

O-418-20

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION Nos.3383097 & 3383089
BY UNI EXCELLENCE LIMITED
TO REGISTER IN CLASSES 9, 35, 38 & 41
THE TRADE MARKS**



**AND
IN THE MATTER OF OPPOSITIONS THERETO
UNDER Nos. 416703 & 416704
BY
THE UNIVERSITY OF LAW LIMITED**

BACKGROUND

1) On 13 March 2019, Uni Excellence Limited (hereinafter the applicant) applied to register the trade marks shown on the front page in respect of identical specifications for the following goods and services:

In Class 9: Downloadable publications; electronic publications; audio visual recordings; pre-recorded software; pre-recorded CDs; pre-recorded DVDs; instructional and teaching apparatus and instruments; audiovisual teaching apparatus; education software; downloadable educational course materials; computer software; application software; computer hardware; CD-ROMs, DVDs; videos; media content; databases; data communications equipment; parts and fittings for all the aforesaid goods.

In Class 35: Providing business information via a website; risk management consultancy; business risk assessment services; business consulting; business research; business management; business administration; business information; business data analysis services; commercial information; statistics (compilation of); statistical business and commercial information; management and compilation of computerized databases; collection and systemization of business data; market research and studies; accounting; advertising; retail services connected with the sale of downloadable publications, electronic publications, audio visual recordings, pre-recorded software, pre-recorded CDs, pre-recorded DVDs, instructional and teaching apparatus and instruments, audiovisual teaching apparatus, education software, downloadable educational course materials, computer software, application software, computer hardware, CD-ROMs, DVDs, videos, media content, databases, data communications equipment, parts and fitting for the aforesaid goods; consultancy, information and advisory services relating to all the aforesaid services.

In Class 38: Providing interactive on-line bulletin boards for the transmission of messages among computer users in the field of education and training; electronic mail services; provision of user access to a global computer network; providing internet chatrooms, bulletin boards and discussion groups; electronic transmission of data via computer and communication networks and via the Internet; telecommunications; transmission of radio and television programmes; cable transmission of programmes; transmission of telephone calls; data transmission; transmission and reception by data communications of messages, documents, images and voice communications, using data communications sites, addresses and domains; provision of network data communications services

by providing and using multimedia networks and portals; information, consultancy and advisory services relating to the aforesaid services.


In Class 41: Education and instruction; educational and teaching services; provision of education services; providing of training, teaching and tuition; provision of online training; arranging teaching programmes; provision of education courses; providing facilities for educational training; electronic publishing; publications (not downloadable) from databases or the Internet; publication of educational teaching materials; production of educational sound and video recordings; rental of educational materials; rental of recorded education; provision of education on-line from a computer database or via the internet or extranets; arranging and conducting conferences, seminars, exhibitions and competitions; consultancy, information and advisory services relating to all the aforesaid services.

2) The applications were examined and accepted, and subsequently published for opposition purposes on 22 March 2019 in Trade Marks Journal No. 2019/012.

3) On 21 June 2019 The University of Law Limited (hereinafter the opponent) filed identical notices of opposition, subsequently amended. The pleadings were also amended at the hearing. The opponent in these proceedings is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
<p>ULAW</p> <p>U^ULaw</p> <p>A series of two trade marks</p>	3380220	04.03.19 24.05.19	9	Sound recordings; video recordings; tapes; cassettes; compact discs; DVDs and other electronic media; films; CD ROMS; computer games; computer software; Application software (Apps); Apps for mobile devices; video cameras; cameras; photographic and cinematographic apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images; photographic transparencies, photographic films; batteries; encoded magnetic cards, magnetic identity cards, credit cards, debit cards; spectacles, spectacle cases, sunglasses; mouse pads; screen savers; downloadable publications in electronic form.

			16	Stationery; printed matter; books, periodicals, newspapers, magazines, pamphlets, manuals, journals; printed and/or published materials; text books; guides; course notes; case studies; articles; reports of conferences; teaching materials; diaries; writing implements, drawing implements; artists' materials; photographs, postcards, calendars, posters, greeting cards; paper and plastic packaging materials; stickers.
			41	Educational and training services; teaching; examination services; organisation of exhibitions for educational purposes; organisation of conferences, tutorials, seminars and symposia; publishing services; university services; provision of information relating to education, teaching, instruction and research; academic services and conferral of educational degrees; teaching, lecturing and tutorial services; lending libraries and library services; provision of sporting, entertainment and cultural activities and events.
The University of Law	EU 012042636	05.08.13 25.08.14	9	Sound recordings; video recordings; tapes; cassettes; compact discs; DVDs and other electronic media; films; video cassettes; video recorders; CD ROMS; computer games; computer software; video cameras; cameras; photographic and cinematographic apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images; photographic transparencies; batteries; encoded magnetic cards, magnetic identity cards, credit cards, debit cards; spectacles, spectacle cases, sunglasses; video games; mouse pads; screen savers; publications in electronic form, typically supplied on-line from databases or from facilities provided on the Internet; holograms, credit cards with holograms.

			16	Stationery; printed matter, books, periodicals, newspapers, magazines, pamphlets, manuals, journals; diaries, writing implements, drawing implements, artists materials, photographs, postcards, calendars, posters, greeting cards, wrapping paper, plastic materials for use as wrapping, instructional and teaching materials; paper and plastic packaging materials; stickers.
 <p>Colours Claimed / Indication: Petrol Blue "Pantone 314"; Purple "Pantone 254".</p>	EU 12042685	05.08.13 25.08.14	9	Sound recordings; video recordings; tapes; cassettes; compact discs; DVDs and other electronic media; films; video cassettes; video recorders; CD ROMS; computer games; computer software; video cameras; cameras; photographic and cinematographic apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images; photographic transparencies; batteries; encoded magnetic cards, magnetic identity cards, credit cards, debit cards; spectacles, spectacle cases, sunglasses; video games; mouse pads; screen savers; publications in electronic form, typically supplied on-line from databases or from facilities provided on the Internet; holograms, credit cards with holograms.
			16	Stationery; printed matter, books, periodicals, newspapers, magazines, pamphlets, manuals, journals; diaries, writing implements, drawing implements, artists materials, photographs, postcards, calendars, posters, greeting cards, wrapping paper, plastic materials for use as wrapping, instructional and teaching materials; paper and plastic packaging materials; stickers.

- a) The opponent contends that the marks in suit and the opponent's marks shown above are similar and that some of the goods and services applied for are identical and/or similar to the goods and services for which the earlier marks are registered. As such the marks in suit offend against Section 5(2)(b) of the Act.

- b) The opponent contends that because of the use of its trade mark UK 3380220 it has reputation in it. It claims that the marks in suit will benefit from the opponent's advertising and promotion and will gain sales from the association with the opponent's mark. The opponent contends that use of the marks in suit could damage its reputation and it will reduce the distinctiveness of the opponent's mark. It contends that the marks in suit offend against section 5(3) of the Act.
 - c) The opponent contends it has used the sign ULAW since 2014, and the sign THE UNIVERSITY OF LAW since 2012 and has goodwill in both signs. As the signs of the two parties are similar as are the goods and services there will be misrepresentation which will damage the opponent's goodwill in its signs. As such the marks in suit offends against section 5(4)(a).
 - d) Originally the opponent pleaded bad faith under section 3(6), but this was withdrawn at the hearing.
- 4) On 23 September 2019 the applicant filed two identical counterstatements, subsequently amended, basically denying all the grounds of opposition. In response to the bad faith claim it points out that educational services can be provided by independent private institutions which receive no government funding. It states that just because it currently does not supply such services does not mean that it has no intention of doing so in future. It did not put the opponent to proof of use.
- 5) Both parties filed evidence; both sides seek an award of costs in their favour. The matter came to be heard on 8 July 2020 when Ms Messenger of Counsel instructed by Messrs Trademark Eagle Limited represented the applicant; the opponent was represented by Mr Dakanalis of Messrs HGF Limited.

OPPONENT'S EVIDENCE

- 6) The opponent filed a witness statement, dated 7 January 2020, by Lysette Gauna the Head of Brand and Content Marketing for the opponent, a position she has held since June 2014. She states that prior to receiving its University status in 2012 the University was known as "The College of Law". She states that the opponent "offers its educational services in the UK at thirteen campuses and online as well as internationally in Berlin and Hong Kong". She provides numbers of students and also turnover figures, but these do not show the position in the UK or even EU but appear to be global figures. She provides the following exhibits:

- LG1: A copy of two pages from the accounts for 2017/18. This provides the number of students at almost 8,000 in 2016/17 and revenue of approximately £80 million per annum. It is not clear how much of this is down to the UK campuses, its on-line activities or its overseas campuses. The accounts state: “Our vision is to be the global university of choice for the professions,..”.
- LG2: Copies of what appear to be advertisements in newspapers and show advertisements in the *Evening Standard*, and *Metro* on 17 August 2016; the *Telegraph* on 16 August 2018 and the *Guardian* on 17 August 2018.
- LG4: This consists of numerous pages of stories about the opponent, such as it receiving an education award, and offering to refund fees if graduates fail to get a job. However, whilst some are dated prior to the relevant date, others are from abroad and/or dated after the relevant date or not dated at all.
- LG5: Copies of stories featured in an internet site (LEGAL CHEEK) dealing with legal stories, which mention ULAW during the period 2015-2019.
- LG6: Copies of press releases for the period 2013-2018 which show use of the opponent’s full title and also (usually after the full title) the term ULAW.
- LG8: Newspaper stories relating to the press releases at LG6 in *The Independent* and *The Law Society Gazette* during the period 2014-2018.
- LG9: Various copies of entries by social media users, particularly students attending the opponent’s colleges which mention the term ULAW.
- LG10: This shows that the opponent has owned the domain name ULAW-ALUMNI since 2017.
- LG11: An example of the newsletter sent to the opponent’s alumni.

