

BL O/1138/24

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION No. 3771907  
BY HABITAS GROUP LTD  
TO REGISTER THE TRADE MARK:

**CARAVAN**

**BY HABITAS**

IN CLASSES 41 and 43

-AND-

THE OPPOSITION THERETO UNDER No. 436349  
BY CARAVAN TOURS, INC.

## **Background and pleadings**

1. On 30 March 2022, Habitas Group Ltd (“**the Applicant**”) applied to register the figurative mark shown on the cover page of this decision in the UK, claiming a priority date of 3 October 2021 from its trade marks applied for in Saudi Arabia, trade mark numbers 1443007435 and 1443007436. The application was accepted and published for opposition purposes in the Trade Marks Journal on 17 June 2022. Registration is sought for the following services:<sup>1</sup>

### **Class 41**

*Entertainment; sporting activities; Entertainment services, namely, planning, organizing, producing and conducting community festivals featuring a variety of activities, namely, live music, art displays, and participatory games; organizing and arranging exhibitions for entertainment purposes, including live music and art exhibitions; organizing and conducting educational workshops in the fields of wellness and spiritual education, art, music, and yoga; organizing community festivals featuring a variety of activities, namely, live music, art displays, and participatory games.*

### **Class 43**


*Temporary accommodation, namely, booking and reservation services for temporary accommodation; temporary accommodation services, namely, hotel booking and reservation services.*

2. On 20 September 2022, Caravan Tours, Inc. (“**the Opponent**”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opposition is directed at all of the applied-for services.

3. The Opponent relies on its UK trade mark registration for the figurative mark ‘CARAVAN’, and its international trade mark registration for the word-only mark ‘CARAVAN’, details of which are set out below:

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<sup>1</sup> As amended in accordance with the Applicant’s Forms TM21B ‘Change of details to an application’, which were filed by the Applicant on 30 June 2023 and 11 July 2023.

<b>Mark 1</b>	
<b>Representation of the mark:</b>	
<b>UK trade mark registration No.:</b>	3668174
<b>UK Filing date:</b>	13 July 2021
<b>Retained EU filing date pursuant to Article 59 of the Withdrawal Agreement:<sup>2</sup></b>	12 February 2020
<b>Registration Date:</b>	25 February 2022
<b>Classes:</b>	39 and 41

<b>Mark 2</b>	
<b>Representation of the mark:</b>	CARAVAN
<b>IR trade mark registration No.:</b>	1274940
<b>UK designation date:</b>	31 March 2017
<b>Date protection conferred in UK:</b>	16 August 2018
<b>Classes:</b>	39 and 41

4. The Opponent relies on all the services for which its marks are registered. Its Class 39 services include a variety of services for arranging and organizing travel, including arranging travel documentation and travel tour operating; and its Class 41 services include the provision and publication of online travel guides, conducting of guided educational tours and the provision of information online about entertainment events. The Opponent's services are set out in full at paragraph 21 of this decision.

5. By virtue of their earlier filing dates, the trade marks upon which the Opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As they had not been registered for more than five years at the filing date of the contested application, they are not subject to the use conditions set out in section 6A of the Act. As such, the Opponent may rely on all the services for which its trade marks are registered, without having to show any use at all.

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<sup>2</sup> The application for registration of this trade mark was filed pursuant to Article 59 of the 'Withdrawal Agreement' between the UK and the EU i.e. the Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (2019/C 384 I/01). Therefore it retains its original EU filing date.

6. The Opponent claims that the Applicant's mark "*is closely similar to the Opponent's Earlier Marks as it wholly encompasses the dominant and distinctive word CARAVAN*",<sup>3</sup> and that the respective services are identical, closely similar and complementary, thus giving rise to a likelihood of confusion.

7. The Applicant filed a defence and counterstatement denying the claims made.

8. Both the Opponent and Applicant filed evidence. Neither party elected to file submissions during the evidence rounds, nor requested a hearing, however, the opponent filed written submissions in lieu of a hearing.<sup>4</sup> This decision is therefore taken following a careful consideration of the papers before me.

9. The Opponent is represented by Stobbs. The Applicant is represented by Bristows LLP.

## **EVIDENCE**

10. The Opponent's evidence is provided in the Witness Statement of Mr Andrew Carver dated 20 September 2023, with six exhibits, labelled AC1 to AC6. Mr Carver is a Chartered Trade Mark Attorney and IA Manager at the Opponent's representative firm.

11. His Witness Statement solely lists the content of each of the accompanying exhibits, which are definitions of various terms, including "festival", "community" and "Social Entertainment"; as well as screenshots obtained from a variety of third party websites in relation to: (1) the provision of community festivals and sports festivals; (2) ticket sales for events available directly from stadiums and venues as well as from ticket brokers; (3) holiday providers detailing activities available to their guests at their hotels and resorts; (4) details of UK tourist attractions providing educational workshops and tours, as well as brokers selling tickets for a range of educational tours and

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<sup>3</sup> Opponent's Form TM7 'Statement of Grounds', paragraph 4.

<sup>4</sup> I note that the Opponent's submissions in lieu are not paginated and the paragraphs are not numbered either, making the task of accurately referencing their submissions somewhat problematic. The submissions consist of 19 pages in total, therefore, taking these pages in the order in which they were submitted, I have attributed them numbers for ease of reference. Therefore throughout this decision, where I have referenced these submissions, the page numbering is my numbering, based on the sequential order of those pages as they have been filed and presented to me.

workshops; and (5) travel or holiday tour providers offering booking of hotels/ temporary accommodation as part of their services.<sup>5</sup>

12. The Applicant's evidence is provided in two witness statements as follows:

(1) The Witness Statement of Mr Oliver Ripley dated 19 November 2023, with two exhibits labelled Exhibit 1 and Exhibit 2.

(a) Mr Ripley is a director of Habitas Group Limited, a position he has held since 27 October 2021. His evidence (which includes two articles written about the Applicant – Exhibit 1) provides background information about the Applicant, who is stated to be an *“eco-hospitality service provider”*, offering *“luxury accommodation services in a number of countries around the world”*. In his Witness Statement Mr Ripley states that the accommodation provided by the Applicant includes *“hotels, luxury caravans and tented accommodation”*, and that the type of accommodation is dictated by the location and geography of where it is situated.

(b) In particular, he states that the Applicant is using its 'CARAVAN by Habitas' brand *“in respect of [...] luxury caravan[s] and tented”* accommodation. Exhibit 2 shows two such destinations are located in deserts, namely the AIUla desert in Saudi Arabia – images show that the accommodation at this site consists of touring caravans; and the Agafay desert in Morocco – the evidence shows images of tented accommodation at this site. Both destinations are described in the evidence as *“an immersive glamping experience.”*<sup>6</sup> Below are images taken from this evidence showing how the Applicant is using its 'brand' in relation to these locations:<sup>7</sup>

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<sup>5</sup> See the Witness Statement of Andrew Carver dated 20 September 2023, paragraphs 3 to 8.

<sup>6</sup> 'Glamping' is a coined word referring to 'glamorous camping'. It is defined in the Oxford English Dictionary as *“a form of camping that involves accommodation and facilities more luxurious than those associated with traditional camping.”*

<sup>7</sup> Image (3) was poorly reproduced in the evidence, however, it is just about discernible that the words in the bottom left are 'BY HABITAS'.

(1)



(2)



(3)



(c) Evidence which consists of screenshots of the Applicant's website provides the following information:<sup>8</sup>

"[At the 'Agafay' location] We offer unique and exciting adventure activities to explore the local landscape, connect with our natural world and experience the moon-like desert in an unexpected and immersive way. Journey across rocky dunes on camelback or join our e-Bike experience through a nearby eucalyptus forest with a desert survival skills workshop".

[...]

