

O/130/20

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 3230901
IN THE NAME OF LITTLE GENIUS LTD
FOR THE FOLLOWING TRADE MARK:



IN CLASSES 9, 16, 25, 28, 35 AND 41

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 502456 BY LITTLE GENIUS INTERNATIONAL SRL SB

BACKGROUND AND PLEADINGS

1. Little Genius Ltd (“the proprietor”) is the registered owner of the mark shown on the cover page of this decision (“the contested mark”). The contested mark was filed in the UK on 14 May 2017 and was registered on 04 August 2017. It stands registered for the goods and services shown in the Annex I to this decision.

2. On 5 February 2019, Little Genius International Srl SB (“the applicant”) applied to have the contested mark declared invalid under Section 47 of the Trade Marks Act 1994 (“the Act”). The applicant relies upon Sections 5(2)(b), 5(3) and 3(6) of the Act.

3. Under Section 5(2)(b) and Section 5(3), the applicant relies on the following earlier trade marks:

EU008905325



Colours Claimed: White, Red, Blue and Grey.

Filing date: 23 February 2010; Date of entry in register: 02 September 2010.

The applicant relies on all of the goods and services for which the mark is registered, as shown in the Annex II to this decision.

EU015319817



Colours Claimed: White, Red, Blue and Grey.

Filing date: 08 April 2016; Date of entry in register: 05 September 2016.

The applicant relies on all of the goods and services for which the mark is registered, as shown in the Annex II to this decision.

4. Under Section 5(2)(b), the applicant claims that there is a likelihood of confusion because the respective goods and services are identical or similar and the marks are similar.

5. Under Section 5(3), the applicant claims that the earlier marks have a reputation in respect of all of the goods and services for which the earlier marks are registered and that use of the contested mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the earlier marks. Although under this ground the applicant makes the claim that all of the goods and services for which the contested mark is registered should be invalidated, it specifically refers to the risk that the relevant public would believe that the marks are used by the same (or economically connected) undertaking(s) in relation to the goods in class 25 covered by the contested mark, because, it says, the goods “*are understood to be intended for use in an educational setting (as a form of school uniform) where the applicant has its greatest reputation.*” The applicant also states that:

- a) the contested mark takes unfair advantage of the earlier marks because the proprietor has copied the specification of the earlier marks. The claim being made is as follow:

The later registrant has copied part of the earlier registrant's specification verbatim. The earlier registrant's intellectual effort in creating the specifications has been taken by the later registrant. The time and expense of drafting specifications has been borne by the earlier registrant, and the later registrant has simply copied this work. Therefore, the later registrant has obtained a specification without having to consider and draft their own specification. The later registrant has obtained an economic benefit by using the work paid for by the earlier registrant, and the method they have used to obtain this financial benefit is unfair.

The earlier registrant has put a substantial amount of effort and expense in to creating a methodology of teaching. If the later registrant is using the same methodology, then it is being used without the consent of the earlier registrant. This would mean that the later registrant is using a methodology that it has not licenced, and which it has not incurred any expense in creating. This would give the later registrant the benefit of the methodology without having incurred the burden of its developmental cost, and this would give the alter registrant an unfair financial advantage over the earlier registrant.

- b) Use of the later mark will cause detriment to the reputation of the earlier marks and will dilute their distinctiveness. The claims being made are as follows:

The earlier registrant has put a substantial amount of effort and expense in to creating a methodology of teaching. If the later registrant is not using the same methodology, then consumers who have been misled (by use of a similar sign) into believing that the later registrant is operating under the same methodology will be disappointed not to have received the goods and/or services under the standards they were expecting.

The earlier registrant's reputation will suffer detriment as a result of this, as the consumers will be disappointed by not having received the same goods and/or services they were expecting.

and

Allowing a third party, unauthorised user of a highly similar mark will dilute the uniqueness of the earlier registrant's mark. This will lead to the earlier mark losing its unique quality, and its distinctive character will suffer detriment as a result of this erosion of the earlier marks unique characteristics.

6. Under Section 3(6), the applicant's claim is as follows:

1-the Registrant was fully aware of the Applicant for Invalidation's ("AFI's") earlier rights in a highly similar mark. This is undeniable because the Registrant copied verbatim (including spelling mistakes and incorrect capitalisation) large parts of the AFI's specifications which it can only have done by being fully aware of the AFI's earlier registrations.

The Registrant took the conscious decision to apply for a highly similar trade mark with the knowledge that the dominant element was owned by a third party.

The Registrant, who was fully aware of the AFI's mark through its prior use in the same field, conducted a search of the UK TM register of the dominant element of each mark, being the words LITTLE GENIUS, to find it in order to copy its specification and thus ensure that it obtained rights which directly conflicted with the earlier registrant's rights.

Alternatively, the Registrant conducted a clearance search to determine if any rights existed in a similar mark to that of interest to it, found the earlier rights, copied the specification in the full knowledge that an earlier right existed which directly conflicted with their proposed mark, ignored the close similarity of the marks and proceeded with the application regardless of the obvious conflict. The Registrant was also informed of the existence of the AFI's rights by the UKIPO Examiner, but again ignored those rights and proceeded with the application.

In summary, the Registrant's intent in proceeding with registration of a mark where it *undeniably* was fully aware of the earlier rights of a third party, and yet proceeded with an application despite knowledge of the obvious conflict, can only lead to the conclusion that the Registrant's application was filed in bad faith, and prosecuted in bad faith.

7. In addition, the applicant claims that the proprietor has filed an overly wide specification and has no bona fide intention to use the mark on all the goods and services listed in the specification. Finally, the applicant claims that the proprietor registered the mark in order to prevent the applicant, whom started its business in the EU, from using the marks in the UK.

8. The proprietor filed a counterstatement denying the claims made and putting the applicant to proof of use of the earlier EU008905325 mark. In its counterstatement, the proprietor claims that it had notified the applicant of its intention to apply to the EUIPO to invalidate its earlier EU008905325 and EU015319817 marks and says that proceedings should be suspended pending the outcome of those actions. However, no request for suspension has been made and it is not clear whether the proprietor had actually filed any invalidity action against the earlier marks.

9. The applicant is represented by Dolleymores and the proprietor is represented by Cloch Solicitors. The applicant filed evidence and written submissions during the evidence rounds. This will be summarised to the extent that I consider necessary. The proprietor filed nothing behind the counterstatement. Neither party requested to be heard or filed submissions in lieu of a hearing.

EVIDENCE

10. The applicant's evidence consists of a witness statements by Mr Stuart Nield, a chartered trade mark attorney employed by Dolleymores. Mr Nield explains that the content of its witness statement comes from his own knowledge, from researches he has performed or from information provided by his instructing associate. Mr Nield provides only one exhibit, Exhibit LG1, which includes the following sub-exhibits:

Sub-Exhibit LG1A consists of photographs of children which are said were taken (1) on an educational school trip in Italy on 18 May 2015 and (2) at a Little Genius Sport Day on 13/14 June 2014. Some of children wear caps and t-shirts which seem to display the earlier EU008905325 mark, but it is difficult to make out any details. Mr Nield states that this sub-exhibit shows evidence of the earlier mark used on clothing and headgear as well as educational activities;

Sub-Exhibit LG1B consists of an undated photograph of a white t-shirt with the following mark embroidered on the chest area:



Sub-Exhibit LG1C and LG1D consist of photographs of the front pages of two Italian magazines dated April and June 2019 with cards placed over them. The cards display characters from children's books and variations of the mark shown above and are said to be vouchers for the applicant's school which were distributed in Italy. However, they look more like bookmarks and there is nothing to indicate that they contain an offer;

Sub-Exhibit LG1E consists of copies of webpages from the Wayback machine from the applicant's website at www.littlegenius.it dated 1 September 2018. They show items of school uniform for sale and seem to display the earlier EU015319817 mark, but, again, it is difficult to make out any details. Mr Nield says that this evidence shows use of the earlier mark in relation to clothing and *"in general"* because, he states *"the mark appears on the website of the Applicant, and is therefore sufficient to demonstrate that the Applicant, who provides educational services by various means, was using the mark in relation to all areas of its use"*.

