

O-375-17

TRADE MARKS ACT 1994

**IN THE MATTER OF AN APPLICATION
BY ASIA STANDARD MANAGEMENT SERVICES LIMITED
FOR REGISTRATION UNDER NO 3145555
OF THE TRADE MARK**

ASIA STANDARD

AND


**OPPOSITION NO 406567 THERETO
BY STANDARD INTERNATIONAL MANAGEMENT LLC**

Background

1. Application no 3145555 has a filing date of 21 January 2016, stands in the name of Asia Standard Management Services Limited (“the applicant”) and seeks registration of the trade mark **ASIA STANDARD** for a range of goods and services in classes 16, 35, 36, 37, 39, 41 and 43.

2. Following publication of the application in the *Trade Marks Journal* on 5 February 2016, notice of opposition was filed by Standard International Management LLC (“the opponent”). The opposition was originally raised against a wider number of goods and services but, in its skeleton argument, the opponent reduced the extent of its opposition to certain goods and services as set out in paragraph 10 below.

3. The opponent bases its opposition on grounds under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying originally on eight UK and EU trade mark registrations but reduced at the hearing to the following:

Mark	Dates	Specification relied upon
3049342 THE STANDARD	Filing date: 31 March 2014 Date of entry in register: 18 July 2014	Services in classes 38, 39, 41, 43 and 44
EUTM 10749729 	Filing date: 9 March 2012 Date of entry in register: 7 January 2013	Class 35

4. The applicant filed a counterstatement in which, essentially, it denies the grounds of opposition.

5. The opponent filed evidence. The applicant did not file evidence but did file written submissions in lieu which I take into account and refer to as necessary. Matters came before me for a hearing when the applicant was represented by Ms Charlotte Scott of Counsel, instructed by Joshi Worldwide IP Limited. The opponent was represented by Mr Christopher Hall of Counsel, instructed by Boulton Wade Tennant.

The evidence

6. This consists of two witness statements (one filed in reply) from Amar Lalvani, the Managing Member of the opponent company. He states that this role is “comparable in scope and responsibility to that of a CEO or Chief Executive Officer” and is one he has held since August 2013. Attached to both witness statements are a large number of exhibits. I do not intend to summarise this evidence here but have read it and will refer to it as necessary later in this decision.

Decision

7. The opposition is brought under section 5(2)(b) of the Act which states:

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

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

8. As can be seen from the respective dates set out above, each of the marks on which the opponent relies is an earlier mark within the meaning of section 6 of the Act. As neither of the earlier marks relied on had been registered for five years at the date on which the application was published, they are not subject to the proof of use provisions set out in section 6A of the Act and the opponent is entitled to rely on them in respect of each of the services for which they are registered.

9. 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.

Comparison of goods and services

10. Taking into account the reduced number of earlier rights relied upon by the opponent and the reduced extent of its opposition, the respective goods and services to be compared are as follows:

Opponent's specification	Applicant's specification
Class 35 (EU10749729) Retail sales services of goods in retail stores and through and interactive on-line website, namely in connection with cosmetics, soaps, perfumery, essential oils, hair and body lotions, candles, magnetic data carriers, recording discs, compact discs, DVDs and other digital recording media, cameras, cases and holsters for laptops, i-pads and mobile phones made from different materials, glasses and sunglasses, headphones, jewellery, precious stones, horological and chronometric instruments, paper	Class 16 Books; Cards: Envelopes [stationery]; Greeting cards; Magazines [periodicals]; Newsletters; Newspapers; Pictures; Postcards; Printed matter; Printed publications; Stationery.
	Class 35 Business management of hotels.