"The heart of our Habitas experience lies in the immersion into our world and the extraordinary places we call home. Alongside our private activities available for booking, we offer our guests a complimentary daily programming schedule centred around our six pillars: Art & Culture, Wellness, Adventure, Learning, Food & Beverage and Music."

(2) The witness statement of Ms Jennifer Noel dated 17 November 2023. Ms Noel is a Chartered Trade Mark Attorney at the Applicant's representative firm. Ms Noel makes no statement as to the purpose of her evidence and merely provides a brief description of the contents of the two accompanying exhibits, labelled JN1 and JN2. The exhibits consist of the following:

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<sup>8</sup> Exhibit 2.

(a) Exhibit JN1 consists of screenshots showing results of online searches conducted via the 'Google' internet search engine for the terms 'caravan uk' and 'caravan festival uk'. For example, one of the 'Google' search hits is titled "*Top 5 UK festivals to take your caravan to*"<sup>9</sup>).

(b) Exhibit JN2 contains screenshots from UK-based third party websites all relating to caravan holidays, caravan parks and caravan travel. It also contains information about festivals in the UK with pitching space for families to take their caravans to stay onsite and details of a business offering caravan hire for people wanting to take caravans to festivals as an alternative to camping.

13. I have taken all of the parties' evidence into account and shall refer to it to the extent that is necessary throughout this decision.

## **DECISION**

### **Legislation and Case Law**

14. Section 5(2)(b) and 5A the Act are 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

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<sup>9</sup> Exhibit JN1, page 6.

mark is applied for, the application is to be refused in relation to those goods and services only.”<sup>10</sup>

15. 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.

16. I am guided by the following principles which are 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;

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<sup>10</sup> Although where an opposition is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner’s business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused for the broad term(s) caught by the ground(s) for refusal. See Tribunal Practice Note 1/2012.

- (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. In *Gérard Meric v Office for Harmonisation in the Internal Market*,<sup>11</sup> (“**Meric**”), the General Court held to the effect that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

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<sup>11</sup> Case T- 133/05

designated by the trade mark application and vice versa (this principle equally applies to services).

18. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. Those factors include, inter alia:<sup>12</sup>

- (1) the physical nature of the goods or acts of service;
- (2) their intended purpose;
- (3) their method of use / uses;
- (4) who the users of the goods and services are;
- (5) the trade channels through which the goods and services reach the market;
- (6) in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
- (7) whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors);  
or
- (8) whether they are complementary to each other.

19. 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 that the responsibility for those goods lies with the same undertaking”*.<sup>13</sup> Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.<sup>14</sup>

20. When interpreting the terms in a specification I bear in mind:

- (1) that it is *“necessary to focus on the core of what is described [... and that] trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise”*, although *“where words or phrases in their ordinary and natural meaning are apt to cover the category*

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<sup>12</sup> See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case

<sup>13</sup> *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

<sup>14</sup> *Kurt Hesse v OHIM*, Case C-50/15 P

*of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods [and services] in question”;*<sup>15</sup>

(2) where *“the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services”;*<sup>16</sup>

(3) the following applicable principles of interpretation:

*“(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.*

*(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.*

*(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.*

*(4) A term which cannot be interpreted is to be disregarded.”*<sup>17</sup>

21. The services to be compared are shown in the tables below. I note that the Opponent’s Mark 1 specification, for the most part relates specifically to *“travel by foot aeroplane and boat”*. Whilst only some of the terms in its Mark 1 specification are subject to the limitation *“not relating to mobile homes, motor homes, recreational vehicles or caravans”*, all of its Mark 2 specification is subject to that limitation. I have emphasised the limitations in the tables below for ease of reference.

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<sup>15</sup> *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

<sup>16</sup> *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), paragraph 94

<sup>17</sup> See *Sky v Skykick* [2020] EWHC 990 (Ch), paragraph 56 (wherein Lord Justice Arnold, in the course of his judgment, set out a summary of the correct approach to interpreting broad and/or vague terms).

## OPPONENT'S SPECIFICATION

### Mark 1

<b>Class 39:</b>	<p>Booking of holiday travel and tours for travel by <u>foot, aeroplane and boat</u>; package holiday services for arranging travel by <u>foot, aeroplane and boat</u>; travel agency services for arranging holiday travel by <u>foot, aeroplane and boat</u>; tour reservation services for travel <u>foot, aeroplane and boat</u>; personal tour guide services via <u>foot, aeroplane and boat</u>; provision of tourist travel information for travel by <u>foot, aeroplane and boat</u>; sightseeing, tour guide and excursion services via <u>foot, aeroplane and boat</u>; arranging and booking of excursions, day trips and sightseeing tours via <u>foot, aeroplane and boat</u>; coordinating travel arrangements for individuals and for groups for travel by <u>foot, aeroplane and boat</u>; route and itinerary planning services for travel by <u>foot, aeroplane and boat</u>; trip planning services for travel by <u>foot, aeroplane and boat</u>; computerised distribution planning relating to transportation by <u>foot, aeroplane and boat</u>; providing information relating to the planning and booking of travel and transport by <u>foot, aeroplane and boat</u>, via electronic means; arranging travel tours by <u>foot, aeroplane and boat</u>; providing information relating to travel in the field of travel tours by <u>foot, aeroplane and boat</u> via a web site; providing information on travel planning in relation to travel tours by <u>foot, aeroplane and boat</u> via a web site; travel guide services by <u>foot, aeroplane and boat</u>; travel information services in relation to travel tours by <u>foot, aeroplane and boat</u>; travel route planning in relation to travel tours by <u>foot, aeroplane and boat</u>; travel tour conducting by <u>foot, aeroplane and boat</u>; travel tour guide services by <u>foot, aeroplane and boat</u>; travel tour operating by <u>foot, aeroplane and boat</u>; travel tour organizing by <u>foot, aeroplane and boat</u>; personally escorted travel tours by <u>foot, aeroplane and boat</u>; travel consultancy, organization, reservation, courier and arrangement for travel by <u>foot, aeroplane and boat</u>; <b>arranging for travel visas, passports and travel documents for persons traveling abroad, <u>not relating to mobile homes, motor homes, recreational vehicles or caravans</u></b>; information, advisory and consultancy services relating to the aforesaid.</p>
<b>Class 41:</b>	<p>Providing non-downloadable online articles, photographs, and videos in the field of travel, vacations and leisure activities by <u>foot, aeroplane and boat</u> via a web site; publication of online guides, travel maps, city directories and listings for use by travellers by <u>foot, aeroplane and boat</u>, not downloadable; arranging and conducting of education courses relating to the travel industry, being travel by <u>foot, aeroplane and boat</u>; conducting guided tours via <u>foot, aeroplane and boat</u>; conducting and arranging of guided educational tours via <u>foot, aeroplane and boat</u>; publication of directories relating to tourism in relation to travel by <u>foot, aeroplane and boat</u>; conducting guided tours</p>

	of cultural sites for educational purposes via <u>foot, aeroplane and boat</u> ; providing online electronic publications in relation to travel by <u>foot, aeroplane and boat</u> ; publication of online reviews in the field of entertainment, <b><u>not relating to mobile homes, motor homes, recreational vehicles or caravans</u></b> ; information about entertainment and entertainment events provided via online networks and the Internet, <b><u>not relating to mobile homes, motor homes, recreational vehicles or caravans</u></b> ; entertainment services in the nature of organizing and arranging social entertainment events, <b><u>not relating to mobile homes, motor homes, recreational vehicles or caravans</u></b> ; information, advisory and consultancy services relating to the aforesaid.
<b><u>Mark 2</u></b>	
<b>Class 39:</b>	Arranging for travel visas, passports and travel documents for persons traveling abroad; arranging travel tours; providing information relating to travel via a web site; travel guide services; travel information services; travel route planning; travel tour conducting; travel tour guide services; travel tour operating; travel tour organizing; providing information on travel planning via a web site; personally escorted travel tours; <b><u>but not including travel, holiday or information services relating to mobile homes, motor homes, recreational vehicles or caravans.</u></b>
<b>Class 41:</b>	Providing non-downloadable online articles, photographs, and videos in the field of travel, vacations and leisure activities via a web site; <b><u>but not including any of the aforesaid services relating to mobile homes, motor homes, recreational vehicles or caravans.</u></b>

<b>APPLICANT'S SPECIFICATION</b>	
<b>Class 41:</b>	Entertainment; sporting activities; Entertainment services, namely, planning, organizing, producing and conducting community festivals featuring a variety of activities, namely, live music, art displays, and participatory games; organizing and arranging exhibitions for entertainment purposes, including live music and art exhibitions; organizing and conducting educational workshops in the fields of wellness and spiritual education, art, music, and yoga; organizing community festivals featuring a variety of activities, namely, live music, art displays, and participatory games.
<b>Class 43:</b>	Temporary accommodation, namely, booking and reservation services for temporary accommodation; temporary accommodation services, namely, hotel booking and reservation services.

