

O-207-16

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3081069
BY INNOVATIVE PROSPERITY (UK) LTD
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 41:**



AND

**OPPOSITION THERETO (NO. 403867) BY
THE CHANCELLOR MASTERS AND SCHOLARS OF THE UNIVERSITY OF
OXFORD**

Background and pleadings

1. UK Trade mark application no. 3081069 was filed on 11 November 2014 and published for opposition purposes on 5 December 2014. The applicant for the trade mark is Innovative Prosperity (UK) Ltd. The mark and the class 41 services for which registration is sought are:



Online education, oncampus education, training courses; Education courses relating to the travel industry; Information about education; Information on education; Career counseling [education]; Computer education training; Computer education training services; Consultancy services relating to the education and training of management and of personnel; Education in the field of art rendered through correspondence courses; Education information services; Education services in the nature of courses at the university level; Information relating to sports education; Physical education services; Pre-school education; Providing continuing dental education courses; Providing continuing legal education courses; Providing continuing medical education courses; Providing continuing nursing education courses; Arranging of competitions for education or entertainment; Education services; Physical education programmes; Entertainment, education and instruction services; Information relating to education, provided on-line from a computer database or the internet; Information services relating to education; Organisation of competitions (education or entertainment); Education; Organisation of competitions for education or entertainment; Academy education services; Adult education services; Adult education services relating to accounting; Adult education services relating to auditing; Adult education services relating to banking; Adult education services relating to commerce; Adult education services relating to environmental issues; Adult education services relating to finance; Adult education services relating to intellectual property; Adult

education services relating to law; Adult education services relating to management; Adult education services relating to medicine; Adult education services relating to pharmacy; Advisory services relating to education; Arranging of conferences relating to education; Arranging of seminars relating to education; Blindness prevention education services; Career advisory services (education or training advice); Career counselling [training and education advice]; Certification of education and training awards; Charitable services, namely education and training; Club education services; Competitions (organisation of-) [education or entertainment]; Computer assisted education services; Computer assisted physical education services; Conference display services relating to adult basic education; Consultancy services relating to engineering education; Consultation services relating to business education; Dietary education services; Education (information relating to -); Education (religious-); Education academy services; Education academy services for teaching acting; Education academy services for teaching art history; Education academy services for teaching construction drafting; Education academy services for teaching languages; Education advisory services relating to accountancy; Education courses relating to automation; Education examination; Education in movement awareness; Education in road safety; Education in the field of computing ; Education in the field of computing science; Education in the field of data processing; Education services for imparting data processing teaching methods; Education services for imparting language teaching methods; Education services for managerial staff; Education services in the form of music television programmes; Education services provided by holiday resort establishments; Education services provided by radio; Education services provided by television; Education services provided by television programmes; Education services provided by tourist resort establishments; Education services related to the arts; Education services relating to ayurvedic magnetism; Education services relating to banking; Education services relating to business franchise management; Education services relating to business training; Education services relating to commerce; Education services relating to communication skills; Education services relating to computer software; Education services relating to computer systems; Education services relating to computers; Education services relating to conservation.

2. The opponent is The Chancellor Masters and Scholars of the University Of Oxford¹. In summary, its grounds of opposition are under: i) section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) in that there is a likelihood of confusion with four earlier UK trade mark registrations² which consist of, or contain, either the words OXFORD UNIVERSITY or UNIVERSITY OF OXFORD; ii) section 5(3) of the Act in that the applicant’s mark would take unfair advantage or would be detrimental to the distinctiveness and/or repute of the opponent’s four earlier marks and; iii) section 5(4)(a) of the Act in that the use of the applied for mark would confuse people and cause a misrepresentation to them on account of the opponent’s “massive reputation and goodwill” for educational services associated with the sign UNIVERSITY OF OXFORD which has been used in the UK since 1586. In relation to the four earlier marks, I will set out the relevant details later in this decision, to the extent necessary.

