

O-060-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION Nos. 2466223 AND 2466224  
IN THE NAME OF LEEDS METROPOLITAN UNIVERSITY

AND

OPPOSITIONS THERETO UNDER Nos. 97639 AND 97640  
BY CARNEGIE MELLON UNIVERSITY

## TRADE MARKS ACT 1994

**In the matter of Application  
Nos. 2466223 and 2466224  
in the name of Leeds  
Metropolitan University  
and oppositions thereto  
under Nos. 97639 and 97640  
by Carnegie Mellon University**

### Background

1. Leeds Metropolitan University ("LMU") applied on 7 September 2007 for registration of the following marks:

2466223



2466224



2. In each case, registration is sought in respect of a range of goods and services in twenty three classes of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. Full details of each application are given at Annex 1 to this decision.

3. Following publication of the applications in the *Trade Marks Journal*, Notices of Opposition were filed against them by Carnegie Mellon University (“CMU”). CMU’s oppositions are brought on the following grounds:

- Under section 5(2)(b) based on its community trade mark 3974151:



Further details of this mark are given in Annex 2 to this decision. This objection is brought in respect of the goods and services of the applications in classes 16, 35, 41, 42 and 43 only;

- Under section 5(4)(a) based on use since at least 1968 in Bradford of the mark CARNEGIE MELLON in respect of tertiary education, other educational services and research. This objection is brought in respect of all goods and services of the applications;
- Under sections 5(2)(b) and 5(3) based on the unregistered mark CARNEGIE MELLON which it says is a well-known mark in the UK within the meaning of section 56 of the Trade Mark Act and Article 6bis of the Paris Convention. This objection is brought in respect of all goods and services of the applications.

4. LMU filed counterstatements in which it admits CMU is recorded as the registered proprietor of the community trade mark 3974151 but which otherwise denies all of the claims made. It also puts CMU to proof of its claimed reputation.

5. The proceedings were consolidated. Both parties filed evidence and the matter came before me for hearing on 26 November 2010. LMU was represented by Mr Hugo Cuddigan of Counsel, instructed by Pinsent Masons LLP. CMU was represented by Mr Benet Brandreth of Counsel, instructed by Haseltine Lake LLP.

## **Evidence**

6. Evidence was filed on behalf of CMU by Jane More O’Ferrall, a trade mark attorney with Haseltine Lake LLP and Robbee Baker Kosak who is Vice President of University Advancement. LMU filed evidence through Deborah Susan Ruth Bould, a solicitor with Pinsent Masons LLP and Stephen John Denton who is Registrar and Secretary of LMU. Ms More O’Ferrall also filed evidence in reply.

### CMU’s evidence

7. Ms Kosak’s witness statement is dated 23 April 2009. She explains that she has been Vice President of University Advancement for over nine years and that her responsibilities include all global activities relating to marketing and media relations, alumni relations and private fundraising. Attached to her witness statement are fourteen exhibits. Details of these are as follows:

RBK1A: pages from Carnegie Mellon Factbook 2008-2009 published February 2009. This states that in 1900 the Carnegie Technical School was founded by Andrew Carnegie. In 1912 it became the Carnegie Institute of Technology and was known as Carnegie Tech. In 1967, Carnegie Tech merged with the Mellon Institute to become CMU. CMU is made up of seven colleges, has campuses in Qatar as well as in Silicon Valley and also 'plays host' to the Software Engineering Institute (SEI). The SEI was founded in 1984 and is said to be a federally-funded research and development centre which advances software engineering and related disciplines and created useable technologies. It is sponsored by the US Department of Defense and operated by CMU;

RBK1B: a summary prepared by CMU on 9 March 2009. The summary is said to be the result of monitoring of various publications of university rankings which include CMU;

RBK1C: a similar summary as at RBK1B but prepared 9 April 2007;

RBK1D: a copy of the Times Higher Education World University Rankings of 2008;

RBK1E: prints taken from CMU's website as at April 2009 showing its departmental foreign exchange programs. This shows the Art Department of CMU to have offered exchanges with the Duncan Jordonstone college of Art and Design in Dundee and the Glasgow School of Fine Art. The Chemical Engineering department similarly offered an exchange with Imperial College London and the English department with the University of Strathclyde;

RBK1F: prints taken from CMU's website as at April 2009 showing various of its foreign sponsored programs which offers the opportunity to study outside the US, including at the Architectural Association of London, London School of Economics, University College London and the University of Manchester;

RBK1G: a print taken from the Imperial College London website which bears a copyright date of 2009. The page details the opportunity for students in the Department of Chemical Engineering and Chemical Technology to spend their third or fourth years of study abroad and which includes time at CMU;

RBK1H: a print of CMU's website as at 16 March 2009 referring to dual or joint degrees between Carnegie Mellon Heinz College and the University of Oxford being available;

RBK1I: a list of Nobel Prize winners said to be "affiliated with CMU as faculty or alumni";

RBK1J: a list of A M Turing Award winners said to be "affiliated with CMU as faculty or alumni";

RBK1K: a list of what are said to be notable alumni of CMU;

RBK1L: a print from CMU's website giving details of the Software Engineering Institute and its areas of work;

RBK1M: a copy of a press release of 29 May 2008. It advertises Carnegie Mellon Software Engineering Institute's hosting of a conference on 'The Future of Performance Improvement' in Germany in June 2008; and

RBK1N: details of the SEPG 2009 Europe conference held in Prague in June 2009 and which is said to have been hosted by CMU's Software Engineering Institute.

8. Ms More O'Ferrall's first witness statement introduces, at JMOF1A, a print from the Times' website as of 18 March 2009 (after the relevant date) showing a list of UK universities in order of national ranking. 'Leeds Metropolitan' is ranked at number 96, however, I do not know the basis of this ranking because whilst the print is presented as a table showing numerous figures, nowhere is it explained what any of them mean. Ms More O'Ferrall's second witness statement, filed in reply, explains how, on 7 May 2010, she carried out a Google search against the combined words "leeds carnegie". She exhibits the following:

JMOF2: a copy of the first five pages of hits from her search;

JMOF3: pages from the website of Carnegie College in Dunfermline.

#### LMU's evidence

9. Ms Bould's witness statement consists substantially of submission and a critique of CMU's evidence. For this reason I do not intend fully to summarise it but do take her comments into account in reaching my decision. Ms Bould states that LMU has been trading under the name CARNEGIE in the UK since 1933 and is the proprietor of numerous registered trade marks incorporating the name, details of which she exhibits at DSRB1. Whether LMU has other registered trade marks that predate the earlier mark relied upon by CMU cannot affect the outcome of the case in relation to these grounds. As was explained by the Court of First Instance in *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) OHIM* T-269/02:

"24. Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener's mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25. In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.

26. The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (Case T6/01 Matratzen Concord v OHIM-Hukla Germany (MATRATZEN) [2002] ECR II 4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities."

10. Ms Bould states that both CMU and LMU share a common heritage in that both were founded partly through the philanthropy of Andrew Carnegie. Ms Bould also exhibits, at DSRB3, the results of a Google search carried out for the word CARNEGIE alone and in relation to tertiary education and other educational services and research. At DSRB4 she exhibits a summary of UK and Community trade marks owned by third parties which contain the word and are registered in relation to these services. At DSRB5 Ms Bould exhibits a list which she indicates are statistics published by the International Telecommunications Union and which sets out the number of internet users in the UK in 2007.

11. Mr Denton's witness statement is dated 23 March 2010. He explains how Andrew Carnegie established a number of organisations worldwide including the Carnegie UK Trust which was responsible for establishing LMU's Carnegie College of Physical Training as well the Carnegie Technical School which was a predecessor of CMU.

12. Mr Denton gives the history of LMU. He says that the Carnegie College of Physical Training was officially opened in 1933 and that the name Carnegie has been consistently used since then. He explains that following expansion, in 1968 the Carnegie College merged with the City of Leeds College of Education to form the City of Leeds and Carnegie College. This college then merged with Leeds Polytechnic in 1976. Following the merger, one of the faculties was the Carnegie School of Physical Education which, in 1992, was renamed to become the Faculty of Cultural and Educational Services with the Carnegie name being used for the Carnegie National Sports Development Centre and a professorship, until the creation of the Carnegie Faculty of Sport and Education in 2004.

13. Mr Denton states that LMU has sponsored and partnered with various sports teams, sporting events and educational and health programmes through which it has used the Carnegie name and, at SJD1 and SJD2, exhibits examples of these. At SJD3 he exhibits what he describes as various documents demonstrating examples of LMU's use of the Carnegie name. The earliest of these date from December 2007.

14. Mr Denton states the two parties have peacefully co-existed and that he is not aware of any confusion between the respective parties' use of the name.

