

**O-546-15**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION 3066508  
FOR THE TRADE MARK**

**NOOLEGE**

**IN CLASS 41**

**BY PROTHEAN CORP.**

**AND**

**THE OPPOSITION THERETO UNDER NO. 403412  
BY ALAN GRAHAM BURR**

## Background and pleadings

1. Prothean Corp. ("the applicant") applied for the trade mark NOOLEGGE on 30 July 2014 for the following services in Class 41:

*Learning services; online-learning services; e-learning services; online courses; online/offline teaching services; educational services relating to real world skills, sharing skills and recounting experiences for use in developing knowledge; coaching; social-networking; Distance learning services; Interactive and distance learning courses and sessions provided on-line via a telecommunications link or computer network or provided by other means; Correspondence courses, distance learning; Organisation of courses using distance learning methods; Organisation of courses using open learning methods; Organisation of courses using programmed learning methods; Teaching assessments for counteracting learning difficulties; Arrangement of training courses in teaching institutes; Arranging professional workshop and training courses; Business training; Driver safety training; Medical training and teaching; Training for handling scientific instruments and apparatus for research in laboratories; Training of specialists in the plumbing industry; Charitable services, namely, provision of vocational training; Computer education training; Computer education training services; Computer training; Computer training services; Consultancy services relating to the education and training of management and of personnel; Electronic data processing training; Horse training; Job training services; Training and further training consultancy; Training animals for others; Training in administration; Training in the use and operation of data processors; Training in the use of construction machinery; Training services concerned with the use of computer software; Arranging and conducting of training workshops; Computer assisted training services; Management training consultancy services; Management training services; Training; Training and education services; Training courses; Training services; Training services for cinema technicians; Training courses in strategic planning relating to advertising, promotion, marketing and business; Adult training; Adventure training for children; Advice relating to medical training; Advisory services relating to training; Aerobics training services; Arranging of competitions for training purposes; Arranging of conferences relating to training; Arranging of conventions for training purposes; Arranging of demonstrations for training purposes; Arranging of displays for training purposes; Arranging of exhibitions for training purposes; Arranging of festivals for training purposes; Arranging of presentations for training purposes; Arranging of seminars relating to training; Blindness prevention techniques (training in-).*

2. Alan Graham Burr opposes the application on the basis of section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). He relies upon the following earlier trade mark registration<sup>1</sup>:

3061642

Nolidge

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<sup>1</sup> The mark is also registered in class 9, but the goods in this class are not relied upon for the purposes of this opposition.

Class 35: Advertising services provided via the internet.

Class 38: Chat room services.

Class 42: Commissioned writing for the compilation of websites.

Filing date: 24 June 2014; date registration procedure completed 10 October 2014.

3. In his notice of opposition, Mr Burr claims:

“Phonetically NOOLEGE (opposed) and NOLIDGE (oppose) are very similar (KNOWLEDGE).

As evidenced by the applicants Twitter and website pages [www.nooledge.com](http://www.nooledge.com) provides sharing of knowledge through chat rooms services.

We will be providing a very similar service.

The relevant public will believe the trademarks are used by the same undertaking or think that there is an economic connection between the users of the trademarks.”

4. The applicant denies the ground of opposition, claiming that it is purely speculative and that the marks do not sound or look similar.

5. Both parties represent themselves. Neither filed evidence or asked to be heard. Mr Burr filed written submissions in lieu of a hearing. These include references to section 10 of the Act. Infringement is a matter for the courts; this opposition is based upon section 5(2)(b). The applicant sent a short letter at the beginning of the proceedings, along the lines of the contents of its counterstatement.

## **Decision**

6. Section 5(2)(b) of the Act states that:

“(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.”

7. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of services

8. The parties' specifications are:

Earlier mark	Application
<p>Class 35: <i>Advertising services provided via the internet.</i></p> <p>Class 38: <i>Chat room services.</i></p> <p>Class 42: <i>Commissioned writing for the compilation of websites.</i></p>	<p>Class 41: <i>Learning services; online-learning services; e-learning services; online courses; online/offline teaching services; educational services relating to real world skills, sharing skills and recounting experiences for use in developing knowledge; coaching; social-networking; Distance learning services; Interactive and distance learning courses and sessions provided on-line via a telecommunications link or computer network or provided by other means; Correspondence courses, distance learning; Organisation of courses using distance learning methods; Organisation of courses using open learning methods; Organisation of courses using programmed learning methods; Teaching assessments for counteracting learning difficulties; Arrangement of training courses in teaching institutes; Arranging professional workshop and training courses; Business training; Driver safety training; Medical training and teaching; Training for handling scientific instruments and apparatus for research in laboratories; Training of specialists in the plumbing industry; Charitable services, namely, provision of vocational training; Computer education training; Computer education training services; Computer training; Computer training services; Consultancy services relating to the education and training of management and of personnel; Electronic data processing training; Horse training; Job training services; Training</i></p>