3. The applicant filed a counterstatement. Despite two of the opponent’s earlier marks³ being subject to the proof of use provisions⁴ (because they had been registered for more than five years when the applied for mark was published), the applicant did not put the opponent to proof of use. The consequence of this is that the opponent is entitled to rely on the services for which it has claimed use in its statement of case, the claimed use being a subset of the services for which the marks are registered. I do not need to detail all of those services here, but record that they include:

“Education and training services;.....; all provided by a university”

4. Although there is clearly more to the dispute than this, I would highlight two important issues that arise in these proceedings, first, the role that the word OXFORD plays in the competing marks. This can best be illustrated by the following competing

¹ Later evidence shows that the opponent is a lay corporation, incorporated by statute (An Act for the Incorporation of Both Universities) in 1571

² UK registrations 2224116, 2055566, 2568560 & 2570762

³ UK registrations 2224116 & 2055566

⁴ See section 6A of the Act

statements in the respective sides' statement of case/counterstatement. The opponent stated:

“The opponent has acquired distinctiveness in the trade mark OXFORD through its long and prominent use of the trade mark in the education sector. As a result of this acquired distinctiveness customers will easily associate use of an OXFORD branded education establishment with the opponent, as opposed to as a geographical indication.”

whereas the applicant stated:

“The fact that the word OXFORD forms part of the [earlier trade marks] does not entitle [the opponent] to the exclusive use of the word OXFORD”

and

“Having indicated the right by law [a reference to section 11(2)(b) of the Act] to make use of an indication of geographical origin, we can confirm that the business school, for which registration is being sought, relates to educational services which will be provided in Oxford.”

5. The second point is that the applicant draws a distinction between a business school and a university. It states:

“In the present case there can be no doubt that the applicant is not claiming any right or connection with a university. The mark is clearly referred to as a Business School, which is a recognised term for an institution that provides education and confers qualifications in business administration or management. A definition of such institutions is enclosed from which you will see that there can be no question that the educational service is as a university.”

6. The applicant has represented itself throughout the proceedings. The opponent is represented by Sipara Limited. Only the opponent filed evidence. Neither party asked to be heard. The opponent filed written submissions in lieu of a hearing, the applicant did not.

The opponent's evidence

7. This comes from Mr Geoffrey Lees, a solicitor who works in the opponent's legal services office. Mr Lees provides evidence about the history and notoriety of the University of Oxford. I do not consider it necessary to summarise all of this. I would have accepted on judicial notice that the University of Oxford is an extremely well-known university in the UK and, also, worldwide. It is one of the top universities in the world. According to evidence in Exhibits GL5 and GL6 it has been ranked in 5th and 3rd places in tables of top international higher education institutes. In its written submissions the opponent highlights a judgment⁵ of the Intellectual Property Enterprise Court ("IPEC") where Judge Lambert stated:

"There is very valuable goodwill which has been developed over many hundreds of years also associated with the Claimant's marks. I have further found that the Claimant is often referred to as "Ox-ford", and that the use of that mark with words descriptive of the services it provides is strongly associated with the Claimant's business.

8. I will, though, touch on three points that come out of the evidence:

- i) The structure of The University of Oxford. Mr Lees explains that the opponent is structured as a "...collegiate university, consisting of the central university and colleges. The central University is composed of academic departments, faculties and research centres, administrative departments, libraries and museums. The 38 colleges are independent self-governing institutions, which are related to the central university in a federal system".
- ii) The University of Oxford is often referred to as Oxford. Mr Lees states that the opponent's name is often abbreviated and referred to as Oxford. This was noted by Judge Lambert in the case cited above. Evidence in Exhibits

⁵ *University of Oxford v Oxford Law School Ltd* [2014] All ER (D) 104 (Jan)

GL7 (an extract from The Complete University Guide), show that as well as references to the city of Oxford (to explain where the university is based), there are references to Oxford as an indication of the name of the educational establishment. Exhibit GL9 contains screenshots from the opponent's website where the opponent uses the abbreviated form in text e.g. "every student at Oxford is a member of a college". There is also evidence showing the word OXFORD used in relation to publications sold through the opponent's publishing service. The Oxford English dictionary is one such title.

