

O/0270/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003406351

BY THE LONDON PATHWAY

TO REGISTER THE FOLLOWING MARK:

PATHWAY

IN CLASSES 16, 36, 41, 42, 43, 44 AND 45

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP600001273

BY PCL (PATHWAYS) LIMITED

AND

IN THE MATTER OF APPLICATION NO. UK00003408600

BY THE LONDON PATHWAY

TO REGISTER THE FOLLOWING MARKS (SERIES OF TWO):



IN CLASSES 16, 36, 41, 42, 43, 44 AND 45

AND

IN THE MATTER OF OPPOSITION THERETO

BY PCL (PATHWAYS) LIMITED

UNDER NO. OP600001274

Background and pleadings

Lead case: OP600001273

1. On 12 June 2019, The London Pathway (referred to in these consolidated proceedings as “Party B”) applied to register the trade mark (shown below) No. UK00003406351 (“Party B’s 351 mark”), and the application was published for opposition purposes on 13 September 2019.

PATHWAY

2. The registration is sought for the following goods:

Class 16 Printed matter; photographs; stationery and office requisites, except furniture; instructional and teaching materials; printed matter relating to healthcare; printed matter relating to homelessness.

Class 36 Financial affairs; monetary affairs; insurance; real estate affairs; charitable fundraising services; arranging charitable collections; benevolent fund services; provision of permanent accommodation; Providing information and advice on issues concerning permanent housing; information, consultancy and advisory services relating to all the aforesaid services.

Class 41 Education; providing of training; entertainment; sporting and cultural activities; publishing services; production, organisation and management of conferences, seminars, workshops, exhibitions and events for educational or cultural purposes; non-downloadable publications; information, consultancy and advisory services relating to all the aforesaid services.

Class 42 Industrial analysis and industrial research services; medical research; laboratory research; research on homelessness; information, consultancy and advisory services relating to all the aforesaid services.

Class 43 Temporary accommodation; services for providing food and drink; supplying meals to the homeless or underprivileged; Providing information and advice on issues concerning temporary housing; information, consultancy and advisory services relating to all the aforesaid services.

Class 44 Medical services; provision of health and medical information; information consultancy for healthcare professionals; Providing information and advice on issues concerning healthcare; information, consultancy and advisory services relating to all the aforesaid services.

Class 45 Providing legal information and advice on issues concerning homelessness and welfare.

3. PCL (Pathways) Limited (referred to in these consolidated proceedings as “Party A”) opposes the trade mark on the basis of sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against Party B’s Class 41, Class 43, and Class 45 services and is reliant upon the series of marks and the services detailed below.
4. Trade mark No. UK00002449776, filed on 16 March 2007 and registered on 20 June 2008.

Pathways

Pathway

- Class 41 Provision of education and training, vocational education, lifestyle counselling and mentoring and residential training in independent living skills, and the assessment of associated competencies, capabilities and risks.
- Class 43 Provision of supported housing, residential family care centres, temporary accommodation and children's homes.
- Class 45 Lifestyle counselling, social work services namely providing counselling, care and support to children in care, young people leaving care, children and young people at risk and young people with learning disabilities, and the assessment of competencies, capabilities and risks of the aforesaid persons.

Second case: OP600001274

5. On 21 June 2019, Party B applied to register the trade mark shown below, No. UK00003408600 (series of two) ("Party B's 600 marks") and the application was published for opposition purposes on 13 September 2019.



6. The registration is sought for the same goods and services as those applied for under Party B's 351 mark.
7. Party A opposes the trade mark on the basis of section 5(2)(b) of the Act. The opposition is directed against Party B's Class 41, Class 43, and Class 45 services and is reliant upon the same series of marks and services as detailed at paragraph 4.

The consolidated proceedings

8. Party A filed separate Form TM7Fs. Form TM7F is a notice of “fast track” opposition, which can be used when the opposition is based on sections 5(1) and/or 5(2) of the Act. In this instance, the opposition being based on a mark that had been registered for five years or more on the date that Party B’s marks were filed, Party A was required to include evidence of use of the mark to demonstrate that the mark had been genuinely used as per section 6A of the Act, which it duly did.
9. Party B filed separate Form TM8s and accompanying counterstatements, denying the claims made.
10. The cases were consolidated.
11. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”
12. Except where filing proof of use evidence is a prerequisite, the net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it, or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.
13. In addition to Party A’s proof of use evidence, which was mandatory, Party B sought leave to file evidence “that the terms 'PATHWAY'/'PATHWAYS' are

commonly used in the UK, in actual commerce and by the relevant public”.
This request was accepted.

14. An oral hearing was neither requested nor was it considered necessary.
15. Party A filed written submissions in lieu of a hearing. Party B did not file any written submissions.
16. Party B is represented by Wiggin LLP and Party A is represented by Squire Patton Boggs (UK) LLP.

