

BL O/1225/24

IN THE MATTER OF THE TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK3497530 FOR THE TRADE MARK



IN CLASS 36

AND THE MATTER OF APPLICATION NO. UK3545118 FOR THE TRADE MARK



IN CLASSES 35 AND 36

BY REALIA EM LTD

AND THE OPPOSITIONS THERETO UNDER NOS. 421575 AND 424473

BY GLEB BORUKHOV

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF J WILLIAMS (O/0864/24) DATED 5 SEPTEMBER 2024.

DECISION

Introduction

1. This is an appeal by REALIA EM LTD (“**Appellant**”) from decision O/0864/24 of Mr John Williams (“**Decision**”) concerning the opposition by Gleb Borukhov (“**Respondent**”) to the Appellant’s applications for the marks shown below (“**Applications**”). Application No. UK3497530 (“**the 530 mark**”) was applied for on 5 June 2020.



2. It was published on 10 July 2020 in respect of the following services:

Class 36: *Real estate acquisition [for others]; Real estate acquisition [on behalf of others]; Real estate acquisition services; Real estate administration; Real estate affairs; Real estate affairs services; Real estate agencies; Real estate agency; Real estate agency services.*

3. Application No. 3545118 (“the 118 mark”) was applied for on 16 October 2020.



4. It was published on 26 February 2021 in respect of the following services:

Class 35: *Real estate marketing; Real estate marketing analysis.*

Class 36: *Real estate (Leasing of -); Real estate acquisition [for others]; Real estate acquisition [on behalf of others]; Real estate acquisition services; Real estate administration; Real estate affairs; Real estate affairs services; Real estate agencies; Real estate agency; Real estate agency services; Real estate agency services for the leasing of land; Real estate agency services for the rental of buildings; Real estate agency services relating to the purchase and sale of buildings; Real estate agency services relating to the purchase and sale of land; Real estate agents services; Real estate and property management services; Real estate appraisal; Real estate appraisal and valuation; Real estate appraisal services; Real estate appraisals; Real estate appraisals [valuations]; Real estate assessment [financial]; Real estate brokerage; Real estate broking; Real estate consultancy; Real estate consultation; Real estate consultations; Real estate equity sharing; Real estate escrow services; Real estate financing; Real estate insurance services; Real estate investment; Real estate investment advice; Real estate investment consultancy; Real estate investment management; Real estate investment planning; Real estate investment services; Real estate lease renewal services; Real estate lease surrender services; Real estate leasing; Real estate lending services; Real estate listing services for housing rentals and apartment rentals; Real estate management; Real estate management services; Real estate management services relating to building complexes; Real estate management services relating to commercial buildings; Real estate management services relating to entertainment venues; Real estate management services relating to housing estates; Real estate management services relating to industrial premises; Real estate management services relating to office premises; Real estate management services relating to residential buildings; Real estate management services relating to retail premises; Real estate management services relating to shopping centers; Real estate management services relating to shopping malls; Real estate procurement for others; Real estate property management; Real estate selection and acquisition [on behalf of others]; Real estate services; Real estate services related to management of property investments; Real estate settlement services [financial services]; Real estate syndication; Real estate time-sharing; Real estate trustee services; Real estate valuation services; Real estates evaluation (fixing of a price).*

5. The Respondent opposed the Applications on the basis of section 5(2)(b) of the Trade Marks Act 1994. The Respondent relied upon the series of two trade marks shown below, under No. UK3455240 (“**Earlier Marks**”), filed on 3 January 2020 and registered on 27 March 2020.

