

O/640/20

TRADE MARKS ACT 1994

TRADE MARK APPLICATION 3389515

BY SHIRLEY WHITE AND OMARI WHITE-DALEY

TO REGISTER A SERIES OF TWO TRADE MARKS IN CLASSES 9 AND 42

AND

OPPOSITION 417121

BY RATED PEOPLE LIMITED

Background and pleadings

1. On 4th April 2019 (“the relevant date”), Shirley White and Omari White-Daley (“the applicants”) applied to register the series of two trade marks shown below.



I shall refer to them collectively as “the contested marks.”

2. The applicants apply to register the contested marks in relation to the goods/services set out below.

Class 9: Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; computer programs; recorded computer programs; computer programs (downloadable software); computer software; computer software programs; recorded computer software; software; operating software; communication software; application software; interactive computer software; virtual reality software; data communications software; data processing software; pre-recorded software; computer software applications, downloadable; computer software for document management; computer software for database management; software in the form of mobile telephone applications; software in the form of web applications; electronic databases; electronic or magnetic identification devices; instruction manuals in electronic format; downloadable computer software applications; training manuals in electronic format; electronic newsletters.

Class 42: Hosting a website containing reviews and accommodation ratings on a computer network; hosting a website containing reviews on a computer network.

3. Rated People Limited (“the opponent”) opposes the registration of the contested marks. The opponent claims that:

- (i) It is the proprietor of three earlier EU trade marks consisting of, or containing, the words RATED PEOPLE;
- (ii) The contested marks are similar to the earlier EU trade marks because (a) they contain the word RATED, and (b) the RL logo element of the contested marks uses a stylised letter R in a similar shade of green to that used and registered in the logo element of EU15238983;
- (iii) The earlier marks cover identical and similar goods and services in classes 9, 35 & 42, including “*operating online marketplaces for sellers and buyers of goods and/or services*” in class 35 (EU15238983), “*providing an online commercial information directory on the Internet*” in class 35 (EU9544776), and “*developing and hosting a server on a global computer network for the purpose of facilitating e-commerce via such a server*” in class 42 (EU13873013);
- (iv) There is a likelihood of confusion on the part of the public, including the likelihood of association;
- (v) The earlier EU marks have a reputation in the EU/UK and are used in relation to the UK’s number 1 online marketplace for connecting homeowners with quality tradespeople;
- (vi) Use of the contested marks would, without due cause, take unfair advantage of, and/or be detrimental to, the reputation and distinctive character of the earlier marks;
- (vii) RATED PEOPLE has been used throughout the UK since 2005 in relation to, inter alia, “*hosting a server on a global computer network for the purpose of facilitating e-commerce via such a server*” and downloadable and non-downloadable software, and has acquired a valuable goodwill;
- (viii) Use of the contested marks would constitute a misrepresentation to the public that the applicants are connected with the opponent, which would cause damage to the opponent’s goodwill.

4. The opponent says that the applicants' application should be refused under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

5. Two of the three earlier marks relied on by the opponent were registered less than five years before the relevant date. Consequently, they are not subject to proof of use under s.6A of the Act. Both of these marks are composite marks including figurative elements. EU15238983 looks like this.



6. EU13873013 looks like this.



7. The other earlier mark (EU9544776) consists solely of the words RATED PEOPLE. This mark was registered more than five years before the relevant date. The opponent relies on the registration of this mark in relation to a wide range of services in class 35, including "*providing an online commercial information directory on the Internet*". The opponent made the required statement that the mark had been used in the EU during the 5-year period ending on the relevant date in relation to the services in class 35 for which it is registered.

8. The applicants filed a counterstatement denying the grounds of opposition. I note that:

- (i) The opponent was put to proof of use of earlier EU trade mark EU9544776;

- (ii) The applicants contend that both RATED PEOPLE and RATED LETTINGS are descriptive of, and non-distinctive for, websites that provide ratings of people or properties;
- (iii) The applicants deny that the figurative elements of EU15238983 or EU13873013 are similar to the distinctive figurative element of the contested marks;
- (iv) The opponent is put to proof of the reputation and goodwill claimed for the earlier marks and that it extended to all the goods/services on which the opponent relies.

9. Both sides seek an award of costs.

Representation

10. The applicants are represented by TR Intellectual Property Ltd. The opponent is represented by Lane IP Ltd. Neither party asked for a hearing. I have, however, had the benefit of written submissions from both sides.

The evidence

11. Only the opponent filed evidence. This consists of a witness statement by Mr Alexander Shaw, who is the opponent's Chief Financial Officer and Company Secretary.

12. Mr Shaw says that the opponent was formed in 2005 after a builder walked out on the founder of the company during a home improvement project. The opponent operates a website at www.ratedpeople.com. Homeowners can post jobs on this website free of charge. Tradespeople can subscribe to the website in order to bid for the work. Homeowners can rate tradespeople according to the quality of their completed work. Mr Shaw says that 3.8 million homeowners are "signed up" with his company. Around 900k to 1 million jobs throughout the UK and Northern Ireland were posted on the website each year between 2014 and 2018. Over 50k tradespeople covering 30 trades are said to subscribe to the website, including

builders, carpenters, cleaners, electricians, gas/heating engineers, locksmiths, pest controllers, plumbers, roofers, tree surgeons and window fitters.

13. In addition to its core services the opponent's website also provides:¹

- A messenger service through which homeowners and tradespeople can communicate with each other about jobs.
- Cost guides showing homeowners how to estimate a fair price for their jobs.
- An 'Ask the expert' service through which homeowners can ask an expert specific questions about a prospective job.
- A blog, including posts by the opponent's experts providing insight into the fields of trade covered on the website.
- A Homeowners checklist setting out what qualifications and reviews to check before engaging a tradesperson for a job.