- iii) Business education provided by the University of Oxford. Mr Lees states that the opponent has offered courses in leadership since 1966 through a division which was then named The Oxford Centre for Management Studies, which was renamed Templeton College in 1966. The educational services provided by Templeton College were then transferred to Said Business School in 2005. It is stated that the opponent has continued to offer these services through the Said Business School (stated to be a department of the opponent) since then. There are various press articles in Exhibit GL18 about the changes of name and the subsequent transfer of the educational services to Said Business School. The articles do not paint as straightforward a picture as Mr Lees does. But what is clear is that, as Mr Lees states, Said Business School is promoted as being a part of the University of Oxford. Information about the business school is then provided. In 2015 the Financial Times ranked the business school 22nd in the world in respect of full time MBA programmes and, also, 10th in the world in the combined ranking of Executive Education programmes. The business school has had an annual turnover exceeding £50 million in the last two years and expended more than £2 million on advertising. Its website had over 1.7 million hits "last year" and it regularly emails over 100,000 prospective contacts regarding its activities.

The relevance of section 11(2)(b) of the Act

9. At this juncture, it is worthwhile dealing with an apparent misconception on the part of the applicant. As noted earlier, the applicant refers (in its counterstatement) to section 11(2)(b) of the Act. This stipulates that a registered trade mark is not infringed by (my emphasis added):

“(b) **the use of indications concerning the** kind, quality, quantity, intended purpose, value, **geographical origin**, the time of production of goods or of rendering of services, or other characteristics **of goods or services**, ...”

10. By referring to the above provision, the applicant appears to consider that it has a defence in these proceedings. However, this is not the case because the provision is a defence against infringement and has no direct impact on the opponent’s ability to oppose (and potentially succeed) a new trade mark application. The question before the tribunal is simply whether the use of the applied for mark would give rise to confusion/deception or one of the other heads of damage. I accept, though, that the applicant’s underlying point is not wholly irrelevant. However, the point being made is better expressed that there will be no confusion/deception etc. because the only point of coincidence between the names is the use of a geographical location with the consequence that such coincidence will not confuse anyone into believing that any form of connection exists between the respective undertakings. I will, of course, return to this point later.

Section 5(4)(a) – passing off

11. I will deal first with the ground of opposition under section 5(4)(a) of the Act, which reads:

“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 this Act as the proprietor of “an earlier right” in relation to the trade mark.”

12. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing-off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It 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.”

13. 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:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) 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.

While 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.”

The relevant date

14. In *SWORDERS*⁶ Mr Allan James, acting for the Registrar, considered the relevant date for the purposes of section 5(4)(a) of the Act and concluded that:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

15. This analysis was subsequently approved by Mr Daniel Alexander QC as the Appointed Person in *Advanced Perimeter Systems Limited v Multisys Computers Limited*⁷. Kitchen L.J. made similar findings in relation to the relevant date for determining the validity of a Community Trade Mark in analogous circumstances: see *Maier v ASOS*⁸. The filing date of the subject trade mark is 11 November 2014. There is no pre-filing use made by the applicant, consequently, that is the only date that need be considered.

⁶ BL O-212-06

⁷ BL O-410-11

⁸ [2015] EWCA Civ 377

Goodwill

16. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), the Court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

17. The opponent's pleaded case is that it has a “massive reputation and goodwill” associated with the name UNIVERSITY OF OXFORD. Given what I have already said about the opponent's evidence, this is undoubtedly the case. The opponent lists various educational and educational related services “all provided by a university” as representing the use which has been made. This is also clearly the case. Although it may be that the opponent's goodwill was first founded, and is perhaps the strongest, based upon traditional academic education, the opponent has also offered a business school, firstly under the names The Oxford Centre for Management Studies/Templeton College, but more recently under the name Said Business School.

