O/1079/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. 3972823 AND 3972828
BY ENGEX LTD
TO REGISTER THE FOLLOWING TRADE MARKS:

(SERIES OF TWO)

IN CLASS 37

AND

Centric Facilities Management

CENTRIC FACILITIES MANAGEMENT

(SERIES OF TWO)

IN CLASS 37

AND

OPPOSITIONS THERETO UNDER NUMBERS 445813 AND 445812
BY CENTRICK LIMITED

BACKGROUND AND PLEADINGS

1. On 27 October 2023, Engex Ltd ("the applicant") applied to register in the UK the trade marks numbered 3972823 ("823") and 3972828 ("828") as outlined on the front cover page of this decision (collectively "the contested marks"). The applications were accepted and published for opposition purposes on 10 November 2023 and registration is sought for the following services:

> **Class 37**: Installation, repair and maintenance of cleanroom facilities and equipment; Air conditioning apparatus cleaning services; Advisory services relating to the maintenance and repair of mechanical and electrical equipment; Servicing and repair of mechanical access platforms; Building services; Building consultancy services; Building cleaning services; Consultancy services relating to the repair of buildings; Advisory services relating to the installation of building automation equipment; Interior and exterior cleaning of buildings; Providing information relating to building cleaning; Facilities management; Building construction and repair; Providing information relating to the construction, repair and maintenance of buildings; none of the aforesaid in relation to the management, control, optimisation or efficiency of energy and energy consumption.

2. On 12 February 2024, Centrick Limited ("the opponent") opposed the applications in full under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following series of trade marks:

> **centrick**
>
> **CENTRICK**
>
> UK registration no. 3067263
> Filing date 06 August 2014; registration date 13 February 2015
> Relying on the following services:

Class 35: Advertising; auctioneering of property or land; relocation services for businesses or individuals; marketing of property or land; marketing research in relation to property or land; consultancy, information or advisory services relating to any of the aforesaid.

Class 36: Property management; property portfolio management; renovation of property; valuation of property; valuation of real estate; valuation of land; valuation of farms; valuation of offices or office space; administration of property portfolios; real estate agency services; real estate appraisal; real estate brokers; real estate management; rent collection; rental, leasing or letting of real estate; rental, leasing or letting of offices or office space; rental, leasing or letting of houses or apartments; renting, leasing or letting of farms; rental, leasing or letting of land; property finding services; management of land; land acquisition services; consultancy, information or advisory services relating to any of the aforesaid.

Class 37: Construction of property; construction supervision; maintenance of property; renovation of property; building repair; cleaning services; interior or exterior painting of property; decorating; glazing; plumbing; plastering; roofing; electrical services relating to buildings; cleaning services; land reclamation; land excavating; land developing; land drainage; dismantling of buildings; preservation of buildings; interior refurbishment of buildings; insulating of buildings; pest control relating to buildings; services for the construction of buildings; consultancy, information or advisory services relating to any of the aforesaid.

3. The marks relied upon by the opponent qualify as ‘earlier marks’ in accordance with section 6 of the Act. They have been registered for more than five years at the filing date of the applicant’s mark and are, therefore, subject to the proof of use requirements in section 6A of the Act. The applicant has requested that the opponent provide proof of use for the following terms:

Class 37: Maintenance of property; renovation of property; building repair; cleaning services; electrical services relating to buildings; cleaning services[1]; preservation of buildings; interior refurbishment of buildings; pest control relating to buildings; services for the construction of buildings

4. Under section 5(2)(b) the opponent claims that there is a likelihood of confusion on the basis that the marks are similar, and the services are either identical or highly similar leading to a likelihood of confusion, including a likelihood of association, and that the contested marks should be refused registration.

5. The applicant filed a defence and counterstatement denying the claims made and requesting that the opponent provides proof of use of its earlier trade marks only in so far as the services as aforesaid as relied upon.

REPRESENTATION

6. The opponent is represented by Forresters IP LLP and the applicant is represented by The Trademark Helpline. Both parties filed evidence in these proceedings. Neither party requested a hearing, nor did they file additional written submissions in lieu of a hearing. This decision is taken following a careful consideration of the papers filed.

PRELIMINARY ISSUES

7. It is noted that the applicant has filed a witness statement of Mr Warick Wincup[2], the Director of Engex Ltd who has held this position since 2021. The witness statement includes evidence of the applicant's business, and its intended use of Centric Facilities Management, along with exhibits of "potential visuals for future use". I note that within Mr Wincup's witness statement he provides details as to the background of the company and some of its activities, as well as evidence on the matter. Mr Wincup also makes reference to the fact that there are multiple active companies listed on

[1] The term *cleaning services* appears twice within the opponent's specification and has therefore been listed twice in the applicant's TM8. I consider these terms to be identical and will therefore only deal with this once within my decision.

[2] The deadline for filing the applicant's evidence was 7 October 2024, however, the applicant did not file their witness statement until 8 October 2024. The applicant subsequently filed a TM9R which was unopposed, and the evidence was entered into proceedings.