22. In interpreting the parties' specifications I bear in mind the following explanatory notes of the Nice Classification system:

- Class 39 includes services for the transport of people, from one place to another by rail, road, water or air and services necessarily connected with such transport.
- Class 41 includes mainly services consisting of all forms of education or training, services having the basic aim of the entertainment, amusement or recreation of people, as well as the presentation of works of visual art or literature to the public for cultural or educational purposes.
- Class 43 includes services for providing temporary accommodation.

23. I also note that section 60A(1)(a) of the Act provides that goods and services are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, nor dissimilar to each other on the ground that they appear in different classes under the Nice Classification.

24. For the purposes of making the comparison, I have grouped the Applicant's services together below where the same reasoning applies.<sup>18</sup>

### **Class 41**

#### **Entertainment, amusement and recreation**

25. The Opponent's Mark 1 specification contains the following Class 41 services:

*Entertainment services in the nature of organizing and arranging social entertainment events, not relating to mobile homes, motor homes, recreational vehicles or caravans.*

26. The Opponent submits that the restriction at the end of the Opponent's term does not alter the scope of protection of the service in a way in which stops the respective terms from being identical or similar. I agree.

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<sup>18</sup> See *Separode Trade Mark* BL O/399/10, paragraph 5, with regard to grouping goods and services together.

27. I have compared the Opponent's entertainment services detailed above with the following services contained in the Applicant's Class 41 specification:

(1) Entertainment

The Opponent's service falls within the Applicant's broader services. These are therefore **identical** on the principle outlined in *Meric*.

(2) Entertainment services, namely, planning, organizing, producing and conducting community festivals featuring a variety of activities, namely, live music, art displays, and participatory games; organizing community festivals featuring a variety of activities, namely, live music, art displays, and participatory games.

(a) The Opponent's term relates to entertainment services in the form of organizing and arranging social entertainment events. Having regard to the submissions and evidence provided by the Opponent, I find that a social entertainment event (i.e. a form of entertainment that involves attending public venues)<sup>19</sup> is a broad term that would encompass the Applicant's community festivals (i.e. a program of entertainment events attended by a group of individuals),<sup>20</sup> on the basis that they have the same basic aim in common, which is of providing entertainment, amusement or recreation to a socially gathered group of people with common interests.

(b) The Applicant's services specifically relate to the planning, organizing, producing and conducting of such festivals. I therefore find that the Applicant's services for "*organizing*" and "*planning*" such events are **identical** (on the principle outlined in *Meric*) to the Opponent's "*organizing*" and "*arranging*" of social entertainment events.

(c) With regard to the Applicant's "*producing and conducting*" of such events, I find that they are similar to the Opponent's services on the basis that they share the same purpose and nature, they would also share the same user and trade channels. In addition, the Applicant's services of "*producing and*

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<sup>19</sup> See the Opponent's submissions in lieu dated 7 February 2024 [page 14], and related Exhibits AC1 and AC2 of the Witness Statement of Andrew Carver.

<sup>20</sup> Ibid.

*conducting*” are complementary to the Opponent’s *“organizing and arranging”* in such a way that the consumer of those services would believe that they come from the same undertaking. I therefore find that the respective services are similar to a **high degree**.

(3) *Organizing and arranging exhibitions for entertainment purposes, including live music and art exhibitions*

Although the Applicant’s services relate to *“exhibitions”* (an exhibition being a public showing of something) they are nonetheless qualified by the wording *“for entertainment purposes”*. As such, they are services for the organizing and arranging of events with the basic aim of providing entertainment, amusement or recreation to people. Therefore in light of my above conclusions, I find that these services are **identical** to the Opponent’s services on the principle outlined in *Meric*. **In the alternative** they are **highly similar** as they have the same purpose and nature, they would share the same users and would share the same trade channels. They could also likely be in competition with each other and complementary to each other.

(4) *Sporting activities*

(a) An entertainment service does not necessarily have to be some form of musical or theatrical show in order for it to be a form of entertainment. As long as it has the basic aim of providing entertainment, amusement or recreation of people, then that entertainment can take many forms. *“Sporting activities”* is an inherently broad term, and whilst a participant of those activities (i.e. a player, as opposed to a spectator) may choose those activities because they could also have the added benefit of improving their health and fitness (although not all sporting activities would necessarily have this added benefit e.g. shooting), the sporting activities nevertheless have the basic aim of providing entertainment, amusement or recreation to people, whether those people are participating in such sports or merely spectating. Indeed, sporting activities are by their very nature a form of recreational activity (particularly when considering that people participate

in sporting activities as a hobby or pastime)<sup>21</sup> as well as a form of entertainment and amusement (particularly when considering that people attend sporting events as spectators for entertainment purposes).

(b) As the term “*sporting activities*” is a broad term it can encompass the provision of those activities to groups of people, whether it be team sports, such as social clubs providing sporting activities in the nature of football, netball etc.; or individual sports such as social clubs providing sporting activities in the form of tennis, golf etc. The provider also need not necessarily be limited to sports-related social clubs, but could, as the Opponent has pointed out for example,<sup>22</sup> be holiday/tour operators providing those activities as forms of entertainment to their guests, such as volleyball games/tournaments – see examples below taken from the Opponent’s evidence of activities provided by third party hotels/tour operators:<sup>23</sup>



(c) The broad nature of the applied-for term is such that it would also encompass the organizing and arranging of sporting activities. For example, a golf club or tennis club (who is the service provider) could organize and arrange tournaments (i.e. sporting activities) for its members to take part in; a football club would arrange a football match (a sporting activity) for its fans to attend and watch; and a package holiday provider could organise volleyball games/tournaments for its guests.

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<sup>21</sup> ‘Recreation’ is defined by the Oxford English Dictionary as “*the action or fact of refreshing or entertaining oneself through a pleasurable or interesting pastime, amusement, activity, etc. (esp. habitually); amusement, entertainment.*”

<sup>22</sup> See the Opponent’s submissions in lieu dated 7 February 2024, [pages 14 – 15].

<sup>23</sup> See the Opponent’s evidence, Exhibit AC4, page 54.

(d) Taking all the foregoing into account, I consider the applied-for term to be similar to the Opponent's, on the basis that they may overlap in purpose and nature, since the sporting activities encompass the provision of sporting events (such as tournaments) which are services for the provision of entertainment, amusement and recreation, to a socially gathered group of people with a common interest; the applied-for term is also a broad term that would encompass the organizing and arranging of such activities/events. Consequently, I consider the services may overlap in user. They may share the same trade channels since an entertainment service provider may also organize and arrange social entertainment events in the form of sporting activities. It is possible that they could also be in competition with each other. These services are similar to at least a **medium degree**.

