1994 ("**the Act**"). The Opponent's Notice of Opposition includes the claims listed below. The Opponent's final submissions in support of the opposition include some emphasis of particular points from the parties' respective pleaded positions. For this reason, I record the Opponent's statement of case in some detail, along with the Applicant's responses in its counterstatement, as follows:

i. The Contested Mark, ARTISI, is highly similar to the Earlier Mark, ARTISTA, in terms of appearance, sound, and meaning.

ii. Both marks are "*used for exactly the same services or for similar services within the same or related sectors, increasing the likelihood of confusion among the public*".

iii. Consumers may mistakenly perceive 'ARTISI' as a variant or sub-brand of 'Artista', leading to direct confusion (mistaking one for the other) or indirect confusion (believing the marks are linked).

iv. Visual Similarity: Both marks are short and share a similar structure, with the prefix "Artis-".

v. The only difference lies in the suffix ("-ta" vs. "-i"), which is minimal and unlikely to prevent confusion.

vi. Phonetic Similarity: Both marks are pronounced similarly, with a near-identical first syllable and slight variation in the final sound, which may go unnoticed in spoken communication.

vii. Conceptual Similarity: Both marks evoke artistic or creative associations, leading to similar impressions in the minds of consumers.

**The Applicant's defence**

4. The Applicant's counterstatement in its Form TM8 set out denials, admissions, non-admissions and submissions in defence of its trade mark application, responding to the specifics of the Opponent's statement of claims (noted above). Those responses in the pleaded defence are as follows:

Similarity of marks:

i. It is **not admitted** that ARTISI is *"highly similar to ARTISTA in terms of appearance, sound and meaning*" or that the marks are "*short*".

ii. It is **admitted** that "*ARTISI and ARTISTA share a similar structure, with the prefix "Artis-*"" and that the "*only difference lies in the suffix ("-ta" vs. "i")*", but it is **denied** that this difference "*is minimal and unlikely to prevent confusion*".

iii. *It is **not admitted** that "both marks are pronounced similarly, with near-identical first syllable and slight variation in the final sound, which may go unnoticed in spoken communication."*

iv. It is **not admitted** that "*both marks evoke artistic or creative associations, leading to similar impressions in the minds of consumers.*"

Similarity of services:

v. It is **admitted** that some of the services of the Opponent's earlier registration relied upon are identical or similar to the Application.

vi. It is **denied** that both marks are used for exactly the same services *"or for similar services within the same or related sectors, increasing the likelihood of confusion among the public.*"

Likelihood of confusion

vii. It is **denied** that consumers may mistakenly perceive 'ARTISI' as a variant or sub-brand of 'Artista', leading to direct confusion or indirect confusion.

5. The Applicant reserved the right to further particularise its position and file detailed submissions during the proceedings.

**Representation, consolidation and separation, and papers filed**

6. The Applicant is represented by Charles Russell Speechlys LLP. The Opponent is represented by Sion O'Connor (her son).

7. In response to the Opponent's opposition to the Application, the Applicant sought to invalidate the Earlier Mark on which the Opposition is based,[2] and the cross-proceedings were initially consolidated, to be heard together. The invalidity claims are based on grounds under section 3(6) and section 5(4)(a) of the Act, and, in view of evidential issues discussed at a case management conference,[3] including cross-examination and a request to file further evidence (after closure of the evidence rounds), the Opposition was separated from the invalidity proceedings. The position of the invalidity hearing will be revisited according to the parties' wishes in light of this Decision and outcome of the Opposition. Meanwhile, the Opposition lends itself to determination without reference to evidence.

8. Both parties filed detailed final submissions on 25 September 2026. This Decision is based on my close reading of the pleadings and submissions.

**STATUTORY PROVISIONS**

9. Sections of the Act applicable to this Decision are set out below:

**Section 5** Relative grounds for refusal of registration.

2 Proceedings number CA000508406.
3 Held on 25 August 2026.

(1) [...]

**(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".

….

5A Grounds for refusal relating to only some of the goods or services

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.

10. The ARTISTA trade mark relied on by the Opponent, constitutes an "earlier trade mark" for the purposes of section 5 since it was filed before the application date of the contested Application.[4] Since the Opponent's Earlier Mark had been registered for less than five years at the filing date of the Application, the use conditions set out in section 6A of the Act are not engaged and the Opponent may rely on all of the specified services under the Earlier Mark.

**RELEVANCE OF EU LAW**

9. 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.