Sub-Exhibit LG1F consists of undated copies from the website www.littlegenius.school promoting the applicant's international school. The copies were printed on 19 July 2019;

Sub-Exhibit LG2 consists of a copy of the UKIPO's response to the proprietor's application to register the contested mark. It lists the applicant's marks as earlier marks;

Sub-Exhibit LG3 consists of an extract from the proprietor's website at www.littlegenius.org.uk showing that its director has taught in International Schools in America and Italy.

DECISION

11. Sections 5(2)(b), 5(3) and 3(6) of the Act have application in invalidation proceedings because of the provisions set out in Section 47. The relevant parts of Section 47 are as follows:

"47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

[...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

[...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

[...]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

[...]

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court;

and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

THE SECTION 5(2)(b) GROUND FOR INVALIDATION

12. Section 5(2)(b) of the Act is as follows:

“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”.

13. The earlier EU008905325 mark was registered on 02 September 2010, more than 5 years before the date of the application for invalidation, i.e. 5 February 2019. Consequently, the enforcement of the applicant’s rights is subject to proof of use of the earlier EU008905325 mark in the EU in the period ending on the date of the application for invalidation, namely 6 February 2014 to 5 February 2019 (“the first relevant period”). As the earlier EU008905325 mark has been registered for more than 5 years at the date the contested mark was filed, i.e. 14 May 2017, the proof of use is

also required in the five-year period ending on the filing date of the contested mark, namely 15 May 2012 to 14 May 2017 (“the second relevant period”).

14. The earlier EU015319817 mark was registered on 5 September 2016 and is not subject to proof of use.

Proof of use of EU008905325

15. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark:

Ansul at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

17. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

18. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

19. The onus is upon the applicant to prove that its trade mark has been put to genuine use within the EU during the relevant periods.

20. The majority of the exhibits filed by the applicant are undated or were printed after the relevant periods and, as such, do not assist in helping the applicant to establish genuine use within the relevant periods. Also, most importantly, the applicant did not provide any evidence of sales in the UK or even in the EU. There is no indication of turnover or marketing expenditures. Whilst the evidence suggests that the applicant runs an international school in Rome and that it uses the mark in relation to that business, there is no specific evidence as to when the school was set up and no detail as to how many pupils attended the school at the point in time when genuine use must be assessed. More generally, the applicant failed to adduce any evidence that any of the goods and/or services listed in the registered specification were actually provided within the relevant periods (or, if they were provided, to what extent they were provided). It was entirely within the applicant's gift to provide sales and marketing figures for each range of goods and/or services in the UK and/or EU but there is no explanation as to why this has not been done. **My conclusion is therefore that the applicant has not shown that it has genuinely used the earlier EU008905325 mark in the relevant periods and cannot rely on that mark in the present opposition proceedings.**

21. However, this is not the end of the matter. As I have already said, the opponent can still rely on the earlier EU015319817 which is not subject to proof of use.

Section 5(2)(b) – case law

22. 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 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 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

23. 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 of its judgment that:

“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”.

24. 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 uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) 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;

(f) 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.

25. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court 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”.

26. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (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”.

27. The applicant’s submission regarding the parties’ respective goods and services is that the comparison of the goods and services must be carried out taking into account that both parties are involved in education of young children and that all the conflicting goods and services will be offered within that context. According to the applicant all of the goods and services at issue “*must be considered as related, and hence similar goods regardless of the closeness of the goods and services if viewed in a vacuum*”. I reject the submission. The list of items covered by the parties’ marks includes goods and services which are not limited to the education sector and

therefore I am required to consider notional use of the marks separate from the context of the type of business or trade intended by the parties. I shall return to this point later.

28. The proprietor concedes that there is some similarity between the respective specifications¹. However, as the proprietor does not say to what degree it accepts that the goods and services are similar, I will proceed to my own assessment.

29. The goods and services to be compared are:

The proprietor's goods and services	The applicant's goods and services
<p><u>Class 9</u>: DVD players; compact disc players; CD-ROMs bearing sound or visual recordings; prerecorded compact discs; prerecorded cassette tapes; prerecorded mini discs; prerecorded video tapes; computer programs computer software; optical apparatus and instruments for use in education; MP3 players; video disc players; video recorders; video cassettes; electronic books (downloadable); electronic study papers (downloadable). Audio and video recording; Scientific and teaching apparatus and instruments; Teaching apparatus and equipment; Magnetic, optical or magnetic/optical carriers, including compact disks, DVDs, cassettes, diskettes, cartridges containing multi-media and/or audiovisual material, sound, images and texts, all for instructional and teaching purposes, and in particular for instruction</p>	<p><u>Class 9</u>: Audio and video recording; Scientific and teaching apparatus and instruments; Teaching apparatus and equipment; Magnetic, optical or magnetic/optical carriers, including compact disks, DVDs, cassettes, diskettes, cartridges containing multi-media and/or audiovisual material, sound, images and texts, all for instructional and teaching purposes, and in particular for instruction and teaching of languages, calculating machines; Apparatus for recordings, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Computer software; Games software; Application software for social networking services via internet; Instruction manuals in electronic format; Application software for cloud computing services.</p>

¹ Paragraph 9 of the counterstatement

<p><i>and teaching of languages, calculating machines; Apparatus for recordings, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Computer software; Games software; Application software for social networking services via internet; Instruction manuals in electronic format; Application software for cloud computing services.</i></p>	
<p><u>Class 16:</u> <i>Stationery, calculating tables, pencils, erasers, tools for memorising words, pen cases, books, booklets, writing or drawing books, magazines, paper including home study paper, name card paper; instruction and teaching materials (except apparatus); folders for papers; blackboards; hand writing specimens for copying; periodicals, catalogues, pamphlets, posters, manuals, models for study. Adhesives for stationery or household purposes; Artists' materials; Paint brushes; Typewriters and office requisites (except furniture); Stationery and instructional and teaching material (except apparatus), namely cases for stationery, office stationery, party stationery, writing stationery, stickers (stationery), plastic envelopes, envelopes (stationery), tracing patterns, wall calendars, desk calendars, calendar desk pads, printed calendars, pocket calendars, folders for</i></p>	<p><u>Class 16:</u> <i>Adhesives for stationery or household purposes; Artists' materials; Paint brushes; Typewriters and office requisites (except furniture); Stationery and instructional and teaching material (except apparatus), namely cases for stationery, office stationery, party stationery, writing stationery, stickers (stationery), plastic envelopes, envelopes (stationery), tracing patterns, wall calendars, desk calendars, calendar desk pads, printed calendars, pocket calendars, folders for papers, portfolios, folders (stationery), desk mats, box files, pen clips, glitter glue for stationery purposes, compasses for drawing, filing containers, desktop business card holders, memo pad holders, writing paper holders, letter holders, stapler holders, file covers, paper clip holders, holders for adhesive tapes, holders for files, art mounts, French curves, elastic bands for offices, decorative pencil-top</i></p>