APPLICANT’S EVIDENCE

7) The applicant filed two witness statements. The first, dated 9 March 2020, is by Virginia Szepietowski the principal Director of the applicant. She states that the applicant’s Companies House registration puts as the nature of the business “Other education not elsewhere classified” and also

“Educational support services”. The applicant’s objective is to guide students into the best universities in law. The applicant has a team of lawyers, law students, legal trainees and legal education specialists who give students “the inside edge they need to get into the UK’s best law schools”. This is achieved by providing courses such as “lawyer for a day” which gives an insight into the legal profession and shows them if the career is right for them. Other courses help students prepare their personal statements, and techniques and methods on answering questions to achieve the best results. The applicant’s client base are GCSE and A level students looking to study law at university, they do not provide college or university courses. The training and education courses on offer are pre-university and designed to simply help them get into university. She points out that the applicant created its social media accounts prior to those of the opponent with their Facebook, Twitter and Instagram accounts all being opened in November 2018. She contends that the use of the applicant’s mark pre-dates that of the opponent’s use of ULAW. Although a number of exhibits are provided these are almost all dated after the relevant date (March 2019).

8) The second witness statement, dated 9 March 2020, is by Rosario Valdez-Knight the applicant’s Trade Mark Attorney. She provides the following exhibits:

- RVK1: Copies of papers from the EUIPO where the opponent’s mark was rejected on the basis of lack of distinctiveness.
- RVK2: Examples of the opponent being referred to recently as the College of Law, although many of these appear to be referring to events which happened prior to the change of name such as stating that people graduated from the College of Law many years prior.
- RVK5: An example of a presentation provided by the opponent where it used the acronym UOL not ULAW.
- RVK6: Profiles of the some of the opponent’s visiting professors, none of whom use the ULAW acronym.

OPPONENT’S EVIDENCE IN REPLY

9) The opponent filed a witness statement, dated 23 April 2020, by Ms Gauna who has provided evidence earlier in these proceedings. She provides the following exhibits:

- LG14: Articles from the UK press referring to the opponent as ULAW which were not paid-for editorial. These are dated February 2015 – October 2017 and include articles from The Metro, The Solicitor’s Journal, The Telegraph, The Times & The Independent.
- LG15: examples from the UK press of paid-for editorial in The Guardian, one of which is dated in 2018.
- LG17: Examples of the website LEGAL CHEEK being quoted by other media outlets The Independent in 2016 and the Evening Standard in 2017.
- LG20: Further posts from social media showing the opponent being referred to as ULAW. These are dated 20 July 2017 – 18 February 2019.
- LG21: Definitions of the term UNI from a number of online dictionaries which shows it is short-hand for university.

DECISION

10) The first ground of opposition is under section 5(2)(b) which reads:

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

(a)

(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.”

11) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

12) The opponent is relying upon its trade marks shown in paragraph 3 above which are clearly earlier trade marks. The applicant did not put the opponent to proof of use of these marks.

13) When considering the issue under section 5(2)(b) I take into account the following principles which 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

14) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

15) The opponent contends that the average consumer would be the general public, but states that none of the goods and services are anything other than everyday items and so the average consumer will pay no more than an average level of attention to the selection. The applicant agrees that the general public would be included in the average consumer but contends that businesses will also be part of the consuming group, and that this group in particular would pay a higher than average level of attention.

16) The goods and services sought to be registered by the applicant are somewhat varied, encompassing, inter alia; DVDs / CDs, electronic publications and Computer hardware and software in class 9; Retail services, Business information, consultancy and research services in class 35; electronic mail, on-line messaging and mail services, telecommunication services and transmission of data in class 38 and education services in class 41. The average consumer for such goods and services would be the general public and businesses, and the level of attention paid would also vary considerably with some services such as those for businesses, or relating to education and telecommunications or goods such as computer hardware commanding considerable levels of attention given the nature of the services and goods and their cost. Whereas, CDs might be purchased without much thought if on a long road trip, or indeed retail services might be chosen simply for convenience of access. Such goods and services may be sold through a range of channels, including retail outlets (computers etc) and on the internet or via catalogues and print media (most of the services). The selection process will be primarily a visual one, although as many of the services will involve discussions with staff and as one might receive a recommendation, aural considerations must also be taken into account. I summarise the levels of attention that will be paid to the various goods and services below:

Goods and services	Level of attention paid:
In Class 9: Downloadable publications; electronic publications; audio visual recordings; pre-recorded CDs; pre-recorded DVDs; CD-ROMs, DVDs; videos; media content;	Low to Medium
In Class 9: pre-recorded software; instructional and teaching apparatus and instruments; audiovisual teaching apparatus; education software; downloadable educational course materials; computer software; application software; computer hardware; databases; data communications equipment; parts and fittings for all the aforesaid goods.	Medium to high
In Class 35: retail services connected with the sale of downloadable publications, electronic publications, audio visual recordings, pre-recorded CDs, pre-recorded DVDs, CD-ROMs, DVDs, videos, media content;	Low to Medium
In Class 35: Providing business information via a website; risk management consultancy; business risk assessment services; business consulting; business research; business management; business administration; business information; business data analysis services; commercial information; statistics (compilation of); statistical business and commercial information; management and compilation of computerized databases; collection and systemization of business data; market research and studies; accounting; advertising; retail services connected with the sale of pre-recorded software, instructional and teaching apparatus and instruments, audiovisual teaching apparatus, education software, downloadable educational course materials, computer software, application software, computer hardware, databases, data communications equipment, parts and fitting for the aforesaid goods; consultancy, information and advisory services relating to all the aforesaid services.	Medium to high
In Class 38: Providing interactive on-line bulletin boards for the transmission of messages among computer users in the field of education and training; electronic mail services; provision of user access to a global computer network; providing internet chatrooms, bulletin boards and discussion groups; electronic transmission of data via computer and communication networks and via the Internet; telecommunications; transmission of radio and television programmes; cable transmission of programmes; transmission of telephone calls; data	Medium to high

transmission; transmission and reception by data communications of messages, documents, images and voice communications, using data communications sites, addresses and domains; provision of network data communications services by providing and using multimedia networks and portals; information, consultancy and advisory services relating to the aforesaid services.	
In Class 41: electronic publishing; publications (not downloadable) from databases or the Internet;	Low to Medium
In Class 41: Education and instruction; educational and teaching services; provision of education services; providing of training, teaching and tuition; provision of online training; arranging teaching programmes; provision of education courses; providing facilities for educational training; publication of educational teaching materials; production of educational sound and video recordings; rental of educational materials; rental of recorded education; provision of education on-line from a computer database or via the internet or extranets; arranging and conducting conferences, seminars, exhibitions and competitions; consultancy, information and advisory services relating to all the aforesaid services.	Medium to high

Comparison of goods and services

17) 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”.

18) 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.

19) In *Gérard Meric v Office for Harmonisation in the Internal Market*, 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”.

20) In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is

equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

21) 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 GC stated that "complementary" means:

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

22) As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand:

".....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

23) I also note that if the similarity between the goods is not self-evident, it may be necessary to adduce evidence of similarity even if the marks are identical. In *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, the General Court pointed out that:

"43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27)."

24) Thus, where the similarity between the respective goods / services is not self-evident, the opponent must show how, and in which respects, they are similar.

25) The applicant's marks have identical specifications; therefore, I shall only carry out one comparison test. Although the opponent is relying upon its three marks the specifications of EU 012042636 and EU 12042685 are identical. The applicant provided the following admission on the similarity of the goods and services in respect of the opponent's UK trade mark 3380220:

Class	Identical	Similar	Not similar
9	Downloadable publications; electronic publications; audio visual recordings; pre-recorded software; pre-recorded CDs; pre-recorded DVDs; education software; computer software; application software; CD-ROMs, DVDs; videos;	downloadable educational course materials; media content;	instructional and teaching apparatus and instruments; audiovisual teaching apparatus; computer hardware; databases; data communications equipment; parts and fittings for all the aforesaid goods.
35	None	None	All
38	None	None	All
41	Education and instruction; educational and teaching services; provision of education services; providing of training, teaching and tuition; provision of online training; arranging teaching programmes; provision of education courses; electronic publishing; publication of educational teaching materials; provision of education on-line from a computer database or via the internet or extranets; arranging and conducting conferences, seminars, exhibitions	publications (not downloadable) from databases or the Internet;	providing facilities for educational training; production of educational sound and video recordings; rental of educational materials; rental of recorded education; competitions; consultancy, information and advisory services relating to all the aforesaid services.

