

TRADE MARKS ACT 1994
CONSOLIDATED OPPOSITIONS

Application No.	Mark	Applicant	Opponent(s)	Opposition No.
2219853	Reed Online	Reed Employment Ltd	Reed Elsevier Group plc & Reed Business Information Ltd	51136
2280946A	Reed	Reed Executive plc	Reed Elsevier Group plc	92384
2270582	Reed Business Information	Reed Business Information Ltd	Reed Executive plc & Reed Employment Ltd	92625
2280946B	Reed	Reed Executive plc	Reed Exhibitions Ltd & Reed Business Information Ltd & Reed Elsevier Group plc	96866 96867 96868
2399702	Reed	Reed Executive plc	Reed Elsevier Group plc & Reed Business Information Ltd	94050 94052

1. These proceedings concern five trade mark applications. Three are by Reed Executive Plc. The fourth is by Reed Employment Limited, which is a subsidiary of Reed Executive plc. The fifth application is by a wholly unrelated business: Reed Business Information Limited, which is a subsidiary of Reed Elsevier Group plc. The main business of Reed Executive/Reed Employment is the operation of a national chain of employment agencies. The Reed Elsevier Group is primarily a provider of various forms of business information, including the organisation of exhibitions.

2. The four applications made by Reed Executive and its subsidiary company face seven oppositions brought by Reed Elsevier and other companies in the same group of companies. The fifth application, made by Reed Elsevier, is opposed jointly by Reed Executive and Reed Employment.

3. The oppositions have been consolidated and this decision covers them all. I have taken account of all the evidence before me whether or not it was filed in relation to individual oppositions prior to their consolidation.

4. It will be appreciated from the above that the names of a lot of the companies in these proceedings include the word 'Reed'. In the interests of convenience and clarity I will refer to the companies in the Reed Executive group, collectively, as 'Executive' and the companies in the Reed Elsevier group, again collectively, as 'Elsevier', except where it is necessary to distinguish between the individual members of the two groups of companies.

5. I come to the specific grounds of opposition below, which are numerous. To assist understanding, this is a broad indication of the parameters of the dispute. Firstly, there is a dispute as to whether Executive's applications in Class 35 to register REED marks (in which I here include marks containing REED) for recruitment services covers, or is in conflict with, Elsevier's earlier registration and use of REED marks for advertising and/or publishing services, which includes the publication of job advertisements. The parties have locked horns before over this matter in the context of Executive's earlier infringement proceedings, which culminated in the judgment of the Court of Appeal reported at [2004] RPC 40. However, the parties are agreed that whilst this judgment is relevant, it is not decisive of any part of the dispute in these oppositions.

6. Secondly, there is a dispute as to whether the Executive's applications to register REED for education and conference services (and similar services) conflicts with any enforceable earlier marks or rights that Elsevier has under marks containing the word Reed for education and exhibition services (and similar services) having regard to Executive's own use of Reed for education services.

7. Thirdly, there is a dispute as to whether the Executive's application to register REED for legal services and various related services conflicts with any enforceable earlier marks or rights that Elsevier has under marks containing the word REED for legal, or legal information, or publishing services.

8. Fourthly, there are a number of disputes as to whether there is any conflict and/or which side has priority when it comes to the registration of REED marks for various goods and services which relate to the parties main fields of activity, such as

electronic publications, printed matter and providing access to electronic data databases.

9. An unusual aspect of these consolidated proceedings is that they include three marks that were published a very long time ago and therefore precede the proof of use requirements introduced on 5th May 2004. The other two marks were published more recently and are subject to the proof of use requirements. The result is a rather complicated and unsatisfactory position whereby the outcome of Executive's four applications depends partly on when they were published.

10. The long delay in resolving some of these oppositions was caused by stays of proceedings that the parties agreed at various times. In retrospect, these went on far too long. Seven and a half years in the case of the oldest application. Indeed if it had not been for a case management conference initiated by the Office in April 2009 and the imposition of consolidation and a strict timetable it is likely that some of the oppositions would have dragged on even longer. Apart from the extreme delay, the 'slow-stop-keep separate' approach to litigation must have greatly increased the costs of the parties, as can be seen from the mountain of overlapping/duplicate evidence filed in these cases.

WHAT THE EVIDENCE SHOWS

Executive's evidence

11. Executive's principal evidence comes from Andrew Abernathy and Joan Edmunds, who are lawyers employed by Executive. Mr Abernathy's witness statement is dated 3 December 2008. Ms Edmunds's witness statement is dated 17 July 2009.

12. According to this evidence, Executive's business was started in 1960 by Alec Edward Reed. The core business is, and always has been, employment agency and recruitment services. That business is conducted under the name REED. Until 1995 the business was conducted solely through a chain of high street employment agencies. By 2001, there were around 300 branches throughout the UK. From 1995 there has also been a web site.

13. Ms Edmunds explains that the principal users of Executive's core services are employers, other recruitment agencies (who she describes collectively as "clients") and work seekers ("candidates"). The essence of the service is matching work seekers to suitable employment opportunities. The services offered to clients and candidates are described like this:

"[Executive] advises clients on the best medium for advertisement, assists in the preparation of the initial advertisement and manages advertising campaigns. [Executive] offers recruitment response management and can handle the assessment of potential candidates, the selection of candidates and the conduct of skills based and psychometric tests."

"[Executive searches for and matches Candidates to temporary and permanent positions. In addition [Executive] offers services to candidates such as interview

training, compilation of CV training and assistance with negotiation of terms of engagement.”

14. Ms Edmunds also provides turnover figures for Executive’s services under the mark REED. These cover the period 1975-2000. They show that Executive’s turnover in 1975 was around £10.5m, rising to £26m by 1984, to £115m by 1994, and to £372m by 2000.

15. As one would expect with a business of this size, Executive has spent a large amount of money promoting its services. It has advertised in publications (including some of Elsevier’s that it relies upon to show use of REED in relation to [job] publication/advertising services), mail shots, attending exhibitions, sponsorship and (in 2000) TV advertising. According to Mr Abernathy, Executive spent around £2.5m promoting its services in 1995, but this rose to nearly £12m in 2000.

16. Ms Edmunds gives evidence that:

“As well as [Executive’s] core business in the provision of employment agency, recruitment and related services, [Executive] also provides education and training services and since 1998 welfare to work programmes.”

17. According to Ms Edmunds,

“In addition to its core recruitment and employment agency services, Reed has also provided education and training under the REED trade mark for over 30 years. Reed Business School was formed in 1972 by the founder of Reed, Alec Reed. It was initially known as the Reed College of Accountancy. In 1989 the business of Reed College of Accountancy together with its goodwill was acquired by Reed Education Trust Limited and became known as Reed College. Reed College was jointly managed by Reed Executive Limited and Reed Education Trust Limited from 1992 to 1996, after which Reed Executive Limited took over sole management of Reed College. In 2000, Reed College changed its name to Reed Business School Limited (trading as 'Reed Business School') and Reed Education Trust Limited and its subsidiary, Reed Business School, used the REED trade mark with the consent of Reed Executive Limited. Appended hereto and marked Exhibit JE5 are details of the Reed Business School and its facilities together with reference to various courses offered, and an example of a copy invoice. The courses are offered on residential and non-residential bases and include courses in accountancy, business accounting, management accounts and financial planning. Similarly to the position in relation to the office network of the employment and recruitment business, the REED trade mark features prominently on all materials relating to the Reed Business School. In addition, Reed Business School invests significantly in advertising.

Reed has also provided education and training services formerly under the name Reed Training and since 2000 Reed Learning. Reed Learning offers a wide range of courses in subjects including marketing, law, accountancy, human resources, information technology, management, secretarial skills, sales, banking, finance, and customer services. Appended hereto and marked Exhibit JE6 are copies of two course directories which show the wide range of courses offered, two copy advertisements dated 2001, Internet reference to REED Learning and a table showing the number of "delegate days" for Reed Training Courses during the period 1997-2003. A "delegate day" is equal to one delegate attending a one-day training course.

Although it is difficult to provide annual sales turnover figures relating to the provision of education and training under the REED trade mark, I can confirm the figures from both Reed Training and Reed Business School for the period 2000 2003...”.

18. These are the figures provided:

	2000	2001	2002	2003
Reed Learning	£3,357,000	£5,221,000	£6,918,000	£7,800,000
Reed Business	£1,789,000	£1,567,000	£1,458,000	£1,670,714

19. Exhibits JE5 and 6 illustrate the educational services provided by Executive. The exhibits include ‘course directories’ from 1997 and 2002. Both directories carry the name ‘REED Training’. The name REED dominates the mark because it is larger than the word ‘Training’ and appears above it. The courses in the later directory are described under the headings ‘Personal Development’, ‘Management Development’, ‘Human Resources’, ‘Finance’, ‘Information Technology’, ‘Sales and Marketing’ and ‘Secretarial and Support Skills’. According to the client list on the back cover of the Directory, REED Training had 152 corporate clients in 2002.

20. The courses covered in the earlier 1997 brochure are of the same kind - vocational training for employees and managers. The courses offered at that time were fewer in number. A similar document is provided by Mr Abernathy. It is buried away in the middle of a thick exhibit called AA2. It shows that a similar range of courses (although fewer again in number) were being offered under the name REED Training between November 1995 and June 1996. This is consistent with the claim made on a web page published by Executive in 2002 (a copy of which is also included in exhibit JE5), which indicates that REED Training was established in 1993.

21. The final page of exhibit JE6 comprises a table showing the total number days spent by attendees at REED Training courses between 1997 and 2003. The figures for 1997-2000 are quite modest, in the 4-11k range. As courses are typically 1-2 days, that suggests about 3-8k trainees per annum. The figures for later years are a little larger, around 18k training days in 2002 rising to around 30k days by 2003.

22. From the description of the services provided under the name REED Learning in a copy of a web page taken in October 2002 (also in exhibit JE5), they appear to be those provided under the name REED Training plus various ancillary services, such as on-line learning.

23. Also included in JE5 is a copy of an invoice from September 1991 for a book keeping course held at Reed College of Accountancy that month. I note that this is two years after Ms Edmunds states that Reed College of Accountancy became Reed College. This suggests that the change of trading name was later than she claims. Another page also buried away in the middle of Exhibit AA2 to Mr Abernathy’s statement, does, however, show use of Reed College in January 1996. This is a copy of a communication addressed to delegates attending a ‘recruitment consultancy’ course.

24. A copy of a web page from October 2002 is also included in JE5 which describes Reed Business School. This includes a claim that the Business School had, by that time, acquired a reputation for professional qualifications (mainly accountancy, but also taxation and personal development) and business management training (as one would expect from a business school).

25. On the basis of this evidence, I find that:

- i) By the year 2000, Executive had a substantial reputation under the mark REED for employment agency and recruitment services.
- ii) Reed College of Accountancy was formed in 1972. It provided accountancy type educational services under that name up until at least September 1991.
- iii) Sometime between September 1991 and January 1996 the name was changed to Reed College and the scope of the educational services provided under that name was broadened.
- iv) In 2000, the name was changed again to Reed Business School which provided courses to acquire business related qualifications, such as accountancy and taxation, as well as management training.
- v) REED Training was established in 1993 and sometime between then and November 1995, Executive started to offer vocational training for employees and managers under this name.
- vi) Similar services were provided from 2000 under the name REED Learning.

26. I have not overlooked the evidence of Jackie Johnson (a Trade Mark Attorney working for Executive's agents) and Ken Baker (a market research specialist). However, as Mr St Quintin placed no reliance on this evidence at the hearing, I do not think that I need to go into the detail of it. Suffice it to say that Ms Johnson's evidence was a minor bit of internet research about the meaning of 'recruitment advertising'. Mr Baker's evidence introduced the results of two internet based omnibus surveys designed to test the public's reaction to the word REED. Omnibus surveys are wholly unsuitable for use in legal proceedings for reasons which are well documented. See, for example, the explanation I gave in *Vivat Holdings Limited v Levi Strauss & Co*, O/154/02. Conducting such surveys via the uncontrolled medium of the internet introduces a further level of difficulty.

Elsevier's evidence

27. Elsevier's principal evidence comes in the form of witness statements by Jane Moore, Mark Kelsey and Jackie Poole. Because the evidence was filed prior to the consolidation of the opposition proceedings, there are several versions of each statement in evidence. There are five versions of Jane Moore's statement. Many carry the same date. There are a few differences between these statements. In order

to make it clear which version of the statement I am referring to, I will include the original opposition number the first time I mention it. There is also a great deal of duplication (although again not complete duplication) of the supporting exhibits. Even with this duplication removed, the exhibits occupy 8 ring binders.

28. Ms Moore is a solicitor and senior legal advisor to Elsevier. Her statements are dated 8 December 2008 and 26 January 2009. They provide a history and an overview of Elsevier's commercial activities. The following is taken from the version filed in connection with opposition No. 92384.

29. Ms Moore states that prior to a merger between Reed International Plc and Elsevier NV on 1 January 1993, companies owned by Reed International Plc *“used the trade mark REED in relation to at least printed publications, business information services, education and training services and the arranging and conducting of exhibitions”*.

30. Ms Moore provides (as exhibits JM4a and JM4b) copies of Elsevier's Annual Reviews between 1995 and 2001 in order to demonstrate the range of corporate activities since the merger in 1993. These reviews are aimed at those who have a financial interest in the Elsevier group. The 1995 Review states that:

“REED ELSEVIER is a world leading publisher and information provider. Its activities include scientific, professional, business and consumer publishing”.

31. The Review indicates that Elsevier's main markets are in North America and Europe. Pages 19-21 of the Review describe Elsevier's activities under the name Reed Reference Publishing, which is described as *“one of the world's leading publishers of reference information for the library, legal, bookseller and professional markets”*. Reed Reference Publishing is said to operate through six businesses, most of which are in the USA. The UK based business is said to be conducted through a company called Bowker Saur, which publishes, inter alia, New Scientist.

32. Reed Educational and Professional Publishing is another division of Elsevier. The Review says that it was formed in 1995. It is described as *“the leading publisher for the UK primary and secondary school market”*. It appears to operate under names such as Ginn's, Heinemann and Butterworth-Heinemann. Several of the publications these companies produce are shown in the Review. None carry the name REED.

33. Reed Information Services is another division. It is described as *“a leading provider of business information in both printed and electronic forms, with operations in the UK, North America and Asia/Pacific”*. It appears to have operated in the UK under the names Kompass and Kelly's. Two publications are shown in the Review. Ms Moore says that the name REED is clearly shown on the spine of one of the publications called 'The Banker's Almanac', which is aimed at the international banking market. I can see the mark Kompass on the front of the publication, but on the copy of the exhibit filed at the IPO it is not possible to make out any of the words on the spine.

34. Ms Moore also draws my attention to the division of Elsevier called Reed Business Publishing. It is said to have published 56 different titles in the UK in 1995, including Estates Gazette, Computer Weekly and Flight International. Copies of the covers of these publications are illustrated in the Review. None appear to bear the mark REED. The same point applies to Reed Consumer Books, which is “a UK based consumer book publisher”. Again, the covers of three of its books are reproduced in the Review. Again, there is no sign of the name REED.

35. Ms Moore points out that ‘legal’, ‘education’ and ‘business’ are identified as primary areas of interest to Elsevier in the 2000 and 2001 corporate reviews. This is so, but always in the context of Elsevier’s business as an information provider. Further, the extent of the use in the UK of the mark REED in relation to any of these services is unclear. For example, the publication of legal information appears to have been conducted under the name Butterworth’s Direct until 2000, and then Lexis-Nexis.

36. Finally, Ms Moore provides (as exhibit JM11) a copy of a witness statement made by Paul Sissons, the Head of Reed Business Information Limited in 2001. The only point I need to record from Mr Sisson’s statement is that Executive placed job adverts with Elsevier up until June 2000, including some posted on Elsevier’s Totaljobs web site, which was the subject of the earlier litigation between the parties.