REALIA

FAMILY OFFICE

realia family office

6. The Respondent opposed all the Appellant's services and relied upon the following services:

Class 36: *Advisory services relating to real estate ownership; Advisory services relating to real estate valuations; Corporate real estate advisory services; Investment advisory services relating to real estate; Investment advisory services; Capital investment advisory services; Investment banking consulting and advisory services; Agency services for the leasing of real estate property; Agency services for the selling on commission of real property; Real estate brokerage; Brokerage of real estate; Financial brokerage services for real estate; Property (Real estate -) brokerage services; Private equity fund investment services; Management of private equity funds; Fund management for private clients; Fund management services; Capital fund management; Capital investment fund management; Funds management services; Investment fund management; Investment management of funds; Venture capital fund management; Administration of property portfolios; Arranging of leases for the rental of commercial property; Commercial property investment services; Estate management services relating to transactions in real property; Evaluation of real property; Financial services relating to property; Financial services relating to real estate property; Financial services relating to real estate property and buildings; Financial services relating to the acquisition of property; Financial services relating to the sale of property; Financial valuation of freehold property; Financial valuation of leasehold property; Financial valuation of personal property and real estate; Financing of property development; Financing of property loans; Leasing of real estate property; Property (Real estate -) consultancy services; Property (Real estate -) evaluations; Property (Real estate -) finance; Property (Real estate -) investment; Property (Real estate -) management; Property (real estate -) appraisal [financial]; Property appraisal services [valuation]; Property asset management services; Property investment banking services; Property investment services; Property leasing [real estate property only]; Property management services; Property portfolio management; Property valuation; Provision of finance for property development; Real estate and property management services; Real estate property management; Real estate services related to management of property investments; Valuations and financial appraisals of property; Property (Real estate -) brokerage services; Financial brokerage services; Financing and funding services; Financing in relation to the buying and selling of businesses; Financing of acquisitions; Financing of bridging loans; Financing of building projects; Financing of development projects; Financing of land acquisition; Financing of loans against security; Financing of mergers; Financing of property development; Financing services relating to real estate development; Asset-based financing; Brokerage services for arranging financing by other financial institutions; Consultancy concerning financing of energy*

projects; Corporate financing; Equity financing; Facilitating and arranging financing; Project financing; Providing financing to emerging and start-up companies; Provision of aircraft financing; Real estate financing; Venture capital financing; Advisory services relating to real estate ownership.

7. The two oppositions were consolidated on 16 May 2022. Neither party filed written submissions, but the Appellant filed evidence. A hearing was held on 13 February 2024. Prior to the hearing, the Appellant filed skeleton arguments, whereas the Respondent attended the hearing without having filed a skeleton argument.
8. In the Decision, J. Williams for the Registrar held that the opposition was wholly successful.
9. On 2 October 2024 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

The Hearing Officer's decision

10. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):
 - a. The average consumer would be a member of the public purchasing a private home, a landlord, or a property developer. All of these types of consumers would pay close attention when utilising estate agents' services in respect of such things as claimed service levels and rates of commission. The sums of money at stake would be considerable. The level of attention paid would be high. Visual considerations would predominate, although verbal factors cannot be discounted;
 - b. The 530 mark is visually similar to a medium degree to the Earlier Marks. It is aurally identical if the wholly descriptive "ASSET & LIFESTYLE MANAGEMENT" in the 530 mark is not voiced. If it is voiced, the marks would be of medium aural similarity. It is conceptually similar to a low degree. The 118 mark is visually similar to a medium degree to the Earlier Marks. It is of medium aural similarity if the wholly descriptive "ASSET & LIFESTYLE MANAGEMENT" and "MULTI FAMILY OFFICE" is not voiced. If the descriptive words were to be voiced, the marks would be of low aural similarity. It is conceptually similar to a low degree to the Earlier Marks;
 - c. The Earlier Marks are inherently distinctive to a high degree. The point of commonality between the marks – the word "REALIA" – is inherently distinctive alone to a high degree;
 - d. The services are identical or highly similar;
 - e. The Hearing Officer held that there is no likelihood of direct confusion, however there is a likelihood of indirect confusion.