Companies House that share the word Centric, and therefore the word is commonly used.

8. In this instance, the applicant's evidence is not relevant as the assessment I must undertake under section 5(2)(b) is a notional one; the provisions of the Act are not merely a reflection of what is happening in the market[3]. When assessing the likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark might be used if it were registered[4], as the use that the applicant has made of its mark prior to the application does not precede the opponent's earlier right. My assessment must take into account only the contested mark, its specification, and any potential conflict with the earlier marks. Therefore, I will not comment any further upon this evidence in respect of its support of the above points. Mr Wincup has also made submissions within his witness statement regarding the likelihood of confusion between the marks, which I will refer to at the appropriate time later in my decision.

EVIDENCE & SUBMISSIONS

9. The opponent filed a witness statement of Mr James William Ackrill, dated 5 October 2024, which is accompanied by twelve exhibits JAW1-JAW12. Mr Ackrill is a Director of Centrick Ltd and he provides evidence of use of the opponent's mark.

10. I have given due consideration to all of the documents filed but will only refer to the evidence/submissions as appropriate to the extent that is necessary in my decision.

DECISION

11. 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

[3] *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41
[4] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66

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.

PROOF OF USE

12. The relevant statutory provisions are as follows:

> "6A(1) This section applies where
>
> (a) an application for registration of a trade mark has been published,
>
> (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
>
> (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
>
> (1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.
>
> (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
>
> (3) The use conditions are met if – (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.
>
> (4) For these purposes – (a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not

the trade mark in the variant form is also registered in the name of the proprietor), and (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

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

13. Section 100 of the Act states that:

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

14. The relevant period for assessing genuine use is the five-year period ending with the filing date of the application in issue, i.e. 28 October 2018 – 27 October 2023.

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

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV*

[EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 W.F. *Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

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

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

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

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns:

Ansul at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

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

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

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

16. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person stated that:

> "22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

17. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me, and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the contested mark.

The Opponent's Evidence

18. In his witness statement, Mr Ackrill states that he has been the Director of Centrick Limited since 23 March 2005. As part of his evidence, Mr Ackrill has provided print outs of company information pertaining to Centrick Limited which has been taken from the Government Companies House website[5]. This comprises of the incorporation and structure of the company and its officers. It also lists the dates upon which the company accounts were filed. This is a matter of public record and does not contribute to my assessment, and therefore, I will not comment upon this any further.

19. Mr Ackrill has produced background information relating to Centrick Limited and has provided evidence in the way of screenshots from the company website[6]. I note that these screenshots have been taken from the website https://centrick.co.uk and "shows my company's use the [sic] Centrick brand for a range of property, building,

[5] Exhibit JWA1
[6] Exhibit JWA2

construction and related services"[7]. I note that these screenshots are undated, and the evidence illustrates some of the services on offer, such as property services including build to rent, building and estate management, asset management, valuation and professional services and investment and new homes, as well as maintenance services.

20. Mr Ackrill has produced further screenshots from the same site[8] which "clearly demonstrate that the earlier marks have been used in the United Kingdom for a wide range of services, including (but not limited to) the services that proof of use has been requested for, namely:

> *Maintenance of property; renovation of property; building repair; cleaning services; electrical services relating to buildings; cleaning services; preservation of buildings; interior refurbishment of buildings; pest control relating to buildings; services for the construction of buildings"[9].*

21. The screenshots refer to "examples" of Centrick Limited's building and estate management services, national portfolio asset management solutions which includes property management, and a "platform designed to simplify, support and streamline your whole build-to-rent operation"[10]. I note that there is the provision for users to enter their contact details for a member of the building and estate management team to contact them. Page 7 of the screenshots states "26477 homes we manage carefully every day, 200+ team members on your side, 500+ communities we look after, £4bn property in our care". I also note that the website states "Building and estate management with Centrick. Explore just some of the ways our Building & Estate Management solutions help our client's every day". The site then goes on to list the services that are provided by the opponent. I note that these screenshots are undated, however, there is reference later on in the evidence which appears to be indicative of the website pages during part of the relevant period. Mr Ackrill submits that there were 45,000 clicks on their websites, such as those website pages

[7] Witness statement of Mr James Ackrill, paragraph 4
[8] Exhibit JWA3
[9] Witness statement of Mr James Ackrill, paragraph 5 – I note that the applicant has not put the opponent to proof in respect of "services for the construction of buildings" and I will therefore not proceed to consider proof of use in respect of this term
[10] Exhibit JWA3 page 25

referenced in JWA2 and 3[11], and that the company invested in advertising between January 2022 and July 2024.