14. The opponent's website receives around 7 million visits each year, which places it amongst the 2800 most visited websites in the UK.²

15. Mr Shaw says that the opponent has used RATED PEOPLE in various different forms since the business started in 2005. The evidence indicates that the main mark used on the opponent's website is EU15238983. I could not see evidence of use on the website of EU13873013 in the form in which it is registered, but there is evidence that the following variant of this mark was used around 2014 - 2016.³



16. In 2012 the opponent launched two mobile phone apps called Rated People - Homes and Rated People – Trades, which have been available to download from

¹ See exhibit AS-9

² See exhibit AS-3

³ See exhibit AS-7

Googleplay and the AppStore ever since. The apps had been downloaded 250k times by the date of Mr Shaw's statement in December 2019.

17. The opponent's turnover is between £11m and £13m per annum. Between 2014 and 2019, the opponent spent between £4.2m and £6.7m per annum marketing and promoting its services. This included TV, radio and event advertising as well as placing adverts in publications. I note the following:

- The opponent ran RATED PEOPLE radio adverts on TalkSPORT between 2nd and 14th October 2017, which were listened to by an estimated 2 million people.
- The radio ad was re-run in March 2017, and again in October 2018, on TalkSPORT, Heart Digital and Heart London, during the course of which it was listened to by an estimated 4 million people.
- The opponent ran a TV advertising campaign in March 2017 placing adverts for its RATED PEOPLE website on More4, Film4, Really and Home TV.
- The TV adverts were timed to appear during breaks in popular and/or relevant TV programmes such as Grand Designs (207k adult viewers on the relevant channel at the time), Come Dine with Me (217k adult viewers), DIY SOS (101k adult viewers) and Escape to the Country (50k adult viewers).
- A further TV advertising campaign was run between October and December 2018 on Channel 4 and other channels owned by that channel, e.g. More4, Film4.
- The opponent advertises mainly in publications that appeal to tradespeople, such as Professional Builder and Professional Heating & Plumbing, but has also advertised in a publication aimed at the general public, i.e. City A.M.
- Advertisements in publications up to 2016 included the EU13873013 mark (in the form in which it is registered), whereas advertisements from 2017 onwards featured the EU15238983 mark, or variants of it.
- When the RATED PEOPLE mark is used in word-only form, e.g. as part of a web address, the words are often printed in green or in association with green branding.

18. The opponent also has a presence on social media. Its Facebook account set up in 2011 has had 40k “likes”. The Twitter account set up in 2009 has over 10k followers. The opponent also has Instagram and LinkedIn accounts. The opponent also operates a YouTube account on which it posts its TV adverts and videos showing tradespeople how best to utilise its services. A TV advert posted on YouTube in 2012 received over 1.7m views.

19. The opponent services have received coverage in the media, including in national newspapers such as The Mirror and The Guardian. An article published in the ‘Money’ pages of The Guardian on 4th June 2018 compared what it called “...*the main websites that list tradespeople.*” RATED PEOPLE was one of them. The others were MyBuilder, Checkatrade, Trustmark and Buy with Confidence.

20. The opponent’s services have won awards. In October 2018 it was the winner of UK Customer Experience’s ‘Best Online Customer Engagement’ award. It was also shortlisted by the On the Tools Awards for ‘Online Tradesperson Directory of the Year’.

21. An extract from a market research report by YouGov is in evidence.⁴ It shows that a monthly online survey of 2000+ UK consumers conducted during 2018 revealed that around 20% of respondents were aware of the opponent’s RATED PEOPLE brand. This rose to around 25% amongst homeowners.

22. Mr Shaw has not provided market share data, but according to him RATED PEOPLE is “*the UK’s number 1 marketplace connecting homeowners with quality local tradespeople.. .*”

Proof of use of EU9544776

23. The relevant parts of Section 6A of the Act are as follows:

“(1) This section applies where

⁴ See exhibit AS-22

- (a) an application for registration of a trade mark has been published,*
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),*
- (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and*
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period .*

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or*
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.*

(4) For these purposes -

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and*
- (b) -*

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

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

24. The opponent is therefore required to show use of RATED PEOPLE in relation to the registered services in class 35 during the period 5th April 2014 and 4th April 2019. Section 100 of the Act places the burden of showing use of the earlier mark on the opponent. I will keep in mind the case-law set out in *Walton International Ltd & Anor v Verweij Fashion BV*.⁵

25. The applicants' written submissions included numerous detailed criticisms of the opponent's evidence of use of RATED PEOPLE. The applicant takes issue with the opponent's claim to have used its mark since 2005. Despite filing no evidence of its own, they claim that their own research indicates that the website was not functioning until 2008. In the absence of any evidence from the applicants, I accept the opponent's evidence on this point. In any event, as the relevant date is in 2019 it makes little difference whether the opponent's business started in 2005 or 2008.

26. The applicants point out that the number of visits to the opponent's website does not equate with the number of unique visitors, nor show how many of the visits were intentional. In a similar vein, the applicants point out that the number of jobs posted

⁵ [2018] EWHC 1608 (Ch)

on the opponent's website does not necessarily equate with the number of jobs undertaken as a result. I accept these points for what they are worth, but I do not consider that they cast doubt on the opponent's claim to have used RATED PEOPLE on a substantial scale in relation to its online marketplace.

27. It is true that most of the use shown in the relevant 5 year period is of the composite mark registered under EU15238983. However, it is well established that use of a registered trade mark as part of another mark may constitute genuine use of the registered mark, provided it continues to be perceived as indicating the trade origin of the goods/services.⁶ That is clearly the case here.⁷

28. The real issue is the identification of the services provided under the RATED PEOPLE mark and deciding on an appropriate notional specification for the purposes of this opposition.

29. The relevant case-law was summarised by Carr. J. in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; Thomas Pink Ltd v Victoria's Secret UK Ltd [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; Thomas Pink at [53].

⁶ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 CJEU

⁷ See, for example, the way that the opponent's services were identified by the Guardian in the article referenced in paragraph 19 above.

v) *It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in Pan World Brands v Tripp Ltd (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; Thomas Pink at [53].*

vi) *A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. Maier v Asos Plc [2015] EWCA Civ 220 ("Asos") at [56] and [60].*

vii) *In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46."*

30. Although this case concerned partial revocation, exactly the same considerations apply to proof of use in opposition proceedings.