<p><i>papers, portfolios, folders (stationery), desk mats, box files, pen clips, glitter glue for stationery purposes, compasses for drawing, filing containers, desktop business card holders, memo pad holders, writing paper holders, letter holders, stapler holders, file covers, paper clip holders, holders for adhesive tapes, holders for files, art mounts, French curves, elastic bands for offices, decorative pencil-top ornaments, adhesive labels, highlighting markers, paperweights, staples for offices, paper fasteners, school supplies (stationery), crayons, chalk, staples (stationery), paper-clips, angle guides (drawing instruments), lettering stencils, ink, printed flip charts, blank flip charts, whiteboards, adhesive-backed letters and numbers, noteboards, staple removers, coloured pencils, lead for coloured pencils, sticky tape, daily planners, fibre-tip markers, coloured pens, colouring pens, folders (stationery), holders for desk accessories, holders for notepads, letter holders, stamp mounts, document portfolios, thumbtacks (stationery), loose-leaf binders, rulers; Rulers; File cards; Desk sets, Seals for the office, Shields [paper seals], Drawing instruments; Notebooks, Paper knives [office requisites], Desk pads, Pencil sharpeners, Plastic materials for packaging (not included in other classes), Printers' type; Printing blocks; Paper, Cardboard and goods made from this material, not included in other classes, namely, Year planners, Desk diaries, Diaries, Pocket notebooks, Stationery, Office requisites, Paper stationery, Notelets, Correspondence cards, Gift wrap cards, Note pads, Pads [stationery], Note pads, Sketch pads,</i></p>	<p><i>ornaments, adhesive labels, highlighting markers, paperweights, staples for offices, paper fasteners, school supplies (stationery), crayons, chalk, staples (stationery), paper-clips, angle guides (drawing instruments), lettering stencils, ink, printed flip charts, blank flip charts, whiteboards, adhesive-backed letters and numbers, noteboards, staple removers, coloured pencils, lead for coloured pencils, sticky tape, daily planners, fibre-tip markers, coloured pens, colouring pens, folders (stationery), holders for desk accessories, holders for notepads, letter holders, stamp mounts, document portfolios, thumbtacks (stationery), loose-leaf binders, rulers; Rulers; File cards; Desk sets, Seals for the office, Shields [paper seals], Drawing instruments; Notebooks, Paper knives [office requisites], Desk pads, Pencil sharpeners, Plastic materials for packaging (not included in other classes), Printers' type; Printing blocks; Paper, Cardboard and goods made from this material, not included in other classes, namely, Year planners, Desk diaries, Diaries, Pocket notebooks, Stationery, Office requisites, Paper stationery, Notelets, Correspondence cards, Gift wrap cards, Note pads, Pads [stationery], Note pads, Sketch pads,</i></p>
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<p>sharpeners, Plastic materials for packaging (not included in other classes), Printers' type; Printing blocks; Paper, Cardboard and goods made from this material, not included in other classes, namely, Year planners, Desk diaries, Diaries, Pocket notebooks, Stationery, Office requisites, Paper stationery, Notelets, Correspondence cards, Gift wrap cards, Note pads, Pads [stationery], Note pads, Sketch pads, Writing tablets, Notepads, Notepads, Sketch pads, Writing tablets, Envelopes [stationery], Carbonless copying paper, Copying paper, Writing paper, Headed notepaper, Graph paper, Notepaper, Envelope paper, Label paper, Photocopy paper, Paper for wrapping books, Postcards, Paper party decorations, Paper stationery, Labels of paper, Paper sheets for note taking, Quick reference pocket guides, Pocket books [stationery], Writing or drawing books, Bookmarkers, Adhesive paper, Note pads, Stencil paper [mimeograph paper], Bond paper, Paper for bags and sacks, Postcard paper, Computer paper, Publication paper, Magazine paper, Digital printing paper, Laser printing paper, Recycled paper, Paper sheets [stationery], Folios; Printed matter; Bookbinding material; Photographs;</p>	<p>Writing tablets, Notepads, Notepads, Sketch pads, Writing tablets, Envelopes [stationery], Carbonless copying paper, Copying paper, Writing paper, Headed notepaper, Graph paper, Notepaper, Envelope paper, Label paper, Photocopy paper, Paper for wrapping books, Postcards, Paper party decorations, Paper stationery, Labels of paper, Paper sheets for note taking, Quick reference pocket guides, Pocket books [stationery], Writing or drawing books, Bookmarkers, Adhesive paper, Note pads, Stencil paper [mimeograph paper], Bond paper, Paper for bags and sacks, Postcard paper, Computer paper, Publication paper, Magazine paper, Digital printing paper, Laser printing paper, Recycled paper, Paper sheets [stationery], Folios; Printed matter; Bookbinding material; Photographs; Stationery; Books, brochures and publications.</p>
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<i>Stationery; Books, brochures and publications.</i>	
<u>Class 25:</u> <i>Clothing, footwear, headgear.</i>	
<u>Class 28:</u> <i>Toys, including wooden toys, building blocks (toys), paper toys, plastic toys, toys for education; playing cards; jigsaw puzzles; games of education; magnetic number board games; the parts and fittings for all the aforesaid in class 28.</i>	<u>Class 28:</u> <i>Games and playthings; Gymnastic and sporting articles not included in other classes; Card games.</i>
<u>Class 35:</u> <i>Business management and organisation consulting, business management assistance, business information services, professional business consultancy, marketing research, providing management guidance to franchised learning service centres, providing management guidance to franchisees, providing operational guidance to franchisees, advertising, business management assistance, business advisory and consultancy services associated with educational services. Advertising; Help in the working or management of a commercial undertaking or the business affairs or commercial functions of a commercial enterprise; Advertising by mail order; Updating of advertising material; All of the foregoing services relating to teaching businesses and establishments, in particular language teaching; Organization of events,</i>	<u>Class 35:</u> <i>Advertising; Help in the working or management of a commercial undertaking or the business affairs or commercial functions of a commercial enterprise; Advertising by mail order; Updating of advertising material; All of the foregoing services relating to teaching businesses and establishments, in particular language teaching; Organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes.</i>

<p><i>exhibitions, fairs and shows for commercial, promotional and advertising purposes.</i></p>	
<p><i>Class 41: Publication of educational texts; publication of books; education examination services; translation services; tuition, education, teaching and instruction, including education teaching and instruction by correspondence courses; providing educational information and data; consultancy and guidance on education; rental and leasing of education books and texts; rental and leasing of educational sound recordings and visual recordings; publication of electronic books and journals online; providing online electronic publications (not downloadable); education information services; provision of correspondence courses; operation of academies; arranging and conducting seminars, symposiums, workshops and conferences; mathematics, language including English, and infant education; education by correspondence; providing methods of instruction for use with learning materials; provision of learning materials for after school education classes, advisory and consultancy services associated with the above-mentioned services. Education;</i></p>	<p><i>Class 41: Education; Providing of training; Entertainment; Sporting and cultural activities; Services rendered by teaching establishments, in particular language teaching; Customized teaching services, namely, language teaching, including services rendered in establishments, at home or via communications networks; Education and training relating to nature conservation and the environment; Educational and training services relating to games; Arranging and conducting of games; Organising of educational games; Musical education services; Musical education services; Arranging and conducting of concerts; Arranging and conducting of concerts; Education in the field of computing; Provision and management of sporting events; Sports tuition, coaching and instruction; Conducting of educational courses in science; Education in the field of computing; Training for parents in parenting skills; Educational services provided by a school.</i></p>

<p><i>Sporting and cultural activities; Services rendered by teaching establishments, in particular language and mathematics teaching; Customized teaching services, namely, language and mathematics teaching, including services rendered in establishments, at home or via communications networks; Education and training relating to nature conservation and the environment; Educational and training services relating to games; Arranging and conducting of games; Organising of educational games; Musical education services; Musical education services; Arranging and conducting of concerts; Arranging and conducting of concerts; Education in the field of computing; Provision and management of sporting events; Sports tuition, coaching and instruction; Conducting of educational courses in science; Education in the field of computing; Training for parents in parenting skills; Educational services provided by a school.</i></p>	
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Class 9

30. The terms *Audio and video recording; Scientific and teaching apparatus and instruments; Teaching apparatus and equipment; Magnetic, optical or magnetic/optical carriers, including compact disks, DVDs, cassettes, diskettes, cartridges containing multi-media and/or audiovisual material, sound, images and texts, all for instructional and teaching purposes, and in particular for instruction and teaching of languages, calculating machines; Apparatus for recordings, transmission*

or reproduction of sound or images; Magnetic data carriers, recording discs; Computer software; Games software; Application software for social networking services via internet; Instruction manuals in electronic format; Application software for cloud computing services; are identically contained in both specifications.