### Education

28. The Applicant has applied for the following term:

*“organizing and conducting educational workshops in the fields of wellness and spiritual education, art, music, and yoga”*

29. The Opponent's Mark 1 Class 41 specification contains the following services:

*“conducting and arranging of guided educational tours via foot, aeroplane and boat”.*

30. In reference to its evidence, the Opponent makes the following observations and submits (inter alia) that the above services would originate from the same undertaking:<sup>24</sup>

“Exhibit AC5, [shows that] numerous famous landmarks / places of interest (such as the Royal Albert Hall, the Manchester Art Gallery, the Houses of Parliament) typically provide educational tours and workshops (relating to their field of interest) alongside one another. In addition, as at pages 89 – 92 of

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<sup>24</sup> See the Opponent's submissions in lieu dated 7 February 2024 [pages 15 – 16].

Exhibit AC5, consumers can search and buy tickets for educational tours and / or workshops via the same trade channels – such as at Eventbrite.”

31. I agree that the Opponent’s evidence does indeed show this, therefore it is possible that the above services could originate from the same undertaking. Furthermore, I note that the Applicant’s evidence supports a conclusion that educational workshops can be provided by a temporary accommodation provider, when taking into account that the Applicant’s website states that it offers survival skills workshops and that it provides regular programming for its guests centred around inter alia, “*learning*”.

32. Albeit on the one hand the Opponent’s services are for conducting and arranging guided educational tours, and on the other hand the Applicant’s services are for organizing and conducting educational workshops, I find that the competing terms are similar on the basis that they both share the same purpose i.e. they are both for the organizing / arranging and conducting of activities intended to educate the participant. They may also share the same user who may be, for example, a holidaymaker; and they may also share the same trade channels, since a holidaymaker may book a guided educational tour of the place they are staying in through the same undertaking that also organizes and conducts other activities for tourists, such as various educational workshops. The services are also likely to be in competition with each other as the user may select one above the other. That said, the services are unlikely to be complementary as they are not indispensable or important to the use of each other. I find these services to be similar to a **medium degree**.

33. As a matter of completeness I note that whilst, given the Applicant’s evidence, the Applicant’s entertainment events / activities / workshops etc. may only be provided to its guests, that does not alter my above findings on identity and similarity when comparing the competing specifications on the basis of notional and fair use; and I note that in any event, even in those circumstances (where the services are provided to guests) the services are still nonetheless provided to the general public, albeit as part of a holiday package.

## **Class 43**

Temporary accommodation, **namely**, booking and reservation services for temporary accommodation; temporary accommodation services, **namely**, hotel booking and reservation services.

34. Although the above applied-for services are under the general scope of ‘temporary accommodation’, the use of the word ‘**namely**’ has the effect of limiting those services to solely booking and reservation of hotels/ temporary accommodation. Therefore the services are not for the actual provision of temporary accommodation.

35. In its submissions, the Opponent has compared these applied-for services with terms in its Class 39 specifications. The terms which the Opponent identifies as comparators are set out below (my underlining for ease of reference) and I agree that these are appropriate comparators:

### **Mark 1**

Booking of holiday travel and tours for travel by foot, aeroplane and boat; package holiday services for arranging travel by foot, aeroplane and boat; travel agency services for arranging holiday travel by foot, aeroplane and boat; tour reservation services for travel foot, aeroplane and boat; travel route planning in relation to travel tours by foot, aeroplane and boat; travel tour conducting by foot, aeroplane and boat; travel tour operating by foot, aeroplane and boat; travel tour organizing by foot, aeroplane and boat.

### **Mark 2**

Arranging travel tours; travel route planning; travel tour conducting; travel tour operating; travel tour organizing; *but not including travel, holiday or information services relating to mobile homes, motor homes, recreational vehicles or caravans.*

36. Firstly, I address the Opponent’s terms which I have underlined above. Those services are, in essence, services for booking and arranging travel, and the Applicant’s are services for booking accommodation, therefore the purpose and nature of those

services is different since a consumer would not use the services to book a flight if what they wanted was to book a hotel room for example.

37. However, I consider that the respective services are complementary on the basis that a consumer, after having booked their travel, is also likely to require the services of booking accommodation in the place they are travelling to, therefore the services are important to each other in such a way that the consumer may believe that they are offered by the same undertaking (such as a travel agency or tour operator). It therefore follows that the respective services would share the same user and also share the same trade channels. Therefore, notwithstanding that Class 39 of the Nice Classification system does not include the reservation of hotel rooms or other temporary accommodation,<sup>25</sup> this does not prevent a finding of similarity between the respective services (bearing in mind the provisions of section 60A(1)(a) of the Act). I therefore consider the respective services to be similar to a **medium degree**.

38. The remaining terms are the Opponent's services for 'travel tour conducting' and 'travel tour operating'. As a consumer of these services myself, I am aware that the services provider can own their own airlines, ocean liners etc. and that often a consumer is able to book their travel with the provider directly, rather than via an agent/broker.

39. I am also aware (again as a consumer of these services myself) that travel tour operators/ conductors not only own their own modes of transportation e.g. their own airlines etc., but they can also own their own hotels, campsites etc. and again, a consumer is able to book their accommodation directly with the provider (as is shown in the Applicant's evidence, its customers can book accommodation directly with them),<sup>26</sup> all as part of a package holiday.

40. Whilst the Opponent's services fall under Class 39 and therefore indicate that they relate to travel rather than accommodation, the competing services are nonetheless clearly found in the same market and are rather intertwined, and the fact that those respective services are often available from the same provider is only likely to facilitate the perception by the relevant consumer of the close connections between them, and

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<sup>25</sup> See the Explanatory Note for Class 39 of the Nice Classification system which states that 'reservation of hotel rooms or other temporary accommodation by travel agents or brokers' is not included in that class.

<sup>26</sup> See Mr Ripley's evidence – Exhibit 2, page 22.

support the impression that the same undertaking is responsible for the provision of those services. Therefore I find there to be similarity between the respective services on the basis of complementarity, and because they would also share the same user and would share the same trade channels. These services are similar to a **medium degree**.

#### Conclusions in relation to the comparison of the services

41. I have found that the applied-for terms are either identical or similar to the Opponent's terms and that, where I have found similarity, that degree of similarity is either high or medium.

42. For the most part, the identity/similarity lies with the services contained in the Opponent's Mark 1 specification. Whilst I have also found that some terms contained in the Mark 2 specification are similar to the applied-for terms, those terms have the same counterparts in the Mark 1 specification.

#### Approach

43. In light of my findings, reliance solely on Mark 2 could only ever lead to partial success since only some of the applied-for services are similar to the Mark 2 specification. Equally, reliance on both marks would not put the Opponent in a better position since the Mark 2 services for which similarity has been found have counterparts in the Mark 1 specification where the same finding of similarity has also been made. Therefore, additional reliance on the Mark 2 terms would not put the Opponent in a better position than if it relied solely on the terms contained in its Mark 1 specification.

44. Although I take into account that Mark 2 is a word-only mark and therefore its protection is not limited by any features such as typeface or capitalisation appearing on the Register, whereas the stylisation of Mark 1 forms part of its protection, I nonetheless consider Mark 1 to represent the Opponent's best case. This is because, in the event of a finding of likelihood of confusion, reliance on Mark 1 would lead to the opposition being successful in its entirety since all of the applied-for services are either identical or similar to the Mark 1 specification. I shall only return to considering Mark 2 if necessary.

## **The average consumer and the nature of the purchasing act**

45. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the services in question. It is therefore necessary to determine who the average consumer of the respective services is, and how the consumer is likely to select them.

46. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word “average” merely denotes that the person is typical,<sup>27</sup> which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.<sup>28</sup>

47. The average consumer of the respective services will either be a member of the general public or they will be professional users. The services will be selected either online, from brochures, over the phone, or even through word-of-mouth recommendations, therefore visual and aural considerations will both apply, although I consider the services will be predominantly selected visually following perusal of brochures and websites, whereby the consumer will be presented with an image of the respective marks.

