

O-061-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3179540
BY ROCKEFELLER INTERNATIONAL LIMITED
TO REGISTER**

Rockefeller

**AS A TRADE MARK
IN CLASSES 20, 26, 27, 41, 42 AND 45
AND
IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 408473
BY THE ROCKEFELLER UNIVERSITY**

BACKGROUND

1. On 10 August 2016 Rockefeller International Limited (“the applicant”) applied to register the trade mark Rockefeller for certain goods and services in classes 20, 26, 27, 41, 42 and 45.

2. The application was published for opposition purposes on 4 November 2016.

3. The application is opposed by The Rockefeller University (“the opponent”). The opposition is based upon Section 5(2)(b) of Trade Marks Act 1994 (“the Act”). The opponent relies upon the following International Trade Mark no. 1137231, as shown below:

THE ROCKEFELLER UNIVERSITY

4. The registration contains the following disclaimer: "UNIVERSITY".

5. The opponent relies upon all of the goods and services in its registration, namely:

Class 9: Downloadable electronic publications in the nature of newsletters in the fields of science and medicine.

Class 16: Publications, namely, books, newsletters and pamphlets in the fields of science and medicine.

Class 41: Educational services in the nature of providing courses of instruction and distributing course materials in connection therewith and training at the university and post-graduate levels, and conducting or sponsoring lectures, seminars, colloquia, and symposia in the fields of biochemistry, structural biology, chemistry, immunology, virology, microbiology, neurosciences, physics, mathematical biology, medical sciences, human genetics and molecular, cell, and developmental biology.

Class 42: Scientific and medical research services in the fields of biochemistry, structural biology, chemistry, immunology, microbiology, medical sciences, human genetics, molecular, cell, and developmental biology.

Class 45: Licensing of intellectual property.

6. The opponent's mark has an international registration date of 16 March 2012 and was granted protection in the EU on 2 October 2013, which is less than five years before the publication date of the application. The significance of these dates is that (1) the opponent's mark constitutes an "earlier mark" for the purposes of section 5(2)(b) of the Act, and (2) the proof of use provisions in section 6A of the Act do not apply in respect of it.

7. The application covers goods and services in a number of classes, but only the following are opposed:

Class 41: Teaching; education; training; conducting of seminars and congresses; arranging of exhibitions for cultural purposes

Class 42: Technical research services

Class 45: Investigations in relation to intellectual property; intellectual property services; advisory services relating to intellectual property protection; management of trademarks; legal services relating to the registration of trademarks; consultancy relating to the protection of industrial designs; licensing of patents; management of patents; copyright management consultation; legal services relating to copyright licensing.

8. The opponent claims that the applied for mark is highly similar to the earlier mark and covers services that are identical with and/or similar to those under the earlier mark, such that there would be a likelihood of confusion. The applicant filed a notice of defence and counterstatement, denying the claims.

9. Neither party filed evidence. Neither side requested a hearing but the opponent filed written submissions in lieu of a hearing. I will refer to these submissions as necessary

below. The opponent is represented in these proceedings by Mishcon De Reya LLP. The applicant represents itself.

DECISION

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

“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.”

Section 5(2)(b) - case-law

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

12. In comparing the respective specifications, all the relevant factors should be taken into account. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

13. The parties’ goods and services are as follows:

Applicant’s services	Opponent’s goods and services
Class 41: Teaching; education; training; conducting of seminars and congresses; arranging of exhibitions for cultural purposes	Class 9: Downloadable electronic publications in the nature of newsletters in the fields of science and medicine.
Class 42: Technical research services	Class 16: Publications, namely, books, newsletters and pamphlets in the fields of science and medicine.
Class 45: Investigations in relation to intellectual property; intellectual property services; advisory services relating to intellectual property protection; management of trademarks; legal services relating to the registration of	Class 41: Educational services in the nature of providing courses of instruction and distributing course materials in connection therewith and training at the university and post-graduate levels, and

