

O/1136/22

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3580010

BY

VIA ART FUND, INC.

TO REGISTER THE TRADE MARK:

VIA ART FUND

AND IN THE MATTER OF OPPOSITION THERETO, NO. 425885

BY

NATIONAL ART COLLECTIONS FUND

BACKGROUND AND PLEADINGS

1. Via Art Fund, Inc. (“the applicant”) applied to register the trade mark **VIA ART FUND** in the UK on 15 January 2021. The application claims a priority date of 24 March 2015, from the European Union designation of international registration 1272913, which in turn claims a priority date of 26 September 2014, arising from US registration 86407401.¹ The application was accepted and published in the Trade Marks Journal on 30 April 2021 in respect of the following services:

Class 35: Conducting promotional and public awareness programs designed to encourage patronage and support for museums, galleries, and other visual arts institutions, exhibits, and art events; charitable services, namely, commissioning, purchasing, and acquiring works of art for the benefit of museums, galleries, and other visual arts institutions and art events for others.

Class 36: Charitable services, namely, funding the installation and exhibition of works of art by others; charitable fundraising services in the field of the visual arts; charitable foundation services, namely, providing funding for museums, galleries, exhibitions, scholarly research, publishing, residencies, scholarships, and educational programs in the field of visual arts.

Class 41: Art exhibition services, namely, organizing the exhibition of works of art by others; conducting educational programs, namely, conducting classes, seminars, and conferences in the field of visual arts.

2. National Art Collections Fund (“the opponent”) opposes all of the services of the contested application on the basis of section 5(2)(b), section 5(4)(a), section 3(1)(b) and section 3(1)(c) of the 1994 Trade Marks Act (“the Act”).

3. The opponent relies on UK registration 2545349 for the purposes of the section 5(2)(b) ground of opposition. That registration was filed on 20 April 2010 and registered on 24 September 2010 for the following series of two marks:

ArtFund[®]

ArtFund[®]

¹ Pursuant to Article 59 of the Withdrawal Agreement between the UK and the European Union.

4. The opponent relies only on a part of the goods and services under this registration, namely:

Class 35: Advertising, marketing and promotional services; preparation and presentation of audio visual display for advertising purposes; dissemination of advertising matter; all of the aforementioned in the field of art.

Class 36: Charitable fundraising; financial sponsorship; provision of loyalty schemes; provision of online information relating to any of the aforesaid services; information services relating to any of the aforesaid; all of the aforementioned in the field of art.

Class 41: Educational and cultural services namely, conducting classes, seminars, conferences, and workshops in the fields of art, sculpture, painting, engraving, pottery, ceramics; instructional and teaching services relating to all the aforesaid; production of sound and video recordings; arranging and conducting conferences; ticket reservation services; provision of online information relating to any of the aforesaid services; information services relating to any of the aforesaid; all of the aforementioned in the field of art.

5. In respect of the section 5(2)(b) ground of opposition the opponent stated:

The sign 'VIA ART FUND' is highly similar to the device for which the earlier mark is registered, the dominant and distinctive element of which is the words 'ART FUND'. The only difference is the presence of the word 'VIA', which means 'through' or 'by way of'.

The services for which the application seeks registration are in the same three classes as those services for which the earlier mark is registered which are relied upon in this opposition. They are all highly similar if not identical.

They are all services connected with fundraising or charitable work associated with the art world such that use of the sign 'VIA ART FUND' would imply that the services are provided 'through' or 'by way of' the opponent, under its sign 'ART FUND'.

In the circumstances, there is a real likelihood of confusion between the opposed application and the earlier mark.

6. For the purposes of the section 5(4)(a) ground of opposition the opponent claims a goodwill generated through use of the sign **ART FUND** throughout the UK since 2006, on the following services:

The earlier right has been used in respect of:
charitable fundraising for the purposes of art and cultural heritage;
the provision of a membership scheme for members to view art exhibitions and receive an art magazine;
the provision of digital/online and physical educational events focused on the art world;
the provision of funding to museums and curators for acquisitions; training and development; and the display of art through tours and exhibitions;
the running of public appeals to help save particular works of art;
the advertising and promotion of UK museums and galleries and their exhibitions;
the provision to museums and galleries of a crowdfunding platform to help fundraise for individual projects;
the provision of assistance to museums and galleries to help them organize exhibitions and share collections; and
the running of the Art Fund Museum of the Year competition.

7. The opponent relies on section 5(4)(a) to oppose all of the applicant's services and stated:

The sign 'VIA ART FUND' is highly similar to the sign 'ART FUND'. The only difference is the word 'VIA' which means 'through' or 'by way of'.
The services for which registration is sought overlap with and/or are identical or highly similar to those for which the earlier right has acquired goodwill through nationwide use. To the extent that they are not identical or highly similar (which is not admitted) they are a natural extension of the core services for which the opponent has generated goodwill through use of the sign 'ART FUND'.
In the circumstances, use of the sign 'VIA ART FUND' would imply that the services are provided 'through' or 'by way of' the opponent, under its sign 'ART FUND'. Members of the public would, therefore, be led to believe that the services of the applicant are those of the opponent or are in some way connected with, licensed by or authorised by the opponent. This would amount to a misrepresentation that would damage the goodwill owned by the opponent in the sign 'ART FUND', built up through extensive use nationwide since 2006.

8. In respect of the opposition brought under section 3(1)(b) and section 3(1)(c), the opponent claimed:

The sign 'VIA ART FUND' is incapable of acting as a badge of origin as it simply indicates that the services for which registration is sought have been provided 'by way of an art fund' or 'through an art fund'. As a result it is incapable of indicating the applicant or any originator of such services. The average consumer will not perceive it as an indicator of origin designating any particular fund but simply as a generic description of the services.