Misrepresentation

18. In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] *R.P.C.* 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

19. The applicant's mark consists of the words OXFORD BUSINESS SCHOOL and a figurative element consisting of half a Union Flag. The sign used and relied upon by the opponent consists of the words UNIVERSITY OF OXFORD. There is clearly an aspect of similarity between mark and sign on account of the common presence of the word OXFORD. The words UNIVERSITY OF and BUSINESS SCHOOL are clearly descriptive, so less significance will be placed on those words. Whilst a Union Flag (or in this case half of one) is not particularly distinctive, it nevertheless contributes to the overall impression of the applicant's mark, and, consequently, reduces the degree of visual similarity with the opponent's sign. There is a moderate (between low and medium) level of visual similarity, together with a medium level of aural similarity. There is a high degree of conceptual similarity as both mark and sign comprise the word OXFORD together with aspects which are descriptive of the services in question (BUSINESS SCHOOL/UNIVERSITY OF)

20. Under the law of passing-off there is no pre-requisite for there to be a common field of activity. However, in the case before me the applicant seeks registration of its mark for a range of educational services. Although some of the educational services it seeks registration for are somewhat at odds with the use of the words BUSINESS

SCHOOL in the mark, the fact remains that they could all potentially be provided in a university. It is logical to assume, both from the nature of the applicant's mark, and also from the comments the applicant made in its counterstatement, that the primary services of interest will be education services in the field of business study. As I have already observed, the opponent's goodwill extends to such things.

21. That then leads to the key question of misrepresentation. The question boils down to whether a substantial number of people would, if the applied for educational services were offered under the applicant's mark, believe that the opponent was in some way responsible for them. In that respect, it is clear that the respective names would not be mistaken for one another. Nevertheless, it is still possible for customers and potential customers to come to the erroneous belief that is required for the ground to succeed. This is particularly so bearing in mind that a university will often have departments and faculties. That is clearly the case with the opponent's operating structure, something which I am sure is not untypical within the field. The counter argument, though, is the applicant's point regarding the geographical significance of the word OXFORD. In *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39, Lord Simonds stated that:

“Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

22. I accept that the same rationale could be adopted here. However, each case must be considered on its own merits, there are no hard and fast rules. In the case before me the goodwill of the opponent is extremely strong. It has been established that the university it operates has various faculties and departments. There is also evidence showing that whilst the sign used by the opponent is UNIVERSITY OF OXFORD, it is often abbreviated to OXFORD. Be it in trade, or be it, as is the case here, in a trade mark, whether the use of the word OXFORD will be seen purely as an indication of

geographical origin (as the applicant submits) depends on the context of use. I come to the view that here, at the very least, a substantial number of members of the public will see the applied for mark as indicating a department or faculty within the opponent's university. They will believe that there is some form of economic connection and that the opponent will have an overarching responsibility for the quality of the services.

23. I do not consider that the above finding is undermined by the fact that the opponent already operates a business school called SAID BUSINESS SCHOOL. First, not all customers or potential customers will know of this, so, when encountering the applied for mark, such people will have the erroneous belief explained in the previous paragraph. Even for customers/potential customers that know of SAID BUSINESS SCHOOL (as a department or faculty of the opponent) then the applied for mark is likely to be assumed as some form of new name, either which has replaced, or is to operate in conjunction with, SAID BUSINESS SCHOOL; thus, the erroneous belief that the opponent is responsible for the services offered under the applied for mark will still be engendered. The opponent succeeds in clearing the hurdle of misrepresentation.

Damage

24. In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing-off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if

he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.”

25. All of the applied for services could, as I have already indicated, be offered by a university. The opponent’s university offers education in a wide range of fields. Consequently, there is clear potential for damage based upon a direct loss of sales.

26. There is also potential for damage more generally. In *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA), Warrington L.J. stated that:

“To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me.”

Further, I note that in *WS Foster & Son Limited v Brooks Brothers UK Limited* [2013] EWPC 18, Mr Recorder Iain Purvis QC stated:

“Damage

55 Although proof of damage is an essential requirement of passing off cases, it will generally be presumed where a misrepresentation leading to a likelihood of deception has been established, since such deception will be likely to lead to loss of sales and/or more general damage to the exclusivity of the Claimant's unregistered mark. Mr Aikens accepted that if there was a misrepresentation in the present case, then he had no separate case on damage. I hold that damage is inevitable, at least in the sense recognised in *Sir Robert McAlpine v Alfred McAlpine* [2004] RPC 36 at 49 (the ‘blurring, diminishing or erosion’ of the distinctiveness of the mark).”