4 Section 6 of the Act.

## CASE LAW PRINCIPLES

11. 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 THE SERVICES**

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

i. their intended purpose;

ii. their method of use / uses;

iii. who the users of the services are;

iv. the trade channels through which the services reach the market;

v. whether they are in competition with each other (taking into account whether they are in the same or different sectors); and

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

vi. whether they are complementary to each other. Complementary has been described as meaning that *"there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking"*.[6] Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.[7]

13. I bear in mind too that when interpreting terms in a specification that it is *"necessary to focus on the* core *of what is described* [... and that] *trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise",* although *"where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods* [and services] *in question"*.[8]

14. Importantly for the present contested services, where services in the specification of one party's mark are included in a broader term from the other party's specification, they are considered to be identical: see *Gérard Meric v OHIM*, Case T-133/05, paragraph 29.

15. **Annex 2** to this Decision reproduces the colour-coded table from the Applicant's final submissions, in which it highlights the applied-for services that the Applicant admits to be identical to services specified under the Earlier Mark. It is clear that the Applicant accepts that the great majority of the applied-for services are identical; the table also identifies services for which similarity is admitted, as well as those that it argues are not similar.

**Identical Services**

16. The Applicant accepts that the following services applied for in Classes 36 and 37 are identical to the registered services of the Earlier Mark. There is therefore no dispute between the parties as to the identity of the services listed below:

6 *Boston Scientific Ltd v OHIM,* Case T-325/06, paragraph 82
7 *Kurt Hesse v OHIM, Case C-50/15 P*
8 *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

**Class 36**

*Real estate agency; Estate agencies (Real -); Estate management (Real -); Real estate administration; Real estate affairs; Real estate appraisals; Real estate valuations; Real estate services; Real estate property management; Real estate affairs services; Financial evaluations [real estate]; Residential real estate agency services; Rental of real estate and property; Arranging of shared ownership of real estate; Advisory services relating to real estate ownership; Provision of information relating to real estate; Real estate management services relating to residential buildings; Real estate management services relating to office premises; Real estate management services relating to commercial buildings; Real estate management services relating to building complexes; Real estate management services relating to entertainment venues; Real estate management services relating to industrial premises; Real estate management services relating to retail premises; Real estate management services relating to shopping centres; Estate management services relating to transactions in real property; Real estate listing services for apartment rentals; Real estate agency services relating to the purchase and sale of buildings; Real estate agency services relating to the purchase and sale of land; Lease of real estate; Real estate management services; Real estate assessment [financial]; Rental of real estate; Real estate lease renewal services; Provision of housing accommodation; Accommodation (rental of -) [apartments]; Rental of buildings; Rental of property; Rental of flats; Apartment rental services; Rental of homes; Rental of houses; Renting of dwellings; Rental of apartments; Housing management; Real estate management services relating to housing estates; Rental of student housing; Rental of flats, studios and rooms; Management of apartments; Providing real estate information relating to property and land; Providing information relating to real estate affairs, via the Internet; Leasing of freehold property; Leasing of real estate; Providing information relating to the leasing of land; Property management; Property portfolio management; Property management services; Administration of property portfolios; Real estate and property management services; Estate agency; Estate management; Estate brokerage; […] rental and management of social rented properties; […] rental and management of social rented properties; […] rental and management of affordable rented properties; […] rental and management of private rented properties; […] rental and management of shared ownership properties*

**Class 37**

*Construction of leisure complexes; House building; Construction of houses; Construction of house extensions; Custom construction of houses; Residential construction; Construction of residential properties; Residential and commercial building construction; Consultancy relating to residential and building construction; Construction of property; Custom building construction; Construction advisory services; Building construction consultancy; Building and construction services; General building construction services; Building construction; Refurbishment of buildings; Building; Building repair; Building services; Building of apartment buildings; Building of offices; Building of shops; Maintenance of buildings; Decorating of buildings; Building services relating to building for habitation; Insulating of buildings; Building construction and repair; Building repair and renovation; Building maintenance and repair; Development of land [construction]; Conversion of shop premises; Conversion of business premises; Masonry; Plastering; Plumbing; Roofing repair; Roofing services; Roofing installation; Building sealing*

**My approach on similarity**

17. I consider below the services that the Applicant admits are similar, but submits are not identical. I take account of the Opponent's submissions on the comparison while reaching my own conclusions on their degree of similarity.