	<p><i>and further training consultancy; Training animals for others; Training in administration; Training in the use and operation of data processors; Training in the use of construction machinery; Training services concerned with the use of computer software; Arranging and conducting of training workshops; Computer assisted training services; Management training consultancy services; Management training services; Training; Training and education services; Training courses; Training services; Training services for cinema technicians; Training courses in strategic planning relating to advertising, promotion, marketing and business; Adult training; Adventure training for children; Advice relating to medical training; Advisory services relating to training; Aerobics training services; Arranging of competitions for training purposes; Arranging of conferences relating to training; Arranging of conventions for training purposes; Arranging of demonstrations for training purposes; Arranging of displays for training purposes; Arranging of exhibitions for training purposes; Arranging of festivals for training purposes; Arranging of presentations for training purposes; Arranging of seminars relating to training; Blindness prevention techniques (training in-).</i></p>
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9. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the Court of Justice of the European Union (“CJEU”) stated, at paragraph 23 of its judgment:

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

10. 'Complementary' was defined by the General Court ("GC") in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

"82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...".

11. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* ("Treat") [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

12. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"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."

13. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

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

14. The applicant's services, with the exception of social networking, are all training services. These are not similar in nature to any of Mr Burr's services. They are not similar in purpose. They are not in competition and are not complementary; there is no relationship between advertising, chat room services, writing of websites and training such that the average consumer would assume that the same undertaking is responsible for them. Mr Burr alleges (without proving) that the applicant provides training through chat rooms. This does not make the services any more similar than telephone services compared to telephone banking services. The provision of a service over a particular medium does not make the service similar to the medium of provision. The same is true of social networking services. Mr Burr's chat room services are telecommunication services in class 38, not social networking *per se*. The parties' services are not similar.

### Average consumer

15. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

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

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

17. The average consumer for the applicant's services is a person or business looking for training services. On a notional view, the purchase of training services will cause some degree of care to be used. The more advanced or expensive the training, the closer will be the attention paid to its selection. The purchasing process is likely to be primarily visual, e.g. after consulting a website or prospectus, but I do not discount the potential for aural use, such as via word of mouth recommendation. Mr Burr's services are typically business to business services, although advertising services are purchased by individuals too. His services are all internet based, which means that, by nature, they will be almost wholly a visual purchase. A reasonable, but not the highest, level of attention will be paid to their selection.

### Comparison of marks

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

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

19. The respective marks are:



Earlier mark	Application
Nolidge	NOOLEGE

20. Both marks consist of single elements which give them their overall impression. There are some visual similarities: both begin with NO, contain the letter L and end with DGE. The double OO in the application makes it look longer than the earlier mark, and the vowel in the second syllable is different (I/E). They are visually similar to a moderate degree. Phonetically, the earlier mark sounds like the word KNOWLEDGE, whereas the application, with its lengthened first syllable, does not. There is little phonetic similarity. Although the earlier mark sounds like KNOWLEDGE, it looks nothing like it. Unless articulated, it is highly unlikely that the average consumer would recognise the concept of KNOWLEDGE in the earlier mark, and even less likely in the application. There is no conceptual similarity between the marks on a visual level, and conceptual difference aurally. Overall, there is only a low degree of similarity between the marks.

#### Distinctive character of the earlier mark

21. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>2</sup> the CJEU stated that:

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

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

22. Mr Burr has filed no evidence of use, so I have only the inherent position to consider. The mark, an invented word, is visually high in inherent distinctive character because it does not allude to or describe any characteristics of the

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<sup>2</sup> Case C-342/97.

services for which it is registered. Aurally, is of average distinctive character as it sounds like KNOWLEDGE.

### Likelihood of confusion

23. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. This includes keeping in mind the whole mark comparison, because the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. One of the principles in the authorities states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I have found that the parties' services are not similar, which means that there can be no likelihood of confusion, as per *Waterford Wedgwood plc v OHIM Case C-398/07*, in which the CJEU stated:

“35 It must be noted that the Court of First Instance, in paragraphs 30 to 35 of the judgment under appeal, carried out a detailed assessment of the similarity of the goods in question on the basis of the factors mentioned in paragraph 23 of the judgment in *Canon*. However, it cannot be alleged that the Court of First Instance did not take into account the distinctiveness of the earlier trade mark when carrying out that assessment, since the strong reputation of that trade mark relied on by Waterford Wedgwood can only offset a low degree of similarity of goods for the purpose of assessing the likelihood of confusion, and cannot make up for the total absence of similarity. Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

24. That, effectively, is the end of the matter. I also find that even if I had found that there was some similarity between the services, the differences between the marks, for services to which a reasonable level of attention will be paid during selection, would avoid any likelihood of confusion.

### **Costs**

25. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale of costs published in Tribunal Practice Notice 4/2007. The applicant was self-represented, so would not have had the cost of professional representation. I have reduced the award accordingly. I award the applicant £100 for considering the opposition and filing the counterstatement.

26. I order Alan Graham Burr to pay Prothean Corp. the sum of £100 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

**Dated this 23rd day of November 2015**

**Judi Pike  
For the Registrar,  
the Comptroller-General**