The sign 'VIA ART FUND' is entirely descriptive of the kind of services for which registration is sought. Its meaning is 'by way of an art fund' or 'through an art fund'. In the circumstances, the average consumer, faced with the sign will not perceive it as a badge of origin but, instead, will see it as a description of the way in which the services and each of them have been or will be provided.

9. Given its filing date, the opponent's mark is an earlier mark in accordance with section 6 of the Act and, as it had completed the respective registration process more than five years before the filing date of the contested application, it was subject to the proof of use provisions contained in section 6A of the Act. The applicant did not

however, put the opponent to proof of use, and as a result, the opponent may rely on any and all of the goods and services under its registration.

10. The applicant submitted a counterstatement in which it denied the claims made by the opponent and stated that, in respect of the section 5(2)(b) ground of opposition, the marks at issue are not similar and that there will as a result, be no likelihood of confusion. The applicant accepted however, that some of the services at issue are identical and that there is a degree of similarity between some of the remaining contested services. Regarding the section 5(4)(a) pleading, the applicant denied that the opponent holds goodwill and asserts that no misrepresentation will occur. In respect of the section 3(1) grounds of opposition, the applicant claims that the presence of the word VIA at the beginning of the contested mark removes the possibility that the whole sign could be found to be descriptive or devoid of distinctive character.

11. Both parties filed evidence and written submissions in these proceedings, which will be summarised to the extent that I feel is necessary.

12. The applicant has been represented by Dechert LLP throughout these proceedings. The opponent has been represented by Farrer & Co LLP.

13. A hearing was requested and was held remotely on 17 October 2022, at which the applicant was represented by Mr Nathan Smith of Dechert LLP. The opponent was represented by Mr Jamie Muir Wood of counsel, instructed by Farrer & Co.

14. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Evidence

15. Both parties provided evidence. I will summarise the opponent's evidence briefly but will not go into great detail. I will however refer to this information and the evidence of the applicant throughout my decision, where I feel it is pertinent to do so.

16. I note that the opponent's evidence is intended to support the claim under section 5(4)(a) that it enjoyed a goodwill in a business at the relevant date. It is not required to support genuine use of the earlier registration relied upon for the purposes of the section 5(2)(b) ground of opposition.

17. The opponent's evidence comprises a witness statement of Carolyn Young, the Director of marketing of the opponent, which is dated 10 February 2022. Exhibit CY1 is provided under Ms Young's statement.

18. Ms Young states that the opponent was founded in 1903 to help museums and galleries acquire works of art and was originally named 'NATIONAL ART COLLECTIONS FUND'.

19. Prior to 2011 the opponent ran a membership scheme which was a subscription-based membership scheme, entitling holders to gain free or reduced-price entry, to a wide range of participating galleries, museums and historic houses nationwide; as well as providing reduced-price entry to major exhibitions. In 2011 the scheme was re-branded, and the opponent launched the 'National Art Pass'. An annual Pass or a life membership Pass can be purchased by members of the public, who then receive materials under the opponent's sign 'ART FUND' which includes a quarterly magazine titled 'Art Quarterly', the opponent's magazine.

20. Ms Young states that funds collected by the opponent through the scheme and the Pass, plus donations, bequests and legacies, enable it to support museums and galleries in the purchase of works of art; help museums and galleries avoid having to sell works of art; support current and up-and-coming artists; and fund exhibitions and support curators in linking them with venues for exhibitions.

21. Ms Young states that by 2006, the opponent had, at a conservative estimate, raised and distributed funds totalling in excess of £150 million to a wide range of galleries, museums, artists, curators, projects and exhibitions. It was in 2006, Ms Young submits, that the opponent adopted the sign ART FUND as its name.

22. Ms Young asserts that she is unaware of any competitors to the opponent, operating in the same space.

23. In paragraph 22 of her witness statement Ms Young provides the following information:

Under the Sign the Opponent has raised the following approximate annual sums in the United Kingdom since 2006:

Year	Income	Year	Income
2006	£8.6m	2014	£24.1m
2007	£48.8m	2015	£14.8m
2008	£10.0m	2016	£15.2m
2009	£8.1m	2017	£13.7m
2010	£10.0m	2018	£14.8m
2011	£8.5m	2019	£17.1m
2012	15.1m	2020	£14.5m
2013	£10.6m	2021	£17.5m (estimated)

24. In paragraph 23 she provides the following table of information:

Since 2006, the Opponent has spent the following approximate sums on grants, for acquisitions, projects, exhibitions, competitions and awards, all of which have featured prominent use of the Sign:

Year	Expenditure	Year	Expenditure
2006	£4.4m	2014	£14.2m

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Year	Expenditure	Year	Expenditure
2007	£45.6m	2015	£6.2m
2008	£6.7m	2016	£10.6m
2009	£5.2m	2017	£7.3m
2010	£7.6m	2018	£5.4m
2011	£7.0m	2019	£15.8m
2012	£6.2m	2020	£16.1m
2013	£5.1m	2021	£13.4m

25. And in paragraphs 25 and 26, the following information:

Since 2006, the Opponent has had the following approximate number of annual members for the Scheme (from 2006 – 2011) and for the Pass (from 2011):

Year	Members	Year	Members
2006	74,668	2014	117,000
2007	75,607	2015	122,000
2008	79,319	2016	123,000
2009	79,831	2017	139,000
2010	76,331	2018	151,000
2011	88,724	2019	159,000
2012	95,900	2020	130,000
2013	107,000	2021	130,000

Since 2006, the Opponent has spent the following approximate sums on advertising and promotion in the United Kingdom under the Sign:

Year	Expenditure	Year	Expenditure
2006	£3.6m	2014	£5.0m
2007	£3.7m	2015	£5.0m
2008	£3.5m	2016	£6.0m
2009	£3.4m	2017	£6.8m
2010	£3.8m	2018	£7.5m
2011	£3.6m	2019	£1.18m
2012	£3.8m	2020	£1.8m
2013	£3.9m	2021	£1.8m