31. EU9544776 is registered in relation to the following services in class 35:

Advertising; business management; business administration; office functions; business appraisals; business management assistance; professional business consultancy; business information; business inquiries; business investigations; commercial information and advice for consumers; cost price analysis; price comparison services; compilation of information into computer

databases; compilation of statistics; data search in computer files for others; efficiency experts; marketing research; marketing studies; opinion polling; sales promotion for others; classified advertising; compilation of business directories; compilation of directories for publishing on global computer networks or the Internet; providing an online commercial information directory on the Internet; on-line advertising on a computer network; organisation, operation and supervision of customer loyalty schemes; organisation, operation and supervision of an incentive scheme; advertising services provided on the internet; information, advice and consultancy services relating to all the aforesaid.

32. In my view, the opponent's evidence justifies the protection of EU9544776 in relation to the following services:

Commercial information and advice for consumers; cost price analysis; price comparison services; compilation of information into computer databases; compilation of statistics; data search in computer files for others; sales promotion for others; classified advertising; compilation of business directories; compilation of directories for publishing on global computer networks or the Internet; providing an online commercial information directory on the Internet; on-line advertising on a computer network: all relating to jobs in and around the home undertaken by tradespeople.

33. In my view, the concluding restriction is a fair characterisation of the opponent's services and avoids granting protection in relation to broad categories of services rather than the appropriate sub-category. For example, although the opponent provides *commercial information and advice for consumers* it does not provide such information or advice in relation to many distinct sub-categories of such services, e.g. buying and selling vehicles.

The section 5(2)(b) ground of opposition

34. Section 5(2)(b) of the Act is as follows:

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

(a) -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Procedural economy

35. It is sufficient to examine the opponent's s.5(2)(b) case based on earlier mark EU15238983. This is because I consider this mark to be the most similar to the contested marks. If the opponent does not succeed based on this earlier mark, it will be no better off with the other two. Additionally, I find there is no need to examine the argument made in the opponent's written submissions, that the opponent is the owner of a 'family' of earlier marks and there is a likelihood of the contested marks being mistaken for a member of that 'family'. This is because (1) the opponent's pleaded case did not mention a 'family' of marks, and (2) although the opponent has used RATED PEOPLE with various (green) get-up over the years, the evidence does not show that the opponent has a 'family' of RATED marks on the market at the relevant date.

Comparison of goods and services

36. To the extent that it is necessary, the relevant goods/services are set out in the following table.⁸

Applicant's goods/services	Opponent's goods/services
<p>Class 9: Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; computer programs; recorded computer programs; computer programs (downloadable software); computer software; computer software programs; recorded computer software; software; operating software; communication software; application software; interactive computer software; virtual reality software; data communications software; data processing software; pre-recorded software; computer software applications, downloadable; computer software for document management; computer software for database management; software in the form of mobile telephone applications; software in the form of web applications; electronic databases; electronic or magnetic identification devices; instruction manuals in electronic format; downloadable computer software applications; training manuals in electronic format; electronic newsletters.</p> <p>Class 42: Hosting a website containing reviews and accommodation ratings on a computer network; hosting a website containing reviews on a computer network.</p>	<p>EU15238983</p> <p>Class 9: Computer hardware and firmware; computer software; mobile software applications; e-commerce software to allow users to perform electronic business transactions via a global computer network; computer application software for mobile phones and other mobile devices, namely, software for online directory services featuring a wide variety of consumer services of others; computer application software for mobile phones and other mobile devices, namely, software for online marketplaces featuring a wide variety of consumer services; electronic publications.</p> <p>Class 35: Operating online marketplaces featuring a wide variety of services of others; compilation of information relating to professionals; information, advisory and consultancy services relating to all the aforesaid.</p> <p>Class 42: Hosting an interactive website and online non-downloadable software for uploading, downloading, posting, showing, displaying, tagging, sharing and transmitting messages, comments, multimedia content, videos, movies, films, photos, audio content, animation,</p>

⁸ The full specification for EU15238983 is set out in Annex A

	pictures, images, text, information, and other user-generated content.
--	--

37. In *Gérard Meric v OHIM*⁹ the General Court stated that:

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

38. I find that *computer hardware and firmware* in the class 9 specification of EU15238983 covers *apparatus for recording, transmission or reproduction of sound or images*. These goods must therefore be considered to be identical. Similarly, *computer hardware and firmware* in EU15238983 covers *magnetic data carriers and electronic or magnetic identification devices*. These goods must therefore also be considered identical.

39. *Computer software* in class 9 of EU15238983 is wide enough to cover all the computer programs and software in class 9 of the specification of the contested trade mark. These goods are also identical.

40. This leaves *electronic databases; instruction manuals in electronic format; training manuals in electronic format; electronic newsletters* in class 9 of the application. The latter three terms are covered by *electronic publications* in class 9 of EU15238983. These goods are therefore also identical. I understand *electronic databases* (as goods) to be database software, or a combination of database software and the hardware/firmware on which the software is held. In either case, these goods are identical to *computer hardware and firmware* and/or *computer software* covered by EU15238983.

⁹ Case T-133/05

41. I conclude that all the goods covered by class 9 of the application are identical to goods in class 9 covered by EU15238983.

42. The web-hosting services in class 42 covered by EU15238983 are wide enough to cover websites with any *user-generated content*, including *accommodation ratings* and *reviews*. The services in class 42 of the application must therefore be considered as identical to the web-hosting services in class 42 covered by EU15238983.