15. That concludes my summary of the evidence to the extent I consider it necessary.

**The objection under section 5(2)(b) based on Community Trade Mark  
No. 3974151**

16. Community trade mark No. 3974151 was applied for on 3 August 2004 and has a priority date, from the United States, of 2 February 2004. It is an earlier mark under the provisions of section 6 of the Act. The earlier mark completed its registration procedure on 12 January 2006 which is less than five years before the publication dates of both of LMU's applications. That being so, CMU's earlier mark is not subject to the proof of use requirements set out in section 6A of the Act.

17. Section 5(2)(b) of the Act reads:

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

(a) ...

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

18. In determining the question under Section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (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*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B. V.* paragraph 27;

(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*, paragraph 23;

- (d) the visual, aural and conceptual similarities of the marks must therefore 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*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) 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*, paragraph 24;
- (g) in determining whether similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer inc*; mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but 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*, paragraph 29;
- (j) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*;
- (k) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L Laudato & C. Sas v OHIM*.

19. In essence, the test under Section 5(2)(b) is whether there are similarities in marks and goods which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be



attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

### Comparison of goods and services

20. Whilst LMU accepts that there is “some identity” in respect of the respective goods and services, it does not explain this further. I therefore go on to compare them in some detail. CMU’s objection under this ground was originally directed at LMU’s applications insofar as they cover goods and services (identically worded in both cases) in classes 16, 35, 41, 42 and 43 (See Annex 1). In his skeleton arguments, Mr Brandreth adjusted that position somewhat. Taking these concessions into account, the goods and services to be compared are as follows:

LMU’s applications	CMU’s earlier mark
Printed matter; newspapers; periodical publications; magazines; books; booklets; instructional and teaching materials.	Printed publications, namely instruction manuals, books, articles, reports and printed guidelines concerning organizational development and design capabilities
Business appraisals; <i>business administration services</i> ; business advice and inquiries; compilation and provision of business, trade or commercial information; compilation of business directories; business investigations; business management services; advice relating to business management and organisation; operational business services; business planning; writing or preparation of business reports; business research and surveys; commercial management assistance; economic forecasting and analysis for business purposes; business advisory services relating to franchising; market analysis, research and surveys; business advice relating to marketing; marketing; marketing studies and profit surveys; preparation of project studies relating to business matters; arranging and conducting business or trade shows; provision of business statistical information; business statistical studies; business statistical services; <i>auditing services</i> ; <i>computerised data base management</i> ; <i>computer data processing and data verification</i> ; <i>computerised business information storage and retrieval</i> ; business or commercial information agency services; professional advisory and consultancy services; all relating to commercial or industrial undertakings.	Business appraisal consulting services in process appraisal to organizations engaged in the acquisition or production of products and services

<p><i>Vocational education and training services; teaching, tuition, training and instruction services, all being educational or vocational; provision of courses of instruction; provision of correspondence courses; education examination services; arranging and conducting educational conferences, conventions, lectures, exhibitions, day schools, workshops and seminars; rental of educational material and apparatus; research, advisory and consultancy services, all relating to education and training; provision of training facilities for the teaching of vocational skills; provision of information and preparation of reports relating to training, and vocational skills; vocational guidance; testing of individuals to determine employment skills; management training services; training in the use or operation of computers; publication of books, magazines, journals, printed matter, texts, periodicals, photographs and instructional and training materials; professional consultancy and research services relating to vocational matters; preparation of reports relating to vocational matters.</i></p>	<p>Providing training in process appraisals to organizations engaged in the acquisition or production of products and services</p>
<p><i>Research and development of new products; industrial research development and testing; laboratory research and testing services; laboratory services; design and testing of new products; preparation of statistics for scientific research purposes; scientific testing; technological research; technological consultation services; testing of materials and products; inspection of plant and machinery; preparation of engineering drawings; engineering research and consultancy ; commercial and industrial design services; information technology and computing services; computer programming; design and development of computer software and hardware; computer consultancy; rental of computers, computer software.</i></p>	<p>Computer consultation services, namely providing assessment services to businesses and governmental agencies and units to determine their computer development and design capabilities</p>

21. The goods and services which appear in italics are those which CMU submits are similar to LMU's goods and services. All other goods and services are, it submits, identical.

22. The Trade Mark Registry's Classification Manual states, at 5.2.27:

"Note that specifications including 'namely' should be interpreted as only covering the named goods. Thus, in the above 'dairy products namely cheese

and butter' would only be interpreted as meaning 'cheese and butter' and not 'dairy products' at large. This is consistent with the definitions provided in Collins English Dictionary which states 'namely' to mean 'that is to say' and the Cambridge International Dictionary of English which states 'which is or are'."

23. I bear this in mind when considering CMU's specification of goods and services in classes 16 and 42.

24. In considering the similarity or otherwise of the goods and services and following the established tests in *Canon and British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] RPC 281, I am required to consider the nature of the goods and services, their intended purpose and method of use, their users and channels of trade and whether the goods and services are in competition with each other or complementary to each other.

25. I also bear in mind that goods and services can be considered identical when those designated by the earlier mark are included within a more general category designated by the trade mark application and vice versa (as per *Gérard Meric v OHIM*).

26. In making a comparison of the respective services, I bear in mind the following guidance in *Avnet Inc v Isoact Ltd (Avnet)* [1998] FSR 16:

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

### **LMU's goods in Class 16**

27. Each of CMU's goods as specified in class 16 are included within the term *printed matter* as appears in LMU's specification of goods in class 16 and are therefore identical goods. In addition, I consider *instruction manuals* as appears in CMU's specification to be included within LMU's *instructional and teaching materials* and within *periodical publications. Articles, reports and printed guidelines* are included within LMU's *periodical publications*. All of these are, therefore, considered to be identical goods. *Books* appear in both specifications and are identical goods. That leaves *newspapers, magazines and booklets* each of which I consider to be identical to *books, articles, reports and printed guidelines* as appears in CMU's specification.

### **LMU's services in class 35**

28. CMU's *business appraisal consulting services* in class 35 are limited to those concerning *process appraisal to organizations engaged in the acquisition or production of products and services*. As these are services which are included within LMU's *business appraisals* in the same class, they are identical services. An audit is a quality management tool which provides an appraisal and evaluation of e.g. a

process and therefore I consider *auditing services* as appears in LMU's application to be identical to CMU's *business appraisal consulting services*.

29. An appraisal of a process involves identifying, researching, collecting and analysing that process and reporting and advising on the resultant findings. For these reasons I consider:

*Business administration services; business advice and inquiries, compilation and provision of business, trade or commercial information; business investigations; business management services; advice relating to business management and organisation; operational business services; business planning; writing or preparation of business reports; business research and surveys; commercial management assistance; economic forecasting and analysis for business purposes; business advisory services relating to franchising; market analysis, research and surveys; business advice relating to marketing; marketing studies and profit surveys; preparation of project studies relating to business matters; provision of business statistical information; business statistical studies; business statistical services; business or commercial information agency services; professional advisory and consultancy services, as appear in LMU's specification in class 35 to be similar services to those of CMU.*

30. LMU's specification in this class also covers *compilation of business directories* which I consider to be similar to *books* as appears in CMU's specification in class 16. A directory may be in book form and there is a close connection between the two such as they are complementary.

31. CMU's business appraisals consulting services are limited to *organizations engaged in the acquisition or production of products and services*. Whilst that may mean appraising a wide variety of processes the particular organisation may be involved in, it does not, however, mean that the appraisal service itself is identical or similar to the process being appraised. For this reason, I do not consider CMU's services to be similar to *marketing; and arranging and conducting business or trade shows* as included within LMU's specification. The nature of the services differ, as do the uses and trade channels and they are not complementary in that one is not essential for the other. For the same reasons I do not consider that LMU's *computerised business information storage and retrieval services* are similar to any of CMU's appraisal services in class 35 or assessment services in class 42. That leaves *computerised data base management and computer data processing and data verification* which I consider to be similar to CMU's *computer consultation services* (which are limited to those 'named') in class 42 as they are services which may be carried out as part of that service.