26. Ms Young refers to the opponent’s website, which she states is operated under the sign ART FUND, and which promotes the Pass and provides information as to ‘what’s on’ or ‘what to see’, where a range of exhibitions across the UK can be found on the homepage. In paragraph 29 of her witness statement a table of Google analytics figures is presented to demonstrate the level of activity and interest in the opponent’s website between 2011 and 2021. That table looks like this:

Year	Total page views	Year	Total page views
2011	3,412,529	2017	5,064,063
2012	2,765,789	2018	5,185,099
2013	5,177,312	2019	1,575,966
2014	4,577,742	2020	3,103,949
2015	4,754,109	2021	2,832,033
2016	4,702,080		

27. Ms Young states that the opponent operates a crowdfunding platform known as ‘Art Happens’ which, since it was launched in June 2014 has enabled 34 museums

and galleries to raise funds for 36 projects. Museums that have participated are spread geographically around the UK and include museums in Cardiff, Warwickshire, Durham, Shropshire and Hastings.

28. Since 2006, Ms Young claims that the opponent has supported a wide range of commissions and acquisitions under the sign ART FUND, with examples provided in exhibit CY1, including James Turrell's Deer Shelter at Yorkshire Sculpture Park in 2006 (£762,754) and Jaume Plensa's *Dream* displayed at St Helen's in 2009 (£1.8m).

29. Ms Young's witness statement lists many other acquisitions, commissions, grants made, and examples of art works saved through campaigns carried out under the opponent's sign ART FUND.

30. Since 2008 the opponent has run a 'Museum of the Year' competition, branded with the sign ART FUND, where the winning museum is awarded £100,000.

31. Ms Young also states that the opponent provides digital/online and physical educational events focussed on the art world.

32. Exhibit CY1 contains a substantial amount of information which is intended to support the witness statement of Ms Young, with material relating to global reach, partnerships with many museums and galleries across the UK and with a national charity 'VocalEyes', branded materials and media/press coverage of the opponent's work among other things.

Decision

33. I will begin my decision by considering the actions brought by the opponent under sections 3(1)(b) and 3(1)(c) of the Act.

34. Section 3(1) states that:

"3(1) The following shall not be registered –

(a) signs which do not satisfy the requirements of section 1(1),

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

[...]"

35. Section 1(1) states that:

"1(1) In this Act "trade mark" means any sign which is capable-

(a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and

(b) of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging."

36. The relevant date for determining whether the mark is objectionable under the above provisions is the filing date of the contested mark, which was 24 March 2015.

37. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b).² The position under the above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect.³

38. The mark at issue is **VIA ART FUND**

² SAT.1 SatellitenFernsehen GmbH v OHIM, Case C-329/02 P, paragraph 25

³ *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

39. I will begin with an assessment of the application under section 3(1)(c). This provision prevents the registration of marks which are descriptive of goods and services, or a characteristic of them.

40. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104,

Windsurfing Chiemsee, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

41. In *Campina Melkunie BV and Benelux-Merkenbureau*, Case C-265/00, the Court of Justice of the European Union (“CJEU”) stated that:

“39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

40. However, such a combination may not be descriptive within the meaning of Art.3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition will have to be satisfied as regards both the aural and the visual impression produced by the mark.

41. Thus, a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics within the meaning of Art.3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in

relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.”

42. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, the Court of Justice held that:

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

43. The opponent has shown in evidence that the word VIA, which forms the first element of the contested mark, is an ordinary English word that means ‘through’ or ‘by way of’. It submits that the case law is clear that if at least one meaning is descriptive, this is enough. I agree with this point, however it is also the case that for section 3(1)(c) to bite, the mark as a whole, must be found to consist exclusively of a sign or an indication that designates a characteristic of the goods or services on offer under that sign. This is something that Mr Muir Wood set out in his skeleton arguments, and which he made submissions on during the hearing before me. Mr Muir Wood suggested that the average consumer will view the contested mark as the whole term VIA ART FUND which, he asserted, would simply be perceived as a term describing the charitable, promotional, educational and exhibition services provided by the applicant through, or by way of, an art fund. He said that the contested sign “gives no clue as to the origin of those services but simply describes how they have been provided”. He added: “Accordingly, when one looks at the sign as a whole, it is an application to register the phrase "by way of art fund" or "through art fund". Absent

any acquired distinctiveness for the sign for the term "art fund", ...the sign simply indicates a characteristic of the services.”

44. Regarding the opposition based on section 3(1)(b), Mr Muir Wood submitted that, as the contested mark is simply a descriptive term, it must also fail under section 3(1)(b), as it must lack any distinctive character for any of the services of the applicant.

45. Mr Smith, in his skeleton arguments, stated that the applicant accepts that the term ‘ART FUND’ is descriptive, devoid of any distinctive character, and generic in respect of all of the applied for services, all of the opponent’s earlier services, and for the services relied on for the purposes of the section 5(4)(a) ground of opposition. He claimed however, that the addition of the word VIA, which he asserted is of normal inherent distinctiveness and is neither descriptive nor characteristic of any group of things, is the dominant and distinctive element in the contested mark. He submitted that the whole term VIA ART FUND is “neither a natural way to describe the Application Services, nor is it correct grammatically”. Mr Smith also stated that the opponent had been unable to show any use of the term ‘via art fund’ by any third parties and suggested that the term was too abstract to refer to any specific services. He added that the term does not describe or allude to any characteristics of his clients’ services. Further, Mr Smith pointed out that the mark had been accepted without question under absolute grounds and is registered in the EU and the US and had also been accepted for publication at the UK IPO without objection by the examiner.