**Similar Services**

18. The Applicant accepts that the following services applied for in Classes 36 and 37 are similar to some extent to the registered services of the Earlier Mark:

**Class 36:**

- *Rent collection;*
- *Rent payment services;*

19. For its part, the Opponent submits that collecting rent is an ordinary incident of managing rental property and that the applied-for *Rent collection; Rent payment services* are caught within the scope of *real estate management services for others* and *real estate service, namely, rental property management* under the Earlier Mark and are therefore identical according to the inclusion principle expressed in *Meric*. I find that rental property management, may involve, for instance, advertising available rental properties, communicating with tenants, handling any property issues, collecting the rental amount from the occupant and relaying rental payments to the landlord. I accept, therefore that rent collection / payment services are included within the Opponent's *rental property management*. The services may therefore be considered **identical**.

- *Housing agency*

20. The Opponent submits that housing agency services, according to the inclusion principle expressed in *Meric*, are identical to agency and brokerage services under the Earlier Mark. I find, for example, that *real estate services, namely, rental, brokerage, leasing and management of apartments* under the Earlier Mark may include the sort of social housing that may typically be associated with a housing agency. I therefore accept that the applied-for *Housing agency* may be considered **identical** to those services of the Earlier Mark.

- *Sale* […] *of social rented properties;*
- *Sale* […] *of affordable rented properties;*
- *Sale* […] *of private rented properties;*
- *Sale* […] *of shared ownership properties*

21. The Applicant submits that the "sale" elements of the above, singled out from the fuller specified terms applied for, are not identical to the services of the Earlier Mark, but only similar. Brokerage services involve an intermediary that connects buyers and sellers to facilitate transactions such as the sale of real estate. In my view, the above property sale services may reasonably be considered as among the real estate transactions facilitated and anticipated by the Earlier Mark's *real estate agency and brokerage services, real estate service namely providing real estate listings for*

*facilitating condominium and other real estate transactions.* I find the above applied-for sale services may be considered to be **identical**, and in any event are highly complementary and overlapping in users, purpose and channels of trade.

**Class 37:**

- *Building demolition*

22. The Applicant submits that the "demolition" element, singled out from the fuller specified terms applied for, is not identical to the services of the Earlier Mark, but only similar. I note that the Earlier Mark includes *project management for building, construction and civil engineering projects* in Class 35. I find that - perhaps paradoxically - building and construction, as well as civil engineering works, may involve demolition. However, in my view, project management involves organising and coordinating sub-contractors and is a role distinct from the construction and demolition and other works within a project. I find the demolition services in Class 37 are **similar to medium degree** based on factors such as complementarity, channels of trade and shared users.

- *Building project management services*

23. Section 60A(1) of the Act provides that for the purpose of the Act goods and services are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, nor are they to be regarded as being dissimilar from each other on the ground that they appear in different classes. The Opponent notes that the Earlier Mark has registered protection for services in Class 35 that include: *project management for building, construction and civil engineering projects.* These strike me as **identical** services on an ordinary reading. Given the precision and closeness in the way the respective specifications are expressed, I am not satisfied that they should be considered less than identical simply because they reside in different classes under the Nice Classification system. This conclusion on identity is not obviously disrupted by the provision of Section 60A(1) of the Act, notwithstanding that it refers only to matters of similarity. In any event, the Applicant admits similarity in respect of these applied-for services in Class 37, and I find that even if they are not identical to the Class 35 services, they are **identical** to *Real*

*estate development* services in Class 37 under the Earlier Mark (based on *Meric*) or else very highly similar based on shared nature, purpose and users.

**Services that are not similar**

24. The Applicant submits that the following services applied for in Classes 36 and 41 are dissimilar to the registered services of the Earlier Mark, or at most very lowly similar.

**Class 36:**

- *Property (Real estate -) finance;*
- *Provision of finance for real estate development;*
- *Financial services relating to real estate property and buildings;*
- *Real estate investment services;*
- *Financial consultancy relating to real estate investment;*
- *Provision of finance for leasing;*
- *Financing of property development;*
- *Property investment services;*
- *Financial services relating to the sale of property;*
- *Financing services relating to real estate development*

25. The above services essentially enable the financing of real estate projects of various types, though some are expressed in terms that reasonably capture a wider range of services than simply providing money. The Opponent highlights the following services under the Earlier Mark, also in Class 36:

- *real estate investment trust management services;*
- *hotel condominium financial asset management;*
- *real estate equity sharing, namely, managing and arranging for co ownership of real estate;*
- *real estate consultancy*