37. Mr Kelsey is the Chief Operating Officer of Reed Business Information Limited (RBI). There are two similar statements from him dated 8 December 2008. The following is taken from the statement he filed in relation to Opposition No. 51136. Mr Kelsey says that by 2001 RBI was the UK’s largest business-to-business magazine and directory publisher with a portfolio of over 100 market leading magazines, directories and online services and an annual turnover of £260m. Similar turnover figures are given for 1997-2000. Circulation figures for these publications are provided as exhibit MVK1. These show that the individual publications were circulated to between 1000 and 108,000 people within the UK, mostly on a weekly basis.

38. Mr Kelsey states that the REED BUSINESS INFORMATION name appears frequently in and on these publications. Some examples are provided as MVK3. These include New Scientist and Motor Transport. These show the above name and REED BUSINESS PUBLICATION being used in small font and mostly accompanied by a device element, usually under the editorial details on the inside page. The words are so small in some of the examples that one could easily overlook the name. In a couple of cases the names REED BUSINESS INFORMATION (accompanied by a device) and REED BUSINESS PUBLICATION appear on the front cover. In both cases the names are tiny, both in absolute terms and relative to the size of the name of the publication. They are not easy to spot, even when looking for them.

39. The examples in evidence are from November and December 2008 (i.e. after any potentially relevant date in these proceedings). However, Mr Kelsey says that he understands that the format has not changed since 2001 and that these can, therefore, be taken as representative of the use of REED BUSINESS

INFORMATION. (I note that he does not say the same about the single instance of use shown of REED BUSINESS PUBLICATION)

40. There is evidence (exhibit MVK6) that the mark REED BUSINESS INFORMATION (with the same device) was used between 1998-2001 to promote exhibitions on hairdressing through a magazine called Hairdressing Journal.

41. Mr Kelsey says that revenue from recruitment advertising is very important to RBI as a publisher. Between 2005 and 2008 it provided income of around £40m per annum. An increasing proportion of this was as a result of online advertising. Mr Kelsey says that, by way of example, over a third of the content of New Scientist is devoted to recruitment advertising.

42. Mr Kelsey produces (as exhibit MVK5) examples of promotional material for the SED construction industry exhibition for its annual events between 1992-1999. This material bears the name Reed Business Publishing (again with a device), and appears to have been used to attract job advertisements for an RBI publication called Contract Journal, which is a popular magazine in the construction industry. This material is clearly aimed at potential advertisers. There are examples of similar promotional material from 2000 and 2001, which does not appear to be related to the SED exhibition. The name of the magazine features prominently in this material. However, it also bears the marks REED BUSINESS INFORMATION & device and also REED CONSTRUCTION. It is clear that RBI was in each case offering advertising space in the Contract Journal magazine.

43. Exhibits MVK8 and 9 to Mr Kelsey's statement consist of some advertisements offering advertising space in RBI's publications on a 'buy-2-get-1-free' basis. Again what is being offered is advertising space. The advertisements carry the mark Reed Business Information alongside the device mentioned above. The adverts in evidence are from 2004/5, but Mr Kelsey says that they are typical of similar advertising undertaken prior to 2001. These advertisements were produced in connection with one or more of RBI's printed publications, but it is not clear whether they were distributed through the publications themselves or by some other means. Again, they are plainly directed at potential advertisers.

44. Mr Kelsey identifies RBI's recruitment advertising customers as falling into three categories. Firstly, employers; secondly, employment agencies; and thirdly, recruitment advertising agencies, who place advertisements on behalf of both employers and employment agencies.

45. Ms Poole is a lawyer and the Company Secretary of Reed Exhibitions Limited. She filed three similar witness statements. In the version Ms Poole filed in support of opposition No. 96866 she describes the history of Reed Exhibitions Limited like this.

"Reed Exhibitions Limited started out as "Bridges Exhibitions Limited", incorporated on 21 December 1960 in the United Kingdom under Company Registration no. 678540. In 1963, Bridges Exhibitions Limited underwent a change of name to "Industrial and Trade Fairs Holdings Limited". Forty percent of the company was acquired by Reed Business Publishing Limited, a wholly-owned subsidiary of Reed International Ltd, (now Reed Elsevier Plc). In 1983, Reed Elsevier Plc acquired the remaining sixty percent of industrial and Trade Fairs Holdings Ltd which was

renamed Reed Worldwide Exhibitions. On 1 April 1987, the company name was changed to "The Reed Exhibition Companies Limited" as indicated on the Certificate of Incorporation and, finally, to Reed Exhibitions Limited on 8 January 2002 as indicated on the Certificate of Incorporation".

46. The turnover figures for exhibitions held in the UK are large. Between 1994 and 2001, the annual turnover of Reed Exhibitions limited was between £22m and £36m per annum. Ms Poole describes the use of the REED EXHIBITIONS trade mark in relation to these exhibitions like this.

"Every year. Reed Exhibitions runs more than four hundred and seventy events in thirty seven countries. This year we are running twenty five exhibitions in the United Kingdom and most of these shows, including "World Travel Market", "Interplas", "Inspex", "IJL", Interphex", "100% Design", "Infosecurity" and "The London Book Fair", were running pre-2001. The "Reed Exhibitions" name has always featured prominently at our shows, on the related exhibition websites and the home website, and on materials for all of the exhibitions, as can be seen from the examples provided at Exhibits JP3, JP4, JP6, JP11 and elsewhere. As well as being our company name. REED EXHIBITIONS also functions as a trade mark, as did our former name REED EXHIBITION COMPANIES, establishing the clear and exclusive link between the Reed Exhibitions name and our exhibitions and events".

47. Exhibit JP3 consists of copies of web pages from the web site at reedexpo.co.uk. Most of the pages carry a copyright date of 2005. The first page is entitled "Welcome to Reed Exhibitions", which is described as "The world's leading organiser of trade and consumer events". Other pages entitled "About Reed Exhibitions" and "Our Markets" provide further information about the company and the wide range of markets in which it organises exhibitions.

48. I do not find exhibits JP4 and 6 to be of much assistance because the material they contain is either dated after any possibly relevant date, or does not bear the mark REED, or both. Nor do I do find exhibit JP11 of any assistance. This consists of copies of Reed Exhibitions Companies newsletters from 1990-95. Ms Poole gives no evidence as to where they were sent, so they could be internal. In any event, they do little to show that the name REED was used publicly in relation to the exhibitions (as opposed to just the company).

49. Exhibit JP12 is a little more helpful. It consists of copies of calendars of events, exhibition and conference schedules and show diaries for the years 1985-98 and 2000 and 2001. These documents list the UK events put on by Reed Exhibitions for each year. Again there is no evidence as to where these were sent, but they do appear to be in the nature of promotional material. For example, the 1985 document invites readers to get in touch with Reed Exhibitions for further information about the exhibitions listed. Some of the later ones carry the strap line "...reach your market through the Reed Exhibition Companies", indicating that they were aimed at potential exhibitors. The 1985 document shows use of REED EXHIBITIONS. The later ones show use of REED EXHIBITION COMPANIES, usually together with a device of a stylised globe. The latter combination of signs also appears in an 'Organising Manual' given to exhibitors at a World Travel Market exhibition held at Earl's Court in 1997 (a copy of which makes up exhibit JP10).

50. I do not accept that these exhibits show what Ms Poole says that they do: that *“The Reed Exhibitions name has always featured prominently at our shows, on the related exhibition websites and the home website, and on materials for all the exhibitions”*. Rather they show use of the name in relation a limited range of material mainly aimed at potential exhibitors.

51. Ms Poole provides a partial explanation for the relative paucity of contemporaneous evidence of external use of REED in relation to exhibitions. She states:

“Our exhibitions are promoted through direct mailshots, press releases and advertising throughout the UK. Reed Exhibitions has a dedicated sales team for each of its exhibitions, promoting them through extensive press and public relations campaigns. Whilst Reed Exhibitions does not retain a central archive of press releases going back as far as 2001, I have managed to locate from the Internet a number of press releases issued around the filing date of the current application i.e. from earlier that year or just after. I attach these at Exhibit JP7 herewith, together with a list and brief description of each”.

52. Exhibit JP7 consists of copies of third party press statements, mainly from two web sites called Electronicstalk and Engineeringtalk. These are dated 2001 and seem to pick up on press releases issued by Reed Exhibitions during that year. They identify Reed Exhibitions as the organiser of a number of exhibitions including NEPCON, INSPEX and MANUFACTURING WEEK.

53. There is also some third party evidence about Reed Exhibitions’ reputation as an organiser of exhibitions. Exhibit JP8 includes an extract from the web site of a market research firm called Key Note Limited. The extract consists of a report called *“Exhibitions and Conferences, March 2002”*. Reed Exhibitions is listed under *“Major Exhibition Organisers”*.

54. Exhibits JP13 and 14 consist of witness statements by Nigel Nathan and Philip Soar. Mr Nathan is the Managing Director of Earls Court and Olympia Group Limited. He has considerable knowledge within the exhibitions market. Mr Nathan gives evidence that Reed Exhibitions Limited has held exhibitions at his company’s venues for *“many years”* and that he would associate the name REED/REED EXHIBITIONS with that business.

55. Mr Soar is the Chairman of the Association of Event Organisers, which is the trade body for Event and Exhibition organisers in the UK. He has worked in this field for *“two decades”* and has a very good working knowledge of the relevant market. Mr Soar gives evidence that Reed Exhibitions has built up a *“significant reputation as the leading exhibition organiser in the United Kingdom, and indeed the World, over a period in excess of two decades”*.

56. According to Ms Poole,

“Reed Exhibitions’ travel division, Reed Travel Exhibitions, has organised a wide range of travel exhibitions, conferences and events for over twenty years and its flagship show is World Travel Market. [She] attach[es] at Exhibit JP6 extracts from the Diary of Events in the 2001 Route Planner Catalogue for Reed Exhibitions’ World

Travel Market Exhibition. This refers to forums, lectures and debates provided at the event as well as a specific "Seminar and Debate Programme" showing a typical range of educational and training services provided by Reed Exhibitions through its travel division Reed Travel Exhibitions. This programme was published by Reed Exhibitions in anticipation of the November 2001 "World Travel Market" conference in Earls Court, London".

57. It is striking that neither the mark REED, nor even the mark REED TRAVEL EXHIBITIONS, appear anywhere in exhibit JP6. The closest one gets to this is the use in a website address of 'travel.reedexpo.com'. In fact Ms Poole doesn't actually say that the seminars she mentions were provided under the mark REED TRAVEL EXHIBITIONS. The closest she gets to this is when she states that the "Seminars and Debates Programme" was published by Reed Exhibitions" (emphasis added).

58. Exhibit JP9 consists of a copy of a publication from 1995 by Reed Exhibition Companies entitled 'Making the most of trade exhibitions'. It is obviously directed at potential exhibitors. It is written by Tom Heinersdorff, who was the Managing Director of the company at that time. Ms Poole draws attention to two paragraphs from this publication under the heading 'Associated Events' as support for the proposition that exhibitions are commonly associated with educational activities. The paragraphs in question are shown below.

- (i) *"Educational forums are now common at exhibitions, and range from hour-long seminars to full blown conferences run over the three days of an exhibition. From an exhibitor's point of view, the former option is to be preferred. Short seminars held within the exhibition hall are ideal as they do not take visitors away from the exhibition floor, or lock them up for long periods of time. Format is not the only consideration, however. A seminar programme is only as good as its content and its speakers. If it is to genuinely attract visitors to an event, it must promise both to inform and inspire" and;*
- (ii) *"Show features which aim to educate or entertain visitors, without putting them under any pressure to buy, add to the perceived value of an event, and hence encourage visitors to attend. One such example is the 'advisory clinic', at which industry experts offer free, independent advice on specific areas of technology, or subjects of topical interest. For example, at a manufacturing event, they may help visitors with their queries on the BS 5750 quality standard, at a catering event they may advise on issues of health and safety, and so on."*

59. Messrs Nathan and Soar also provide some evidence on this point. Mr Nathan says that:

"I confirm that I would associate the name REED/REED EXHIBITIONS with a number of high profile exhibitions and events in the United Kingdom, which are held by Reed Exhibitions Limited. I am aware that in order to attract visitors, the exhibitions held by Reed Exhibitions at our exhibitions venue usually incorporate educational events such as seminars, workshops, talks or demonstrations, which relate to the subject field of the exhibition".

60. I note that Mr Soar does not say that seminars, workshops etc. he describes were held under the mark REED or REED EXHIBITIONS.

61. Mr Soar's evidence includes the following:

"Within my experience, it is perfectly normal in the United Kingdom for medium and large exhibitions of the type run by Reed Exhibitions to provide seminars, conferences and educational events on the specific (and related) subject matters of those exhibitions. Indeed, it would be the norm that they would do so.

For the whole period in which I have been involved in the exhibition and events business, being the two decades since 1989, Reed Exhibitions have always used the name "Reed Exhibitions" to brand their events".

62. I note that Mr Soar states, in terms, that Reed Exhibitions has always used that name to brand their "events". I think it is clear that he is there referring to exhibitions. Mr Soar does not say that REED EXHIBITIONS was used to identify the trade source of any educational services provided at these exhibitions.

63. Elsevier's evidence also includes witness statements from Nicola Amsel and Robert Perkins. Ms Amsel is a partner in a firm of private investigators who examined the web sites of the parties to these proceedings in November 2009 and provides a report on what she found. Neither side mentioned it at the hearing. The investigation seems too far after any possibly relevant date to shed any further light on the matters before me. Consequently, I need say no more about it.

64. Mr Perkins is the Chief Executive Officer of Totaljobs Group Limited, which is the principal vehicle for Elsevier's online recruitment advertising. Mr Perkins explains the background to the launch of this website and the development of Executive's own website. Mr Perkins describes the position in 1999 like this.

"The first TOTALJOBS website was put on-line in July 1999. The first version of the site was essentially aimed at protecting existing RBI titles and their recruitment advertising revenues rather than aggressively competing against the more established general job boards such as Monster. When I was appointed to make TOTALJOBS work, one of the things that most impressed was that RBI's share of the £1.5 billion spent each year on recruitment advertising in the United Kingdom represented about five per cent of the total, most of the remainder being lost to national, regional and free newspapers. This was partly a symptom of the fact that RBI only captured part of the advertising revenue from some of the total amount of job vacancies advertised at any one time because it only dealt with certain specialist market sectors and did not have 100% of any of these".

65. Mr Perkins further states that when the Totaljobs web site was launched in July 1999 *"REED BUSINESS INFORMATION branding was used quite heavily on the site. Over time this changed and, by 26 August 2001, all references to RBI were removed from the website".*

66. The launch of the Totaljobs website is described in some detail in the report of the earlier infringement proceedings between the parties, which is reported at [2003] RPC 12. I note from this report that Pumfrey J. found that versions 1 and 2 of the Totaljobs website, which ran from July 1999 to January 2000 were experimental. They were not actively promoted (paragraphs 26-34 of the judgment). Version 3 was launched on 10 January 2000 and consumer advertising began a week later. This

version, like the previous two, featured the REED BUSINESS INFORMATION & device mark in a supporting role to the Totaljobs branding. However, this was removed from the site on 26 June 2000 (paragraph 72) leaving the only use of the mark on the site as an appendage to a copyright claim in small print.

67. On the basis of the above evidence I find that:

- i) There is nothing to support Ms Moore's bare assertion that prior to 1993, Elsevier's predecessor used the trade mark REED (alone) in relation to printed publications, business information services, education and training services and the arranging and conducting of exhibitions.
- ii) There is no credible evidence that after 1993 Elsevier used any mark containing the word REED in the UK in relation to education or training services or instructional materials.
- iii) There is no credible evidence that Elsevier has ever provided legal or legal information services in the UK under the marks REED, REED ELSEVIER or REED BUSINESS INFORMATION.
- iv) The mark REED BUSINESS INFORMATION has been used since before 2001, albeit quite discreetly, in relation to Elsevier's business focussed publications. Most of the use of the mark was in conjunction with a device mark. By 1999, these publications had around 5% of the UK market for recruitment advertising, mainly covering specialist areas of the jobs market.
- v) The same mark and its predecessor – REED BUSINESS PUBLISHING (again, mostly in conjunction with a device) was used between 1992 and 2001 in relation to business publications in order to promote those publications and exhibitions relating to the construction and hairdressing industries. This use would have served to link the mark with the publications which helped sponsor those events.
- vi) Recruitment advertising consists substantially of offering advertising space for job advertisements. Both before and after 2001, Elsevier has promoted its advertising space services, partly by reference to the REED BUSINESS INFORMATION & Device mark, to those interested in placing job advertisements in its business publications.
- vii) It is therefore likely that Elsevier had acquired goodwill under the above names for a wide range of business publications by 2000. However, the extent of the reputation amongst the readers of such business publications would have been limited by the discreet and very much secondary manner in which the REED BUSINESS INFORMATION name was used.
- viii) Elsevier's Totaljobs 'jobs board' was introduced in July 1999 but was not actively promoted until 17 January 2000. The principal use of the

REED BUSINESS INFORMATION mark was removed from the website in June 2000.