46. Having considered the submissions from both parties and the relevant case law above, I dismiss the grounds of opposition brought under section 3(1)(c) of the Act. I find that the term VIA ART FUND, when considered as a whole, is somewhat awkward in its construction. Whilst the individual components can all be said to be common everyday words with clear meanings, the term itself does not comprise an expression that consists exclusively of a sign or indication that designates a characteristic of the services at issue. In order to create a grammatically clear expression that might be argued to be entirely descriptive, further mental steps would have to be taken, or words added to the sign.

47. The opponent’s submissions revolve largely around the argument that when taking account of the meaning of the word ‘VIA’, the applicant’s mark would be

perceived as the expressions 'by way of Art Fund' or 'through Art Fund'. Mr Muir Wood told me during the Hearing that: "The word Via means by way of or through. It does not indicate a completely separate brand Art Fund. It simply indicates through Art Fund, by way of Art Fund. That is the reason why we say it is entirely descriptive and lacking in distinctive character...".

48. I disagree with this assessment. In order to come to the conclusions suggested by Mr Muir Wood, I believe that both expressions require the addition of the word 'The' being a determiner used to refer to something or someone. In this instance that something being an Art Fund, which would in each expression represent an entity of some kind. The lack of a determiner in the phrases 'by way of Art Fund' and 'through Art Fund' leaves both expressions, as claimed by Mr Smith during the Hearing, grammatically incorrect and somewhat unnatural in their construction.

49. This is sufficient to find that the mark VIA ART FUND, as a whole, does not comprise exclusively a descriptive term that designates a characteristic of the services at issue.

50. The opponent has made clear that the section 3(1)(b) ground of opposition is firmly tied to the section 3(1)(c) claim. Mr Muir Wood states that the contested mark must be found to be devoid of distinctive character in the event that it is found to be entirely descriptive. As I have concluded that the contested mark does not consist exclusively of a descriptive sign or indication, it follows that the opponent's section 3(1)(b) claim must also fail. For completeness however, I will add that my conclusion regarding the question as to whether the term VIA ART FUND can be said to be entirely devoid of any distinctive character, would be a negative. Due to the somewhat abstract construction of the term, I believe that, as a whole, it cannot be said to have no distinctiveness at all.

51. Therefore the opposition actions brought under section 3(1)(b) and section 3(1)(c) of the Act have failed.

52. I now move on to consider the opposition action brought under section 5(2)(b).

Section 5(2)(b)

53. Section 5(2)(b) of the Act states:

“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.”

The principles

54. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are gleaned from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the services

55. In the judgment of the 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”.

56. 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.


57. It has also been established by the General Court (“GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, 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”.

58. In his skeleton arguments and in submissions during the Hearing, Mr Smith, on behalf of the applicant, submitted that there was a degree of similarity and, in some cases, identity, between most, if not all, of the contested services. He suggested however, that any differences between the services at issue lay in their nature and purpose.

59. For the sake of procedural economy, for the purposes of the section 5(2)(b) pleading, I intend to proceed on the basis that all of the applicant’s services are similar to at least some degree, to the services of the opponent’s earlier mark.

Comparison of the marks

Earlier Marks	Contested Mark
 <p>And</p>	<p>VIA ART FUND</p>

Overall impression

60. The earlier marks are figurative, combining and conjoining the words Art and Fund which are presented in a fairly standard typeface, with a small heart shaped graphic device, placed at the top right, or end, of the marks. The first mark in the series is also presented in a colour scheme, with the first word ‘Art’ presented in a red/pink colour and the word ‘Fund’ in black. The same red/pink colour is used in the figurative heart device. The second mark is presented in black and greyscale lettering. Due to the size and the placement of the heart device in both earlier marks, the words ‘ArtFund’ can be said to be the dominant aspects of the marks, representing the much larger elements, however these words are also considered by both parties to be descriptive

and non-distinctive in the context of the services at issue. As such the figurative heart elements, cannot be dismissed as they play a very important, distinctive, role in the earlier marks. Whilst any distinctiveness in the earlier marks lies in their figurative aspects and overall 'get-up', the overall impressions lie in the marks as wholes.

61. The contested mark is a plain word mark that comprises the three words VIA ART FUND. The applicant has suggested that the word VIA is the dominant and distinctive element in its mark, with the words ART FUND being entirely descriptive, generic and devoid of any distinctive character for any of the services at issue. The opponent has submitted that the contested mark should be considered as a whole and should not be dissected. It has asserted that the word VIA should not be considered as the dominant and distinctive element in that mark.

62. In my assessment of the overall impression of the contested mark, I take note of the opponent's submissions regarding its opposition under section 3(1) of the Act, which I have dealt with above. From the submissions of the opponent, and those of Mr Smith on behalf of the applicant, it has in my opinion, been expressly argued by both parties that the term ART FUND is devoid of distinctive character and entirely descriptive. I appreciate that the opponent makes these claims in respect of the whole contested mark but, and as was asserted by Mr Smith during the Hearing, by arguing that the term VIA ART FUND should be rejected under sections 3(1)(b) and (c), the opponent must be taking the position that ART FUND as a term is also entirely descriptive and devoid of distinctive character. The applicant in fact goes further and claims that the combination ART FUND is a generic term in the relevant field of interest.

63. In my deliberations around the question of distinctiveness and descriptiveness of the contested mark, I have concluded that the mark as a whole 'VIA ART FUND' is a somewhat awkward combination that may be allusive but is an unusual construction that is not grammatically correct, requiring intellectual reflection and the addition of further elements before an exclusively descriptive, non-distinctive term might emerge. The issue I must consider is whether, and to what degree, the addition of the word VIA, when placed in front of the term ART FUND, can be said to be the addition of an independently distinctive, dominant element to a descriptive term, as claimed by the applicant, or whether it simply serves to create a distinctive three-word trade mark.

