

BLO/276/20

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO 2627562
IN THE NAME OF RZIM ZACHARIAS TRUST
IN RESPECT OF TRADE MARK:

The Oxford Centre for Christian Apologetics

AND

AN APPLICATION FOR A DECLARATION OF THE
INVALIDITY THEREOF UNDER NO 501820
BY THE CHANCELLOR, MASTERS AND SCHOLARS
OF THE UNIVERSITY OF OXFORD.

BACKGROUND

1. Trade mark No. 2627562 shown on the cover page of this decision stands registered in the name of RZIM Zacharias Trust (the proprietor). It was applied for on 2 July 2012 and completed its registration procedure on 12 October 2012. The relevant goods and services for which it is registered are as follows:

Class 9

Pre-recorded CDs, DVDs, Blu-Ray Discs, magnetic data carriers and other data-carrying media in this class; downloadable software; podcasts; audio and video recordings; downloadable publications; all of the aforesaid containing material, content and/or data with a religious theme or containing material, content and/or data relating to or in the fields of theology, apologetics, evangelism, pastoral care, Christian ministry, counselling, Christian counselling and biblical study, and the teaching and training thereof, news and current affairs.

Class 16

Printed matter; books; newspapers; magazines; journals; pamphlets; booklets; periodicals; instructional and teaching material; all of the aforesaid containing material with a religious theme or relating to or in the fields of theology, apologetics, evangelism, pastoral care, Christian ministry, counselling, Christian counselling and biblical study, and the teaching and training thereof; stationery.

Class 41

Education, training and teaching services in the fields of theology, apologetics, evangelism, pastoral care, Christian ministry, counselling, Christian counselling and biblical study; education, training and teaching services in the fields of theology, apologetics, evangelism, pastoral care, Christian ministry, counselling, Christian counselling and biblical study provided on-line and by way of podcasts, videocasts, webinars and other visual and/or audio means; bible teaching services; organising and conducting seminars, conferences, lectures, courses, symposiums, presentations, on-line presentations, workshops, and events in the fields of theology, apologetics, evangelism, pastoral care, Christian ministry, counselling, Christian counselling and biblical study; educational services in the form of

comment on news and current events from a Christian perspective; providing news in the nature of comment on current events; provision of information regarding news and current events or topical issues; provision of information in the form of educational literature and on-line content in the fields of theology, apologetics, evangelism and biblical study; production of podcasts, videocasts, radio, film and television programmes; freelance journalism; publishing services relating to material in the fields of theology, apologetics, evangelism, pastoral care, Christian ministry, counselling, Christian counselling and biblical study; information, advisory and consultancy services relating to the aforesaid.

Class 45

Ministerial and pastoral services; counselling services; Christian counselling services; information, advisory and consultancy services relating to the aforesaid.

2. On 12 October 2017, The Chancellor, Masters and Scholars of the University of Oxford (the applicant) filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) and (b) and 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

Section 47(2) states:

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

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

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

3. Under s. 5(2)(b) the applicant says that the mark THE OXFORD CENTRE FOR CHRISTIAN APOLOGETICS is both so similar to the University's registered trade

marks and registered in relation to goods and services which are either identical or so similar thereto that there exists a likelihood of confusion on the part of the public.

4. Under s.5(3) the applicant says that its marks have a reputation and that the use of the impugned mark on the goods and services for which it is registered would take unfair advantage of and/ or cause harm to the repute of the University's registrations.

5. Under s.5(4)(a) the applicant relies upon its prior right to sue for passing off in relation to the use of the impugned mark as being contrary to section 5(4)(a) of the Act.

6. For the purposes of its claims under 5(2)(b) and 5(3) of the Act, the applicant relies upon the following earlier registrations and goods and services:

Mark details:	Goods and services:
<p>UK TM: 1576322</p> <p>OXFORD</p> <p>Filing date: 31 October 1994</p> <p>Date of entry in the register: 30 July 1999</p>	<p>Class 9 Audio and video cassettes, floppy discs bearing computer software, CD ROMS, published material in digital format.</p> <p>Class 16 Books, journals, catalogues, leaflets, posters, bookmarks, bar mats, pens, adhesive tape, gift wrapping paper.</p> <p>Class 41 Publishing services included in Class 41.</p>
<p>UK TM: 2055566</p> <p>UNIVERSITY OF OXFORD</p>	<p>Class 41 University services; academic services; conferral of degrees; arranging and conducting seminars, symposiums, conferences and congresses; conducting correspondence courses; teaching,</p>

<p>Filing date: 7 February 1996</p> <p>Date of entry in the register: 17 October 1997</p>	<p>lecturing and tutorial services; educational and training services; providing information concerning education; educational examinations; organisation of exhibitions for educational purposes; lending libraries and library services; provision of sporting, cultural and entertainment activities; museum services; rental of educational apparatus and instruments; information and advisory services, all relating to the aforesaid; all provided by a university.</p> <p>Class 42 Rental of temporary accommodation; cafe, canteen and restaurant services; leasing of access time to computer databases; professional consultancy services; technical project studies; research and development for others; all provided by a university.</p>
<p>UK TM: 2224116</p> <p>OXFORD UNIVERSITY</p> <p>Filing date: 1 March 2000</p> <p>Date of entry in the register: 1 September 2000</p>	<p>Class 41 Academic services provided by universities, university services; conferral of degrees; arranging and conducting seminars, symposiums, conferences and congresses; conducting correspondence courses; teaching, lecturing and tutorial services; educational and training services; providing information concerning education; educational examinations; organisation of exhibitions for educational purposes; lending libraries and library services; provision of sporting, cultural and entertainment activities; museum services; rental of educational apparatus and instruments; information and advisory services all relating to the aforesaid; all provided by a university.</p>

	<p>Class 42 Rental of temporary accommodation, cafe, canteen and restaurant services; provision of access time to computer databases; professional consultancy services; technical project studies; research and development for others; all provided by a university.</p>
<p>EU TM: 3424851</p> <p>OXFORD</p> <p>Filing date: 29 October 2003</p> <p>Date of entry in the register: 6 October 2006</p>	<p>Class 9 Audio and video cassettes; floppy discs bearing computer software; CD ROMs; DVDs; DVD-ROMs; CDs; published material in digital format; optical, electronic and magnetic data storage devices bearing recorded information; digital media; media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing music, sounds, images, text, and information; sounds, images, text and information provided by telecommunications networks, by online delivery and by way of the Internet and the world wide web; computer software for teaching, instructional and educational purposes; electronic publications; electronic databases; apparatus and instruments; all for recording and reproducing sound or video; blank and pre-recorded sound and video recording materials; information stored in electronic, digital and magnetic form; publications in electronic form, supplied on-line from databases or from facilities provided on the Internet.</p> <p>Class 41</p>

Publishing services; publishing of electronic publications; electronic publishing services; provision of information relating to teaching, instruction, research and education; provision of online-electronic publications; teaching, instructional and educational services relating to the English language; publishing services provided by means of the Internet and world-wide web; providing information regarding the English language, teaching, research, instruction and education by means of the Internet; providing information regarding the English language, teaching, research, instruction and education by means of a computer database; academic services provided by universities; university services; conferral of degrees; arranging and conducting seminars, symposiums, conferences and congresses; conducting correspondence courses; teaching, lecturing and tutorial services; educational and training services; providing information concerning education; educational examinations; organisation of exhibitions for educational purposes; lending libraries and library services; provision of sporting, cultural and entertainment activities; museum services; rental of educational apparatus and instruments; information and advisory services all relating to the aforesaid; all provided by a university.