Evidence

17. The statement of truth section of the Form TM7F is signed and dated 4 August 2022 by Shabir Ali, a director of Party A. There are seven questions – Questions 3 to 9 – of which answers are provided for Questions 3, 4, 5, 7 and 9.
18. The answer to Question 5 takes the form of a continuation sheet which documents the exhibits, which are numbered 1 to 14. Exhibits 1 to 14 are appended to the Form TM7F.
19. It should also be noted that, in answer to Question 9, Shabir Ali states the following:

“Since 16 March 2007 the trade mark has been licenced to Progressive Care Limited on a nonexclusive basis, initially by the previous owner of the mark, Mr Shabir Ali (Director and Shareholder of PCL (Pathways) Limited), and this licence remains in force following the transfer of the trade mark to PCL (Pathways) Limited. This licence is recorded on the register having number RC000053800.”

20. Party B's evidence consists of a witness statement from Paul Hamlin, the Project Manager of Party B. The witness statement is signed and dated 3 October 2022 and is accompanied by one exhibit, Exhibit PH1.

DECISION

21. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

22. Sections 5(1) to 5(2)(b) of the Act read as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because—

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

(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.”

23. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(1) In this Act an “earlier trade mark” means—

(a) a registered trade mark, international trade mark (UK) a European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

24. Given its filing date, the series of trade marks upon which Party A relies in both oppositions qualify as earlier trade marks as defined above.

Proof of use

25. Party A’s series of marks had been registered for more than five years at the filing dates of the applications and therefore the proof of use provisions apply.

26. The proof of use provisions are set out in section 6A of the Act, the relevant parts of which state:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),

(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) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) 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 Union.

(5A) [...]

(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.”

27. Section 100 of the Act is also relevant, which reads:

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

28. Pursuant to section 6A of the Act, the relevant periods for assessing whether there has been genuine use of the earlier series of marks are the five-year periods ending with Party B’s filing dates i.e. 13 June 2014 to 12 June 2019 and 22 June 2014 to 21 June 2019.

29. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v*

Hagelkruis Beheer BV [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

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

campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

30. I note that the material offered in evidence shows use of the marks by Party A’s licensee – Progressive Care Limited. Progressive Care Limited is recorded on the register as a licensee and it is perfectly legitimate to seek to show use of a mark by evidencing use by a licensee.