- ix) That up until June 2000, Executive was a user of Elsevier's recruitment advertising services.
- x) There has been use of REED EXHIBITIONS and REED EXHIBITION COMPANIES, mostly in conjunction with a device mark, in relation to exhibitions and conferences organised by Reed Exhibitions Limited and its predecessors since 1985.
- xi) The exhibitions were held under other names and there is no credible evidence which supports Ms Poole's claim that the mark REED EXHIBITIONS etc. was used on a significant scale in documents aimed at those attending these exhibitions: the exhibits said to support this claim conspicuously fail to do so.
- xii) There is acceptable evidence that the mark REED EXHIBITIONS was commonly used in documents aimed at those exhibiting at these events and on Reed Exhibitions home web site.
- xiii) Reed Exhibitions Limited (and Elsevier) had therefore acquired a substantial goodwill as an organiser of exhibitions and conferences by 2001, but its reputation was primarily amongst those with an interest in exhibiting.
- xiv) Some talks and short seminars were held as 'associated events' at these exhibitions from at least as early as November 2001. The purpose of holding them was to make the exhibitions more attractive to potential attendees. However, there is no evidence that the name REED EXHIBITIONS (or any similar name) was used in relation to the arranging or conducting of those associated events or that they generated any goodwill for Reed Exhibitions as a provider of educational services.

THE HEARING

68. The matter came to be heard on 19 January 2010 when Elsevier was represented by Mr A Bernhard of F J Cleveland and Executive was represented by Mr Thomas St Quintin of Counsel, instructed by Grant, Spencer, Caisley & Porteous.

OPPOSITION No. 51136 - BY REED ELSEVIER GROUP PLC AND REED BUSINESS INFORMATION LIMITED AGAINST APPLICATION No. 2219853 IN THE NAME OF REED EMPLOYMENT LIMITED

69. The trade mark is REED ONLINE. The application is dated 20 January 2000. It is opposed in respect of *'Recruitment services, including such services provided on-line from a computer database or the Internet'*. There are two grounds of opposition – s. 5(2)(b) and s.5(4)(a).

70. The s.5(2)(b) ground of opposition is based on earlier CTM No. 652909, which consists of the mark REED alone and is registered, inter alia, for:

Class 35

Advertising and promotional services: provision of business and trade information including such services provided electronically.

Class 41

Publishing services, including electronic publishing.

71. The s.5(4)(a) ground is based on Elsevier's common law rights in the word REED as a result of the use of that word in relation to a range of publications and websites containing job advertisements.

72. The grounds of opposition are denied. In particular, Executive relies on the fact that all the services covered by this application are not materially different to those covered by its existing UK registration of the word REED under No. 1296450, which is registered for '*employment agency services*', and its own use of the mark REED in relation to recruitment services since 1960.

73. I will first examine the s.5(2)(b) ground. In so doing I note that the date of publication of this application preceded the coming into force of S.I. 2004/946 on 5 May 2004, which introduced s.6A of the Act and the associated 'proof of use' provisions. Consequently, under Regulation 8 of S.I. 2004/946 Elsevier is entitled to rely upon the earlier CTM for all the services for which it is registered, the closest of which are shown above in paragraph 70 above.

The Law

74. The relevant parts of s.5 are 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.

75. I take into account the guidance from the settled case law of the European Court of Justice ("ECJ") in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Matratzen Concord v OHIM C-3/03* [2004]

ECR I-3657, and *Shaker di L. Laudato & C. Sas v OHIM C-334/05 P* (LIMONCELLO). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (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; *Sabel BV v Puma AG*, and the overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components; *Matratzen Concord v OHIM*,
- (e) However, 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; *Shaker di L. Laudato & C. Sas v OHIM*,
- (f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective services, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,
- (g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of s.5(2); *Sabel BV v Puma AG*,
- (i) if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section: *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

76. The crux of Elsevier's objection is apparent from a comparison of the opposed services and other similar services, the opposition to which was dropped at the hearing. The unopposed services are '*Employment agency services, including such services provided on-line from a computer database or the Internet*'. In a nutshell,

Elsevier opposes registration of REED ONLINE for recruitment services, but not for employment agency services.

77. The Court of Appeal found that Elsevier's publication of job advertisements amounted to a publication service (see paragraph 62 of the judgment) and that there was no likelihood of confusion as a result of certain uses by Elsevier of REED BUSINESS INFORMATION for such a publication service in the face of Executive's earlier registration of REED for 'employment agency services'. Against this background Elsevier is concerned about the consequences of Executive registering the mark REED ONLINE to cover 'recruitment services'.

78. Elsevier indicated at the hearing that it would be prepared to drop its opposition if Executive's services were to be restricted to 'recruitment agency services' so as to emphasise its role as an agent or middleman in the recruitment process. Executive were not prepared to make such an amendment, but this offer at least served to identify the parameters of the real dispute between the parties under this heading. It turns on the relationship between what Elsevier calls 'recruitment advertising' and Executive's 'recruitment services'.

79. Executive's position is set out succinctly in Mr St Quintin's skeleton argument like this.

"As can be seen, the services for which the REED ONLINE 853 Application seeks registration have little connection to the services for which the REED 909 CTM is registered.

The closest link could be that '*Advertising and promotional services*' might be used to advertise or promote employment agency and /or recruitment services or, as appears to be foreshadowed in Elsevier's evidence, it may be said that the listing of job vacancies falls within 'advertising and promotion services' or the same listings are part of a 'publishing service' such that these services are said to encompass 'recruitment services'.

Against these arguments (if they were to be run), the following points are made:

- a. The listing of job vacancies is not an 'advertising or promotional service'. Advertising and promotion is an activity directed at drumming up business. It is part of a sales activity. The listing of job vacancies in, for example, one of Elsevier's magazines, provides necessary publicity to the existence of that vacancy, but it does not 'advertise' nor 'promote' it.
- b. The average consumer will understand that the companies who undertake 'recruitment services' by *placing* job listings in various media are not the same companies providing the job listing service, and the average consumer will not expect them to be the same.
- c. The mere fact that a publication is used as a vehicle for carrying out one element of a recruitment service does not mean that the publication itself is offering a recruitment service.

In summary, for the reasons above, there is simply no likelihood of confusion between the REED ONLINE 853 Application and any of the earlier trade marks asserted against it."

80. The first question is whether the respective services are identical. In determining this matter the parties are agreed that it is necessary to apply the guidance of the Court of Appeal in the earlier proceedings between them to the effect that:

“Specifications of 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”.

81. The noun ‘recruitment’ is defined in the Oxford English Dictionary as *“The act or process of recruiting of a military force or class of persons”*. In a commercial context, the meaning is, of course, focussed on the recruitment of employees.

82. In assessing the relationship between, on the one hand, a service of publishing or advertising job vacancies and, on the other hand, a recruitment service, it is helpful to keep in mind that services covered by a trade mark registration are services offered to others. Accordingly, when Executive advertises the job vacancies for which it has been engaged as a recruiter to fill, it is not providing anyone with an advertising or publication service. It is publishing those jobs itself in connection with its recruitment services. In principle, this is no different to a travel company advertising available holidays. The travel company does not thereby provide an advertising service to others. It merely promotes the holidays which it is offering to sell. If it decides to place advertisements for them in a third party magazine or web sites, it may use the advertising services of others. Those third parties do not, simply on that account, become providers of travel services. By parity of reasoning, I do not think that it would be right to regard ‘recruitment advertising’ as a subset of ‘recruitment services’. Rather, recruitment advertising is in fact a subset of advertising services. Alternatively, it is a publication service. I therefore find that the respective services are not identical.

83. I believe that this finding is consistent in all material respects with the judgment of the Court of Appeal cited above, which decided that employment agency services were not identical to the publication of job advertisements. It is true that recruitment services may be a little different in scope to employment agency services. On behalf of Executive, Mr St Quintin described the difference like this:

“a recruitment service also encompass something such as CV workshops, provision of consultancy services for employers relating to how they can best attract talent and how they can run their selection processes in order to find the best people from the applicants to their jobs and related things such as that. It is a service in the field of recruitment. It is broader.”

In relation to the placing of adverts, in my submission, there is not an overlap between the two. REED ELSEVIER's business is in publishing. That business of publishing includes the provision of advertising space, including listings of job advertisements. But, in my submission, that is something distinct from the business of an employment agent or someone providing recruitment services.”

84. There is room for argument as to whether ‘recruitment services’ covers ‘CV Workshops’. As I do not have to decide that point I prefer to leave it open. ‘Consultancy services relating to recruitment’ seems to me to be one step removed from a recruitment service as such. It does not fall within the core of the possible meanings of ‘recruitment services’. I do, however, agree with another suggestion made at the hearing that recruitment services covers the work of ‘head hunters’, which might not fall within the scope of employment agency services.

The law on similarity of goods and services

85. Having decided that the respective services are not the same, I turn to the question of similarity. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* where the ECJ stated at paragraph 23 of its judgment:

“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.

86. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06, the General Court restated that “complementary” means this.

“It is true that goods are complementary if 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”

Similarity of services

87. In a response to Executive’s application to cancel Elsevier’s Community Trade Mark No. 652909 (‘REED’), the First Board of Appeal of the Office for Harmonisation in the Internal Market (OHIM), decided in case R-144/2003-1 that the ‘*employment agency services*’, for which the Executive’s earlier REED mark was protected, were not similar to the ‘*advertising and promotional services*’ for which Elsevier’s later Community mark was protected.

88. Similarly, in opposition decision B298648 of 26/7/07, OHIM decided that Elsevier’s opposition based on earlier Community Trade Mark No.652909 to Executive’s application to register REED for ‘*recruitment services*’ should fail because recruitment services were dissimilar to the ‘*advertising services*’ for which the earlier mark was protected.

89. I agree with the core of the OHIM Board of Appeal’s reasoning, but I think that it is going too far to deny that there is any similarity at all between recruitment advertising (or publication of job advertisements) and recruitment services. It seems to me there is some connection between their respective purposes (which is not the same as saying that they share the same purpose). Further, insofar as employers may place job advertisements themselves or engage a recruitment business to fill vacancies for them, there is an overlap between the persons at whom the respective services are directed. I do not think that the respective services are of the same nature. The one is an advertising or a publication service, the other is the service of finding suitable job candidates for employers.

90. Although employers may choose to advertise jobs and assess candidates themselves as an alternative to using a recruitment service, the providers of recruitment and recruitment advertising services do not usually compete for the

same business. Rather the choice is akin to that made by the owner of a property when deciding whether to try and sell his property himself or to engage an estate agent to do it for him. Nor are the respective services complementary in the sense used in the case law. This is because, from the viewpoint of the relevant consumers and end users, recruitment advertising services are not indispensable or important for the use of recruitment services in such a way that customers may think that the responsibility for those services lies with the same undertaking.

91. For these reasons, I find that there is very low degree of similarity between the services.

The similarity between the marks

92. Mr Bernhard submitted, on behalf of Elsevier, that REED and REED ONLINE are less distinguishable than REED and REED BUSINESS INFORMATION because ONLINE is wholly descriptive of an on-line service. I agree. The marks are not identical, but they are virtually so.

The distinctive character of the earlier mark

93. In my view, the earlier mark – REED - has a below average level of inherent distinctive character. REED is a common surname. Consumers are accustomed to surnames being widely used in trade to distinguish the goods and (particularly) the services of different undertakings. That is not to say that the surname REED is incapable of distinguishing the goods or services of the parties. However, it does mean that *prima facie* consumers will not be as quick as they would be with a more distinctive mark to assume that uses of REED for different but somehow related services, are uses of that mark by economically related undertakings.

94. Elsevier had used the mark REED BUSINESS INFORMATION for 7 years prior to 2000 in respect of a wide range of publications, most of which included a section with job vacancies. Had this use enhanced the distinctive character of REED for (job) advertising and (job) publication services by the date of the opposed application in January 2000? It is common ground that, as a matter of law, a mark may acquire the distinctive character it originally lacked as a result of its use as part of, or in conjunction with, another sign. That being so it must also be possible, in principle, for a mark to acquire an enhanced level of distinctiveness as a result of such use. However, as a matter of fact, the use shown of the above signs in this case had not, in my view, enhanced the distinguishing power of Elsevier's earlier REED mark to the point where it was a strong mark for these services at the relevant date in January 2000. This is because:

- i) RBI had 5% of the UK market for recruitment advertising by 1999, mostly selling advertising space to those in specialist areas of the jobs market.
- ii) The public facing use of the REED BUSINESS INFORMATION in relation to the services in question was very much secondary to, and less noticeable than, the various publication titles. Therefore, not

everyone who dealt with magazines would have remembered the name REED.

- iii) The reputation that RBI (Elsevier) had for recruitment advertising amongst employers and recruitment agents was, at that date, part and parcel of its trade as a publisher of business and industry publications. The nature of Elsevier's reputation for recruitment advertising was therefore narrowly focussed on its printed publications.
- iv) The use of REED BUSINESS INFORMATION in relation to the Totaljobs web site only began in July 1999 and was not actively promoted to the public as a general 'jobs board' until around the relevant date in January 2000.
- v) Elsevier accepts that the words BUSINESS INFORMATION played a part in distinguishing its services.

The Average Consumer

95. The average consumer of a recruitment service is an employer looking for professional help to fill a job vacancy. Getting the right candidates is plainly of commercial importance to employers. Such a consumer is therefore likely to pay a higher than average level of attention when selecting a suitable service provider.

96. Taking the closest services covered by Elsevier's earlier mark – advertising/publication of job vacancies - the average consumer is again likely to be an employer or someone acting on their behalf. Such a consumer is likely to carefully consider where to place an advertisement for a job. I find that such a consumer will pay an above average level of attention when selecting such services.

97. Potential employees are also 'end users' of recruitment services and of advertising/publication of job vacancies services. Such a user may not pay quite as much attention to the selection of the service provider as an employer, but even here careful thought is likely to be given as to the best places to look for suitable job advertisements because finding a suitable job is also very important to the person seeking employment. Consequently, such 'end users' would also pay a reasonably high level of attention when selecting services of this kind.

Likelihood of confusion

98. In my judgment, there is no likelihood of confusion despite the near identity between the respective marks. This is because the level of similarity between the respective services is very low and the earlier mark does not have a particularly high level of distinctive character. By contrast, the level of attention paid by relevant consumers and end users when selecting the respective services is relatively high.

99. Further, there is nothing to suggest that consumers or end users generally expect undertakings that provide recruitment services to also provide advertising or publication [of job vacancies] services [for third parties].

100. I do not therefore regard it as likely that consumers and end users will expect the undertaking which uses REED ONLINE for recruitment services to be the same as, or economically linked to, the user of REED for (job) advertising and (job) publication services.

Section 5(4)(a) ground

101. It is apparent from the way that the opposition under s.5(4)(a) is pleaded (see paragraph 71 above) that the factual basis for the opposition based on Elsevier's unregistered rights in REED mirrors the s.5(2) ground based upon its registered mark. It cannot succeed to any greater extent than the s.5(2) ground because it also depends a likelihood of confusion or deception, which I have rejected. The s.5(4)(a) ground is therefore also rejected.

Conclusion on opposition 51136

102. The opposition is rejected.

OPPOSITION No. 92384 - BY ELSEVIER AGAINST APPLICATION No. 2280946A IN THE NAME OF EXECUTIVE

103. The trade mark is REED (alone). The date of the application is 18 September 2001. It is opposed in respect of the following goods and services.