Class 42

Computer-based information services; research and development for others; provision of information relating to research and development for others; technical research services; provision of information relating to

	<p>technical research; provision of information relating to scientific and technological services; provision of information relating to information technology; research services; engineering services; scientific testing; professional consultancy services relating to research, law and social services, science and engineering.</p>
<p>EU TM: 11230281</p> <p>OXFORD UNIVERSITY PRESS</p> <p>Filing date: 1 October 2012</p> <p>Date of entry in the register: 10 November 2013</p> <p>Seniority from the following UK TMs:</p> <p>1172688 – 11 June 1982 1372918 – 10 February 1989 2006875 – 6 January 1995</p>	<p>Class 9</p> <p>Audio and video cassettes; floppy discs bearing computer software; CD RAMS; CD ROM'S DVDs; DVD-ROMs; CDs; published material in digital format; optical, electronic and magnetic data storage devices bearing recorded information; digital and analogue media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing downloadable music, downloadable sounds, downloadable images, downloadable text; downloadable sounds, downloadable images, downloadable text and information provided by telecommunications networks, by online delivery and by way of the Internet and the world wide web; computer programs; computer software for teaching, instructional and educational purposes; downloadable electronic publications; electronic databases; apparatus and instruments; all for recording and reproducing sound or video; blank and pre-recorded sound and video recording materials; information stored in electronic, digital and magnetic form; downloadable publications in electronic form, supplied on-line from databases for from facilities provided on the Internet; downloadable software</p>

and applications; software applications delivered online through a web-browser or as a downloadable application or application delivered to any computing device including desktop, laptop and tablet computers as well as mobile devices; parts and fittings for the aforesaid goods.

Class 16

Paper, paper article, cardboard and cardboard articles, books, printed matter; instructional and teaching materials; journals; periodicals; newspapers; printed sheet music; bibles; magazines, maps, posters and charts, photographs.

Class 41

Publishing services; publishing of electronic publications; electronic publishing services; provision of information relating to teaching, instruction, research and education; provision of online-electronic publications; teaching, instructional and educational services relating to the English language; publishing services provided by means of the Internet and world-wide web; providing information regarding the English language, teaching, research, instruction and education by means of the Internet; providing information regarding the English language, teaching, research, instruction and education by means of a computer database; academic services provided by universities; university services; conferral of degrees; arranging and conducting seminars, symposiums, conferences and congresses; conducting correspondence courses; teaching,

	lecturing and tutorial services; educational and training services; providing information concerning education; educational examinations; organisation of exhibitions for educational purposes; lending libraries and library services; provision of sporting, cultural and entertainment activities; museum services; rental of educational apparatus and instruments; information and advisory services all relating to the aforesaid; all provided by a university.
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7. For the purposes of its claim under s.5(4)(a) of the Act the applicant relies on:

(i) OXFORD UNIVERSITY PRESS, used throughout the UK since 1 January 1960 for education services, publishing services and publications.

(ii) OXFORD UNIVERSITY, used throughout the UK since 1586 for education services, publishing services and publications.

(iii) OXFORD, used throughout the UK since 1586 for education services, publishing services and publications.

(iv) UNIVERSITY OF OXFORD, used throughout the UK since 1586 for education services, publishing services and publications.

8. On 15 January 2018, the proprietor filed a counterstatement denying the claims made. The proprietor asserts that the name OXFORD in the title of The Oxford Centre for Christian Apologetics is no more than an indication of its geographical location.

9. Both parties filed evidence, written submissions and a skeleton argument. A hearing took place before me at which the proprietor was represented by Mr Simon Malynicz QC, instructed by J A Kemp LLP. The applicant was represented by Mr Michael Silverleaf QC, instructed by Wiggin LLP.

10. Mr Geoffrey Lees (a senior solicitor of the applicant) and Ms Joanna Marks (Group Legal Director of Oxford University Press) attended the hearing for cross examination on certain aspects of their evidence.

Preliminary issue

11. At the start of the hearing the parties notified me that they had been in correspondence the previous day and sought direction on the issue of cross examination. Mr Silverleaf, for the applicant, also applied to file additional evidence in the form of copies of agreements between the applicant and some of its Registered Independent Centres (RICs).

12. By way of background, prior to the hearing, the proprietor had requested cross examination of Mr Lees and Ms Marks. The purpose was to examine the statements by those witnesses concerning control of the applicant's trade marks in its agreements with third parties, particularly RICs. The request was allowed. The day before the hearing the request to cross examine was withdrawn. However, in Mr Malynicz's skeleton argument he maintained a challenge to the evidence provided by Mr Lees.

13. Mr Silverleaf submitted at the hearing:

“The first occasion on which anything was said to suggest that Mr Lees’ evidence was not accepted at face value as establishing the existence of that term was on Tuesday afternoon when skeletons were exchanged.”¹

14. Mr Silverleaf submitted to me at the hearing that in response to Mr Malynicz's skeleton argument he (on behalf of the applicant) provided the proprietor with copies of agreements between the University and its RICs on which Mr Lees would rely during cross examination. The request to cross examine was then withdrawn by the proprietor, but the challenge to Mr Lees' evidence in the skeleton argument was maintained.

¹ The term referred to by Mr Silverleaf QC is Mr Lees' submission that Oxford University retained goodwill in the proprietor's trade mark.

15. TPN 5/2007 is clear that if evidence is to be challenged, the issue must be raised in such a way that the witness may answer the criticism. This can be done within the evidence rounds, allowing the challenged party to respond or, alternatively, the challenging party can file factual evidence of its own or request that the witness be cross examined.²

16. Mr Malynicz made clear that the challenge to the applicant's evidence was being maintained despite the request to cross examine that witness being withdrawn.

17. In making a direction I bore in mind:

- that the witnesses were present at the hearing and were prepared to be cross examined on the exact point which Mr Malynicz still sought to contest, namely the control of the 'Oxford' marks by third parties under their agreements with the University.
- Tribunal practice notice 5/2007.
- Mr Malynicz's position that he maintained his objection to Mr Lees' evidence.

18. Having heard both parties' submissions on this issue, I directed that cross examination should go ahead and Mr Malynicz reinstated his request. I admitted into evidence the copies of the agreements provided by Mr Silverleaf, on which Mr Lees would rely under cross-examination. Thirty minutes had been agreed following the initial request for cross-examination and this was the period allowed. I shall refer to the content of the examination as necessary in the remainder of this decision.