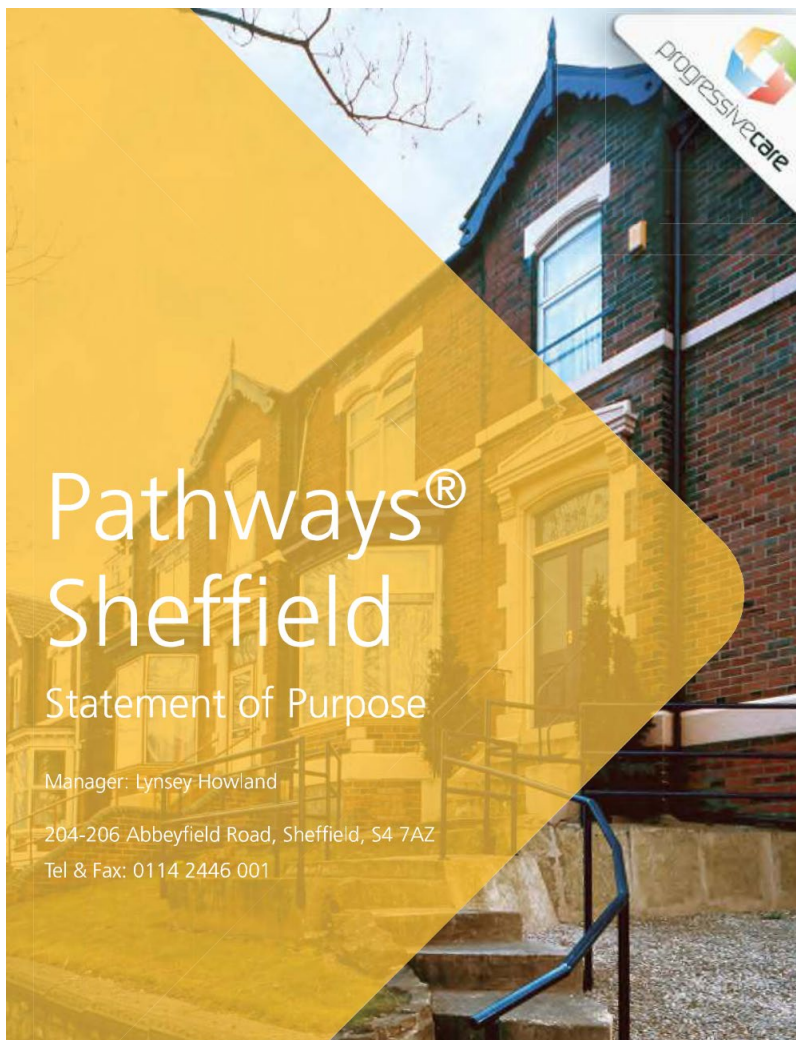
Use of the marks as registered

31. The plural form of Party A’s series of marks – “Pathways” – can be seen in use throughout the evidence. It features regularly as the prefix for the licensee’s children’s homes e.g. “Pathways Stalybridge” on page 1 of Exhibit 8. It also features as headings for explanatory text about the facilities, methodology and ethos of its children’s homes. The singular version of Party A’s mark – “Pathway” – also appears in the evidence. This is in the form of how the children’s homes provide routes through the care system and document children’s progress as they acquire independent living skills prior to supported living. For example, on “Page 4 of 19” in Exhibit 11, there is a heading, “The Pathway[®] Plan”, followed by: “The Pathway[®] Plan will be an ongoing working document which has input from the Young Person, their social worker, their key worker and any other professional involved.”

32. It is clear that the licensee uses “Pathways” and “Pathway” as the branding for its children’s homes and that therefore Party A’s series of marks are shown to be in use as registered within the relevant periods. The relationship between Progressive Care and Pathways is explicitly spelt out in the evidence in a number of instances (e.g. page 3 of 19, Exhibit 11) as follows:

“FOUNDATIONS (UK00002452698), PATHWAYS, PATH WAY and PATHWAY (UK00002449776) are all registered trade marks operated by Progressive Care Limited under licence from Shabir Ali.” However, I should address the presence of other branding in the evidence.

33. A number of pages in the evidence feature a hexagonal device and the word “progressivecare”, for example, this extract from Exhibit 9:



34. In respect of Progressive Care’s training offering, there is also “CARE 2 SUCCEED” in white letters inside a green circle (e.g. Exhibit 8, page 4 of 6).

35. I am guided by the case law that relates to the use of a mark with another mark. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its

registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1). (Emphasis added.)

36. The average consumer would regard the “progressivecare” brand as denoting the overall ownership group and “CARE 2 SUCCEED” as Progressive Care’s training offering. “Pathways” and “Pathway” are used specifically in a trade mark sense for the children’s homes and the routes through the care system that they offer. Therefore, “Pathways” and “Pathway” will be perceived independently even when used in conjunction with these other brands. On that basis, the use of the marks at issue in conjunction with these other brands is acceptable.

Sufficient use

37. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹

38. In response to Question 4 about where the mark has been used, Shabir Ali states the following: “The key areas in which the trade mark, UK00002449776, is used include:

Merseyside, Lancashire, Greater Manchester, Yorkshire, North Derbyshire, Cheshire, Staffordshire and the West Midlands.”

39. Submitted in response to Question 5 on Party A’s Form TM7F, the exhibits offered in evidence are discussed below.

40. Exhibit 1 is described by Shabir Ali as: “Pathways Stalybridge children’s residential home Statement of Purpose front cover 2008, and PowerPoint training presentation rolled out in 2008 across Pathways sites in Sheffield, Solihull, Stalybridge and Wigan.” The PowerPoint presentation is a “Parents & Carers Guide” for Pathways Wigan. As the relevant periods cover the years

¹ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

2014 to 2019, this exhibit does not assist Party A in demonstrating proof of use during the relevant periods. It is not even close enough to the beginning of the relevant periods to infer that use would be likely to have continued on into the relevant periods.

41. Exhibit 2 is: “example of marketing materials for Pathways believed to be from 2009, and marketing information dated 18 June 2009 for Pathways sites in Sheffield, Solihull, Stalybridge and Wigan.” Again, this exhibit does not assist Party A in demonstrating proof of use during the relevant periods.
42. Exhibit 3 is: “marketing and training material for Pathways from February 2011, from September 2011 setting out various services provided specifically including "Training and Education", and front cover of Pathways children's home resident guide for site at Dudley dated December 2011.” Again, this exhibit does not assist Party A in demonstrating proof of use during the relevant periods.
43. Exhibit 4 is: “Pathways Sheffield Guide dated July 2013”. While this exhibit is closer in date to the relevant periods, being from just under a year before, it is still outside the relevant periods. As such, it is of limited assistance to Party A.
44. Exhibit 5 is: “Pathways competition poster from March 2015, East Midlands Pathway poster believed to be from October 2015.” This exhibit is within the relevant periods. The competition poster offers prizes for designing an Easter egg. The East Midlands Pathway poster sets out details of “2 steps on the Pathway to Independent Living”. There is no information provided as to where these posters were put up, so it is not possible to estimate how many people would have been exposed to them.
45. Exhibit 6 is: “various screen shots of on line marketing via the website www.progressivecare.co.uk by the licensee of the trade mark dated 20 November 2008, 12 February 2012, 20 November 2013, 17 May 2016, 14

October 2017.” Of these screen shots, only the ones from 17 May 2016 and 14 October 2017 (pages 6 to 9) are in-date. The pages from both those dates feature information about the Pathways Stalybridge accommodation for children and young people, its goal, and contact information. There is no information supplied as to how many people have accessed these web pages.