22. I note that two promotional documents have also been provided which "set out a selection of the various services that my companies have offered under the Centrick brand"[12]. A number of sections of the documents have been highlighted. The document states "Centrick Property's unique service offering combines block management, maintenance, sales and lettings services…Centrick property specialises in estate management, residential sales and lettings, maintaining developments and managing property lettings on behalf of its clients nationwide". The brochure highlights the following services:

a. Sales – Selling tenanted units to maintain rental income
b. Lettings
c. Tenancy management
d. Build to rent asset management
e. Rent collection & arrears management
f. Lettings maintenance and expenditure
g. Block management
h. Estate management services (including garden maintenance, hard landscaping maintenance, safety checks, refuse checks, minor management)

I have no evidence before me as to how these promotional documents are distributed, who they are distributed to or with what frequency.

23. Mr Ackrill has produced a selection of news articles and online publications that demonstrate the use of the CENTRICK brand across the United Kingdom during the relevant period[13]. I note that all of these articles have been taken from the CENTRICK website directly. All of the articles are dated within the relevant period although some of the dates are obscured. The articles all show use of the mark for property services

[11] Witness statement of Mr James Ackrill paragraph 13
[12] Witness statement of Mr James Ackrill, paragraph 6
[13] Exhibit JWA5

including residential sales and lettings, new homes, Build-to-Rent, asset management and estate management.

24. Mr Ackrill has also produced a number of news articles[14] that reference a selection of industry awards that Centrick Limited and its related companies have been nominated for and/or won. Again, all of these articles have been taken from the CENTRICK website directly. The following occurred within the relevant period:

a. The Residential Property Management Agency of the Year at Insider's Midlands Residential Property Awards in 2022
b. Property Manager of the Year at the RESI Awards in 2022
c. Sales and Lettings Agency of the Year at the RESI Awards in 2022
d. The Company Leader (100+ employees) award at The West Midlands Leadership Awards 2022
e. The Residential Property Management Agent of the Year - Insider Midlands Residential Property Awards 2023
f. The Office Agency of the Year at the Midland Property Industry Awards 2023
g. The Regional Agency of the Year – East Midlands & West – The Negotiator 2023

25. Mr Ackrill has produced figures which illustrate the revenue generated from 1 October 2018 to 30 December 2023. These figures are as follows:

Year	Revenue (GBP ex VAT)
01 October 2018 – 30 September 2019	5,269,457
01 October 2019 – 30 September 2020	4,974,578
01 October 2020 – 30 September 2021	6,772,593
01 October 2021 – 30 September 2022	8,493,458
01 October 2022 – 30 December 2023	14,352,570
Total:	**39,862,656**

[14] Exhibit JWA6

Mr Ackrill states that these figures relate to revenue generated by Centrick Limited, Centrick Property Sales Ltd and Centrick Valuation and Professional Services Ltd. These are all entities which form part of the Centrick Group of companies[15]. The annual sales figures are further broken down by different departments[16]:

Year	Valuation & Professional Services	Building & Estate Management	Sales & Lettings
01 October 2020 – 30 September 2021	511,128	2,903,475	3,357,990
01 October 2021 – 30 September 2022	697,462	4,281,702	3,514,294
01 October 2022 – 30 December 2023	1,075,919	8,390,915	4,885,736
Total:	**2,284,509**	**15,576,092**	**11,758,020**

I note that, despite breaking down the revenue figures by relevant department, above, the headings for each set of figures are still very broad and the figures are not further broken down to assist with my assessment of use of some of the opponent's more specific terms.

26. Mr Ackrill has provided a selection of invoices dated between 1 December 2018 and 3 October 2023[17]. I note the following:

a. Mr Ackrill states that the invoices provided do not represent the total sales during the above period but represent a sample of sales in the years 2018-2023.

b. All of the invoices display CENTRICK in the header. I note that the products sold relate to various services provided by the company.

c. The invoices confirm the services have been provided to a number of addresses within the UK. The names and addresses have been redacted, although it is apparent that these include addresses in Birmingham and Poole, and that there is repeat custom.

[15] As evidenced in Exhibit JWA7
[16] Witness statement of Mr J Ackrill, paragraph 11
[17] Exhibit JWA8

d. The invoices relate to a range of services provided including caretaker, cleaning, management, major works, concierge, out of hours, block management, EWS works and 24/7 fees. The fees for these services range from £115.05 to £20,790.21.

27. Mr Ackrill has made the following statements regarding the opponent's marketing strategy and spend:

a. For the period 1 January 2022 to 29 July 2024, £6,500 was invested in Pay Per Click advertising. Mr Ackrill states that "this has secured us the number one position via Google for searches for "CENTRICK". Our Pay Per Click advertising has led to over 45,000 clicks on our websites – such as those website pages referenced in Exhibits JWA2-JWA3"[18].
b. The opponent has invested in the advertisement and promotion of the CENTRICK brand on Facebook, a breakdown of the annual promotional investment is as follows:

Date	Investment (GBP)
2020	£12,378.47
2021	£8,671.72
2022	£13,445.77
2023	£16,222.19
Total:	**£50,718.15**

c. For the period of March 2022 to October 2023, the opponent invested over £20,000 with an external PR and social media agency to promote the CENTRICK brand within the UK. An example invoice which was issued by this agency[19] has been provided for the sum of £1,320.
d. Mr Ackrill has produced a selection of advertisements in relation to the CENTRICK brand[20], however, these are dated 2 and 5 October 2015 respectively and therefore fall outside of the relevant period.
e. The opponent has sponsored a music festival in Solihull since 2018[21].
f. The opponent has sponsored Solihull Moors FC during the 2021-2022 season at a cost of approximately £6,350[22].