<p>trademarks; consultancy relating to the protection of industrial designs; licensing of patents; management of patents; copyright management consultation; legal services relating to copyright licensing.</p>	<p>conducting or sponsoring lectures, seminars, colloquia, and symposia in the fields of biochemistry, structural biology, chemistry, immunology, virology, microbiology, neurosciences, physics, mathematical biology, medical sciences, human genetics and molecular, cell, and developmental biology.</p> <p>Class 42: Scientific and medical research services in the fields of biochemistry, structural biology, chemistry, immunology, microbiology, medical sciences, human genetics, molecular, cell, and developmental biology.</p> <p>Class 45: Licensing of intellectual property.</p>
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14. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

15. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (GC) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

16. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

17. In its counterstatement, the applicant admitted that there are some similarities in the respective specifications. However, it also argues that the goods and services covered by the earlier mark are different from those specified in the application because of their specialist nature. It states:

“11. One important factor to be taken into consideration when ascertaining the similarity of goods and services is their distribution channel. Although this was not explicitly mentioned in Canon, it is widely used as an assessment criterion (See, amongst others, Decision of the Court of First Instance of April 21, 2005, Case No.: T-164103 - monBeBe). The reasoning behind this criterion

is that if services are made through the same distribution channels, the consumer may be more likely to assume that the goods or services are possibly manufactured by the same entity and vice versa. This factor is of even greater importance when the goods are sold in the same sections of large shops, such as supermarkets, or in smaller specialized shops.

12. Applying this factor to the case at hand, the services of the earlier mark, in Class 41 in particular, would be distributed more specifically to postgraduates and undergraduate students, who are focused on biology, chemistry and physics. The classes and courses provided appeal to a specific group of individuals interested in this field. As such, the quality and provision of the education will be specialist and niche. Accordingly, it is unlikely that the average consumer would be confused by the educational services provided.”

18. The specialist nature of the goods and services of the earlier mark does not prevent the conclusion that they are encompassed by the broader terms covered by the application. The opposed *teaching, education, training and conducting of seminars and congresses* are not limited in any way and notionally cover the *educational services in the nature of providing courses of instruction and distributing course materials in connection therewith and training at the university and post-graduate levels, and conducting or sponsoring lectures, seminars, colloquia, and symposia in the fields of biochemistry, structural biology, chemistry, immunology, virology, microbiology, neurosciences, physics, mathematical biology, medical sciences, human genetics and molecular, cell, and developmental biology* of the earlier mark. These services are identical on the principle outlined in *Meric*.

19. Likewise, the opposed *arranging of exhibitions for cultural purposes* notionally cover the same specialist fields to which the services of the earlier mark relate, i.e. science exhibitions. Even if the nature and methods of use of the respective services are different, the users would be the same, i.e. students, teachers, scientists, and the purpose would also be similar, i.e. educational and cultural. The services may be provided through the same channels, i.e. universities and societies, and there is a clear complementary relationship in the sense that customers may think that the

responsibility for those services lies with the same undertaking. Overall, I find that these services are similar to a high degree to the opponent's services in class 41.

20. The opposed *technical research services* are also broadly defined. Even if technical research is not identical to the opponent's *scientific and medical research services in the fields of biochemistry, structural biology, chemistry, immunology, microbiology, medical sciences, human genetics, molecular, cell, and developmental biology*, I still find that the respective services are similar. The distinction between scientific research and technical research is often a fine one, with the two branches of research supporting and informing each other. The nature, purpose and methods of use are similar, the services may be utilised by the same users and provided by the same companies and have therefore a strong complementary relationship. These services are similar to a high degree to the opponent's services.

21. The opposed *intellectual property services, management of trademarks, licensing of patents, management of patents, copyright management consultation, legal services relating to copyright licensing* either encompass or are encompassed by the *licensing of intellectual property* services covered by the earlier mark. These services are also identical on the *Meric* principle.