26. While I acknowledge the financial emphasis of contested services, and the need to base comparisons on the core of the respective services, I do not agree with the Applicant that the above are dissimilar or only very lowly similar. I find that the more widely expressed contested services are these:
    - *Financial services relating to real estate property and buildings;*
    - *Real estate investment services;*
    - *Financial consultancy relating to real estate investment;*
    - *Financing services relating to real estate development.*
    - *Financial services relating to the sale of property;*

27. I find that there is **at least a high degree of similarity** with the services identified under the Earlier Mark, which are concerned with investment trust and condominium financial asset management, arranging for co ownership of real estate and real estate consultancy at large.

28. Even in respect of the remainder of the identified contested services, that are more inherently focused on serving as the source of financial support i.e. *Property (Real estate -) finance; Provision of finance for real estate development; Provision of finance for leasing; Financing of property development* - I find there is **at least a low similarity** with the services identified under the Earlier Mark, taking into account factors such as users, trade channels and complementarity.

**Class 41:**

- *Provision of gymnasium facilities*

29. The Opponent estimates the similarity of this single contested term at a lower level. The Opponent notes that the following services are specified under the Earlier Mark:

    (i) **Class 35**: *the bringing together for the benefit of others, of a variety of […] health and beauty, leisure, sport and fitness […] services, enabling customers to conveniently view and purchase goods and services and make use of such facilities in a shopping centre, mall or residential environment*.

(ii) **Class 36**: *real estate services, namely, leasing and management for others of residential condominiums located within hotel developments" and "hotel condominium management services*

(iii) **Class 37**: *real estate development and construction of hotel, resort, casino, restaurant, bar, and nightclub property*.

30. I agree with the Opponent that the term at paragraph 29(i) above extends to enabling customers to make use of sport and fitness facilities in a residential environment. The Opponent relies on various factors to argue that the applied-for *Provision of gymnasium facilities* services are similar to the services of the Earlier Mark, as follows.

31. The Opponent submits that the services have shared end users, in the form of residents of, and visitors to, the residential, hotel and mixed-use schemes in which such facilities are provided. The Opponent argues that the services may entail the same trade channels, since undertakings which develop, let and manage residential and hotel schemes commonly provide the on-site gymnasium themselves, or procure it and hold it out as part of their own offering. I acknowledge that it may well be that the gym facilities in a development are not marketed independently of the development.

32. I also acknowledge that there may be circumstances in which the services may be complementary (according to the description of the concept in *Boston Scientific*), since residents' use of the fitness facilities is an important part of what they acquire when taking an apartment in such a scheme, and a resident will naturally assume that the facilities are provided by, or under the authority of, the undertaking responsible for the scheme.

33. However, while I have acknowledged aspects of the Opponent's submissions on similarity in respect of *Provision of gymnasium facilities*, I also find that the provision of fitness machines for the use of residents of an apartment development is a different scenario from *Provision of gymnasium facilities* in the more usual context of a leisure

centre or fitness club accessible to the public at large (even if by payment or membership).

34. In view of the above considerations, I find there is **a low degree of similarity** in relation to the *Provision of gymnasium facilities* in Class 41.

**THE AVERAGE CONSUMER AND THE NATURE OF THE PURCHASING ACT**

35. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods or services in question. The word "average" here denotes that the person is typical.[9] The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. It is therefore necessary to determine who is the average consumer of the respective services, and how the consumer is likely to select those services. 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.[10]

36. The services at issue are directed both at the general public, including tenants, buyers, sellers and homeowners commissioning building works or using fitness facilities, and at business and professional customers, including landlords, investors and developers.

37. The Opponent submits that the level of attention will be *"average for everyday services such as rentals, repairs, maintenance and gym use, and may be higher for property purchase, investment and finance."*

38. The Applicant argues that *"even for the general public, the services in question are high value, specialist services, which will be chosen carefully, with a very high degree of care and attention. Constructing or buying, or indeed renting one, is typically one of the most financially significant decisions of most people's lives."* It submits that both for members of the public and commercial professionals, *"the purchasing*

9 *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), paragraph 60

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

*process is likely to be a lengthy one, during which the mark will be encountered repeatedly. These are … some of the most important purchasing decisions the buyer will make, and the purchasing process itself is highly involved, typically taking weeks, months or years, during which the buyer is repeatedly exposed to the mark."*

39. The Opponent makes various criticisms of the position submitted by the Applicant (particularly the repeat exposure point), which I shall address in this Decision to the extent I consider warranted, including under my consideration of a likelihood of confusion. For the purpose of this part of my Decision, which is focused on the average consumer and nature of the purchasing act, I accept the caution advanced by the Opponent that the level of attention cannot be taken as uniformly high across the specifications. The assessment must be made across the whole of each specification on the basis of notional and fair use, not by reference to a selection of examples drawn from the more valuable end of the listed services. Nonetheless, for the great majority of the applied-for services, I agree with the Applicant that they are costly, substantial and specialist. They are not regular or casual purchases and will be attended with a degree of research and a high or very high degree of care.