#### **LMU's services in class 41**

32. LMU's *vocational education and training services; teaching, tuition, training and instruction services, all being educational or vocational; provision of courses of instruction; provision of correspondence services; education examination services; arranging and conducting educational conferences, conventions, lectures, exhibitions, day schools, workshops and seminars; rental of educational material and apparatus; provision of training facilities for the teaching of vocational skills;*

*vocational guidance; management training services; training in the use or operation of computers; all include or are included within CMU's services in class 41 and are therefore identical services.*

*33. Research, advisory and consultancy services, all relating to education and training; provision of information and preparation of reports relating to training and vocational skills; testing of individuals to determine employment skills; professional consultancy and research services relating to vocational matters; and preparation of reports relating to vocational matters are all services which are preparatory to or form part of a training package. The uses and users are the same and they will be delivered by the same providers. There is a very close connection between the respective services such that I consider they are complementary services to the provision of training. I therefore consider them to be similar services to CMU's services in class 35.*

*34. That leaves publication of books, magazines, journals, printed matter, texts, periodicals, photographs and instructional and training materials which I consider to be similar to CMU's goods in class 16 as there is a close connection between them such as they are complementary.*

#### **LMU's services in class 42**

*35. CMU's computer consultation services in class 42 are limited to those 'named' which are all assessment services. I consider them to be identical to technological consultation services; information technology and computing services and computer consultancy as appears in LMU's applications as they are included within these terms. I also consider them to be identical to LMU's research and development of new products; industrial research development and testing; laboratory research and testing services; laboratory services; design and testing of new products; preparation of statistics for scientific research purposes; scientific testing; technological research; testing of materials and products; inspection of plant and machinery; engineering research and consultancy; computer programming; design and development of computer software and hardware; rental of computers; computer software as they are all services which may be provided as part of an appraisal service. I do not consider CMU's services to be identical or similar to preparation of engineering drawings or commercial and industrial design services. The nature and uses of the respective services differ and they are not complementary services.*

*36. In summary, I find all of LMU's goods and services as opposed by CMU to be identical or similar to those included within CMU's earlier mark with the exception of:*

*Marketing; arranging and conducting business or trade shows; computerised business information storage and retrieval services; and,*





*Preparation of engineering drawings; commercial and industrial design services.*

## The relevant public and the nature of the purchasing act

37. The respective goods may be bought by the general public or businesses and from a variety of retail sources. They are everyday goods, with those of a technical nature perhaps bought more irregularly at a greater cost than those of more general interest but none being a particularly high cost. The respective services are likely to be bought by professionals within a business or other organisation though I do not rule out the fact that LMU's services in class 35 will also be purchased by the general public. Whether bought by businesses or the general public, all of the services are likely to be accessed or commissioned irregularly and after relatively detailed contact between the customer and a specialised provider. The cost of those services is likely to vary depending on the nature of the particular service and whether it is being provided to an individual or an organisation. If the services have to be tailored to the particular business or organisation involved, the costs could be significant. Whether provided to an individual or a business, a good deal of care is likely to be involved in their purchase.

## Comparison of marks

38. The marks to be compared are:

CMU's earlier mark	LMU's applications
<p data-bbox="188 1005 316 1037">3974151</p> 	<p data-bbox="826 1005 954 1037">2466223</p>  <p data-bbox="826 1256 954 1288">2466224</p>  

39. Each of the respective marks consists of a number of elements. Where a mark has a number of component features, the contribution of those individual elements to the marks as a whole and the impression conveyed to the average consumer of the goods in question, are important factors in the consideration of whether two marks are similar.

40. The earlier mark consists of a slatted, double overlapping hexagonal device to the right hand side of which are the words 'Carnegie' and 'Mellon' above the words

'Software Engineering Institute'. The words 'Software Engineering Institute' are descriptive of such an establishment. Both Carnegie and Mellon are relatively uncommon surnames. Whilst the device is a distinctive element, in my view the words 'Carnegie' and 'Mellon' have independently distinctive roles.

41. LMU's mark No. 2466223 consists of the device of what appears to me to be a stylised rose to the side of which is the name 'carnegie'. Again, whilst the device element is distinctive, it is the word 'carnegie' which is the dominant, distinctive element within the mark given its size and position and the fact that words "speak louder" than device elements.

42. Given that the word Carnegie appears in each of the respective marks, there is a degree of similarity between them from a visual perspective. There are also clear visual differences given the presence of the other elements within each mark. The marks are visually similar to a low degree.

43. Since there are word elements within each of the respective marks, it is unlikely that the average consumer would refer to them by reference to their respective device elements. In my view, the words Software Engineering Institute play a subordinate role within the earlier mark given their position and descriptiveness. It is the words 'Carnegie Mellon' that will be of most importance, taking into account the perception of the average consumer. LMU's mark will be referred to as 'Carnegie'. I find that there is a higher level of similarity between the marks from an aural perspective.

44. The meaning that the average consumer will give to the words Software Engineering Institute is self-explanatory. As I indicated above, both Carnegie and Mellon are surnames and this is not altered by their combination within the earlier mark. Each of the respective marks will be seen as having surnominal significance.

45. LMU's mark No. 2466224 also contains the rose device and word 'Carnegie', though here with the additional word 'Leeds' above the word 'Carnegie'. The whole is presented in an oval background which also contains a 'swoosh' device. Although the word 'Leeds' is presented above the word 'Carnegie', given the geographic meaning of the word Leeds, it is the word Carnegie which is the dominant and distinctive element of the mark.

46. To the extent that this mark shares the word Carnegie with the earlier mark, there is a degree of visual similarity between them but, given the other elements present within each mark, they also have clear visual differences such that they are visually similar to a low degree. Again, since there are word elements within each of the respective marks, it is unlikely that the average consumer would refer to them by reference to their respective device elements. In my view the marks will be referred to as 'Carnegie Mellon' and 'Leeds Carnegie' which, given the commonality of the word 'Carnegie', leads to a higher level of similarity between them from an aural perspective. Again, each of the respective marks will have a surnominal significance with LMU's mark indicating a connection with the city of Leeds.

47. Taking all matters into account, I find that each of LMU's marks have a moderate degree of similarity with the earlier mark.

## Likelihood of confusion

48. In reaching a decision on whether there is a likelihood of confusion, I must make a global assessment based on all relevant factors. The decision of the General Court in *New Look Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, indicates that the circumstances in which the relevant goods and the marks are encountered by the consumer, particularly at the point at which the purchase is made, is an important consideration. But I also have to make an assessment of all relevant factors and take into account the fact that the consumer will rarely have an opportunity to compare marks side by side but will instead rely on the imperfect picture of them he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27).

49. Another factor to be taken into account is the distinctive character of the earlier trade mark having regard to its inherent characteristics and the reputation it enjoys with the public. Whilst CMU has filed a fair amount of evidence, there is no evidence of use of the mark in relation to the goods and services for which that mark is registered. I have no evidence from the trade or the public. Absent evidence, I am unable to find that the mark has enhanced its distinctive character through the use made of it. That said, I consider the earlier mark to have a reasonable degree of inherent distinctiveness given the inclusion within it of the two relatively unusual surnames and the device element.

50. Confusion can be direct or indirect. Direct confusion occurs where the consumer directly mistakes one mark for another and is confused as to the economic origin of the goods and services (taking into account other relevant factors such as those goods and services and the distinctiveness of the earlier mark). In respect of each of LMU's marks I have found them to have a modest degree of similarity with the earlier mark. Given the differences between the respective marks, I do not consider it likely that either of LMU's marks will be directly mistaken for CMU's earlier mark, even where identical goods and services are involved.

51. Indirect confusion must be more than a likelihood of association in the strict sense (*Lloyd Schuhfabrik*); it is more an association between the marks due to some similarity between them which causes the public wrongly to believe the respective goods and services come from the same or an economically linked undertaking (*Marca Mode CV v Adidas AG & Adidas Benelux BV*).

52. In *Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) v Shaker di L Laudato & C Sas* Case C-334/05 P, it was stated:

“41 It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances,



be dominated by one or more of its components (see order in *Matrazen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

42. As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element.”

53. In *Medion AG v Thomson multimedia Sales Germany & Austria GmbH* Case C-120/04, the ECJ stated:

“30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.”

54. Whilst I have found the respective marks to have some differences, there is some similarity which converges on the word CARNEGIE which I have found to have an independent distinctive role in each mark. This may result in the consumer believing that the respective goods and services come from the same provider. Applying the global approach as I am required to do, I consider there is a likelihood of indirect confusion between each of LMU’s marks and the earlier mark where the respective goods and services are identical or similar.

55. That being so, the opposition based on section 5(2)(b) of the Act against each of LMU’s applications succeeds in respect of all goods and services except:

*Marketing; arranging and conducting business or trade shows; computerised business information storage and retrieval services; and,*

*Preparation of engineering drawings; commercial and industrial design services.*

## The objection based on section 5(4)(a) of the Act

56. CMU's claim under this ground is based on use since at least 1968 of the mark CARNEGIE MELLON in respect of tertiary education, other educational services and research. It is claimed that the mark was first used in Bradford but that goodwill extends to the whole of the UK. This objection is brought in respect of all goods and services of both of LMU's applications. Section 5(4) states:

"5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) .....

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

57. The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

"The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

58. A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20, 1993. This was the subject of consideration by the General Court in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07. In that judgment the General Court stated:

"50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an

action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its nonregistered national mark before the date of filing, in this case 11 March 2000.”