Class 09:

Downloadable electronic publications provided online from databases or the Internet, all relating to employment agency and recruitment services.

Class 16:

Printed matter and printed publications, all relating to employment agency and recruitment services.

Class 35:

Business information services; compilation of advertisements for use as web pages on the Internet; provision of space on websites for advertising goods and services; database collection and management; all the aforesaid services relating to employment agency and recruitment services; business consultation services in the fields of personnel management, placement, recruitment and relocation; employee attraction, retention and analysis programmes.

Class 41:

Education and training; arranging and conducting of conferences, seminars, tutorials and workshops; all the aforesaid relating to employment agency and recruitment services.

Class 42:

Leasing access to a computer database in connection with any services relating to employment agency and recruitment services.

104. The grounds of opposition pursued at the hearing were:

- i) Under s.5(1) and s.5(2)(a) of the Act because the opposed mark is identical to earlier CTM No. 652909 – REED - which is registered in classes 9, 16, 35, 39, 41 and 42 for goods/services which are identical or similar to the opposed goods/services.
- ii) Under s.5(2)(b) because the opposed mark is similar to UK pending application No.2270582 – REED BUSINESS INFORMATION (opposed by Executive, see below) – which covers identical and similar goods/services to the opposed application.
- iii) Under s.5(4)(a) because of Elsevier’s common law rights in marks containing REED.

105. Executive’s mark is plainly identical to Elsevier’s CTM No. 652909. To the extent that the respective goods and services are also identical, registration of Executive’s mark is therefore excluded under s.5(1). The complaint under s.5(2) is that use of the Executive’s mark in relation to goods/services which are similar to those for which the earlier marks are protected will result in a likelihood of confusion on the part of the public.

106. The complaint under s.5(4)(a) is that Executive’s use of the opposed mark in relation to the opposed goods/services would constitute passing off.

107. Executive denies the grounds of opposition. The counterstatement indicated that Executive would seek to rely on its own longstanding use of the mark REED in order to found a defence of statutory acquiescence under s.48. However, no such point was taken at the hearing, and when I asked him about it Mr St Quintin confirmed that the point was not being pursued.

108. I will first examine the grounds based on s.5(1) and s.5(2) of the Act. The opposition based on earlier UK mark 2270582 largely duplicates the ground covered by the opposition based upon CTM 652909. However, I find it convenient to start by considering the conflict between Executive’s application and Elsevier’s earlier pending UK mark 2270582 – REED BUSINESS INFORMATION, which covers, *inter alia*, “*compilation of advertisements for use as web pages on the Internet*”.

109. Although application 2270582 is one of the applications covered by these consolidated opposition proceedings, Executive’s opposition does not extend to these services. Consequently, it will be registered in relation to these services. This means that Elsevier can rely on the registration of the earlier mark for “*compilation of advertisements for use as web pages on the Internet*” for the purposes of this opposition.

Identity of services

110. It is obvious that the services mentioned above are literally identical to “*compilation of advertisements for use as web pages on the Internet*” in Class 35 of Executive’s later application.

Similarity of marks

111. The marks, REED and REED BUSINESS INFORMATION are not identical, but they are manifestly similar because the former mark is a major element of the latter mark and appears at the beginning of that mark.

Distinctive character of earlier mark

112. In my view, the mark REED BUSINESS INFORMATION has an average level of distinctiveness for these services. This is because the words 'Business Information' are not directly descriptive of these services and therefore lend a bit of extra distinguishing capacity in this instance compared to the word REED alone.

Average consumer

113. The average consumer is someone who wants help to compile an advertisement for use on the Internet. It is someone who intends to advertise something, probably a business person. Such a person is likely to pay a relatively high degree of attention when selecting a service provider.

Likelihood of confusion

114. I, nevertheless, consider that the use by the parties of the marks REED and REED BUSINESS INFORMATION in relation to these identical services would cause the average consumer to expect that the users of those marks were the same or were economically connected. Consequently, I find that there is a likelihood of confusion and that Executive's application to register REED for '*compilation of advertisements for use as web pages on the Internet*' in Class 35 must be refused under s.5(2)(b).

115. In view of this conclusion, there is no need for me to express a concluded view about whether Executive's application to register REED for '*compilation of advertisements for use as web pages*' is also liable to be refused on the basis of Elsevier's earlier CTM for REED alone, which is protected for '*advertising services*'.

116. All the goods and services for which Elsevier's earlier REED CTM is protected and the remaining opposed goods/services in Executive's REED application are set out in the following table.

Class	REED 909 CTM	REED 946A Application
9	Electronic publications; publications in electronic form supplied on-line from a database or from facilities provided on the Internet or other network (including web-sites); computer software; recorded tapes, discs, cassettes, cinematographic films; CD-Roms; information stored on	Downloadable electronic publications provided online from databases or the Internet, all relating to employment agency and recruitment services.

	electronic, magnetic or optical means.	
16	Printed publications including books, newspapers, magazines and journals; instruction and teaching material; timetables, schedules and maps	Printed matter and printed publications, all relating to employment agency and recruitment services
35	Advertising and promotional services; provision of business and trade information including such services provided electronically; arranging and conducting trade shows.	Business information services; provision of space on websites for advertising goods and services; database collection and management; all the aforesaid services relating to employment agency and recruitment services; business consultation services in the fields of personnel management, placement, recruitment and relocation; employee attraction, retention and analysis programmes.
39	Provision of information relating to transportation and travel including such services provided electronically.	
41	Publishing services, including electronic publishing; arranging and conducting exhibitions, seminars and conferences; provision of information relating to education and entertainment, and sport including the provision of such services electronically; education, entertainment and instruction by or relating to radio and television; production, presentation, distribution, syndication, networking and rental of television and radio programmes and of films and video recordings.	Education and training; arranging and conducting of conferences, seminars, tutorials and workshops; all the aforesaid relating to employment agency and recruitment services.
42	Providing access to on-line interactive databases; creation of Internet web-sites; computer programming; provision of information relating to medical, scientific and legal matters including	Leasing access to a computer database in connection with any services relating to employment agency and recruitment services

	such services provided electronically; hotel services and provision of information relating thereto.	
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117. The proof of use provisions do not apply. Consequently, the earlier CTM is entitled to protection for all the goods/services it covers.

Identical marks, identical services

118. It is, in my view, self evident that *'downloadable electronic publications provided online from databases or the Internet, all relating to employment agency and recruitment services'* in Class 9 of Executive's application are covered by *'publications in electronic form supplied on-line from a database or from facilities provided on the Internet or other network (including web-sites)'* in Class 9 of Elsevier's earlier CTM.

119. Similarly, I find that *'printed matter and printed publications, all relating to employment agency and recruitment services'* in Class 16 of Executive's application are covered by *'printed publications including books, newspapers, magazines and journals'* in Class 16 of Elsevier's earlier CTM.

120. I further find that *'Business information services'* in Class 35 of Executive's application are covered by *'provision of business and trade information including such services provided electronically'* in Class 35 of Elsevier's earlier CTM.

121. Further still, I find that *'provision of space on websites for advertising goods and services'* in Class 35 of Executive's application is identical to *'advertising and promotional services'* for which Elsevier's earlier CTM is protected. It could be argued that there is a fine distinction between the two, but I find that, in this case, the difference is elusive. In any event, even if these services are not identical they are so similar that the difference is immaterial.

122. I also find that *'Leasing access to a computer database in connection with any services relating to employment agency and recruitment services'* in Class 42 of Executive's application is identical to *'Providing access to on-line interactive databases'* in Class 42 of Elsevier's earlier CTM. I do not consider that the limitation *"...in connection with any [unnamed] services relating to employment agency and recruitment services"* (emphasis added) in Executive's application greatly narrows the scope of that application. In any event, there is no corresponding limitation to the services specified in Elsevier's CTM, so notional use of Elsevier's mark would include use in the same restricted context. In this connection, I take into account the guidance of the ECJ from paragraphs 75 and 76 of Case C-498/07P, *Aceites del Sur-Coosur SA v OHIM*, that when assessing objections to the registration of a trade mark it is necessary to take account of all the circumstances in which the mark might be used.

123. I turn next to Class 41 of Executive's application. Elsevier says that *'arranging and conducting of conferences, seminars, tutorials and workshops; all the aforesaid relating to employment agency and recruitment services'* in Class 41 of Executive's

application are identical or closely similar to '*arranging and conducting exhibitions, seminars and conferences*' in Class 41 of Elsevier's CTM. I find that the services are identical insofar as Executive seeks to register REED for 'arranging and conducting of conferences and seminars'. The same services are listed in Elsevier's CTM, but are not limited by subject matter. They therefore include conferences and seminars relating to employment agency and recruitment services. The qualification applied to Executive's services therefore makes no difference.

124. In the light of my findings that the respective goods and services identified above are identical, and given that the marks are self evidently identical, Executive's application must be refused under s.5(1) of the Act in respect of:

Class 9

Downloadable electronic publications provided online from databases or the Internet, all relating to employment agency and recruitment services.

Class 16

Printed matter and printed publications, all relating to employment agency and recruitment services.

Class 35

Business information services and provision of space on websites for advertising goods and services.

Class 41

Arranging and conducting of conferences, seminars; all the aforesaid relating to employment agency and recruitment services.

Class 42

Leasing access to a computer database in connection with any services relating to employment agency and recruitment services.

Identical marks, dissimilar services

125. I turn next to consider whether '*business consultation services in the fields of personnel management, placement, recruitment and relocation; employee attraction, retention and analysis programmes*' in Executive's application are similar to any of the services covered by Elsevier's earlier CTM. Mr St Quintin thought that the closest services in Elsevier's CTM were '*provision of business and trade information including such services provided electronically*' and Mr Bernhard did not identify anything closer. The only point of apparent similarity is that both descriptions of services include the word 'business'. However, in Executive's application the word simply describes the class of users to whom the services are directed. In Elsevier's CTM the word 'business' defines the nature of the information provided through the service. In reality the word 'business' is wholly redundant in Executive's description of services which would have exactly the same meaning if expressed as '*consultation services in the fields of personnel management, placement, recruitment and relocation; employee attraction, retention and analysis programmes*'. In my judgment, it is self evident that these services are not similar to any of Elsevier's services.

126. Some similarity of services is a pre-requisite for a successful objection under s.5(2) of the Act; see *Waterford Wedgwood plc v OHIM*, ECJ case C-398/07P. I therefore reject the opposition based on CTM 652909 insofar as ‘*business consultation services in the fields of personnel management, placement, recruitment and relocation; employee attraction, retention and analysis programmes*’ is concerned.

Identical marks, similar services

127. Executive’s application also includes ‘*database collection and management; all the aforesaid services relating to employment agency and recruitment services*’. It is submitted that these services are identical or similar to ‘*provision of business and trade information including such services provided electronically*’ in Class 35 of Elsevier’s earlier CTM or else ‘*providing access to on-line interactive databases*’ in Class 42 of the specification of the CTM.

128. I confess I have had some difficulty in understanding which services Executive’s description covers which are not part and parcel of employment agency or recruitment services. In his skeleton argument, Mr St Quintin described the scope of Executive’s services like this:

‘database collection and management relating to employment agency and recruitment services’ is plainly a subset (and a key one) of the activities of an employment or recruitment agent.

These activities (the gathering of information about candidates and jobs – i.e. database collection - and the management of that data so that appropriate candidates can be matched to specific jobs) are essential to the successful running of a recruitment or employment agency.

It is also plain that, in an employment agency context, the database collected must be kept confidential or its value will be lost. It is only the outputs of a search of that database, in the form of a list of suitable candidates, that is communicated externally.”

129. On this understanding of the services, Mr Quintin says that they are not similar to ‘*provision of business and trade information including such services provided electronically*’ because a) such information is provided to anyone who wants it, and b) the nature of the data supplied is different. I am not taken with the first point. There is no reason why business and trade information cannot be collected for particular customers and outputs provided only for them. However, in my view it is tolerably clear that the qualification to Executive’s description of services effectively limits the data being collected and managed to that related to the provision recruitment and employment agency services. This effectively defines the nature and purpose of the data being collected and managed.

130. I agree with St Quintin that consumers would expect ‘*database collection and management relating to employment agency and recruitment services*’ to be provided by a recruitment or employment business, who would not be expected to supply business and trade information. I do not think that the respective services have the same purpose. They are both connected with the provision of information so they are related in nature, although not the same. One is about the collection and management of employment data, the other about the supply of trade and business

data. The services are not in competition, nor are they complementary. The end users of both are likely to be businesses, so there may be an overlap in the respective user bases, but they are not the same. Overall, the services have some similarity, but there are more differences. There is therefore only a very low degree of similarity between them.

131. Elsevier also relies upon the registration of its earlier CTM in Class 42 for '*providing access to on-line interactive databases*'. I remind myself that Elsevier's services in Class 42 fall under the heading of 'technological services'. As the explanatory note to Class 42 in the Nice Classification (9th edition) makes clear, business research and evaluations are proper to Class 35, as is the provision of business information and the provision of recruitment information. The services covered by Elsevier's CTM in Class 42 are therefore the provision of the technological means to access on-line databases; for example, the class includes 'hosting of web sites' (for others).

132. The Court of Appeal decided in *Altecnic* [2002] RPC 34, that it is proper to take into account the class that goods and services are registered for when determining their nature and scope. Consequently, it is necessary to look upon the core of Elsevier's services in Class 42 as being the provision of the technological means of accessing databases.

133. In my view, these services also have only, at most, a very low degree of similarity to '*database collection and management relating to employment agency and recruitment services*' in Executive's application. They are different in purpose and nature, they are not in competition and they are not complementary, at least in the sense described in the case law. This is because the one is not indispensable or important for the use of the other so that consumers would expect them to be ordinarily provided by the same or economically connected undertakings. There may be some overlap in the respective user bases, but the services cannot be deemed similar on that basis alone. Consequently, the registration of Elsevier's earlier CTM in Class 42 presents no stronger case than that based on the registration of the mark in Class 35.

134. I find that '*arranging and conducting of workshops; all the aforesaid relating to employment agency and recruitment services*' in Class 41 of Executive's application is closely similar to "*arranging and conducting seminars*" in Class 41 of Elsevier's CTM. Again the qualification applied to Executive's application makes no difference because Elsevier's seminars are not limited by subject and could therefore cover anything. In my experience, the description 'seminar' can be applied to a range of events. At the one end of the spectrum, a seminar is sometimes a large event where information or views are exchanged as per meaning four in Collins English Dictionary. It can also be used to describe "*a small group of students meeting regularly under the guidance of a tutor, professor etc.*", as per meaning one in Collins English Dictionary. Elsevier's CTM covers both kinds of seminars. The distinction between a seminar of the latter kind and a workshop is a fine one. They are at least closely similar. There are similarities in purpose, the respective services are of the same general nature, and they could compete with one another in the sense that one may choose to (say) study at a workshop or at a seminar. It follows that the services may be directed at the same users. In my judgment, there is therefore a high level of

similarity between *'arranging and conducting seminars'* and *'workshops relating to employment agency and recruitment services'*.

135. That covers all the services in Executive's application except for *'education and training'* and *'arranging and conducting tutorials'*, *'... all the aforesaid relating to employment agency and recruitment services'* in Class 41. A tutorial is defined in Collins English Dictionary as *"a period of intensive tuition given by a tutor to a small group of students"*. It is clearly a part of an educational service and therefore falls to be considered alongside *'education services'*. The closest services covered by Elsevier's CTM are *'provision of information relating to education.....including the provision of such services electronically'* and *'education.... and instruction by radio and television'*.

136. Executive's services are again qualified as *'relating to'* employment agency and recruitment services. This description would appear to be wide enough to cover, for example, training to qualify as a recruitment consultant. A television program designed to help students studying for the same purpose would also fall within description *'education.... and instruction by radio and television'* in Class 41 of Elsevier's earlier CTM. On this basis I think it is clear that the purpose of the respective services would be the same, as would be the intended users. The services could be in competition with other and/or could be complementary in that an educational course may consist of a combination of TV broadcasts and associated classes or tutorials. Only the medium and therefore the nature of the services would differ.

