

O/1043/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003787360

BY A&A PORTFOLIO LTD

FOR THE FOLLOWING TRADE MARK:

Icon Surveyors

iconsurveyors

icon surveyors

(SERIES OF 3)

IN CLASSES 36 AND 42

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 507427

BY ICON REAL ESTATE MANAGEMENT B.V.

BACKGROUND AND PLEADINGS

1. A&A Portfolio Ltd (“the proprietor”) applied to register the series of three trade marks shown on the cover page of this decision (“the Contested Marks”) in the UK on 12 May 2022. It was registered on 21 April 2023 for the following services:

Class 36 Real estate and property management services; Real estate appraisal and valuation; Real estate appraisal services; Real estate appraisals; Real estate appraisals [valuations]; Real estate management; Real estate management services; Real estate management services relating to residential buildings; Real estate property management; Real estate services; Real estate valuation services.

Class 42 Surveying Services, Residential Property Surveying, Commercial Property Surveying.

2. On 13 June 2023, Icon Real Estate Management B.V. (“the applicant”) applied to have the Contested Marks declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”) based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act.

3. However, on 24 December 2024, the applicant withdrew its section 5(3) and 5(4)(a) grounds in writing, and the applicant also withdrew its invalidation against the class 42 services. On this basis, the invalidation only proceeds against the proprietor’s class 36 services.

4. Under section 5(2)(b) only, the applicant relies upon the following trade marks:

ICON

Comparable UK trade mark (EU) registration no. UK00918003308

Filing date 21 December 2018.

Registration 10 May 2019.

(“the First Earlier Mark”)



Comparable UK trade mark (EU) registration no. UK00916670184

Filing date 3 May 2017.

Registration 22 September 2017.

Priority date 2 January 2017.

(“the Second Earlier Mark”)



Comparable UK trade mark (EU) registration no. UK00916670333

Filing date 3 May 2017.

Registration 22 September 2017.

Priority date 2 January 2017.

(“the Third Earlier Mark”)

5. Following the end of the transition period of the UK’s withdrawal from the EU, all EU trade marks (“EUTM”) registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

6. The applicant relies upon all of the earlier marks’ services, as contained in Annex 1 to this decision. The applicant also claims that there is a likelihood of confusion because the services are identical or highly similar and the marks are visually and aurally similar to a high degree, and conceptually identical.

7. The proprietor filed a counterstatement denying the claims made.

8. The applicant is represented by Taylor Wessing LLP and the proprietor is unrepresented. Only the proprietor filed evidence in chief. Neither party requested a hearing, however, the applicant filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

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.

EVIDENCE AND PRELIMINARY ISSUE

10. The proprietor's evidence consists of the witness statement of Mr Beau Monroe Davies dated 29 April 2025. Mr Monroe is the owner and director of the proprietor, and his statement is accompanied by 6 exhibits.

11. I note that the evidence in exhibits 3 to 6 has been filed showing the use of the proprietor's mark, including on its letterhead and website iconsurveyors.co.uk. Whilst its website describes the proprietor as a widely experienced specialist in Boundary Surveying, it also lists that the proprietor provides the following services: schedule of condition report, licence for alterations, access licence, RICS homebuyers report, defect analysis and digital defect analysis. In his witness statement, Mr Davies' claims that the proprietor's mark is "clearly distinguishable" from the applicant's mark, and that the "inclusion of the descriptive word "surveyors" [...] identifies a specific, regulated profession and immediately distinguishes the proprietor's services from the applicant's more general real estate services".

12. Firstly, I note that all of the proprietor's evidence is undated. Nevertheless, the proprietor's above evidence which shows the use of its mark in the market is not relevant to my assessment. I have to carry out a notional assessment based upon the

specifications before me (how the services within the parties' specifications could be used and sold), and all the circumstances in which the marks applied for might be used if they were registered.¹ The evidence, therefore, does not assist the proprietor.

DECISION

13. Section 5(2)(b) of the Act has application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

¹ *O2 Holdings Limited & Anor v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66.