59. As a consequence CMU must establish that at the date of the filing of the applications for registration, 7 September 2007 it had a protectable goodwill in the United Kingdom.

60. In reaching a conclusion on this ground of opposition, I take note of the comments of the Appointed Person, Mr Geoffrey Hobbs Q.C. in *Wild Child Trade Mark* [1998] RPC 455 where he said:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4<sup>th</sup> Edition Vol.48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990]RPC 3341 and *Erven Warnik BV v J Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and,
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously

expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of "passing off", and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that;

To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (a) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (b) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

Whilst it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances."

In assessing whether confusion or deception is likely the court attaches importance to the question whether the defendant can be shown to have

acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

61. CMU is an overseas undertaking but is claiming goodwill in the UK. In *Pete Waterman Ltd v CBS United Kingdom Ltd* [1993] EMLR 27, Sir Nicholas Browne-Wilkinson VC stated:

“A. As a matter of principle, the existence of a severable English goodwill attached to a place of business in this country is not the basis of a right to complain of passing-off in this country. What is necessary is for the plaintiffs to show they have a trade connection here which will normally consist of customers forming part of their goodwill, wherever that goodwill is situated, which goodwill is being invaded by the acts of the defendant in this country;

B. The approach which I have set out at A above is not open to me as there is binding authority to the effect that the basis of [the] plaintiff’s claim must be a goodwill locally situated in England: but

C. The presence of customers in this country is sufficient to constitute the carrying on of business here whether or not there is otherwise a place of business here and whether or not the services are provided here. Once it is found that there are customers, it is open to find that there is business here to which the local goodwill is attached;

D. To the extent that the *Crazy Horse* case is authority to the contrary, I prefer not to follow it.”

The judgment of the Vice-Chancellor makes it clear that it is necessary to have customers in the jurisdiction.

62. In *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, EWCH 3032 (Ch), Arnold J stated:

“215. Fourthly, in order to found a passing off claim in the United Kingdom, the claimant must own goodwill in the United Kingdom. It is not enough to have a reputation here: see *Anheuser-Busch Inc v Budejovicky Budvar NP* [1984] FSR 413.

216. Fifthly, it is sufficient for goodwill to exist in the United Kingdom that the claimant has customers or ultimate consumers for his goods here, and for this purpose it is immaterial whether the claimant (a) has some branch here or (b) trades directly with customers here without having any physical presence in the jurisdiction (for example, by mail order) or (c) trades through intermediaries such as importers and distributors (provided that the circumstances are not such that the goodwill is owned by the intermediary): see e.g. *SA des Anciens Etablissements Panhard et Levassor v Panhard Levassor Motor Co* [1901] 2 Ch 513, *Manus v Fullwood & Bland* (1949) 66 RPC 71, *Nishika Corp v Goodchild* [1990] FSR 371 and *Jian Tools for Sales v Roderick Manhattan Group* [1995] FSR 924”.

63. Whilst CMU has filed evidence, it has provided no information which allows me to evaluate whether and if so to what extent, it has a reputation or goodwill in respect of the services it relies upon. Whilst Ms Kosak states that she has been told that “in 2007 over 60,000 sessions on [CMU’s website] originated from the United Kingdom” the evidence does not explain what a ‘session’ is or what any visitors to the site may have accessed or indeed how the figures were arrived at. I have no evidence that CMU has ever provided its services within the UK and certainly no evidence that it had done so at the relevant date. I have no evidence of any advertising expenditure relating to the mark it relies upon. And I no evidence that it has ever had any students or other customers within or from the UK.

64. There is evidence that CMU has been established in the US for many years and that it has offered on its website an exchange programme with various educational establishments in the UK but there is no evidence to show that anyone has accessed that part of the website and there is no evidence that any exchanges actually took place on or before the relevant date (or at all). Similarly, whilst there is evidence that various educational establishments in the UK have offered exchange programmes with various CMU colleges, there is no evidence of any take-up of those exchanges. In any event, all of the web pages giving details of the exchange programmes date from April 2009, well after the relevant date in these proceedings.

65. CMU claims use from 1968 in Bradford but there is no evidence at all to support this. At JMFO1, there is exhibited an extract from the Times Online newspaper showing its ‘Good Universities Guide’ for 2008. The extract, which is in table form, lists 113 different establishments within the UK. Whilst, as I indicated earlier in this decision, it dates from after the relevant date and has no key which allows me to be able to understand what the figures are measuring, I note that CMU does not appear on it. The lists provided at RBK1B and RBK1C are said to show how CMU has been ‘ranked’ by various publications. They date from 2009 and 2007 respectively. Whilst I have no reason to doubt that CMU was mentioned in these publications, no evidence has been provided to show where these publications were circulated nor what was being ‘ranked’ in the articles (articles which themselves are not provided). And whilst, at RBK1D, the Times Higher Education World University Rankings for 2008 shows CMU as the 21<sup>st</sup> on a list of 200, I do not know on what basis the ranking was prepared. The figures provided are essentially meaningless without any explanation of them and cannot be taken to show use of the mark in relation to the services relied upon within the UK.

66. In short, CMU has failed to establish any goodwill or reputation in respect of its claimed services in the UK. That being the case, the objection based on section 5(4)(a) of the Act fails.

### **The objections under section 5(2)(b) and 5(3) and section 56**

67. CMU’s remaining objections are brought under sections 5(2)(b) and 5(3) of the Act on the basis that it is the proprietor of a well-known trade mark CARNEGIE MELLON. The provision relating to claims of this nature are founded upon section 55 and 56 of the Act which state:

“55.(1) In this Act-

- (a) ‘the Paris Convention’ means the Paris Convention for the Protection of Industrial Property of March 20<sup>th</sup> 1883, as revised or amended from time to time, (aa) ‘The WTO agreement’ means the Agreement establishing the World Trade Organisation signed at Marrakesh on 15<sup>th</sup> April 1994, and b) a ‘Convention country’ means a country, other than the United Kingdom, which is a party to that Convention,”

and,

“56.(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who-

- (a) is a national of a Convention country, or
- (b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in the United Kingdom. References to the proprietor of such a mark shall be construed accordingly.”

68. I have set out above the provisions of section 5(2) of the Act. Section 5(3) states:

“5-(3) A trade mark which –

- (a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a 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.”

69. The scope of Section 5(3) has been considered in a number of cases notably *General Motors Corp v Yplon SA* (CHEVY) [1999] ETMR 122 and [2000] RPC 572, *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10, *Premier Brands UK Limited v Typhoon Europe Limited* (TYPHOON) [2000] FSR 767, *Daimler Chrysler v Alavi* (MERC) [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application* (VISA) [2000] RPC 484, *Valucci Designs Ltd v IPC Magazines* (LOADED) O/455/00, *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7 and *Davidoff & Cie SA v Gofkid Ltd* (DAVIDOFF) [2003] ETMR 42.

70. The applicable legal principles arising from these cases are as follows:

- a) ‘Reputation’ for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned with the

products or services covered by that trade mark (paragraph 26 of the ECJ's judgment in *General Motors Corp. v Yplon SA (CHEVY)* [1999] ETMR 122).

- b) Under this provision the similarity between the trade marks does not have to be such as to give rise to a likelihood of confusion between them; the provision may be invoked where there is sufficient similarity to cause the relevant public to establish a link between the earlier trade mark and the later trade mark or sign, *Adidas Salomon v Fitnessworld*, paragraphs 29-30.
- c) The stronger the earlier trade mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (per Neuberger J. in *Premier Brands*, and the ECJ in *CHEVY*, paragraph 30).
- d) Unfair advantage is taken of the distinctive character or the repute of the earlier trade mark where there is clear exploitation and free-riding on the coat-tails of a famous trade mark or an attempt to trade upon its reputation: *Spa Monopole v OHIM*.

71. To these, I would also add the following legal principles that have arisen from the ECJ judgment in *Intel Corporation Inc. v CPM United Kingdom Ltd (INTEL)* C-252/07:

- a) Whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier trade mark with a reputation and the later trade mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.
- b) The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link between the conflicting trade marks, within the meaning of *Adidas-Salomon and Adidas Benelux*.
- c) Whether use of the later trade mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, must be assessed globally, taking into account all factors relevant to the circumstances of the case.
- d) The use of the later mark may be detrimental to the distinctive character of the earlier mark with a reputation even if that mark is not unique; a first use of the later mark may suffice to be detrimental to the distinctive character of the earlier mark; proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future.



72. CMU claims that its mark is well-known because “of its extensive trade and other activity in the fields of tertiary education, other educational services and research” in the UK. In the *PACO/PACO LIFE IN COLOUR* trade mark case [2000] RPC 451, the registrar’s hearing officer held:

- (a) a trade mark could only be well known in respect of the goods or services in respect of which it has been used, and
- (b) accordingly, PACO RABANNE was not a well-known trade mark for clothing even though it had a reputation in relation to perfume.