Cancellation applicant's evidence

Witness statement of Geoffrey Lees and Exhibits GL1-GL24

19. Mr Geoffrey Lees is a Senior Solicitor who has worked for the cancellation applicant since 6 January 2014. His statement is dated 16 April 2018.

² I note the exception that evidence which is obviously incredible can be challenged without prior notice or cross-examination, but that is clearly not the case here.

Witness statement of Joanne Marks and exhibits JM1-JM40

20. Ms Joanne Marks is the Group Legal Director of Oxford University Press (OUP), a position she has held since 1999. Her statement is dated 16 April 2018.

Two witness statements of Justyn Terry

21. Mr Justyn Terry is the Vice-Principal and Academic Dean at Wycliffe Hall and provides two witness statements dated 16 May 2018 and 28 September 2018.

Witness statement of Robert Norman Furneaux and exhibits RNF1 and RNF2

22. Mr Furneaux is a solicitor, trade mark attorney and director of the applicant's representative. His statement is dated 28 September 2018.

Copies of agreements between the applicant and some of its RICs – admitted at the hearing

23. Mr Lees provides evidence about the history and standing of the University of Oxford. I do not consider it necessary to summarise all of this. I would have accepted on judicial notice that the University of Oxford is an extremely well-known university in the UK and, also, worldwide. It is one of the foremost universities in the world.

24. The University of Oxford was second in the 'World University Rankings 2013-2014' and was third for 'Theology and Religious Studies'.³ The 2014 Research Excellence Framework (REF) found that the applicant has the country's largest volume of world-leading research.⁴ For the financial year 2016/17 the university had an income of £1400 million.⁵

25. Ms Marks begins by providing evidence relating to the history and standing of OUP. As above, I am prepared to accept on judicial notice that OUP is a well-known publisher and do not intend to provide a detailed summary of all of the evidence on that point.

³ See exhibit GL8.

⁴ See exhibit GL10.

⁵ See paragraph 11 of Geoffrey Lees' statement.

26. OUP is one of the departments of the University with a publishing history of more than 500 years. Ms Marks says of its objective:

“The Press furthers the University’s objective of excellence in research, scholarship, and education by publishing worldwide. As an educational publisher, the Press’s main criteria when evaluating a new title for publication are its quality and whether it supports those aims of furthering education and disseminating knowledge.”

27. It produces and makes available educational resources for all age groups and supports teachers at all levels. In addition, it publishes more than 5,500 new scholarly, reference and higher education products and services annually worldwide. These include text books, journals, dictionaries and reference materials in both print and digital form.

28. UK turnover for 2012, 2013 and 2014 was £389 million, £343 million and £377 million, respectively.

29. Having accepted these first points, it is necessary for me to highlight other areas of evidence which are pertinent to this particular case, namely, the structure of the applicant’s university, use of OXFORD by the same and provision of theology at the applicant’s university.

i) The structure of the University of Oxford.

30. Mr Lees explains that the opponent is structured as a:

“...collegiate university, consisting of both the central university and the colleges and permanent private halls. The central University is composed of academic departments and research centres, administrative departments, libraries and museums...”

The permanent private halls (PPHs) of which there are six, have the same functions as the colleges and like the colleges, are financially independent

and self-governing. The PPHs were founded by various Christian denominations and still retain their religious character.”

ii) The University of Oxford’s use of OXFORD.

31. Mr Lees states that the opponent’s name is often abbreviated and referred to as Oxford. He provides examples of use by the media, for example:⁶

“Oxford college appoints Benedict Cumberbatch and Emma Watson.”
The Guardian, 5 February 2016

“Alan Rusbridger: lifting the lid on Oxford admissions.”
Times Higher Education, 21 December 2015

“Daily video gaming can be good for children, says Oxford study.”
Cityam.com, 4 August 2014

“Oxford teaches you to be ‘the best’ – it doesn’t prepare you for real life.”
The Daily Telegraph, date unclear

“DNA study shows yeti is real (sort of) – and Oxford scientist prepares expedition to find it.”
www.independent.co.uk, 2 July 2014

32. Mr Lees provides examples of alumni described in the media as ‘Oxford educated’. These include, inter alia, Crown Prince Naruhito, heir to the Chrysanthemum throne of Japan (Daily Telegraph, 1 December 2017); Neil Gorsuch, a federal judge in Colorado (www.legalcheek.com, 1 February 2017) and Euclid Tsakalotos, an economist tipped to be Greece’s new finance minister by uk.businessinsider.com in July 2015.⁷

⁶ See exhibit GL15.

⁷ See exhibit GL16.

33. Mr Lees also provides examples of the applicant using the name Oxford, rather than Oxford University, as part of the name of its departments, centres and institutes.⁸

These include:

Oxford Centre for Global History

Oxford Centre for Research in US History

Oxford Centre for Industrial and Applied Mathematics

Oxford Centre for Population Research

Oxford Centre for the Analytics of Resource Rich Economies

34. Mr Lees also provides evidence of courses provided as 'Oxford' courses. An example is given of courses offered by the SAID Business School of Oxford University. They were offered in 2012 and 2013 and are titled: 'Leadership Programmes with the Oxford Advantage'. They are, 'Oxford Strategic Leadership Programme', 'Oxford Diploma in Organisational Leadership' and 'Oxford High Performance Leadership Programme'.⁹

35. Ms Marks states that since the 19th Century, OUP has consistently used the name OXFORD as a trade mark to denote its products and services. She submits that there are two forms in which OXFORD is used for the products and services. The first is as follows:



OXFORD

36. Ms Marks says that this version appears on the spine of all OUP publications and the front of some publications. The second version she refers to is as follows:



OXFORD
UNIVERSITY PRESS

⁸ Mr Lees statement, paragraph 24.

⁹ See exhibit GL12.

37. Ms Marks submits that this appears in some form on everything that OUP produces. Examples of such use are provided in evidence.¹⁰

38. OUP is overseen by a committee of senior members of the University, known as the 'Delegacy of the Press'. They ensure the quality and educational relevance of everything published under the 'OXFORD' imprint. Approval of the delegates is required to use the OXFORD name in the title of a book, book series or new service. Ms Marks provides an extract of the Oxford University Press Corporate Identity Guidelines for Third Parties,¹¹ which shows that OUP may grant permission to use its logos but that use must be in accordance with the guidelines. Parties are advised which of the logos they are able to use and OUP retains the right of approval for the application of any of its logos, prior to materials being produced.¹²

39. Ms Marks provides evidence of OXFORD, used by OUP for all of the printed goods it offers,¹³ including dictionaries¹⁴ and in respect of digital publications.¹⁵

40. Ms Marks also provides evidence of publications of OXFORD World Classics, OXFORD Bookworms (graded for all reading levels), OXFORD law textbooks, and OXFORD Journals. In addition, she provides prints from Oxford School Improvement which includes OXFORD Assessment, OXFORD Primary and OXFORD Reading Tree.¹⁶

41. In addition to print titles, Ms Marks states that OUP has also provided tapes, CDs, DVDs and over the last 20 years electronic and digital formats such as software applications and online subscriptions.¹⁷

42. Ms Marks further submits that OUP provides educational services in addition to its products. These include examination services, online interactive functionality, online

¹⁰ See exhibit JM4.