137. The *'provision of information relating to education.....including the provision of such services electronically'*, covers the supply of material for educational courses. I find that this service is therefore complementary to Executive's education and training services. I conclude that there is a high degree of similarity between these services.

Distinctive character of the earlier mark

138. For the reasons explained at paragraph 93 above, I consider that *prima facie* Elsevier's CTM REED has a below average level of distinctive character for each of the services I have found to bear some similarity to those in Executive's application, namely:

- i) *'provision of business and trade information including such services provided electronically'* in Class 35;
- ii) *'arranging and conducting exhibitions and seminars'* in Class 41; and
- iii) *'provision of information relating to education.....including the provision of such services electronically'* and *'education.... and instruction by radio and television'*, also in Class 41.

139. On the basis of my earlier findings of fact, I am not prepared to accept that the distinctive character of Elsevier's earlier CTM, REED, had been enhanced in any material way for *'provision of business and trade information including such services*

provided electronically' by the date of Executive's application in September 2001 as a result of its use as part of the mark REED BUSINESS INFORMATION in relation to magazines and directories.

140. I accept that the mark REED had acquired at least an average degree of distinctive character by that date in relation to *'arranging and conducting exhibitions'* as a result of its use as part of the names REED EXHIBITIONS or REED EXHIBITION COMPANIES.

141. I have not found any use of REED by Elsevier in relation to *'provision of information relating to education.....including the provision of such services electronically'* and *'education.... and instruction by radio and television'*. It follows that the distinctive character of the REED CTM had not been enhanced for these services at the relevant date in September 2001.

The average consumer

142. The average consumer of the opposed services in Executive's application, namely:

- i) *'database collection and management relating to employment agency and recruitment services'* in Class 35,
- ii) *'arranging and conducting of tutorials and workshops; all the aforesaid relating to employment agency and recruitment services'* in Class 41, and
- iii) *'education and training... all the aforesaid relating to employment agency and recruitment services'* also in Class 41,

- is likely to be, in the case of i) above, an employer, in the case of ii), an employer or a person looking for employment, and in the case of iii) a person looking for education in the field of recruitment. In the first two cases, I find that, for the reasons given in paragraphs 96 and 97 above, the average consumer is likely to pay a reasonably high degree of attention when selecting the services at issue. Selecting a provider of education and training services is also an important activity for the average consumer, and I therefore find that these services would also be selected with an above average degree of care and attention.

Likelihood of confusion

143. In my judgment, the very low level of similarity between *'provision of business and trade information including such services provided electronically'* and *'database collection and management relating to employment agency and recruitment services'* combined with the reasonably high degree of attention likely to be paid by the relevant average consumer and the modest level of distinctiveness of the earlier CTM are sufficient to rule out the likelihood of confusion, including the likelihood of association (in the sense of indirect confusion), despite the identity of the respective marks. The same applies to the objection based upon the registration of the earlier CTM for *'providing access to on-line interactive databases'*.

144. I have reached the opposite conclusion with regard to the use by the parties of the mark REED in relation to, on the one hand, '*arranging and conducting seminars*' and on the other hand, '*arranging and conducting of workshops; all the aforesaid relating to employment agency and recruitment services*'. This is because of the high level of similarity between these services.

145. I also find that there is a likelihood of confusion, including the likelihood of association (again in the sense of indirect confusion) as a result of the use by the parties of the mark REED in respect of, on the one hand, '*provision of information relating to education.....including the provision of such services electronically*', and '*education....and instruction by radio and television*' and on the other hand, '*education and training*' and '*arranging and conducting of tutorials ... all the aforesaid relating to employment agency and recruitment services*'. This is also because of the combination of identical marks and closely similar services. In these circumstances, I do not think that the modest level of distinctiveness of the CTM for the services relied upon by Elsevier for this purpose, and the reasonably high degree of attention likely to be paid by relevant consumers, is sufficient to exclude the likelihood of confusion, including the likelihood that consumers will assume that there is an economic connection between the users of the mark REED for the respective services.

The Section 5(4)(a) ground

The Law of passing off

146. Section 5(4) of the Act states that a trade mark shall not be registered:

- ".....if, or to the extent that, its use in the United Kingdom is liable to be prevented-
- a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
 - b) by virtue of an earlier right other than those referred to in subsections (1) to (3) above or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs."

147. The requirements to succeed in a passing off action are well established and are summarised in *Halbury's Laws of England* 4th Ed. as being that:

- i) the claimant's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- ii) there is a misrepresentation by the defendant (whether or not intentional) which is likely to deceive the public into believing that the defendant's goods or services are those of the claimant; and
- iii) the claimant has suffered or is likely to suffer damage as a result of the erroneous belief created by the defendant's misrepresentation.

148. It is common ground that the date of the commencement of the activity complained of is a relevant date. I agree that this is a relevant date, but not the only relevant date. Section 5(4)(a) is intended to give effect to article 4(4)(b) of Directive

2008/95/EC (originally 89/104/EEC) and the national law must therefore be applied, so far as possible, in accordance with the underlying Directive. Article 4(4)(b) is as follows:

“Any Member State may...provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:

(a) -

(b) rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark, and that nonregistered, trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.”

149. It seems clear from this provision that in order for such an objection to succeed the proprietor of the unregistered trade mark must have been in a position to prohibit the use of the trade mark for which registration is sought at the date of the application. See, by analogy, paragraph 51 of the judgment of the General Court in Joined cases T-114/07 and 115/07, *Last Minute Network Ltd v OHIM*.

150. This is a relevant factor in this case because Executive operated an employment agency service under the mark REED for many years prior to the date of the opposed application and has long provided recruitment services. The following summary of the applicable law in this situation is taken from the judgment of Mr Geoffrey Hobbs QC as The Appointed Person in *Croom’s Application* [2005] RPC 2.

“When rival claims are raised with regard to the right to use a trade mark, the rights of the rival claimants fall to be resolved on the basis that within the area of conflict:

(a) the senior user prevails over the junior user;

(b) the junior user cannot deny the senior user’s rights;

(c) the senior user can challenge the junior user unless and until it is inequitable for him to do so.”

151. The services which have survived the s.5(1) and 5(2) grounds of opposition (see paragraph 152 below) are much more closely connected with Executive’s longstanding goodwill than they are with any of goods and services for which Elsevier may have a protectable goodwill under the name REED. Consequently, Elsevier must therefore be considered the junior user in respect of the services which have survived the s.5(1) and 5(2) grounds of opposition. In relation to these services, the s.5(4)(a) case is therefore hopeless and I reject it accordingly.

Conclusion on opposition 92384

152. Application 2280946A must be refused under s.5(1) or 5(2) of the Act in respect of all the opposed goods and services, except for:

Class 35

Business consultation services in the fields of personnel management, placement, recruitment and relocation; employee attraction, retention and analysis programmes’

and

Database collection and management relating to employment agency and recruitment services’.

**OPPOSITION No. 92625 – BY REED EXECUTIVE PLC AND REED
EMPLOYMENT LIMITED AGAINST APPLICATION No. 2270582 BY REED
BUSINESS INFORMATION LIMITED**

153. The trade mark is REED BUSINESS INFORMATION. The application was filed on 19 May 2001. Registration of the mark is opposed in respect of the following goods/services.

Class 09:

Electronic publications; publications in electronic form supplied on-line from a database or the Internet; computer software; information stored on electronic, magnetic or optical means; computer software to enable searching of data.

Class 16:

Publications; books; newspapers; magazines; journals; instructional and teaching material; timetables; schedules.

Class 35:

Advertising and promotional services; advertising and promotion services and information services relating thereto; business information services; all provided on-line from a computer database or the Internet; compilation of advertisements for use as web pages on the Internet; compilation of directories for publishing on the Internet; provision of business and trade information including such services provided electronically; arranging and conducting trade shows.

Class 41:

Publishing services, including electronic publishing; arranging and conducting exhibitions, seminars and conferences; provision of information relating to education, including the provision of such services electronically; education and instruction by or relating to radio and television.

Class 42:

Providing access to on-line interactive databases.

154. The grounds of opposition pursued at the hearing are:

- i) Under s.5(2)(b) of the Act based on UK registration No. 1296450, which consists of the word REED and is registered with effect from 23 December 1986 in the name of Reed Employment Ltd in respect of *'Employment agency services, included in Class 35'*.
- ii) Under s.5(2)(b) based on CTM registration No. 1341064, which also consists of the word REED and is registered with effect from 12 October 1999 in the name of Reed Employment Ltd in respect of *'Employment agency and recruitment services; including employment agency and recruitment services provided on-line from a computer database or the Internet'*.

- iii) Under s.5(2)(b) based on opposed application No. 2219853, which consists of the words REED ONLINE, which was filed on 20 January 2000, stands in the name of Reed Employment Ltd, and is proposed to be registered for the same services as CTM 1341064.
- iv) Under s.5(3) based on UK registration No. 1296450 and CTM 1341064.
- v) Under s.5(4)(a) based on the opponent's common law rights in the mark REED as a result of carrying on a business since 1960 throughout the UK as an employment agency and offering related goods and services under that mark.

155. The complaint under s.5(2) is that use of the opposed mark in relation to all the opposed goods/services will result in a likelihood of confusion on the part of the public.

156. The complaint under s.5(3) is that use of the opposed mark in relation to all the opposed goods/services will take unfair advantage and be detrimental to the distinctive character and repute of the earlier REED marks because “[Executive] *has no control over the goods and services produced under the subject mark by [Elsevier] and cannot therefore control their quality or nature*” which “*may lead to loss of sales*”.

157. The complaint under s.5(4)(a) is that use of the opposed mark in relation to the opposed goods/services will constitute passing off in the light of Executive claimed goodwill under the mark REED in relation to ‘*employment agency and recruitment services and related goods and services*’.

158. Elsevier accepts that Executive has used the mark REED in respect of employment agency services. Other than that, the grounds of opposition are denied. In particular, Elsevier put Executive to proof of use that use of REED BUSINESS INFORMATION in relation to the opposed goods and services would be detrimental to the distinctive character or repute of Executive's earlier UK or CTM registrations of the mark REED.

The Section 5(2)(b) grounds

159. The proof of use provisions do not apply to this opposition because the opposed application was published on 16 April 2004, i.e. before the proof of use requirement in s.6A was introduced on 5 May 2004. Executive is therefore entitled to ask for its earlier marks to be protected for all the services for which they are registered.

160. It is obvious that the s.5(2)(b) grounds based on UK application 2219853 and UK registration 1296450 add nothing to the same ground based on CTM 1341064. I will therefore start by examining the s.5(2)(b) ground based on this earlier mark.

161. In most respects, Executive's s.5(2) ground of opposition to Elsevier's application is a mirror image of Elsevier's similar oppositions to Executive's

application to register REED ONLINE for recruitment services. The parties appear to agree that the closest services in the opposed application are advertising and publishing services. In the case of its own application, Executive denied that there was sufficient similarity between these services and recruitment services so as to justify Elsevier's oppositions based on earlier CTM 652909. Consistent with this position, Executive's primary position at the hearing was that its own s.5(2) opposition to Elsevier's application should similarly fail. However, if I was against the position that Executive took in defending its own application from Elsevier's s.5(2) attack, then its corresponding attack on Elsevier's application should succeed.

162. As I have accepted Executive's argument that there is insufficient similarity between the respective services so as to justify Elsevier's opposition to Executive's applications to register REED ONLINE and REED (alone) for recruitment services, it follows that I similarly reject Executive's s.5(2)(b) opposition to Elsevier's application to register REED BUSINESS INFORMATION for advertising and publishing services, which includes advertising/publishing job vacancies.

163. I adopt my earlier reasoning, with two adjustments. Firstly, I have accepted that Executive's extensive and very public use of the mark REED in respect of employment agency and recruitment services is likely to have materially enhanced the distinctive character of that mark to the point where it had an above average degree of distinctive character by the date of the opposed application. Secondly, I respectfully agree with the reasoning of the Court of Appeal (at paragraphs 37-41 of the judgment) that REED BUSINESS INFORMATION should not be regarded as identical to REED for the purposes of this comparison. The marks are plainly similar but the difference between them has some distinguishing effect. More such effect than in opposition 51136, where the comparison was between REED and REED ONLINE.

164. The first adjustment favours Executive, the second Elsevier. In my view, these factors cancel each other out in the overall assessment of the likelihood of confusion. I therefore come to the same conclusion, albeit for slightly different reasons, in this opposition as I did when looking at the same issue from the opposite perspective in to Elsevier's oppositions to Executive's application to register REED ONLINE for recruitment services. The s.5(2) grounds of opposition are therefore rejected.

The Section 5(3) ground

165. Section 5(3) is as follows:

"5(3) A trade mark which -
(a) is identical with or similar to an earlier trade mark,
(b) -
shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

166. The relevant case law can be found in the following judgments of the ECJ: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009]

ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L'Oreal v Bellure*. The law appears to be as follows.

- (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) The reputation of the earlier mark may extend beyond the consumers for the goods and services for which it is registered; *Intel, paragraph 51*.
- (d) It is necessary, but not sufficient, for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.
- (e) Whether such a link exists must be assessed globally taking account all relevant factors, including the degree of similarity between the respective marks and goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.
- (f) Although it is not a necessary factor, a link between the trade marks is necessarily established where the relevant public is caused to believe that the goods/services marketed under the later mark come from the owner of the earlier mark, or of an economically connected undertaking; *Intel, paragraph 57*.
- (g) Where a link is established, the owner of the earlier mark must also establish that it has resulted in the existence of one or more of the types of injury set out in the section, or there a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*: whether this is the case must also be assessed globally, taking account of all the relevant factors; *Intel, paragraph 79*.

167. Although the ground was not dropped at the hearing, it was not really argued either. The merits of the case were not mentioned at all in Mr St Quintin's skeleton argument. On behalf of Elsevier, Mr Bernhard took the position that Executive had not explained its case well enough for Elsevier to be able to meet it. I agree.

168. I do not doubt that, on the evidence, Executive has established that the mark REED enjoys the necessary reputation for employment agency and recruitment services to bring a s.5(3) opposition. I will assume, without formally deciding the matter that a section of the public coming across Elsevier's REED BUSINESS INFORMATION mark in relation to what has been described as 'recruitment advertising' will be caused to think about Executive's REED mark. Even if that is so, in order to make good the objection it is necessary for Executive to show that the effect of such a link would be to cause one of the injuries set out in the section. The

way that the ground is pleaded suggests that the complaint is about a likelihood of confusion, including the likelihood that consumers will believe that the users of the marks are economically connected. I have already considered and rejected that claim under the s.5(2) ground. It has no greater merit under this heading.

169. No other basis has been put forward (let alone proven) for the complaint that Executive's lack of control of the quality of Elsevier's goods and services may lead to loss of sales. In these circumstances, the s.5(3) ground must be rejected.

The Section 5(4)(a) ground

170. Mr St Quintin submitted that an aspect of Executive's opposition under this heading might succeed even if its s.5(2)(b) case did not. This is how he put it in his skeleton argument.

“Even adopting this primary position [that Executive's s.5(2)(b) ground based on registrations of REED for employment agency/recruitment services should fail for the same reasons as Elsevier's oppositions to its own applications for those services], however, there is no equivalent limitation on the opposition under s.5(4) because the goods and services it covers are wider than the goods and services of the existing [Executive] trade mark registrations. As set out above, Reed Executive has a substantial goodwill in relation to education and training. By reason of this, elements of class 41 for which registration is sought, namely the *“provision of information relating to education, entertainment and sport including the provision of such services electronically; education, entertainment and instruction by or relating to radio and television”* should be refused.”

171. Before I consider the merit of this point I must determine whether it is open to Executive to make it. As I pointed out at the hearing, the s.5(4)(a) ground is based upon Executive's claim to own goodwill under the mark REED in relation to *“employment agency and recruitment services and related goods and services”*. Executive's pleaded case does not mention any goodwill under the mark REED in relation to the provision of training and education services. Pleadings must be clear and unambiguous so that the other party knows the case it is being invited to meet. Accordingly, unless training and education services are apparent from the words *“...and related.... services”*, this objection is not within Executive's pleaded case.