73. In his decision in the Le Mans trade mark case BL-0-012-05, Mr Arnold Q.C. sitting as the Appointed Person referred to these findings and stated the following:

“Conclusion (a) is a commonsense proposition of law which counsel for the opponent in the present case accepted. In reaching conclusion (b) Mr James referred to paragraph 31 of the Opinion of Advocate General Jacobs in Case C-375/97 *General Motors Corp v Yplon SA* [1999] ECR I-5421. Although it is primarily concerned with Articles 4(4)(a) and 5(2) of the Directive, I think it is worth quoting the relevant section of the Opinion in full:

“30. Both in the proceedings before the Court, and in general debate on the issue, attention has focused on the relationship between ‘marks with a reputation’ in Article 4(4)(a) and Article 5(2) of the Directive and well known marks in the sense used in Article 6*bis* of the Paris Convention for the Protection of Industrial Property. Well-known marks in that sense are referred to in Article 4(2)(d) of the Directive.

31. General Motors, the Belgian and Netherlands Governments and the Commission submit that the condition in the Directive that a mark should have a ‘reputation’ is a less stringent requirement than the requirement of being well-known. That also appears to be the view taken in the 1995 WIPO Memorandum on well-known marks.

32. In order to understand the relationship between the two terms, it is useful to consider the terms and purpose of the protection afforded to well known marks under the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). Article 6*bis* of the Paris Convention provides that well-known marks are to be protected against the registration or use of a ‘reproduction, an imitation, or a translation, liable to create confusion’ in respect of identical or similar goods. That protection is extended by Article 16(3) of TRIPs to goods or services which are not similar to those in respect of which the mark is registered, provided that use of the mark would ‘indicate a connection between those goods or services and the owners of the registered trade mark and provided that the interests of the owner of the registered trade mark are likely to be damaged by such use’. The purpose of the protection afforded to well-known marks under those provisions appears to have been to provide special protection for well-

known marks against exploitation in countries where they are not yet registered.

33. The protection of well-known marks under the Paris Convention and TRIPs is accordingly an exceptional type of protection afforded even to unregistered marks. It would not be surprising therefore if the requirement of being well-known imposed a relatively high standard for a mark to benefit from such exceptional protection. There is no such consideration in the case of marks with a reputation. Indeed as I shall suggest later, there is no need to impose such a high standard to satisfy the requirements of marks with a reputation in Article 5(2) of the Directive.

34. The view is supported by at least some language versions of the Directive. In the German text, for example, the marks referred to in Article 6*bis* of the Paris Convention are described as 'notorisch bekannt', whereas the marks referred to in Article 4(4)(a) and Article 5(2) are described simply as 'bekannt'. The two terms in Dutch are similarly 'algemeen bekend' and 'bekend' respectively.

35. The French, Spanish, and Italian texts, however, are slightly less clear since they employ respectively the terms 'notoirement connues', 'notoriamente conocidas', and 'notoriamente conosciuti' in relation to marks referred to in Article 6*bis* of the Paris Convention, and the terms 'jouit d'une renommée', 'goce de renombre', and 'gode di notorietà' in Article 4(4)(a) and Article 5(2) of the Directive.

36. There is also ambiguity in the English version. The term 'well known' in Article 6*bis* of the Paris Convention has a quantitative connotation (The *Concise Oxford Dictionary* defines 'well known' as 'known to many') whereas the term 'reputation' in Article 4(4)(a) and Article 5(2) might arguably involve qualitative criteria. The *Concise Oxford Dictionary* defines reputation as '(1) what is generally said or believed about a person's or thing's character or standing...; (2) the state of being well thought of; distinction; respectability;... (3) credit, fame, or notoriety'. Indeed it has been suggested that there is a discrepancy between the German text compared with the English and French texts on the grounds that the 'reputation' of a trade mark is not a quantitative concept but simply the independent attractiveness of a mark which gives it an advertising value.

37. Whether a mark with a reputation is a quantitative or qualitative concept, or both, it is possible to conclude in my view that, although the concept of a well-known mark is itself not clearly defined, a mark with a 'reputation' need not be as well known as a well-known mark.”

The Advocate General refers in one of his footnotes to Mostert. Mostert at 8-17 suggests the following criteria derived from a number of sources for assessing whether a mark is well-known:

- (i) the degree of recognition of the mark;
- (ii) the extent to which the mark is used and the duration of the use;
- (iii) the extent and duration of advertising and publicity accorded to the mark;
- (iv) the extent to which the mark is recognised, used, advertised, registered and enforced geographically or, if applicable, other relevant factors that may determine the mark's geographical reach locally, regionally and worldwide;
- (v) the degree of inherent or acquired distinctiveness of the mark;
- (vi) the degree of exclusivity of the mark and the nature and extent of use of the same or a similar mark by third parties;
- (vii) the nature of the goods or services and the channels of trade for the goods or services which bear the mark;
- (viii) the degree to which the reputation of the mark symbolises quality goods;
- (ix) the extent of the commercial value attributed to the mark.

59. In September 1999, the Assembly of the Paris Union for the Protection of Intellectual Property and the General Assembly of the World Intellectual Property Organisation (WIPO) adopted a Joint Recommendation concerning Provision on the Protection of Well-Known Marks. Article 2 of the Joint Recommendation provides:

(1)(a) In determining whether a mark is a well-known mark, the competent authority shall take into account any circumstances from which it may be inferred that the mark is well known.

(b) In particular, the competent authority shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, well known, including, but not limited to, information concerning the following:

1. the degree of knowledge or recognition of the mark in the relevant sector of the public;
2. the duration, extent and geographical area of any use of the mark;
3. the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;

4. the duration and geographical area of any registration, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;

5. the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities;

6. the value associated with the mark.

(c) The above factors, which are guidelines to assist the competent authority to determine whether the mark is a well-known mark, are not pre-conditions for reaching the determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not listed in subparagraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factor listed in subparagraph (b), above.

(2)(a) Relevant sectors of the public shall include, but shall not necessarily be limited to:

(i) actual and/or potential consumers of the type of goods and/or services to which the mark applies;

(ii) persons involved in channels of distribution of the type of goods and/or services to which the mark applies;

(iii) business circles dealing with the type of goods and/or services to which the mark applies.

(b) Where a mark is determined to be well known in at least one relevant sector of the public in a Member State, the mark shall be considered by the Member State to be a well-known mark.

(c) Where a mark is determined to be known in at least one relevant sector of the public in a Member State, the mark may be considered by the Member State to be a well-known mark.

(d) A Member State may determine that a mark is a well-known mark, even if the mark is not well-known or, if the Member State applies subparagraph (c), known, in any relevant sector of the public of the Member State.

(3)(a) A Member State shall not require, as a condition for determining whether a mark is a well-known mark:

(i) that the mark has been in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, the Member State;

(ii) that the mark is well known in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, any jurisdiction other than the Member State; or

(iii) that the mark is well known by the public at large in the Member State (b) Notwithstanding subparagraph (a)(ii), a Member State may, for the purpose of applying paragraph (2)(d), require that the mark be well-known in one or more jurisdictions other than the Member State.”

60. Two points of interest emerge from Article 2 of the Joint Recommendation. The first is that the list of six criteria contained in Article 2(1)(b) is not inflexible, but provides as it were a basic framework for assessment. The second is that *prima facie* the relevant sector of the public consists of consumers of and traders in the goods or services for which the mark is said to be well known.”

74. In terms of the matters before me the fact is that there is no evidence of any awareness amongst the relevant sectors of the public. The best that CMU's evidence gets is a claim to recognition based on the rankings listed in various publications but, for reasons I gave earlier, these cannot be taken as an indicator of any sort of recognition, particularly not in the UK and in relation to use on the claimed services.

75. I have no evidence to show the duration, extent and geographical area of any use of CMU's mark. There is no evidence of it having any students or other consumers of its services, no evidence of any income from the services which may have been provided and no evidence of advertising. Other than use that may have occurred through access to Internet pages (evidence of which dates from after the relevant date), there is no other evidence of use within the UK, or indeed anywhere. There is no evidence that CMU's mark has been accorded the status of a well-known mark in its home country, let alone in any other.

76. The final question is the value associated with the mark. A mark under which a business trades is obviously valuable to that business. It may well be that the question being posed is more to do with the asset value rather than the “badge of origin” question and in that respect I am almost completely unsighted. I have no doubt the mark relied upon has a value to CMU but absent relevant information I am unable to go anywhere near to being able to assess this.