64. After much deliberation, I find that the contested mark will be perceived as a three-word mark, in which the word VIA albeit forming the initial element, cannot be said to be dominant – it is not the more eye-catching aspect of the mark, and it is presented in the same size and font as the other words. Neither do I accept that it is, as was argued by Mr Smith, the only distinctive element in the mark. I find that the word VIA, as argued by the opponent, is a common everyday word that will be perceived as such. The distinctiveness of the contested mark lies in the combination of the words as a whole, and that is where the overall impression must lie.

Visual Comparison

65. Visually the marks all contain the words 'ART FUND' albeit presented in slightly different typefaces and with a mix of upper, and lower-case lettering. The marks differ in the word VIA of the contested mark which forms the beginning of that mark, in the small heart device element of the earlier marks, and in the use of colour in the first earlier mark. As all of the word elements of the earlier marks (which are those elements found to dominate those marks), are wholly contained within the contested mark, notwithstanding the stylistic and figurative differences, I conclude that these marks are visually similar to at least a medium degree.

Aural Comparison

66. All of the marks at issue contain the words 'ART FUND' which will be articulated identically. The marks differ in that the contested mark also contains the word 'VIA' which has no counterpart in the earlier marks, and which will, by virtue of its placement on the left of the mark, be articulated first. The heart shaped figurative element found in the earlier marks will not be articulated and therefore plays no part in the aural comparison. The earlier marks are wholly contained within the contested mark, and whilst the aural difference between them comes at the start of the contested mark, I find these marks to be aurally similar to a high degree.

Conceptual Comparison

67. The marks share the concept of an art fund, which will be commonly understood amongst the relevant public and has been accepted by both parties as being a descriptive term within the context of the services at issue. The addition of the word

VIA to the term ART FUND in the contested mark has been described by the opponent as serving to indicate that services provided by the applicant will be 'by way of' or 'through' an art fund. Whilst I am not wholly convinced that the contested mark will be perceived in the way that the opponent has suggested, due to the somewhat awkward construction of the whole, the shared concept in ART FUND suggests that these marks are conceptually similar to a high degree. It is however possible, that a part of the relevant public may perceive the contested mark in the way that the opponent suggests but this would not, in and of itself, increase the conceptual similarity in my view. In my opinion the figurative heart element in the earlier marks would play no conceptual role in those marks and neither party provided submissions on this point.

Distinctive character of the earlier mark

68. The degree of distinctiveness of the earlier mark is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion⁴. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

69. 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

⁴ *Sabel BV v Puma AG*, Case C-251/95, § 24

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).”

70. In *Kurt Geiger v A-List Corporate Limited* BL O-075-13, Mr Iain Purvis K.C., acting as the Appointed Person, pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

71. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

72. Trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented

words which have no allusive qualities. Further, the distinctiveness of a mark can be enhanced by virtue of the use made of it.

73. The opponent has not expressly claimed that the earlier marks relied upon have acquired an enhanced degree of distinctiveness through the use made of them, although I note from submissions, that the opponent's earlier registration was the subject of a non-use action taken by the applicant. Mr Muir Wood stated that his client's registration duly survived that action, albeit with some restriction of the specification of goods and services initially registered. He did not claim that the outcome in that action explicitly pointed to any suggestion of a raised degree of distinctive character in his clients' marks, but I understand the point being made, that evidence provided by his client has been accepted by a Hearing Officer of the IPO to support genuine use of the earlier marks relied upon in this action, and for the services on which the opponent now relies. It is of course the case that proof of genuine use does not automatically provide an indication as to the level of inherent distinctiveness that the mark in question might enjoy. In fact, Mr Muir Wood said during the hearing:

"On inherent distinctive character, ... this is a mark which is primarily for the words ART FUND, and its inherent distinctive character comes from that. ... it has been challenged for non-use. Use has been found. We are not required to plead an acquired distinctiveness case because we rely primarily on passing off rights, but plainly, it has maintained at least a moderate degree of distinctive character through its use."

74. I have found that the dominant element in the opponent's marks is the combination of the words 'ArtFund'. Whilst I have not dismissed the small but distinctive heart device in the earlier marks, it is the verbal elements 'Art Fund' that provide the only aural and conceptual impact in those marks and it is the words that dominate visually, due to the small size and placement of the figurative element in those marks.

75. The opponent has, I believe, accepted that the words ART FUND together, are entirely descriptive and devoid of any distinctive character when considered within the context of the applicant's services. It has also submitted that the applicant's services are identical or highly similar to its own services, something that the applicant has, to a large degree accepted and which I also consider to be the case. Therefore, I

conclude that the opponent recognises that the term ART FUND within its earlier marks must be descriptive of, and devoid of any distinctive character for, the services on which it relies.

76. The opponent's earlier marks are inherently distinctive due to the combination of the words Art and Fund conjoined, along with a distinctive figurative heart element and some colour/stylisation in the lettering used. I conclude therefore that as the visually dominant element, which is also the only element that plays an aural role and provides the only clear concept in the marks, is entirely descriptive and non-distinctive, the opponent's earlier marks are inherently distinctive to only an extremely low degree.

77. The evidence provided by the opponent is not sufficient, in my opinion, to enhance the earlier marks to any significant degree, and this was not expressly pleaded. In fact, from the submissions of Mr Muir Wood and in particular his comment that: "We are not required to plead an acquired distinctiveness case because we rely primarily on passing off rights, but plainly, it has maintained at least a moderate degree of distinctive character through its use" I conclude that in fact the opponent appreciates that its earlier marks may be moderately distinctive through use, and must therefore be inherently distinctive to a lower degree than that.

Average consumer and the purchasing act

78. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average"

denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

79. Both parties provided submissions on the average consumer and likely purchase process of the services in issue. They are agreed that the average consumer will generally and largely be a professional one, but that for certain types of services the general public may also be considered as the average consumer.