43. Turning to the comparison between the goods and services covered by the application and the services in class 35 for which EU15238983 is registered, I note that they are not identical. In *Canon*¹⁰ the CJEU stated at paragraph 23 of its judgment that:

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

44. In *Kurt Hesse v OHIM*,¹¹ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. And in *Boston Scientific Ltd v OHIM*,¹² the General Court stated that “complementary” means:

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

¹⁰ Case C-39/97

¹¹ Case C-50/15 P

¹² Case T-325/06

45. Web-hosting services in class 42 appear to be complementary to certain business information services in class 35. The services in class 42 being the provision of the technological means of providing business information services to consumers. Indeed, although the services fall in different classes they may appear to be different aspects of a single commercial offering when viewed from the consumer's perspective.

46. In my view, *hosting a website containing reviews on a computer network* and *hosting a website containing reviews and accommodation ratings on a computer network* in class 42 are complementary services (in the sense described in the case-law) to *operating online marketplaces featuring a wide variety of services of others; compilation of information relating to professionals* for which EU15238983 is registered in class 35. I note that the nature of the reviews provided through the applicants' web-hosting services is not defined in the first description of its services in class 42. It could, therefore, cover hosting any kind of reviews, including reviews of tradespeople. Therefore, these services are similar to a high degree.

47. Further, even if I consider the specific goods/services for which I find (below) that the earlier mark has become highly distinctive through use, e.g. *Software for accessing online marketplaces* etc. and *operating online marketplaces featuring reviews of tradespeople for others; compilation of information relating to professional tradespeople; information, advisory and consultancy services relating to all the aforesaid* in class 35,¹³ I find that there is at least a low degree of similarity to the goods/services covered by the application. This is because (1) the ultimate purpose of the respective goods/services could be to provide commercial information to consumers, (2) the goods/services could be used to post or read reviews or ratings, (3) the information provided through the goods/services relates, or could relate, to property (albeit in different ways), (4) the method of use also appears similar, i.e. via websites on the internet.

¹³ See paragraph 60 below for full list

Average consumer and the selection process

48. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*.¹⁴

49. The application covers a wide range of computer hardware, firmware and software. The average consumers of such goods includes businesses as well as the general public. The cost and importance of hardware, firmware and software varies considerably depending its complexity and function. It is sufficient for present purposes to note that the hardware, firmware and software covered by the application include goods of moderate cost, such as mobile apps and data storage devices, for which the average consumer could be a member of the general public or a business. Such consumers are likely to pay an average degree of attention when selecting such goods. The same applies to publications in class 9 for use with such hardware, firmware and software, i.e. *instruction manuals in electronic format; training manuals in electronic format; electronic newsletters*.

50. The services in class 42 covered by the application are web-hosting services for the provision of reviews and accommodation ratings. These services are likely to be used by business people who want their services to be posted and advertised on a website. They are also likely to be used by the general public for the purpose of posting reviews and ratings and/or accessing reviews/ratings left by other members of the public. Average consumers of such services are liable to pay an average degree of attention when selecting a service provider.

51. The applicants' goods/services are likely to be selected primarily by eye, e.g. from websites or advertisements. However, radio adverts, word-of-mouth recommendations and orders may also play some part in the selection process, even though they will usually lead consumers to a place where the marks can be seen.

¹⁴ CJEU Case C-342/97

Therefore, the sound of the marks must be considered, albeit secondary in importance to how they look.

Distinctive character of the earlier trade mark

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

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

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

53. The applicants submit that RATED PEOPLE is descriptive of the goods/services relied on by the opponent. Therefore, EU15238983, which includes the words RATED PEOPLE along with figurative elements, is low in distinctiveness. The applicants dispute that the opponent's evidence shows that RATED PEOPLE had become highly distinctive through use by the relevant date.

54. The opponent submits that RATED PEOPLE had acquired a reputation and an enhanced level of distinctiveness through use prior to the relevant date.

55. I accept that RATED PEOPLE is descriptive of services in class 35 for *operating online marketplaces featuring reviews of tradespeople for others; compilation of information relating to professional tradespeople; information, advisory and consultancy services relating to all the aforesaid* (“the core services”). The descriptive meaning of RATED is obvious when considered in relation to reviews, ratings and information about tradespeople. It could be argued that there is a degree of ambiguity about what is meant by ‘PEOPLE’. However, in the context of goods/services for providing ratings of tradespeople, the omission of the qualifying word ‘trades’ offers no disguise to the fact that RATED PEOPLE is descriptive of the intended purpose of the goods/services. There is nothing unusual or distinctive about the combination of RATED and PEOPLE either. This finding also applies to hardware and software in class 9 for accessing such services, and associated web-hosting and non-downloadable software services in class 42 (“the associated goods/services”).

56. RATED PEOPLE would not be descriptive of the goods/services for which EU15238983 is registered in classes 9, 35 and 42¹⁵ if (unlikely as this may seem) they were unrelated to providing ratings of people, e.g. *computer hardware and firmware* for connecting users to their banks. Additionally, EU15238983 includes a distinctive stylised ‘R’ device in green. Accordingly, when (notionally) considered in relation to all the goods/services for which RATED PEOPLE is registered, but not descriptive, EU15238983 has an average or ‘normal’ degree of inherent distinctive character.

57. The evidence shows that the opponent used RATED PEOPLE with various get-up for at least 11 years prior to the relevant date in relation to the core services in class 35. It also shows that the opponent provided web-hosting services in class 42 through which ratings of tradespeople were posted. Since 2012, it also provided software apps for use in accessing such services. Between 2014 and 2018 the

¹⁵ Per paragraph 36 above

opponent was turning over £11 - £13m per annum under the mark. It invested around half that figure each year in advertising and promotion, including TV advertising. The opponent's website won awards. In 2018 the Guardian included RATED PEOPLE alongside four competitors in a review of "...the main websites that list tradespeople." A YouGov online survey in 2018 found that 20% of respondents had heard of the opponent's website. This figure rose to 25% amongst homeowners, who are a key market for the opponent's core services and associated goods/services.