31. The contested *computer programs computer software* is encompassed by (and is identical to) the applicant's *computer software (Meric)*.

32. The contested *CD-ROMs bearing sound or visual recordings; prerecorded compact discs; prerecorded cassette tapes; prerecorded mini discs; prerecorded video tapes; video cassettes;* fall within (and are identical to) the applicant's *Magnetic, optical or magnetic/optical carriers, including compact disks, DVDs, cassettes, diskettes, cartridges containing multi-media and/or audiovisual material, sound, images and texts, all for instructional and teaching purposes (Meric)*.

33. The contested *optical apparatus and instruments for use in education; DVD players; compact disc players; MP3 players; video disc players; video recorders* are encompassed by (and are identical to) the applicant's *Apparatus for recordings, transmission or reproduction of sound or images (Meric)*.

34. The contested *electronic books (downloadable); electronic study papers (downloadable)* are highly similar to the applicant's *Audio and video recording*, which would include audio-books. They are also similar to the applicant's *Magnetic, optical or magnetic/optical carriers, including compact disks, DVDs, cassettes, diskettes, cartridges containing multi-media and/or audiovisual material, sound, images and texts*, which can feature study materials, so the goods may be in competition with each other and/or be interchangeable. Furthermore, they may be aimed at the same consumers, and may coincide in producers and distribution channels.

Class 16

35. The following goods in the contested specification are identical to the terms listed in the applicant's specification: *Adhesives for stationery or household purposes; Artists' materials; Paint brushes; Typewriters and office requisites (except furniture);*

Stationery and instructional and teaching material (except apparatus), namely cases for stationery, office stationery, party stationery, writing stationery, stickers (stationery), plastic envelopes, envelopes (stationery), tracing patterns, wall calendars, desk calendars, calendar desk pads, printed calendars, pocket calendars, folders for papers, portfolios, folders (stationery), desk mats, box files, pen clips, glitter glue for stationery purposes, compasses for drawing, filing containers, desktop business card holders, memo pad holders, writing paper holders, letter holders, stapler holders, file covers, paper clip holders, holders for adhesive tapes, holders for files, art mounts, French curves, elastic bands for offices, decorative pencil-top ornaments, adhesive labels, highlighting markers, paperweights, staples for offices, paper fasteners, school supplies (stationery), crayons, chalk, staples (stationery), paper-clips, angle guides (drawing instruments), lettering stencils, ink, printed flip charts, blank flip charts, whiteboards, adhesive-backed letters and numbers, noteboards, staple removers, coloured pencils, lead for coloured pencils, sticky tape, daily planners, fibre-tip markers, coloured pens, colouring pens, folders (stationery), holders for desk accessories, holders for notepads, letter holders, stamp mounts, document portfolios, thumbtacks (stationery), loose-leaf binders, rulers; Rulers; File cards; Desk sets, Seals for the office, Shields [paper seals], Drawing instruments; Notebooks, Paper knives [office requisites], Desk pads, Pencil sharpeners, Plastic materials for packaging (not included in other classes), Printers' type; Printing blocks; Paper, Cardboard and goods made from this material, not included in other classes, namely, Year planners, Desk diaries, Diaries, Pocket notebooks, Stationery, Office requisites, Paper stationery, Notelets, Correspondence cards, Gift wrap cards, Note pads, Pads [stationery], Note pads, Sketch pads, Writing tablets, Notepads, Notepads, Sketch pads, Writing tablets, Envelopes [stationery], Carbonless copying paper, Copying paper, Writing paper, Headed notepaper, Graph paper, Notepaper, Envelope paper, Label paper, Photocopy paper, Paper for wrapping books, Postcards, Paper party decorations, Paper stationery, Labels of paper, Paper sheets for note taking, Quick reference pocket guides, Pocket books [stationery], Writing or drawing books, Bookmarkers, Adhesive paper, Note pads, Stencil paper [mimeograph paper], Bond paper, Paper for bags and sacks, Postcard paper, Computer paper, Publication paper, Magazine paper, Digital printing paper, Laser printing paper, Recycled paper, Paper sheets [stationery], Folios; Printed matter; Bookbinding material; Photographs; Stationery; Books, brochures and publications.

36. Applying the principle set out in *Meric*, the contested *Stationery, calculating tables, pencils, erasers, tools for memorising words, pen cases, books, booklets, writing or drawing books, magazines, paper including home study paper, name card paper; instruction and teaching materials (except apparatus); folders for papers; blackboards; hand writing specimens for copying; periodicals, catalogues, pamphlets, posters, manuals, models for study* fall within (and are identical to) the applicant's term *Printed matter and Stationery (Meric)*.

Class 25

37. As regards the similarity between the proprietor's *Clothing, footwear, headgear* and the applicant's goods and services, the applicant states:

"...These goods are clothing, footwear and headgear. We submit that there are only two possible scenarios related to this clothing. Firstly, that it will be school uniform which is directly related to education by its very nature; it is only worn during school, or during school related activities: children simply do not wear uniforms outside of being directly related to schooling/education. [...] Alternatively, the [proprietor] may claim that the clothing is not intended to be used as uniform, but rather would be placed on the open market and would be available for sale to any party who wishes their child to wear. We would submit that any such argument would be fanciful, and that the clothing is either for use as uniform [...] or there is no intention to use the mark on clothing that is not uniform, in which case the application in respect of clothing was made in bad faith. We also take the opportunity to review the mark involved"

38. The applicant's claim that the proprietor does not intend to use the mark on all of the goods covered by the specification in class 25 is not relevant to the assessment of the similarity between the respective goods and services. Having said that, I agree with the applicant that there is some similarity between the contested goods in class 25 and the applicant's services in class 41. The closest clash I can see is with the applicant's *Education; Sporting and cultural activities; Provision and management of sporting events*. For the purpose of this comparison, the approach based on notional and fair use of the marks across the full width of the specifications works in favour of

the applicant. A similar conclusion was reached by the Board of Appeal in a recent case (R 887/2018-2), where it was held that:

“36. The opponent argues that the contested ‘education, entertainment and sports; sports and fitness; providing sports entertainment via a website; sporting and cultural activities; entertainment, sporting and cultural activities; organizing and presenting displays of entertainment relating to style and fashion; organisation of events for cultural, entertainment and sporting purposes; organization of sporting events and competitions, involving animals’ in Class 41 are similar to a high degree to ‘sporting equipment and articles’ in Class 28 covered by the earlier mark.

37. The General Court has held that the organization of sporting activities involves the use of ‘games’— and, by extension, ‘gymnastic and sporting articles’—hence, a degree of low similarity exists between them (16/09/2013, T-250/10, *Knut - der Eisbar*, EU:T:2013:448, § 68-76).

38. Furthermore, it is common for gymnasiums to sell small articles of sports attire (t- shirts, swimming caps, weightlifting gloves) and accessories (e.g. squash balls, weightlifter belts, etc.). In addition, manufacturers of sporting articles tend to promote the practicing of sports and may be organisers or sponsors of sporting events. The complementary nature of the goods and services, together with the overlap of distribution channels, indicates that those goods and services have a certain similarity. The Boards of Appeal have applied this line of reasoning in several decisions regarding in particular the similarity between the said goods and services in Class 28 and Class 41 (14/11/2017, R 1104/2017-2, *lottoracing / lotto (fig.) et al.*, § 20-22; 30/10/2008, R 853/2007-1, *EASYCAMP/EASYCAMP et al.*, § 21-23; 29/09/2006, R 1190/2005-2, *JUST PUMP (fig.) / BODY PUMP (fig.)* § 20). It follows that the contested ‘education, entertainment and sports; sports and fitness; providing sports entertainment via a website; sporting and cultural activities; entertainment, sporting and cultural activities; organizing and presenting displays of entertainment relating to style and fashion; organisation of events for cultural, entertainment and sporting purposes; organization of sporting

events and competitions, involving animals' in Class 41 are similar to a low degree to 'gymnastic and sporting articles not included in other classes' in Class 28 and to 'clothing, headgear' in Class 25 to the extent that they include articles of sports attire covered by the earlier mark.