27. These forms of damage are particularly important in a case such as this where the opponent offers services which are clearly of the highest standing and repute and where detrimental impacts may arise on the basis of an injurious association and which may also have an impact on the exclusivity of the services offered.

28. The opponent succeeds under section 5(4)(a) in relation to all of the applied for services. Strictly speaking, I do not need to consider the other grounds of opposition, but I nevertheless outline my views below.

Section 5(2)(b)

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

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

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

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

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

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

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

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

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings 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

31. It is, in my view, only necessary to consider the matter on the basis of the first two of the opponent's earlier marks⁹, both of which, as stated earlier, cover:

“Education and training services;.....; all provided by a university”

32. Goods and services may be considered identical if one term falls within the ambit of another, as per the judgment in *Gérard Meric v OHIM*, Case T-133/05. All of the applied for services are educational in nature and all could be provided in a university. Consequently, the services are identical.

33. The applicant comments in its counterstatement that it does not operate via a university. Even if this fact were reflected in some way in the applicant's specification, little changes because the services would still be the same in inherent nature and purpose, they would be used by people in the same way and they would compete. Thus, even if the services were not identical, they would be similar to a very high degree.

Average consumer and the purchasing act

34. 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. 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

⁹ UK registrations 2224116 & 2055566

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.”

35. In its written submissions, the opponent submitted that the average consumer is a person seeking education in the field of business study and that the selection process would be modest because of the relative obscurity of the applicant’s business. This is not the correct approach. First, it does not reflect the extent of the services in play and, second, the obscurity or otherwise of the applicant does not affect how an average consumer will select the services he is or she is looking for. The opponent also submitted that the Union Flag in the applicant’s mark shows that the applicant targets people from overseas who will have limited knowledge of the UK and will, therefore, associate the word OXFORD exclusively with the opponent. Again, I do not accept these points. They represent an over analytical view of the applicant’s mark, and also, as already observed, the nature of the applicant’s mark does not affect the average consumer of the services.

36. Consumers of the services involved would ordinarily be members of the public who are seeking education. They could be (relatively) young people of traditional university age, but also older people. I accept that the selection process for an appropriate service provider in this field is likely to be a fairly considered one. The marks will be encountered on brochures, prospectus, websites etc., all of which suggests a predominantly visual process, but aural considerations should not be ignored due to the impact of speaking to people at careers and educational fairs etc.

Comparison of marks

37. 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 (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

38. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:



v

UNIVERSITY OF OXFORD and OXFORD UNIVERSITY

39. I have already touched on the similarity of the applicant’s mark and the UNIVERSITY OF OXFORD earlier mark. It would be superfluous to repeat my analysis, but I highlight that I considered that there was a moderate (between low and medium) level of visual similarity, a medium level of aural similarity and a high level of conceptual similarity. In comparison to OXFORD UNIVERSITY, a similar analysis applies, however, the greater similarity in structure of the verbal elements (OXFORD plus description) leads to a higher level of visual and aural similarity (medium and reasonably high respectively) with the applied for mark; as per my earlier assessment, the marks are high in conceptual similarity.

Distinctive character of the earlier marks

40. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

41. Whilst from an inherent perspective the earlier marks may not be particularly distinctive, it should be clear from the observations I have already made that the marks benefit from an enhanced reputation and are to be regarded as highly distinctive. This applies to OXFORD UNIVERSITY as well as THE UNIVERSITY OF OXFORD as it is clear that the former will be seen as an alternate name for the latter.

Likelihood of confusion

42. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

43. As I found earlier in passing-off, it is clear that the marks will not be mistaken for one another, even bearing in mind the concept of imperfect recollection. However, direct confusion is just one type of confusion. At paragraph 30, point k, I highlighted above a concept which is often referred to as “indirect confusion”:

“(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.”