¹¹ See exhibit JM6.

¹² See Ms Marks witness statement, paragraph 5.

¹³ See exhibits JM7-JM19.

¹⁴ See exhibits JM27-JM30.

¹⁵ See exhibits JM20-JM26.

¹⁶ See exhibit JM5.

¹⁷ See 4.4 of Ms Marks statement.

professional development and teacher training services and portals which house collections of resources for teachers, students and parents.¹⁸

43. Some examples are as follows:

Oxford Primary English Assessment (complement to Oxford Reading Tree products) enables recording, reporting and tracking of progress.

Oxford Owl – launched 2011 – (won BETT award in 2012). Has more than 2 million users including 200,000 teachers. Helps with reading and mathematics and is a portal for OUP primary level resources for parents and teachers. Includes advice for teachers and professional development tools.¹⁹

Oxford Teachers Club – provides teachers with practice activities and ideas for classes along with related resources.²⁰

Oxford International AQA Examinations – 2014-2015 launched joint venture with AQA²¹ to deliver a new suite of GCSE and A level qualifications.²²

Oxford English Testing – launched in 2010. Provides assessment, marking, mock tests and practice material.²³

Oxford Discover – won a British Council ELTons Award in 2015 for excellence in course innovation. Designed to improve thinking and communication skills for English Language students.

Oxford Practice Grammar – a free online testing service.

¹⁸ See 4.5 of Ms Marks statement.

¹⁹ See exhibit JM10.

²⁰ See exhibit JM13.

²¹ An awarding body in England, Wales and Northern Ireland.

²² See exhibit JM12.

²³ See exhibit JM14.

Learn Online with Oxford – Resource for students and teachers, which offers online practice, homework, automatic marking and instant feedback.²⁴

Oxford Teachers Academy – launched in 2015, offers online self-study courses for teachers which are certified by the University of Oxford Department for Continuing Education.²⁵

Ms Marks submits that online academic products are sold through Oxford Handbooks Online and Oxford Reference Online.

Oxford Scholarship Online – launched in 2004, is a curated research tool to enable researchers to find authoritative texts more easily.

Oxford Scholarly Editions Online – launched in 2012, gives scholars access to full-text annotated versions of trusted research sources to establish authoritative texts for citation. Currently includes writers active between 1485 and 1901 as well as classical Latin authors.

44. English Language teaching resources are available as downloads or software applications and include Oxford Teachers' Club, English File, Oxford Living Grammar and Oxford Bookworms.²⁶

45. Ms Marks provides details of religious texts including bibles, sold by OUP. She further submits that OUP operates a number of websites focusing on religion, including www.oxfordbiblicalstudies.com and www.oxfordislamicstudies.com. It also publishes the Journal of Hindu Studies in association with the Oxford Centre for Hindu Studies and the Journal of Islamic Studies with the Oxford Centre for Islamic Studies. Prints from these web pages show the OXFORD mark at the top of the page with the much smaller word ACADEMIC below it.²⁷

²⁴ See exhibit JM16.

²⁵ See exhibit JM18 and JM19 for further resources for teachers.

²⁶ See exhibit JM26.

²⁷ See exhibit JM33.

iii) Theology and religious education at the University of Oxford.

46. Mr Lees' evidence is two-fold in this regard. He begins by outlining that one of the applicant's departments is the Faculty of Theology and Religion. According to the Complete University Guide the applicant was ranked first in the UK and Europe and second in the world for Theology and Religious Studies in 2017.²⁸ I note that the proprietor does not contest this evidence.

47. The remainder of Mr Lees' evidence on this point relates to the proprietor and its students and their references to the applicant.

48. For the purposes of this decision it is sufficient to note that Christian Apologetics is a branch of theology which was first practised in the early years of the Christian church. It seeks to present historical and evidential bases for Christianity.²⁹

49. Prints from the proprietor's website have been obtained using waybackmachine.³⁰ A page from 2012 has the following at the top of the page:



50. The page heading is 'TWO YEAR COURSE (MASTERS)'. The introduction reads as follows:

"The two year full time Master's programme in Theology is an exciting opportunity to be immersed in the study of theology and apologetics in the stimulating environment of Oxford. Students are awarded a University of Oxford Master's degree upon successful completion of the course."

²⁸ See exhibit GL18.

²⁹ See Graham Lees, paragraph 27 and exhibit GL19.

³⁰ See exhibit GL22.g

51. The right-hand side of the page is titled 'OXFORD UNIVERSITY' and includes information about and photographs of Oxford University.

52. Mr Lees provides extracts from social media accounts which show comments about courses run by the proprietor.³¹ An article from The Ivy League Christian Observer, dated 24 June 2014, is titled, 'Princeton Alumnus Guides Apologetics Program at Oxford'. It reads:

"...[Mr V], Princeton '04, is serving as a key scholar at The Oxford Centre for Christian Apologetics, a partnership between Ravi Zacharias International Ministries and Wycliffe Hall, an independent theology program within the University of Oxford".

53. A tweet from Zacharias Trust dated 25 October 2012 reads:

"#applynow for @OCCA start Oct 2013 and get Oxford Uni accredited Certificate in Theological and Pastoral Studies awarded by Wycliffe Hall."

54. A facebook user titled 'Da' T.R.U.T.H, posted the following on 16 February 2017:

"Headed to Oxford University this summer!!! I am one of 12 people selected to attend a 5 week apologetics course at OCCA (a program at Oxford University)..."

55. A facebook user [Mr M] posted the following on 13 January 2017:

"I'd like to thank everyone for the well-wishes and congratulations concerning my acceptance into Oxford University...I will be doing a 1-year program at Wycliffe Hall and Oxford Centre for Christian Apologetics (OCCA). It will be a simultaneous focus on Theology and Apologetics with volunteering/ministering around London and Oxford areas."

³¹ See exhibit GL24, a clearer copy of which was provided at the hearing.

56. A student blog by 'Matt' refers to 'my year at the Oxford Centre for Christian Apologetics (September 2017-September 2018).' The image at the top of the page is of an Oxford skyline overlain with two logos, the second of which is the University of Oxford brand.'

57. A print from 'The Best Schools' is undated. It originates from the US and lists the 'Best Overseas Apologetics Program' as Oxford Centre for Christian Apologetics, which has the following description:

"The Oxford Centre for Christian Apologetics (OCCA) is an autonomous study centre that provides a number of courses for students enrolled at the prestigious Oxford University. To enter the program students have to be accepted into the certificate or masters program in theological studies in Wycliffe Hall (a 'college' within Oxford University)...Oxford University is a historic institution – one of the oldest and most prestigious universities in the world – and the Centre's apologetics faculty is world-renowned. Students in the OCCA are also Wycliffe Hall members, so they enjoy the full privileges of Oxford University."