39. In conclusion, contrary to the contested decision's findings, the contested services at issue under appeal are not dissimilar to the goods and services covered by the earlier Italian registration, but similar to a low degree."

39. Applying similar considerations to the present case, I find that there is a low degree of similarity between the contested *Clothing and headgear* in class 25 and the earlier *Education; Sporting and cultural activities; Provision and management of sporting events* in class 41. Whilst the contested *footwear* could be arguably said to be one step removed from the earlier services, the proprietor has accepted some similarity between the respective specifications and has not raised any specific argument (or exception) in relation to *footwear*. Consequently, I extend the same finding to the contested footwear.

Class 28

40. The contested *Toys, including wooden toys, building blocks (toys), paper toys, plastic toys, toys for education; playing cards; jigsaw puzzles; games of education; magnetic number board games* fall within (and are identical to) the applicant's *Games and playthings (Meric)*. Although the applicant's specification does not cover *parts and fittings*, the contested *the parts and fittings for all the aforesaid in class 28* are highly complementary to goods which I have found to be identical to the applicant's goods. On that basis, the contested *the parts and fittings for all the aforesaid in class 28* are also highly similar to the applicant's goods.

Class 35

41. The following services in the contested specification are identical to the terms listed in the applicant's specification: *Advertising; Help in the working or management of a commercial undertaking or the business affairs or commercial functions of a*

commercial enterprise; Advertising by mail order; Updating of advertising material; All of the foregoing services relating to teaching businesses and establishments, in particular language teaching; Organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes.

42. Applying the principle set out in *Meric*, the applicant's *Help in the working or management of a commercial undertaking or the business affairs or commercial functions of a commercial enterprise [...] relating to teaching businesses and establishments* is sufficiently broad to encompass, and therefore be identical to, the contested *Business management and organisation consulting, business management assistance, business information services, professional business consultancy, marketing research, providing management guidance to franchised learning service centres, providing management guidance to franchisees, providing operational guidance to franchisees, advertising, business management assistance, business advisory and consultancy services associated with educational services (Meric)*. If I am wrong about this, the services are highly similar because they have similar uses, users and purpose, are likely to be provided by the same companies through the same trade channels and are complementary and in competition.

Class 41

43. The following services in the contested specification are identical to the terms listed in the applicant's specification: *Education; Providing of training; Entertainment; Sporting and cultural activities; Education and training relating to nature conservation and the environment; Educational and training services relating to games; Arranging and conducting of games; Organising of educational games; Musical education services; Musical education services; Arranging and conducting of concerts; Arranging and conducting of concerts; Education in the field of computing; Provision and management of sporting events; Sports tuition, coaching and instruction; Conducting of educational courses in science; Education in the field of computing; Training for parents in parenting skills; Educational services provided by a school.*

44. The contested *Services rendered by teaching establishments, in particular language and mathematics teaching; Customized teaching services, namely,*

language and mathematics teaching, including services rendered in establishments, at home or via communications networks are encompassed by (and identical to) the applicant's *Services rendered by teaching establishments, in particular language teaching; Customized teaching services, namely, language teaching, including services rendered in establishments, at home or via communications networks*, because the term "*in particular language teaching*" does not act as a restriction to this field and indicates an example, with the result that there is identity between the contested services and the applicant's services (*Meric*).

45. Applying the principle set out in *Meric*, the applicant's *Education, Services rendered by teaching establishments* and *Educational services provided by a school* are sufficiently broad to encompass, and therefore be identical to, the contested *education examination services; tuition, education, teaching and instruction, including education teaching and instruction by correspondence courses; providing educational information and data; consultancy and guidance on education; rental and leasing of education books and texts; rental and leasing of educational sound recordings and visual recordings; education information services; provision of correspondence courses; operation of academies; arranging and conducting seminars, symposiums, workshops and conferences; mathematics, language including English, and infant education; education by correspondence; providing methods of instruction for use with learning materials; provision of learning materials for after school education classes; advisory and consultancy services associated with the above-mentioned services*.

46. This leaves *Publication of educational texts; publication of books; publication of electronic books and journals online; providing online electronic publications (not downloadable)* and *translation services*. As regards the contested *Publication of educational texts; publication of books; publication of electronic books and journals online; providing online electronic publications (not downloadable)*, they consist of preparing and issuing a book, a journal or an electronic publication for public sale. The services are therefore similar to at least a low degree to the applicant's *printed matter, books and publications* in class 16 as both concern the publication of texts and can be provided by the same businesses. They may also be complementary to each other.

47. Lastly, the contested *translation services* are similar to a low degree to the applicant's *Education* (which would cover language classes) and *Services rendered by teaching establishments, in particular language teaching*. This is because the services can have the same commercial origin and stem from the language industry. Further, many companies which provide language classes/language training also offer simultaneously translation and interpreting services. The reason for this is that these services are complementary. The services can, therefore, be provided by the same companies, target the same customers and can also have the same distribution channels².

The average consumer

48. 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 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.”

49. The average consumer of the contested goods and services could be a member of the general public or a business user. The breadth of the goods and services is large with a correspondingly large potential for there to be a range of cost, frequency of selection etc. In general terms the goods are not particularly expensive and will be

² See case R 1655/2017-2, Decision of the Board of Appeal of 10 July 2018

selected with a medium level of care and consideration. Slightly more care might be paid to the selection of business services and education and training providers but whilst this might be a little higher than the norm, it is unlikely to be of the very highest level of consideration.

50. The goods and services are likely to be seen on brochures, advertising material on the web etc, all of which suggests that the visual impact of the marks will play an important role in the selection process and will likely take on most significance. However, I do not discount the potential for the verbal use of the marks through recommendations, booking over the phone etc. Aural similarity must not, therefore, be excluded from the assessment.

Comparison of marks

51. 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.”

52. 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 respective trade marks are shown below:

Contested mark	Earlier mark
	

53. The contested mark is made up of two main elements: the words ‘Little Genius’ and the image of a graduate cap. The words ‘Little Genius’ are presented in title case, in a multitude of colours (namely the colours red, blue, green, black and orange) with the baseline on which some of the letter sits being randomly shifted up and/or down. The graduate cap is in black, is not particularly stylised and it is placed above the words ‘Little Genius’. In my view, whilst the graduate cap is not negligible and contributes to the visual impression of the mark, it is less distinctive than the words ‘Little Genius’, which has the greatest relative weight in the overall impression, because (1) due to their size and colour, the words are more prominent and eye-catching; (2) the graduate cap is not particularly striking and is designed to reinforce the meaning of the words. In this connection, the public is likely to perceive a symbolic association between the concept of a ‘genius’ (which refers to a person who is a highly talented, creative, or intelligent), and the graduate cap, which conveys the concept of academic success. The result is that the principle that where a mark is composed of words and figurative elements, the former are more distinctive than the latter (because the average consumer will more easily refer to the goods and services in question by quoting their name than by describing the figurative elements of the mark³), is fully applicable in this case.

54. The applicant’s mark is also made up of a number of elements. The verbal elements of the mark, namely the words ‘LittleGenius’, ‘International’ and ‘Awakening the Genius Within’, are split on three lines. The words ‘LittleGenius’ are written in title case, are conjoined and presented in red. Due to their size, positioning and colour, the

³ Case T- 312/03, paragraph 37

words 'Little Genius' are more prominent and eye-catching than the other words contained within the mark. The words 'International' and 'Awakening the Genius Within' are in blue and grey respectively and are presented in a smaller size compared to the words which are placed above them. The mark also includes a figurative element made up of the silhouette of two children (one in red and one in blue) incorporated within two square frames with their arms stretched to reach two stars.