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D)-(2DA) [Repealed]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

Section 5(2)(b)

14. Section 5(2)(b) reads as follows:

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

(a)...

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

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

15. Due to the First Earlier Mark’s filing date, and the Second and Third Earlier Mark’s priority dates, the trade marks upon which the applicant relies qualify as earlier trade marks pursuant to section 6 of the Act. While I note that in its counterstatement, the proprietor requested the applicant provide “proof of use” of its earlier marks, the earlier marks have not completed their registration process more than five years before the

relevant date (the filing date of the proprietors' trade marks). Accordingly, the use provisions at section 47(2A) of the Act do not apply. The applicant may rely upon all of the services it has identified without demonstrating that it has used the marks.

Section 5(2)(b) - case law

16. In making this decision, I bear in mind the following principles gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

17. The competing services are as follows:

Applicant's services	Proprietors' services
<p>The First Earlier Mark <u>Class 36</u></p>	<p><u>Class 36</u> Real estate and property management services; Real estate appraisal and</p>

<p>Real estate portfolio management; commercial real estate brokerage.</p> <p>The Second and Third Earlier Mark</p> <p><u>Class 35</u></p> <p>Management of apartments in a shared building; management of separate spaces in a shared building.</p> <p><u>Class 36</u></p> <p>Management of buildings; management of commercial real estate; leasing of buildings; rental of buildings; consultancy in relation to the rental of buildings; insurance of buildings; real estate agency services in relation to the rental of buildings; real estate agency services in relation to commercial real estate.</p> <p><u>Class 37</u></p> <p>Maintenance of buildings; repairing of buildings; decorating of buildings; consultancy services in relation to the renovation of buildings.</p>	<p>valuation; Real estate appraisal services; Real estate appraisals; Real estate appraisals [valuations]; Real estate management; Real estate management services; Real estate management services relating to residential buildings; Real estate property management; Real estate services; Real estate valuation services.</p>
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18. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be

taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

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

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

20. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (“GC”) stated that:

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

21. For the purposes of considering the issue of similarity of services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

22. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

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

Real estate and property management services; Real estate management; Real estate management services; Real estate management services relating to residential buildings; Real estate property management; Real estate services.

23. I find that all of the applicant’s class 36 services in its First, Second and Third Earlier Marks’ specifications falls within the proprietor’s above broader categories. They are, therefore, identical on the principle outlined in *Meric*.

Real estate appraisal and valuation; Real estate appraisal services; Real estate appraisals; Real estate appraisals [valuations]; Real estate valuation services.

24. Real estate appraisals are typically performed by real estate agents and are intended to set a guide price to help sell a property. Real estate valuations are typically provided by those who work in real estate agencies, however, these individuals will possess a further qualification which allows them to provide a report of the specific market value of a property (assessing its size, location, age, condition and local market trends, including the recent sales of comparable properties). I therefore consider that these services will overlap in trade channels with the applicant’s class 36 services, all of which would also be provided by real estate agencies. The services will also overlap

in user. I do not consider that the services are in competition, however, I find that the applicant's "commercial real estate brokerage" services may be complementary to the proprietors services on the basis that the purchase and sale of a commercial property cannot be conducted without the property being appraised and valued. The user of the services will also clearly believe that the services originate from the same undertaking. Therefore, taking the above into account, I find that the parties' services are similar to a medium degree.

The average consumer and the nature of the purchasing act

25. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

26. The average consumer for the services are likely to be property owners, whether that be an individual (including members of the general public), or an organisation. The cost of the services in question is likely to vary, albeit it is likely to be on the higher end of the scale as all of the services pertain to property and real estate. The frequency of purchase is also likely to vary.

27. Nevertheless, the average consumer will take various factors into consideration, such as the cost, the location, reputational standing of the provider and the suitability

of the services for their specific needs. I also consider that as all of the services are related to property and real estate, the average consumer will be paying a high degree of attention during the purchasing process.