40. There are some services that may engage a level of attention less elevated than others and the Opponent points to the following services and fair and notional circumstances:

"rent collection, rent payment services, rental of flats, rental of flats, studios and rooms, rental of student housing, renting of dwellings, roofing repair, plastering, plumbing, masonry, building sealing, decorating of buildings, maintenance of buildings and provision of gymnasium facilities. A student renting a room, a tenant paying rent, a householder engaging a plasterer or a resident using a gym is not making one of the most significant financial decisions of his or her life."

41. I accept that a householder's selection of a tradesman to carry out plastering work may demand a lower degree of attention than, for example, *Real estate management services relating to building complexes* or *Residential and commercial building construction.* However, plastering is a messy, and fairly time-consuming service, often necessitating disruptive occupation of parts of one's private home; plastering services are engaged very infrequently, are not particularly cheap and the quality of

the finish will be important. In my view, the purchasing process still entails an above-medium or high degree of attention. Similar considerations apply to the other examples given by the Opponent, such as masonry and roofing repair, and even engaging plumbing and building decoration services, which will entail a higher-than-average degree of attention. A student renting a room or a tenant paying rent is engaging those services for the purpose of their living accommodation, even if that is temporary. This strikes me as a significant decision, with regular and significant cost and, in my view, the purchasing process entails an above-medium or high degree of attention.

42. The marks will be seen in marketing materials, including online and potentially in signage of commercial premises or on-site hoardings. The selection of the services is therefore primarily visual, although I do not discount that aural considerations may play a part by way of word-of-mouth recommendations.

**COMPARISON OF MARKS**

43. The marks to be compared are these:

| **The Contested Mark** | **The Earlier Mark** |
|---|---|
| ARTISI | ARTISTA |

44. Each mark is a single word. The overall impression of the respective marks resides in each word as a whole.

45. Consumers will perceive each of the marks as a whole. I find that these are certainly not long or complex marks. In the continuation sheet of the TM7F, the Opponent claimed that the marks are “short”. While the Applicant’s counterstatement had not admitted that claim, in its final written submissions in lieu of an oral hearing the Applicant admitted the claim that the marks are “short”. However, I accept the

Opponent's submission that nothing turns on the label as such, and it would be wrong to treat "shortness" as engaging any "special rule under which the differences between these marks are given greater weight than the ordinary principles allow."

**Visual comparison**

46. ARTISTA and ARTISI are single words of seven and six letters respectively, which coincide in their first five letters. The Opponent invoked references in case law to the effect that "the consumer normally attaches more importance to the first part of words." It cited paragraph 81 of the General Court finding in *El Corte Inglés v OHIM*,[11] which reads as follows:

"*It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters 'lo' which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter 'r', which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity*."

47. The Opponent submitted that "the same reasoning applies directly here: the presence of the same root ARTIS- in ARTISTA and ARTISI gives rise to a strong visual similarity."

48. For the Applicant, Counsel submitted as follows: "the ending "ISI" is strikingly different from the ending "ISTA". "ISTA" as a suffix is familiar to English speakers – e.g. "barista", or "fashionista". There are no common English words (which I can think

11 Joined Cases T-183/02 and T-184/02

of) which end in the suffix "ISI" – reinforcing its striking and fanciful nature and consequent high degree of inherent distinctiveness. Visually, therefore, the degree of similarity is no higher than medium."

49. Clearly, the first five letters of each, A-R-T-I-S, are identical and appear in the same order and the same position. This gives rise to a significant degree of visual similarity. However, unlike the MUNDICOR case, the respective marks end with different letters, which in my view has a notable impact on their visual impressions. The opening and closing letters of the Earlier Mark are a letter "A", which sandwich the five letters "RTIST". The combination of the symmetry of the bookending As, with the additional length of the word and the difference of the "-TA" ending of the Earlier Mark versus the "-I" ending of the shorter word of the Contested Mark, leads to a different visual impression. [12] Overall, I find that the marks are **visually similar to a medium degree**.