58. Although they criticise the opponent's evidence, none of this evidence is contradicted by any evidence from the applicants. The applicants' point out that the opponent's claim to have over 50k tradespeople registered on its website appears to be contradicted by a record of an interview with the opponent's founder (published on its website) in which he says that there are 30k registered tradespeople. The opponent's representative submits that the discrepancy arises from the respective dates of Mr Shaw's witness statement compared with the earlier date of the published interview with the founder of the business. In the absence of any evidence from the applicants, or a request to cross examine Mr Shaw on his evidence, I accept what he says.

59. In my view, the evidence is sufficient to show that, by the relevant date, the words RATED PEOPLE had acquired a distinctive character in relation to the opponent's core services and associated goods/services in classes 9 and 42.

60. I therefore find that the figurative version of the mark (EU15238983), which as the applicants correctly note appears to be the primary mark used by the opponent in recent years, had acquired a highly distinctive character by the relevant date in relation to:

Class 9: Software for accessing online marketplaces featuring reviews and information about tradespeople and jobs in and around the home.

Class 35: Operating online marketplaces featuring reviews of tradespeople for others; compilation of information relating to professional tradespeople; information, advisory and consultancy services relating to all the aforesaid.

Class 42: Hosting an interactive website featuring reviews and information about tradespeople and jobs in and around the home; online non-downloadable software for uploading, downloading, posting, showing, displaying, tagging, sharing and transmitting messages, comments, multimedia content, videos, movies, films, photos, audio content, animation, pictures, images, text, information, and other user-generated content, all for reviews and information about tradespeople and jobs in and around the home.

Comparison of marks

61. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*¹⁶ that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

¹⁶ Case C-591/12P

62. The respective trade marks are shown below:

<p style="text-align: center;">EU15238983</p> 	
<p>Earlier trade mark</p>	<p>Contested trade marks</p>

63. The opponent submits that (1) the respective marks coincide visually in that RATED is the first word in the marks, (2) the word LETTINGS is entirely descriptive in the contested marks and will therefore make little impact on consumers, and (3) the visual similarity between the contested marks and EU15238983 is heightened by the presence of the stylised RL device in the colour green (in the first mark in the series).

64. From an aural perspective, the opponent says that RATED is the dominant and distinctive element of the marks because it is the first word and both PEOPLE and LETTINGS are less distinctive.

65. The opponent further submits that the marks are highly similar from a conceptual perspective, each bringing to mind the idea of a ratings service.

66. The applicants submit that as RATED PEOPLE and RATED LETTINGS are descriptive, the distinctive character of EU15238983 resides in the figurative element, which is different to the figurative device in the contested marks.

67. The assessment of similarity between the marks must not be elided or confused with the assessment of their distinctive character or the likelihood of confusion. Therefore, although it is necessary to take account of the fact that both RATED PEOPLE and RATED LETTINGS are descriptive terms (for some of the goods/services covered by the marks) in my overall assessment of the likelihood of confusion, this does not alter the degree of similarity between the marks.¹⁷

68. In my view, there is a medium-to-high degree of visual similarity between the first contested mark and EU15238983. This is because (1) the first word in the marks is RATED,¹⁸ (2) the marks include a stylised 'R' in the colour green, and (3) these visual similarities outweigh the impact of the visual differences arising from (4) the different second words PEOPLE and LETTINGS, respectively, and (5) the differences between the stylised 'R' device in the earlier mark and the stylised 'RL and house' device in the contested marks.

69. Further, as registration of a trade mark in black and white covers use of the mark in any colour, my finding that there is a medium-to-high degree of visual similarity between EU15238983 and the first contested mark also applies to the second contested mark.¹⁹

70. Turning to aural similarity, I accept the opponent's submission that the marks will be verbalised as RATED PEOPLE or RATED LETTINGS. The coincidence of RATED as the first word in the marks creates a degree of aural similarity. However, there is only a medium degree of overall aural similarity between the marks. This is because the different sounds of PEOPLE and LETTINGS make a significant difference to the overall sound of the marks when spoken.

¹⁷ See, for example, *Ravensburger AG v OHIM*, Case T-243/08 at paragraph 27.

¹⁸ The beginnings of word marks usually make more impact of consumers than the endings: see *Enercon GmbH v OHIM*, T-472/07

¹⁹ *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47

71. I accept the opponent's submission that there is a degree of conceptual similarity between the marks because they suggest a ratings service. However, given the different stated subjects of the ratings services, i.e. PEOPLE v LETTINGS, the degree of conceptual similarity is medium, not high.

Global assessment – likelihood of confusion

72. The following principles 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.

The principles

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

all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

73. The opponent submits that there will be direct and indirect confusion. Particularly with regard to the former, the opponent submits that RATED is the dominant and distinctive element of the earlier mark.

74. The applicants submit that there is no likelihood of confusion. In this connection, the applicants' representative claims to have carried out trade mark searches for the

word RATED in the relevant classes of the UK, EU and International trade mark registers and found over a 1000 registered marks. The applicants have not submitted any details of these searches, so it is not clear what was found. In any event, it is well established that the results of searches of trade mark registers carry little or no weight in the absence of evidence that the marks found in the searches are actually in use in the UK.

75. I do not accept that RATED is the dominant and/or distinctive element of the earlier mark. This is because RATED PEOPLE forms a unit with a meaning based on the combination of those words. Therefore, it is artificial to view RATED separately, or independently, of PEOPLE. In my view, the distinctive elements of the earlier mark consist of the stylised 'R' device and the words RATED PEOPLE. Neither of these elements are visually dominant over the other. I accept that RATED PEOPLE dominates the earlier mark from an aural perspective. I take account of the identity of some of the goods/services and the highly distinctive character of the earlier mark in relation to the goods/services set out in paragraph 60 above. I have also considered the impact of the conceptual similarity between the marks. This will be limited because the idea of a ratings service *per se* is not a distinctive concept in the context of the goods/services at issue. Taking account of all relevant factors, I find that, even allowing for imperfect recollection, the visual and aural differences between the marks (as wholes) are sufficient to avoid a likelihood of direct confusion.