55. Whilst the stylised arrangements of the applicant's mark are more fanciful than that of the contested mark, the words 'LittleGenius' are still more distinctive than the figurative elements. This is because the image of the two children reaching for the stars will be understood as evoking the idea that the children will achieve very high goals (or have very high ambitions), reinforcing the meaning of the words 'LittleGenius'. The words 'International' and expression 'Awakening the Genius Within' are visually subordinate to the other elements of the mark and are weak in distinctiveness because the first is descriptive and tells consumers that the goods and services are provided internationally and the latter is laudatory. Consequently, they and will have less weight in the perception and recollection of the mark by the average consumers.

Visual, aural and conceptual similarity

56. The proprietor claims that the marks at issue are visually different and that they share the *"pedestrian LITTLE GENIUS phrase"*, which it says, *"is even less distinctive in the context of the goods and services covered by the respective marks which relate to education"*. The applicant claims that the marks are visually similar because they share the distinctive and dominant words 'Little Genius'.

57. As a preliminary point, even if some of the goods and services covered by the parties' specification relate to education, the words 'Little Genius' are not descriptive of the goods and services or even of the field of activity within which the goods and services are provided. The words 'Little Genius' it likely to be understood as a reference to a very bright child. The most that can be said is that, when used in the context of educational services which target small children, the key marketing message the mark conveys is "our pupils are really clever" which implies that the

quality of the education provided is of a high standard. However, even then, the term 'Genius' is not directly descriptive of a characteristic of the goods or services or even of the end users.

58. Visually, the marks at issue differ in the words 'International' and 'Awakening the Genius Within', in their figurative elements and in their colour. However, they are nevertheless visually similar owing to the presence of words 'Little Genius'/'LittleGenius'. These words form units which retain independent distinctive roles in each mark. Further, the distinguishing elements of the marks are of an intrinsically less distinctive nature in comparison to the common words 'Little Genius'/'LittleGenius'. Taking into account the similarities and the differences, I find that the marks are similar to a low to medium degree.

59. Aurally, the level of similarity is greater, because the figurative elements of the marks will not be articulated. The words 'Little Genius'/'LittleGenius' will be pronounced identically in both marks. As regards the earlier mark, it is highly unlikely that the words 'International' and 'Awakening the Genius Within' will be pronounced, because their font is significantly smaller, they are weak in distinctiveness and are set apart beneath the words 'LittleGenius'. In my view the marks are aurally identical.

60. The words 'Little Genius'/'LittleGenius' will convey the same conceptual message in both marks. Whilst the other elements of the marks will convey other concepts, for the reasons I have stated above, they will have very little influence on the overall conceptual perception of the marks. The marks are conceptually highly similar.

Distinctive character of earlier mark

61. 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).”

62. I have already rejected the proprietor’s submission that the term ‘Little Genius’ is descriptive. Even considering that the words ‘Little’ might suggest, when used in relation to some of the goods and services (e.g. audio-visual material in class 9, items of school stationery in class 16, toys, games and playthings in class 28 and educational, sport and entertainment services in class 41) that they are aimed at a younger audience, the term ‘Little Genius’ as a whole is distinctive to, at worse, a slightly lower than medium degree, not lower than that.

63. Although the applicant has provided evidence of use of Italy, it has not provided any information about turnover, marketing expenses, extent and length of use or market share. Consequently, the mark cannot benefit from enhanced distinctiveness. The stylisation of the mark adds some distinctiveness to it and in my view, overall, the applicant’s mark is inherently distinctive to a medium degree.

Likelihood of confusion

64. 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 goods and services and vice versa. I must also keep in mind the average consumer for the goods and 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.

65. Confusion can be direct or indirect. Direct and indirect confusion were described in the following terms by 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.”

66. Before turning to the issue of the likelihood of confusion, there are some preliminary points which need to be dealt with.

67. First, in its counterstatement, the proprietor says that the “*gulf between the marks is accentuated when [the applicant’s marks] are correctly viewed as family of marks*”. The applicant does not rely on a ‘family of marks’ and the fact that there is a family resemblance between the two marks relied upon by the applicant is not pertinent. Furthermore, I have found that the evidence filed by the applicant is not sufficient to establish genuine use of the earlier EU008905325, which means that my assessment of the opposition under Section 5(2)(b) will be limited to the EU015319817 mark.

68. Second, the proprietor refers to having registered its company in June 2014 and says that it has used the contested mark prior to the proprietor. Use of the mark by the proprietor is irrelevant to the assessment of the likelihood of confusion under Section 5(2)(b). Tribunal Practice Notice 4/2009 explains this as follows:

“The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark.

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.”

69. The proprietor has not sought to invalidate the applicant’s mark based on a claim to an earlier unregistered right. Section 72 of the Act provides that registration shall be taken as *prima facie* evidence of the validity of a registered trade mark. The applicant’s mark must be regarded as validly registered and, in these circumstances, the law requires priority to be determined according to the filing dates of the conflicting marks. Consequently, the applicant’s marks have priority.

70. Thirdly, the proprietor says that if the applicant establishes genuine use, the proprietor wishes to rely on honest concurrent use. There is no evidence that proprietor’s mark has been used, so the issue of honest concurrent use does not even arise in this case.

71. Fourth, the proprietor criticises the applicant for not having opposed the contested mark during the two-month period after its publication. However, this would not prevent the applicant from bringing an invalidity action after the registration of the mark.

72. I move now on to consider the likelihood of confusion.

73. With the exception of the goods in class 25 and some of the services in class 41, which I found to be similar to a low degree, the goods and services are either identical or highly similar. I have identified the average consumer to be a member of the general public or a business user who will select the goods and services primarily by visual means, although I do not discount an aural component. I have concluded that the level of attention paid during the purchasing process will range from medium to slightly higher than medium. I found the marks to be visually similar to a low to medium degree, aurally identical and conceptually similar to a high degree. I found the earlier mark to be distinctive to a medium degree and I remind myself that it is the distinctiveness of the common element that is key⁴.

74. I recognise that for those consumers who encounter the marks visually, the visual differences between the marks might assist in distinguishing them and might avoid direct confusion arising. However, in my view, even if the differences between the marks are recalled by the consumer, they are not sufficient to preclude a finding of a likelihood of confusion. As I have noted above, the words 'Little Genius' have the greatest impact in the overall impression of both marks and the differences between the marks are created by elements which reinforce the message portrayed by these words and/or are weak in distinctiveness. In those circumstances, and bearing in mind the principle of imperfect recollection, my conclusion is that the average consumer, having encountered the earlier mark, is likely to conclude that the contested mark is an alternative mark used by the applicant. This is so even in relation to the goods and services which are similar only to a low degree or for which the words 'Little Genius' have a slightly lower than medium degree of distinctiveness. **There is a likelihood of indirect confusion.**

⁴ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

75. Whilst, I note that in its counterstatement the proprietor said that in the event it was to be unsuccessful, it would submit a fall-back position, nothing further was filed so I do not need to consider the point.

76. The Section 5(2)(b) ground succeeds.

THE SECTION 5(3) GROUND OF INVALIDATION

77. I now turn to the opposition based upon section 5(3) of the Act. Section 5(3) of the Act states as follows:

“5(3) A trade mark which -

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

...