22. This leaves *investigations in relation to intellectual property, advisory services relating to intellectual property protection, legal services relating to the registration of trademarks and consultancy relating to the protection of industrial designs*. The nature and purpose of these services is similar to the nature and purpose of the opponent's *licensing of intellectual property* as they are both aimed at managing and protecting intellectual property rights. The users and method of use are the same and the services are likely to be provided by the same companies, i.e. law firms, so there is a clear complementary relationship in the sense established by the case law. I find that these services are highly similar to the opponent's services.

The average consumer and the nature of the purchasing act

23. As the case law above indicates, it is necessary for me to determine who the average consumer is for the services at issue; I must then determine the manner in which these services will be selected in the course of trade. 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.”

24. The average consumer of the parties’ services is either the general public or a business users. The services are not every day purchased. Given their specialist nature and their likely cost, the average consumer will select the services with, at least, an above average degree of attention.

25. The selection process is predominantly visual, with the marks being encountered on websites or in marketing material, although, there is some potential for aural considerations, as I do not exclude that the services may be acquired following word of mouth recommendations.

Distinctive character of earlier mark

26. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*²⁶, 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).”

27. As no evidence of use has been filed by the opponent, I have only the inherent distinctive character to consider. The earlier mark consists of the word THE ROCKEFELLER UNIVERSITY. However, it has a disclaimer of the word UNIVERSITY. The disclaimer is an admission by the trade mark owner that the disclaimed component is not distinctive of its goods and services and that its presence in another party’s trade mark cannot give rise to a likelihood of confusion¹.

28. Regardless of the disclaimer, the words THE and UNIVERITY in the earlier mark describe (or are allusive of) the entity that provides the services and, I agree with the opponent, they do not materially alter the distinctive character of the mark. The word ROCKEFELLER is, therefore, the main identifier of the opponent’s business. It has no meaning in respect of the services at issue, it is neither allusive nor descriptive. The opponent states that the name ROCKEFELLER is solely known as the name of a well-known family in the USA and has a high degree of inherent distinctiveness.

29. The word ROCKEFELLER has no meaning in the English language and even if the UK consumers were to recognise it as a US name, they will regard it as unusual

¹ PACO/PACO LIFE IN COLOUR [2000] RPC 451

and striking. They will therefore accord it with a high degree of inherent distinctive character.

Comparison of marks

30. 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 them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

31. It would be wrong therefore artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features, (which are not negligible) and therefore contribute to the overall impressions created by them.

32. The marks to be compared are:

Application	Earlier mark
Rockefeller	THE ROCKEFELLER UNIVERSITY

Overall impression

33. The applied for mark is made up of the single word Rockefeller presented in titled case. There are no other elements to contribute to the overall impression, which is contained in the word itself.

34. The earlier mark consists of the words THE ROCKEFELLER UNIVERSITY presented all in upper case. I have already stated that the dominant and distinctive element of the mark is the word ROCKEFELLER. Given the meaning of the mark, I also take the view that the word ROCKEFELLER has an independent distinctive significance since it will be perceived as the name given to the concerned University.

Visual similarity

35. Visually, both marks share the word Rockefeller/ROCKEFELLER. As notional and fair use means that either mark could be used in upper, lower or titled case, the difference created by the cases as presented above is not relevant. Owing to the presence of the words THE and UNIVERSITY in the earlier mark, it appears much longer than the applied for mark. Even taking into account that difference, I find that there is a medium degree of visual similarity.

Aural similarity

36. Aurally, the word Rockefeller/ROCKEFELLER will be pronounced identically in each mark. I am of the view that given the descriptive/allusive nature of the words THE and UNIVERSITY in relation to the services, consumers may not articulate them and that the marks may, therefore, be aurally identical. Were the words THE and UNIVERSITY to be articulated, however, I conclude there would be a medium degree of aural similarity between the competing marks.