26) In relation to the goods and services applied for compared to the opponent's specification under EU 12042636/EU12042685 the applicant makes the following admissions:

Class	Identical	Similar	Not similar
9	Downloadable publications; electronic publications; audio visual recordings; pre-recorded software; pre-recorded CDs; pre-recorded DVDs; education software; computer software; application software; CD-ROMs, DVDs; videos; media content;	downloadable educational course materials;	instructional and teaching apparatus and instruments; audiovisual teaching apparatus; computer hardware; databases; data communications equipment; parts and fittings for all the aforesaid goods.
35	None	None	All

38	None	None	All
41	None	None	All

27) I shall first consider the goods of the two parties in class 9. I accept that all of the goods identified by the applicant above are indeed identical to goods within the opponent's class 9 specification. I do not understand why the applicant has placed "media content" in the column for identical in respect of the opponent's EU marks yet merely similar in relation to its UK mark. The opponent's marks have "downloadable publications in electronic form" and "publications in electronic form, typically supplied on-line from databases or from facilities provided on the Internet" (which to my mind would include downloadable publications) both of which I believe encompasses the term "media content". Similarly, this term in the opponent's marks also encompasses the term "downloadable educational course materials" which makes these goods identical not similar.

28) The first contested items are: "instructional and teaching apparatus and instruments; audio-visual teaching apparatus". The opponent contended that these were similar to its "Photographic and cinematographic apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images". In support of this view it contended that:

"The contested terms would encompass digital electronic devices for recording, organising, transmitting, manipulating and reviewing text, data, audio, image and video files (e.g. digital screens, projectors), such devices used in the course of providing instruction and teaching. All such devices are apparatus for recording, transmission, reproduction of sound or images.

The opposed goods are similar to 'photographic and cinematographic apparatus and instruments; apparatus for recording, transmission, reproduction of sound or images'. The Opponent's terms extend to digital electronic devices (such as tablet computers, film projectors, digital screens) which are commonly used as instructional and teaching apparatus.

The parties' goods are sold through the same trade channels (e.g. shops for electrical and/or electronic products) and in the same specialist retailers. They coincide in their end users (namely members of the public) and may share commercial origin. It is submitted that the goods are **similar.**"

29) The applicant countered:

“There is no similarity between the goods. The nature, method of use and intended purpose of *“apparatus for recording, transmission, reproduction of sound or images”* is entirely different to the nature, method of use and intended purpose of both *“Instructional and teaching apparatus and instruments”* and *“audiovisual teaching apparatus”*. The purpose of the former goods is to enable a consumer to record / transmit / reproduce audio or visual content, the purpose of the latter is to provide a consumer with apparatus and instruments for providing instruction and/or teaching.

Contrary to the Opponent’s submission there is no reason to suppose they would be sold through the same trade channels. That submission appears to be premised on the basis that the instructional and teaching apparatus and instruments are electronic. Firstly, the term is not limited in that way and secondly, even if it were, the trade channels for providing an electronic instructional apparatus, whatever that may be, is unlikely to be the same as the trade channel for providing an apparatus for recording sound.

The Opponent’s submission that the contested terms would encompass digital electronic devices for, *inter alia*, recording, transmitting and manipulating audio, image and video files is, with respect, flawed. Those goods are not clearly covered by the literal meaning of the contested goods and there is no evidence to support the submission that they are. The Opponent’s submission is premised on an overly broad interpretation of the contested goods.

Similarly, the Opponent again incorrectly applies an overly broad interpretation when it submits that its *“photographic and cinematographic apparatus and instruments”* should be interpreted as including *“digital electronic devices (such as tablet computers, film projectors, digital screens)”*. The latter is not covered by the literal meaning of the former which is apparatus and instruments used in the processes of photography or cinematography which may not even be digital. A tablet computer may be able to take a photograph, but that does not make it a piece of photographic apparatus.”

30) The term “instructional and teaching apparatus and instruments” clearly covers items such as Van de Graf generators, Geiger counters and other similar scientific instrumentation. Whilst the goods covered by the opponent’s specification can be used as a teaching aid, I am not aware of a camera or film projector, for example, that is specifically for teaching use and no evidence relating to such has been filed. Therefore, if the applicant were to use its mark upon such goods as and then claim that it

had used its mark upon “instructional and teaching apparatus and instruments” it would not be accepted and the mark would be revoked in respect of such items. To my mind, there is no similarity between “instructional and teaching apparatus and instruments” and any item within the opponent’s specifications.

31) Moving onto the term “audio-visual teaching apparatus”, I fail to understand how these cannot be encompassed by the opponent’s term “apparatus for recording, transmission, reproduction of sound or images”. The applicant has failed to state what, other than the obvious items such as projectors, televisions, monitors, headphones, microphones, etc they are seeking to provide under this heading. The applicant states that “That submission appears to be premised on the basis that the instructional and teaching apparatus and instruments are electronic”. Given that the goods are in class 9 this seems an odd submission. I find that the applicant’s specification of “audio-visual teaching apparatus” **is identical** to the opponent’s specifications of “apparatus for recording, transmission, reproduction of sound or images”.

32) The next item for consideration is “computer hardware”. The opponent compares this to its Class 9 specification of “Apparatus for recording, transmission, reproduction of sound or images; batteries; cameras; computer software.” The opponent contends:

*“The term computer hardware comprises the physical parts of a computer system including inter alia the computer monitor and parts inside the computer such as the hard disk drive, batteries etc. The Opponent’s specification in Class 9 encompasses the physical parts of a computer system namely, a computer monitor, a computer battery, a computer printer, a computer camera etc. The Opponent’s ‘apparatus for recording, transmission, reproduction of sound or images; batteries; cameras’ is **closely similar** (if not identical) to ‘computer hardware’.*

*It is also submitted that there is similarity between the Opponent’s computer software and the Applicant’s computer hardware. The goods are dependent on one another for their operation; computer hardware cannot operate without software and vice versa. Although the nature of these goods may not be the same, software and hardware coincide in end user and producers. They are sold in the same outlets and all computer hardware is sold with some preinstalled software to ensure functionality of the hardware. It is submitted that computer hardware and computer software are **similar**.*

The Opponent notes that a similar reasoning was adopted by the Registrar in previous decisions and refers by way of example to SHOOT INTERNATIONAL LIMITED v Pedigree Group Limited, BL O-371-17, para 30.”

33) The earlier decision mentioned above stated the following:

“30. The contested *computer hardware* is most likely to be understood as meaning the physical components of which a computer system is made up. A *storage device* is defined as a piece of computer equipment in which information can be stored. The term would, in my view, include any computing hardware that is used for storing data, either internal, e.g. hard disk, or external, i.e. USB memory stick, to a computer. Consequently, I agree with the opponent that the contested *hardware* is broad enough to include the opponent’s *data storage devices* and goods are identical on the *Meric* principle. As computers need software and programs to operate, the contested *computer hardware* is also highly similar to the opponent’s *computer software* because the respective goods are complementary in the sense that one set of goods is indispensable for the use of the other and this is likely to lead the average customer to assume that the responsibility for the goods lies with the same undertaking. Although the nature and methods of use may be different, the users, intended purpose and distribution channels are likely to be the same. I therefore find that the applied for *computer hardware* is identical to the opponent’s *data storage devices* and highly similar to the opponent’s *computer software*.”

34) The applicant submits:

“There is no similarity between the goods. The Opponent’s submissions are, with respect, tenuous at best. As the Opponent accepts, the literal meaning of “*computer hardware*” is the physical components that a computer system requires to function. However, the very nature of computer hardware is that its functionality is dependent on software. For example, the hardware of a computer may include a camera or a microphone, but those components cannot be used to record sound or images other than as part of the complete computer unit. As such as a piece of computer hardware a camera or microphone is not an apparatus for recording sound or images, it only gains that functionality when combined with other pieces of hardware and software.

Therefore, it does not follow that because a computer as a whole unit (including all of the hardware and all of the software etc) can be used to record/transmit/reproduce sound or images does not mean there is similarity with “*apparatus for recording, transmission, reproduction of sound or images; batteries; cameras*”. There is no similarity between computer hardware and computer software. Although both are used in the creation of a complete computer system they are fundamentally different in nature. One is a physical component, the other is a set of data/codes etc.

35) Whilst I agree with the applicant that the physical natures of the goods are different it is inescapable that computer hardware relies upon software to work and vice versa. They are clearly complementary and similar to a medium degree.

36) The next item is the applicant’s specification of “Databases” which the opponent contends is similar to its “computer software”. The applicant submits that “A “*database*” is an organised collection of information or data. “*Computer software*” is a program that enables a computer to perform a specific task. There is no overlap in the literal meaning of those terms. The opponent’s submissions incorrectly rely on overly broad interpretations.” To my mind, a database is a collection of software and as such identical to the opponent’s goods.

37) The next item in the applicant’s class 9 specification is “Data communications equipment” which the opponent contends is at least similar to its “Apparatus for recording, transmission, reproduction of sound or images”. The applicant submits: “The nature, method of use and intended purpose of “*data communications equipment*” is different to “*apparatus for recording, transmission, reproduction of sound or images*”. The former refers to the devices of a communications network that connect a data source with its destination. For example, a computer modem is a common piece of data communication equipment. The Opponent’s submission that a mobile phone or tablet computer is a piece of data communication equipment is simply incorrect. In any case, telecommunication equipment does not fall within the natural meaning of the Opponent’s term”. Using the applicant’s own example of a modem, to my mind this is clearly a piece of apparatus which transmits sounds or images. I therefore find the goods to be identical.