Grounds of Appeal

11. The Appellant's Grounds of Appeal are as follows:
 - a. **Ground 1:** The Hearing Officer's decision overlooked the applicant's significant financial investment of over £200,000 in creating and promoting the "Realia EM LTD" brand. This investment has been crucial in establishing a strong and distinct market presence. Despite the presentation of substantial evidence in support of this investment, the decision does not reflect any acknowledgment or consideration of these factors.

The opponent did not refute or contest the applicant's claims regarding this investment. This lack of rebuttal should have been taken into account when assessing the likelihood of confusion, as the applicant's investment directly contributes to brand recognition and public association with the "Realia EM LTD" mark. The tribunal's failure to weigh this significant fact constitutes a material error.

- b. **Ground 2:** The opponent has failed to provide any evidence demonstrating that they are actively using the trade mark in connection with the services for which it is registered. Under trade mark law, non-use of a trade mark for a continuous period of five years can lead to its revocation. Despite the legal requirement to show active use of the mark, the opponent has not submitted any proof of such use, which significantly weakens the legitimacy of the opposition.

This failure by the opponent to demonstrate actual use of their trade mark should have been a critical factor in the tribunal's decision. Without use, the opponent's trade mark cannot maintain its exclusive rights, making the opposition invalid. The tribunal did not adequately consider this lack of evidence in its assessment, which represents a significant oversight in the ruling.

- c. **Ground 3:** The applicant has been using the "Realia" mark well before the opponent registered their trade mark. There is clear evidence in the form of brochures, promotional materials, business activities, and financial investments that demonstrate the applicants continuous use of the trade mark for "Lifestyle and Asset Management" services.

The opponent has effectively misappropriated the trade mark by registering it after observing the success and recognition of the applicant's brand. This prior use of the mark should have been considered as a key factor by the tribunal, particularly in assessing the bad faith of the opponent's registration. The tribunal's failure to consider the applicant's prior use and the opponent's misappropriation is a significant oversight.

- d. **Ground 4:** The applicant's mark is distinct both visually and conceptually from the opponent's trade mark. The applicant's trade mark features the phrase "Asset & Lifestyle Management," which is absent from the opponent's branding. Additionally, the applicant's use of a black background and distinctive design elements creates a visually unique mark compared to the opponent's "Realia Family Office" branding.

The tribunal did not adequately consider these differences, which significantly reduce the likelihood of confusion between the two trade marks.

- e. **Ground 5:** The distinctiveness of the applicant's trade mark is further reinforced by the nature of its services and target audience - sophisticated consumers such as high-net-worth individuals and institutional investors - who are discerning and unlikely to be confused by the differences in branding and service offerings.

- f. **Ground 6:** The opponent has not provided any evidence showing actual use of their trade mark or any harm caused by the applicant's activities. This absence of evidence should have been a decisive factor in the tribunal's decision. The tribunal erred by not giving sufficient weight to the lack of evidence from the opponent, particularly regarding use of the trade mark and any confusion in the market.

Given the opponent's failure to present proof of actual confusion or harm, coupled with the applicant's significant investment and established market presence, there is no likelihood of confusion under section 5(2)(b) of the Trade Marks Act 1994.

- g. **Ground 7:** The claim that the applicant's significant investment in developing and promoting the trade mark was not mentioned in the decision indicates that the tribunal did not give full weight to the evidence presented. This oversight can be framed as a procedural error or a failure to properly assess the facts, which can be grounds for appeal. The tribunal was obligated to consider all relevant evidence in assessing the likelihood of confusion, including the applicant's substantial financial and reputational commitment to the mark. The omission of this critical factor materially affects the correctness of the decision.
- h. **Ground 8:** Case law supports the principle that prior use and significant investment in a trade mark can influence how a mark is perceived by the public and reduce the likelihood of confusion. The *Revolve v Volvo* case illustrates how prior use and the sophistication of the consumer base play a key role in the perception of trade marks. Similarly, the *Celine SARL v Celine SA* case reinforces the idea that even where marks may share similarities, prior use and substantial investment can distinguish the applicant's trade mark in the eyes of the relevant public.