Proprietor's evidence

Witness statement of Dr Amy Louise Orr-Ewing and exhibits AL01-AL08

58. Dr Orr-Ewing is the Regional Director of the proprietor, a position she has held since 2014, and Director of the Oxford Centre for Christian Apologetics. Her statement is dated 13 July 2018.

Two witness statements of Gavin Hyde-Blake and exhibits GHB1-GHB4

59. Mr Hyde-Blake is Director and owner of Eccora Limited which he describes as, 'a specialist intellectual property investigations company'. His statements are dated 9 July 2018. Mr Hyde-Blake's evidence relates to use of 'Oxford' by third parties. I will not summarise it here but will refer to it as necessary later in this decision.

Witness statement of Benjamin Richard Mooneapillay and exhibits BRM1 and BMR2

60. Mr Mooneapillay is a partner at the proprietor's representative. His witness statement introduces photographs of a number of businesses which use 'Oxford' within the names of their businesses or services. I do not intend to summarise it here but will refer to it later in this decision.

Preliminary issues

Other entities using 'Oxford' not challenged by the applicant

61. Much was made of the fact that the applicant has not challenged every use of Oxford by third parties. At the hearing Mr Malynicz questioned Ms Marks on this point. Her response was that whilst OUP makes every effort to protect its trade marks, launching actions where appropriate, it is not possible to challenge every instance. I find Ms Marks's response entirely reasonable. There are numerous examples in evidence of previously decided cases before the IPO, EUIPO and IPEC involving the applicant. In any case, I must consider the marks before me in this case based on the grounds raised. Whether or not the applicant has taken action against other third parties and whether or not some of the third party use shown in evidence does amount to infringement of the applicant's rights are matters entirely irrelevant to the matter to be decided here.

Agreement between the proprietor and the applicant

62. Wycliffe Hall is a Permanent Private Hall of the University of Oxford. I pause here to note that Mr Malynicz submitted for the proprietor that Wycliffe Hall is not a party to these proceedings and that, as a consequence, Mr Terry's evidence is not relevant to the matter to be decided. It is clear from Mr Lees' evidence that many of the colleges which form part of the applicant are operated by independent committees and/or governing bodies. The applicant has six such halls and all are connected to the applicant.

63. Mr Lees states that Wycliffe Hall offers a range of theological programmes and degrees as well as ministerial training. Its governing body is the Hall Council. He provides a copy of a Memorandum of Agreement between Wycliffe Hall and the

proprietor.³² It is dated November 2010 and sets out the detail of a joint initiative between the two parties. The agreement was terminated by Wycliffe Hall on 30 November 2015.

64. The key points arising from Mr Terry's statements are as follows:

65. The proprietor's intention to register THE OXFORD CENTRE FOR CHRISTIAN APOLOGETICS as a trade mark was first raised at a meeting between staff of Wycliffe Hall and the proprietor, on 2 May 2012.

66. A memo from the proprietor's principal dated 23 April 2012 sets out the proposal that the proprietor would be granted exclusive use of the name 'Oxford Centre for Christian Apologetics' and 'OCCA'. The proprietor would register the trade mark.

67. Mr Terry confirms that Wycliffe Hall did not give permission for the proposals to be carried out by the proprietor. The first knowledge of the trade mark was in a telephone conversation between Wycliffe Hall's Bursar and the University's legal department.

68. Mr Terry submits that Clause 8.6 of the Memorandum of Agreement between the parties, dated November 2010 states that the names OCCA and Oxford Centre for Christian Apologetics or other derivatives which might be identified with the Centre shall not be used other than in respect of the Centre established under the agreement without the express permission of the Council of Wycliffe Hall and the Trustees of the proprietor. Mr Terry reiterates that no permission was given by Wycliffe Hall.

69. Agreements between the cancellation applicant and other RICs were admitted at the hearing. They are as follows:

The Oxford Centre for Hindu Studies (dated 10 July 2006)

The Oxford Centre for Buddhist Studies (dated 12 September 2006)

³² See confidential exhibit GL21.

The Oxford Centre for Islamic Studies (dated 12 December 2006)

Oxford Institute for Energy Studies (dated 21 August 2007)

70. Each agreement contains the following:

“2.2 The University shall take the exclusive benefit of all goodwill in the Trade Mark which is established by its use by the Licensee insofar as such goodwill supports the University’s common law and trade mark rights in the name ‘Oxford’.”

71. The trade marks referred to in each of the agreements are plain word OXFORD marks for publishing services and related goods in classes 9, 16 and 41.

72. In addition, also submitted at the hearing is a trade mark licence between the cancellation applicant and The Oxford Centre for Hebrew and Jewish Studies. It is dated 24 August 2018. The agreement relates to use of three OXFORD marks in classes 9, 16 and 41 and outlines the conditions of use for the University’s logos. Clauses 4.1 and 4.2 confirm that any goodwill generated by use by the RIC shall accrue to the University. Clause 4.3 reads as follows:

“OCHJS shall not apply for, or obtain, registration of the Trade Mark, or any trade or service mark that includes the word or mark ‘Oxford’, or otherwise consists of, comprises, or is confusingly similar to, the Trade Mark, for any goods or services in any country.”

73. The applicant’s submission with regard to these agreements is that it is clear that it keeps tight control of the use of its name and logos in its agreements with third parties.

74. Ms Amy Orr-Ewing submits in her witness statement, for the proprietor:

“3. In 2004, the Zacharias Trust and Wycliffe Hall established what was then called the Oxford Centre for Evangelism and Apologetics (OCEA). In 2006,

the centre was renamed the Oxford Centre for Christian Apologetics (OCCA). The OCCA is an autonomous study-centre based in Oxford.

4. The name 'Oxford Centre for Christian Apologetics' was chosen because it is a centre for Christian Apologetics based in Oxford. The word 'Oxford' was not used to take advantage of the reputation of the University of Oxford...In 2012, the name of the centre was registered as a trade mark, in order to protect the use, in light of its growing reputation."

75. The agreement between the proprietor and Wycliffe Hall makes no mention of trade marks nor does it explicitly refer to any other intellectual property. The clause (8.6) referred to by Mr Terry includes the following additional text at the end of the clause:

"This agreement permits OCCA and RZIM to use the titles OCCA and Oxford Centre for Christian Apologetics and any subsequently agreed and or amended titles for marketing and promotional purposes."

76. This is very different to the agreements between the applicant and other RICs which were admitted at the hearing. These explicitly refer to particular trade marks, shown in a schedule to those agreements. They also provide clear instructions and restrictions in terms of third party use of the applicant's trade marks. No such agreement has been put in evidence between the two parties in this case.

77. I note also that the agreements between the applicant and its other RICs which were put in evidence show that the goods and services in all of these agreements appear to relate only to publishing goods and services.