38) I now turn to the class 35 services applied for by the applicant. The opponent does not oppose the following parts of this specification: “Providing business information via a website; risk management consultancy; business risk assessment services; business consulting; business research; business

management; business administration; business information; business data analysis services; commercial information; statistics (compilation of); statistical business and commercial information; management and compilation of computerized databases; collection and systemization of business data; market research and studies; accounting; advertising; consultancy, information and advisory services relating to all the aforesaid services”.

39) The opponent points to a variety of goods in its class 9 specification and contends:

“There is established case law that retail services concerning the sale of specific goods are similar to an average degree to those specific goods. Retail services and the goods retailed are complementary; the services are provided in the place where the goods are offered for sale. They are also directed at the same public. The public will inevitably associate similar marks used for these goods and services. The Applicant’s contested services relates to the retail of its Class 9 goods. The Opponent has already made submissions on the parties’ goods in Class 9 being identical and similar. It is submitted that the retail of the Applicant’s Class 9 goods is also **similar** to the Opponent’s goods in Class 9.”

40) I accept that in *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

41) Whilst in *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether

there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

42) However, on the basis of the European courts' judgments in *Sanco SA v OHIM* (Case C-411/13P) , and *Assembled Investments (Proprietary) Ltd v. OHIM* (Case T-105/05, at paragraphs [30] to [35] of the judgment), upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*, (Case C-398/07P) Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

43) The opponent has not addressed the issue of the retail services normally associated with its goods, let alone provided evidence of how such goods are usually retailed. In the absence of any such information I regard the applicant's retail services to be dissimilar to the opponent's goods in class 9.

44) I next turn to the applicant's services in class 38. The first group of services are: "Providing interactive on-line bulletin boards for the transmission of messages among computer users in the field

of education and training”. The opponent contends that these are similar to its class 41 services of “Educational and training services”. Its reasoning is:

“The Applicant’s services are important in the course of the delivery of education and training services by facilitating communication between (a) the educators and their students and (b) among the students. Bulletin boards are routinely used in the context of education services provided online, such as webinars and online lectures. These services form a standard part of typical education services provided online, particularly in higher education. To the extent these services are provided in the field of education and training they could be interpreted as originating from the same source. The services target the same end users, namely students and educators, and there is complementarity between the services. It is submitted that the services are **similar**.”

45) This is a ludicrous claim. One might as well claim that as tables, chairs and pencils are used in education then the manufacture of these are similar to education services. Many businesses use items and services, it does not mean that their business is the same or similar to the business providing said goods or services.

46) The next group of services in class 38 are “providing internet chatrooms, bulletin boards and discussion groups”. The opponent contends that if used in the fields of education and training then these services are similar to its class 41 services. I refer to my response in paragraph 45 above, these are not similar services.

47) The balance of the class 38 services applied for are: “electronic mail services; provision of user access to a global computer network; electronic transmission of data via computer and communication networks and via the Internet; telecommunications; transmission of radio and television programmes; cable transmission of programmes; transmission of telephone calls; data transmission; transmission and reception by data communications of messages, documents, images and voice communications, using data communications sites, addresses and domains; provision of network data communications services by providing and using multimedia networks and portals; information, consultancy and advisory services relating to the aforesaid services”. The opponent contends that its Class 9 goods of “apparatus for recording, transmission, reproduction of sound or images” are similar. The opponent contends:

“The contested services are clearly all telecommunication services allowing people to communicate with one another by remote means. The Opponent's apparatus for recording, transmission or reproduction of sound or images are apparatus and devices used to communicate audio or video information over a distance via radio waves, optical signals, etc., or along a transmission line. The term would cover goods capable of facilitating the communication of data (whether sound or video) such as a mobile phone. The contested services allow people to communicate with one another by remote means. The Opponent's goods make the delivery of these services possible. It is submitted that there exists a link between the Opponent's apparatus for recording, transmission and reproduction of sound or images and the Applicant's telecommunication services. These goods and services are **similar**, given their complementary character, and their purpose and distribution channels are the same. The public purchases a phone in the same establishment and at the same time it purchases a mobile phone service or a broadband service. This reasoning has been adopted by the EUIPO and confirmed by the Boards of Appeal in Case R 404/2017-1 Lahners LLC v Santillana Education, S.L., para 32-33. The Registrar previously adopted similar reasoning regarding the similarity between telecommunication services and apparatus for recording, transmission, reproduction of sound or images; the Opponent refers by way of example to Cream Holdings Limited v Karma Communications Group Limited BL O-26717, para 73-74. Telecommunication services were also held similar to telecommunication apparatus in Metron Technology Limited v Athenian Developments Ltd, BL O-523-17, para 29-31.

48) The applicant submitted: “There is no similarity between the contested services and the class 9 goods relied upon. The services do not have the same nature, method of use or intended purpose as the goods and are neither complementary nor competitive. The Opponent is, with respect, incorrect to say that “apparatus for recording, transmission, reproduction of sound or images” includes mobile phones, that interpretation goes far beyond the core of the possible meanings attributable to that term. However, even were that the case, the fact that a mobile phone may have functionality allowing a consumer to take a photo and also to send, for example, electronic mail, does not mean that a camera is similar to an electronic mail service”.

49) The cases quoted by the opponent are not completely on all fours with the instant case as the opponent is simplifying the issues in these cases to suit its own agenda. Unlike the cases quoted the opponent does not have telecommunications equipment as part of its specification. If the opponent wished to have such items registered it should have included them, although given it operates a university it is doubtful to say the least if such a registration will prevail if proof of use or revocation

action were to be taken. I am willing to accept that overall there is a degree of complementarity between the goods and services which makes them similar to a medium degree.

50) I next turn to the class 41 services and the applicant's specification of "Providing facilities for educational training". The opponent claims its class 41 services of "Educational and training services; university services" are similar. The opponent contends: "The contested services are clearly complementary as the provision of facilities for education and training is indispensable to the provision of the education and training services. The Opponent submits that the natural meaning of the contested term would be largely understood to mean establishments such as colleges and universities as well as their classrooms, lecture theatres, libraries etc. The Opponent's services will be provided in facilities such as classrooms, lecture halls etc. and the provision of said facilities is integral to the delivery of the Opponent's services. In addition to their complementarity, the parties' services share the same end user (students and educators attending the facilities in the course of receiving / delivering education and training), and will often be provided by the same undertakings i.e. a university providing education would also provide the facilities where the education service is delivered. It is submitted that the parties' services are **closely similar**."

51) I do not accept the opponent's submission that the provision of a building and other items is similar to providing educational services. Recent events have shown that educational services can be provided remotely without buildings being used, and the open university has taught by post for many years, whilst other providers merely rent space in convenient locations. The opponent's mark is registered for the provision of educational services not the buildings that such courses might be taught in. One merely has to ask the question of whether use of the opponent's mark in providing buildings for educational services would preserve their registration for educational services to realise the answer is that there is no similarity between the services.

52) Next I compare the applicant's services in class 41 of "Arranging and conducting competitions" with the opponent's class 41 services of "provision of sporting, entertainment and cultural activities and events". The applicant submitted "There is no similarity between the services. Contrary to the Opponent's submissions they do not have the same nature, method of use or intended purpose and are neither complementary nor competitive. The nature / purpose of a competition is a contest of luck or skill where two or more parties, only one of which can be successful, seek to achieve the same goal. An entertainment activity is one which gives pleasure or enjoyment. A cultural activity is

something which enhances a party's intellectual or social development. A sporting activity is an athletic activity requiring skill which may or may not be competitive. As such, whilst there may be a degree of overlap between those services they do not fall within one another. For example, not all sporting events are competitions and not all competitions are sporting events. Insofar as there is similarity it is submitted that the degree of similarity is low". Clearly, the applicant is missing the point here. Sporting, entertainment and cultural activities can also be competitive. Although I accept that they need not include a competitive element it is clear that they both can and do include such an element on occasion. The opponent's services therefore encompass those of the applicant, and they are identical.

53) Next are the applicant's class 41 services of "Production of educational sound and video recordings" which the opponent claims are similar to its class 9 goods of "Sound recordings; video recordings" and its class 41 services of "Educational and training services". The opponent submits:

"There is a close relationship between sound and video recordings and the production of said recordings. The goods and services coincide in their providers and distribution channels. They also target the same end users. The Opponent's 'sound recordings; video recordings' include educational sound and video recordings; the Opponent is an educational institution and its sound and video recordings would be of an educational nature. It is submitted that the Applicant's 'production of educational sound and video recordings;' is **similar** to the Opponent's 'sound recordings; video recordings' in Class 9. Further, it is submitted that the contested service is **similar** to the Opponent's 'educational and training services. Educational institutions routinely produce and supply audio visual recordings of lectures, seminars and other educational activities. The services target the same end users, namely individuals seeking education, and have the same purpose. They coincide in their providers and distribution channels".