172. In my view, the services in question are not discernible from the words *“...and related goods and services”*. Further, the type of educational and training services identified in Executive's evidence are mostly business vocational training rather than being related to employment agency and recruitment activities. This makes it even more difficult to accept that Executive's s.5(4)(a) pleadings in this opposition encapsulate the educational and training services described in its evidence.

173. I have asked myself whether the parties have nevertheless joined issue over that matter as a result of subsequent exchanges between them so that Executive's s.5(4)(a) case can be deemed to have been broadened so as to cover the goodwill it claims under the mark REED in relation to education and training. However, I do not think that I would be justified in making that finding. Elsevier filed two witness statements which are identified as relating to this opposition. The first dated 3 December 2008 is by Andrew Abernathy. That statement makes no reference to

Executive's goodwill in relation to education and training services. The second statement dated 17 July 2009 is by Joan Edmunds. That statement does describe Executive's trade in education and training services. In particular, it describes the business known as the Reed Business School. It mentions that the school runs courses in "*accountancy, business accounting, management accounts and financial planning*". The statement also describes Executive's goodwill under the names Reed Training and Reed Learning. These services are described as covering "*a wide range of subjects including marketing, law, accountancy, human resources, information technology, management, secretarial skills, sales, banking, finance and customer services.*"

174. I do not think that Elsevier could have been expected to understand that these were the "*related services*" (to employment agency and recruitment services) alluded to in the Notice of Opposition. Indeed Ms Edmunds witness statement uses the words "*employment agency, recruitment and related services*" (emphasis added) to describe Executive's "*core services*" before she goes on to state that Executive also provides education services (see paragraph 16 above).

175. Ms Edmunds' statement was also directed at defending Executive's application 2280946B to register REED for, inter alia, "*education and training services; none relating to employment agency and recruitment services*" from three oppositions brought by Elsevier. Executive's counterstatements in two of those oppositions specifically relied upon Executive's own goodwill under Reed Business School for education and training services. In these circumstances, Ms Edmunds' evidence about education and training services would naturally have been taken by Elsevier as relating to Executive's defence of application 2280946B rather than expanding the grounds of its own opposition to Elsevier's application to register REED BUSINESS INFORMATION.

176. This is consistent with Elsevier's evidence in reply. This consists of two witness statements by Nicola Amsel and Robert Perkins dated 19 November 2009 and 24 November 2009, respectively. Although headed as applying to all the (by then consolidated) oppositions before me, both statements are directed at the dispute between the parties about recruitment and (job) advertising services. Education services are not mentioned. Consequently, I can see no basis for concluding that, despite the absence of any express pleading by Executive, the parties have nevertheless joined issue over Executive claimed earlier right to REED for educational services in relation to Elsevier's application to register REED BUSINESS INFORMATION.

177. The s.5(4)(a) claim cannot therefore be considered insofar as it is based on an earlier right to REED for educational services. To the extent that it is based upon the pleaded goodwill in employment agency and recruitment services, it covers the same ground as the s.5(2)(b) case. I reject it for similar reasons. In short, Elsevier's use of REED BUSINESS INFORMATION in relation to "*provision of information relating to education, entertainment and sport including the provision of such services electronically; education, entertainment and instruction by or relating to radio and television*", would not amount to a misrepresentation in the light of Executive's goodwill under the mark REED for employment agency, recruitment services and

related goods and services, because the differences between the marks and services are sufficient to exclude the likelihood of deception.

178. The s.5(4)(a) ground is therefore rejected.

Conclusion on opposition No. 92625

The opposition is rejected.

OPPOSITION Nos. 96866, 96867 & 98868 - BY REED EXHIBITIONS LIMITED, REED BUSINESS INFORMATION LIMITED AND REED ELSEVIER GROUP PLC AGAINST APPLICATION No.2280946B IN THE NAME OF REED EXECUTIVE PLC

179. This was originally a part of application No. 2280946. The application was divided into two parts. The opposition to the 'A' part is covered above. The mark is again REED (alone). The filing date is 18 September 2001. The application covers the following services.

Class 41

Education and training; arranging and conducting of conferences, seminars, tutorials and workshops; none relating to employment agency and recruitment services.

180. Opposition 96866 by Reed Exhibitions Limited is based on a single ground under s.5(4)(a). The claimed earlier right is REED EXHIBITIONS, which it says has been used in the UK since 1987 in relation to conferences and events relating to a wide range of topics.

181. Opposition 96867 by Reed Business Information Limited is based on three grounds. The first is under s.5(2)(b) based on earlier UK trade mark 2270582, REED BUSINESS INFORMATION (unsuccessfully opposed by Executive - see above) which will therefore be registered for goods and services in Classes 9, 16, 35, 41 and 42. The second objection is under s.5(4)(a) and is based on Elsevier's claim to have an earlier right in the above named mark as a result of its use on the same goods and services relied on for the purposes of s.5(2)(b) ground.

182. The third objection is based on s.3(6). The application is claimed to have been filed in bad faith because Executive had no intention of using the trade mark, except in relation to services relating to employment agency and recruitment.

183. Opposition 96868 by Reed Elsevier Group Plc is also based on three grounds. Firstly, s.5(1) and s.5(2)(a) based on Elsevier's earlier CTM 652909 - REED, which is registered for, inter alia, '*arranging and conducting exhibitions, seminars and conferences*' in Class 41 and '*instructional and teaching material; printed publications*' in Class 16. Secondly, under s.5(4)(a) based on Elsevier's claim to have an earlier right in the same mark as a result of its use on the same goods and services relied on for the purposes of s.5(2)(b) ground. Thirdly, under s.3(6) because the application was made in bad faith. In this connection, Elsevier claims that Executive a) knew about its reputation under the mark REED for the services in the

opposed application, and b) had no intention of using the mark other than in relation to services relating to employment agency and recruitment services.

184. Executive denies the grounds of opposition and puts its opponents to proof of the claims made. In particular, Elsevier is put to proof of use of CTM 652909 – REED. In relation to the claims of bad faith, Executive states that it has been using the mark REED for many years as part of the name Reed Business School.

185. I find it convenient to start with the opposition 96867 under s.5(2)(b) based on Elsevier's earlier UK application 2270582 – REED BUSINESS INFORMATION. This application survived Executive's opposition (see above). It has not yet been registered. Consequently, even though the proof of use requirement apply to the opposed application, they do not cover this earlier mark by virtue of s.6A(1)(c). Thus (subject to the registration of the earlier mark) Elsevier is entitled to ask for it to be protected, inter alia, for:

Class 16
instructional and teaching material.

Class 35:
arranging and conducting trade shows.

Class 41:
arranging and conducting exhibitions, seminars and conferences; provision of information relating to education, including the provision of such services electronically; education and instruction by or relating to radio and television.

Similarity of goods and services

186. Executive's opposed services are:

Education and training; arranging and conducting of conferences, seminars, tutorials and workshops; none relating to employment agency and recruitment services.

187. The "*arranging and conducting seminars and conferences*" in Elsevier's earlier UK mark 2270582 are plainly identical to "*arranging and conducting of conferences, seminars; none relating to employment agency and recruitment services*" in the opposed application. Elsevier's services are not limited by subject matter and therefore cover seminars and conferences irrespective of subject. The exclusion applied to Executive's list of services does not therefore prevent the marks covering identical services.

188. I earlier found in paragraph 134 that '*arranging and conducting of workshops; all the aforesaid relating to employment agency and recruitment services*' in Class 41 of Executive's application were closely similar services to '*arranging and conducting seminars*' in Class 41. I adopt the same reasoning in reaching the same conclusion here.

189. Executive's application also covers '*education and training*' and '*arranging and conducting of tutorials*', '*none relating to employment agency and recruitment*

services'. Elsevier's earlier mark covers 'provision of information relating to education, including the provision of such services electronically' and 'education and instruction by.... radio and television'. I earlier found (at paragraphs 136 and 137) that these are very similar, if not identical services. I adopt the same reasoning in reaching the same conclusion here.

190. I have not overlooked that my earlier reasoning in opposition 92384 addressed the situation where the qualification to Elsevier's application was the reverse of the one that applies here, i.e. in the earlier opposition it was "all relating to employment agency and recruitment services". I do not think that the reversal of the qualification makes any difference. This is because Elsevier's mark is not restricted by subject and could therefore cover services on any of the subjects covered by either of the opposed applications.

Similarity of marks

191. The marks, REED and REED BUSINESS INFORMATION are not identical, but they are manifestly similar because the former mark is a major element of the latter mark and appears at the beginning of that mark. I accept that the additional words 'Business Information' distinguish the marks to some extent, but they must be considered to be highly similar.

Distinctive character of earlier mark

192. In my view, the mark REED BUSINESS INFORMATION has a below average level of distinctiveness for the services at issue in Class 41. It is a little more distinctive than Reed alone, but not much, particularly in relation to business events and business education. I have found no evidence that the mark's inherent distinctiveness has been enhanced to a different level as a result of its use in relation to the goods and services listed in paragraph 185 above. In reaching this conclusion I have not overlooked the fact that the mark has been used to promote a couple of exhibitions (see paragraph 40 above). However, that is not the same as finding that exhibitions have been arranged and conducted under that mark. And in any event, the evidence of such promotion is limited to just a few exhibitions.

The average consumer

193. The average consumer of the opposed services in Executive's application, namely:

'arranging and conducting of conferences, seminars, tutorials and workshops; none relating to employment agency and recruitment services', and

'education and training... none relating to employment agency and recruitment services',

- is likely to be a person seeking information, education or training, perhaps a person engaged in business or a profession. Such a consumer is likely to pay a reasonably high degree of attention when selecting the services at issue.

Likelihood of confusion

194. In my judgment, the use by the parties of the marks REED BUSINESS INFORMATION and REED in relation to, on the one hand, *'arranging and conducting exhibitions, seminars and conferences'* and on the other hand, *'arranging and conducting of conferences, seminars, and workshops'* is likely to cause confusion, including the likelihood that consumers will wrongly believe that there is an economic connection between the users of the respective marks. The identity/close level of similarity between the respective services combined with the high level of similarity between the marks is sufficient to justify this conclusion, despite the relatively low level of distinctive character of the earlier mark and the relatively high level of attention likely to be paid by an average consumer during the process of selecting these services.

195. For similar reasons, I also find that there is a likelihood of confusion, including the likelihood of association (again in the sense of indirect confusion) as a result of the use by the parties of the marks REED BUSINESS INFORMATION and REED in relation to, on the one hand, *'provision of information relating to education.....including the provision of such services electronically'* and *'education.... and instruction by radio and television'* and, on the other hand, *'education and training'* and *'arranging and conducting tutorials'*.

196. As the s.5(2)(b) ground is wholly successful, I do not find it necessary to consider the further objections based on s.3(6) or s.5(4)(a) in this opposition.

197. As the registration of the earlier mark for the services described above may turn on the outcome of any appeal against my decision in opposition 92625, I will also consider opposition 96868. The opposed application was published on 18 January 2008. CTM 652909 – REED - was placed on the register of Community trade marks on 6 April 1999, more than five years prior to the date of publication of application 2289946B.

198. Section 6A of the Act is as follows.

“6A Raising of relative grounds in opposition proceedings in case of non-use

(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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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 Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(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.”

199. Elsevier can therefore only rely upon this mark to the extent that it can show that it has been put to genuine use in the Community in the period between 19 January 2003 and 18 January 2008.

200. Elsevier relies, in particular, on the registration of the earlier CTM for *‘arranging and conducting exhibitions, seminars and conferences’* in Class 41 and *‘instructional and teaching material; printed publications’* in Class 16.

201. In accordance with s.100, the burden is on Elsevier to show use of the REED mark in the Community in relation to the above goods and services within the five year period specified above.

202. I earlier found that Elsevier has shown use of the mark REED EXHIBITIONS, mostly in combination with a device mark. There is no real dispute that such use has occurred. The issue between the parties is a) whether use of this mark counts as use of REED, and b) the range of services it has been used for. Despite the fact that the mark seems mostly to have been used in combination with a device mark there is some documentary evidence from which I am prepared to find that it was used as a word only mark during the relevant period. I have in mind, particularly, the use shown in exhibit JP3 to Ms Poole’s statement, which is described in paragraph 47 above. This is consistent with the evidence of Philip Soar. He says that Elsevier has always used the name REED EXHIBITIONS to brand their events.

203. On behalf of Executive, Mr St Quintin says that use of REED EXHIBITIONS is not use of REED and therefore does not show use of the REED CTM that Elsevier relies upon.

204. It is clear from s.6A(4)(a) that use of the earlier mark includes use in a form differing in elements that do not alter the mark’s distinctive character. Mr Bernhard for Executive says that this is the case here. The word ‘Exhibitions’ is purely descriptive in relation to exhibitions and therefore use of REED EXHIBITIONS is simply use of REED plus the name of the service. This difference in form cannot alter the distinctive character of REED alone. I agree. I think it can easily be

distinguished from the Court of Appeal's finding in the earlier litigation that REED BUSINESS INFORMATION was not use of an identical mark to REED. This case is different because:

- i) The Court of Appeal were considering whether those marks were identical for the purposes of infringement under s.10(1) of the Act, not whether the use of REED BUSINESS INFORMATION was use of REED in a form differing in elements which altered its distinctive character, and
- ii) The word 'Exhibition' is obviously 100% descriptive for exhibitions whereas 'Business Information' is descriptive in a more general way for printed and online publications, and therefore has the capacity to create a mark which is a bit more than just the name REED.

205. The Court of Appeal made a similar point to the one made in ii) above when, in paragraph 37 of the judgment, Lord Justice Jacob said:

"The use of capital letters is of some visual significance – it conveys to the average user that "Business Information" is part of the name. If the added words had been wholly and specifically descriptive – really adding nothing at all (eg "Palmolive Soap" compared to "Palmolive") the position might have been different [I assume the judge meant for soap]. But "Business Information" is not so descriptive – it is too general for that."

206. The implication is that the Court of Appeal would have held that Palmolive Soap was an identical mark to Palmolive. I find that Elsevier's use of REED EXHIBITIONS in relation to exhibitions can be accepted as evidence of use of the mark REED in a form differing in elements that do not alter its distinctive character. What about '*arranging and conducting, seminars and conferences*'? I have accepted that REED EXHIBITIONS has been used in respect of organising conferences since 1985. I will assume for present purposes that Elsevier organised conferences under the mark during the relevant period. I do not think that the word 'Exhibitions' is purely descriptive of conferences. 'Exhibition' is not another name for a conference. Reed Exhibitions is plainly a trading name like Reed Business Information. In my view, the addition of 'Exhibitions' to the mark REED does therefore alter its distinctive character when used in relation to conferences. The same would apply to seminars

207. I have not found any use of REED EXHIBITIONS in the relevant five year period in relation to seminars. That is not to say that seminars were not held at events arranged by Elsevier during the relevant five year period. However, there is no satisfactory evidence that these seminars were arranged and conducted by Elsevier (as opposed to exhibitors at the exhibition under their own marks) or that the mark REED EXHIBITIONS was used in relation to the arranging and conducting of seminars (as opposed to the name of the individual exhibitions, such as World Travel Market).

208. In any event, as I have found that use of Reed Exhibitions does not count as use of REED, except in relation to exhibitions, it follows that the CTM cannot be protected in respect of '*arranging and conducting conferences and seminars*'. There

is no evidence of use of REED (alone) or Reed Exhibitions in relation to ‘*instructional and teaching material; printed publications*’ in Class 16. There is use of the latter mark ON printed publications, but this use was ‘in relation to’ exhibitions.

209. I acknowledge that there is evidence of use of REED BUSINESS INFORMATION and device during the relevant 5 year period in relation to printed publications. This raises the question of whether this use counts as use of REED “*in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered*”. As I noted earlier, this is not the same question as whether the use of REED BUSINESS INFORMATION counts as use of an identical mark to REED. This is a difficult issue to resolve, particularly as Elsevier sometimes attaches significance to the distinguishing effect of the words ‘Business Information’. I will assume, without deciding the matter, that the use of REED BUSINESS INFORMATION for printed publications counts as use of REED for the purpose of s.6A(4)(a). Where would that get Elsevier?