<p>and cardboard goods, printed matter, photographs, posters, stationery, artists' materials, plastic materials for packaging, leather and imitations of leather, goods made of leather and imitations of leather, trunks and travelling bags and accessories for trunks and travelling bags, umbrellas parasols, walking sticks, pillows, houseware, glassware, porcelain, earthenware, textiles and textile goods, bed covers, bed linens, blankets, table covers, travel sets (textile goods made from alpaca wool), travelling sets, clothing, footwear, headgear, snow globes, toys, toys for adults, games and playthings, gymnastic and sporting articles, works of art, baskets, silkscreen prints, candleholders, bookends, paperweights, ceramic wall art, canvas flags, pictures, paintings (framed or unframed), flower-stands, flower-pot pedestals, vases, artificial flowers, artificial fruit, artificial garlands, porcelain articles for decoration purposes, glass articles for decoration purposes, articles of wood, cork, reed, cane, wicker, horn, bone, ivory, shell, amber, mother-of-pearl for decoration purposes.</p>	
<p>Class 38 (3049342) Providing computer/online Internet access facilities</p>	<p>Class 36 Accommodation bureau [apartments]; Apartment house management; Leasing of real estate; Real estate management; Rental of offices [real estate]; Renting of apartments; Renting of flats.</p>
<p>Class 39 (3049342) Parking valet services</p>	<p>Class 39 Arranging of tours; Booking of seats for travel; Car parking; Sightseeing [tourism]; Transport reservation; Travel reservation.</p>
<p>Class 41(3049342) Entertainment; entertainment services provided by hotels; entertainment services provided in hotels, restaurants and nightclubs; nightclub services; providing meeting/convention room facilities for educational conventions</p>	<p>Class 41 Amusements; Arranging and conducting of concerts; Booking of seats for shows; Conducting of concerts (arranging and); Club services [entertainment or education]; Entertainer services; Entertainment; Health club</p>

	services [health and fitness training]; Night clubs; Party planning [entertainment]; Presentation of live performances; Production of shows; Providing casino facilities [gambling].
Class 43 (3049342) Services for providing food and drink; temporary accommodation; restaurant services; bar, café, cocktail lounge services; providing banquet and social function facilities for special occasions; catering services; hotels; hotel services; providing meeting/convention room facilities for other types of convention	Class 43 Accommodation bureau [hotels, boarding houses]; Bar services; Cafés; Cafeterias; Canteens; Food and drink catering; Hotel reservations; Hotels; Motels; Rental of meeting rooms; Rental of temporary accommodation; Restaurants; Self-service restaurants; Snack-bars; Tourist homes.
Class 44 (3049342) Barber shop services/beauty salon services; spa services	

11. In response to the applicant’s written submissions requesting the opponent substantiate its assertions that certain goods and services are identical or similar, Mr Hall referred me to Mr Lalvani’s Exhibit 23 to his second witness statement. This exhibit (pages 306 to 362) consists of pages downloaded from the websites of a number of hotels. The pages were downloaded well after the relevant date and the vast majority refer to hotels outside the UK but Mr Lalvani states they are intended to “demonstrate that it is common in the hotel industry for providers to offer the goods and services claimed in the Application alongside or in the context of “hotels” and “hotel services”, and that such services are often provided under the same brand name as the hotel or in a co-branded format.” Even if this were the case at the relevant date in the UK this would not be sufficient, of itself, to enable a finding of similarity.

12. In the judgment of the Court of Justice of the European Union “CJEU” in *Canon*, Case C-39/97, the court stated at paragraph 23:

“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”.

13. The relevant factors identified by Jacob J. in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

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

14. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated:

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

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

15. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. stated:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

16. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. stated:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

17. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

19. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as “complementary” and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

20. In relation to the applicant’s goods in class 16, the opponent submits that *books, greetings cards, magazines [periodicals], newsletters, newspapers, pictures, printed matter* and *printed publications* are either highly or reasonably similar to its

entertainment services in class 41, that cards, envelopes [stationery], greetings cards and postcards are reasonably similar to its hotel services and that Envelopes [stationery] and Stationery are reasonably or highly similar to its providing meeting/convention room facilities all in class 43. I disagree. The users and uses of the respective goods and services differ as do their nature. I acknowledge that e.g. programmes for a particular show may be sold at the venue hosting that show. I further acknowledge that those who provide accommodation for conventions or other meetings sometimes also provide certain items of stationery such as pens and notepaper, for use by those attending those conventions or meetings, as part of their service. I acknowledge yet further that some hotels will provide e.g. writing paper and envelopes or newspapers for use by guests staying at those hotels. I do not consider, however, that such provision is a core part of the relevant services such that there is a complementary relationship between the respective goods and services. I do not consider the relevant public is liable to believe that the responsibility for them lies with the same undertaking or with economically connected undertakings. Taking all relevant factors into account, I consider that the applicant's goods as applied for in class 16 are dissimilar to each of the opponent's services within its earlier mark 3049342 as are relied on.