48. Irrespective of whether they are members of the public or professional users, the average consumer will want to make sure that the services suit their needs and requirements. I therefore consider the average consumer will pay a medium degree of attention when selecting the services at hand.

## **Comparison of marks**

49. I have already set out the principles gleaned from established case law with regard to comparing competing marks. I also note that the Court of Justice of the European Union stated in *Bimbo SA v OHIM*,<sup>29</sup> 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

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<sup>27</sup> *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), paragraph 60



<sup>28</sup> *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

<sup>29</sup> Case C-591/12P, at paragraph 34.

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.”

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

51. The marks being compared are shown below:

Earlier mark – Mark 1	Contested mark
	

The ‘CARAVAN’ element

52. Clearly the competing marks coincide with regard to the word ‘CARAVAN’. The meaning of that word is not in dispute between the parties. ‘CARAVAN’ is an ordinary English word used to describe a mobile home/ recreational vehicle used as temporary accommodation, often as holiday accommodation. Before I proceed with a detailed comparison of the marks, and before I assess the distinctive character of the earlier mark, I note the Opponent’s submissions in relation to the Applicant’s evidence.

53. The Applicant adduced evidence in relation to how it is using its sign, and evidence showing the word ‘caravan’ being used by third parties within the ordinary meaning of the word i.e. to refer to a ‘caravan’. However, the Applicant did not provide any legal arguments to accompany its evidence and, in particular, Ms Noel did not state in her Witness Statement the purpose of her evidence. Therefore, the lack of legal arguments and explanation led to the Opponent making the following assumption as to the purpose of Ms Noel’s evidence, and provide submissions based on such assumption:

“We assume that this evidence has been submitted in an attempt to argue the point that the word ‘CARAVAN’ is frequently used in the UK marketplace to refer to caravans (or services relating thereto), such that upon seeing the applied for mark a consumer would see ‘CARAVAN’ as denoting caravans in some way – and therefore that it is not distinctive in the mark.”<sup>30</sup>

54. Critically, if the Applicant had a point to make by filing its evidence, it should have made that point by also filing submissions. Instead it left its case up to suppositions and assumptions. Nevertheless, I have the Opponent’s detailed submissions on the Applicant’s evidence, which I have taken into consideration. It appears that the Opponent’s submissions are based on an assumption that if, (through the filing of evidence) it could be shown that an element of the applied-for mark is descriptive and/or non-distinctive (irrespective of any finding that that same element could be found to be distinctive in the earlier mark), then the relevant consumer would not see that common element as denoting trade origin in the later mark, thus (presumably) the consumer would have to look at other elements within the applied-for mark to denote trade origin and would not rely on the ‘CARAVAN’ element which it has in common with the earlier mark. Ultimately the Opponent’s position is that the Applicant’s evidence does not support a finding that *“consumers would see ‘CARAVAN’ in the applied-for mark as being descriptive or non-distinctive in respect of the services applied for”*.<sup>31</sup>

55. The Opponent submits that, notwithstanding Mr Ripley’s evidence in relation to the Applicant’s actual business activities, showing that *“the Applicant offers luxury caravan and tented destinations, and [related] examples thereto”*,<sup>32</sup> an assessment must be based on notional and fair use of the mark, and that the applied-for services *“do not specifically relate to caravans and/or have no clear relationship to caravans, such that ‘CARAVAN’ is not used descriptively in the [applied-for] mark, and is therefore distinctive”*.<sup>33</sup>

56. The Applicant’s mark does not consist solely of the word ‘CARAVAN’ and it appears that the Applicant’s evidence has indeed been presented to downplay the

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<sup>30</sup> See the Opponent’s submissions in lieu dated 7 February 2024, [page 7].

<sup>31</sup> Ibid. [page 9].

<sup>32</sup> Ibid. [page 9].

<sup>33</sup> Ibid. [page 9].

significance of the common element between the marks, particularly when having regard to the general principle that descriptive and/or non-distinctive elements of a mark tend to be given less weight than distinctive features in assessments made under section 5 of the Act. However, that is only the general principle, and there is nothing to suggest that this is a hard rule, since such a situation does not preclude a finding of a likelihood of confusion *per se*, and all of the relevant factors must be assessed and that is how I intend to proceed. I shall return to this point later in my conclusions on likelihood of confusion. In any event, I note that even if an element of a mark is descriptive and/or non-distinctive, that does not of itself render it negligible or invisible,<sup>34</sup> and its presence within a mark should still nonetheless be considered when comparing competing marks.

57. Albeit Mr Ripley's evidence supports a finding that the applied-for Class 41 services could be offered to guests staying in a caravan, there is nothing in his evidence to suggest that the word 'CARAVAN' in the mark applied-for is being used to describe the applied-for Class 41 services and there is nothing in Ms Noel's evidence to suggest that either. Thus the word 'CARAVAN' cannot be said to be devoid of distinctive character in relation to the applied-for Class 41 services, if anything it is unusual in relation to those services.

58. With regard to the applied-for Class 43 services, the Opponent submits that whilst its primary position is that 'CARAVAN' does not describe those services, neither does it consider it to be non-distinctive of those services, it acknowledges that when taking into account their broad breadth, they could encompass booking and reservation services for caravans. That said, it submits that *"fundamentally, the assessment of likelihood of confusion must take into account notional use of the Applicant's mark at a level where direct competition between the parties could take place (i.e. hypothetically where the contested application is used in respect of applied for services which are similar to those which the Earlier Marks are registered [for]."*<sup>35</sup>

59. Consequently the Opponent maintains that the word 'CARAVAN' in the applied-for mark is distinctive even in relation to the applied-for Class 43 services when taking into account notional and fair use. I agree, on the basis that even though a notional sub-category of those services would extend to booking and reservation services for

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<sup>34</sup> *Purity Hemp Company Improving Life as Nature Intended*, Case BL O/115/22.

<sup>35</sup> *Ibid.* [page 9].

caravans, that is merely one sub-category of a broad term, and notional use must be considered in regard to the full breadth of the specification. To use the example provided by the Opponent in its submissions: if those applied-for Class 43 services relate to booking hotel accommodation, then caravan would have no meaning – indeed, I think this would be a rather unusual use of that word in such circumstances. It would also be unusual for example, in relation to booking tented accommodation since a tent is not a caravan. That said, when viewing that ordinary word within the broader ambit of the relevant market for those Class 43 services, the word does not possess inherently high distinctive qualities either.

60. One of the factors which must be considered in the global appreciation test is the distinctiveness of the earlier mark, this is because the more distinctive the earlier mark, the greater the likelihood of confusion may be<sup>36</sup> (I have addressed the distinctive character of the earlier mark in my paragraphs 77 to 84 below) and the starting point is that a registered trade mark must be assumed to have at least some distinctive character.<sup>37</sup> Whilst traders cannot monopolise merely descriptive words, therefore any trader would be free to use ‘caravan’ descriptively (including the parties themselves), that is not what is in issue here. It is my opinion that, notwithstanding that the earlier registration excludes services relating to caravans, the fact that there are instances where the Applicant, and indeed even the Opponent itself, could use the word caravan descriptively during the course of trade, certainly does not affect the scope of protection of the earlier right. Most significantly, it does not negate all the other instances in which both parties, within the scope of their specifications, could use that word distinctively to denote trade origin, especially when taking into account not only the full breadth of the registered specification, but also the full breadth of the applied-for specification. I shall also return to this point later in my conclusions on likelihood of confusion.

61. In conclusion, I shall proceed on the basis that I have nothing before me to suggest that the word ‘CARAVAN’ in the applied-for mark is a descriptive and/or non-distinctive element of the mark and should consequently be given less weight.

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<sup>36</sup> *Sabel BV v Puma AG*, Case C-251/95.

<sup>37</sup> See *Formula One Licensing BV v OHIM*, Case C-196/11P, paragraphs 41 - 44.