80. The services at issue are generally promotional, charitable, educational, cultural, fundraising and exhibition services relating to art, museums and galleries. These services will be selected from specialist high street establishments and retail outlets, and via advertisements provided in traditional media such as newspapers, or online through specialist websites.

81. I consider the purchasing process to be predominantly visual. However, I do not discount that there may be an aural component to the process, given that word-of-mouth recommendations may be made, or discussions may take place over the telephone and in places such as museums and galleries. Due to the nature of the services being provided, although the price and frequency of purchase of the services may vary, the level of attention involved will be at least medium for both sets of consumers, with the more specialist and sophisticated services attracting a higher degree of attention, albeit not the highest level. This conclusion appears, in my opinion, to roughly mirror the position set out by both parties during the Hearing.

Likelihood of confusion

82. There is no simple formula for determining whether there is a likelihood of confusion. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind.

83. It is clear then that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa (*Canon* at [17]). In making my assessment, I must consider the various factors from the perspective of the average consumer, bearing in mind 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 (*Lloyd Schuhfabrik* at [26]).

84. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“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.

Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

85. These examples are not exhaustive but provide helpful focus.

86. I have concluded that the services at issue are all similar to at least some degree. The competing marks have been found to be visually similar to at least a medium degree and aurally/conceptually similar to a high degree. The average consumer of the services in issue will generally be professionals but may in some instances include members of the general public, all of whom will select the services primarily through visual means, though I have considered an aural component in the selection process as well. I have concluded that the level of attention exercised during the purchasing process will range from at least medium to higher than medium, depending on the consumer group and the precise nature of the services required. I have found the opponent’s marks to have an extremely low degree of inherent distinctive character which has not been enhanced through use.

87. In its submissions the opponent has claimed that there is a likelihood of both direct and indirect confusion between the marks at issue. However, having considered all of the submissions and evidence provided by both parties, and taking note of the case law set out above, I come to the view that direct confusion will not occur.

88. I remind myself in particular of the comment in paragraph 39 of the *Kurt Geiger* decision, in which Mr Purvis K.C. stated that:

“...It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”⁵

89. Both parties have, I believe, accepted that the words ART FUND when combined, form a descriptive and non-distinctive term when considered within the context of the

⁵ Paragraph 56 of this decision (BL O-075-13)

services at issue. I have found that the opponent's marks are inherently distinctive to an extremely low degree, and I believe that they are distinctive due solely to the overall 'get-up' in those marks, and largely because of the inclusion of the figurative heart element. I have found that whilst the figurative element is quite small, it will certainly not go unnoticed and cannot be dismissed. I find in fact that it is this element that makes the largest contribution to the distinctiveness of the marks and plays a very important role in the impact that those marks have in the mind of the average consumer.

90. The opponent has submitted that the word VIA in the contested mark is likely to be ignored or go unnoticed. I find this argument difficult to accept given the placement of that word at the beginning of the applicant's mark. I do not find that VIA should be downgraded to any degree within the contested mark. In fact, I believe that, due to its position in the mark, it will be given significant weight within the whole.

91. As such, given the entirely descriptive, non-distinctive nature of the combination ART FUND/ArtFund, and an at least medium level of attention being paid by both sets of consumers, I believe that the differences in the marks are sufficient to ensure that the average consumer will not mistake one for the other. I find that this would be the case even in the event that all of the services in issue were considered to be identical.

92. Having concluded that direct confusion will not occur, I go on to consider the possibility of indirect confusion.

93. I remind myself of the comments set out above of Mr Purvis K.C. in *LA Sugar Limited*, where he identified categories that might support a claim of indirect confusion.

94. The common element between the marks has been found to be entirely descriptive and non-distinctive within the context of the services at issue.

95. I have found that the applicant's mark is distinctive due to the combining of all three words and that the mark is not dominated by the word VIA, as the applicant has suggested. In my opinion the term hangs together as a unitary sign, however the descriptive impact of the combination ART FUND is not in dispute. I have also found that the figurative heart element in the earlier marks is extremely significant in the creation of inherent distinctiveness and that even with this figurative element added,

the earlier marks are of an extremely low distinctive character due to the dominance of non-distinctive, descriptive verbal elements.

96. The words ART FUND are clearly not strikingly distinctive, such that the average consumer would assume only one undertaking would be using that expression. The contrary appears to be the case in fact.⁶ The addition of the word VIA to the words ART FUND is not, in my opinion, an obvious or logical brand extension of the opponent's earlier marks, nor can it be said to be an entirely non-distinctive addition to the earlier marks relied upon. That being the case, I find that indirect confusion will not occur.

97. In my deliberations I have also kept in mind the finding in *Duebros Limited v Heirler Cenovis GmbH*, in which Mr James Mellor K.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, as this would be mere association rather than indirect confusion.⁷

98. Whilst it is possible that the applicant's mark might call to mind the opponent's marks; given the entirely descriptive and non-distinctive nature of the common elements, it is far from a certainty. However, even if this were to be the case, I find that it would amount at most to mere association.

99. Having found that no direct or indirect confusion will occur, the opposition insofar as it is based on section 5(2)(b), has failed.

100. I now move on to consider the section 5(4)(a) grounds of opposition.

Section 5(4)(a)

101. Section 5(4)(a) of the Act states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

⁶ Evidence of third-party use of the term is provided under Exhibit NS1.

⁷ BL O/547/17

(a) by virtue of any rule or 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 4(A) is met ...”

102. Subsection 4(A) is as follows:

“The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

103. 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).”

104. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant 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 indicium 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 two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which 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 claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (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 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.”

Relevant Date

105. In *Advanced Perimeter Systems v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander Q.C. (as he then was), sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*, BL O/212/06:

“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.”⁸

106. The applicant has not claimed to have used the contested mark before the date of application and so the relevant date must be 26 September 2014, being the earliest priority date of the contested application.