28. The services may be purchased following the perusal of advertisements or via signage on the physical premises of a real estate agency. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from a real estate agents or via word-of-mouth recommendations.



Comparison of the trade marks

29. It is clear from *Sabel BV 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. 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.”

30. 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.

31. Therefore, the respective trade marks are shown below:

Applicant's earlier marks	Proprietor's trade marks
<p data-bbox="376 300 611 376">ICON</p> <p data-bbox="308 418 683 452">("the First Earlier Mark")</p>  <p data-bbox="284 651 707 685">("the Second Earlier Mark")</p>  <p data-bbox="301 1133 687 1167">("the Third Earlier Mark")</p>	<p data-bbox="847 506 1350 577">Icon Surveyors</p> <p data-bbox="860 633 1337 705">iconsurveyors</p> <p data-bbox="850 763 1345 835">icon surveyors</p> <p data-bbox="987 909 1209 943">(SERIES OF 3)</p>

Overall Impression

32. The First Earlier Mark consists of the word "ICON". There are no other elements to contribute to the overall impression which lies in the word itself.

33. The Second Earlier Mark consists of the word "ICON", presented horizontally in an ordinary black capitalised typeface, with each letter presented in its own black box, all of which are connected. I find that the word "ICON" plays a greater role in the overall impression of the mark, with the stylisation and orientation playing a lesser role.

34. The Third Earlier Mark consists of the word "ICON", presented vertically in an ordinary black capitalised typeface, with each letter presented in its own black box, all of which are connected. I find that the word "ICON" plays a greater role in the overall impression of the mark, with the stylisation and orientation playing a lesser role.

35. The proprietor's marks consist of the words "Icon" and "Surveyors", either presented in title-case or in lower-case. Two of the series includes a space between the words "Icon" and "Surveyors" and one in the series presents the words "Icon" and "Surveyors" conjoined. As I will come to discuss in the conceptual comparison, the parties' have agreed that the word "Surveyors" is descriptive of the proprietor's services, and therefore I find it plays a lesser role in the overall impression, with the word "Icon" playing a greater role.

Visual Comparison

The First Earlier Mark and the proprietor's marks

36. Visually, the applicant's First Earlier word mark, "ICON", is fully replicated at the beginning of the proprietor's marks, a position to which the average consumer usually pays more attention.² This clearly acts as a visual point of similarity. However, the proprietor's marks end in the word "Surveyor". This acts as a visual point of difference. I therefore find that the marks are visually similar to above a medium degree.

The Second Earlier Mark and the proprietor's marks

37. Visually, the marks overlap in the word "ICON". This element appears at the beginning of the applicant's mark which as noted above, the average consumer usually pays more attention to. This acts as a visual point of similarity. However, the Second Earlier Mark consists of the box stylisation encompassing the letters "ICON" and the proprietor's marks end in the word "Surveyor". These act as visual points of difference. I find that the marks are visually similar to no more than a medium degree.

The Third Earlier Mark and the proprietor's marks

38. Visually, the marks overlap in the word "ICON". This acts as a visual point of similarity. However, the Second Earlier Mark also consists of the box stylisation encompassing the letters "ICON", which is presented vertically, and the proprietor's

² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

marks end in the word “Surveyor”. These act as visual points of difference. I therefore find that the marks are visually similar to no more than a medium degree.

Aural Comparison

The First Earlier Mark and the proprietor’s marks

39. Aurally, the word “ICON” in the First Earlier Mark, and at the beginning of the proprietor’s marks, will be given their ordinary dictionary pronunciation. The word “Surveyor” at the end of the proprietor’s marks will also be given its ordinary dictionary pronunciation. Therefore, due to the aural identity of the word “ICON” at the beginning of the marks, I find that they are aurally similar to above a medium degree.

The Second Earlier Mark and the proprietor’s marks

40. The box stylisation of the Second Earlier Mark will not affect its pronunciation. I therefore find that the same comparison applies in paragraph 39 above. I find that the marks are aurally similar to above a medium degree.