21. The opponent further submits that the applicant's goods in class 16 are similar to its retail sales services in class 35 as are included within its EUTM 10749729. The most relevant of these are *Retail sales services of goods in retail stores and through and interactive on-line website, namely in connection with...paper and cardboard goods, printed matter, photographs, posters, stationery.*

22. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

23. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment):

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

24. On the basis of the European Courts’ judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM*², upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*³, however, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;

¹ Case C-411/13P

² Case T-105/05, at paragraphs [30] to [35] of the judgment

³ Case C-398/07P

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

25. Each of the applicant's goods as opposed, are items of printed matter or stationery as are subject of the opponent's retail services. Applying the principles identified above, I find there is a complementary relationship between them such that the respective goods and services are similar to a reasonable degree.

26. The applicant's services in class 35 are *Business management of hotels*. The opponent submits these are identical to its *Hotels* and *hotel services* whilst the applicant admits "that such services are similar to a moderate degree to the Opponent's "*hotel services*" in Class 43". I proceed on the basis that the respective services are similar to a moderate degree.

27. The opponent submits that each of the applicant's services which it has opposed in class 36 are at least reasonably similar to its *Temporary accommodation*. It further submits that the applicant's *Accommodation bureau [apartments]* are identical and its *apartment house management* reasonably similar to its *Hotels* and *Hotel services*. The applicant considers the closest of the opponent's services to be its *temporary accommodation* and submits that even in respect of these services the respective services are not similar in any way. It submits that its services in this class relate "to the provision or management of permanent accommodation (meaning as a home or for a substantial period of time) and not temporary accommodation" and that the respective services "are different in their intended purpose and do not tend to be provided by the same suppliers".

28. Temporary accommodation services are, self-evidently, services which provide accommodation on a temporary basis. The word "temporary" means different things to different people in their particular circumstances but can be taken to mean not

permanent. An accommodation bureau is a business which finds accommodation (in this case apartments) for its clients or finds tenants for landlords, thereby acting as a conduit between those who own property and those who wish to occupy it, whether on a short or long-term basis. Similarly, each of the applicant's other services in class 36 will include the provision of property to those who wish to occupy it. There is therefore an overlap in the users and uses of each of the respective services such that I find there is a low degree of similarity between them. Hotel and hotel services also include the provision of accommodation and I therefore find there is again a low degree of similarity between them and the applicant's accommodation bureau and apartment house management.

29. As for the applicant's services in class 39, the applicant accepts that its *car parking services* are "identical or similar" to the opponent's *parking valet services*. Bearing in mind the comments in *Meric* referred to above, I find these are identical services.

30. The opponent submits that the applicant's *booking of seats for travel, transport reservation and travel reservation services* are identical to its hotel services. At the hearing, Mr Hall expanded on this slightly and submitted that these are services which would be provided through a hotel's concierge service. The opponent further submits that the applicant's *arranging of tours and sightseeing [tourism]* are identical to the opponent's *hotel services*.

31. The applicant denies these services are identical. It refers me to the opponent's evidence at Exhibit 23 page 320 which shows very brief details of the various services available at the Disney Polynesian Village Resort in Florida and submits that "it is not representative of hotels generally" because of "the all-encompassing resort-nature of Disney". I have already commented on the fact that this material post-dates the relevant date, however, as it relates to a Disney resort in Florida, I do not find it persuasive in any event given that it is highly unlikely to reflect services typically provided by hotels in the UK. The applicant submits that "such services are not commonly provided by hotels rather than hotels merely acting as an agent for transport or tour operators who provide the services direct to the hotel's customers". In my view, each of the respective services are such as will be provided to the same

users through the same trade channels. They are also complementary in that they are often supplied together as part of a tour package. I consider they are similar to a reasonable degree.