78. The applicant's evidence as a whole does indicate that in its dealings with third parties Oxford University does maintain tight control of the use of its trade marks and how its logos are used, including the quality of any images, particularly with regard to publication goods and services. In that regard both Mr Lees and Ms Marks were credible witnesses, who clearly have experience of such arrangements. I am prepared to conclude this to be the case, as a general principle, but in the absence of an explicit

agreement between these parties in relation to trade marks, I do not intend to give it any further weight than that.

The invalidation under the 5(4)(a) ground

79. Section 5(4) of the Act states:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade...

(b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

80. In *Discount Outlet v Feel Good UK*,³³ Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL)*, namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived,

³³[2017] EWHC 1400 IPEC.

but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

81. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

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

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

83. In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

The relevant date

82. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*,³⁴ Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

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

³⁴ BL O-410-11

have been any different at the later date when the application was made.”

83. It is clear in this case that the proprietor has made use of its mark prior to the date of filing of the trade mark. Evidence which predates the application date can be found in a number of annual reports.³⁵ The 2007 report is titled Annual RZIM Ministry Report. The mention of the OCCA is in a small paragraph which states that it has 43 students across a number of programmes. An undated document states that 12 students graduated from OCCA in 2007/8. The 2009 report shows 21 students graduating across two programmes. The 2010/11 report is titled Ravi Zacharias International Ministries Annual Ministry Report and refers to the next year’s course benefitting from Oxford University accreditation and its aim to recruit 35 students for the year.

84. The use by the proprietor prior to the filing date is very small in the context of the university/tertiary education sector which, no doubt, admits many thousands of students per year. In addition, I am not able to see any examples of trade marks used in the recruitment and teaching of the proprietor’s students, so cannot determine whether or to what extent it had generated goodwill prior to the filing date. I note that the proprietor has not made any claim to goodwill prior to the filing date in its counterstatement or submissions and will therefore consider the matter at that date.

85. The filing date of the contested trade mark is 2 July 2012 and the matter need only be assessed as of 2 July 2012.

Goodwill

86. In *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd*³⁶ the Court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one

³⁵ See ALO1, the first exhibit to Ms Orr-Ewing’s statement.

³⁶ [1901] AC 217 (HOL).

thing which distinguishes an old-established business from a new business at its first start.”

87. The applicant claims goodwill for the following goods and services for each of the signs relied on:

- OXFORD UNIVERSITY PRESS for education services, publishing services and publications.
- OXFORD UNIVERSITY and UNIVERSITY OF OXFORD for education services, publishing services and publications.
- OXFORD, for education services, publishing services and publications.

88. In paragraphs 4-6 of its counterstatement, the proprietor accepts that the applicant has used the marks UNIVERSITY OF OXFORD and OXFORD UNIVERSITY for many years and has reputation and goodwill for the provision of tertiary level educational services provided by a university. It accepts the structure of the university as outlined by the applicant and that the applicant has a theology department. The proprietor accepts the same with regard to OXFORD UNIVERSITY PRESS for publishing services and educational publications.

89. The proprietor does not accept that the applicant has used the mark OXFORD for many years and disputes that the applicant has any reputation or goodwill in that mark. It also denies that the mark OXFORD has become highly distinctive for educational and publishing goods and services.

90. Given what I have already said about the applicant’s evidence earlier in this decision, it is undoubtedly the case that the applicant has considerable goodwill in OXFORD UNIVERSITY, UNIVERSITY OF OXFORD and OXFORD UNIVERSITY PRESS.

91. I find that for all three of these marks the goodwill rests in educational services and publications and publishing services. Under the OXFORD UNIVERSITY and UNIVERSITY OF OXFORD signs the applicant clearly provides educational services and has done for many hundreds of years; I have accepted as much on judicial notice. However, it also publishes content through its website and social media channels, provides supporting documentation for courses, student support, tutorials and so on. Given the substantial goodwill for educational services, the level of published material both online and in printed form is clearly considerable across the numerous faculties and colleges under the Oxford University umbrella. With regard to OXFORD UNIVERSITY PRESS, it is clear from my comments earlier in this decision that I accept the applicant has strong goodwill under this sign for publishing services and publications, but the evidence shows that in addition, OUP also provides educational services, including, inter alia, examination services, assessment services and professional development courses for teachers. It is also clear that these services are offered at all levels of education from primary to university level.

92. With regard to the OXFORD sign, Mr Lees states that the applicant is often abbreviated and referred to as OXFORD. This was noted in the judgment of the English Intellectual Property Enterprise Court in *The Chancellor Masters and Scholars of the University of Oxford v Oxford Law School Limited*³⁷ in which District Judge Lambert held as follows:

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

93. The evidence shows that as well as references to the city of Oxford to show where the university is based, there are many references to Oxford as an indication of the university. Some of the courses provided by the University are Oxford courses, for example ‘Oxford Diploma in Organisational Leadership’, which is provided by a

³⁷ [2014] All ER (D) 104 (Jan)

business school which is part of Oxford University. Faculties and departments routinely use 'Oxford Centre...' and 'Oxford Institute...' to denote the fact that they are part of Oxford University. In addition, the OXFORD sign appears on the spine of every book published by OUP, which amounts to many millions of titles around the world. OUP's educational services are branded 'OXFORD' followed by the particular service, for example, 'Oxford School Improvement', 'Oxford Discover' and 'Oxford Teachers Academy'. I find that the applicant has substantial goodwill in its OXFORD sign for educational services, publishing services and publications.

Misrepresentation

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

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

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

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

95. And later in the same judgment:

".... for my part, I think that references, in this context, to 'more than *de minimis*' and 'above a trivial level' are best avoided notwithstanding this court's reference to the former in *University of London v. American*

University of London (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

96. I have found the applicant to have goodwill in respect of education services, publication services and publications.

97. The applicant’s goodwill is associated with the signs OXFORD UNIVERSITY, UNIVERSITY OF OXFORD, OXFORD UNIVERSITY PRESS and OXFORD. The proprietor’s mark comprises the words THE OXFORD CENTRE FOR CHRISTIAN APOLOGETICS. There is clearly an aspect of similarity between the proprietor’s mark and the applicant’s signs on account of the common presence of the word OXFORD. The other words, UNIVERSITY, UNIVERSITY OF and UNIVERSITY PRESS in the applicant’s signs and the words CENTRE FOR CHRISTIAN APOLOGETICS in the proprietor’s mark are clearly descriptive of the services being provided and so are of lower distinctiveness. I find that the OXFORD sign and the proprietor’s mark are visually and aurally similar to a medium degree, the earlier sign being entirely reproduced in the proprietor’s registration. There is a high degree of conceptual similarity as both contain the word OXFORD with the only other words in the proprietor’s mark being descriptive of the services offered. The signs OXFORD UNIVERSITY, UNIVERSITY OF OXFORD and OXFORD UNIVERSITY PRESS are visually similar to a fairly low degree and aurally similar to a medium degree. There is a high degree of conceptual similarity between these three of the applicant’s signs and the proprietor’s mark as they all comprise the word OXFORD with other words which are descriptive of the services in question.