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

78. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This 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 (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

79. The relevant date for the assessment under Section 5(3) is the date when the contested mark was filed – 14 May 2017.

Reputation

80. In *General Motors Corp v Yplon SA*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. 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,

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation in the Member State. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

81. The applicant’s EU008905325 and EU015319817 registrations must have a reputation in a substantial part of the EU. The applicant has not provided me with any turnover or marketing figures. It has said nothing about the duration, intensity and geographical extent of use at all. My conclusion is, therefore, that there is nothing in the evidence to support the claim that the earlier marks had a reputation in the EU (or in the UK) at the relevant date. **The Section 5(3) objection therefore falls at the first hurdle.**

THE SECTION 3(6) GROUND FOR INVALIDATION

82. The law in relation to Section 3(6) of the Act (“bad faith”) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch), as follows:

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, “Bad faith in European trade mark law” [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032

(Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that

product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

83. The arguments advanced by the applicant under this ground are that:

- a) The proprietor was aware of the applicant's marks because it applied for a similar mark and copied part of the applicant's specification;
- b) The proprietor's specification is too broad, and the proprietor had no bona fide intention of using the mark across the full range of goods and services for which registration was sought;
- c) The contested mark is a blocking registration and the proprietor registered the mark in order to prevent the applicant from using its mark in the UK.

84. The onus is on the applicant to prove bad faith.

85. The applicant has filed no evidence to support its claim that when the proprietor applied for the contested mark it was acting in bad faith. Consequently, it seems to me, that the applicant's case rests on the premises that the similarity between the respective marks and the specifications and the length of the specification for which the contested mark is registered, are self-evident proof of bad faith. This cannot be the case, as it would amount to discounting actual intention as irrelevant.

86. Whilst this is sufficient in my view to dismiss the applicant's case based on bad faith, for the sake of completeness, I will make the following points.

87. First, the evidence filed by the applicant does not establish that, at the relevant date, the applicant's marks had acquired a reputation in the Italy (or, indeed, in the UK) or that the proprietor was aware that the applicant was using the marks in Italy. Second, even if the applicant had proven that the contested mark was not coined entirely innocently, (a fact which cannot be considered automatically proven especially given that the marks are not identical, but merely similar enough to give rise to a likelihood of confusion), that fact alone would not amount to bad faith. In this

connection, in BL-O-580/16, Prof. Ruth Annand, sitting as the Appointed Person, stated:

“First, the Opponent accepted that the Hearing Officer was correct in instructing himself by reference to the decisions of the Appointed Person in *DAAWAT Trade Mark* [2003] RPC 11 and *AJIT Trade Mark* [2006] RPC 25 that (due to the territorial nature of trade mark rights) the mere appropriation of a name registered/used abroad was not enough under UK law – there must be something else. That something else in *DAAWAT* included prior dealings between the parties and knowledge on the part of the applicant that the foreign proprietor had plans to enter *inter alia* the UK market under the mark. In *AJIT*, it was the presence of albeit a small number of customers in the UK for the foreign proprietor’s newspaper, and the likelihood borne out by later evidence that the UK Punjabi community (customers for the parties’ newspapers) would be misled into believing that newspapers under the mark in suit originated from the foreign proprietor.”

88. There is nothing to suggest that the applicant had, at relevant date, any plan to enter the UK market and there is no evidence of prior dealing between the parties. Finally, as regards the applicant’s claim that the specification of the contested mark is too broad, it does not amount, per se, to bad faith as confirmed by the recent decision of the CJEU in *Sky v SkyKick* (case C-371/18):

“First Directive 89/104 must be interpreted as not precluding a provision of national law under which an applicant for registration of a trade mark must state that the trade mark is being used in relation to the goods and services in relation to which it is sought to register the trade mark, or that he or she has a bona fide intention that it should be so used, in so far as the infringement of such an obligation does not constitute, in itself, a ground for invalidity of a trade mark already registered.”

89. Accordingly, I find that the applicant has not established a *prima facie* case of bad faith. **The invalidity application based on Section 3(6) also fails.**

OUTCOME

90. The application for a declaration of invalidity of the contested trade mark is successful in its entirety under Section 5(2)(b). The registration UK00003230901 is deemed never to have been made.

COSTS

91. The applicant has been successful and is entitled to a contribution towards the costs of the proceedings, based upon the scale of costs published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £1,000 as a contribution towards its costs. This sum is calculated as follows:

Official fees:	£200
Preparing a statement and considering the other party's statement:	£300
Filing evidence and written submissions:	£500
Total	£ 1,000

92. I order Little Genius Ltd to pay Little Genius International Srl SB the sum of £1,000. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of March 2020

T Perks
For the Registrar,
the Comptroller-General

Annex I

UK3230901



Filing date: 14 May 2017; Date of entry in register: 04 August 2017.

Goods and Services:

Class 9: *DVD players; compact disc players; CD-ROMs bearing sound or visual recordings; prerecorded compact discs; prerecorded cassette tapes; prerecorded mini discs; prerecorded video tapes; computer programs computer software; optical apparatus and instruments for use in education; MP3 players; video disc players; video recorders; video cassettes; electronic books (downloadable); electronic study papers (downloadable). Audio and video recording; Scientific and teaching apparatus and instruments; Teaching apparatus and equipment; Magnetic, optical or magnetic/optical carriers, including compact disks, DVDs, cassettes, diskettes, cartridges containing multi-media and/or audiovisual material, sound, images and texts, all for instructional and teaching purposes, and in particular for instruction and teaching of languages, calculating machines; Apparatus for recordings, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Computer software; Games software; Application software for social networking services via internet; Instruction manuals in electronic format; Application software for cloud computing services.*

Class 16: *Stationery, calculating tables, pencils, erasers, tools for memorising words, pen cases, books, booklets, writing or drawing books, magazines, paper including home study paper, name card paper; instruction and teaching materials (except apparatus); folders for papers; blackboards; hand writing specimens for copying; periodicals, catalogues, pamphlets, posters, manuals, models for study. Adhesives for stationery or household purposes; Artists' materials; Paint brushes; Typewriters and office requisites (except furniture); Stationery and instructional and teaching material (except apparatus), namely cases for stationery, office stationery,*

party stationery, writing stationery, stickers (stationery), plastic envelopes, envelopes (stationery), tracing patterns, wall calendars, desk calendars, calendar desk pads, printed calendars, pocket calendars, folders for papers, portfolios, folders (stationery), desk mats, box files, pen clips, glitter glue for stationery purposes, compasses for drawing, filing containers, desktop business card holders, memo pad holders, writing paper holders, letter holders, stapler holders, file covers, paper clip holders, holders for adhesive tapes, holders for files, art mounts, French curves, elastic bands for offices, decorative pencil-top ornaments, adhesive labels, highlighting markers, paperweights, staples for offices, paper fasteners, school supplies (stationery), crayons, chalk, staples (stationery), paper-clips, angle guides (drawing instruments), lettering stencils, ink, printed flip charts, blank flip charts, whiteboards, adhesive-backed letters and numbers, noteboards, staple removers, coloured pencils, lead for coloured pencils, sticky tape, daily planners, fibre-tip markers, coloured pens, colouring pens, folders (stationery), holders for desk accessories, holders for notepads, letter holders, stamp mounts, document portfolios, thumbtacks (stationery), loose-leaf binders, rulers; Rulers; File cards; Desk sets, Seals for the office, Shields [paper seals], Drawing instruments; Notebooks, Paper knives [office requisites], Desk pads, Pencil sharpeners, Plastic materials for packaging (not included in other classes), Printers' type; Printing blocks; Paper, Cardboard and goods made from this material, not included in other classes, namely, Year planners, Desk diaries, Diaries, Pocket notebooks, Stationery, Office requisites, Paper stationery, Notelets, Correspondence cards, Gift wrap cards, Note pads, Pads [stationery], Note pads, Sketch pads, Writing tablets, Notepads, Notepads, Sketch pads, Writing tablets, Envelopes [stationery], Carbonless copying paper, Copying paper, Writing paper, Headed notepaper, Graph paper, Notepaper, Envelope paper, Label paper, Photocopy paper, Paper for wrapping books, Postcards, Paper party decorations, Paper stationery, Labels of paper, Paper sheets for note taking, Quick reference pocket guides, Pocket books [stationery], Writing or drawing books, Bookmarkers, Adhesive paper, Note pads, Stencil paper [mimeograph paper], Bond paper, Paper for bags and sacks, Postcard paper, Computer paper, Publication paper, Magazine paper, Digital printing paper, Laser printing paper, Recycled paper, Paper sheets [stationery], Folios; Printed

matter; Bookbinding material; Photographs; Stationery; Books, brochures and publications.