76. The opponent's stronger case is based on indirect confusion. According to the opponent, relevant average consumers will believe that the similarities between the marks, coupled with the identity or similarity between the goods/services, indicates that the opponent is the user of the contested marks. Alternatively, that the marks are used by an economically linked undertaking and represent an extension of the specific services provided under the opponent's mark.

77. In *L.A. Sugar Limited v By Back Beat Inc*,²⁰ Mr Iain Purvis Q.C., as the Appointed Person, explained that:

²⁰ Case BL O/375/10

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

78. I find that the visual similarities between the marks, coupled with the highly distinctive character of the earlier mark in relation to the goods/services set out in paragraph 60 above, are sufficient to create a likelihood of indirect confusion. I note, in particular, that:

- (i) The earlier mark was well established at the relevant date and the words RATED PEOPLE had acquired a secondary (trade mark) meaning in relation to the goods/services for which they are inherently descriptive;
- (ii) The words RATED LETTINGS in the contested marks are not used in a purely descriptive context; rather, the use of the words beneath the stylised ‘RL’ device suggests that RATED LETTINGS are intended to be seen as a name with trade mark character;
- (iii) To the extent that the goods/services covered by the contested marks are different to the goods/services for which the earlier mark was highly distinctive in fact at the relevant date, they cover goods/services which are, at the least, similar to a low degree;
- (iv) When considering notional use of the marks in relation to all the registered/applied for goods/services, especially those for which RATED PEOPLE is not descriptive, EU15238983 has an average or

- 'normal' degree of inherent distinctive character and the respective goods/services in classes 9 and 42 must then be considered identical.
- (v) The users of the respective goods/services are likely to be the same or, where they are not the same, there is likely to be a significant overlap between the users, e.g. people who want to let properties also need to maintain them;
 - (vi) The use of the stylised 'RL' device in the contested marks in the colour green is consistent with a brand extension from EU15238983;
 - (vii) The use of the stylised 'house' element of the contested marks supports the meaning of the words RATED (PROPERTY) LETTINGS and, therefore, does little to contradict the suggestion that the marks are a brand extension.

79. I have kept in mind the warning given by Mr James Mellor Q.C. as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH*²¹, that a finding of indirect confusion should not be made merely because the two marks share a common element. Mr Mellor pointed out that it is not sufficient that a mark merely calls another mark to mind: this is mere association, not indirect confusion. I have also borne in mind that where the only similarity between the marks arises from the use of descriptive words, one should be cautious about finding that there is a likelihood of confusion.²² However, in my judgement, the overall resemblance between the marks at issue goes further than that and justifies a finding that there is a likelihood of indirect confusion.

80. The opposition under s.5(2)(b) based on EU15238983 therefore succeeds in full.

The section 5(3) of ground of opposition

81. Section 5(3) states:

“(3) A trade mark which-

²¹ BL O/547/17

²² See, for example, *Whyte and MacKay Ltd v Origin Wine UK Ltd & Anor* (“ORIGIN”) [2015] EWHC 1271 (Ch)

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

82. The opponent bases its case on the same three earlier EU marks covered by the opposition under s.5(2). However, I find that it is only necessary to consider the case based on EU15238983 and, briefly, EU9544776 (RATED PEOPLE word-only). If the opposition does not succeed on the basis of these marks the opponent will be no better off with EU13873013.

83. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Saloman*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the

relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in

particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Reputation

84. For the reasons given in paragraphs 57 – 59 above, I find that EU15238983 had acquired a reputation in the UK at the relevant date in relation to:

Class 9: Software for accessing online marketplaces featuring reviews and information about tradespeople and jobs in and around the home.

Class 35: Operating online marketplaces featuring reviews of tradespeople for others; compilation of information relating to professional tradespeople; information, advisory and consultancy services relating to all the aforesaid.

Class 42: Hosting an interactive website featuring reviews and information about tradespeople and jobs in and around the home; online non-downloadable software for uploading, downloading, posting, showing, displaying, tagging, sharing and transmitting messages, comments, multimedia content, videos, movies, films, photos, audio content, animation, pictures, images, text, information, and other user-generated content, all for reviews and information about tradespeople and jobs in and around the home.

85. A reputation in the UK also counts as a qualifying reputation in the EU.²³

Therefore, I find that EU15238983 was entitled to protection under s.5(3) at the relevant date.

86. Although EU15238983 appears to have been the opponent's primary trade mark at the relevant date, the words RATED PEOPLE as such had also acquired a reputation amongst a significant part of the general public in the UK, including homeowners and tradespeople. The use of the words RATED PEOPLE in radio

²³ See *Pago International GmbH v Tirolmilch registrierte GmbH*, CJEU, Case C-301/07

advertisements shows that the distinctiveness and reputation attached to those words does not depend on the presence of the stylised green 'R' device element in EU15238983 (although it no doubt adds to the distinctiveness of the words and forms part of the overall brand identity). Therefore, I find that EU9544776 (RATED PEOPLE) had also acquired a reputation in the UK/EU by the relevant date in relation to the following registered services in class 35:

Commercial information and advice for consumers; cost price analysis; price comparison services; compilation of information into computer databases; compilation of statistics; data search in computer files for others; sales promotion for others; classified advertising; compilation of business directories; compilation of directories for publishing on global computer networks or the Internet; providing an online commercial information directory on the Internet; on-line advertising on a computer network: all relating to jobs in and around the home undertaken by tradespeople.

Link with EU15238983?

87. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

88. I adopt my findings at paragraphs 68 – 71 above.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

89. There is at least a low degree of similarity between the goods/services for which the earlier mark has a reputation and the goods/services covered by the application. There is a significant overlap between the users of the goods/services.

The strength of the earlier mark's reputation

90. The earlier mark appears to have had relatively strong reputation at the relevant date in relation to the goods/service set out at paragraph 60 above.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

91. The earlier mark has a relatively low degree of inherent distinctiveness in relation to the goods/services for which it has acquired a reputation, but the mark had become highly distinctive through use by the relevant date.