## Overall impression

62. The earlier mark is a figurative mark comprised of the word 'CARAVAN' in a relatively plain, lowercase, emboldened typeface. The word 'CARAVAN' is presented in blue and it is underlined in red. The stylisation and underlining is minimal and is subservient to the word itself, such that the overall impression of the mark is dominated by the actual word 'CARAVAN'.

63. The contested mark is also a figurative mark. It is comprised of the word 'CARAVAN' and the wording 'BY HABITAS' each displayed in two different, yet both relatively plain, uppercase black typefaces.

64. With regard to stylisation, whilst the typefaces are not distinctively remarkable, and add little, if anything, to the overall impression of the mark, it is the sizing and placement of the words making up the mark which contribute to its overall impression. This is because the word 'CARAVAN' is presented much larger relative to the words 'BY HABITAS', thus this feature visually emphasizes the word 'CARAVAN' within the mark. The word 'CARAVAN' therefore has a greater visual impact within the mark than the words 'BY HABITAS'. Furthermore, the word 'CARAVAN' sits above the words 'BY HABITAS' meaning that a consumer, reading in the conventional way (being left to right and top to bottom), would read the mark as 'CARAVAN BY HABITAS', with the word 'CARAVAN' being read first – as a general rule of thumb, the first parts of a mark normally carry a greater significance because the average consumer tends to focus its attention on the beginnings of a mark.<sup>38</sup>

65. I have already set out the submissions of the Opponent with regard to the assessment of the distinctiveness of the word 'CARAVAN' in the mark applied for. Following on from this, the Opponent also makes the following submissions about the overall impression of the mark:<sup>39</sup>

“[...] the “CARAVAN” element is the distinctive part of the contested mark, and the evidence submitted by the Applicant does not call this into question. In the event that the “CARAVAN” element is deemed to be of lower distinctiveness (which we deem unlikely in view of the discussions above), [...] the fact that the

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<sup>38</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraph 81

<sup>39</sup> *Ibid.* [pages 9 – 10].

similar element is more descriptive or non-distinctive, [...] is not on its own sufficient to conclude that such word is negligible in the overall impression of that mark in the mind of the consumer (T-194/09, *Líneas aéreas del Mediterráneo*, paragraph 30).”

66. Paragraph 30 of the above cited judgement of the General Court states that (my emphasis for clarity):

“In that regard, it should be noted that, although as a general rule the public will not consider a descriptive element forming part of a mark as the distinctive and dominant element in the overall impression produced by that mark, the fact remains that the low level of distinctiveness of an element of a mark does not necessarily mean, **when its size or its position in the sign are taken into account**, that that element is negligible in the overall impression produced by that mark.”

67. Given my earlier comments about the notional use of the word ‘CARAVAN’ in relation to the applied-for services, and taking all the foregoing into account, it is my opinion that the average consumer, whilst perceiving the contested mark as a whole, will also perceive that it consists of several components, and that it is the word ‘CARAVAN’ that plays a dominant role in the overall impression of the mark because of the way that word is sized and positioned relative to the other elements and because it is the first part of the mark. It is because of these foregoing factors that I also find that ‘CARAVAN’ has an independent distinctive role in the mark, and that its meaning is not qualified by the words ‘BY HABITAS’ (unlike the ‘BY HABITAS’ element which is qualified by the word ‘CARAVAN’ – i.e. the words ‘BY HABITAS’ suggest the meaning of a ‘CARAVAN’ ‘designed by’ and/or ‘provided by’ an undertaking called ‘HABITAS’. The word ‘CARAVAN’ therefore qualifies the ‘BY HABITAS’ element.)

#### Visual comparison

68. The marks coincide with the word ‘CARAVAN’ – it being a word which dominates the overall impression of both marks. The different typefaces used in the respective marks represent a point of visual difference, however, since both typefaces are relatively plain, this does not represent a notable point of difference, especially when

bearing in mind that it is the word 'CARAVAN' itself which would denote trade origin, as opposed to the particular typeface used to represent that word.

69. Albeit it is not appropriate to notionally apply complex colour arrangements to a mark applied for in black and white, fair and notional use of a black and white mark means that it should normally be considered on the basis that it could be used in any colour,<sup>40</sup> therefore the difference in colour between the competing marks is not a differentiating feature.

70. The words 'BY HABITAS' have no counterpart in the earlier mark, and therefore represent a point of visual dissimilarity. However, given my foregoing comments, whilst also bearing in mind the visual prominence of the word 'CARAVAN' relative to the words 'BY HABITAS', I find that the marks are, overall, visually similar to a medium degree.

#### Aural comparison

71. Aurally the marks coincide in the word 'CARAVAN', which would be pronounced identically in both marks i.e. 'CAH-RAH-VAN'. The contested mark would therefore be pronounced as 'CAH-RAH-VAN' 'BY' 'HAB-IH-TASS'. The words 'BY HABITAS' have no counterpart in the earlier mark and therefore represent a point of aural dissimilarity.

72. That said, bearing in mind that the first part of a mark is where a consumer tends to focus its attention, the fact that the aural identity lies at the beginning of the contested mark is notable. Overall the marks are aurally similar to a medium degree owing to the shared identical pronunciation of the word 'CARAVAN'.

#### Conceptual comparison

73. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>41</sup> The word 'CARAVAN' can either refer to a mobile home often used for temporary holiday accommodation, which can have wheels (i.e. a touring caravan), or not (i.e. a static caravan); or it can refer to a convoy of people who

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<sup>40</sup> Colour (as opposed to extraneous matter) is an implicit component of a trade mark registered/applied for in black and white - see the Court of Appeal decisions in: *Specsavers* [2014] EWCA Civ 1294, paragraph 5; and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47.

<sup>41</sup> This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R. I-643; [2006] E.T.M.R. 29.

travel together on foot or by vehicle, often in a long line or file, typically heading to the same destination,<sup>42</sup> for example migrant caravans.

74. I consider the average UK consumer (or a significant proportion thereof) of the services at hand is more likely to attribute the first definition to the word 'caravan' i.e. a mobile home. It is that concept that would be immediately grasped by the average consumer. Therefore both marks share the identical concept with regard to the word 'CARAVAN'.

75. I have already stated that the words 'BY HABITAS' suggest the meaning of 'designed by' and/or 'provided by' an undertaking called 'HABITAS'. I have no submissions before me with regard to the meaning of the word 'HABITAS', and whilst it does share a resemblance with the ordinary word 'habitat', from which the average consumer would derive a conceptual meaning, it may also be seen as an invented word and therefore would be conceptually neutral. Either way, it has no counterpart in the earlier mark.

76. Whether the 'CARAVAN' is 'BY HABITAS' or otherwise, the overriding concept portrayed by the contested mark is that of a 'caravan', especially when bearing in mind that the overall impression of the contested mark is dominated by that word. Therefore overall the marks are conceptually similar to at least a medium degree, owing to the shared identical concept of the word 'CARAVAN'.

### **Distinctive character of the earlier trade mark – Mark 1**

77. The degree of distinctiveness of the earlier mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion may be.<sup>43</sup>

78. The Opponent makes no claim to enhanced distinctiveness through the use made of the earlier mark, and has filed no evidence of use, therefore I only have the inherent distinctiveness of the mark to consider.

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<sup>42</sup> See the definition for 'caravan' contained in both the Oxford English Dictionary and the Collins English dictionary.

<sup>43</sup> *Sabel v Puma*.

79. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

80. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,<sup>44</sup> 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 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 [...] (see *Windsurfing Chiemsee*, paragraph 51).”

81. The earlier mark is a figurative mark which consists of the word ‘CARAVAN’ presented in a relatively plain, lowercase blue typeface, underlined in red. ‘CARAVAN’ is an ordinary English word used to describe a mobile home/ recreational vehicle used as temporary accommodation, often as holiday accommodation.

