

O-174-20

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NOS. 3263483 AND 3263482
BY NATURE RESEARCH SOCIETY TO REGISTER THE FOLLOWING TRADE
MARKS**



AND

NATURE RESEARCH SOCIETY

IN CLASSES 41 AND 42

**AND IN THE MATTER OF JOINT OPPOSITIONS THERETO UNDER NOS. 411150
AND 411154 BY HM PUBLISHERS HOLDINGS LIMITED AND MACMILLAN
PUBLISHERS INTERNATIONAL LIMITED**

Background and pleadings

1) I issued my decision BL-160-19 regarding these proceedings on 27 March 2019. The decision was appealed and on 10 February 2020, Amanda Michaels, sitting as the Appointed Person, issued her decision regarding the merits of the appeal.

2) The opponents relied upon a number of earlier registrations that were in respect of one or other of the following two marks:

(i) The word mark NATURE

(ii) The figurative mark natureresearch

3) The grounds of opposition were based upon section 5(2)(b) and section 5(3) of the Trade Marks Act, 1994 (“the Act”).

4) Ms Michaels found that the oppositions based upon the earlier figurative mark “NatureResearch” was partially successful under section 5(2)(b) and section 5(3) and that the 5(2)(b) grounds based upon the earlier “NATURE” mark failed. In respect of the oppositions based upon section 5(3), insofar, as they relied upon the earlier mark “NATURE”, Ms Michaels identified an omission in respect of my comments at [56]. This paragraph is shown below:

“56) The common element present in both marks is the words “Nature Research”. As I have already found, these words designate a characteristic. Therefore, the consumer is likely to see any similarity arising from this common element as coincidence. Therefore, whilst one mark may bring the other to mind and, thus, create the requisite link, it is only a very weak link. I find that the existence of such a weak link is insufficient for there to be any detriment or unfair advantage taken on the part of the applicant. The common occurrence of the words NATURE RESEARCH is likely to be put down to the fact that they indicate the subject matter of the services.”

5) Ms Michaels’ comments are:

“30. The Opponents pointed out that the Hearing Officer’s analysis in [56] referred only to the mark and so he erred in failing to consider the potential objection under s 5(3) based upon the much more famous NATURE mark. It is right that there was no separate analysis of the position. Possibly the Hearing Officer again considered that the Opponents’ best case was based on the mark, but he does not say so. This is, I accept, a gap in the decision.

31. I discussed with Mr Stobbs whether the point should be remitted to the Registry. He invited me to decide the point. However, the Applicant was not present, and may have wished to object to that approach. In those circumstances I think it right to remit the issue to the UKIPO.

Conclusion

...

33. I will remit the opposition based upon s 5(3) but only in so far as it is based upon trade mark 3174031 NATURE.”

5) Therefore, I now consider the opponents’ case under section 5(3) in respect of its reliance upon the earlier NATURE marks.

6) At [54] of my decision I found that by virtue of “the more extensive and longstanding use” the earlier mark NATURE benefits from “a notable reputation” in respect of publishing of scientific journals.

7) When considering if the requisite link exists, at [55] of my decision, I referred to the following extract from the Court of Justice of the European Union judgment in *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P (at paragraph 72):

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the

protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

8) Therefore, the absence of a likelihood of confusion (as found at [49] of my decision) does not necessarily preclude a finding that the requisite link exists for the purposes of section 5(3) of the Act. However, the reason that I found no likelihood of confusion is still relevant to my considerations here. Whilst acknowledging its longstanding use as the title of a scientific journal, I found that there is no likelihood of confusion because of the greater differences¹ between the respective marks. The earlier mark consists of the ordinary and readily understood word NATURE. The applicant’s word mark consists of the words NATURE RESEARCH SOCIETY. The first will be readily understood by the relevant public as a reference to the physical world collectively². The applicant’s mark, on the other hand, will equally be readily understood, as referring to a society involved in research in the field of nature. Therefore, even accounting for the “notable reputation” acquired by the earlier mark, when keeping in mind the differences between the marks and, in particular, the different conceptual identities, even where identical services are involved, the requisite link will not be established. The word “nature” as it appears in the applicant’s mark, will not lead the relevant public to make a connection to the opponent’s mark, but rather it will serve as a word contributing to the message created by the mark as a whole and does not have any independent distinctive character.

¹ Compared to the comparison based upon the opponent’s figurative mark “NatureResearch”

² The full dictionary meaning was provided at [17] of my decision

9) In respect of the applicant's word and device mark, the similarities to the earlier mark NATURE are markedly less than in respect of its word mark and it follows that the requisite link is even less likely to be established.

10) I conclude that the oppositions fail in their entirety against both the applicant's word mark NATURE RESEARCH SOCIETY and its figurative mark, insofar as they are based upon the earlier word marks NATURE.

11) As this finding alludes, I have considered whether the opponents' case based upon its earlier mark NATURE should succeed to the same extent as found by Ms Michaels in respect of its figurative "NatureResearch" mark. However, I find that the differences between the marks are so great that no such partial success is appropriate here.

Costs

12) As neither party has been put to any additional costs resulting from this decision, I make no award of costs.

Dated this 17th day of March 2020

**Mark Bryant
Principal Hearing Officer
For the Registrar**