[18] Witness statement of Mr James Ackrill, paragraph 13
[19] Exhibit JWA9
[20] Exhibit JWA10
[21] Exhibit JWA11
[22] Exhibit JWA12

FORM OF THE MARK

28. For the sake of completeness, before I move on to assess if the opponent has shown genuine use, I must first consider if I find the use of the mark as shown in the evidence to be use of the mark as registered. As outlined *in Lactalis McLelland Limited v Arla Foods AMBA*, Case BL O/265/22,[23] the use of the mark in a different form may also constitute use of the mark as registered.

29. The earlier marks are word only marks presented in both upper and lower case. Given that normal and fair use of the registration will cover use in any standard typeface or font, where the mark is used in capitals or title case this is use of the mark as registered and is use upon which the opponent may rely. The mark is also shown as follows throughout the evidence:

30. The above variations are figurative marks in which the word CENTRICK is presented in various shades of blue font. All of the variations also include a square which is made up of small blue/green circles, and in two of the variations appears to be shaded. Two of the variations contain the additional words, PROPERTY MAINTENANCE and PROPERTY respectively. The word MAINTENANCE appears in

[23] At [13 – 15]. See also Hyphen GmbH v EUIPO, Case T-146/15, at [28-32].

a considerably smaller font beneath the other elements. I consider that these words are descriptive of the services provided and that in these variations, CENTRICK remains the dominant element of the mark. I consider that the use of a different colour, the square and the additional words do not detract from the word CENTRICK itself and will merely be seen as either descriptive or stylistic elements. As the word CENTRICK remains the distinctive element of the figurative mark, I find that these figurative forms are therefore acceptable variations of the mark and is use upon which the opponent can rely.

SUFFICIENT EVIDENCE

31. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself[24].

32. I am satisfied that the evidence shows that the trade marks have been used either as registered or in the acceptable variations as outlined. The revenue figures are in the millions per annum and the opponent has clearly taken steps to promote the products sold under its mark and to maintain a share in the market. Taking the evidence as a whole into account, I am satisfied that the earlier marks have been put to genuine use during the relevant period in the UK.

FAIR SPECIFICATION

33. Having reached the above conclusion, I must now consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the services relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they

[24] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

34. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

"245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those

which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

35. The services for which proof of use has been sought are as follows:

Class 37 - Maintenance of property; renovation of property; building repair; cleaning services; electrical services relating to buildings; preservation of buildings; interior refurbishment of buildings; pest control relating to buildings;

36. Some of the terms relied upon by the opponent are broad and would cover a wide range of services. Whilst I am satisfied that the trade mark has been used as registered, I consider that the opponent has shown enough evidence for some of their broader terms, such as maintenance of property, but not enough for some of the specific services that they have within their specification. For example, I have no evidence of electrical services or pest control. Similarly, I do not consider that the evidence before me shows that the opponent has used the mark in relation to renovation or interior refurbishment. Consequently, I consider a fair specification for the earlier mark to be:

Class 37 - Maintenance of property; Building repair; Cleaning services

DECISION

Section 5(2)(b)

37. Sections 5(2)(b) and 5A of the Act reads as follows:

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

[…]

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

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

5A 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."

RELEVANT LAW

38. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("CJEU") 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.

<u>The principles</u>

(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

39. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

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

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

41. 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."

42. Further, in *Kurt Hesse v OHIM*,[25] 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*,[26] the GC stated that "complementary" means:

> "…there is 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."

43. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

> "365. […] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear

[25] Case C-50/15 P
[26] Case T-325/06

and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case".

44. In *Avnet Incorporated v Isoact Limited* [1998] FSR 16, Jacob J (as he then was) said at [19]:

> "[…] definitions of services … are inherently less precise than specifications of goods. […] In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

I bear in mind that it is permissible to group services together for the purposes of assessment[27].

45. The services to be compared are shown in the table below:

Opponent's services	Applicant's services
Class 35: Advertising; auctioneering of property or land; relocation services for businesses or individuals; marketing of property or land; marketing research in relation to property or land; consultancy, information or advisory services relating to any of the aforesaid.	
Class 36: Property management; property portfolio management; renovation of property; valuation of	