82. Although I am aware that, where the words used in a figurative mark are descriptive (and not distinctive), the distinctiveness of a mark may be attributed to the stylisation alone rather than the words themselves (*Nicoventures Holdings v The London Vape Company*)<sup>45</sup> I do not consider this to be the case here, this is because, when taking into account the limitations of the Opponent’s services (i.e. they are limited to travel by foot, aeroplane and boat; and/or they do not relate to mobile homes,

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<sup>44</sup> Case C-342/97.

<sup>45</sup> [2017] EWHC 3393 (Ch). In this case Birss J found that the stylisation made the two marks very different because he found that the distinctiveness of the competing marks was entirely in the stylisation rather than the words themselves.

motor homes, recreational vehicles or caravans), it is clear that the word 'CARAVAN' is neither suggestive nor allusive of the services for which the earlier mark is registered, indeed, it is somewhat unusual in relation to the registered services.

83. The distinctiveness of the mark therefore derives from the word 'CARAVAN' itself and the stylisation does not imbue the word with any greater distinctive character, this is because the stylisation is minimal and is subservient to the word 'CARAVAN'. However, when viewing that ordinary word within the ambit of the relevant market in which the Opponent's services are provided, it does not possess inherently high distinctive qualities either.

84. Overall I find that the earlier mark has a low to medium degree of inherent distinctive character.

### **Conclusions on likelihood of confusion**

85. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.<sup>46</sup> I must also consider the average consumer of the services, the nature of the selection process and bear in mind that 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.<sup>47</sup>

86. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.<sup>48</sup> The relative weight of the factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.<sup>49</sup>

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<sup>46</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

<sup>47</sup> *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

<sup>48</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

<sup>49</sup> See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

87. It is well established that confusion can be direct, which is a simple matter of the consumer mistaking one mark for another, or indirect. Indirect confusion arises where the consumer recognises that one mark is different from the other, but because of the marks' similarities, believes that the goods or services bearing the later mark come from the same undertaking or from an economically linked undertaking.<sup>50</sup> For example, they conclude that the later mark is another brand of the owner of the earlier mark because they share a common element.<sup>51</sup>

88. Confusion can also be 'right way round' or 'wrong way round', which in essence is nothing more meaningful than the order in which the consumer happened to come across the earlier mark and the later mark,<sup>52</sup> i.e. 'wrong way round' confusion embraces situations where the average consumer comes across the later mark first and believes that the services denoted by the earlier trade mark come from the same undertaking.<sup>53</sup>

89. Before I proceed with my assessment of the likelihood of confusion, I return to my earlier point about low level distinctiveness of an element which two competing marks have in common,<sup>54</sup> and that even a low degree of distinctiveness of that common element does not preclude a finding of a likelihood of confusion *per se* because all the relevant factors must be assessed.

90. I am keenly aware from the case of *Whyte and Mackay*<sup>55</sup> (in which the earlier mark 'ORIGIN' for wine was compared with the later mark 'JURA ORIGIN' for Scotch whisky) that "*if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.*"

91. However, as I have mentioned, such a situation does not preclude a finding of likelihood of confusion, but of course it is a relevant factor, and **in an appropriate case** it may be decisive (see *Nicoventures Holdings v The London Vape Company*).<sup>56</sup>

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<sup>50</sup> *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 10

<sup>51</sup> *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16-17

<sup>52</sup> *Comic Enterprises v Twentieth Century Fox* [2016] EWCA 41, paragraph 80.

<sup>53</sup> *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207 paragraph 14.

<sup>54</sup> See my paragraph 56.

<sup>55</sup> *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*, [2015] EWHC 1271 (Ch), paragraph 44.

<sup>56</sup> [2017] EWHC 3393 (Ch), paragraph 27.

This is why it is important to not lose sight of why a finding of no likelihood of confusion in *Whyte and Mackay* and *Nicoventures* was found to be appropriate based on the particular factors in those cases, i.e. in *Nicoventures*, the stylisation was decisive because the words were descriptive; and in *Whyte and Mackay* not only was 'ORIGIN' considered to have a low level of distinctiveness, but because when 'ORIGIN' was used *after* the name of the Scottish island 'JURA', it became entirely descriptive and would simply be taken as indicating that the whisky originated from the Scottish island, rather than having any independent trade mark significance. Accordingly the later mark would have been understood as a unit and therefore the word 'ORIGIN' had no independent distinctive role in the later mark.

92. I also am keenly aware that the global appreciation test must have regard to all the relevant factors and undue importance must not be placed on distinctive character, which is only a single factor in the multifactorial assessment. Indeed, in *L'Oréal SA v OHIM*,<sup>57</sup>(a case in which the earlier mark 'FLEXI' was compared to the later mark 'FLEXI AIR') the CJEU found that similarity between the marks should not be disregarded in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character, a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question.

93. Furthermore, even if a term could be regarded as descriptive, it has been stated that there is no hard rule that use of a descriptive term cannot lead to a finding that there is confusion but it also shows that such a case is harder to establish,<sup>58</sup> although not impossible.<sup>59</sup> In *Match Group, LLC V Muzmatch Ltd*,<sup>60</sup> the High Court stated the following:

"The fact that a claimant's mark and a defendant's sign share a common element that is descriptive may make it more difficult to conclude that there is a likelihood of confusion, but it does not make it impossible. Moreover, it seems to me that a finding of a likelihood of confusion may well be appropriate where

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<sup>57</sup> C-235/05 P at paragraph 45

<sup>58</sup> *Planart LLC v Photobox Ltd* [2020] EWHC 713 (Ch) at paragraph 29.

<sup>59</sup> *Match Group, LLC V Muzmatch Ltd* [2022] EWHC 941 (IPEC) at paragraph 91.

<sup>60</sup> *Ibid.*

the average consumer recognises that that common element, whilst capable of being used descriptively, is in fact being used distinctively as a badge of origin. The issue is highly fact sensitive and has to be assessed globally, taking into account all relevant factors, including the context in which the signs have been used.”

94. Returning to my earlier point,<sup>61</sup> I note that the findings in *Match Group* support the point I made earlier about the use of the ‘CARAVAN’ element in relation to the full breadth of the applied-for Class 43 services. Namely, that whilst ‘CARAVAN’ is capable of being used to describe a type of temporary accommodation (in relation to a sub-category of the Applicant’s booking and reservation services) it is also capable of being used distinctively as a badge of origin in relation to the broader scope of those services, when taking into account notional and fair use.

95. Finally, as was pointed out to me by the Opponent, the fact remains that the low level of distinctiveness of an element of a mark does not necessarily mean, when its size or its position in the sign are taken into account, that that element is negligible in the overall impression produced by that mark.<sup>62</sup> ‘Size and position’ can be a decisive factor in an appropriate case, and in this regard I note the findings of Mr Thomas Mitcheson KC, as the Appointed Person, in *Tea Lab Company Limited v Wissotzky Tea (Israel) Ltd.*<sup>63</sup> Mr Mitcheson found a likelihood of confusion between the following two trade marks, notwithstanding the presence of the seemingly distinctive ‘WISSOTZKY’ element in the applied-for mark (mark applied-for on the right – both of which were in respect of tea products in Class 30):



96. Thus Mr Mitcheson set aside the Hearing Officer’s decision of no likelihood of confusion. He stated that “*the starting point is the Hearing Officer’s finding that the dominant parts of Tea Lab’s mark were TEA and LAB, an assessment with which I*

<sup>61</sup> See my paragraph 60.

<sup>62</sup> T-194/09, *Líneas aéreas del Mediterráneo*, paragraph 30.