Whether there is a likelihood of confusion

92. I have found that there is a likelihood of confusion.

Finding

93. Taking all these factors into account, I find that the relevant public would have made a mental link between the contested marks and EU15238983.

Link with EU9544776?

94. In *Specsavers International Healthcare Limited & Others v Asda Stores Limited*,²⁴ the CJEU held that:

“2. Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours with the result that it has become associated in the mind of a significant portion of the public with that colour or combination of colours, the colour or colours which a third party uses in order to represent a sign alleged

²⁴ Case C-252/12

to infringe that trade mark are relevant in the global assessment of the likelihood of confusion or unfair advantage under that provision.”

As s.5(3) of the Act is based on an EU Directive, this ruling must be followed when applying s.5(3) of the Act.

95. The ruling in *Specsavers* appears to mean that I should take into account that (1) although registered in black and white, EU9544776 has been used extensively in green, and (2) the first contested mark includes a device element in green, and the second contested mark could be used in the same colour.

96. In deciding whether the relevant public will make a link between the marks I will again examine the factors set out in *Intel*. My findings about “*the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public*” and “*the strength of the earlier mark’s reputation*” are the same as set out in paragraphs 89 and 90 above in relation to EU15238983.

The degree of similarity between the conflicting marks

97. Even considering the use of the words RATED PEOPLE in green, I find that there is a lower degree of visual similarity between the earlier mark and the contested marks than in the case of EU15238983. This is because the marks no longer have in common a stylised letter ‘R’ in green as part of the respective device elements. Nevertheless, there remains a low degree of visual similarity between the marks because of the common first word – RATED – and the presence, or the potential presence in the case of the second contested mark, of the colour green. The medium degree of aural and conceptual similarity between the contested marks and EU9544776 is not affected by the omission from the latter of the stylised ‘R’ device in EU15238983.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

98. The earlier mark appears to have little or no inherent distinctiveness in relation to the goods/services for which it has acquired a reputation. However, since the mark is registered, I am required to treat it as having a minimal degree of distinctive character. In any event, I find that through extensive use in the UK prior the relevant date, the mark had become distinctive to a medium degree.

Whether there is a likelihood of confusion

99. Given the lower degree of visual similarity between the contested marks and EU9544776 (compared to EU15238983) and the inherent descriptiveness/non-distinctiveness of RATED PEOPLE alone (and RATED LETTINGS for that matter), I am more cautious about finding that there is a likelihood of confusion. However factoring in the common use of the colour green, I find that, on balance, there is a likelihood of confusion amongst a smaller-but-still-significant proportion of the relevant public.²⁵

Finding

100. Taking all these factors into account, I find that the relevant public would have made a mental link between the contested marks and EU9544776.

Unfair advantage

101. In my view, the contested marks would take unfair advantage of the reputation of EU15238983. This is because a significant part of the relevant public who are consumers of the goods/services for which EU15238983 has a reputation will be caused to believe that the goods/services offered under the contested marks are marketed by the same undertaking and are of the same quality.

²⁵ See *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 at paragraph 34(v) of the judgment

102. With some hesitation, I reach the same conclusion with regard to EU9544776.

Detriment to reputation/distinctive character

103. My finding that a significant part of the relevant public will mistakenly believe that the parties' marks are used by the same or connected undertakings inevitably means that use of the contested marks will make the earlier marks less distinctive. I do not find it necessary to examine the opponent's case about further potential detrimental consequences (or unfair advantages) any further.

Due cause

104. The applicants have not pleaded 'due cause' as such. However, the applicants' complaint about the opponent trying to assert a monopoly in the word RATED for goods/services relating to ratings of commercial services/properties may be understood as a plea of due cause.

105. The judgment of the CJEU in *Leidseplein Beheer BV v Red Bull*²⁶ makes it clear that 'due cause' does not depend on the existence of overriding objective reasons for using the contested sign. Further, in *Interflora Inc v Marks and Spencer plc*²⁷ the Court of Appeal made it clear that a claim of unfair advantage should not be accepted where its effect would be to stifle fair competition, and the use complained about would not affect the functions of the earlier trade mark.

106. Therefore, if the only thing the opponent could complain about was the applicants' use of the words RATED LETTINGS, I may have found that the applicants had due cause to use the contested marks. Indeed, it may not have needed to show due cause because it would also have affected my findings of a likelihood of confusion and unfair advantage. However, the opponent's case under sections 5(2) and 5(3) of the Act is not so limited. It extends to the use of the stylised

²⁶ Case C-65/12

²⁷ [2015] EWCA Civ 1403

R as part of the device element in the contested marks in (or potentially in) a similar colour green to that associated with the earlier marks. In the face of the evidence of the reputation attached to the earlier marks, the applicants have not shown any cause for using this element of its marks.

107. The opposition under s.5(3) of the Act succeeds accordingly.

The section 5(4)(a) ground of opposition

108. I can deal with this briefly. The relevant parts of s.5(4)(a) of the Act are shown below:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa)

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

109. The requirements for showing passing off are well established: (1) the existence of goodwill in a business which the public distinguish by the claimant’s sign, (2) a misrepresentation by the defendant liable to cause deception amongst a substantial number of the claimant’s customers or potential customers, and (3) damage or the likelihood of damage to the claimant’s goodwill caused by the defendant’s misrepresentation.

110. It should be clear from my previous findings why I consider that the opponent has established goodwill under RATED PEOPLE in relation to the goods/services set out in paragraph 60 above.