77. Taking all of the above into account, and even accepting that they provide a framework rather than a rigid formula, I do not see that CMU has come anywhere near to establishing that their mark is known, let alone well-known, be it anywhere other than the U.S. Even in that country, it has not established the level of awareness of the name. I do not see any basis on which I can conclude that use of

the mark applied for in connection with any of the goods or services specified would result in confusion nor do I consider that the criteria set out above in paragraph 69 above has been satisfied. On this basis I dismiss the opposition brought under section 5(2)(b) and 5(3) on the basis of a well-known mark.

### **Summary of findings**

78. CMU's oppositions against application nos. 2466223 and 2466224 have succeeded, in part, under the grounds based on section 5(2)(b) based on its earlier registration, but failed under section 5(2)(b), 5(3) and 5(4)(a) based on the mark CARNEGIE MELLON. That being the case, the applications are free to proceed to registration in respect of the following goods and services:

#### **Class 3**

Toiletries; soaps; perfumes; cosmetics, cosmetic kits; hair preparations, hair lotions, shampoos; deodorants for personal use, body sprays; talcum powder; after shave lotions, eau de cologne, shaving preparations; non-medicated bath preparations and products, bath foams, bath oils, shower gels; air fresheners; toothpaste; gift sets incorporating some or all of the aforesaid goods.

#### **Class 6**

Badges, pins, vehicle badges; keys, key blanks, key rings, key fobs, key chains; locks and ornaments; cups; trophies; plates, plaques; monuments, statues and statuettes; works of art; boxes, money boxes.

#### **Class 9**

Sound recordings; video recordings; tapes; cassettes; compact disks; films; slides; video cassettes; video recorders; CD ROMs; games adapted for use with television receivers; computer games; entertainment and games computer software relating to sports; video cameras; cameras; photographic and cinematographic apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images; photographic transparencies, photographic films; batteries; encoded magnetic cards, magnetic identity cards, credit cards, debit cards; spectacles, spectacle cases, sunglasses; protective sports clothing; eye protection wear for sports; headwear for sporting activities for protection against injury.

#### **Class 10**

Sports supports; sporting articles for protective purposes; supports for athletic purposes; elbow pads and protectors; knee guards.

#### **Class 14**

Trophies; ornaments; works of art; figurines, models; badges; cups, boxes, cases; horological and chronological instruments; clocks, alarm clocks; watches; jewellery and precious stones; bracelets, chains; coins, medals, medallions; key rings; tie clips, tie pins, cufflinks.

#### Class 16

Photographs, pictures, prints; posters; greeting cards; postcards; notepads; address books; scrapbooks; folders; catalogues; calendars; photograph albums; diaries; stamp albums; stickers; decalcomanias; paperweights; cardboard articles; stationery; pens, pencils; erasers, pencil sharpeners, pencil cases; rulers; book markers; business card holders; cheque book holders; drawing materials, artists' materials; paper napkins, paper handkerchiefs; wrapping and packaging materials; gift bags and carrier bags.

#### Class 18

Articles of leather or imitation leather; bags, travel bags; holdalls, rucksacks; sports bags, boot bags; satchels; luggage and trunks; wallets and purses; belts; card holders; key fobs and key rings; umbrellas/parasols.

#### Class 20

Plaques; mirrors; picture frames; tags for use on bags, made wholly or principally of plastic; works of art, figurines, models and ornaments, all made of wood, wax, plaster or plastic; pennants; key fobs and keyrings being made of plastic; signboards; sleeping bags; non-metallic trays; advertising display boards

#### Class 21

Glassware, earthenware, porcelain, china; domestic utensils and containers, none being of precious metals or coated therewith; glasses, tumblers; crockery, plates, cups, mugs; combs; flasks; coasters; lunch boxes; money boxes, piggy banks; water bottles; toothbrushes; household and kitchen containers; hip flasks; goblets, mugs; trays; vases; household containers and utensils.

#### Class 24

Textile articles; bed linen, duvet covers, pillow cases, sheets, blankets; table linen, table cloths, napkins; handkerchiefs; curtains, blinds; pennants, banners, flags; towels, beach towels; textile wall hangings; rugs; face towels, tea towels, flannels; place mats; textile fabrics for use in the manufacture of sportswear.

#### Class 25

Articles of outerclothing; articles of underclothing; articles of sports clothing; footwear; headgear; scarves, shorts and socks; sweatshirts, hooded tops; tracksuits, t-shirts, hats and caps, jackets; wristbands, headbands; ties.

#### Class 26

Badges; emblems; buttons; rosettes; patches; lanyards; embroidery; hair bands and ribbons.

#### Class 27

Wall paper; wall hangings; floor coverings; rugs; carpets; mats, play mats; floor coverings for use in sporting activities; imitation turf for use in covering surfaces for sports purposes.

#### Class 28

Toys; games; playthings; teddy bears, cuddly toys; puzzles, jigsaw puzzles; balloons; sporting equipment; gymnastic and sporting articles; ordinary playing cards; coin/counter operated games.

#### Class 30

Biscuits; cakes; pastry; ice cream, confectionery; chocolate, popcorn, chewing gum; beverages, chocolate beverages; coffee; tea; cocoa products; bread, preparations made from cereals; snack goods; foodstuffs made from dough; savoury products; prepared meals; sauces; preparations for use as dietetic additives for consumption by sports persons.

#### Class 32

Beers, lagers; non-alcoholic beverages; fruit drinks, fruit juices; mineral water, soda water, aerated water; carbonated beverages; syrups and other preparations for making beverages.

#### Class 35

Marketing; arranging and conducting business or trade shows; preparation of publicity material; publication of publicity leaflets and text; publicity services; accountancy services; preparation of accounts; book-keeping; company record keeping; cost and management accounting; preparation of statements of accounts; computerised accounting; computerised business information storage and retrieval; word processing; personnel management and personnel management advice; personnel management consultancy; employment counselling and consultancy; all relating to commercial or industrial undertakings.

#### Class 37

Repair and maintenance of sports equipment; provision of maintenance services for sports establishments; construction of complexes for sports purposes; construction of sports fields.

#### Class 39

Arrangement and booking of travel and tours; provision of travel information; booking of seats for transportation of passengers by land, sea and air; chartering of vehicles and aeroplanes; car and coach hire; provision of car parking services; rental of sports apparatus for transportation.

#### Class 41

Undergraduate and postgraduate education and training services; library services; lending library services, advisory services, all relating to libraries; provision of training facilities for the teaching of academic subjects; provision of information and preparation of reports, all relating to education and academic subjects; preparation of resumes; production of videos, cassettes and cine-films; production of radio and television programmes; news programmes for radio or television; recording studio services; provision of recording studio facilities; audio recording services; arranging and conducting conferences, conventions, lectures, exhibitions, day schools, workshops and seminars, all for entertainment purposes; radio and television entertainment



services; theatre and cinema services; theatre production services; provision of rehearsal space; rental of cine-film, cine-film projectors, videos, video records, sound records and sound recording apparatus; art gallery and exhibition services; concert services; live band performances; orchestra services; disco and night club services; provision of club recreation facilities; recreation services; provision of recreational facilities; physical fitness instruction; physical education services; provision of educational facilities and facilities for sporting events; organising of sporting activities and sports competitions; sports refereeing and officiating; staging of sports tournaments; organising of gymnasium facilities; provision of club sporting facilities; rental of sports apparatus; professional consultancy and research services relating to educational matters; preparation of reports relating to educational matters; photography and video taping services; rental of loudspeakers and video cameras.

**Class 42**

Analysis of materials; materials advice; chemical analysis and research; chemical laboratory services; safety testing of products; architecture services; preparation of architectural plans; quantity surveying; survey services; planning services; preparation of engineering drawings; engineering services; commercial and industrial design services; graphic art and design services.

**Class 43**

Provision of facilities for conventions, conferences, lectures, exhibitions, day schools, workshops, seminars; provision of board room facilities; provision of trade show facilities.

**Class 45**

Rental of sports clothing; inspection of apparatus; legal services and legal research; legal consultancy services.

**Costs**

79. Both parties have achieved a measure of success and I therefore order that each bears its own costs.

**Dated this 21 day of February 2011**

**Ann Corbett  
For the Registrar  
The Comptroller-General**

Annex 1:

**Application no. 2466223**

Date of Application: 7.9.2007

Date of publication: 24.04.2008

Mark:



Specification of goods and services:

**Class 3**

Toiletries; soaps; perfumes; cosmetics, cosmetic kits; hair preparations, hair lotions, shampoos; deodorants for personal use, body sprays; talcum powder; after shave lotions, eau de cologne, shaving preparations; non-medicated bath preparations and products, bath foams, bath oils, shower gels; air fresheners; toothpaste; gift sets incorporating some or all of the aforesaid goods.

**Class 6**

Badges, pins, vehicle badges; keys, key blanks, key rings, key fobs, key chains; locks and ornaments; cups; trophies; plates, plaques; monuments, statues and statuettes; works of art; boxes, money boxes.