32. In respect of its services in class 41, the applicant accepts that its *Amusements, Entertainer services, Entertainment and Presentation of live performances* are identical to the opponent's *Entertainment*. It also accepts that its *Night clubs* and *Club services [entertainment]* are identical to the opponent's *nightclub services*. I agree.

33. Whilst the opponent submits they are identical, the applicant submits that its *Providing casino facilities [gambling]* are similar to the opponent's *entertainment services provided by hotels; entertainment services provided in hotels, restaurants and nightclubs* on the basis that "casinos are often located in hotels". I proceed on the basis that the respective services are at least similar.

34. The opponent submits that the applicant's *Health club services [health and fitness training]* are identical to its *Hotel services in Class 43*, and its *Barber shop services/beauty salon services* and *spa services* in Class 44. The applicant accepts that "hotels often feature gyms, swimming pools etc." but submits there is no similarity between its services and any of those of the opponent. This is somewhat at odds with its submissions as regards casinos above. I consider that there is at least a reasonable degree of similarity between its services and the opponent's *Hotel services* and *spa services*. There is an overlap in the users and channels of trade in that it is not uncommon for spa and beauty salon services to be provided as part of a health club offering.

35. The applicant's remaining services in this class are *Arranging and conducting of concerts; Booking of seats for shows; Conducting of concerts (arranging and); Party planning* and *production of shows*. The applicant submits there is no similarity with any of the opponent's services. The opponent, however, regards them to be identical to (at least) its *entertainment; and entertainment services*. I consider there to be at least a reasonable degree of similarity between the respective services on the basis

that there is an overlap in users and channels of trade and the services are complementary.

36. As regards the applicant's services in Class 43, given that both specifications include the identically worded *hotels*, these are identical services. The opponent's *hotel services* will include *Hotel reservations* and thus, on the basis of *Meric*, these are also identical services. The applicant's *Accommodation bureau [hotels, boarding houses]; Motels; Rental of temporary accommodation*; I find to be identical to the opponent's *Temporary accommodation and hotels*. I find the applicant's *Tourist homes* to be highly similar if not identical to the opponent's *temporary accommodation*. I find the applicant's *Bar services; Cafés; Cafeterias; Canteens; Food and drink catering; Restaurants; Self-service restaurants; and Snack-bars* to be included within and therefore identical to, at least, the opponent's *Services for providing food and drink*. Lastly, I find the applicant's *Rental of meeting rooms* to be identical to the opponent's *providing meeting/convention room facilities for other types of convention*.

Average consumer and the nature of the purchasing process

37. 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, Case C-342/97*.

38. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The

words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

39. The goods and services are varied. For some, such as health club and café services, the average consumer will be a member of the general public. For others, such as business management of hotels or renting of offices, the average consumer will be a business. For yet others, such as booking of seats for travel or hotel reservations, the average consumer will be either a member of the public or a business. It follows that the degree of attention paid to the purchase of the goods and services also varies from the casual purchase of a pack of envelopes, the more considered purchase of travel reservations or hotel services and through to the highly careful purchase of leasing of real estate or apartment house management services. For each of the goods and services, visual considerations are likely to be the most important part of the selection process with the goods being bought from a shelf or selected from the pages of a catalogue and with both goods and services being bought or initial approaches made through a website. Aural considerations, however, may also play a part and must not be ignored especially given that services may be bought after recommendation and following discussions.