<sup>63</sup> BL O/0918/23

*agree. I also agree that the reference to laboratory in the context of tea is somewhat unusual and distinctive. However, these findings appear to be at odds with the Hearing Officer's assessment of Wissotzky's mark, where the T and LAB are equally prominent, but where he concluded that the much smaller WISSOTZKY [element] would play the strongest role.*"<sup>64</sup>

97. Mr Mitcheson was unable to reconcile the Hearing Officer's findings in relation to the 'WISSOTZKY' element, "*particularly given the much greater prominence*" of the 'T LAB' element. He considered that this apparent inconsistency justified him reconsidering the global question on appeal and found that there was a likelihood of both direct and indirect confusion. He stated that:

"34. [...] unlike the Hearing Officer I do not consider that the presence of WISSOTZKY will assist the average consumer in accurately remembering and recalling the parties' marks for one another. Instead, I consider that the overwhelming likelihood is that consumers will recall the respective undertakings by reference to the TEA/T LAB label [...]. As such, I do not think the Hearing Officer took proper account of the likelihood of imperfect recollection. I do not think that TEA LAB is descriptive enough to be ignored in the way the Hearing Officer found; indeed I think the unusual suggestion of tea being made in a laboratory will be something that the average consumer will recall. In contrast to the findings of the Hearing Officer I do consider that [there] will be plenty of scenarios in which the average consumer will not place sufficient weight on the WISSOTZKY part of the mark applied for, and as a result there will be a likelihood of direct confusion.

35. As for the likelihood of indirect confusion, I consider that the Hearing Officer fell into further error, again underestimating the importance of imperfect recollection. In particular, I disagree that the average consumer would recall the difference between TEA and T, especially given the aural and conceptual similarities. Further, the Hearing Officer only seemed to consider a scenario where the Wissotzky mark was seen first when he concluded as he did in §85 "I see no reason why the average consumer would think it logical that such a distinct element would be removed from a mark so that the mark would be read

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<sup>64</sup> Ibid. paragraph 32.

simply as a descriptive reference to a tea lab...” He did not consider the situation in which a consumer familiar with the TEA LAB mark saw the Wissotzky mark and might well consider that it was a sub-brand, geographical or specialist version of the more general TEA LAB range. Given the identity of goods, and the levels of visual, aural and conceptual similarity between the marks found by the Hearing Officer, I therefore think he was wrong to conclude that there was no likelihood of indirect confusion.”

98. Turning now to my conclusions on the likelihood of confusion. Accordingly, the factors to be taken into account can be summarised as follows:

- (1) the respective services are either identical or similar to each other. In the case where they are similar, they are similar to either a high or medium degree;
- (2) the average consumer of the services are members of the general public or professionals. The selection process of those services is predominantly, but not exclusively visual, and the average consumer (whether they are the general public or professionals) will pay a medium degree of attention when selecting those services;
- (3) Mark 1 has a low to medium degree of distinctive character and the distinctive character of the mark derives from the word ‘CARAVAN’ itself as opposed to the stylistic representation of that word. Whilst the word ‘CARAVAN’ is capable of being used descriptively in the market in which the Opponent operates, the word is nonetheless somewhat unusual and in relation to the registered services (bearing in mind the exclusions which apply to those services);
- (4) the word ‘CARAVAN’ is distinctive of the applied-for Class 41 services and is capable of being used distinctively in relation to the applied-for Class 43 services (when taking into account notional and fair use);
- (5) although the marks have the word ‘CARAVAN’ in common, they are visually, and aurally similar to a medium degree and conceptually similar to at least a medium degree overall when taking into account the differences between the marks;

(6) the common element between the competing marks dominates the overall impression of both marks, with the word 'CARAVAN' having an independent distinctive role in the contested mark.

99. In reaching my conclusion I bear in mind that, although I have found that the earlier mark has a low to medium degree of distinctive character, giving undue weight to a mark's low level of distinctiveness would be inconsistent with the global appreciation test, which is central to the comparison of marks. It is also important to have regard to the elements of a mark which give them their distinctive character, whilst still recognising that even if a common element is capable of being used descriptively (as is certainly the case in relation to a specific sub-category of the Applicant's Class 43 specification), it could also be used as a badge of origin (when bearing in mind the broad-breadth of that same Class 43).

100. Furthermore, even if the word 'CARAVAN' in the contested mark has a low level of distinctiveness that does not necessarily mean, when its size or its position in the sign are taken into account, that that element is negligible in the overall impression produced by that mark, indeed, as I have found, it dominates the overall impression of the contested mark and it has an independent distinctive role within the mark.

101. Standing back and considering the matter globally, I do not consider that even a low degree of distinctive character of the 'CARAVAN' element in either mark is sufficient to dispel a finding of likelihood of confusion, particularly when having regard to the specific factors in this case whilst bearing in mind the principle of interdependency and taking into account the effects of imperfect recollection. I therefore consider that when the specific factors in this case are appreciated globally, a conclusion that there is a likelihood of confusion is warranted, and that that confusion could be direct or indirect.

102. With regard to direct confusion, to paraphrase Mr Mitcheson in '*TEA LAB*', I consider that the overwhelming likelihood is that consumers will recall the respective undertakings by reference to the word 'CARAVAN' and I do not think that 'CARAVAN' is so low in distinctive character that it would be ignored in the contested mark. Indeed, I think the unusual suggestion of the word 'CARAVAN' (when taking into account fair and notional use) being used in relation to services unrelated to caravans, will be something that the average consumer will recall.

103. Other factors which lead me to this conclusion are that the selection process of the services is predominantly visual, therefore the placement, size and prominence of the word 'CARAVAN' in the contested mark is significant in determining that that word dominates the overall impression of the contested mark; also, even where the services are selected orally, 'CARAVAN' is the first part of the contested mark and is where the aural identity lies, therefore, bearing in mind the general rule of thumb that the first part of a mark normally carries a greater significance because it is where a consumer tends to focus its attention, this is another significant factor. As a consequence, it would not necessarily be the presence of the 'BY HABITAS' element that would assist the average consumer in accurately remembering and recalling the parties' marks for one another, particularly when taking into account the effects of imperfect recollection.

104. Again to paraphrase Mr Mitcheson in *'TEA LAB'*, I think the unusual suggestion of the word 'CARAVAN' being used in relation to services unrelated to 'caravans' will be something that the average consumer will recall. Consequently, there will be plenty of scenarios in which the average consumer will not place sufficient weight on the 'BY HABITAS' part of the mark applied for and will instead rely on the 'CARAVAN' element to denote trade origin.

105. In such circumstances I consider that the average consumer (or a significant proportion thereof), when encountering the marks in relation to identical or similar services (which are similar to either a high or medium degree) is likely to confuse one mark for the other, and therefore there is a likelihood that they would be directly confused as to the origin of those services.

106. With regard to indirect confusion, I consider that the average consumer is likely to conclude that the contested mark is another brand of the owner of the earlier mark or that the earlier mark is another brand of the owner of the contested mark, because they share a common element, and not that the differences between the marks denote services from different undertakings. For example, they would conclude that the differences in the marks are attributable to a sub-brand or specialist version of the more general 'CARAVAN' range of services. This would lead the average consumer (or a significant proportion thereof) of identical and similar services, to be indirectly confused as to the origin of those services.

## **OUTCOME**

107. The opposition under section 5(2)(b) of the Act is successful in its entirety. Subject to any successful appeal, contested trade mark application number 3771907 shall be refused registration.

## **Final Remarks**

108. As Mark 1 leads to the opposition being successful in its entirety, there is no need to consider the second trade mark upon which the opposition is based.

## **COSTS**

109. The Opponent has been successful and is entitled to a contribution towards its costs. I therefore award the Opponent the sum of **£1,100** based on the contributory scale set out in Tribunal Practice Notice 2/2016. The sum is calculated as follows:

Official fee for filing Form TM7	£100
Preparing a statement of grounds and considering the other side's counterstatement	£200
Preparing evidence	£500
Preparing submissions in lieu of a hearing	£300
<b>TOTAL</b>	<b>£1,100</b>

110. I therefore order HABITAS GROUP LTD to pay CARAVAN TOURS, INC the sum of **£1,100**. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 28<sup>th</sup> day of November 2024**

**Daniela Ferrari**

**For the Registrar**