The Third Earlier Mark and the proprietor’s marks

41. The vertical box stylisation of the Third Earlier Mark will not affect its pronunciation. I therefore find that the same comparison applies in paragraph 39 above. The marks are aurally similar to above a medium degree.

Conceptual Comparison

The First Earlier Mark and the proprietor’s marks

42. Conceptually, the word “ICON” will be assigned its ordinary dictionary meaning in both the First Earlier Mark and the proprietor’s marks. The word “Surveyors” at the end of the proprietor’s marks will also be given its ordinary dictionary meaning, that being a person whose job is to survey land or buildings. As noted in paragraph 11 above, in his witness statement, Mr Davies’ states that the word “surveyors” in its mark

is descriptive. In paragraph 2.5(b) of its written submissions in lieu, the applicant also states that the word surveyors in the holder's mark is descriptive, and that this is a point accepted by both parties.³ I agree and therefore find that this is a non-contentious point. The word "Surveyors" consequently acts as a conceptual point of difference between the marks, however, as the marks overlap in the concept of "ICON", I find that they are conceptually similar to above a medium degree.

The Second Earlier Mark and the proprietor's marks

43. I do not consider that the box stylisation of the Second Earlier Mark contributes to the conceptual message conveyed by the mark. On this basis, I find that the same comparison applies in paragraph 42 above. The marks are conceptually similar to above a medium degree.

The Third Earlier Mark and the proprietor's marks

44. I do not consider that the vertical box stylisation of the Third Earlier Mark contributes to the conceptual message conveyed by the mark. On this basis, I find that the same comparison applies in paragraph 42 above. The marks are conceptually similar to above a medium degree.

Distinctive character of the earlier trade mark

45. 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

³ I also note that in paragraph 4.2 of its statement of grounds, the applicant states that the word surveyors in the holder's mark "is entirely descriptive and non-distinctive for the challenged services".

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 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; 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 promotion of 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).”

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

47. Firstly, I note that the proprietor has filed evidence in exhibits 1 and 2 to show that “there are other “ICON” marks registered and operating within Class 36” and that “this demonstrates that “ICON” is not an exclusive identifier for the applicant in class 36 services”. Mr Davies states that exhibits 1 and 2 shows that “Icon Properties” “operates in a similar sector without causing market confusion with the applicant”. However, I note that exhibit 1 does not contain any evidence.⁴ Nonetheless, exhibit 2 contains an undated screenshot from iconproperties.co.uk which is an estate agents that provides sales, lettings and management services. It also contains a undated photo from the front of a property displaying the banner “ICON PROPERTIES”. Mr Davies states that

⁴ This was highlighted in the Registry’s official letter dated 15 April 2025 whereby it stated that some of the listed evidence did not appear to be present amongst the documents filed.

this shows use of the word “ICON” by other companies which operate in similar sectors without causing market confusion with the applicant.

48. In *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06 the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71).”

49. The mere fact that there may be multiple marks that contain the word “ICON” being used in the UK for class 36 services is not relevant to my assessment. Whilst Mr Davies’ has tried to show the use of “ICON” marks being used by other undertakings that provide class 36 services, I note that evidence suffers from multiple deficiencies. Firstly, all of it is undated. Secondly, whilst it is clear that “ICON PROPERTIES” provides sales, lettings and management services, I do not have any evidence such as the price lists pertaining to those services, a list of clients or turnover figures generated by the undertaking under the “ICON” mark in the UK for real estate services. Therefore, the evidence is insufficient to establish frequent use of the mark by third parties, and on this basis, I do not consider that the evidence sufficiently shows that the distinctive character of the word “ICON” has been weakened because of its frequent use in the fields concerned. Consequently, the evidence does not assist the proprietor.