Goodwill

107. The opponent must show that it had goodwill in a business at the relevant date and that the mark relied upon is associated with, or distinctive of, that business.

108. The opponent claims to have used the mark ‘**ART FUND**’ throughout the UK since 2006 in respect of the following services:

Charitable fundraising for the purposes of art and cultural heritage; the provision of a membership scheme for members to view art exhibitions and receive an art magazine; the provision of digital/online and physical educational events focused on the art world; the provision of funding to museums and curators for acquisitions; training and development; and the display of art through tours and exhibitions; the running of public appeals to help save particular works of art; the advertising and promotion of UK museums and galleries and their exhibitions; the provision to museums and galleries of a crowdfunding platform to help fundraise for individual projects; the provision of assistance to museums and galleries to help them organize exhibitions and share collections; and the running of the Art Fund Museum of the Year competition.

109. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217:

⁸ Quoted in paragraph 43 of BL O-410-11.

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages 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. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

110. 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 off 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.”

111. 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.”

112. In *Smart Planet Technologies, Inc. v Rajinda Sharm* [BL O/304/20], Mr Thomas Mitcheson Q.C. (as he then was), as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

113. The opponent's evidence provides some impressive statistical information, at least on the face of it. Notably, Ms Young states that annual sums raised under the sign ART FUND by the opponent amounted to £143.8 million between 2006 and 2014.⁹ The information in her witness statement also shows that the opponent spent £102 million on grants, acquisitions, projects, exhibitions, competitions and awards between 2006 and 2014.¹⁰ The number of annual memberships of the Scheme held

⁹ Paragraph 23 of this decision

¹⁰ Paragraph 24 of this decision

between 2006 and 2011 was 474,480 in total, and total membership of the Pass, between 2012 and 2014, amounted to 319,900.¹¹ Ms Young also stated that advertising and promotional expenditure relating to the opponent's services under the sign between 2006 and 2014 was £34.3 million in total¹² and that, based on Google analytics figures, the opponent's website had almost 116 million page views between 2011 and 2014.¹³

114. In response to the opponent's evidence, Mr Smith stated that much of that evidence does not show use of the sign 'ART FUND' as relied upon, but rather it shows use of the figurative marks that the opponent has registered with a heart shape device – those marks which were relied upon for the section 5(2)(b) ground of opposition. He also submits that much of the evidence shows use of the term 'THE ART FUND' as opposed to the sign relied upon which is simply 'ART FUND'. On this point he said:

“Again, much of the use is of the word THE ART FUND rather than the sign ART FUND. I agree that in many instances use of a word such as "the" would not be as significant, but here the inclusion of the word "the" will have an impact on the relevant public's interpretation of the sign given the descriptiveness of the term ART FUND”.

115. He stated that much of the evidence in exhibit CY1 provided under Ms Young's witness statement, appeared to be internally facing and therefore unlikely to be seen by the public.

116. Mr Smith also submitted a witness statement and evidence on behalf of his client in which, under exhibit NS1 he provides information relating to third-party use of the words ART FUND in the relevant field of interest and in what seems to me to be in an entirely descriptive manner. I note that, for example, he provides evidence in respect of The Speakers Art Fund; Manchester Contemporary Art Fund; East Anglia Art Fund (EAAF) and The Outset Contemporary Art Fund, amongst others.

117. The opponent, in reply to Mr Smith's evidence, submitted further evidence by way of a witness statement of Paul Jones, a solicitor and partner at Farrer Co LLP,

¹¹ Paragraph 25 of this decision

¹² Paragraph 25 of this decision

¹³ Paragraph 26 of this decision

and exhibit PS1, which serves to establish that some of the examples provided by Mr Smith, of third-party use of the term ART FUND, come from the US and other non-UK based sources.

118. I have considered all of the information and evidence provided by Mr Smith and Mr Jones carefully and I take account of that information in my deliberations.

119. On balance, taking account of the relevant case law outlined above, and having considered all of the evidence provided by both parties very carefully, I conclude that the opponent has not established that it holds a goodwill in a business where the words ART FUND will be perceived by the relevant public as being distinctive of that business.

120. I agree largely with the submissions of Mr Smith with regard to the opponent's evidence. The vast majority of the evidence points to use of marks which are not the sign relied upon. The mark most commonly shown throughout the evidence is the figurative mark:

The logo for ArtFund, featuring the word 'Art' in a bold, pink, sans-serif font, followed by 'Fund' in a bold, black, sans-serif font. A small pink heart symbol is positioned at the top right of the letter 'd'.

which was relied upon under the section 5(2)(b) ground of opposition. It is this mark which I find is the mark mostly used by the opponent to promote itself. It is also the case that the expression 'The Art Fund' is commonly used by the opponent and by third parties including press and media. I accept that there is some use of the term 'ART FUND' within the opponent's evidence, however the descriptive nature of that expression results in a likelihood that the relevant public will attach no distinctive value to it when considering the services on offer.

121. There are many examples of the term 'The Art Fund' being used as the name of the opponent. By way of a very limited set of examples, I note the following:

- The opponent's magazine Art Quarterly sets out on the editorial pages that the magazine is published by 'The Art Fund'.

- In a fax to Allen & Overy (page 021 in CY1) the opponent refers to its new logo design and states "...the new abbreviation of our name "The Art Fund".
- On the 'Consolidated Statement of Financial Activities year ended 31 December 2014' (page 034 of CY1) – the statement is headed: "The Art Fund in 2014/15".
- At the top of page 039 of CY1 – "What's on – The Art Fund".
- Page 058 of CY1 displays a long list of events in 2013 – all begin with the name 'The Art Fund'.
- On page 080 of CY1 an article entitled 'Man The Barricades' is headed "The Art Fund (as it is now known)". The article uses the term 'The Art Fund' on four occasions in one paragraph.
- In an article referring to The National Portrait Gallery, page 110 of CY1 is headed 'The Art Fund'.
- Page 117 of CY1 provides an article in the Guardian from January 2007 which states "David Barrie, director of The Art Fund said..."
- Page 212 of CY1 is dated 2009 and relates to 'Artists Rooms on Tour' and refers to "...independent art charity The Art Fund".
- An invoice from February 2014, on page 226 of CY1 is shown clearly as being between Whitechapel Gallery and 'The Art Fund'.
- On page 232 of CY1 there is a press release from the V&A in which, under Notes of the Editor there is a reference to The Art Fund' - the figurative heart mark is also on display.
- On page 265 of CY1 in the Freize press release there is an article headed 'The Art Fund' which also contains the same term 'The Art Fund' twice in the body of the article.