Comparison of marks

40. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*:

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

41. The marks to be compared are as follows:

Applicant's mark	Opponent's marks
ASIA STANDARD	3049342 THE STANDARD
	EUTM10749729 

42. Each of the respective marks contain two words, the second of which is the word **STANDARD**. In the applicant's mark it follows the word **ASIA**, both words presented in plain block capitals. The word **ASIA** has a geographical meaning and, as the applicant accepts is "somewhat allusive to the kind or style of certain of the contested Goods/Services". In the opponent's mark 3049342, the word **STANDARD** follows the word **THE**, again both words being presented in plain block capitals. The word **THE** is the definite article which leads me to find that it is the word **STANDARD** which is the dominant and distinctive element of the opponent's mark. In its EUTM the same words are presented in title case, the whole inverted and on a black rectangular background. Whilst the inversion adds to the distinctiveness of the mark, it is the word element within the mark which is dominant.

43. Comparing the applicant's mark, first, with the opponent's mark 3049342, the fact that both contain the word **STANDARD** as the second of the two words making up each mark leads to clear visual and aural similarities between them. There are also clear visual differences due to the first words being **ASIA/THE** respectively. Overall, I find there is medium degree of visual and aural similarity between these marks. Comparing the applicant's mark with the opponent's EUTM, the fact that the latter is inverted leads me to find that the visual similarities are slightly less. Despite the

inversion, the EUTM will still be pronounced in the usual way so there remains a medium degree of aural similarity between the respective marks.

44. The word **STANDARD** is an ordinary dictionary word in common usage which means a level of quality or attainment which is considered acceptable, usual or normal or a level used to judge the quality of something else. Preceded either by the definite article or the geographical word **ASIA**, I find that there is a medium degree of conceptual similarity between each of the respective marks.

The distinctiveness of the earlier mark

45. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other 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).”

46. As set out above, the opponent's earlier mark 3049342 consists of the words **THE STANDARD**. These are ordinary dictionary words in everyday use with a meaning that will be well-known to the average consumer though is not descriptive of any particular goods or services. I consider it to be a mark with an average degree of inherent distinctive character. The earlier EUTM has a slightly higher (though not materially so) degree of inherent distinctive character due to its presentation.

47. The opponent has filed evidence. That evidence shows that it owns and operates hotels (first witness statement of Amar Lalvani, paragraph 2) offering "rooms, restaurants, nightclubs, entertainment, food, drinks, meeting and events facilities, spa services and online booking services". It is said to have five hotels, all of which are located in the United States. Referring me to the case of *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2010] RPC 16, the opponent claims that as it has customers in the UK it has goodwill here. Whilst it has long been accepted that goodwill can exist in the UK even where a party has no business based here, the issue in the current case is not whether there is goodwill but instead whether the distinctive character of the earlier marks has been enhanced through their use.

48. Mr Lalvani exhibits a number of documents. They include:

Exhibit 2: Said to be "some paper clippings demonstrating the reputation acquired to date in the UK and worldwide". Taken from a number of newspapers and magazines, all of them date from after the relevant date.

Exhibit 3: Said to be "screenshots of The Standard website showing that customers in the UK can book a stay in one of the five hotels based in the US". The exhibit consists of some 7 pages. The first (page 38) is a single page showing results of an Internet search. Pages 39 and 42 largely show an image. Pages 40 and 41 give brief details of some of the facilities on offer at the hotels. Page 43 appears to show the facility to check availability of rooms and page 44 shows available rooms and rates. The rates are shown in dollars. Whilst the EUTM is shown on the printouts, each of them are dated well after the relevant date in these proceedings.

Exhibit 4: An extract from *The Telegraph* website referring to The Standard, Downtown LA. It is not dated. In his second witness statement Mr Lalvani exhibits a print from the Internet Archive Wayback machine (Exhibit 28) to show it having a date of 23 August 2016, again, after the relevant date in these proceedings.

Exhibit 5: Printouts from the Tripadvisor website which Mr Lalvani says include 2348 reviews “some of which come from the UK”. The printout is dated 28 July 2016 and show just a few reviews, 3 of which indicate they are from people with UK addresses. These reviews indicate they were posted 3, 4 or 6 “days ago” from which I infer they were posted after the relevant date.