46. Exhibits 7, 8, 9 and 10 are: “Pathways Sheffield children's residential home Statement of Purpose June 2015”, “Pathways Stalybridge children's residential home Statement of Purpose 21 December 2015”, “Pathways Sheffield children's residential home Statement of Purpose 22 September 2016”, and “Pathways Sheffield children's residential home Statement of Purpose 3 February 2017”. All of these statements of purpose are in-date. They describe the children’s homes staffing, facilities, and policies.

Example 1: Exhibit 7, page 5 of 33: **“Pathways 204** This 4 bedroom home is dedicated to providing short, medium and long term placements for children aged 12-17 years old. We aim to support young people towards independence within a safe and managed environment, offering skills to prepare for independent living.”

Example 2: Exhibit 8, page 7 of 21: “Whilst the young person is residing at Pathways they will have their own Individual Placement Plan, devised by Pathways staff, Social Care and the young person. The young person will also have their own individual Health Plan and Behavioural Support Plan. In addition young people are also encouraged to create their own 'My Plan' which is a young person centred plan discussing all areas of care and support as well as wishes and feelings. Depending on risk/needs identified young people will have a tailored Safeguarding Plan and one or more Risk Management Plan.”

Example 3: Exhibit 9, page 5 of 18: “Pathways® Sheffield wishes to provide a safe and nurturing environment where young people can feel comfortable enough to be themselves, as well as creating structure in young people's

lives that may have had little routine previously whilst taking into account their abilities and personal goals.”

Example 4: Exhibit 10, page 5 of 17: “Pathways® will consider - young people, male and female, with:

- An element of challenging behaviour
- Offending behaviour
- Social and emotional difficulties
- A history of being absent/missing from home
- Moderate learning difficulties
- Child exploitation concerns
- Self-harming behaviour”

There is no information provided as to how widely these statement of purpose documents have been disseminated.

47. Exhibit 11 is: “various print outs from the website www.progressivecare.co.uk as at 20 February 2019 detailing services provided by the licensee of the trade mark”. These web pages are in-date and include details of Pathways children’s homes. For example, how they prepare young people for supported living:

“Continuity of care...

This service is for Young People who are preparing for their move to supported living. We work closely with our partner agencies to ensure that each young person has a workable person centred Pathway® plan.”

48. There is no information supplied as to how many people have accessed the web pages documented in Exhibit 11.

49. Exhibit 12 is: "Pathways Transitional Support to Independence Brochure for South Yorkshire and Derbyshire setting out services provided by the licensee aimed at facilitating the process of young people in their transition to adult life specifically including "*Training and Education*", "*Pathway Plan*" and "*Pathway Planning*", and front cover usage of the Pathways mark." This brochure is undated, and it is therefore not possible to say whether it was produced during the relevant periods.

50. Exhibit 13 is: "various print outs from the website www.progressivecare.co.uk as at 20 November 2019 detailing services provided by the licensee of the trade mark." These printouts post-date the relevant periods by five months.

51. Exhibit 14 is: ""Pathways Service Brochure" which is available from <https://www.progressivecare.co.uk/pathways>." The brochure is undated, and it is therefore not possible to say whether it was produced during the relevant periods.

52. In response to Question 7 about the number of sales achieved under the mark, Shabir Ali states the following:

"Due to the nature of the Pathways branded business, there are no "sales" as such. However, residential places within care homes are funded, so there is still income. The estimated relevant annual turnover attributable to the use of the trade mark UK00002449776 within the regions traded in are as follows:

2014 - £4,950,485
2015 - £3,872,947
2016 - £3,915,650
2017 - £4,479,214
2018 - £5,115,376
2019 - £7,856,844"

I note that it is not possible to say what proportion of the 2014 and 2019 figures fall within the relevant periods.

53. The evidence of annual turnover in respect of funded residential places is the only quantifiable evidence offered by Party A and it is not broken down further. For example, there is no statement as to how many places were funded and hence what the revenue per place was. While there is no information supplied as to the size of the market, market share, or advertising expenditure, the revenue in each of the years quoted is considerable.

54. Party A has a .uk website and there is some corroborating evidence as to geographical location which bears out Shabir Ali's answer to Question 4 on the Form TM7F.