**Aural comparison**

50. Both marks comprise three syllables. It seems to me that the most likely pronunciation of the Contested Mark will be AR-TEE-ZEE, though it may also be pronounced as (i) AR-TEESS-EE (ii) AR-TIZ-EE or (iii) AR-TISS-EE.

51. The Earlier Mark will be pronounced as AR-TISS-TA or AR-TEE-STA.

52. The Opponent submitted that "the stress in each falls on the second syllable, so the only point of difference lies in the unstressed final sound, which is the part of a word least clearly articulated, least clearly heard and least well remembered." The Opponent cited the case law notion that "English speakers slur the endings of words, with the consequence that the beginning is accentuated by comparison".[13] The Opponent submitted that the marks are aurally similar to a high degree.

53. Counsel for the Applicant submitted that "aurally, the degree of similarity is low." He submitted that "the second two syllables of the respective marks are strikingly different". I agree that the differences are most pronounced where the Contested

12 It is also in no doubt that identical beginnings can be offset by different endings – see for example, the General Court in CureVac GmbH v OHIM, T-80/08, at [41].

13 Sargent LJ in *London Lubricants (1920) Ltd's Application* (TRIPCASTROID) (1925) 42 RPC 264 at 279

Mark is spoken as AR-TEE-ZEE and the Earlier Mark as AR-TISS-TA. Although other possible pronunciations may bring the marks aurally closer, the inevitable differing sounds in their final syllables remain clearly perceptible.

54. The premise of a tendency to slur, expressed in *London Lubricants*, is merely a potential rule of thumb to consider. I agree that the stress in both parties' marks falls on the second syllable, the lightest emphasis being on the first syllable, but I find that the actual difference between the enunciation of the sounds ISSTA / ISSEE and EESSTA / EEZEE is notable and will be distinctly heard. I find the marks aurally similar to no more than a medium degree.

**Conceptual comparison**

55. Counsel for the Applicant submits as follows:

"ARTISTA, to all or at least the vast majority of consumers, will be understood as conveying the concept of "artist" - perhaps in a foreign language (Spanish/Italian). Even non-Spanish/Italian-speakers are very likely to recognise that the word ARTISTA entirely contains the word 'artist', and to those consumers ARTISTA is likely to suggest the concept of the word 'artist', perhaps in some unknown foreign language. For those consumers, that concept is not reproduced in the ARTISI Application, such that the marks are conceptually different.

Some other consumers (a much smaller number - and it is submitted a negligible number) may not recognise ARTISTA as conveying the concept of the word 'artist'; for those consumers, there is no concept, the conceptual comparison is not possible and the marks are conceptually neutral as regards one another."

56. The Opponent accepts that UK consumers will understand ARTISTA as meaning "artist", given its closeness to the English word. The average consumer is a construction of the typical consumer and is deemed reasonably well informed. With that in mind I agree with the Applicant's submission that the proportion of consumers of the services at issue who would fail to recognise ARTISTA as conveying the

concept of the word ‘artist’ is negligible. The average consumer would immediately perceive in the Earlier Mark the concept of ‘artist’.

57. The Opponent accepts that “ARTISI has no settled meaning in English” and states that “it is no part of her case that ARTISI has a clear and specific meaning of its own.” However, it also states that the opening element ARTIS in the Contested Mark “will nonetheless evoke the same idea of art, artists and artistry. That string is the common opening of a family of ordinary English words which share a single underlying idea, that of art and of making: artist, artistic, artistry and artisan among them.” The Opponent argued that if UK consumers read ARTISTA as "artist", that concept is shared with the identical ARTIS- opening of the Application. I must assess matters from the perspective of the constructed average consumer, and I am not satisfied that the word ‘ARTISI’ gives rise to any immediately graspable concept in the mind of that consumer, particularly as the Opponent herself acknowledges that ARTISI has no clear and specific meaning of its own.

58. At paragraph 53 of the Opponent’s submissions, it is claimed that no conceptual difference arises “merely because one mark conveys a concept and the other does not.” I take some issue with that statement. In my view, the finding that ARTISTA conveys an immediately graspable concept (of ‘artist’), and that the word ARTISI has no clear and specific meaning, does give rise to a conceptual difference.