These cases illustrate the importance of considering market reality, established use, and the impact of investment when assessing likelihood of confusion. The tribunal's decision did not properly weigh these critical factors, and these omissions significantly affect the findings of fact.

- 12. The Appellant's director, Mr Pechinin, expanded upon the above in his skeleton argument and at the hearing, and I set out below further details as are necessary to understand my overall conclusions. The Respondent did not file a skeleton argument but attended the hearing and asked that the Decision be upheld.

Standard of review

- 13. The approach to be adopted in an appeal hearing has been laid down a number of times in case law. It was summarised in *Axogen v Aviv* [2022] EWHC 95 (Ch) at §24-25:

"Appellate Function"

- 24. Although I was referred to numerous cases on the subject (including *English v Emery Demibold & Struck Ltd* [2002] 1 WLR 2409, *REEF Trade Mark* [2003] RPC 5, *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, *Shanks v Unilever Plc* [2014] RPC 29, *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17, *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch), *Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 and *NINEPLUS O/039/21*), the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:

- i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);
- ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a

belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS O/039/21* at [14]);

- iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [81]);
- iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.
- v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], *REEF* at [28] and *Fine & Country* at [50]-[51]).
- vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).
- vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], *Actavis Group* at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (*Shanks* at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).
- viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], *Fage* at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).

- ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)]).
25. In the context of appeals relating to the likelihood of confusion, an evaluative issue described by Mr Iain Purvis QC sitting as an Appointed Person in *ROCHESTER Trade Mark* BL O/049/17 at [31] as "indeterminate and open to debate", Mr Purvis QC went on to say this at [33]:

"...the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

- (i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case
- (ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person
- (iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal
- (iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. Jacob J (as he then was) made this point in the passing off case *Neutrogena v Golden* [1996] RPC 473 at 482:

'It was certainly my experience in practice that my own view as to the likelihood of deception was not always reliable. As I grew more experienced I said more and more "it depends on the evidence."'

Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.

34. I shall therefore approach this appeal on the basis that in the absence of a distinct and material error of principle, I ought not to interfere with the decision of the Hearing Officer unless I consider that his view on the issue of likelihood of confusion was clearly wrong in the sense that it was outside the range of views which could have been reasonably taken on the established facts."

14. To the above should be added:

- The judgment of the Court of Appeal in *Lidl Great Britain Ltd v. Tesco Stores Ltd* [2024] EWCA Civ 262, where Arnold LJ said at §110 "It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable"; and
- The Supreme Court's guidance in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 where it stated at §49 "...on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of

consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion”.

15. I shall bear all the above in mind when reviewing the Decision.

Discussion

(1) Failure to consider substantial investment and established use

(3) Prior use and misappropriation of the trade mark

(7) Procedural Error in Failing to Assess the Applicant's Investment

16. I deal with Grounds 1, 3 and 7 together as they raise the same issue.

17. At §§16-18 the Hearing Officer said:

“16. Both parties have made allegations as to the other’s business conduct and their ownership status in relation to particular companies and websites. However, these allegations are not pertinent to the matter before me, i.e. the claim under section 5(2)(b) of the Act.

17. The applicant has also claimed that it has used the sign “Realia Family Office” prior to the opponent’s registration of that sign. While that may be the basis for a counterclaim under section 5(4)(a) of the Act, no such counterclaim having been filed by the applicant, I must again restrict myself to examining the matter before me – a claim under section 5(2)(b).

18. While I have thoroughly reviewed the documentation supplied to me, including the evidence that the applicant has filed, I cannot take account of those parts of the applicant’s counterstatements, witness statement, and skeleton arguments that relate to business conduct, ownership issues, or prior use of the sign “Realia Family Office” because they are not relevant to the section 5(2)(b) claim. I also do not find any of the applicant’s exhibits to be of assistance in determining the 5(2)(b) claim as they cover the same non-5(2)(b) points”.