**Class 9**

Sound recordings; video recordings; tapes; cassettes; compact disks; films; slides; video cassettes; video recorders; CD ROMs; games adapted for use with television receivers; computer games; entertainment and games computer software relating to sports; video cameras; cameras; photographic and cinematographic apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images; photographic transparencies, photographic films; batteries; encoded magnetic cards, magnetic identity cards, credit cards, debit cards; spectacles, spectacle cases, sunglasses; protective sports clothing; eye protection wear for sports; headwear for sporting activities for protection against injury.

**Class 10**

Sports supports; sporting articles for protective purposes; supports for athletic purposes; elbow pads and protectors; knee guards.

#### Class 14

Trophies; ornaments; works of art; figurines, models; badges; cups, boxes, cases; horological and chronological instruments; clocks, alarm clocks; watches; jewellery and precious stones; bracelets, chains; coins, medals, medallions; key rings; tie clips, tie pins, cufflinks.

#### Class 16

Printed matter; newspapers, periodical publications, magazines; books, booklets; photographs, pictures, prints; posters; greeting cards; postcards; notepads; address books; scrapbooks; folders; catalogues; calendars; photograph albums; diaries; stamp albums; stickers; decalcomanias; paperweights; cardboard articles; stationery; pens, pencils; erasers, pencil sharpeners, pencil cases; rulers; book markers; business card holders; cheque book holders; drawing materials, artists' materials; instructional and teaching materials; paper napkins, paper handkerchiefs; wrapping and packaging materials; gift bags and carrier bags.

#### Class 18

Articles of leather or imitation leather; bags, travel bags; holdalls, rucksacks; sports bags, boot bags; satchels; luggage and trunks; wallets and purses; belts; card holders; key fobs and key rings; umbrellas/parasols.

#### Class 20

Plaques; mirrors; picture frames; tags for use on bags, made wholly or principally of plastic; works of art, figurines, models and ornaments, all made of wood, wax, plaster or plastic; pennants; key fobs and keyrings being made of plastic; signboards; sleeping bags; non-metallic trays; advertising display boards.

#### Class 21

Glassware, earthenware, porcelain, china; domestic utensils and containers, none being of precious metals or coated therewith; glasses, tumblers; crockery, plates, cups, mugs; combs; flasks; coasters; lunch boxes; money boxes, piggy banks; water bottles; toothbrushes; household and kitchen containers; hip flasks; goblets, mugs; trays; vases; household containers and utensils.

#### Class 24

Textile articles; bed linen, duvet covers, pillow cases, sheets, blankets; table linen, table cloths, napkins; handkerchiefs; curtains, blinds; pennants, banners, flags; towels, beach towels; textile wall hangings; rugs; face towels, tea towels, flannels; place mats; textile fabrics for use in the manufacture of sportswear.

#### Class 25

Articles of outer clothing; articles of underclothing; articles of sports clothing; footwear; headgear; scarves, shorts and socks; sweatshirts, hooded tops; tracksuits, t-shirts, hats and caps, jackets; wristbands, headbands; ties.

#### Class 26

Badges; emblems; buttons; rosettes; patches; lanyards; embroidery; hair bands and ribbons.

#### Class 27

Wall paper; wall hangings; floor coverings; rugs; carpets; mats, play mats; floor coverings for use in sporting activities; imitation turf for use in covering surfaces for sports purposes.

#### Class 28

Toys; games; playthings; teddy bears, cuddly toys; puzzles, jigsaw puzzles; balloons; sporting equipment; gymnastic and sporting articles; ordinary playing cards; coin/counter operated games.

#### Class 30

Biscuits; cakes; pastry; ice cream, confectionery; chocolate, popcorn, chewing gum; beverages, chocolate beverages; coffee; tea; cocoa products; bread, preparations made from cereals; snack goods; foodstuffs made from dough; savoury products; prepared meals; sauces; preparations for use as dietetic additives for consumption by sports persons.

#### Class 32

Beers, lagers; non-alcoholic beverages; fruit drinks, fruit juices; mineral water, soda water, aerated water; carbonated beverages; syrups and other preparations for making beverages.

#### Class 35

Business appraisals; business administration services; business advice and inquiries; compilation and provision of business, trade or commercial information; compilation of business directories; business investigations; business management services; advice relating to business management and organisation; operational business services; business planning; writing or preparation of business reports; business research and surveys; commercial management assistance; economic forecasting and analysis for business purposes; business advisory services relating to franchising; market analysis, research and surveys; business advice relating to marketing; marketing; marketing studies and profit surveys; preparation of project studies relating to business matters; arranging and conducting business or trade shows; provision of business statistical information; business statistical studies; business statistical services; preparation of publicity material; publication of publicity leaflets and text; publicity services; accountancy services; preparation of accounts; auditing services; book-keeping; company record keeping; cost and management accounting; preparation of statements of accounts; computerised accounting; computerised data base management; computer data processing and data verification; computerised business information storage and retrieval; word processing; personnel management and personnel management advice; personnel management consultancy; employment counselling and consultancy; business or commercial information agency services; professional advisory and consultancy services; all relating to commercial or industrial undertakings.

#### Class 37

Repair and maintenance of sports equipment; provision of maintenance services for sports establishments; construction of complexes for sports purposes; construction of sports fields.

### Class 39

Arrangement and booking of travel and tours; provision of travel information; booking of seats for transportation of passengers by land, sea and air; chartering of vehicles and aeroplanes; car and coach hire; provision of car parking services; rental of sports apparatus for transportation.

### Class 41

Undergraduate, postgraduate and vocational education and training services; teaching, tuition, training and instruction services, all being educational or vocational; provision of courses of instruction; provision of correspondence courses; education examination services; arranging and conducting educational conferences, conventions, lectures, exhibitions, day schools, workshops and seminars; rental of educational material and apparatus; library services; lending library services, advisory services, all relating to libraries; research, advisory and consultancy services, all relating to education and training; provision of training facilities for the teaching of academic subjects and vocational skills; provision of information and preparation of reports, all relating to education, training, academic subjects and vocational skills; vocational guidance; preparation of resumes; testing of individuals to determine employment skills; management training services; training in the use or operation of computers; publication of books, magazines, journals, printed matter, texts, periodicals, photographs, and instructional and training materials; production of videos, cassettes and cine-films; production of radio and television programmes; news programmes for radio or television; recording studio services; provision of recording studio facilities; audio recording services; arranging and conducting conferences, conventions, lectures, exhibitions, day schools, workshops and seminars, all for entertainment purposes; radio and television entertainment services; theatre and cinema services; theatre production services; provision of rehearsal space; rental of cine-film, cine-film projectors, videos, video records, sound records and sound recording apparatus; art gallery and exhibition services; concert services; live band performances; orchestra services; disco and night club services; provision of club recreation facilities; recreation services; provision of recreational facilities; physical fitness instruction; physical education services; provision of educational facilities and facilities for sporting events; organising of sporting activities and sports competitions; sports refereeing and officiating; staging of sports tournaments; organising of gymnasium facilities; provision of club sporting facilities; rental of sports apparatus; professional consultancy and research services relating to vocational and educational matters; preparation of reports relating to vocational and educational matters; photography and video taping services; rental of loudspeakers and video cameras.

### Class 42

Research and development of new products; industrial research development and testing; laboratory research and testing services; laboratory services; design and testing of new products; preparation of statistics for scientific research purposes; scientific testing; technological research; technological consultation services; testing of materials and products; analysis of materials; materials advice; chemical analysis and research; chemical laboratory services; safety testing of products; inspection of plant and machinery; architecture services; preparation of architectural plans; quantity surveying; survey services; planning services; preparation of engineering drawings; engineering services; engineering research and consultancy; commercial

and industrial design services; graphic art and design services; information technology and computing services; computer programming; design and development of computer software and hardware; computer consultancy; rental of computers, computer software.

#### Class 43

Provision of facilities for conventions, conferences, lectures, exhibitions, day schools, workshops, seminars; provision of board room facilities; provision of trade show facilities.

#### Class 45

Rental of sports clothing; inspection of apparatus; legal services and legal research; legal consultancy services.

**Application no. 2466224**

Date of application: 7.9.2007

Date of publication: 25.4.2008

Mark:



Specification of goods and services:

**Class 3**

Toiletries; soaps; perfumes; cosmetics, cosmetic kits; hair preparations, hair lotions, shampoos; deodorants for personal use, body sprays; talcum powder; after shave lotions, eau de cologne, shaving preparations; non-medicated bath preparations and products, bath foams, bath oils, shower gels; air fresheners; toothpaste; gift sets incorporating some or all of the aforesaid goods.