**DISTINCTIVE CHARACTER OF THE EARLIER MARK**

59. The distinctive character of the earlier mark must be assessed, as, potentially, the more distinctive the earlier mark, either inherently or through use, the greater the likelihood of confusion.[14]

60. In *Lloyd Schuhfabrik*, the Court of Justice of the European Union stated that:

14 *Sabel* at [24]

"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-2779, 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 […]"

61. The Opponent submits that "*ARTISTA is the word for "artist" in Italian, Spanish and Portuguese. It is not an English word. It neither describes nor alludes to any characteristic of real estate, construction, business or hospitality services. It is therefore inherently distinctive to at least a medium degree, and for the substantial part of the UK public that does not recognise it as a foreign word it is an unusual, invented-looking term of higher distinctiveness still*."

62. The Applicant also acknowledges that ARTISTA means 'Artist' in European languages. Counsel submits that "*this meaning will be recognised by all or at least the vast proportion of UK consumers - namely, those who speak Italian or Spanish [or Portuguese], have a general grasp of Latin-derived languages, or even just those who recognise that the word 'artist' is entirely contained within the word ARTISTA, differing by only one letter A at the end. This meaning, 'artist', is at least allusive to the 'artistic' nature of the services offered under it, and for at least some of the services may even be descriptive (for example, and without limitation, interior decoration services, or indeed construction). As such, its degree of inherent distinctive character will be low to medium.*"

63. I am not convinced that the word ARTISTA is descriptive for any of the earlier services. Even in respect of terms such as *interior decoration services* or *building construction* or *restoration of architectural works,* the term is no more than allusive.

For the vast majority of the services under the Earlier Mark, I find the word to be neither descriptive nor allusive. The most that might be said is that the word has a laudatory ring, but I find that overall the Earlier Mark has at least a medium degree of distinctive character. The Opponent has not claimed any use of the Earlier Mark, nor filed evidence of such, so the assessment of distinctive character rests only on the inherent position.

**CONCLUSION AS TO LIKELIHOOD OF CONFUSION**

64. I turn now to make a global assessment of likelihood of confusion if the parties' marks were used concurrently in respect of their respective services. This assessment takes account of my findings set out in the foregoing sections of this decision and of all of the various principles from case law outlined in my paragraph 11 above.

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

66. The respective services are identical and case law allows that a greater degree of similarity between services may offset a lesser degree of similarity between the marks. The selection of the services is primarily visual, although aural considerations may play a part by way of word-of-mouth recommendations. I do not consider the marks to be highly similar, but there is a medium degree of visual and aural similarity. The Earlier Mark has at least a medium degree of distinctive character, though there has been no enhancement of its distinctive character through use.

67. In my view, the average consumer will perceive in the Earlier Mark the concept of "ARTIST", despite the additional letter "A" at the end of the word mark. The Opponent submits that the identical ARTIS- opening of ARTISI evokes the same field, and the marks are conceptually similar. I do not accept that position. Although the Contested Mark contains "ARTIS", I find the conceptual effect of the mark as a whole too inchoate. The presence of ARTIS in the Contested Mark is not, in my view, sufficient

to give rise to any immediately graspable concept in the mind of the average consumer. There is a conceptual difference between the marks.

68. That said, the Opponent is of course correct that conceptual difference is one factor to be weighed with the others as part of the global assessment of a likelihood of confusion. Conceptual counteraction is not a trump card that necessarily overcomes any perceived visual or aural similarity. Mr O'Connor drew my attention to two cases in which one mark was an invented word without meaning, the other conveyed a concept, and notwithstanding the conceptual difference those oppositions succeeded, because the average consumer was likely to misremember one mark for the other.[15] While I have noted those examples, it is of course the case that each set of proceedings must be determined according to its facts in a global assessment taking account of all relevant factors.

69. In my view, taking all of the relevant factors into account, including the overall impression of the marks, there is not a likelihood of confusion. Even allowing for imperfect recollection, where the average consumer does not have the chance to make a direct comparison of the marks, but instead relies on the imperfect picture of them that they have kept in their mind, and notwithstanding that the great majority of the services may be considered to be identical, I am satisfied that the differences between the marks are sufficient to rule out the likelihood of direct confusion on the part of the average consumer. My conclusion in this regard takes account not only of the differences between the marks, but in particular the high degree of attention that will be brought to bear in the process of selecting the services at issue, both by professional customers and by members of the public.