44. In the case before me, my finding is that there is a likelihood of indirect confusion. Due to the similarity that exists between the marks and the identity (or very high similarity) between the services, together with the very strong reputation that exists, the common use of OXFORD will not be put down to a coincidental use of a geographical name, but will instead indicate to the average consumer that the applicant’s mark (and the services it offers) are part of the opponent’s university offering. The opposition succeeds under section 5(2)(b) on the basis of both the earlier marks I am considering.

Section 5(3)

45. Section 5(3) of the Act reads:

“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 Community trade mark, 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.”

Reputation

46. The earlier marks (I will consider the same two as per the assessment under section 5(2)(b)) must have a reputation. In *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572 the CJEU stated:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

47. For reasons that should be clear by now, my finding is that the earlier marks pass the reputation requirement.

The required link

48. In addition to having a reputation, a link must be made between the subject trade mark and the earlier marks. In *Adidas-Salomon*, the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

49. In *Intel Corporation Inc v CPM (UK) Ltd* (C-252-07) (“Intel”) the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.

50. I have already assessed the above factors at various parts of this decision. I come to the view that the relevant public will make a link. That is so even if there was no likelihood of confusion.

The heads of damage

51. There are three potential heads of damage under section 5(3). They are often referred to as: i) free-riding, ii) dilution, and iii) tarnishing. The three kinds of damage were conveniently summarised by the CJEU in Case C-487/07), *L’Oréal v Bellure*, as follows:

“39. As regards detriment to the distinctive character of the mark, also referred to as ‘dilution’, ‘whittling away’ or ‘blurring’, such detriment is caused when that mark’s ability to identify the goods or services for which it is registered is weakened, since use of an identical or similar sign by a third party leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is particularly the case when the mark, which at one time aroused immediate

association with the goods or services for which it is registered, is no longer capable of doing so (see, to that effect, *Intel Corporation*, paragraph 29).

40. As regards detriment to the repute of the mark, also referred to as ‘tarnishment’ or ‘degradation’, such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark’s power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.

41. As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.”

52. Given my finding that there is a likelihood of indirect confusion, it follows, in this case, that an unfair advantage will be gained. Members of the relevant public will be attracted to the services offered under the applied for mark because they believe them to be under the auspices of the opponent’s university. The applicant will thus be benefiting from the opponent’s reputation, a reputation it has built up over very many years. In terms of whether such advantage is unfair, I note that in *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the unfairness of the advantage gained and held:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant’s intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a

particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the

53. The above applies in this case. The applicant refers to the geographical meaning of the word OXFORD which could be said to be an argument of due cause, or at least explain why any advantage gained is not unfair. However, whilst there may be circumstances in which the word OXFORD may be used and presented which may not give rise to a presumed association with the university, the circumstance here, in respect of the subject mark, is that such an association will be presumed and that its objective effect will be as described.

54. Even if my finding had been that there was no likelihood of confusion, members of the relevant public would at least pause to wonder whether the services offered under the applied for mark come from the same or a related undertaking as the opponent. This, in itself, would give rise to two heads of damage. First, the bringing to mind of the opponent's mark may still result in members of the relevant public being attracted to the applicant's services and, perhaps, benefiting from the opponent's reputation for high quality training, in other words, some of that prestige may rub off. Second, the use of another brand featuring the word OXFORD (plus descriptor) and the pausing to wonder that may occur will dilute the distinctiveness of the opponent's mark and, consequently, may have an impact on its capacity to be immediately associated with the opponent. The ground under section 5(3) succeeds.

Conclusion

55. All three grounds of opposition have succeeded. The application is to be refused for all of its services.

Costs

56. The opponent has succeeded and is entitled to a contribution towards its costs. My assessment is set out below:

Official fee - £200

Preparing a statement and considering the other side's statement - £300

Filing evidence - £700

Written submissions - £400

Total - £1600

57. I therefore order Innovative Prosperity (UK) Ltd to pay The Chancellor Masters and Scholars of the University of Oxford the sum of £1600. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of April 2016

Oliver Morris

For the Registrar,

The Comptroller-General