55. The evidence that is supplied is scant in respect of how many users of Party A's website there are and the extent of distribution of Party A's posters and Statement of Purpose documents. However, there is sufficient evidence to show that information about Pathways children's homes and the approach to the care delivered in those homes is publicly available.

56. Looking at the evidential picture as a whole (and bearing in mind that I can only consider such evidence as falls within the relevant periods), I am satisfied that Party A has demonstrated genuine use of its marks within the UK. Its revenue is considerable and is consistent across the relevant periods, albeit the corroborating evidence of its children's homes being promoted on the market is modest. Party A's use of its marks is clearly more than merely token use. I consider there to be real commercial exploitation of the marks on the market for at least some of the relevant services, about which I go into more detail below. The use shown is in accordance with the commercial *raison d'être* of the marks i.e. the use creates or preserves an outlet for the services that bear the marks.

Fair specification

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

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

58. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation 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].

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."

59. Reminding myself that I can only consider evidence that falls within the relevant periods, the use of the marks that Party A has shown is relatively narrow by comparison with the expansive list of services that it seeks to rely upon. The use shown centres upon children's homes and the approach to the care delivered in those homes, and does not extend, for example, to education and training in general. The evidence shows that training outside of the children's homes is carried out under the "CARE 2 SUCCEED" brand. There is, however, evidence that children are prepared for independent living in Pathways children's homes.

60. There is no evidence that any residential family care centres or temporary accommodation is operated under the Pathways or Pathway brands. While

there is evidence of children being prepared for supported living within the children's homes, there is no evidence of supported housing being provided under the Pathways or Pathway brands. The evidence available shows that care settings other than children's homes are operated under the banner of Progressive Care rather than Pathways or Pathway. For example, Progressive Care units are listed on page 1 of Exhibit 11. Only the children's homes – Sheffield and Stalybridge – are badged as Pathways® establishments. The remaining units listed – “Handsworth (Bridging Support)”, “Crimicar Lane (Bridging Support)” and “Woodside (16+ provision) are not badged in that manner.

61. The only quantifiable evidence relates to the funding of residential places, for which there is corroborating evidence for children's homes. There is no evidence of any standalone, specialised services being commissioned separately under the marks. However, there is some evidence that some specialised services are offered within the children's homes. In respect of lifestyle counselling there is support available in relation to healthy lifestyles and encouragement to live according to structures and routines. The evidence also shows that Pathways children's homes accommodate children with moderate learning difficulties.

62. The evidence supports the scenario of the average consumer – a local authority – purchasing places in Pathways children's homes. They will have had sight of information showing children's homes, branded as Pathways children's homes which use Pathway plans to document children's progress through the care system. Consequently, the average consumer would describe Pathways and Pathway as brands for children's homes and the services offered within them.

63. I consider a fair specification for Party A's marks to be:

- Class 41 Provision of residential training in independent living skills, and the assessment of associated competencies, capabilities and risks.
- Class 43 Provision of children's homes.
- Class 45 Lifestyle counselling, social work services namely providing counselling, care and support to children in care, young people leaving care, children and young people at risk and young people with learning disabilities, and the assessment of competencies, capabilities and risks of the aforesaid persons.

Case law

64. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. That is why this decision continues to make reference to the trade mark case-law of EU courts.

65. 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:

(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 greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the services

66. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. 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 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.”

67. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

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

68. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... 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.”

69. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the

following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

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

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

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

(4) A term which cannot be interpreted is to be disregarded.”

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

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for 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.”

71. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v 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 the responsibility for those goods lies with the same undertaking.”

72. 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.”

While 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.”

73. The services in question are as below.

Party A's services	Party B's services
<p><u>Class 41</u> Provision of residential training in independent living skills, and the assessment of associated competencies, capabilities and risks.</p>	<p><u>Class 41</u> Education; providing of training; entertainment; sporting and cultural activities; publishing services; production, organisation and management of conferences, seminars, workshops, exhibitions and events for educational or cultural purposes; non-downloadable publications; information, consultancy and advisory services relating to all the aforesaid services.</p>
<p><u>Class 43</u> Provision of children's homes.</p>	<p><u>Class 43</u> Temporary accommodation; services for providing food and drink; supplying meals to the homeless or underprivileged; Providing information and advice on issues concerning temporary housing; information, consultancy and advisory services relating to all the aforesaid services.</p>
<p><u>Class 45</u> Lifestyle counselling, social work services namely providing counselling, care and support to children in care, young people leaving care, children and young people at risk and young people with learning disabilities, and the assessment of competencies,</p>	<p><u>Class 45</u> Providing legal information and advice on issues concerning homelessness and welfare.</p>

capabilities and risks of the aforesaid persons.	
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Class 41

74. Training being a form of education, Party B's "Education" and "providing of training" are *Meric* identical to Party A's "Provision of residential training in independent living skills ... " in that the service designated by the earlier mark is included in the more general categories designated by the trade mark application.