[27] *Separode Trade Mark* BL O/399/10

property; valuation of real estate; valuation of land; valuation of farms; valuation of offices or office space; administration of property portfolios; real estate agency services; real estate appraisal; real estate brokers; real estate management; rent collection; rental, leasing or letting of real estate; rental, leasing or letting of offices or office space; rental, leasing or letting of houses or apartments; renting, leasing or letting of farms; rental, leasing or letting of land; property finding services; management of land; land acquisition services; consultancy, information or advisory services relating to any of the aforesaid.	
Class 37: Construction of property; construction supervision; Maintenance of property; building repair; interior or exterior painting of property; decorating; glazing; plumbing; plastering; roofing; land reclamation; land excavating; land developing; land drainage; dismantling of buildings; insulating of buildings; cleaning services; services for the construction of buildings; consultancy, information or advisory services relating to any of the aforesaid.	**Class 37:** Installation, repair and maintenance of cleanroom facilities and equipment; Air conditioning apparatus cleaning services; Advisory services relating to the maintenance and repair of mechanical and electrical equipment; Servicing and repair of mechanical access platforms; Building services; Building consultancy services; Building cleaning services; Consultancy services relating to the repair of buildings; Advisory services relating to the installation of building automation

	equipment; Interior and exterior cleaning of buildings; Providing information relating to building cleaning; Facilities management; Building construction and repair; Providing information relating to the construction, repair and maintenance of buildings; none of the aforesaid in relation to the management, control, optimisation or efficiency of energy and energy consumption.

46. The opponent submits as follows:

> "The contested services in class 37 are identical and/or highly similar to the Opponent's class 35, 36 and 37 services. There is a clear overlap in class 37. The parties' services have the same / similar nature, intended purpose, method of use, trade channels, users, uses and are complementary to / in competition with each other".

47. The applicant submits as follows:

> "The Applicant argues that the contested marks do not directly compete. Additionally, they assert that any perceived similarity due to the overlap in terms within class 37, as claimed by the Opponent, would not lead to confusion. Furthermore, the visual distinctions between the Application and the earlier registration invalidate any alleged similarity. While both trademarks operate in the property management domain, their specific services, approaches and brand identities set them apart".

48. Within his witness statement of 7 October 2024, Mr Warrick Wincup made the following statement in respect of the applicant's specification:

> “The opponent has made it clear that their trademark is specifically connected to residential property management services further reducing the likelihood of confusion between the two brands. Furthermore, the opponent’s registration includes a broader range of services across business management (Class 35), financial services (Class 36) and construction / repair (Class 37) which positions the opponent as a comprehensive property management and real estate service provider. Whereas, due to the narrow scope of the terms in the Applications, Centric Facilities Management seeks to demonstrate that it is a business specialising in maintaining and managing building facilities”.

Building services; Building construction and repair;

49. The above are wide terms and would encompass a variety of services and aspects of construction in relation to buildings. The opponent’s specification includes *construction of property* and *services for the construction of buildings*. I consider that these are wide ranging terms and would encompass the applicant’s terms, making them identical on the principles outlined in *Meric*.

Servicing and repair of mechanical access platforms;

50. In the absence of submissions, I consider that mechanical access platforms are items of equipment for use in the construction industry. I note that the opponent’s specification includes *building repair*, however, I do not see any obvious overlap in the servicing and repairing of this equipment/apparatus and building services generally or those contained within the opponent’s specification. It is foreseeable that those involved in the construction industry may require the use of mechanical access platforms and will therefore require the servicing and repair of the same. However, the nature, purpose and trade channels will not overlap, and I do not find competition or complementarity. I do not consider that those providing building services would also be responsible for the servicing and repair of the equipment. Therefore, I find the services to be dissimilar.

Installation, repair and maintenance of cleanroom facilities and equipment;

51. I have no submissions in respect of the above term. I would consider a cleanroom to be a controlled environment for manufacturing / testing processes, or somewhere such as a pharmaceutical laboratory. The opponent's specification includes the terms *maintenance of property* and *building repair* in Class 37. Property maintenance services include the upkeep of a property to ensure it is in good working order, safe, and presentable. I consider that these services would include a wide range of activities such as regular cleaning and landscaping, repairs to electrical and plumbing systems, structural fixes like roofing and window replacements, and safety checks and upgrades to meet health and fire regulations. As the opponent's specification includes maintenance of property at large, I consider that there would be an overlap in purpose, use and user. I do not consider that there would be competition or complementarity. I therefore find these services to be similar to a medium degree.

Building cleaning services; Interior and exterior cleaning of buildings; Air conditioning apparatus cleaning services; Providing information relating to building cleaning;

52. The opponent's specification includes the broad term, *cleaning services*. I consider that this term encompasses the applicant's above terms and is therefore identical on the principles outlined in *Meric*.

Consultancy services relating to the repair of buildings; Building consultancy services; Providing information relating to the construction, repair and maintenance of buildings;

53. The opponent's specification includes the terms *construction of property; maintenance of property; building repair; services for the construction of buildings* and *consultancy, information or advisory services relating to any of the aforesaid.* I therefore find the opponent's terms to encompass the applicant's terms on the principles outlined in *Meric*.