54) The manufacture of sound and video recordings in class 9 requires no more than the correct machinery to duplicate a master version onto however many copies are required, and then package them for the market. The applicant in its class 41 service is providing production services which are the means of producing the master or original copy. Such services are highly specialised and usually require face to face meetings to ensure that the provider is suitable for the task in hand, such as their creativity or special effects ability. The opponent's goods are not similar to the services of the applicant. Similarly, education and training services do not cover production services.

55) Finally, we come to the end of the applicant's opposed class 41 specification and the contention by the opponent that the applicant's "Rental of educational materials; rental of recorded education" are similar to its services of "Lending libraries and library services". The applicant submitted:

"The services are dissimilar. The terms must be interpreted by reference to their literal meanings and as being confined to the core of the possible meanings attributable to them. A library is a curated collection of sources of information and resources for consumers to access, read, use and borrow. It is submitted that the core meaning of the terms is therefore providing consumers access to a collection of such materials across a range of different topics. On the other hand, it is submitted that the natural meaning of "*rental of educational materials; rental of recorded education*" is the provision of a service whereby consumers can pay for access to specific educational content. Whilst it may be possible to borrow educational materials from a library it is submitted that this high level of overlap is not sufficient to confer similarity."





56) It is obvious that the opponent's library services would encompass the rental of educational materials in whatever form. There is no law forbidding libraries from charging for access to material or for loaning it out for set periods of time. Indeed, most libraries do have a system of charging for certain items and have done so for many years. Therefore, I find that the opponent's services encompass those of the applicant and are identical.

Comparison of trade marks

57) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

Opponent's trade marks		Applicant's trade mark
3380220	<p>ULAW</p> <p>ULaw</p> <p>A series of two trade marks</p>	<p>3383097</p> 
EU 012042636		3383089
EU 12042685	 <p>Colours Claimed / Indication: Petrol Blue "Pantone 314"; Purple "Pantone 254".</p>	

59) I shall first compare the opponent's mark 3380220 (ULAW) to the applicant's mark 3383097 (UNILAW & device). The opponent submitted:

“UniLaw is the visually dominant element of the contested mark, the tag line ‘GET INTO LAW SCHOOL’ is diminutive and merely underlines the superior element UniLaw. The scales of justice device is small and does not suffice to distance the marks. Aurally, the ULAW and UNILAW marks are closely similar. The pronunciation of ‘U’ dominates the beginning of both marks, LAW will be pronounced identically in the marks. The scales of justice device in the UniLaw Logo will not be pronounced. The tag line GET INTO LAW SCHOOL is unlikely to be vocalised as it is just a promotional slogan. Conceptually, the ULAW and UNILAW marks coincide in the LAW element, which will be understood in identical fashion in both marks. Further, the University provided evidence that (a) ULAW will be associated with the University and THE UNIVERSITY OF LAW and (b) the UNI- prefix [in UNILAW] will be interpreted as a shortening of ‘university’. Both marks may be interpreted as alluding to universities in the field of law. The tag line GET INTO LAW SCHOOL emphasises the possible interpretation of UNILAW as ‘university law’”.

60) Whilst the applicant submitted:

“As a general rule words have a greater impact than devices in a figurative mark because a consumer’s eye will naturally be drawn to verbal elements. However, the figurative elements cannot be ignored and, it is submitted, the stylisation and device element of the Applicant’s mark further enhance the visual dissimilarity between the marks. As well as the words UNILAW the Applicant’s figurative mark contains the words “GET INTO LAW SCHOOL”. Whilst it is accepted that this slogan is of low distinctiveness within the mark its impact is not negligible. As well as enhancing the aural dissimilarity this element of the Applicant’s mark is important in respect of the conceptual comparison of the marks in issue. The Applicant submits that these words give the mark a very clear conceptual meaning that the purpose of the goods/services being offered under and/or by reference to the mark are to assist consumers with applying to law school. This further distinguishes the Applicant’s mark conceptually from the Opponent’s mark.”

61) Although the opponent’s mark is a series of two marks the only difference between them is that one is in upper case and the other is a mixture of upper and lower case. In the instant case I do not believe that the differences are such that they make a change to the way the marks are viewed and neither side has commented on this issue. I shall therefore carry out a single comparison test using just one of the opponent’s marks. Similarly, the use of colour in the applicant’s mark is not claimed in its registration and again neither side comments upon it and so I shall treat the mark as if it were black and white. The opponent’s mark consists of the letters “U”, “L”, “A” and “W”. The word “ULAW” is meaningless and will not, despite the claims by the opponent, be seen by the average consumer as shorthand for the University of Law. Visually both marks begin with the letter “U” and contain the word “LAW”. However, there are a number of differences, such as the scales device at the start of the mark, the fact that the applicant’s mark is effectively made up of two words “uni” and “law”. The word “uni” has a dictionary meaning of “one, or single” as in unicycle / unicorn etc. I am also willing to accept that it is used as a shorthand form of the word university. The applicant’s mark also has the strapline which is very visible and informs the reader of the nature of the applicant’s underlying service. Aurally the marks begin the same with the “u” sound but differ completely thereafter. Conceptually, anyone unfamiliar with the opponent’s mark will be bemused by the mark and have no clue what the goods or services offered are all about. The applicant’s mark clearly indicates that the user will assist one to get into studying law at a university or college. Overall there is a very small amount of similarity which is far outweighed by the differences. I therefore conclude that there is a very low degree of similarity between the marks.

62) I next turn to consider the opponent's mark 3380220 (ULAW) to the applicant's mark 3383089 (UNILAW). The opponent contended.

“Visually, the ULAW and UNILAW marks have considerable similarity: Both start with the letter ‘U’, share the suffix ‘LAW’ and are of similar length. The letters ‘N’ and ‘I’ are in lower case in the contested mark, positioned between the capitalised ‘U’ and ‘L’ letters. ‘N’ and ‘I’ are not visually prominent in UniLaw. Aurally, the ULAW and UNILAW marks are closely similar. The pronunciation of ‘U’ dominates the beginning of both marks, LAW will be pronounced identically in the marks. Conceptually, the ULAW and UNILAW marks coincide in the LAW element, which will be understood in identical fashion in both marks. Further, the University provided evidence that (a) ULAW will be associated with the University and THE UNIVERSITY OF LAW and (b) the UNI- prefix [in UNILAW] will be interpreted as a shortening of ‘university’. Both marks may be interpreted as alluding to universities in the field of law. “

63) The applicant submitted:

“21. Nothing turns on the different casing of the two marks in the Opponent's series of marks because a word trade mark protects notional use of the word itself irrespective of capitalisation. As such, the two marks in the series are not distinguished herein and are referred to in the singular.

22. It is well established that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The overall impression of both marks therefore resides in the words themselves. However, it is also well established that consumers are naturally drawn to elements of trade marks that they recognise and will therefore break down a word mark into elements which resemble words that they recognise.

23. Both UNILAW and ULAW are neologisms with no definitive meaning in the English language. However, the Applicant's mark follows a linguistic rule that would be understood by English speaking consumers such that the neologism would be perceived in a particular way. This is a case where the neologism is more than the mere sum of its parts.

24. Both marks contain, and end with, the word LAW which is a common and recognisable word to English speaking consumers and is likely to be recognised as such. Furthermore,

it is descriptive of a characteristic of the goods and services in issue. It therefore has a low inherent distinctiveness in relation to the goods and services in issue.

25. The other element of the Applicant's mark is itself a recognisable word in the English language – "UNI". The Opponent submits that UNI is an informal short for University. When used solus it is accepted that one (although not the only - it can, for example, also mean "unique" or "universal") meaning of the word is as an abbreviation for University.

26. However, when UNI is used as a prefix in the formation of a compound word its recognised meaning in the English language is 'a single one', for example unicycle, unilateral etc. As such, in the Applicant's submission, this is the way the word UNI would be perceived in the Applicant's mark. Even to those consumers who perceive UNI, used solus, as meaning University there is a perceptible difference between the neologism UNILAW and the separate elements Uni and Law.

27. It is therefore submitted that whilst consumers would naturally break down the Applicant's mark into the words UNI and LAW that mark, and its meaning, would be perceived as a whole based on usual linguistic principles of compound words starting with the word UNI. In this context the word UNI, meaning "one", and the neologism UNILAW (which would be perceived as meaning "one law") has no particular descriptive meaning for the relevant goods and services and has normal inherent distinctiveness.

28. On the other hand, in the Opponent's mark the word LAW is preceded by a single letter with no discernible meaning. As such, whilst consumers may break that mark down into the elements U and LAW the letter U does not change the meaning of the word LAW and the Opponent's mark as a whole is of very low inherent distinctiveness.

29. It is accepted that there is some visual and aural similarity between the marks as a result of the same first letter 'U' and the same ending "LAW". However, the degree of similarity is low.

30. The Applicant's mark is visually longer and consists of three syllables (U-NI-LAW) as opposed to the two syllables (U-LAW) of the Opponent's mark.

31. Furthermore, although consumers usually place more attention on the beginning of a trade mark, and this is likely to be the case in respect of the Applicant's mark, particularly given that the UNI element is the dominant and distinctive component as addressed above, it is submitted that the Opponent's mark is an exception to this general rule. In respect of the mark ULAW a consumer's attention will be drawn to the recognisable word LAW rather than the single, letter U that precedes it.