75. I compare Party B's "production, organisation and management of ... seminars, workshops, ... for educational ... purposes" with Party A's "Provision of residential training in independent living skills ... ". Residential training is a type of education and could be provided in the form of a seminar or workshop. As such, the respective services overlap to an extent in terms of nature, purpose, users, and method of use. Admittedly, educational seminars and workshops cover a much broader range of activity than residential training in independent living skills. The respective services would share trade channels. The services would be in competition where independent living skills training was sought, but they are not complementary because residential training could be delivered in a formal trainer-to-trainee classroom setting without recourse to seminars or workshops. I consider the respective services to be of medium similarity.

76. I compare Party B's "production, organisation and management of conferences, ... exhibitions and events for educational ... purposes" with Party A's "Provision of residential training in independent living skills ... ".

While the services share an educational purpose, Party B's services are all activities that would take place externally rather than on a residential basis and so they are different in terms of their nature and method of use. Their users may also differ as between trainees consuming training directly and conference, exhibition and event goers, and the trade channels would be relatively divergent. The respective services are only in competition to a very limited degree where a consumer was choosing between education in independent living skills in a residential training environment and such education being imparted via a conference, exhibition, or event. The services are not complementary. I consider the level of similarity of the respective services to be low.

77. Party B's remaining Class 41 services are "entertainment", "sporting and cultural activities", "publishing services", "production, organisation and management of conferences, seminars, workshops, exhibitions and events for ... cultural purposes", and "non-downloadable publications". In respect of nature, purpose, methods of use, users, trade channels, and competition and complementarity, they do not have enough in common with Party A's training service, children's homes service, or counselling, care and support services for children and young people, for there to be a finding of anything other than dissimilarity.

Class 43

78. Party B's "Temporary accommodation", by comparison with Party A's "Provision of children's homes", is a broad category of accommodation that caters for a wide group of users, from members of the public on holiday to those with a social need. Although children's homes could be used by children and young people on a temporary basis, they are generally used for medium or long-term accommodation. Consequently, while the services share the same broad nature, purpose, and methods of use, they differ in respect of the typical user and the usual length of occupancy. While temporary accommodation might be commissioned collectively, by a social housing agency for example, it is generally purchased by individual members

of the public. On the other hand, places in children's homes are usually purchased by local authorities rather than individual members of the public. On that basis, the trade channels for the respective services differ. The services are only in competition to the extent that someone seeking to place a young person at short notice might utilise temporary accommodation or a children's home. The services are not complementary. Overall, I find the respective services to be of low similarity.

79. I consider Party B's "Providing information and advice on issues concerning temporary housing" to be dissimilar to Party A's "provision of children's homes". The former is an advice service targeted at adults, whereas the latter is the provision of physical premises for the accommodation and care of children and young people. However, by comparison with Party A's "... social work services namely providing ... support to ... young people leaving care", there are potential overlaps. One of the main issues for young people leaving care is finding housing, so support could take the form of housing advice. However, Party A's service is one of general emotional and practical support, whereas Party B's service is one of advice on a specific issue, namely temporary housing. As both services have a social dimension, there could be an element of convergence in terms of trade channels. The services are only in competition where care leavers are involved, and they are not strictly speaking complementary. Overall, I find the services to be of low similarity.

80. While food and drink are provided in children's homes, Party A does not seek protection for any form of catering service such as Party B's "services for providing food and drink". The connection between the respective services is too tenuous for there to be a finding of anything other than dissimilarity. By the same token, the target recipients of Party B's "supplying meals to the homeless or underprivileged" are in a different category of social need from the inhabitants of children's homes which are generally funded by the state. I also find this service to be dissimilar.

Class 45

81. Party B's "Providing legal information and advice on issues concerning homelessness and welfare" and Party A's "... social work services namely providing ... support to ... young people leaving care" potentially overlap. Avoiding becoming homeless and access to benefits are key issues for young people leaving care is finding housing, so Party A's support could take the form of advice on those matters, albeit it would not be as authoritative as Party B's legal advice. However, Party A's service is one of general emotional and practical support, whereas Party B's service is one of advice on specific issues, namely homelessness and welfare. As both services have a social dimension, there could be an element of convergence in terms of trade channels, albeit formal legal advice may be ringfenced in how it is advertised. The services are only in competition where care leavers are involved, and they are not strictly speaking complementary. Overall, I find the services to be of low similarity.

82. As some degree of similarity between the services is required for there to be a likelihood of confusion², the opposition must fail in respect of the following services in Party B's specification:

Class 41 Entertainment; sporting and cultural activities; publishing services; production, organisation and management of conferences, seminars, workshops, exhibitions and events for cultural purposes; non-downloadable publications; information, consultancy and advisory services relating to all the aforesaid services.