Advisory services relating to the installation of building automation equipment; Advisory services relating to the maintenance and repair of mechanical and electrical equipment;

54. The applicant's above services relate to advisory services in respect of the installation, maintenance and repair of various items of building equipment. The opponent's terms include advisory services relating to the maintenance of property, building repair and services for the construction of buildings. I consider that there is unlikely to be an overlap in purpose, as the opponent's terms specifically relate to maintenance and repair of property, however, there may be an overlap in user, as consumers who are seeking advisory services in relation to maintenance of property may also require advisory services in relation to automation equipment (which I consider to relate to functions such as heating, ventilation and air conditioning etc). The nature of the services may overlap, as both are advisory services, however the specific nature of these services will differ. There is unlikely to be competition or complementarity. Overall, I find the services to share a low degree of similarity.

Facilities management;

55. In the absence of submissions, I consider that *facilities management* will include the organisation of property maintenance and repair services. The opponent's specification includes the term *maintenance of property* in Class 37, which I have defined above. I consider that *maintenance of property* is a broader term which would include the applicant's term and therefore I find this to be identical based upon the principles in *Meric*.

56. As some degree of similarity between the services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition aimed against those services that I have found to be dissimilar will fail[28]. Therefore, the opposition under section 5(2)(b) fails for the following services:

Class 37 - Servicing and repair of mechanical access platforms;

[28] *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

THE AVERAGE CONSUMER AND THE PURCHASING ACT

57. 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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

58. I have no submissions from either party in regards to the average consumer and I will therefore draw my own conclusions.

59. The average consumer of the services is likely to be either a member of the general public or a professional, including those working in facilities management or the building or construction industry. I would expect the consumer to come into contact with the marks alongside services selected online or at trade fairs, for example. The services are unlikely to be selected with any real degree of frequency (with the exception of professional consumers in the relevant field) and the associated costs are likely to range from low for regular services, but in some circumstances will be significant. In approaching the selection, the average consumer will likely consider factors such as compatibility, quality and the reputational standing of the provider. The mark's visual impression is likely to play a greater part in the selection process, though I do not discount the relevance of the mark's aural impression; as bookings may be made over the telephone, for example. Weighing all factors, I find the average

consumer will likely apply between a medium and high degree of attention to the purchase.

COMPARISON OF TRADE MARKS

60. It is clear form *Sabel* 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 states at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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."

61. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade 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.

62. The marks to be compared are as follows:

Opponent's marks	Applicant's marks
centrick Mark 1 in series **CENTRICK**	centric FACILITIES MANAGEMENT

Mark 2 in series	Mark 1 in series  Mark 2 in series “The ‘823 marks”
	Centric Facilities Management Mark 1 in series **CENTRIC FACILITIES MANAGEMENT** Mark 2 in series “The 828 marks”

63. The opponent submits as follows:

> “The contested mark (CENTRIC FACILITIES MANAGEMENT) is visually, aurally and conceptually similar to the earlier mark (CENTRICK). The dominant and distinctive part of the contested mark (CENTRIC) is almost identical to the earlier mark, and this word appears at the beginning of the contested mark”.

64. The applicant submits as follows:

> "Only one of the words that make up the figurative mark…is "Centric" (the "Application"), meaning in or at the centre. Conversely, the registration relied upon for the opposition is a wordmark, which is solely composed of the word "Centrick". The Application also features a stylised blue and white "C". It is established practice that trademarks be considered as a whole, rather than judged by their component parts. It is unlikely that the relevant public would confuse a figurative mark with stylised components with the single word registration; "Centrick"".

Overall impression

65. I note that the opponent's series of two marks are word only marks and consist of 'centrick' / 'CENTRICK' respectively. Both are presented in a plain typeface. There are no additional elements to the marks and therefore the overall impression lies in the words themselves. For the purposes of the comparison, I will proceed on the basis of the second mark in the opponent's series, CENTRICK. There is no difference between the variation in the casing because a word trade mark registration protects the word itself, irrespective of font, capitalisation or otherwise. Therefore, a trade mark in capital letters covers notional use in lower case and vice versa.

The '823 Marks

66. The applicant's '823 marks are both figurative marks which consist of the words 'Centric Facilities Management' in an unremarkable blue font together with a device which is presented to the left of or above the words. In both marks, the word CENTRIC appears above the words FACILITIES MANAGEMENT, which appear in considerably smaller font. Both marks include a device consisting of a blue square, inside which is a white stylised letter 'C' which appears to be overlayed with a geometric figurative device. This device may also be perceived as a dart or a target, however, I consider that a greater proportion of consumers will perceive this to be a stylised letter shape. Since the eye is naturally drawn to the element of a mark that can be read, given its relative size and central position, the word CENTRIC naturally draws the eye and plays the greater role in the overall impression of the mark. The words FACILITIES MANAGEMENT will play a limited role, due to their size and position and because they will be seen as descriptive of the nature of the services provided by the undertaking.

The device contributes to the mark overall, but to a lesser extent as it will be seen as a decorative element, reinforcing the first letter of CENTRIC.