32. Conceptually there is a degree of similarity as a result of the word LAW appearing in both marks. However, for the reasons addressed above, whereas consumers would perceive the Applicant's mark as alluding to "one law" no such concept would be perceived from the Opponent's mark. In respect of the Opponent's mark it is submitted that on a conceptual level either consumers will attribute no meaning to the letter U such that the mark will be perceived simply as alluding to law or, alternatively, they will perceive it as alluding to "you" or "your" as in "you law" or "your law". Given that the prefixes of the signs have different semantic meanings it is submitted that the conceptual similarity between the marks is low.

33. Insofar as the Opponent is contending that there is a conceptual similarity between the marks because both allude to university this is not borne out by the evidence. The Applicant's mark would not be perceived as alluding to university for the reasons addressed above and, even if it were, there is no support for an argument that the U in ULAW would be perceived by consumers as alluding to "university" when that mark is used in a trade mark sense as opposed to it being used descriptively as a defined abbreviation for the University of Law."

64) Visually both marks start with the letter "U" and end in "LAW", however, the opponent's mark is only four letters long whereas the applicant's is six letters, in terms of short marks a fifty percent increase is significant. Aurally the marks have the same start in the letter "U" and the same ending but differ considerably in the middle section. Conceptually anyone unfamiliar with the opponent's mark will be bemused by the mark and have no clue what the goods or services offered are all about. The applicant's mark is effectively made up of two words "uni" and "law". The word "uni" has a dictionary meaning of "one, or single" as in unicycle / unicorn etc. I am also willing to accept that it is used as a shorthand form of the word university. **Overall there is a low to medium degree of similarity.**

65) I next turn to compare the opponent's EU marks 012042636 & 12042685 to the applicant's mark 3383097. As the opponent's EU marks are identical apart from the colour claim on 12042685, I shall carry out a single comparison test using the black and white mark as this provides the opponent with its strongest case. The opponent contended "There is visual similarity between THE UNIVERSITY OF LAW and the UNILAW marks. The appearance of LAW in colour in both marks is a point of similarity in the stylisation of THE UNIVERSITY OF LAW logos and the UniLaw logo. There is some phonetic similarity between THE UNIVERSITY OF LAW and the UNILAW marks resulting from the pronunciation of the UNI- prefix, encompassed in the pronunciation of UNIVERSITY, and of the common element LAW. THE UNIVERSITY OF LAW and UNILAW marks are conceptually closely similar because of the UNI- prefix will be understood as a reference to 'university'. The UNILAW marks will be understood as 'university law'.

66) The applicant submitted:

"36. It is submitted that the stylisation and presentation of the Opponent's marks are so minimal in nature that they do not endow the mark with any distinctive character over and above that provided by the words themselves. Indeed, this was the conclusion reached by the EUIPO when considering the registrability of the marks.

37. THE UNIVERSITY OF LAW is clearly an understandable phrase in the English language which is descriptive in terms of its primary and obvious definition – being a University providing legal training. It was for this reason that the marks were refused registration for class 41 services (see EUIPO decisions at RVK1). Whilst the mark may have overcome the requirement to possess a degree of inherent distinctive character so as to proceed to registration in respect of the goods in classes 9 and 16 for which it is registered it is submitted that the degree of inherent distinctiveness that it possesses is extremely low.

38. Visually and aurally there is very little similarity between the marks UNILAW and THE UNIVERSITY OF LAW, the Opponent's mark is comprised of four words and eight syllables, as opposed to the single word and three syllables of the Applicant's mark. The only similarity is the fact that UNI and LAW appear in both marks, however, in the Opponent's mark these elements not only appear in separate words but they are separated by another word and UNI is part of the recognisable word UNIVERSITY.





39. There is a very low degree of conceptual similarity between the marks. The Opponent's mark clearly alludes to a University providing legal education whereas, as discussed above, the Applicant's mark alludes to the concept of "one law".

67) The opponent's point regarding colour is without foundation as the applicant's mark can be used in black and white. The mere fact that the word LAW in both marks appears in colour would not be viewed as indicating they are from the same source in the minds of the average consumer. The opponent's mark begins with the definite article which is often overlooked but in the instant case it marks out the subject as being the original or definitive university. Visually there is the similarity of the end word "law" and the fact that the first part of the applicant's mark are also the first three letters of "University" in the opponent's mark. The differences are very obvious and numerous. The same is also true of the aural comparisons, with similarities being scant and differences numerous. The opponent contends that the conceptual similarities will be seen by the average consumer. Even if I accepted the opponent's view that the applicant's mark would be seen as "university law" it is still just a general topic which is taught at innumerable colleges and universities around the globe. It does not relate to an actual teaching facility whereas the opponent's mark does. **Overall, there is a very low level of similarity.**

68) Finally, I turn to consider the opponent's mark EU 012042636 (The University of LAW) to the applicant's mark 3383097 (UNILAW and device). The opponent's and applicant's submissions have been previously set out in these comparison tests. The only exception being the applicant's additional comment that: "Furthermore, the aural and conceptual differences are further enhanced as a result of the inclusion of the words GET INTO LAW SCHOOL in the Applicant's mark as addressed above. The Applicant's mark alludes to the concept of the application process for law school whilst the Opponent's marks allude to the concept of the university itself."

69) Visually and aurally there are very obvious differences which far outweigh the small amount of similarity. To my mind, the device of the scales and the strap line cannot be disregarded as suggested by the opponent. I also am not convinced by the contention that the word UNI will immediately be seen as meaning University, although I accept that some may see it this way. Conceptually the opponent's mark proudly proclaims itself (rightly or wrongly) as the original university teaching law or the definitive university teaching law. The applicant's mark makes it clear they exist to aid the student into whatever law school, college or university they are seeking to attend. **Overall, there is a very low almost non-existent degree of similarity.**

70) My findings in summary are:

Opponent's mark		Applicant's mark		Result
3380220	ULAW	3383097		Very low degree of similarity.
3380220	ULAW	3383089	UNILAW	Overall there is a low to medium degree of similarity.
EU 12042636		3383097		Overall, there is a very low almost non-existent degree of similarity
EU 12042636		3383089	UNILAW	Overall, there is a very low level of similarity.

Distinctive character of the earlier trade mark

71) 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).”

72) The opponent's mark ULAW (3380220) has no meaning that I am aware of in respect of the goods and services for which it is registered. To my mind, it **has an average degree of inherent distinctiveness**. The opponent has provided some evidence of use, but only in relation to its teaching services and even then, its use is usually following the use of the opponent's full name, and as such it is not achieving distinctiveness on its own volition. Because the evidence of use includes evidence of use of the opponent's other mark in promoting its educational services the mark ULAW **cannot benefit from an enhanced degree of distinctiveness through use in relation to the goods and services for which its mark is registered.**

73) The opponent's other marks (the University of LAW EU 012042636 & EU 12042685) are only registered for goods in classes 9 and 16. Use of the mark on items such as books and instruments will suggest that these have academic approval or are somehow "authorised". The marks have a low level of distinctiveness for such goods and due to the complete absence of any evidence of use on such goods **cannot benefit from an enhanced degree of distinctiveness through use in relation to the goods for which its mark is registered.**

Likelihood of confusion

74) 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 trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade marks as the more distinctive the trade mark is, the greater the likelihood of confusion. 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 trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods and services is a member of the general public including businesses who will select the goods and services by predominantly visual means, although I do not discount aural considerations. The level of attention paid will vary and I have set out in the following table what those levels will be for the various groups of goods and services.

Goods and services	Level of attention paid:
In Class 9: Downloadable publications; electronic publications; audio visual recordings; pre-recorded CDs; pre-recorded DVDs; CD-ROMs, DVDs; videos; media content;	Low to Medium
In Class 9: pre-recorded software; instructional and teaching apparatus and instruments; audiovisual teaching apparatus; education software; downloadable educational course materials; computer software; application software; computer hardware; databases; data communications equipment; parts and fittings for all the aforesaid goods.	Medium to high
In Class 35: retail services connected with the sale of downloadable publications, electronic publications, audio visual recordings, pre-recorded CDs, pre-recorded DVDs, CD-ROMs, DVDs, videos, media content;	Low to Medium
In Class 35: Providing business information via a website; risk management consultancy; business risk assessment services; business consulting; business research; business management; business administration; business information; business data analysis services; commercial information; statistics (compilation of); statistical business and commercial information; management and compilation of computerized databases; collection and systemization of business data; market research and studies; accounting; advertising; retail services connected with the sale of pre-recorded software, instructional and teaching apparatus and instruments, audiovisual teaching apparatus, education software, downloadable educational course materials, computer software, application software, computer hardware, databases, data communications equipment, parts and fitting for the aforesaid goods; consultancy, information and advisory services relating to all the aforesaid services.	Medium to high
In Class 38: Providing interactive on-line bulletin boards for the transmission of messages among computer users in the field of education and training; electronic mail services; provision of user access to a global computer network; providing internet chatrooms, bulletin boards and discussion groups; electronic transmission of data via computer and communication networks and via the Internet; telecommunications; transmission of radio and television programmes; cable transmission of programmes; transmission of telephone calls; data	Medium to high

transmission; transmission and reception by data communications of messages, documents, images and voice communications, using data communications sites, addresses and domains; provision of network data communications services by providing and using multimedia networks and portals; information, consultancy and advisory services relating to the aforesaid services.	
In Class 41: electronic publishing; publications (not downloadable) from databases or the Internet;	Low to Medium
In Class 41: Education and instruction; educational and teaching services; provision of education services; providing of training, teaching and tuition; provision of online training; arranging teaching programmes; provision of education courses; providing facilities for educational training; publication of educational teaching materials; production of educational sound and video recordings; rental of educational materials; rental of recorded education; provision of education on-line from a computer database or via the internet or extranets; arranging and conducting conferences, seminars, exhibitions and competitions; consultancy, information and advisory services relating to all the aforesaid services.	Medium to high