Class 43 Services for providing food and drink; supplying meals to the homeless or underprivileged; information, consultancy and advisory services relating to all the aforesaid services.

² *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

The average consumer and the nature of the purchasing act

83. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

84. When considering the competing services, the average consumer of education and training – being a college or institution – would pay attention to course content and how the course was delivered, as well as cost. They would pay a medium level of attention during the purchasing process.

85. In purchasing education and training, visual factors would predominate with a physical or virtual course catalogue being viewed. Verbal factors would play a minor role.

86. Obtaining temporary accommodation would require the average consumer – either a member of the public or housing agency – to consider such factors as the amount of the rent and the quality of the accommodation. Although the purchase would be for a relatively short period of time, it would still require a medium level of attention.

87. Scrutiny of the temporary accommodation service offered would usually be via visual inspection of a website and hence visual factors would predominate during the purchasing process. I do not, however, rule out verbal elements playing a part.

88. The average consumer for children's home places would be a local authority. They would pay attention to the characteristics and facilities offered by the home and would enter into a contract for such a purchase. Given the investment of public funds involved, and that the service involves the welfare of children, the level of attention paid would be high.

89. The assessment of a children's homes company and contract negotiations would require face-to-face meetings. While the scrutiny of paperwork during these meetings would involve visual considerations, verbal factors would play an important part.

90. Procuring support for care leavers, or a wider group who needed support in the form of specific advice on temporary housing, homelessness, or welfare, would require the average consumer – an institution or charity – to carefully consider the nature of the support or advice package being offered. The average consumer would also pay attention to price. Overall, a medium level of attention would be paid.

91. In respect of support and advice packages, a purchase would begin with online research where visual considerations would predominate, verbal factors playing a minor role.

Comparison of the trade marks


92. 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 the marks, 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*, 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.”

93. 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.

94. The respective marks are shown below.

Party A's trade marks	Party B's trade marks
<p style="text-align: center;">Pathways Pathway</p>	<p>Party B's 351 mark:</p> <p style="text-align: center;">PATHWAY</p>
	<p>Party B's 600 marks:</p> <div style="text-align: center;">  </div>

Lead case: OP600001273

95. This case involves Party A's 351 mark. I will compare this mark with the singular form of Party B's series of two – "Pathway" – that being the stronger of Party B's two marks.

96. Party B's opposition is reliant upon sections 5(1) and 5(2)(a) of the Act. For these grounds to succeed, the respective marks must be identical and so I will assess whether they are identical within the meaning of the Act and case law.

97. In *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union ('CJEU') held that:

"54 ... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

98. The marks are word marks consisting of one word, "Pathway"/ "PATHWAY". Party A's trade mark capitalises the initial letter of the word, while Party B's mark is fully capitalised. Considering that point, I refer to Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14:

"It is well established that a 'word mark' protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks ... A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or handwriting as opposed to print) from that which appears in the Register whilst remaining 'identical' to the registered mark."

99. Bearing the above in mind, the marks are identical.

Second case: OP600001274

100. This case involves Party A's 600 marks. I will compare these marks with the singular form of Party B's series of two – "Pathway" – that being the stronger of Party B's two marks.

101. Party A's mark consists of the plain word "Pathway". This is the only thing that forms the overall impression of this mark.

102. Party B's marks are a series of two figurative marks. The word "pathway" is shown in black text on a white background in the first of the series, with white text on a black background being the layout for the second of the series. In both marks, footprint motifs overlay the letters "h" and "y". The word itself contributes strongly to the overall impression and, while the black-on-white/white-on-black stylisation makes a negligible contribution, the footprint motifs have a role to play.

103. Visually, the words "Pathway" and "pathway" are virtually identical, the only variation being the casing. Party B's marks have footprint motifs which are absent from Party A's mark. While this, and the minor stylisation of Party B's marks constitute differences, I still consider the marks to be visually similar to a high degree when bearing in mind the overall impressions of the marks.

104. Aurally, the comparison is between Party A's "Parth-way" and Party B's "parth-way". The respective marks are aurally identical.

105. Conceptually, a pathway is, according to the Collins online dictionary "a path which you can walk along". The footprint motifs in Party B's marks simply reinforce this concept. The respective marks are conceptually identical.

Distinctive character of the earlier mark

106. 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).”

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

108. The word “Pathway” is a dictionary word. It is only mildly allusive of Party A’s services in that people can be said to metaphorically navigate their

way through the care system. I find the earlier mark to be inherently distinctive to a medium degree.