18. The Hearing Officer was entirely correct to proceed as he did. If the Appellant could establish use of its marks prior to the filing date of the Earlier Mark, it may have been able to bring a counterclaim under s. 5(4)(a). Similarly, if the Appellant could establish that the Respondent knew of the Appellant’s prior use, and misappropriated the Appellant’s brand, it may have been able to bring a counterclaim for bad faith under s. 3(6). However, neither such counterclaim was filed, and the only matter under consideration was the s. 5(2)(b) opposition. As the editors of Kerly state at 11-029, *“The global appreciation assessments in relation to the relative grounds in s. 5 must be made on the basis of fair and notional use of the earlier and later marks, rather than by taking into account the actual use in the marketplace as required in the equivalent assessments in relation to infringement (under s.10)”*. The issues raised under grounds 1, 3 and 7 are accordingly, as the Hearing Officer said, wholly irrelevant to s. 5(2)(b).

19. The Hearing Officer therefore cannot be criticised for failing to take these factors into account, and I dismiss the first, third and seventh grounds of appeal.

(2) Opponent’s non-use of the Earlier Mark

20. The Appellant is correct to contend that non-use for a continuous period of five years can give rise to revocation of a trade mark. However, Form TM8 contains at section 7 the question “Do you want the opponent to provide “proof of use”?”. The Appellant ticked the box “No” in his TM8 filed on 28 January 2021. In the circumstances, the Hearing Officer was correct not to consider whether the Earlier Marks had been used, and it is now too late for the Appellant to change his mind as to whether he seeks to put the Respondent to proof of use.
21. I dismiss this second ground of appeal.

(4) Distinctiveness of the Appellant's trade mark

22. The Hearing Officer carried out a careful analysis of all the marks at §§52-64. He considered the marks side-by-side at §54. At §57 he noted that in the 530 mark “The words “ASSET & LIFESTYLE” sit above the word “MANAGEMENT”. The mark has a black rectangular background and the two sets of words discussed above are divided by a white vertical line”.
23. Notwithstanding that, he went on to find that “The word “REALIA” is the most dominant of the words which feature in the mark, being the largest word by height and the first word that the average consumer’s eye would be drawn to, the average consumer being someone who reads from left to right. It is also the only distinctive word, having the greatest weight in the overall impression, whereas the other words in the mark are wholly descriptive. These, together with the stylistic elements, play a much lesser role in forming the mark’s overall impression”.
24. At §58 he noted that in the 118 mark “Below “REALIA EM”, appear the words “Asset & Lifestyle management” in smaller text. All the words and letters in this section are in dark brown text. On the left-hand side of the mark are the words “Multi Family Office” each word being above the next in white text, the words sitting inside a gold square. The mark as a whole has a light brown rectangular background”.
25. He concluded that “While it is true that the average consumer reads from left right, the word and letters “REALIA EM” are the most dominant element in the mark, being prominently displayed in bold type and being larger than the other words in the mark having the greatest weight in the overall impression. They also contain the mark’s only distinctive element, “REALIA” (I do not consider that the average consumer would see the initial letters “EM” as standing for Event Management as the applicant says they do, but rather it would see them as not having any particular meaning). The other words in the mark are wholly descriptive. These, together with the stylistic elements, play a much lesser role in forming the mark’s overall impression”.
26. The Hearing Officer was required to assess the overall impression of the Application. As part of that exercise, he was required to consider whether there were any distinct and dominant features of the Applications. In carrying out that analysis, he took everything into account that he was required to, and made no error of principle. Nor can his assessment be said to be wrong – indeed, I believe it was clearly correct. I dismiss this fourth ground of appeal.

(5) Failure to consider nature of services and target audience

27. The Hearing Officer considered the identity of the average consumer at §§49-50, concluding that “The typical consumer in this case would be a member of the public purchasing a private home, a landlord, or a property developer. All of these types of consumers would pay close attention when utilising estate agents’ services in respect of such things as claimed service levels and rates of commission. The sums of money at stake would be considerable. The level of attention paid would be high”.