The '828 Marks

67. Both of the '828 marks are word only marks and consist of 'Centric Facilities Management' / 'CENTRIC FACILITIES MANAGEMENT' respectively. Both are presented in a plain typeface. There are no additional elements to the marks and therefore the overall impression lies in the words / a combination of the words themselves. For the purposes of the comparison, I will proceed on the basis of the second mark in the opponent's series, CENTRIC FACILITIES MANAGEMENT. There is no difference between the variation in the casing, as set out above. The word CENTRIC plays the greater role in the overall impression of the mark, with the words FACILITIES MANAGEMENT playing a limited role because they will be seen as descriptive of the nature of the services provided by the undertaking

Visual similarity

68. The respective marks overlap to the extent that the entirety of the first word of the contested marks is identical with the first 7 letters of the earlier marks, differing only in the letter 'K' at the end. In respect of the '823 mark, there are also additional elements, which include the device, and the words FACILITIES MANAGEMENT presented in considerably smaller font, there being no counterpart in the earlier marks. Given these factors and weighing up the similarities against the differences, I consider that the '823 marks and the earlier marks are visually similar to a medium degree.

69. In respect of the '828 marks, the respective marks differ in spelling, as above, and to the extent that the '828 marks include the words FACILITIES MANAGEMENT, which I have found play a limited role because they will be seen as descriptive of the nature of the services provided by the undertaking. Given that consumers pay more attention to the beginning of marks[29], I consider that the marks are visually similar to a medium to high degree.

[29] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, GC

Aural similarity

70. The words in both the applicant's '823 and '828 marks are the same, and as no pronouncement will be given to the device, I will proceed to consider both marks at the same time for the purposes of the aural assessment.

71. The earlier marks will be pronounced as SEN-TRICK and I consider that the element CENTRIC in the contested marks, will be pronounced identically to this. The only difference in pronunciation between this and the applicants' marks is the part that the words FACILITIES MANAGEMENT play. Given their role within the mark, being descriptive of the services on offer, the average consumer may not articulate these words, focussing solely on CENTRIC. If this is the case, the marks will be aurally identical. However, if all verbal elements of the mark are articulated, there will be a medium degree of aural similarity between them.

Conceptual similarity

72. Within his witness statement dated 7 October 2024, for the applicant, Mr Wincup submits:

> "I dispute that the opponent's registration is similar to such a degree that it would cause confusion amongst the relevant public, The key term in the Applications is 'Centric', meaning in or at the centre, whereas in the earlier registration, the sole term 'Centrick' which is unique to the opponent's business and branding. The former term 'centric' is so common that the Applications would not have been able to proceed to publication on the Trade Marks Register had they been solely composed of that term. Therefore, the Applications must both be considered as a whole rather than their component parts".

73. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer[30]. The assessment must, therefore, be made from the point of view of the average consumer.

74. Conceptually, I consider that in both the '823 and '828 marks the ordinary definition of the word CENTRIC will be applied, meaning central, or having a centre[31]. Whilst the word, CENTRICK, has no meaning, I consider that the majority of average consumers would consider this to be a mis-spelling / alternate spelling of CENTRIC, and would therefore interpret the words as having the same meaning, making them conceptually identical. The words FACILITIES MANAGEMENT in the contested marks will be regarded as describing the nature of the services on offer and are a point of conceptual difference between the marks. These elements, however, will make little impact as a point of conceptual difference overall, as a result of the shared identical concept created by the use of the elements CENTRICK/CENTRIC.

75. The device in the '823 mark will be seen as a coloured decorative element with no meaning, other than to accentuate the 'C' at the beginning of the mark. Consequently, I consider that when taken as a whole both the '823 and '828 marks are conceptually highly similar to the opponent's earlier marks.

DISTINCTIVE CHARACTER OF THE EARLIER MARK

76. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

[30] *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29
[31] CENTRIC | English meaning - Cambridge Dictionary

> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee,* paragraph 51)."

77. 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. In this instance, as acknowledged above, I find CENTRICK to have no meaning, however, I consider that the majority of average consumers would consider this to be a mis-spelling / alternate spelling of CENTRIC. It is neither descriptive nor allusive of the opponent's services. Consequently, I find that the earlier marks have a medium degree of inherent distinctive character.

78. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, and such enhanced distinctiveness may affect the likelihood of confusion between that mark and a later mark including the same, or a similar, element.

79. As discussed in detail above, the opponent filed a witness statement by Mr Ackrill to evidence its use of the earlier marks in the UK during the relevant period. Whilst I have determined that the opponent has provided sufficient evidence to illustrate use of the marks, I note that there are limitations to the evidence. The opponent has generated revenue of just short of £40 million since 2018, however there are no details in relation to the size of the relevant market, or the share of that market held by services bearing the opponent's mark which makes it difficult for me to assess whether the scale of the use shown is sufficient for establishing enhanced distinctiveness. I also note that the opponent has provided brochures, however there is no evidence as

to the distribution of said brochures. There is evidence from Mr Ackrill that their website has generated 45,000 clicks during the relevant period, although I do not know the number of online enquiries made. As noted, whilst I have found this evidence to be sufficient in respect of genuine use, I do not consider that it goes far enough to establish enhanced distinctiveness.