Exhibit 10: This consists of 4 press cuttings. At page 82 is a brief article taken from *Estates Gazette, Online* dated 30 April 2015 which refers to plans to convert a former town hall annexe in London into a hotel “under the Standard brand”. At pages 83 and 84 are similar articles whose source or date is not given though in his second witness statement Mr Lalvani exhibits a print at Exhibit 26 showing that it appeared in the Evening Standard on 29 August 2014. At page 85 is an extract from *Camden New Journal* dated 23 April 2015, which reports that “planners have approved plans” to convert the town hall annexe into a Standard International hotel. It appears from the evidence that the hotel is still “under development”.

Exhibit 11: This consists of press cuttings taken from a number of publications. Dating from between 2011 and 2013, some of these are shown to be from countries other than the UK and indeed some are in languages other than English. Those in English include *The Financial Times* and *The Independent* and make reference to one or other of the opponent’s hotels in brief terms, often as part of a list with other hotels or bars e.g. “New York’s best rooftop bars” or “City Breaks” or mentioned as one of the examples of a “launch offer” available through a “discount luxury travel website”.

Exhibit 15: This consists of press cuttings dating from between 2011 and 2014. Many are taken from the opponent’s standardculture.com website

though others are from other online magazines e.g. oyster.com and guestofaguest.com for which no details are given of readership. The articles mention various “celebrities” and their visits to one or other of the opponent’s hotels or bars.

Exhibit 16: Said to be “invoices raised to UK customers”. Of the 36 exhibited, 2 are duplicated (pages 236/237 and 225/238) and another 9 others are dated after the relevant date (pages 193 to 210). Whilst all but one have been redacted insofar as the full address details are concerned, partial addresses are shown (in some cases the town/city are shown, whilst others show only “Great Britain”). 6 of them show they were to other than UK addresses (pages 214, 224, 226, 243/244, 246 and 248) which Mr Lalvani acknowledges in his second witness statement. Each is on headed paper bearing the “inverted” mark as registered under the EUTM.

Exhibit 17: Said to be a list of the numbers of members of “The Top of The Standard” a members-only lounge in one of the opponent’s hotels. The list is presented by country and the UK is listed in second place (with 105 members) after the US. Mr Lalvani gives no details of the date at which this list was compiled.

Exhibit 18: Mr Lalvani states this exhibit consists of printouts of Google Analytics information showing the number of people from the UK who visited The Standard website during the whole of 2012 as well as the period 1 January 2014 to 31 August 2016. In fact there is a further printout covering the period 1 January 2013 to 12 November 2013. The figures for 2012 show 127,595 visits whilst those for 2013 show 112,687 visits. The period ending 31 August 2016 is not broken down to show how many visits were made before the relevant date though a graph on the first page does show what I take to be a marked increase towards the end of the period. There is no evidence as to what pages any of the visitors to the website may have seen or how any pages may have looked at that time.

Exhibit 19: Said to be a “chart indicating ...information regarding the total rooms booked by guests from the UK in 2014-2016 and the revenue figures associated with those bookings”. Figures for 2016 span the period January to August and no breakdown is given for how much of these relate to the period before the relevant date. Figures for the calendar years 2014 and 2015 are given as 16,239 and 15,141 rooms respectively, amounting to over \$5m revenue each year.

49. In his second witness statement, Mr Lalvani states that marketing of the opponent’s hotels to UK customers is “largely social media and press driven”. He provides the following exhibits:

Exhibit 24: Said to consist of “two prints from a 2016 online advertising campaign run on UK web-based magazine Dazed Digital along with UK relevant statistics from website analytics”. There are, in fact three pages. The first, at page 363, does not appear to be dated. The remaining two pages are headed:

“HPTO-DAZEDDIGITAL.COM (8/2-8/8)” and

“HPTO-DAZEDDIGITAL.COM/ARTSANDCULTURE (8/2-8/9)”

This suggests that they date from August 2016 and so post-date the relevant date.