210. The use shown of REED is in relation to various kinds of business publications, mainly magazines. Is this sufficient to justify protecting the CTM for ‘*instructional and teaching material; printed publications*’? In deciding the correct approach in law, I am indebted to Mr Justice Arnold (as he now is) who in his judgments as The Appointed Person in *Nirvana Trade Mark O-262-06* and *Extreme Trade Mark O-161-07* comprehensively examined the analogous case law under s.46(5). His conclusion in *Nirvana* was that:

“(1) The tribunal’s first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].

(8) The exercise of framing a fair specification is a value judgment:
ANIMAL at [20].”

211. In his later judgment in *Extreme*, Mr Arnold noted that in the light of the General Court’s intervening judgment in *Mundipharma AG v OHIM*, Case T-256/04:

“..the slightly more generous approach of Jacob J in *ANIMAL Trade Mark* is to be preferred to the slightly less generous approach of Pumfrey J in *DaimlerChrysler AG v Alavi* [2001] RPC 42.”

212. As I have already observed, there is no evidence of use of the mark in relation to ‘*instructional and teaching material*’. Mr Bernhard did try to persuade me that a magazine, like *New Scientist* (the high point of Elsevier’s case in this respect), is educational in nature. However, that could be said of virtually any publication. I do not think that an average consumer would describe that magazine as ‘*instructional and teaching material*’. The range of Elsevier’s other publications is sufficiently wide that I believe that an average consumer might describe them, collectively, (as Elsevier’s witness, Mr Kelsey does) as ‘magazines and directories’. Accordingly, I think that this would be a fair specification for the purposes of s.6A(6).

213. In my view, there is no similarity between these goods and ‘*education and training; arranging and conducting of conferences, seminars, tutorials and workshops; none relating to employment agency and recruitment services*’. The one is a product, the other a service. They are therefore different in nature. Although it could be said that one of the purposes of magazines and directories is educational, I do not think that this means that magazines and directories have the same purpose as education and training services. Nor do I consider that the fact that magazines and directories provide information means they share the same purpose as a conference, seminar or workshop. At most, any similarity of purpose is at the very highest level of generality. There is no evidence that the respective product and service are in competition with one another, and nor are they are not complementary in the sense set out in the case law. As the goods for which the earlier mark is entitled to be protected are dissimilar to the opposed services, the s.5(2)(b) objection based upon them is bound to fail. The question of whether REED BUSINESS INFORMATION counts as use of REED for the purpose of s.6A(4)(a) can therefore be left open.

214. I conclude that the only relevant services for which Elsevier is entitled to protect the CTM REED in these proceedings are ‘*arranging and conducting exhibitions*’.

Similarity of Marks

215. The earlier CTM is plainly identical to the mark applied for.

Distinctive Character of the Earlier Mark

216. I have accepted that, at the date of the opposed application in September 2001, the mark REED had an above average level of distinctive character in relation to the arranging and conducting of exhibitions. However, this is likely to reflect the perception of those who are actual or potential exhibitors at Elsevier’s events, more

than the perception of those attending exhibitions. The latter group are likely to recognise and remember Elsevier's exhibitions by the individual names under which they were run. For this group of consumers, the mark REED therefore had no more than an average level of distinctive character.

Average Consumer

217. The average consumer of '*education and training*' and '*arranging and conducting of tutorials and workshops; none relating to employment agency and recruitment services*' is likely to be a person seeking education or a business person or employee looking for education or training. Such consumers are likely to pay a reasonably high degree of attention when selecting the services at issue.

218. The average consumer of '*arranging and conducting of conferences, seminars, none relating to employment agency and recruitment services*' is likely to be either i) a business looking for an events organiser, or ii) a business or professional person looking for up to date information and discussion about a subject which reflects their field of interest. The first type of consumer is likely to pay an above average level of attention when selecting a service provider. The second type of consumer is likely to pay just an average level of attention.

Similarity of services

219. I find that '*arranging and conducting exhibitions*' is highly similar to '*arranging and conducting of conferences*'. Both are large events likely to be arranged by the same kind of events organiser. I accept that '*arranging and conducting of seminars*' is a little different because these are likely to be smaller events that could be arranged and conducted by a range of different types of organisations. However, as I noted earlier the description 'seminar' is used to describe both small scale conferences and also small educational study groups, similar to workshops and tutorials. Insofar as the description covers the first type of event, I find that '*arranging and conducting of seminars*' is also reasonably similar to '*arranging and conducting exhibitions*'.

220. The most relevant definition of 'workshop' in Collins English Dictionary is '*a group of people engaged in study or work on a creative project or subject*'. I therefore consider that '*arranging and conducting of workshops*' is an education or training service. '*Arranging and conducting exhibitions*' is an events organising service. An exhibition is primarily an informative event. It is therefore different in nature and purpose to an education service. The services are not in competition. The evidence of Mr Soar and Mr Nathan is that it is common for medium and large exhibitions to include educational seminars and workshops. I accept this evidence. The services may therefore be said to be complementary to exhibition services. And I also accept that if such services were provided as associated events at an exhibition, there would be an overlap between the relevant consumers. However, these last findings would only apply in the particular case of workshops held at exhibitions. The vast majority of workshops are not, of course, held at exhibitions. I find that, overall, there is a low degree of similarity between '*arranging and conducting exhibitions*' and '*arranging and conducting of workshops; none relating to employment agency and recruitment services*'. To the extent that '*arranging and*

conducting of workshops is a particular *education and training* service, such similarity as exists between the former and *arranging and conducting exhibitions* also extends to the latter description of services.

221. According to Collins English Dictionary, a tutorial is *'a period of intensive tuition given by a tutor to an individual student or to a small group of students'*. I do not consider that the sort of 'associated events' provided at exhibitions can properly be described as tutorials. Consequently, I see no similarity at all between *'arranging and conducting exhibitions'* and *'arranging and conducting of tutorials'*.

Likelihood of confusion

222. In view of the average or above average level of distinctiveness of the mark REED for exhibitions, the identity of that mark to the opposed mark, and the close similarity of services, I have no doubt that the use of Executive's mark in relation to *'arranging and conducting of conferences'*, would result in a likelihood of confusion.

223. I accept that the matter is more finely balanced in relation to *'arranging and conducting of seminars'* because the degree of similarity of services is a little less. However, bearing in mind that the meaning of 'seminars' extends to *'any group or meeting for holding discussions or exchanging information'*, I find that, on balance, there is a likelihood of confusion. In particular, I think that an average consumer of seminars of this kind would be liable to believe that REED seminars were arranged and conducted by the same undertaking responsible for REED exhibitions, or by an economically related undertaking.

224. The degree of similarity between *'arranging and conducting exhibitions'* and *'education and training; arranging and conducting of workshops; none relating to employment agency and recruitment services'* is lower again. I have considered whether there is a likelihood of confusion if Elsevier permitted Executive to organise workshops at its own exhibitions under the mark REED. However, I consider this an unlikely prospect. It seems likely that as the organiser of the exhibitions, Elsevier would have the means to prevent it from happening. The possibility of confusion arising in these circumstances therefore seems to me to be merely theoretical. I do not think that it would reflect the result of only normal and fair use of Executive's mark in relation to the services at issue. I do not find it likely that there would be any confusion if Executive conducted workshops under the mark REED anywhere else.

225. Therefore, taking account of the relatively high degree of attention likely to be paid by a consumer of this type when selecting the services, the average or above average distinctive character of the mark REED for arranging and conducting exhibitions, and the very low level of similarity between the services, I find that, despite the identity between the marks, there is no likelihood that the average consumer will be confused.

226. It follows from my earlier analysis, that the high point of any only possible similarity between *'arranging and conducting exhibitions'* and *'education and training'* is that the latter covers *'arranging and conducting of workshops'*. Consequently, my conclusion with regard to the use of REED for *'workshops'* also applies to the use of mark for *'education and training'*.

227. '*Tutorials*' are purely educational in nature and there is no evidence that they are commonly associated with exhibitions. The s.5(2)(b) based on CTM 652909 therefore also fails insofar as '*arranging and conducting tutorials*' is concerned.

228. Consequently, the s.5(2) objection based on CTM 652909 succeeds in respect of '*arranging and conducting of conferences, seminars*', but fails in respect of '*education and training*' and '*arranging and conducting workshops and tutorials*'.

The Section 3(6) and 5(4)(a) grounds

229. I will deal with these briefly. In the light of my earlier findings of fact on Elsevier's evidence, in particular that Elsevier has not established that it enjoyed a protectable goodwill under the mark REED in September 2001 in relation to education and training services, I find that Elsevier's case under s.5(4)(a) is no stronger than its case under s.5(2) based on CTM 652909. In particular, Executive's use of the mark REED in respect of '*arranging and conducting of tutorials and workshops*' and '*education and training*' services would not constitute a misrepresentation. Indeed my findings of fact indicate that Executive is the senior user entitled to claim goodwill under the name REED in relation to these services as a result of the use of the name Reed College since at least as early as January 1996. Consequently, the use of the mark REED by Executive for these services would not constitute a misrepresentation or passing off.

230. Executive has established that it operated Reed College and subsequently Reed Business School for a number of years prior to making the opposed application. In these circumstances, Elsevier's claim that Executive acted in bad faith in applying to register the mark REED for '*education and training services, arranging and conducting of tutorials, seminars and workshops*' is untenable. Executive's application to register the mark for these services was plainly made to protect a legitimate business interest. Given my findings so far, I do not consider it necessary to express any view as to the merits of the objection in relation to '*arranging and conducting of conferences*'.

231. Opposition 96866 by Reed Exhibitions Limited under s.5(4)(a) is based on a claimed earlier right in REED EXHIBITIONS as a result of the use of that mark in the UK since 1987 in relation to conferences and events. It will be readily apparent that this is the same objection that I have already considered in relation to opposition 96868. It cannot succeed to any greater extent than it did in that opposition. Consequently, there is no need for me to say anything more about it.

Outcomes of Elsevier's Oppositions to Application 2280946B

232. Opposition 96867 is wholly successful, but the refusal of the application is conditional on the registration of UK trade mark 2270582 – REED BUSINESS INFORMATION.

233. Opposition 96868 is partly successful, but '*arranging and conducting of tutorials and workshops*' and '*education and training*' services would survive that opposition.

234. Opposition 96866 would not succeed to any greater extent than opposition 96868.

OPPOSITION Nos. 94050 & 94052 - BY REED ELSEVIER GROUP PLC AND REED BUSINESS INFORMATION LIMITED AGAINST APPLICATION No.2399702 IN THE NAME OF REED EXECUTIVE PLC

235. The mark applied for is REED (alone). The filing date is 18 August 2005. The application covers the following services:

Class 42:

Legal services; arbitration, legal research and conveyancing services; advice, information and consultancy services relating to all the aforesaid services.

236. Opposition 94052 has two grounds of opposition which are still pursued. Firstly, that registration of the mark REED would be contrary to s.3(1)(b) because Reed is a common surname in the United Kingdom and devoid of any distinctive character for the services at issue. Secondly, that registration would be contrary to s.5(2)(b) because the mark applied for is similar to earlier trade marks UK 2270582 and CTM 3334786 – both REED BUSINESS INFORMATION – which cover the following services:

‘Provision of information relating to legal matters including such services provided electronically’.

237. CTM 3334786 is still pending. I dealt with the opposition to UK application 2270582 above. My decision on that application is therefore subject to appeal. However, it should be noted that the services listed above were not subject to opposition. Consequently, the mark will be registered for these services. It follows that the fate of CTM 3334786 is irrelevant to the outcome of this opposition and I need say no more about it.

238. Opposition 94050 has five grounds of opposition which are still pursued. Firstly, the s.3(1)(b) ground described above is repeated in this opposition (but plainly adds nothing to it). Secondly, there are grounds of opposition under s.5(1) and s.5(2)(a) based on Elsevier’s earlier CTM 652909 REED, which is registered for, inter alia, the services set out in the paragraph 116 above. Thirdly, under s.5(2)(b) based on earlier CTM 652834 – REED ELSEVIER, which is also registered for those services. Fourthly, under s.5(2)(b) based on earlier CTM 3980174 - REED BUSINESS INFORMATION and device, which is still pending but covers amongst many other things:

“software that enables users to electronically file documents with courts and government agencies; software that performs legal citation verification; software that selects and displays citations of related cases and other legal materials; software for producing tables of authorities in the field of law”.

239. Fifthly, under s.5(4)(a) based on Elsevier’s claim to earlier unregistered rights in the marks REED, REED ELSEVIER and REED BUSINESS INFORMATION in

respect of a wide range of goods and services as a result of the use of the first two marks since 2000, and the third mark since 1985.

240. Executive denies the grounds of opposition and puts Elsevier to proof of its use of CTMs 652909 and 652834, and also its claimed reputation and goodwill under the marks REED, REED ELSEVIER and REED BUSINESS INFORMATION in relation to relevant goods or services.

241. I find it convenient to start with the grounds raised in opposition 94052. I shall begin with the s.3(1)(b) ground. The relevant law in this area was set out by the ECJ in *Nichols plc v Registrar of Trade Marks*, Case C-404/02, which is reported at [2005] RPC 12. The relevant part of the judgment is as follows.

“Findings of the Court

22 Article 2 of Directive 89/104 contains a list, described as a ‘list of examples’ in the seventh recital in the preamble to that directive, of signs which may constitute a trade mark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings, that is to say to fulfil the trade mark’s function as an indicator of origin. That list expressly includes ‘personal names’.

23 According to Article 3(1)(b) of Directive 89/104, the distinctive character of a mark must be assessed in relation to the goods or services in respect of which registration is applied for and in relation to the perception of the relevant consumers (see Case C-299/99 Philips [2002] ECR I-5475, paragraphs 59 and 63, and Case C-218/01 Henkel [2004] ECR I-0000, paragraph 50).

24 In that regard, the provision concerned draws no distinction between different categories of trade mark (see, to that effect, Joined Cases C-53/01 to C-55/01 Linde and Others [2003] ECR I-3161, paragraph 42, and, regarding the identical provision in Article 7(1)(b) of Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1994 L 11, p. 1), the order of 28 June 2004 in Case C-445/02 P Glaverbel v OHIM [2004] ECR I-0000, paragraph 21).

25 The criteria for assessment of the distinctive character of trade marks constituted by a personal name are therefore the same as those applicable to the other categories of trade mark.

26 Stricter general criteria of assessment based, for example, on:

- a predetermined number of persons with the same name, above which that name may be regarded as devoid of distinctive character,
- the number of undertakings providing products or services of the type covered by the application for registration, or
- the prevalence or otherwise of the use of surnames in the relevant trade,

cannot be applied to such trade marks.

27 The distinctive character of a trade mark, in whatever category, must be the subject of a specific assessment.

28 In the context of that assessment, it may indeed appear, for example, that the perception of the relevant public is not necessarily the same for each of the categories and that, accordingly, it could prove more difficult to establish the

distinctive character of trade marks in certain categories than that of those in other categories (see, in particular, Henkel, paragraph 52, and, in relation to Article 7(1)(b) of Regulation No 40/94, Case C-468/01 P *Proctor & Gamble v OHIM* [2004] ECR I-0000, paragraph 36, and the order in *Glaverbel v OHIM*, paragraph 23).

29 However, such greater difficulty as might be encountered in the specific assessment of the distinctive character of certain trade marks cannot justify the assumption that such marks are a priori devoid of distinctive character or cannot acquire such character through use, pursuant to Article 3(3) of Directive 89/104.

30 In the same way as a term used in everyday language, a common surname may serve the trade mark function of indicating origin and therefore distinguish the products or services concerned where it is not subject to a ground of refusal of registration other than the one referred to in Article 3(1)(b) of Directive 89/104, such as, for example, the generic or descriptive character of the mark or the existence of an earlier right.

31 The registration of a trade mark constituted by a surname cannot be refused in order to ensure that no advantage is afforded to the first applicant since Directive 89/104 contains no provision to that effect, regardless, moreover, of the category to which the trade mark whose registration is sought belongs.”

242. The essence of Elsevier’s objection under this head is that surnames are commonly used in the field of legal services and therefore REED, being without doubt a common surname, is not capable of distinguishing the legal services of one undertaking from those of other undertakings.