LIKELIHOOD OF CONFUSION

80. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the 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. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, 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.

I remind myself that I made the following findings:

- The services at issue range from being identical upon the principles outlined in *Meric* to similar to a low degree. I have also found some services to be dissimilar, however, as I set out above, these will not factor into the following assessment;

- I have identified that the average consumer will be members of the general public and businesses. Both will select the services by primarily visual means, although I do not discount an aural component;

- I have concluded that between a medium and high degree of attention will be paid;

- The ‘823 mark is visually similar to the earlier marks to a medium degree. The ‘828 mark is visually similar to the earlier mark to a medium to high degree;

- I have found that in instances where only CENTRIC is articulated in the contested marks, the marks will be aurally identical. However, if all verbal elements of the contested marks are articulated, they will be aurally similar to a medium degree;

- I have found the contested marks and the earlier mark to be conceptually similar to a high degree;

- I have found the earlier mark to be inherently distinctive to a medium degree but that the evidence did not sufficiently show that it had enhanced its distinctive character through use;

The ‘823 Mark

81. I begin by considering a likelihood of direct confusion. The competing marks share the word CENTRICK / CENTRIC, which I consider have the capacity to be mistakenly recalled one for the other, as I do not consider that consumers would remember the difference in spelling. However, the contested marks include a device and the additional words FACILITIES MANAGEMENT. I bear in mind that the selection process of the services is predominantly visual and that visual differences will be particularly important when considering direct confusion. In my view, the device, the stylisation and the additional words (albeit that they are descriptive of the services) will not be overlooked. When taking the mark as a whole, notwithstanding the principle of imperfect recollection, the marks will not be misremembered or mistakenly recalled. Consequently, I do not consider there to be a likelihood of direct confusion.

82. I will now move on to consider indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

83. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal[32]. I recognise that a finding of indirect confusion should not be made merely because the

[32] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

competing marks share a common element. The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.

84. When assessing indirect confusion, I have found that the common elements CENTRICK / CENTRIC convey an identical conceptual message and that the differences in those elements (namely the addition of the letter 'K' at the end of the earlier marks) are likely to be mistakenly recalled or misremembered as each other. The additional device and wording in the contested marks are likely to be seen simply as an alternative mark being used by the same undertaking. Therefore, when considering the contested mark, and taking account of the common element in the context of the mark as a whole, the consumer is likely to conclude that it is another brand of the owner of the earlier mark. As a result of this, I find a likelihood of indirect confusion.

The '828 Mark

85. Both the '828 marks and the earlier marks are word only marks, the first word of which will be pronounced identically, and I have found to be conceptually identical. The difference in spelling between CENTRICK / CENTRIC is likely to be mistakenly recalled or misremembered, particularly as consumers will focus on the beginning of the marks as per *El Cortes Ingles*. The contested marks include the words FACILITIES MANAGEMENT, which will be a point of difference between the marks, however, as this is descriptive of the services on offer, the words have little trade mark significance. Taking into account the principles of imperfect recollection and the fact that consumers rarely have the opportunity to compare marks side by side, I consider that there exists a likelihood of direct confusion. If I am wrong about that, I will move on to consider whether there is a likelihood of indirect confusion.

86. If the average consumer does note the addition of the descriptive phrase FACILITIES MANAGEMENT, I consider that they will believe these differences in the marks to be an alternative mark of CENTRICK / CENTRIC for the reasons set out above. Therefore, I find that there is also a likelihood of indirect confusion in respect of the '828 marks.

FINAL REMARKS

87. The opposition is partially successful. Therefore, subject to appeal, the application will be refused in relation to the following services:

Class 37 Air conditioning apparatus cleaning services; Advisory services relating to the maintenance and repair of mechanical and electrical equipment; Building services; Building consultancy services; Building cleaning services; Consultancy services relating to the repair of buildings; Advisory services relating to the installation of building automation equipment; Interior and exterior cleaning of buildings; Providing information relating to building cleaning; Facilities management; Building construction and repair; Providing information relating to the construction, repair and maintenance of buildings; none of the aforesaid in relation to the management, control, optimisation or efficiency of energy and energy consumption

In light of my earlier findings the application will proceed to registration in relation to the following services:

Class 37 Servicing and repair of mechanical access platforms;

COSTS

88. The opponent has on the whole been successful, although not entirely, and is entitled to a contribution towards their costs in line with Tribunal Practice Note 1/2023. In the circumstances I award the opponent the sum of £1150.00 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Filing two Notices of Opposition and considering the applicant's counter statements	£350

Preparing evidence and considering the applicant's evidence	£600
Official fee (x2)	£200
Total:	**£1150.00**

89. I therefore order Engex Ltd to pay Centrick Limited the sum of £1150.00. The above sum should 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.

Dated this 19th day of November 2025

LA Bailey

For the Registrar