28. Contrary to the Appellant’s submission, therefore, it is clear that the Hearing Officer did take the nature of the services and the target audience into account, and indeed made the most favourable (to the Appellant) finding he could have done with regard to the average consumer’s level of attention. I accordingly dismiss this fifth ground of appeal.

(6) Lack of evidence from the opponent

29. The Appellant contends that the lack of any evidence of any actual confusion “should have been a decisive factor in the tribunal’s decision”. As is clear from the excerpt from Kerly cited at §18 above, the analysis under s. 5(2)(b) proceeds on “*the basis of fair and notional use of the earlier and later marks, rather than by taking into account the actual use in the marketplace*”. Indeed, it is the norm in Registry proceedings for there to be no evidence from the marketplace.

30. The Hearing Officer applied the correct test to determine whether there is a likelihood of confusion, and reached a supportable conclusion. I dismiss this sixth ground of appeal.

(8) Case law support

31. The Appellant cites the following case law in support of his appeal:

- i. *Revolvo / Volvo* – decision of Professor Ruth Annand sitting as the Appointed Person, BLO/061/15. The Appellant contends that this illustrates how prior use and the sophistication of the consumer base play a key role in the perception of trade marks.
- ii. *Celine SARL v Celine SA* – CJEU, Case C-17/06. The Appellant contends that this case reinforces the idea that even where marks may share similarities, prior use and substantial investment can distinguish the applicant's trade mark in the eyes of the relevant public.
- iii. *YouView TV Ltd v Total Ltd* - [2012] EWHC 3158 (Ch). The Appellant contends that this case establishes that trade mark descriptions should be interpreted based on their natural and ordinary meaning. The description of the Appellant’s services encompasses lifestyle management and public affairs, and there is no reason to artificially narrow or distort these terms in a way that would exclude protection or create confusion with the opponent’s marks.

32. I cannot see that any of those cases assists the Appellant. In *Revolvo*, the Hearing Officer had concluded that there existed only a moderate degree of visual and aural similarity between the marks, on the basis that:

- REVOLVO was a single invented word of which VOLVO was not the dominant element;
- the viewing public would not dissect the mark into 'RE' and 'VOLVO'; and
- the marks had no conceptual similarity as VOLVO would be seen as an invented word with no meaning, whereas REVOLVO would be seen as an invented word suggestive of the word REVOLVE.

33. The Appointed Person upheld that assessment and the finding of no likelihood of confusion. The factors in this appeal are very different – the dominant element of all the marks is the word REALIA, which the Hearing Officer held to have a high degree of distinctive character.

34. *Celine* concerned an infringement claim. The CJEU ruled that a name, or shop name could infringe a trade mark if it affected the essential function of the trade mark. However, the court

also confirmed that if the third party was using its name in accordance with "honest practices," as defined by the Directive, it might be permissible. No defence of "honest practices" is raised (or even available) in these proceedings.

35. *YouView* was an appeal to the High Court of a Hearing Officer's decision. However, in this matter, the Hearing Officer did not give the descriptions in the specifications of the Applications an artificially narrow or distorted meaning, and accordingly did not fall into error.
36. I dismiss this eighth ground of appeal.

Conclusion

37. The appeal is dismissed. The Applications are refused in their entirety.

Costs

38. Clearly, the Respondent has been the successful party. The Respondent, Mr Borukhov, was an unrepresented party. He has not given any indication as to the length of time incurred in dealing with this appeal, but I believe it would be fair to allow 4 hours (which is half the length of time he incurred for the hearing below). At an hourly rate of £19, that amounts to £76.
39. The Hearing Officer's order that the Appellant shall pay the Respondent the sum of £352 still stands. The total costs award to the Respondent is accordingly £428, payable within 21 days of this decision.

Dr. Brian Whitehead

27 December 2024

Representation

Sergey Pechinin, director of REALIA EM LTD, Appellant/ Applicant

Gleb Borukhov in person, Respondent/ Opponent