Likelihood of confusion

109. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of Party A's trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

110. I note that Party B filed evidence in the form of a witness statement and Exhibit PH1 which seeks to show "that the terms 'PATHWAY'/'PATHWAYS' are commonly used in the UK, in actual commerce and by the relevant public". Party B seeks to show that the terms in question are so widely used by traders in the relevant marketplaces that they are effectively seen by the relevant publics as descriptive of the services at issue.

111. The evidence consists of 13 websites whose organisational names include the word "pathways" or "pathway". These organisations could be said to offer services in the broad categories of service which are at issue in this case.

112. While some of the websites provide general information as to the organisations' size and geographical reach, there is no concrete evidence provided about the extent of commercial use that these traders have made of the terms in question, nor of the significance that these traders have in the relevant marketplaces. Furthermore, the website printouts appear to be contemporaneous with the date of submission of the evidence – 3 October 2022 – and they therefore post-date the relevant periods.
113. I do not consider this to be evidence that the words “pathways” and “pathway” are so widely known in the context of the relevant marketplaces that average consumers see them as effectively descriptive of the services at issue and that therefore Party A's marks do not warrant protection.
114. Earlier in this decision, (except where I have found the services to be dissimilar), I found that the services are either identical, or of medium or low similarity. I have found the earlier mark to be of medium inherent distinctiveness.
115. The average consumer for children's home places (one of Party A's services) would be a local authority paying a high level of attention during the purchasing process. With scrutiny of contract paperwork and face-to-face meetings, visual considerations would be involved, but verbal factors would also play an important part.
116. The average consumer of the parties' education and training services – a college or institution – would pay a medium level of attention during the purchasing process, with visual factors predominating. The same level of attention and balance between visual and verbal factors would apply to purchasers of temporary accommodation (an applied-for service), where the average consumer would be a member of the public or housing agency. The same also applies to the purchase of the parties' support and advice services, whose average consumer would be an institution or charity.

Lead case: OP600001273

117. In this case, the applied-for mark is Party B's 351 mark, and I have found that the respective marks are identical. Party A's section 5(1) claim is successful for those of the parties' services that I have found to be identical.

118. Bearing in mind the interdependency principle, the fact that the marks are identical is a significant factor in my multi-factorial assessment and I find that confusion is engaged even where the parties' services are of a low level of similarity (there is no minimum threshold level of similarity between the services that must be shown as it is sufficient that some similarity exists in order to consider the likelihood of confusion³).

119. Notwithstanding the level of attention paid during the purchasing process, which is medium or high, Party A's section 5(2)(a) claim succeeds for those services that I have found to be of medium or low similarity. I find that there is a likelihood of direct confusion.

Second case: OP600001274

120. In this case, the applied-for marks are Party B's 600 marks and I have found the respective marks to be visually similar to a high degree, and to be aurally and conceptually identical. On the words alone, the marks are identical. This is a significant factor in my multi-factorial assessment. The black-on-white/white-on-black stylisation of Party B's marks is negligible and the conceptually reinforcing footprint motifs in Party B's marks could very easily be mis-recalled by the average consumer as belonging to Party A. Even where the services are of a low degree of similarity and taking account of the medium or high level of attention paid during the purchasing process, I find that there is a likelihood of direct confusion.

³ See *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

121. If I am wrong, and the average consumer was to correctly attribute the footprint motifs to Party A's marks, they would consider these marks to be brand variations of Party B's mark. There would then be a likelihood of indirect confusion.

122. Except for those services that I have found to be dissimilar, Party A's section 5(2)(b) claim succeeds.

CONCLUSION

123. Subject to appeal, in regard to both the lead case (OP600001273) and the second case (OP600001274), the opposition succeeds in relation to the following of Party B's contested services:

Class 41 Education; providing of training; production, organisation and management of conferences, seminars, workshops, exhibitions and events for educational purposes; information, consultancy and advisory services relating to all the aforesaid services.

Class 43 Temporary accommodation; Providing information and advice on issues concerning temporary housing; information, consultancy and advisory services relating to all the aforesaid services.

Class 45 Providing legal information and advice on issues concerning homelessness and welfare.

124. The applications proceed to registration for the following of Party B's contested services:

Class 41 Entertainment; sporting and cultural activities; publishing services; production, organisation and management of conferences, seminars, workshops, exhibitions and events for

cultural purposes; non-downloadable publications; information, consultancy and advisory services relating to all the aforesaid services.

Class 43 Services for providing food and drink; supplying meals to the homeless or underprivileged; information, consultancy and advisory services relating to all the aforesaid services.

125. The applications proceed for Party B's uncontested Class 16, Class 36, Class 42 and Class 44 goods and services.

COSTS

126. In terms of the contested services, the parties have had a roughly equal level of success and so they will each bear their own costs.

Dated this 13th day of March 2023

JOHN WILLIAMS
For the Registrar