98. There is no requirement for a common field of activity under the law of passing off. However, the proprietor’s mark is registered in classes 9, 16, 41 and 45 for goods and services which may be provided by a university, including its publishing press and its theology departments. It is clear that the applicant’s goodwill extends to such things.

99. The key question is whether use of the proprietor’s mark, for the goods and services for which it is registered, is such that the applicant’s customers would

associate the goods and services with them, or believe them to be responsible for them and if so, whether this amounts to a misrepresentation in the minds of the relevant public (being the applicant's customers for the purposes of the s.5(4)(a) assessment).

100. In its skeleton argument, the proprietor submitted:

"11. Critically, there is no distinctive similarity...This is because the word OXFORD designates a geographical location, the city of Oxford, and there are and have been for many years a multitude of entities unconnected with [the University of Oxford]...who use the word OXFORD in their names to designate the fact that they are located in the city and whom the public do not take as being part of or connected in the course of trade with [the University of Oxford]."

101. Mr Hyde-Blake provides evidence in support of the proprietor's claim that its use of 'Oxford' is geographic and will not be considered to be connected to the applicant.³⁸ In his first statement Mr Hyde-Blake investigates:

i) OXFORD used by Oxford based educational establishments.³⁹

ii) Use of 'Oxford Centre for/of' and 'The Oxford Centre for/of' by businesses based in Oxford.⁴⁰

102. In both exhibits Mr Hyde-Blake provides a list of establishments and a URL. No further analysis is provided.

103. Concluding the presentation of this evidence, the proprietor submits:

"37. The legal relevance of the third party use is that it directly impacts on the lack of any likelihood of confusion. If there are so many unconnected

³⁸ Mr Hyde-Blake also provides evidence of use of Bristol, Birmingham, Manchester, and Edinburgh and more in respect of Cambridge. I do not intend to consider these exhibits as they are not relevant to the matter to be decided.

³⁹ See exhibit GHB1.

⁴⁰ See exhibit GHB3.

entities using the name Oxford to indicate a connection with the city, it is most unlikely that the mark in issue will lead to confusion. This also has a bearing on the 5(3) and 5(4) arguments in that there will be no link or any misrepresentation.”

104. The cancellation applicant submits the following with regard to the evidence of Mr Hyde-Blake:⁴¹

“42. ...The state schools are obviously local organisations which have local catchment areas. They do not use the term Oxford as a brand but to identify their location and local reach. Apart from those there is very little information in the report to enable one to work out what they are or what they do so one has to do one's best. Thus, Oxford High School is listed on page 183. Looking at its URL, we see that it is a GDST school. That means that it is member of the Girls' Day School Trust, a well-known family of independent girls' day schools. Being a day school, it can only have a local catchment area. UTC Oxfordshire, which is listed as a school, is a secondary level technical college which, as can be seen, does not use the name Oxford but uses the county designation to denote its location. Much the same goes for LVS Oxford which, according to its website, is a specialist school for local children on the autistic spectrum. Again, this would appear to be a clear case of geographical designation rather than branding, the brand or name of the school being LVS. In summary, we respectfully suggest that this material fails entirely to make out a case of anything other than geographical designations of local scope and impact only.

44. ...in exhibit 2 to his report at page 184 [Mr Hyde-Blake] refers to something he calls "King's Oxford" (fourth from the bottom of the page). A look at the URL he quotes makes clear that it is in fact called King's Education and that Oxford appears on its website simply as one of a number of locations at which students can study. A visit to the website confirms this. This institution does not use the term Oxford either as part of its name or to

⁴¹ See the applicant's skeleton argument by Mr Silverleaf, pages 15 and 16.

identify its location. It is simply one of the places, of which there are several, at which students can undertake their studies. Its inclusion in this form is at best careless and is in any event unhelpful to the tribunal.

45. Other parts of the material are simply irrelevant. The Oxford Wine Company on page 185 isn't going to confuse anybody into thinking that there is a connection with the University. Nor are Oxford Chelt Wine School, Oxford Sail Training Trust or Go Fly Oxford on the same page. Wine, sailing and flying are not among the goods and services for which the University is particularly known! ...Other entries appear to be misplaced. Oxford Gardens Primary School (the last entry on page 187) is a primary school in the Royal Borough of Kensington and Chelsea (see the quoted URL). It appears on the map in Oxford Gardens W10."

105. Mr Silverleaf concludes:

"45...This material provides no support for the proposition that organisations which reach out for custom beyond the locality of the area around the city of Oxford use that name either to identify their location or to brand their products or services. If anything, it suggests the contrary."

108. I bear in mind the comments of Lord Simonds in *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited*,⁴² where he stated that:

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

⁴² [1946] 63 RPC 39.

106. Most of the educational establishments provided in Mr Hyde-Blake's statement are clearly schools and nurseries in the Oxford area: among others, Oxford Day Nursery, East Oxford Primary School, West Oxford Community Primary School and Oxfordshire Hospital School, Oxford. Some of the other entities in the first exhibit are clearly unrelated to the services of a university or teaching establishment: amongst others, Oxford Wine Company and Go Fly Oxford.

107. The exhibit relating to 'Oxford Centre' has examples of third parties which are in some cases clearly businesses which are based in Oxford and are unrelated to the goods and services associated with a University or teaching establishment: amongst others, Oxford Golf Centre and Oxford ADHD Centre. I cannot be sure of the relevance of the rest of the companies named in the exhibit. Mr Hyde-Blake submits that information has been gleaned from a number of sources, including general internet searches and Companies House. Consequently, these may be companies which are dormant or no longer in operation.

108. The applicant's goodwill in this case is extremely strong. The proprietor accepts the structure of Oxford University as described by the applicant. The proprietor also accepts that the university has a theology department. The proprietor's evidence shows that it publishes religious texts and materials and engages in theological teaching. I have already found that the proprietor has demonstrated goodwill under all of its signs, including 'OXFORD', and I accept that the longer form signs are also often abbreviated thus.

109. With regard to the proprietor's evidence, the use of Oxford to denote location by businesses in Oxford and its regions is to be expected as is the same use in names of local education providers, such as high schools and primary schools which have a local catchment area. The fact that there may be businesses using similar names to that of the applicant, which it may not be content with, is not evidence which means that the proprietor should automatically succeed in the case before me. As Ms Marks stated under cross examination, this may be evidence of other examples of infringement of the applicant's rights.

110. Whether or not OXFORD will be seen as simply an indication of geography is, in my view, a matter of context. It is clear from the evidence that the applicant teaches subjects such as religious ethics and philosophy, as well as teaching those who will go on to hold positions as ministers/clergy, in one of any number of denominations. Given the extremely large goodwill of the applicant, I find that a substantial number of members of the public will see the proprietor's mark as indicating a department or faculty within the applicant's university. They will believe that the applicant has responsibility for the provision and quality of the goods and services and that there is an economic link between them. I find this to be the case for all of the goods and services, including those of ministry and counselling.