243. I have a number of difficulties with this submission. Firstly, although I can take judicial notice of the fact that surnames in general (more particularly, combinations of surnames) are commonly used to distinguish partnerships providing legal services, there is no evidence that the name Reed is commonly used for legal services. Secondly, the approach that I am being invited to take appears to fly in the face of the ECJ’s guidance at paragraph 26 of its judgment in *Nichols*, particularly the remarks made under the third indent of that paragraph of the judgment. Thirdly, the submission ignores the possibility that the fact that a sign is of a kind customarily used in the relevant industry to indicate a trade source may not point to the conclusion that it lacks the capacity to distinguish relevant services.

244. I note that the ECJ made a similar point in paragraph 44 of its judgment in *SAT.1 Satellitenfernsehen GMBH v Office for Harmonisation in the Internal Market*, Case C-329/02 P, which is reported at [2005] E.T.M.R. 20. In that case the court considered whether the General Court had wrongly determined that the CTM ‘Sat.2’ was devoid of any distinctive character, partly because it was of the type of sign commonly used as trade marks in the relevant market. The court stated:

“44 The frequent use of trade marks consisting of a word and a number in the telecommunications sector indicates that that type of combination cannot be considered to be devoid, in principle, of distinctive character.”

245. In the present case, which also concerns a sign of a type commonly used in the relevant market to distinguish services according to their trade source, the ECJ’s statement highlights the need for evidence that the particular sign at issue is in such

common use as a source identifier that it cannot distinguish the services of one undertaking from those of the various other undertakings using that sign, or that the sign cannot distinguish for some other reason. There is no such evidence before me. Consequently, the objection is rejected.

246. I turn next to the s.5(2)(b) ground based on earlier trade marks UK 2270582 – REED BUSINESS INFORMATION, which covers the following services:

‘Provision of information relating to legal matters including such services provided electronically’.

247. The classification of services connected to the provision of information is determined by the classification of the subject services. Legal services are in Class 42 and so the provision of information about legal matters is also proper to that Class (by contrast, business and recruitment services are in Class 35, which is partly why I stated earlier that information services related to those services were not covered by one of Elsevier’s registration covering ‘access to interactive databases’ in Class 42).

248. The earlier mark is not yet registered. Accordingly, the requirement of s.6A to show use of the earlier mark does not apply.

Similarity of services

249. The opposed application covers:

Class 42:

Legal services; arbitration, legal research and conveyancing services; advice, information and consultancy services relating to all the aforesaid services.

250. The core of the possible meanings of ‘*legal services*’ is, in my view, legal advice, legal representation and the drawing up of legal documents. These are the services normally provided by a lawyer.

251. The earlier mark covers ‘*provision of information relating to legal matters*’. In my judgment, this is different to ‘*legal services*’, including legal advice. Consumers would look to an information provider for legal information, but look to a lawyer for legal services, including legal advice, which involves an evaluation of legal information. There is nevertheless, some similarity in purpose and the same consumers would be involved. That does not mean very much here, however, because the relevant consumer group covers everyone. In my view, the nature of the services is different (one being a professional advice service, the other a mere provider of raw information). And although there may be times when one would decide to use an information service so as to work out the answer to a legal problem oneself, the services are not really in competition. Consequently, I find that there is only a very low degree of similarity between ‘*provision of information relating to legal matters*’ and ‘*legal services*’.

252. ‘*Conveyancing services*’ are concerned with the transfer of the legal title to a property. They are often provided by a lawyer, although not necessarily so.

'Arbitration' services are concerned with dispute resolution. They are quasi legal services.

253. I adopt similar reasoning for holding that 'conveyancing services' have only a low level of similarity to 'provision of information relating to legal matters'. If anything, the similarity between these services and 'arbitration' services is even less because their respective purpose seems rather different.

254. 'Legal research services' suggests bespoke research whereas 'provision of information relating to legal matters' implies access to raw data. However, these services are highly similar because they share a similar purpose, are related in nature (both being information services), and in some circumstances could be in competition with one another. The respective users are also likely to be the same.

255. I find that 'information relating to legal services, arbitration, legal research and conveyancing services' is identical to the services for which the earlier mark is protected.

256. As legal advice is part and parcel of legal services I think that 'advice relating to legal services' must have a broader meaning including legal research services, which I have held to be highly similar to the services for which the earlier mark is protected. Advice relating to legal research must include information services relating to legal matters, which I have found to be identical services. Advice relating to arbitration and conveyancing is highly similar to the services for which the earlier mark is protected. Accordingly, I find that 'provision of information relating to legal matters' is identical or highly similar to 'advice services relating to legal, arbitration, legal research and conveyancing services'.

257. I confess that I have not found it easy to determine what 'consultancy services relating to legal research' means. It could be just another way of describing legal research services provided on a consultancy basis. On that basis it has the same highly similar relationship to 'provision of information relating to legal matters' as 'legal research'.

258. Similarly, 'consultancy services relating to legal services, arbitration, and conveyancing' is a rather nebulous term capable of covering, or at least including, an information service. I therefore also find that these services are also reasonably similar to 'provision of information relating to legal matters'.

Similarity of marks

259. I adopt my earlier findings in paragraph 191 above, that the respective marks are highly similar.

Distinctive character of earlier mark

260. I adopt my earlier finding at paragraph 192 above, that the mark REED BUSINESS INFORMATION (as a whole) has an average distinctive character for the services at issue. The common element – REED – has a below average level of distinctive character for the reasons given earlier. On the basis of my earlier findings

of fact, I do not consider that the mark's inherent distinctiveness has been enhanced through any use shown to have been made of it in relation to legal information services (for which I have found none).

Average consumer

261. The average consumer for legal, legal research and arbitration services, is likely to be someone with a legal problem or matter to resolve. The average consumer of conveyancing services is likely to be some interested in buying or selling a property. There is likely to be some overlap in each case with potential users of legal information services and those seeking consultancy and advice about the above named services.

262. The user of legal, legal research, arbitration and conveyancing services is likely to pay an above average level of attention when selecting a service provider. The users of related advice, information and consultancy services may not pay quite such a high level of attention when selecting a service provider, but will pay at least an average level of attention.

Likelihood of confusion

263. I find that there is a likelihood of confusion as a result of the use by the parties of the marks REED and REED BUSINESS INFORMATION in relation to, on the one hand, '*provision of information relating to legal matters including such services provided electronically*' and, on the other hand, '*legal research, advice, information and consultancy services relating to legal services, arbitration, legal research and conveyancing services*'.

264. In my view, the identity or high level of similarity between the respective services and the high level of similarity between the marks outweighs the modest distinctive character of the common element of the marks – REED and the relatively high level of attention likely to be aid by consumers when selecting these services. Consequently, an average consumer is likely to be confused into believing that the marks are used by the same service provider, or that there is an economic connection between them.

265. I find that the objection fails for:

Legal services; arbitration, and conveyancing services.

266. These services have only a low degree of similarity to the services covered by the earlier mark. In this case, the differences between the marks combined with the particularly high level of attention likely to be paid by consumers when selecting these services is sufficient to exclude the likelihood of confusion.

267. This brings me to opposition 94050. The first ground of opposition in that opposition under s.3(1)(b) mirrors the ground that I have already considered and rejected in opposition 94052. I reject it again here, and for the same reasons.

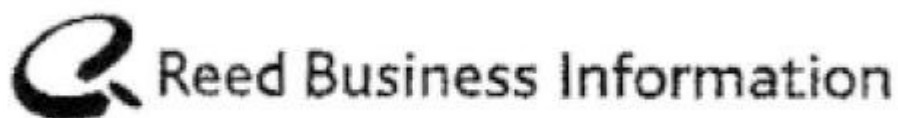
268. The second objection is under s.5(1) and s.5(2)(a) based on Elsevier's earlier CTM 652909 – REED. The closest services to those covered in the opposed application are again '*provision of information relating to legal matters including such services provided electronically*'. These are the same services that I have already considered in connection with the s.5(2)(b) objection in opposition 94052. However, Elsevier's case is potentially a bit stronger here because in this case the respective marks are identical.

269. The earlier CTM had been registered for five years at the date of publication of the opposed application. Consequently, the provisions of s.6A apply and Elsevier is only entitled to rely upon this CTM to the extent that it met Executive's challenge to show genuine use of it in the five year period ending on the date of publication, i.e. 15 October 2000 to 14 October 2005.

270. I earlier found that there is no evidence of genuine use by Elsevier of REED in relation to legal information services. Consequently, the s.5(1) and 5(2)(a) round based on CTM 652909 must be rejected.

271. I also reject the ground of opposition based on CTM 652834 – REED ELSEVIER, which is also registered for legal information services. This mark has also been registered for five years prior to the date of publication of the opposed mark, so the requirements of s.6A also apply to this earlier mark. Again, I have found no use of this mark in relation to legal information services in the period 15 October 2000 to 14 October 2005, or at all. The s.5(2)(b) objection based on this mark must therefore be rejected. In any event, REED ELSEVIER is plainly less similar to REED than REED BUSINESS INFORMATION, which I have already considered for the same services. The opposition based on REED ELSEVIER could not succeed to any greater extent than the opposition based on REED BUSINESS INFORMATION.

272. That brings me to the final s.5(2)(b) ground based on earlier CTM 3980174, which looks like this.



273. This is an earlier trade mark than the opposed mark because it was filed at the Community Trade Mark Office on 1 September 2003. It is still pending. I understand that it is the subject of an opposition by Executive. Consequently, s.6A does not apply to this mark, but the objection based upon it is subject to the registration of the mark.

Similarity of services

274. Elsevier relies, in particular, on the following goods in Class 9:

‘Software that enables users to electronically file documents with courts and government agencies; software that performs legal citation verification; software that selects and displays citations of related cases and other legal materials; software for producing tables of authorities in the field of law’.

275. Given my earlier findings, I only find it necessary to consider the objection based on the above pending CTM in relation to the services which will survive opposition 94052. These are:

‘Legal services; arbitration, and conveyancing services’.

Similarity of goods and services and likelihood of confusion

276. Elsevier’s goods are plainly different in nature to Executive’s services, the one being a product, the other a service. In my view, the purpose of the goods and services is also different. Executive’s mark covers legal professional services and certain associated services. The purpose of those services is to assist the user with a legal problem or issue. Elsevier’s goods may be used by those providing legal services, but their purpose is limited to filing documents, displaying legal citations and authorities etc. The respective consumers are likely to be different. Legal services are offered to end users. The user of Elsevier’s software is, by contrast, likely to be the legal professional himself. The goods and services are plainly not in competition. Nor are they complementary, which must be viewed from the perspective of the consumer. Accordingly, I find that the goods and services are dissimilar and a likelihood of confusion can therefore be ruled out.

Section 5(4)(a) ground of opposition

277. This brings me to the final ground of opposition, which is Elsevier’s objection under s.5(4)(a) based on its claim to earlier unregistered rights in the marks REED, REED ELSEVIER and REED BUSINESS INFORMATION services.

278. Elsevier’s pleaded case under this heading is rather skeletal. It is easier to understand from the facts originally pleaded in support of a s.5(3) ground, which was subsequently dropped. The first of these is as follows.

“The Opponent is a worldwide publishing company which was established in the United Kingdom over 100 years ago. In the United Kingdom, the Opponent has used the mark REED consistently since this time, and REED ELSEVIER since 1962, in relation to a range of publications and related products and services. With the purchase of the Butterworth business in approximately 2000, the REED/REED ELSEVIER trade marks have been used consistently in relation to the provision of legal information and publications relating to legal matters. Titles published by the Opponent company include Halsbury’s Laws of England. The Opponent believes that its marks are known to all legal practitioners in the United Kingdom. In these circumstances, it is submitted that the use and registration of the Applicant’s mark REED would erode the Opponent’s exclusivity in its marks REED and

REED ELSEVIER, and the public would be misled into thinking that the Applicant's activities under the mark applied for were somehow connected with the Opponent and its REED/REED ELSEVIER trade marks. It is also submitted that the Applicant's use and registration of the trade mark REED could inhibit the Opponent's trading activities in the future.

279. The difficulty with the reliance placed on the names REED and REED ELEVIER is that it conflates Elsevier's corporate names and its ownership of businesses that provide legal publications and legal information services, such as Butterworth's and Lexis Nexis, with the ownership of goodwill in relation to these services under the marks REED and REED ELSEVIER. Goodwill is the attractive force which brings in business. The law only protects signs which are distinctive of a particular business. It is therefore necessary to show that the marks have been used in a public way to the customers of that business or that the marks have in some other way become distinctive of that business to the relevant public.

280. In my judgment, Elsevier's evidence does neither. Consequently, as showing that unregistered marks are distinctive of the goods or services for which protection is sought is the first requirement that must be satisfied in order to establish a passing off right, Elsevier's case based on REED and REED ELSEVIER falls at the first hurdle.

281. Further, even if I wrong about that, I do not think that Executive's use of REED in relation to:

'Legal services; arbitration, and conveyancing services.'

- would cause deception and thereby constitute a misrepresentation, which is the second necessary condition that must be satisfied in order to establish a passing off right. This is because Elsevier's goodwill as a publisher is exactly that. No one would expect the publisher of Butterworth's to provide them with legal services, including legal advisory services. Similarly, Lexis Nexis is an on-line legal information service. No one would expect it to provide legal services as such. Further still, even if Elsevier had goodwill under a REED name at the relevant date, it would not have been under the word REED alone, but under the one of its corporate names such as REED ELSEVIER. Consequently, the s.5(4)(a) case cannot be any stronger than the case I have considered under s.5(2)(b) based on registrations of REED BUSINESS INFORMATION.

282. The third s.5(4)(a) case, based on Elsevier's goodwill under the name REED BUSINESS INFORMATION appears to be as follows.

“Reed Business Information, part of Reed Elsevier Group Plc, is one of the world's leading business to business publishers, with a portfolio of more than 100 news and information products, awards, conferences and directories covering 18 markets. These publications and related information services are used and referred to by businesses worldwide, including the UK, and are a common legal research resource.”

283. This is similar to the case that I have already considered and rejected under s.5(2)(b) based upon Elsevier's earlier trade mark REED BUSINESS

INFORMATION. I reject it because a) there is no likelihood of confusion or deception for the reasons I gave earlier, and b) there is also no evidence that the mark REED BUSINESS INFORMATION has been used (and thereby acquired a goodwill) in relation to legal publications.

Conclusion on oppositions 94050 and 94052 to application 2399702

284. The oppositions are partly successful. The application will be refused, except for the following services:

'Legal services; arbitration, and conveyancing services.'

COSTS

285. Elsevier's opposition to application 2219853 has failed. The opposition to application 2280946A was mostly successful. Opposition 96867 to application 2280946B was successful and oppositions 96866 and '868 to the same application were partially successful. Oppositions 94050 and '052 to application 2399702 were partly successful. Executive's opposition to application 2270582 failed. Overall Elsevier has been more successful than Executive and is entitled to a contribution towards its costs. Both sides were content for costs to be assessed in the usual way from the Registrar's scale. I therefore order Reed Executive plc to pay Reed Elsevier Group plc the sum of £4000. This sum to be paid within 14 days of the end of the period permitted for appeal.

286. My reasons for awarding this sum are that:

- i) Elsevier's failed opposition to application 2219853 and Executive's failed opposition to application 2270582 cancel each other out.
- ii) The outcome oppositions 94050 and 94052 to application 2399702 was a draw.
- iii) The award should therefore be based upon Elsevier's mainly successful opposition to application 2280946A and its successful opposition 96867 to application 2280946B.
- iv) The award should take account of the overlap between the evidence filed in support and defence of those oppositions.

287. On that basis my award breaks down as:

£400 to cover the official opposition fees
£400 towards the cost of preparing the notices
£400 towards the cost of considering the counterstatements
£1800 towards the cost of filing evidence and considering Executive's evidence
£1000 towards the cost of the hearing, including skeleton argument.

IMPLEMENTATION

288. Subject to appeal, my decisions on applications 2219853, 2280946A, 2270582 and 2399702 will take effect immediately following the end of the appeal period. The implementation of my decision on application 2280946B is subject to appeal and the registration of application 2270582.

Dated this 31 Day of March 2010

**Allan James
For the Registrar**