**Class 6**

Badges, pins, vehicle badges; keys, key blanks, key rings, key fobs, key chains; locks and ornaments; cups; trophies; plates, plaques; monuments, statues and statuettes; works of art; boxes, money boxes

#### Class 9

Sound recordings; video recordings; tapes; cassettes; compact disks; films; slides; video cassettes; video recorders; CD ROMs; games adapted for use with television receivers; computer games; entertainment and games computer software relating to sports; video cameras; cameras; photographic and cinematographic apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images; photographic transparencies, photographic films; batteries; encoded magnetic cards, magnetic identity cards, credit cards, debit cards; spectacles, spectacle cases, sunglasses; protective sports clothing; eye protection wear for sports; headwear for sporting activities for protection against injury.

#### Class 10

Sports supports; sporting articles for protective purposes; supports for athletic purposes; elbow pads and protectors; knee guards.

#### Class 14

Trophies; ornaments; works of art; figurines, models; badges; cups, boxes, cases; horological and chronological instruments; clocks, alarm clocks; watches; jewellery and precious stones; bracelets, chains; coins, medals, medallions; key rings; tie clips, tie pins, cufflinks.

#### Class 16

Printed matter; newspapers, periodical publications, magazines; books, booklets; photographs, pictures, prints; posters; greeting cards; postcards; notepads; address books; scrapbooks; folders; catalogues; calendars; photograph albums; diaries; stamp albums; stickers; decalcomanias; paperweights; cardboard articles; stationery; pens, pencils; erasers, pencil sharpeners, pencil cases; rulers; book markers; business card holders; cheque book holders; drawing materials, artists' materials; instructional and teaching materials; paper napkins, paper handkerchiefs; wrapping and packaging materials; gift bags and carrier bags.

#### Class 18

Articles of leather or imitation leather; bags, travel bags; holdalls, rucksacks; sports bags, boot bags; satchels; luggage and trunks; wallets and purses; belts; card holders; key fobs and key rings; umbrellas/parasols.

#### Class 20

Plaques; mirrors; picture frames; tags for use on bags, made wholly or principally of plastic; works of art, figurines, models and ornaments, all made of wood, wax, plaster or plastic; pennants; key fobs and keyrings being made of plastic; signboards; sleeping bags; non-metallic trays; advertising display boards.

#### Class 21

Glassware, earthenware, porcelain, china; domestic utensils and containers, none being of precious metals or coated therewith; glasses, tumblers; crockery, plates, cups, mugs; combs; flasks; coasters; lunch boxes; money boxes, piggy banks; water bottles; toothbrushes; household and kitchen containers; hip flasks; goblets, mugs; trays; vases; household containers and utensils.



#### Class 24

Textile articles; bed linen, duvet covers, pillow cases, sheets, blankets; table linen, table cloths, napkins; handkerchiefs; curtains, blinds; pennants, banners, flags; towels, beach towels; textile wall hangings; rugs; face towels, tea towels, flannels; place mats; textile fabrics for use in the manufacture of sportswear.

#### Class 25

Articles of outerclothing; articles of underclothing; articles of sports clothing; footwear; headgear; scarves, shorts and socks; sweatshirts, hooded tops; tracksuits, t-shirts, hats and caps, jackets; wristbands, headbands; ties.

#### Class 26

Badges; emblems; buttons; rosettes; patches; lanyards; embroidery; hair bands and ribbons.

#### Class 27

Wall paper; wall hangings; floor coverings; rugs; carpets; mats, play mats; floor coverings for use in sporting activities; imitation turf for use in covering surfaces for sports purposes.

#### Class 28

Toys; games; playthings; teddy bears, cuddly toys; puzzles, jigsaw puzzles; balloons; sporting equipment; gymnastic and sporting articles; ordinary playing cards; coin/counter operated games.

#### Class 30

Biscuits; cakes; pastry; ice cream, confectionery; chocolate, popcorn, chewing gum; beverages, chocolate beverages; coffee; tea; cocoa products; bread, preparations made from cereals; snack goods; foodstuffs made from dough; savoury products; prepared meals; sauces; preparations for use as dietetic additives for consumption by sports persons.

#### Class 32

Beers, lagers; non-alcoholic beverages; fruit drinks, fruit juices; mineral water, soda water, aerated water; carbonated beverages; syrups and other preparations for making beverages.

#### Class 35

Business appraisals; business administration services; business advice and inquiries; compilation and provision of business, trade or commercial information; compilation of business directories; business investigations; business management services; advice relating to business management and organisation; operational business services; business planning; writing or preparation of business reports; business research and surveys; commercial management assistance; economic forecasting and analysis for business purposes; business advisory services relating to franchising; market analysis, research and surveys; business advice relating to marketing; marketing; marketing studies and profit surveys; preparation of project studies relating to business matters; arranging and conducting business or trade shows; provision of business statistical information; business statistical studies; business statistical services; preparation of publicity material; publication of publicity

leaflets and text; publicity services; accountancy services; preparation of accounts; auditing services; book-keeping; company record keeping; cost and management accounting; preparation of statements of accounts; computerised accounting; computerised data base management; computer data processing and data verification; computerised business information storage and retrieval; word processing; personnel management and personnel management advice; personnel management consultancy; employment counselling and consultancy; business or commercial information agency services; professional advisory and consultancy services; all relating to commercial or industrial undertakings.

#### Class 37

Repair and maintenance of sports equipment; provision of maintenance services for sports establishments; construction of complexes for sports purposes; construction of sports fields.

#### Class 39

Arrangement and booking of travel and tours; provision of travel information; booking of seats for transportation of passengers by land, sea and air; chartering of vehicles and aeroplanes; car and coach hire; provision of car parking services; rental of sports apparatus for transportation.

#### Class 41

Undergraduate, postgraduate and vocational education and training services; teaching, tuition, training and instruction services, all being educational or vocational; provision of courses of instruction; provision of correspondence courses; education examination services; arranging and conducting educational conferences, conventions, lectures, exhibitions, day schools, workshops and seminars; rental of educational material and apparatus; library services; lending library services, advisory services, all relating to libraries; research, advisory and consultancy services, all relating to education and training; provision of training facilities for the teaching of academic subjects and vocational skills; provision of information and preparation of reports, all relating to education, training, academic subjects and vocational skills; vocational guidance; preparation of resumes; testing of individuals to determine employment skills; management training services; training in the use or operation of computers; publication of books, magazines, journals, printed matter, texts, periodicals, photographs, and instructional and training materials; production of videos, cassettes and cine-films; production of radio and television programmes; news programmes for radio or television; recording studio services; provision of recording studio facilities; audio recording services; arranging and conducting conferences, conventions, lectures, exhibitions, day schools, workshops and seminars, all for entertainment purposes; radio and television entertainment services; theatre and cinema services; theatre production services; provision of rehearsal space; rental of cine-film, cine-film projectors, videos, video records, sound records and sound recording apparatus; art gallery and exhibition services; concert services; live band performances; orchestra services; disco and night club services; provision of club recreation facilities; recreation services; provision of recreational facilities; physical fitness instruction; physical education services; provision of educational facilities and facilities for sporting events; organising of sporting activities and sports competitions; sports refereeing and officiating; staging of sports tournaments; organising of gymnasium facilities; provision of club sporting facilities;

rental of sports apparatus; professional consultancy and research services relating to vocational and educational matters; preparation of reports relating to vocational and educational matters; photography and video taping services; rental of loudspeakers and video cameras.

#### Class 42

Research and development of new products; industrial research development and testing; laboratory research and testing services; laboratory services; design and testing of new products; preparation of statistics for scientific research purposes; scientific testing; technological research; technological consultation services; testing of materials and products; analysis of materials; materials advice; chemical analysis and research; chemical laboratory services; safety testing of products; inspection of plant and machinery; architecture services; preparation of architectural plans; quantity surveying; survey services; planning services; preparation of engineering drawings; engineering services; engineering research and consultancy; commercial and industrial design services; graphic art and design services; information technology and computing services; computer programming; design and development of computer software and hardware; computer consultancy; rental of computers, computer software.

#### Class 43

Provision of facilities for conventions, conferences, lectures, exhibitions, day schools, workshops, seminars; provision of board room facilities; provision of trade show facilities.

#### Class 45

Rental of sports clothing; inspection of apparatus; legal services and legal research; legal consultancy services.

## Annex 2

CMU's earlier mark 3974151



### Class 16

Printed publications, namely, instructional manuals, books, articles, reports and printed guidelines concerning organizational development and design capabilities.

### Class 35

Business appraisal consulting services in process appraisal to organizations engaged in the acquisition or production of products and services.

### Class 41

Providing training in process appraisal to organizations engaged in the acquisition or production of products and services.

### Class 42

Computer consultation services, namely providing assessment services to businesses and governmental agencies and units to determine their computer development and design capabilities.