111. I find further support for this finding in Mr Lees' evidence which includes facebook posts from the proprietor's students. These are dated several years after any agreement between the parties came to an end, namely January and February 2017. The first reads: 'Headed to Oxford University this summer!!!'; the second reads: 'I'd like to thank everyone for the well-wishes and congratulations concerning my acceptance into Oxford University.' These were both students who had achieved places at the proprietor's Oxford Centre for Christian Apologetics. While these are not significant in terms of number, they do show that some of the proprietor's own students believe that the proprietor is part of the applicant and not a separate entity.

Damage

112. Having found that the goodwill and misrepresentation limbs of the test have been satisfied in respect of all goods and services, it follows that damage to the applicant's goodwill will arise.

113. In *WS Foster & Son Limited v Brooks Brothers UK Limited*,⁴³ Mr Recorder Iain Purvis QC stated:

"Damage

⁴³ [2013] EWPC 18

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

114. In this case I also bear in mind the decision in *Harrods Limited v Harrodian School Limited*,⁴⁴ in which Millett L.J. described the requirements for damage in passing-off cases like this:

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

115. As well as damage due to direct loss of income where the customer accesses the proprietor's goods and services rather than the applicant's, there is also potential for damage more generally.

⁴⁴ [1996] RPC 697

116. In *Ewing v Buttercup Margarine Company Limited*,⁴⁵ Warrington L.J. stated that:

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

117. The applicant clearly offers goods and services of the very highest standard. The evidence shows the extent to which the applicant keeps control of its image by, for example, only allowing authorised versions of its branding to appear on materials which represent the university, either directly or through one of its many affiliations. It is easy to see in a case such as this that injurious association could certainly have a detrimental effect on the exclusivity of the goods and services it offers.

118. The applicant's invalidation succeeds under sections 47(2)(b) and 5(4)(a) of the Act for all of the goods and services in the proprietor's specification. The applicant having succeeded in full under this ground, I do not, strictly speaking, need to consider the other grounds of opposition. However, I outline my views with regard to section 5(3) below.

119. Section 5(3) of the Act states:

“5...

(3) A trade mark which-

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

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of Community trade mark, in the European Community) and the use of the later mark without due cause

⁴⁵ [1917] 2 Ch. 1 (COA)

would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

120. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oréal v Bellure* [2009] ETMR 55 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 Salomon*, 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 that 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 on the earlier mark; *L'Oréal 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'Oréal v Bellure*).

Reputation

121. The earlier marks relied on by the applicant must have a reputation. In *General Motors Corp v Yplon SA (Chevy)*, the CJEU stated:

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

122. It should be clear from my findings earlier in this decision that the applicant’s marks pass the reputation test.

Link

123. In addition to the earlier mark having a reputation, a link must be made between the mark applied for and the earlier mark. In *Intel Corporation Inc v CPM (UK) Ltd*⁴⁶ (“Intel”) the CJEU provided guidance on the factors to consider when assessing whether a link has been established. They are:

The degree of similarity between the conflicting marks;

The nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;

The strength of the earlier mark’s reputation;

The degree of the earlier mark’s distinctive character, whether inherent or acquired through use;

The existence of the likelihood of confusion on the part of the public.

124. In *Intra-Press SAS v OHIM*,⁴⁷ the CJEU stated that:

“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

⁴⁶ C-252-07

⁴⁷ *Joined cases C-581/13P & C-582/13P*

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).”

125. In other words, the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion. Consequently, if a significant section of the relevant public simply thinks about the opponent’s mark when they see (or hear) the applicant’s mark, then the necessary link is established.

126. I find that when the proprietor’s mark is encountered, even for goods and services which are not identical to those of the applicant, the applicant’s reputation is such that the proprietor’s mark will cause the applicant’s Oxford marks to be brought to mind. In other words, the relevant public will make a link between the parties’ marks.

Damage

127. In its statement of grounds the applicant submits that use of the proprietor’s mark will take unfair advantage of the distinctive character or repute of the applicant’s trade marks. As I have found there to be a misrepresentation and damage as a result under the law of passing off, it follows that unfair advantage will be gained. The applicant has a very strong reputation for the quality and standing of its goods and services, a reputation that has been built up over many hundreds of years. Members of the

relevant public will be attracted to the proprietor's goods and services because they believe them to be provided by an entity which is linked to or part of the applicant.

128. In *Jack Wills Limited v House of Fraser (Stores) Limited*⁴⁸ Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

129. Consequently, evidence of subjective intention is not necessary. It is sufficient if, viewed objectively, the applicant's mark takes unfair advantage of the opponent's mark and I find that to be the case here.

130. Throughout its pleadings, the proprietor relied on the fact that use of the word OXFORD is purely geographic. This could be considered to be due cause, or could give rise to a situation where the advantage gained is not in fact unfair. I have already considered this point and have concluded that whilst there are clearly some situations where the use of Oxford as part of a trade mark could be considered entirely geographic, that is not the case here. The presentation of the mark in this case will

⁴⁸ [2014] EWHC 110 (Ch).

give rise to a presumption of association between the proprietor and Oxford University (in respect of all four earlier marks relied on).

131. The invalidation succeeds under sections 47(2)(a) and 5(3) of the Act.

132. I have considered two of the three grounds pleaded in this case and both have succeeded in full. I therefore do not propose to consider the 5(2)(b) ground. Even if I had not found there to be a likelihood of confusion for some of the goods and services in the proprietor's specification, I would still have found the 5(3) ground to be successful. Members of the relevant public would pause to wonder if the goods and services of the proprietor were being provided by the applicant or a related undertaking. As a consequence, some of the prestige of the applicant would benefit or be transferred to the proprietor. Such an association would have an impact on the applicant's trade mark to be immediately associated with it. In other words, it would dilute the distinctiveness of the applicant's marks.

Costs

133. The opposition having succeeded, The Chancellor Masters and Scholars of the University of Oxford is entitled to a contribution towards its costs.

134. Two case management conferences (CMCs) were held during these proceedings. The first was to discuss an extension to the cancellation applicant's deadline by which to file its evidence in chief (which was allowed). The second concerned a request by the proprietor to strike out the second witness statement of Justyn Terry (which was refused) and a request to cross examine three of the applicant's witnesses (which was allowed). Having considered all of the relevant material, I find that the parties should bear their own costs with regard to the CMCs.

135. I award substantive costs on the following basis:⁴⁹

Official fees:	£200
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⁴⁹ The scale of costs applicable to proceedings before the Comptroller can be found in Tribunal Practice Notice 2/2016.

Preparing the notice of opposition and
considering the counterstatement: £300

Preparing evidence and considering and
commenting on the other side's evidence: £700

Preparation for and attendance at a hearing: £900

TOTAL £2100

136. I order RZIM Zacharias Trust to pay The Chancellor Masters and Scholars of the University of Oxford the sum of £2100. These costs should be paid within 42 days of the date of this decision or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 11th day of May 2020

**Al Skilton
For the Registrar,
the Comptroller General**