Exhibit 25: This is said to be a “report obtained from the International Air Transport Association (IATA) comprising a list of IATA accredited UK travel agents who have booked and sent clients to Standard branded hotel properties of the Opponent between 10 March 2012 and 10 March 2017.” Whilst there is no indication given of how many of the listed stays took place before the relevant date, Mr Lalvani states the exhibit “contains data from over 90 distinct organisations, being intermediary and travel agency customer of the Opponent [and shows] a total of 13,392 nights worth of bookings...”. The exhibit also contains “a list of direct corporate bookings from UK companies, with the individual traveller names redacted for reasons of privacy.” The list shows departure dates from March 2012 to March 2017. Of

those before the relevant date, many of the companies are listed multiple times with many of them booking “room nights” in the hundreds.

Exhibit 27: This consists of what Mr Lalvani states are “screenshots of the booking portal accessible though [the opponent’s website] showing that it is possible [for] targeted UK customers to make room reservations in British Pounds”. The single page was downloaded on 27 March 2017, some 14 months after the relevant date.

Exhibit 29: This is a print from the Internet Archive dated 19 June 2013 showing four pages from the tripadvisor.co.uk website. Referring to The Standard High Line hotel in New York, it shows a number of reviews. They include one from “mrchunky” in London referring to a stay in August 2012, one from “ebear_00” in Edinburgh who writes “We’ve stayed in the Standard a number of time before...”, one from “Stevo9999” in Moulsoford-on-Thames who states (s)he was “lucky to be in this hotel for work meetings”, one from “Y2010_10)” of Glasgow who writes “We chose The Standard for the location...” and one from “shappane” of London who writes “This is easily my favourite NYC hotel...”. All of these reviews are dated June 2013.

Exhibit 30: This consists of some 20 invoices headed with the EUTM, again redacted, which show the address as “Great Britain”. All are dated before the relevant date. Mr Lalvani states that they are “only a sample” of the “thousands” available.

Exhibit 31: This consists of what Mr Lalvani describes as “updated Google analytics figures” for visitors to the standardhotels.com website. I note that the figures relate to the period 1 January 2011 to 13 March 2017 and are not broken down to show how much relates to a period before the relevant date.

50. Again, in his second witness statement, Mr Lalvani refers back to the information given at exhibit 19 of his first witness statement and says the figures were “calculated from the internal records of the Opponent by running a “country by revenue” statistics reports in the Opponent’s booking database” and where “the

address provided by the customer is a UK address". He goes on to provide some further detail for each of the opponent's hotels. They show estimated numbers of UK visitors to be 21,205 in 2014 and 18,983 in 2015. A figure is also given for 2016 but there is no indication of how much of this dates from before the relevant date. Mr Lalvani states: "If a guest has been there multiple times they are counted each time".

51. As can be seen from my summary, the opponent's evidence, despite being of some volume, is not well-focussed in terms of the relevant date in these proceedings. There is a large volume of evidence from third party sources e.g. articles in magazines, newspapers and online publications or references in online reviews, however, little of it dates from before the relevant date. There can be little doubt, however, that at the relevant date and despite the opponent having no place of business in the UK, it had had a significant number of bookings from UK customers, there were many travel agents who booked the opponent's hotels for clients and a large number of business clients who booked rooms for themselves. The hotels are all known as "The Standard" followed by their specific location, e.g. The Standard Hollywood. The invoices exhibited all show the "inverted" EUTM and, whilst the screenshots exhibited of the opponent's website post-date the relevant date, they show both earlier marks which indicates a consistent use of the mark over a fairly long period of time and the evidence as a whole casts light backwards in time as to what would have been visible to customers and potential customers. In short, I consider the distinctive character of the earlier marks will have been enhanced through their use.

Likelihood of confusion

52. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade

marks and must instead rely upon the imperfect picture of them he has retained in his mind.