122. These are a small number of examples that I believe indicate clearly that the opponent and members of the relevant public, as well as third parties and the press/media generally seem to refer to the opponent not as 'Art Fund' but as 'The Art Fund'. There are many more examples in evidence of this.

123. As Mr Smith claimed in his submissions, the difference in the addition of the word 'the' is not always significant, however in this particular instance it makes a big impact.

I agree with him, that there is an important difference between the sign 'The Art Fund', which may be seen as badge of origin in the sense that it serves to designate a specific entity, and the sign 'Art Fund', which I believe has been shown to be entirely descriptive and therefore unable to serve as a badge of origin in any capacity.

124. The examples provided by Mr Smith, of other parties in the same area of business in the UK using the term Art Fund as part of a name, helps to establish that in the eyes of the relevant market, competitors and/or partners of the opponent perceive the combination 'art fund' to be an expression that they should be free to use within their names, in order to describe a characteristic of the services they offer.

125. In BL/O/206/15, Mr Daniel Alexander Q.C. (as he then was) as the Appointed Person found that:

“18. The first, and overarching criticism, is that the Hearing Officer failed to take proper account of the descriptiveness of the term in which goodwill was claimed. That, it is said, led him to take an erroneous approach in evaluating whether the opponent’s activities had generated goodwill, by giving a secondary meaning to the descriptive term.

19. A number of the individual arguments were directed to this point and I deal with them together. They centre on the point made by the Court of Appeal in the case concerning extended passing off *Diageo North America Inc. v. Intercontinental Brands (ICB) Ltd* [2011] RPC 2 at [24] that:

“The more general and descriptive the name is, the more difficult it will be to establish the reputation and goodwill of the claimant in that term and the existence of a misrepresentation by the defendant in the use of the same name”

20. As to this point, there is a spectrum of distinctiveness, running from marks which make no reference to the nature or quality of the goods to those which are wholly descriptive of them. In certain cases, terms are prima facie descriptive but, with use, may acquire a secondary meaning. In other cases, terms which have some descriptive connotation may nonetheless operate effectively to denote trade origin from the outset. As I read the decision, the Hearing Officer approached the case on the basis that “The Proper Pizza Co[mpany]” fell more naturally into the

latter category. Although it has clear descriptive connotation, it is a term which is likely to be taken by a significant proportion of the relevant public to denote a particular undertaking and its goods and services and was used as such. At para. [22] the Hearing Officer expressly rejected the suggestion that the term had been used descriptively.

126. I take note of the finding in *Diageo North America Inc.* that the more descriptive the name is the more difficult it will be to establish the reputation and goodwill of the claimant. In this instance however, unlike the case before Mr Alexander, the issue of descriptiveness has been considered and is very clear. Both parties have accepted that the term ART FUND is descriptive and non-distinctive for the services at issue, which include those services relied upon by the opponent for the purposes of the passing off action. I repeat my conclusions previously, when considering the section 3(1) grounds of opposition. In order for the opponent to argue that the contested mark VIA ART FUND is a mark that should be struck off the register as it is entirely descriptive and devoid of any distinctive character, it is implicit in that argument, that the combination ART FUND is itself entirely descriptive and devoid of distinctive character.

127. I accept that “In certain cases, terms are prima facie descriptive but, with use, may acquire a secondary meaning” however I do not find that this is the case in this instance. The opponent’s evidence shows use predominantly of the figurative mark or the sign THE ART FUND, which Mr Smith submitted is in essence a quite different sign to the words ART FUND solus. I have agreed with Mr Smith that the addition of ‘THE’ to the words ART FUND is significant and has an impact that will not be overlooked or ignored.

128. Ultimately, the opponent believes that it has goodwill in a business in which the term ART FUND is a distinctive element that the relevant public will associate with it and upon which a reputation lies. The fact that the combination ART FUND is entirely descriptive and non-distinctive tells me that the term, in isolation, will be perceived simply as a description and not a badge of trade origin.

129. Mr Smith submitted that: “The case law here is crystal clear here: the applicant cannot be precluded from using a term which is unambiguously descriptive or

incapable of denoting origin, which we say the term Art Fund plainly is". I agree. The relevant public may well recognise the opponent's figurative mark and attribute services provided under that mark to the opponent, due to the distinctiveness and use of that mark. It will not, in my opinion ascribe the same significance to the plain expression ART FUND, which is clearly a non-distinctive, descriptive combination, and one which has been shown to be used by several other parties in the UK at the same time.

130. As I have concluded that the opponent does not hold any goodwill in a business in which the sign ART FUND has been found to be associated with it in a manner that will be perceived as distinctive, the opposition raised under section 5(4)(a), is dismissed.

Conclusion

131. The opposition has failed entirely. Subject to an appeal to this decision, the contested application will be registered for all of the services applied for.

COSTS

132. The applicant has been successful and usually would be entitled to a contribution towards its costs. However, Mr Smith, acting on behalf of the applicant, confirmed during the Hearing that he was seeking no costs award for his client, as he had provided his time *pro bono*. That being the case, I make no award of costs in this instance.

Dated this 22nd day of December 2022

Andrew Feldon
For the Registrar