111. The opponent claims an earlier right in the words RATED PEOPLE. Unlike its trade mark based case, it does not appear to have pleaded its passing off based case on its use of get-up or colour. The get-up and colour in which a word or words is (are) presented can make a critical difference in passing off cases.²⁸ Absent similar get-up or colour, and bearing in mind the inherent descriptiveness of RATED PEOPLE and RATED LETTINGS, I do not consider that the resemblance between RATED PEOPLE (as just words) and the contested marks is sufficient for use of the latter to deceive a substantial number of the opponent's customers or potential customers. I acknowledge even without the use of green branding, some consumers may be caused to wonder whether there is a connection between the users of the marks, but that is not enough to constitute a misrepresentation.²⁹ There may even be a small amount of confusion, but it is well established that a claimant who chooses a descriptive mark may have to put up with this.³⁰ Therefore, use of the marks would not constitute a misrepresentation to the public and the s.5(4)(a) case fails accordingly.

112. If I had construed the opponent's s.5(4)(a) pleaded case as covering its use of RATED PEOPLE in green letters and/or in association with green branding, then my decision would have followed my findings under s.5(2)(b). However, given the successful outcome of the s.5(2) and s.5(3) grounds this would not have affected the overall outcome of the opposition.

Overall outcome

113. The opposition has succeeded and the application will be refused.

Costs

114. The opponent has been successful and is entitled to a contribution towards its costs. I assess these as follows:

²⁸ See *United Biscuits (UK) Ltd v Asda Stores Ltd* [1997] 513

²⁹ See, for example, *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd* [2007] RPC 5 at 16–17

³⁰ *Office Cleaning Services v Office Cleaning Association* [1946] 63 RPC 39 HL

£400 for preparing a notice of opposition and considering the applicants' counterstatement;
£200 for the official fee for Form TM7;
£900 towards the cost of preparing evidence;
£250 for filing written submissions.

115. I therefore order Shirley White and Omari White-Daley to pay Rated People Limited the sum of £1750. The applicants shall be jointly liable for these costs. The costs 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 17th December 2020

**Allan James
For the Registrar**

Annex A

EU15238983

Class 9

Computer hardware and firmware; computer software; mobile software applications; software applications for smart phones, tablet devices and other mobile devices; e-commerce software to allow users to perform electronic business transactions via a global computer network; computer application software for mobile phones and other mobile devices, namely, software for online directory services featuring a wide variety of consumer services of others; computer application software for mobile phones and other mobile devices, namely, software for online marketplaces featuring a wide variety of consumer services; electronic publications; electronic publications in the nature of blogs, e-zines, books and catalogues; CDs; recorded media; software and software applications to enable transmission, access, organization, and management of text messaging, instant messaging, online blog journals, text, web links, and images via the Internet and other communications networks; downloadable software to facilitate online advertising, business promotion, connecting social network users with businesses and for tracking users and advertising of others to provide strategy, insight, marketing, and predicting consumer behaviour; downloadable software via the internet and wireless devices; software for accessing information on a global computer network; downloadable software in the field of social networking; downloadable software in the nature of a mobile application; digital wireless telecommunications software; computer software for use in creating, editing and delivering textual and graphic information via computer communication networks, wireless, telephone or other communication tool, Internet Protocol (IP) telephones; downloadable computer programs for use in telecommunications, namely, telecommunications software for providing single user and multiple user access to a global computer network.

Class 35

Advertising; business management; business administration; office functions; business appraisals; business management assistance; professional business consultancy; business information; business inquiries; business investigations; commercial information and advice for consumers; cost price analysis; price comparison services; compilation of information into computer databases; compilation of statistics; data search in computer files for others; efficiency experts; marketing research; marketing; marketing studies; opinion polling; sales promotion for others; classified advertising; compilation of business directories; compilation of directories for publishing on global computer networks or the Internet; providing an online commercial information directory on the Internet; on-line advertising on a computer network; organisation, operation and supervision of customer loyalty schemes; organisation, operation and supervision of an incentive scheme; advertising services provided on the internet; providing an online commercial information directory on the internet; online retail store services featuring a wide variety of goods and services of others; operating online marketplaces for sellers and buyers of goods and/or services; operating online marketplaces featuring a wide variety of services of others; electronic commerce services, namely, providing

information about services via telecommunication networks; providing consumer product information via the Internet or other communications networks; computerized on-line ordering services featuring a wide variety of goods and services; computerized online ordering featuring general consumer merchandise; providing customer support services for electronic commerce sales transactions; On-line advertising on a computer network; Organization of exhibitions for commercial or advertising purposes; Organization of trade fairs for commercial or advertising purposes; Outsourcing services [business assistance]; online advertising and marketing services; promotional services; business networking; business monitoring and consulting services, namely, tracking users and advertising of others to provide strategy, insight, marketing guidance, and for analysing, understanding and predicting consumer behaviour and motivations, and market trends; placing advertisements and promotional displays in electronic sites accessed via computer networks; providing information regarding careers, employment, and job placement; providing market information in relation to consumer products; providing shopping information; compiling and maintaining online directories; Personnel recruitment; recruitment services; providing information regarding careers, employment, and job placement; sales promotion (for others); compilation of information relating to professionals; information, advisory and consultancy services relating to all the aforesaid.

Class 42

Designing, creating, maintaining and hosting online electronic commerce websites for others; developing and hosting a server on a global computer network for the purpose of facilitating e-commerce via such a server; scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; software as a service (SAAS); hosting an interactive website and online non-downloadable software for uploading, downloading, posting, showing, displaying, tagging, sharing and transmitting messages, comments, multimedia content, videos, movies, films, photos, audio content, animation, pictures, images, text, information, and other user-generated content; hosting of digital content online; hosting multimedia content for others; computer services, namely, providing temporary use of a non-downloadable computer interface in order to create online personalized information services; designing, updating, testing and analysis of computer software and computer programs; designing, testing and analysis of computer systems, computer hardware; maintaining (creating and -) web sites for others, hosting computer sites (web sites); design of web sites and software applications on global computer networks and local and internal computer networks; provision of information in the field of computers in the forms of publications, magazines, magazines supplements, magazine sections, newsletters, pamphlets, brochures, exhibition programs, reports, books and directories, provided on-line from a computer data base or from the Internet; information, advisory and consultancy services relating to all the aforesaid.