70. In this regard, as I noted at paragraph 39 in this Decision, I do not overlook the Opponent's criticisms of the Applicant's submissions. Mr O'Connor submits as follows:

15 BL O/033/21 (BLOMST / BLOOMIST, for identical tableware goods); BL O/566/19 (PIMKIE / PINKIES, for identical jewellery goods). These examples contrast with the finding *against* confusion in *Ruiz-Picasso (Ruiz-Picasso v OHIM*, Case C-361/04 P (Picasso / Picaro for motor vehicles).

*"Repeat exposure during a transaction does not meet the point. An argument from repeated exposure assumes a consumer who has already identified the correct undertaking and is then exposed to its mark repeatedly. The risk under section 5(2)(b) arises earlier, at the point of first encounter: in a search result, a portal listing, a site hoarding, a brochure or an oral recommendation, where the consumer has only an imperfect recollection of the Earlier Mark to work from. Even a circumspect and attentive consumer does not retain a letter-by-letter record of a mark: Lloyd Schuhfabrik at [26]."*

71. It is unnecessary to consider here the concept of initial interest confusion – the trade mark infringement doctrine that allows for a finding of liability where consumers may be initially confused as to the origin of goods/services, even if the confusion is dispelled by the time they make a purchase. My conclusion that there is no likelihood of confusion, factors in my findings regarding the degree of visual and aural similarity of the marks, and a measure of conceptual difference, and the high degree attention that will be brought to the process of selecting and purchasing the services.

72. The repeated exposure to the mark that may or may not arise in the purchasing process is not the operative factor, serving to correct an initial misapprehension on the part of the consumer. Rather, my finding is that in view of the consequential and costly nature of the services at issue,[16] which are typically engaged infrequently, the level of attention that will be paid from the outset in selecting the services and to the sign under which they are marketed, will be high and the average consumer, who is reasonably well informed and reasonably circumspect and observant, will recall the mark and will not mistake the Contested Mark for the Earlier Mark or vice versa. For these reasons, I confirm my finding that there is no likelihood of direct confusion.

73. (For the avoidance of any doubt, my finding of no likelihood of confusion extends to the *Provision of gymnasium facilities* in Class 41. Not only are those services similar only to a low degree, but even if there may be circumstances in which use of a public gym may be chosen casually, with a lower degree of attention, those are not the circumstances on which my finding of similarity is based.)

16 I note that identical goods at issue in other cases, which have offset a lower degree of similarity between the marks, have typically been the sorts of goods that do not give rise to an elevated degree of attention in their purchasing process.

74. It is clear that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion" and that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.[17] Even if the average consumer were to encounter both marks, no likelihood of confusion arises where a later mark merely calls to mind the earlier mark (mere association). As emphasised by James Mellor QC, sitting as the Appointed Person in *Eden Chocolat*: "*… it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element.*" [18]

75. An often-cited account of principles bearing on indirect confusion is that of Iain Purvis QC sitting as the Appointed Person in *LA Sugar Ltd v Back Beat Inc* (O/375/10):

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning—it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually 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:

17 *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16]

18 Case BL O-547-17 *Duebros Limited v Heirler Cenovis GmbH* (27 October 2017) at paragraph 81.4.

(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)."

76. In the present case, none of those example instances applies, and I see no good basis on which a consumer would conclude that the parties' marks are related brands merely because they share the letters 'ARTIS'. That shared string does not convey a clear common concept in the marks as a whole, and the different endings do not suggest a logical brand extension or sub-brand. That remains the case even where the services are identical. I find that there is no proper basis for a finding of a likelihood indirect confusion.

**OUTCOME**

77. The opposition under section 5(2)(b) fails. Trade mark application 4085337 may proceed to registration, subject to any successful appeal of this Decision.

**COSTS**

78. The Applicant has been successful in defence of this opposition. This success gives rise to an entitlement to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. However, I make no order for costs at this stage.

79. The parties have been extensively engaged in related proceedings in which the Applicant seeks to invalidate the Opponent's Earlier Mark.[19] Those proceedings have been suspended pending the outcome of the present Decision. If the invalidity attack is withdrawn, or proceeds to a hearing but is unsuccessful, it is likely that no order for costs will be made against either party. If the Applicant wishes to maintain its invalidity attack and to proceed to a hearing, and is successful in either of its claimed grounds, the question of costs will be determined at that stage.

**Dated this 29th day of October 2026**

**Matthew Williams**

**For the Registrar**

19 Proceedings number CA508406