Class 25: *Clothing, footwear, headgear.*

Class 28: *Toys, including wooden toys, building blocks (toys), paper toys, plastic toys, toys for education; playing cards; jigsaw puzzles; games of education; magnetic number board games; the parts and fittings for all the aforesaid in class 28.*

Class 35: *Business management and organisation consulting, business management assistance, business information services, professional business consultancy, marketing research, providing management guidance to franchised learning service centres, providing management guidance to franchisees, providing operational guidance to franchisees, advertising, business management assistance, business advisory and consultancy services associated with educational services. Advertising; Help in the working or management of a commercial undertaking or the business affairs or commercial functions of a commercial enterprise; Advertising by mail order; Updating of advertising material; All of the foregoing services relating to teaching businesses and establishments, in particular language teaching; Organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes.*

Class 41: *Publication of educational texts; publication of books; education examination services; translation services; tuition, education, teaching and instruction, including education teaching and instruction by correspondence courses; providing educational information and data; consultancy and guidance on education; rental and leasing of education books and texts; rental and leasing of educational sound recordings and visual recordings; publication of electronic books and journals online; providing online electronic publications (not downloadable); education information services; provision of correspondence courses; operation of academies; arranging and conducting seminars, symposiums, workshops and conferences; mathematics, language including English, and infant education;*

education by correspondence; providing methods of instruction for use with learning materials; provision of learning materials for after school education classes, advisory and consultancy services associated with the above-mentioned services. Education; Providing of training; Entertainment; Sporting and cultural activities; Services rendered by teaching establishments, in particular language and mathematics teaching; Customized teaching services, namely, language and mathematics teaching, including services rendered in establishments, at home or via communications networks; Education and training relating to nature conservation and the environment; Educational and training services relating to games; Arranging and conducting of games; Organising of educational games; Musical education services; Musical education services; Arranging and conducting of concerts; Arranging and conducting of concerts; Education in the field of computing; Provision and management of sporting events; Sports tuition, coaching and instruction; Conducting of educational courses in science; Education in the field of computing; Training for parents in parenting skills; Educational services provided by a school.

Annex II

EU008905325



Colours Claimed: White, Red, Blue and Grey.

Filing date: 23 February 2010; Date of entry in register: 02 September 2010.

Goods and services:

Class 9: *Audio and video recordings; scientific and teaching apparatus and instruments; teaching apparatus and instruments; magnetic, optical or magnetic/optical carriers, including compact disks, DVDs, cassettes, diskettes, cartridges containing multi-media and/or audiovisual material, sound, images and*

texts, all for instructional and teaching purposes, and in particular for instruction and teaching of languages, calculating machines; apparatus for recording, transmission or reproduction of sound or image; magnetic data carriers, recording discs.

Class 16: Adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; books, brochures and publications.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; game cards.

Class 35: Advertising; help in the working or management of a commercial undertaking or the business affairs or commercial functions of a commercial enterprise; advertising by mail order; updating of advertising material; all of the foregoing services relating to teaching businesses and establishments, in particular language teaching.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; services rendered by teaching establishments, in particular language teaching; customized teaching services, namely, language teaching, including services rendered in establishments, at home or via communications networks.

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Colours Claimed: White, Red, Blue and Grey.

Filing date: 08 April 2016; Date of entry in register: 05 September 2016.

Goods and services:

Class 9: Audio and video recording; Scientific and teaching apparatus and instruments; Teaching apparatus and equipment; Magnetic, optical or magnetic/optical carriers, including compact disks, DVDs, cassettes, diskettes, cartridges containing multi-media and/or audiovisual material, sound, images and texts, all for instructional and teaching purposes, and in particular for instruction and teaching of languages, calculating machines; Apparatus for recordings, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Computer software; Games software; Application software for social networking services via internet; Instruction manuals in electronic format; Application software for cloud computing services.

Class 16: Adhesives for stationery or household purposes; Artists' materials; Paint brushes; Typewriters and office requisites (except furniture); Stationery and instructional and teaching material (except apparatus), namely cases for stationery, office stationery, party stationery, writing stationery, stickers (stationery), plastic envelopes, envelopes (stationery), tracing patterns, wall calendars, desk calendars, calendar desk pads, printed calendars, pocket calendars, folders for papers, portfolios, folders (stationery), desk mats, box files, pen clips, glitter glue for stationery purposes, compasses for drawing, filing containers, desktop business card holders, memo pad holders, writing paper holders, letter holders, stapler holders, file covers, paper clip holders, holders for adhesive tapes, holders for files, art mounts, French curves, elastic bands for offices, decorative pencil-top ornaments, adhesive labels, highlighting markers, paperweights, staples for offices, paper fasteners, school supplies (stationery), crayons, chalk, staples (stationery), paper-clips, angle guides (drawing instruments), lettering stencils, ink, printed flip charts, blank flip charts, whiteboards, adhesive-backed letters and numbers, noteboards, staple removers, coloured pencils, lead for coloured pencils, sticky tape, daily planners, fibre-tip markers, coloured pens, colouring pens, folders (stationery), holders for desk accessories, holders for notepads, letter holders, stamp mounts, document portfolios, thumbtacks (stationery), loose-leaf binders, rulers; Rulers; File cards; Desk sets, Seals for the office, Shields [paper seals], Drawing instruments; Notebooks, Paper knives [office requisites], Desk pads, Pencil sharpeners, Plastic materials for packaging (not included in other classes), Printers'

type; Printing blocks; Paper, Cardboard and goods made from this material, not included in other classes, namely, Year planners, Desk diaries, Diaries, Pocket notebooks, Stationery, Office requisites, Paper stationery, Notelets, Correspondence cards, Gift wrap cards, Note pads, Pads [stationery], Note pads, Sketch pads, Writing tablets, Notepads, Notepads, Sketch pads, Writing tablets, Envelopes [stationery], Carbonless copying paper, Copying paper, Writing paper, Headed notepaper, Graph paper, Notepaper, Envelope paper, Label paper, Photocopy paper, Paper for wrapping books, Postcards, Paper party decorations, Paper stationery, Labels of paper, Paper sheets for note taking, Quick reference pocket guides, Pocket books [stationery], Writing or drawing books, Bookmarkers, Adhesive paper, Note pads, Stencil paper [mimeograph paper], Bond paper, Paper for bags and sacks, Postcard paper, Computer paper, Publication paper, Magazine paper, Digital printing paper, Laser printing paper, Recycled paper, Paper sheets [stationery], Folios; Printed matter; Bookbinding material; Photographs; Stationery; Books, brochures and publications.

Class 28: *Games and playthings; Gymnastic and sporting articles not included in other classes; Card games.*

Class 35: *Advertising; Help in the working or management of a commercial undertaking or the business affairs or commercial functions of a commercial enterprise; Advertising by mail order; Updating of advertising material; All of the foregoing services relating to teaching businesses and establishments, in particular language teaching; Organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes.*

Class 41: *Education; Providing of training; Entertainment; Sporting and cultural activities; Services rendered by teaching establishments, in particular language teaching; Customized teaching services, namely, language teaching, including services rendered in establishments, at home or via communications networks; Education and training relating to nature conservation and the environment; Educational and training services relating to games; Arranging and conducting of games; Organising of educational games; Musical education services; Musical*

education services; Arranging and conducting of concerts; Arranging and conducting of concerts; Education in the field of computing; Provision and management of sporting events; Sports tuition, coaching and instruction; Conducting of educational courses in science; Education in the field of computing; Training for parents in parenting skills; Educational services provided by a school.