- the opponent's mark (3380220) has an average degree of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use. The opponent's marks EU 012042636 & EU 12042685 have a low degree of distinctiveness and cannot benefit from an enhanced distinctiveness through use.
- the goods of the two parties range in similarity from identical to not similar, as shown below, firstly, when compared to the applicant's UK mark 3380220:

Class	Identical	Similar to medium degree	Not similar
9	Downloadable publications; electronic publications; audio visual recordings; pre-recorded software; pre-recorded CDs; pre-recorded DVDs; education software; computer software; application software; CD-ROMs, DVDs; videos; downloadable educational course materials; media content; audiovisual teaching apparatus; databases; data	computer hardware; parts and fittings for all the aforesaid goods.	instructional and teaching apparatus and instruments; parts and fittings for all the aforesaid goods.

	communications equipment; parts and fittings for all the aforesaid goods.		
35	None	None	Providing business information via a website; risk management consultancy; business risk assessment services; business consulting; business research; business management; business administration; business information; business data analysis services; commercial information; statistics (compilation of); statistical business and commercial information; management and compilation of computerized databases; collection and systemization of business data; market research and studies; accounting; advertising; retail services connected with the sale of downloadable publications, electronic publications, audio visual recordings, pre-recorded software, pre-recorded CDs, pre-recorded DVDs, instructional and teaching apparatus and instruments, audiovisual teaching apparatus, education software, downloadable educational course materials, computer software, application software, computer hardware, CD-ROMs, DVDs, videos, media content, databases, data communications equipment, parts and fitting for the aforesaid goods; consultancy, information and advisory services relating to all the aforesaid services".
38	None	electronic mail services; provision of user access to a global computer network; electronic transmission of data via computer and communication networks and via the Internet; telecommunications; transmission of radio and television programmes; cable transmission of programmes; transmission of telephone calls; data transmission; transmission and reception by data communications of	Providing interactive on-line bulletin boards for the transmission of messages among computer users in the field of education and training; Providing internet chatrooms, bulletin boards and discussion groups.

		messages documents, images and voice communications, using data communications, sites, addresses and domains; provision of network data communications services by providing and using multimedia networks and portals; information, consultancy and advisory services relating to the aforesaid services.	
41	Education and instruction; educational and teaching services; provision of education services; providing of training, teaching and tuition; provision of online training; arranging teaching programmes; provision of education courses; electronic publishing; publication of educational teaching materials; provision of education on-line from a computer database or via the internet or extranets; arranging and conducting conferences, seminars, exhibitions and competitions; rental of educational materials; rental of recorded education; consultancy, information and advisory services relating to all the aforesaid services.	publications (not downloadable) from databases or the Internet;	providing facilities for educational training; production of educational sound and video recordings; consultancy, information and advisory services relating to all the aforesaid services.





And when compared to the opponent's EU marks 012042636 & 12042685:

Class	Identical	Similar to a medium degree	Not similar
9	Downloadable publications; electronic publications; audio visual recordings; pre-recorded software; pre-recorded CDs; pre-recorded DVDs; education software; computer software; application software; CD-ROMs, DVDs; videos; media content;	computer hardware; parts and fittings for all the aforesaid goods.	instructional and teaching apparatus and instruments; parts and fittings for all the aforesaid goods.

	downloadable educational course materials; audiovisual teaching apparatus; databases; data communications equipment; parts and fittings for all the aforesaid goods.		
35	None	None	Providing business information via a website; risk management consultancy; business risk assessment services; business consulting; business research; business management; business administration; business information; business data analysis services; commercial information; statistics (compilation of); statistical business and commercial information; management and compilation of computerized databases; collection and systemization of business data; market research and studies; accounting; advertising; retail services connected with the sale of downloadable publications, electronic publications, audio visual recordings, pre-recorded software, pre-recorded CDs, pre-recorded DVDs, instructional and teaching apparatus and instruments, audiovisual teaching apparatus, education software, downloadable educational course materials, computer software, application software, computer hardware, CD-ROMs, DVDs, videos, media content, databases, data communications equipment, parts and fitting for the aforesaid goods; consultancy, information and advisory services relating to all the aforesaid services”.
38	None	electronic mail services; provision of user access to a global computer network; electronic transmission of data via computer and communication networks and via the Internet; telecommunications; transmission of radio and television programmes; cable transmission of programmes; transmission of telephone calls; data transmission; transmission	Providing interactive on-line bulletin boards for the transmission of messages among computer users in the field of education and training; Providing internet chatrooms, bulletin boards and discussion groups.

		and reception by data communications of messages documents, images and voice communications, using data communications, sites, addresses and domains; provision of network data communications services by providing and using multimedia networks and portals; information, consultancy and advisory services relating to the aforesaid services.	
41	None	None	All

- My findings on the similarity of the marks are as follows:

Opponent's mark		Applicant's mark		Result
3380220	ULAW	3383097		Very low degree of similarity.
3380220	ULAW	3383089	UNILAW	Overall there is a low to medium degree of similarity.
EU 12042636		3383097		Overall, there is a very low almost non-existent degree of similarity
EU 12042636		3383089	UNILAW	Overall, there is a very low level of similarity.

75) I must also consider the issue of indirect confusion which was set out in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“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.

76) In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

77) I also note that in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

78) Therefore, where I have found no similarity in the goods and services there can be no confusion. The opposition under section 5(2)(b) therefore fails in respect of the following goods and services in respect of both of the applicant's marks:

- Class 9: instructional and teaching apparatus and instruments; parts and fittings for all the aforesaid goods.
- Class 35: Providing business information via a website; risk management consultancy; business risk assessment services; business consulting; business research; business management; business administration; business information; business data analysis services; commercial information; statistics (compilation of); statistical business and commercial information; management and compilation of computerized databases; collection and systemization of business data; market research and studies; accounting; advertising; retail services connected with the sale of downloadable publications, electronic publications, audio visual recordings, pre-recorded software, pre-recorded CDs, pre-recorded DVDs, instructional and teaching apparatus and instruments, audiovisual teaching apparatus, education software,

downloadable educational course materials, computer software, application software, computer hardware, CD-ROMs, DVDs, videos, media content, databases, data communications equipment, parts and fitting for the aforesaid goods; consultancy, information and advisory services relating to all the aforesaid services”.

- Class 38: Providing interactive on-line bulletin boards for the transmission of messages among computer users in the field of education and training; Providing internet chatrooms, bulletin boards and discussion ups.
- Class 41: Providing facilities for educational training; production of educational sound and video recordings; consultancy, information and advisory services relating to all the aforesaid services.

79) I first consider the opponent's marks EU 12042636 & EU 12042636 and compare them to both the opponent's marks. As stated earlier there is a very low level of similarity between either of the opponent's marks and the marks in suit. As such and allowing for the concept of imperfect recollection, even when the applicant's marks are used on goods and services which are identical such as “downloadable publications” in class 9 where the level of attention paid by the average consumer will be low to medium there is no likelihood of consumers being directly or indirectly confused into believing that the goods applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it. It stands to reason therefore that the goods and services which are less similar or where the average consumer will pay more attention to selection will also not cause confusion. **The opposition under Section 5(2) (b) therefore fails in respect of all the goods and services sought to be registered.**

80) I now turn to consider the opponent's series of two marks under number 3380220 to the applicant's mark 3383097. As stated earlier there is a very low level of similarity between either of the opponent's marks and the mark in suit. As such and allowing for the concept of imperfect recollection, even when the applicant's marks are used on goods and services which are identical such as “downloadable publications” in class 9 where the level of attention paid by the average consumer will be low to medium there is no likelihood of consumers being directly or indirectly confused into believing that the goods applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it. It stands to reason therefore that the goods and services which are less similar or where the average consumer will pay more attention to selection will also not cause

confusion. **The opposition under Section 5(2) (b) therefore fails in respect of all the goods and services sought to be registered.**

81) Lastly, I turn to consider the opponent's mark 3380220 to the applicant's mark 3383089. Earlier in this decision I found these marks to have a low to medium degree of similarity. As such and allowing for the concept of imperfect recollection, when the applicant's mark is used on goods and services which are identical such as "downloadable publications" in class 9 where the level of attention paid by the average consumer will be low to medium there is a likelihood of consumers being directly or indirectly confused into believing that the goods and services applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it. However, even where there is identity between the goods or services of the two parties and the level of attention paid by the average consumer is at a medium level or above then there will be no confusion. Therefore, the opposition is successful in respect of the following goods and services:

- In Class 9: Downloadable publications; electronic publications; audio visual recordings; pre-recorded CDs; pre-recorded DVDs; CD-ROMs, DVDs; videos; media content;
- In Class 41: electronic publishing;

82) And the opposition under section 5(2)(b) fails in relation to these goods and services:

- In Class 9: pre-recorded software; audiovisual teaching apparatus; education software; downloadable educational course materials; computer software; application software; computer hardware; databases; data communications equipment; parts and fittings for all the aforesaid goods.
- Class 35: retail services connected with the sale of downloadable publications, electronic publications, audio visual recordings, pre-recorded CDs, pre-recorded DVDs, CD-ROMs, DVDs, videos, media content; Providing business information via a website; risk management consultancy; business risk assessment services; business consulting; business research; business management; business administration; business information; business data analysis services; commercial information; statistics (compilation of); statistical business and commercial information; management and compilation of computerized databases; collection and systemization of business data; market research and studies; accounting; advertising;

retail services connected with the sale of pre-recorded software, instructional and teaching apparatus and instruments, audiovisual teaching apparatus, education software, downloadable educational course materials, computer software, application software, computer hardware, databases, data communications equipment, parts and fitting for the aforesaid goods; consultancy, information and advisory services relating to all the aforesaid services.