53. Earlier in this decision I found:

- The applicant goods and services either to be similar to varying degrees or identical to services within the opponent's specifications;
- The average consumer of the goods and services will be either a member of the public or a business who will take varying degrees of care over the purchase depending on the type of goods or services being purchased. In all cases, the purchasing process will be primarily a visual one though aural considerations will also play a part;
- There is a medium degree of visual and aural similarity between the applicant's mark and the opponent's earlier mark 3049342. There is also a medium degree of aural similarity between the applicant's mark and the opponent's EUTM but the visual similarity is slightly less. There is a medium degree of conceptual similarity between each of the respective marks;
- The earlier mark 3049342 has an average degree of inherent distinctive character. The EUTM has a slightly higher though not materially so degree of inherent distinctive character. In respect of both earlier marks, I found their distinctive character has been shown to have been enhanced through use.

54. I have to consider the likelihood of both direct and indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted that:

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

the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

55. I do not consider the average consumer, on seeing the respective marks, would directly confuse them. I do consider, however, that there is a likelihood of indirect confusion as per sub-paragraph ii above, the word ASIA being a non-distinctive element that is likely to be seen as a specific sub-brand having a certain style or as a brand extension. That being the case, the opposition succeeds in respect of all goods and services for which the application was made and which I have found to be identical or similar to whatever degree. For the avoidance of doubt, my finding would have been the same had I not found the earlier marks to have an enhanced distinctive character through use.

Summary

56. The opposition succeeds in full in respect of all the goods and services which have been opposed. Subject to any appeal against my decision, the application will

be allowed to proceed to registration in respect only of those goods and services which have not been subject to this opposition. They are:

Class 16

Address stamps; Advertisement boards of paper or cardboard; Architects' models; Bags [envelopes, pouches] of paper or plastics, for packaging; Booklets; Calendars; Catalogues; Files [office requisites]; Flyers; Handbooks [manuals]; Indexes; Notebooks; Seals [stamps].

Class 35

Advertising; Advisory services for business management; Business appraisals; Business consultancy (Professional); Business information; Business inquiries; Business management assistance; Business organization consultancy; Business research; Commercial or industrial management assistance; Economic forecasting; Import-export agencies; Management (Advisory Services for business); Research (Business); Marketing research; Organization of trade fairs for commercial or advertising purposes; Professional business consultancy; Public relations; Rental of advertising space; Rental of advertising time on communication media; Secretarial services; Trade fairs (Organization of) for commercial or advertising purpose.

Class 36

Brokerage; Business liquidation services, financial; Capital investments; Charitable fund raising; Clearing-houses, financial; Financial analysis; Financial consultancy; Financial evaluation [insurance, banking, real estate]; Financial management; Financing services; Fund investments; Guarantees; Instalment loans; Insurance consultancy; Insurance consultancy; Lease-purchase financing; Loans [financing]; Mortgage banking; Mutual funds; Real estate agencies; Real estate appraisal; Real estate brokers; Securities brokerage; Stocks and bonds brokerage; Trusteeship.

Class 37

Building construction supervision; Building insulating; Building sealing; Construction; Construction consultation; Construction information; Demolition of buildings; Factory construction; Rental of construction equipment; Wallpapering; Warehouse construction and repair.

Class 39

Arranging of cruises; Boat rental; Bus transport; Car transport; Ferry-boat transport; Freight brokerage [forwarding (Am.)]; Freight forwarding; Freight [shipping of goods]; Pleasure boat transport; Railway transport; Rental of warehouses; Storage of goods.

Class 41

Amusement arcade services (providing); Amusement parks; Bookmobile services; Organization of sports competitions; Providing amusement arcade services; Providing golf facilities; Providing sports facilities; Rental of sports grounds.

Costs

57. The opponent has succeeded and is entitled to an award of costs in its favour. In making that award, I take note that whilst it filed a relatively large volume of evidence, it was not well-focussed to the relevant date and would have taken some time for the applicant to review. I do not intend to favour the opponent with an award of costs in respect of it. I make the award on the following basis:

Preparation of notice of opposition:	£200
Official filing fee:	£100
Preparation for and attendance at hearing:	£500
Total:	£800

58. I order Asia Standard Management Services Limited to pay Standard International Management LLC the sum of £800 which, in the absence of any appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 9th day of August 2017

Ann Corbett
For the Registrar
The Comptroller-General