Conceptual similarity

37. The applicant states that the marks are conceptually different because the word UNIVERISTY in the earlier mark introduces a clear concept, which is absent in the opposed mark. I agree that the words THE and UNIVERISTY in the earlier mark are

likely to be perceived as a reference to a place of learning which (depending on what people know) either bears the surname ROCKEFELLER, or is in a place called ROCKEFELLER (universities frequently being called after the place where they are located). For those average consumers who know that ROCKEFELLER is a famous US surname, the marks are conceptually similar to a good degree. For the other group of consumers, who do not know it, it is likely that the word ROCKEFELLER will be perceived as having no particular meaning, in which case, given the reference to the concept of University in the earlier mark, the conceptual position will be different. However, as the words THE and UNIVERSITY are descriptive or allusive in relation to the services, any concept they introduce must be regarded as being of little or no importance.

Likelihood of confusion

38. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective services and vice versa. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

39. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the

other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

40. Earlier in my decision, I have found the parties’ marks to be visually similar to a medium degree and aurally identical (or similar to a medium degree). The marks are conceptually similar to a good degree for those consumers who know that ROCKEFELLER is a famous US surname. For the other group of consumers, who do not know it, ROCKEFELLER will be perceived as an invented word having no particular meaning, in which case although the conceptual position will be different, the difference will be created by a concept that must be regarded as being of little or no importance. The parties’ services are either identical or highly similar and the earlier mark has a high degree of inherent distinctive character². The average consumer is a member of the general public or a business user who will select the services primarily by visual means (though I do not discount an aural component). The degree of attention paid will be above average for both groups of average consumer.

41. In assessing the likelihood of confusion, I also bear in mind that what gives the earlier mark its distinctive character is the word ROCKEFELLER which is identical to the single and dominant component of the applied for mark. Further, regardless of how the average consumers will understand the word ROCKEFELLER in THE ROCKEFELLER UNIVERSITY (as a surname, as a place or as a word with no meaning) it will be perceived as having an independent distinctive character. Weighting all of these factors, my conclusion is that, notwithstanding the above average degree of attention, the marks are close enough to cause direct confusion. Even if average consumers were to notice the differences between the marks, given

² See C-120/04 *Medion v Thomson Multimedia Sales* [2005] ECR I-8551 and C-591/12P *Bimbo SA v OHIM*

the common element ROCKEFELLER, they would think that the services are provided by economically connected undertakings. There is also a likelihood of indirect confusion.

Conclusion

42. The opposition succeeds in relation to the opposed services which are:

Class 41: Teaching; education; training; conducting of seminars and congresses; arranging of exhibitions for cultural purposes

Class 42: Technical research services

Class 45: Investigations in relation to intellectual property; intellectual property services; advisory services relating to intellectual property protection; management of trademarks; legal services relating to the registration of trademarks; consultancy relating to the protection of industrial designs; licensing of patents; management of patents; copyright management consultation; legal services relating to copyright licensing.

43. The application will proceed to registration in relation to the unopposed goods and services, which are:

Class 20: Divans; sofas; armchairs; beds; ottomans; tables; chairs; chaises longues; furniture; mirrors; picture frames

Class 26: Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.

Class 27: Carpets; rugs; matting; linoleum for use on floors; non-textile wall hangings.

Class 41: Entertainment services; production of television programs; film distribution; production of shows; production of films; provision of non-

downloadable films and television programs via a video-on-demand service; arranging, conducting and organisation of workshops; organizing and arranging exhibitions for entertainment purposes; organizing and presenting displays of entertainment [relating to style and fashion]; organization of [fashion] shows for entertainment purposes

Class 42: Technical design and planning of telecommunications equipment; computer software technical support services; technical consultancy relating to the application and use of computer software; technical assessments relating to design; graphic design services; fashion design; creating and maintaining web sites.

COSTS

44. As the opponent has been successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice (TPN) 2/2016, I award costs on the following basis:

Official fee:	£100
Preparing the notice of opposition and considering the counterstatement:	£200
Written submissions:	£200

45. I order Rockefeller International Limited to pay The Rockefeller University the sum of £500 as a contribution towards its costs. This sum is to 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 day 26th January 2018

Teresa Perks

For the Registrar

The Comptroller – General