50. I also bear in mind that in Mr Davies' witness statement, heading number 3 is worded as "existence of co-existence". However, the evidence contained under this evidence pertains to its above argument. I also note that in the conclusion of Mr Davies' witness statement, it says that his evidence has "demonstrated peaceful coexistence of similar marks in Class 36". I note that references to "peaceful coexistence" can be used as part of an honest concurrent use argument. However, the applicant did not actively plead such a defence. Nevertheless, I do not consider that the exceptional circumstances outlined in *Budejovicky Budvar NP v Anheuser-Busch Inc*⁵ and those factors in *Victoria Plum Ltd v Victorian Plumbing Ltd*⁶ are present in the case before me. The evidence does not establish longstanding use of the marks side-by-side, and therefore the evidence is of no assistance in giving rise to a defence of the existence of honest concurrent use. As a result, even if the proprietor did actively plead and rely upon this defence, it is nonetheless dismissed.

51. Therefore, as the applicant has not filed any evidence to show that the distinctiveness of its marks have been enhanced through use, I only have the inherent position to consider.

52. As noted above, the word "ICON" in the First, Second and Third Earlier Marks will be assigned its ordinary dictionary meaning. I consider that the average consumer will perceive this word as indicating that the applicant is an "icon", (something that is admired or has great significance), and consequently, by virtue, their services are "iconic". The word "ICON" is therefore laudatory of the applicant and the quality of its services. I also do not consider that the box stylisation of the Second and Third Earlier Marks contributes to the distinctiveness of them. As a result, I find that the earlier marks are inherently distinctive to between a low and medium degree.

Likelihood of confusion

53. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the

⁵ Case C-482/09, EU:C:2011:605

⁶ [2016] EWHC 2911

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

The First Earlier Mark and the proprietor's marks

54. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to above a medium degree.
- I have found the marks to be aurally similar to above a medium degree.
- I have found the marks to be conceptually similar to above a medium degree.
- I have found the opponent's earlier mark to be inherently distinctive to between a low and medium degree.
- I have identified the average consumer as property owners (including the general public and organisations), who will select the services primarily by visual means, although I do not discount an aural component.
- I have concluded that a high degree of attention will be paid during the purchasing process.
- I have found the parties' services to be identical or similar to a medium degree.

55. I bear in mind the decision of the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion.

56. Therefore, taking all of the above into account, considering the principle of imperfect recollection, I am satisfied that the parties' marks are likely to be mistakenly recalled as each other. The applicant's First Earlier Mark, being the word "ICON", is encompassed at the beginning of the proprietor's marks, a position which tends to make more of an impact than its ends. Albeit the word "ICON" may be perceived by the user as being laudatory of the undertaking and the quality of its services, the applicant and proprietor have both agreed that the word "Surveyor" in proprietor's marks is descriptive. On this basis, I find that the average consumer paying a high degree of attention during the purchasing process would still easily overlook the descriptive word "Surveyor" at the end of the proprietor's marks. In my view, this results in a likelihood of direct confusion on all of the parties' class 36 services, which I have found to be identical or similar to a medium degree.

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

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

58. In *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] 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". Arnold LJ agreed, pointing out 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.

59. I consider that the shared common use of the word "ICON" in the parties' marks will lead the average consumer to conclude that they originate from the same or economically linked undertakings. I bear in mind that the ordinary dictionary word "Surveyors" is defined as a person whose job is to survey land or buildings, and that the proprietor's marks are being used on class 36 services which pertains to land and buildings. Furthermore, as noted above, the applicant and proprietor have both agreed that the word "Surveyor" at the end of the proprietor's marks is descriptive of its services. Consequently, the average consumer will see the addition of the descriptive "Surveyors" element and perceive it as either an updated version of the same mark, and therefore indicative of re-branding, or a sub-brand mark (ICON being the house brand and ICON SURVEYORS being the sub-brand mark). Therefore, taking all of the above into account, I consider there to be a likelihood of indirect confusion.

The Second and Third Earlier Marks and the proprietor's marks

60. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to no more than a medium degree.
- I have found the marks to be aurally similar to above a medium degree.
- I have found the marks to be conceptually similar to above a medium degree.
- I have found the opponent's earlier marks to be inherently distinctive to between a low and medium degree.
- I have identified the average consumer as property owners (including the general public and organisations), who will select the services primarily by visual means, although I do not discount an aural component.
- I have concluded that a high degree of attention will be paid during the purchasing process.
- I have found the parties' services to be identical or similar to a medium degree.