- In Class 38: Providing interactive on-line bulletin boards for the transmission of messages among computer users in the field of education and training; electronic mail services; provision of user access to a global computer network; providing internet chatrooms, bulletin boards and discussion groups; electronic transmission of data via computer and communication networks and via the Internet; telecommunications; transmission of radio and television programmes; cable transmission of programmes; transmission of telephone calls; data transmission; transmission and reception by data communications of messages, documents, images and voice communications, using data communications sites, addresses and domains; provision of network data communications services by providing and using multimedia networks and portals; information, consultancy and advisory services relating to the aforesaid services.
- In Class 41: Education and instruction; educational and teaching services; provision of education services; providing of training, teaching and tuition; provision of online training; arranging teaching programmes; provision of education courses; providing facilities for educational training; publication of educational teaching materials; production of educational sound and video recordings; rental of educational materials; rental of recorded education; provision of education on-line from a computer database or via the internet or extranets; arranging and conducting conferences, seminars, exhibitions and competitions; publications (not downloadable) from databases or the Internet; consultancy, information and advisory services relating to all the aforesaid services.

83) I next turn to the ground of opposition under section 5(3) of the Act which reads:

“(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 the repute of the earlier trade mark.”

84) 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, *Addidas-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; *Addidas 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*).

85) I must firstly consider whether the opponent has met the test for reputation. In *General Motors*, 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.”

86) The opponent relies solely upon its mark UK 3380220 under this ground. In its evidence the opponent gave some instances of use of this mark in relation to university services. However, the use was usually after the full name of the opponent had been stated and thereafter shortened in the interests of brevity by the writer of the various articles. The opponent did not provide turnover figures, numbers of students etc which relate solely to use of this mark. As such the opponent has failed at the first hurdle in that it has not established that it has a reputation in the trade mark ULAW for a set of goods and/or services. **The opposition under section 5(3) fails.**

87) Lastly, I turn to the ground of opposition under section 5(4)(a) which reads:

“(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, where the condition in subsection (4A) is met,

(aa)

(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.”

88) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, 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, 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).”

89) Whilst 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.”

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.”

90) I must first consider the relevant date. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM O-212-06* Mr Allan 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 have been any different at the later date when the application was made.’ ”

91) The applicant has not provided any evidence of use prior to the application date, 13 March 2019, which is therefore the relevant date. I must next consider whether the opponent has shown it has goodwill. In *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL) it was stated:

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

92) In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

93) However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in

the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

94) The opponent contended:

“There has been longstanding use under the ULAW and THE UNIVERSITY OF LAW mark in the UK in relation to education and university services.

35. The University provided references of the earlier marks in the UK press and social media. The earlier marks have also been used to advertise and promote the University’s services in the UK.

36. The University demonstrated use of THE UNIVERSITY OF LAW for education and university services. The Directors’ report and financial statements for the period ended 30 November 2018 [Lysette Guana 1, Exhibit LG1] refers to the services offered by the University and confirms that these services were offered in the UK within the relevant period.

37. THE UNIVERSITY OF LAW and ULAW appear in advertising campaigns in national and regional UK newspapers before the filing date of the Applications [Lysette Guana 1, Exhibit LG2] and in independent and paid for editorial [Lysette Guana 1, Exhibit LG4 and Lysette Guana 2, Exhibits LG14, LG15]. There is also use on press releases [Lysette Guana 1, Exhibit LG6] and as a social media handle on the University’s YouTube [Lysette Guana 1, Exhibit LG9] and Twitter [Lysette Guana 1, Exhibit LG9 and Lysette Guana 2, Exhibit LG20] social media accounts.

38. ULAW is used as a handle (e.g. @ULawStudents, @ULawLibraries) on social media accounts of the University and entities linked with the University, such as the University’s Student Association and Library Services [Lysette Guana 2, Exhibit LG20].

39. A significant portion of prospective, existing and past students of the University would be familiar with the ULAW mark. Its use since at least 2014 amounts to a significant and protectable goodwill in relation to education and university services.

40. It is also indisputable that the University enjoys goodwill in THE UNIVERSITY OF LAW in relation to education and university services.”

95) Whilst the applicant submitted:

“60. Those services have not been considered thus far in the context of the sign THE UNIVERSITY OF LAW because they fall within class 41 and are therefore not protected by the Opponent’s THE UNIVERSITY OF LAW trade marks. As addressed above, the applicant sought to register THE UNIVERSITY OF LAW marks for class 41 services but the applications were rejected by the EUIPO as descriptive and/or non-distinctive of those services.

61. In other words, the Opponent seeks to rely on unregistered rights in the sign THE UNIVERSITY OF LAW in respect of which the EUIPO has concluded that it is not entitled to equivalent registered rights. In the Applicant’s submission, as a matter of principle, where a party is not entitled to a registered trade mark, so as to ensure that it does not have a monopoly right over descriptive signs or indications, it cannot be the case that it can in any case claim such a monopoly by relying on unregistered rights.

62. In the Applicant’s submission, the Opponent’s evidence does not establish that it has an actionable goodwill in the sign THE UNIVERSITY OF LAW. The evidence of use of that sign provided by the Opponent has been as a reference to the university itself. Furthermore, it has been purely descriptive of the purpose and/or characteristics of the services it offers. As such, the Opponent cannot have built up goodwill in THE UNIVERSITY OF LAW as an unregistered trade mark for such services.

63. However, insofar as the Tribunal disagrees and concludes that the Opponent has an actionable goodwill in the sign THE UNIVERSITY OF LAW in respect of class 41 type services the Applicant submits that use of its trade marks for the goods and services for which registration is sought would not in any case amount to a misrepresentation leading to deception or a likelihood of deception. This is clearly the case in respect of the Applicant’s goods in classes 9 and 16 which bear no similarity to the services for which the Opponent claims to have a goodwill in the sign, however, it is equally true of the Applicant’s class 41 services.

64. In particular, there is simply not enough similarity between the Applicant's UNILAW marks and the sign THE UNIVERSITY OF LAW for there to be misrepresentation and/or deception. In *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited*, Lord Simonds stated that:

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

65. The same applies in this case. The Opponent is seeking to unfairly monopolise the words UNIVERSITY, and any abbreviation of that word, and the word LAW. In the Applicant's submission it is not entitled to do so. Furthermore, the fact that there would be no misrepresentation by the Applicant's use of its signs is supported by the fact that there are a number of other third parties using the sign UNILAW in relation to legal services (see RVK4)."

96) Looking at the evidence filed it is not clear how much of the revenue produced relates to the UK as opposed to internationally via the on-line teaching and overseas campuses. Similarly, the student numbers are not solely related to the UK. The onus is on the opponent to make its case, and it was clearly possible for the opponent to provide accurate figures relating to the use of the sign UNIVERSITY OF LAW in the UK. In the same vein it is not clear what if any of the activities can be attributed to the sign ULAW. Even if I were to accept that the opponent had used its sign UNIVERSITY OF LAW in the UK, sufficiently to achieve goodwill, that would have been severely tempered due to the wholly descriptive, non-distinctive nature of the mark. Given the differences in the marks I do not consider misrepresentation would have occurred. The applicant is wrong on its submission that if a mark cannot be registered it cannot have protection under Section 5(4)(a), but the case it referred me to is highly germane. The ground of opposition under section 5(4)(a) fails as the opponent has not shown it has goodwill in either of the signs relied upon.

CONCLUSION

97) The opposition under section 5(2)(b) has been partly successful, but the opposition under sections 5(3) and 5(4)(a) both fail. The opposition succeeds in respect of the following goods and services:

- In Class 9: Downloadable publications; electronic publications; audio visual recordings; pre-recorded CDs; pre-recorded DVDs; CD-ROMs, DVDs; videos; media content;
- In Class 41: electronic publishing;

COSTS

98) As the applicant has been more successful than the opponent it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement x2	£700
Providing evidence and considering the other side's evidence	£1000
Attendance at hearing	£1000
TOTAL	£2700

99) I order The University of Law Limited to pay Uni Excellence Limited the sum of £2700. This sum to be paid within twenty- one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of September 2020

George W Salthouse
For the Registrar,
the Comptroller-General