61. I consider that the box stylisation of the Second and Third Earlier Marks, and the vertical orientation of the Third Earlier Mark, would easily be overlooked by the average consumer paying a high degree of attention, especially as they play a lesser role in the overall impression of the marks. I therefore find that the same considerations apply in paragraphs 55 and 56 above. There is a likelihood of direct confusion between the Second and Third Earlier Marks and the proprietor's mark.

62. I also consider that the shared common use of the word "ICON" in the parties' marks will lead the average consumer to conclude that they originate from the same or economically linked undertakings.

63. The applicant and proprietor have both agreed that the word "Surveyor" at the end of the proprietor's marks is descriptive of its class 36 services. Consequently, the average consumer will see the addition of the "Surveyors" element in the proprietor's mark, and the removal of the box stylisation in the Second and Third Earlier Marks (including the removal of the vertical orientation of the Third Earlier Mark), and will perceive all of the marks as being updated versions of the same mark, and therefore indicative of re-branding. I consider that it is not uncommon for undertakings to re-brand themselves from time to time to accommodate changes in marketing considerations. I therefore find there to be a likelihood of indirect confusion.

CONCLUSION

64. The partial application for invalidation is fully successful and the proprietors' mark is hereby declared invalid in respect of the following services for which it was registered:

Class 36 Real estate and property management services; Real estate appraisal and valuation; Real estate appraisal services; Real estate appraisals; Real estate appraisals [valuations]; Real estate management; Real estate management services; Real estate management services relating to residential buildings; Real estate property management; Real estate services; Real estate valuation services.

65. Under section 47(6) of the Act, the registration is deemed never to have been made for the above services.

66. However, the proprietor's mark remains registered for the following services:

Class 42 Surveying Services, Residential Property Surveying, Commercial Property Surveying.

COSTS

67. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale set out in Tribunal Practice Notice 1/2023.

68. In the circumstances, I award the applicant the sum of £850 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing the application for invalidity and considering the Counterstatement	£250
Considering the applicant's evidence	£150 ⁷
Filing written submissions in lieu	£350
Official fee	£100 ⁸
Total	£850

69. I therefore order A&A Portfolio Ltd to pay Icon Real Estate Management B.V. the sum of £850. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

⁷ On the basis that the applicant filed limited evidence, which was not particularly helpful in these proceedings, I award the opponent less than the usual scale to consider such evidence.

⁸ As noted at paragraph 3 above, the applicant withdrew its section 5(3) and 5(4)(a) grounds. The official fee for filing an opposition on the basis of section 5(2)(b) only is £100, and the applicant has been awarded as such.

Dated this 10th day of November 2025

L FAYTER

For the Registrar

ANNEX 1

The First Earlier Mark

Class 36

Real estate portfolio management; commercial real estate brokerage.

The Second Earlier Mark

Class 35

Management of apartments in a shared building; management of separate spaces in a shared building.

Class 36

Management of buildings; management of commercial real estate; leasing of buildings; rental of buildings; consultancy in relation to the rental of buildings; insurance of buildings; real estate agency services in relation to the rental of buildings; real estate agency services in relation to commercial real estate.

Class 37

Maintenance of buildings; repairing of buildings; decorating of buildings; consultancy services in relation to the renovation of buildings.

The Third Earlier Mark

Class 35

Management of apartments in a shared building; management of separate spaces in a shared building.

Class 36

Management of buildings; management of commercial real estate; leasing of buildings; rental of buildings; consultancy in relation to the rental of buildings; insurance of buildings; real estate agency services in relation to the rental of buildings; real estate agency services in relation to commercial real estate.

Class 37

Maintenance of buildings; repairing of buildings; decorating of buildings; consultancy services in relation to the renovation of buildings.