

BL O/479/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3302566

BY

UNIVERSITY OF THE ARTS, LONDON

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 41:

ual:

AND

OPPOSITION THERETO (NO. 413226)

BY

UNIVERSIDAD DE ALICANTE

Background and pleadings

1) On 9 April 2018, University of the Arts, London (“the applicant”) applied to register the following trade mark in the UK:

ual:

It was accepted and published in the Trade Marks Journal on 27 April 2018 in respect of the following Class 41 services:

Education, teaching, providing of training; entertainment; university services; university education services in the field of art, design, fashion, communication and performing arts; organising, arranging and conducting workshops, seminars, lectures, tutorials, exhibitions, conferences, presentations and conventions for educational purposes; provision of electronic publications in the field of education, art, design, fashion, communication and performing arts; publication of books, films, texts, journals, magazines and periodicals in the field of education, art, design, fashion, communication and performing arts; production of shows, films and video tapes; presentation of live performances and art displays; theatre productions; career advisory services; library services; museum services; art gallery services; arranging and conducting award ceremonies; accreditation services; provision of conference and exhibition services; consultancy advisory and information services in relation to all the aforesaid.

2) Universidad de Alicante (“the opponent”) oppose the trade mark based on Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is based on its earlier European Union Trade Mark (“EUTM”) no. 3504611 for the following mark:

UA

3) The following Class 41 services are relied upon in this opposition:

Education; providing of training; sporting and cultural activities.

4) The opponent argues that the respective marks are similar and if the services are not considered to be identical then they are certainly highly similar.

5) The applicant filed a counterstatement denying the claims made and requested that the opponent provides proof of use of its earlier trade mark relied upon. The counterstatement also includes various submissions on why it believes the marks to be distinguishable from one another. I have read these submissions and shall bear them in mind.


6) Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary. The applicant filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision.

7) A hearing took place via telephone on 15 May 2019, with the opponent represented by Mr Smyth of FR Kelly. The applicant did not attend but has been represented in these proceedings by Kempner & Partners LLP.

Evidence

8) The opponent's evidence consists of a witness statement and exhibits from Ms Carolina Molina of Disain IP. Disain IP are the opponent's representatives before EUIPO.

9) Exhibit CM1 to the witness statement consists of an extract from the opponent's website (www.ua.es), which states that the University was established in 1979, and has more than 33,000 students. The extract also stated that the opponent provides 123 official degrees plus 4 "UA degrees" which I take to be qualifications unique to the opponent. One of the extracts from the website states that the opponent's University "welcomes around 1,200 foreign students each year"¹. Most of the exhibit

includes the following mark  **Universitat d'Alacant**
Universidad de Alicante but many of the pages refer to UA. For example, one heading states "Research at UA" and "Research and Development projects – UA" is within the body of the text. Most of the extracts are undated with the few that are being before the relevant period (2008) or the date of printing, which is after the relevant period.

10) With regard to turnover, Ms Molina provides the following turnover figures which she states are for services provided under the mark "UA":

Year	Income (Euros)
2013	35,502,650
2014	35,926,963
2015	34,928,244.93
2016	37,292,500
2017	37,800,000
2018	36,520,000

11) A further detailed breakdown of turnover was presented as follows:

Revenue	2015 (euros)	2014 (euros)	2013 (revenue)
Tuition official studies	29,832,682	30,085,463	30,043,500
Tuition own studies	2,400,000	2,400,000	2,997,900
Courses and seminars	260,000	250,000	224,500
Cultural and sport activities	400,000	500,000	613,400
Inscriptions for conferences and	100,000	100,000	100,000

¹ Welcome message from the Office of University President.

similar			
Investigation in education and research	-	800,000	800,000
Investigation	1,935,562	1,791,500	723,350

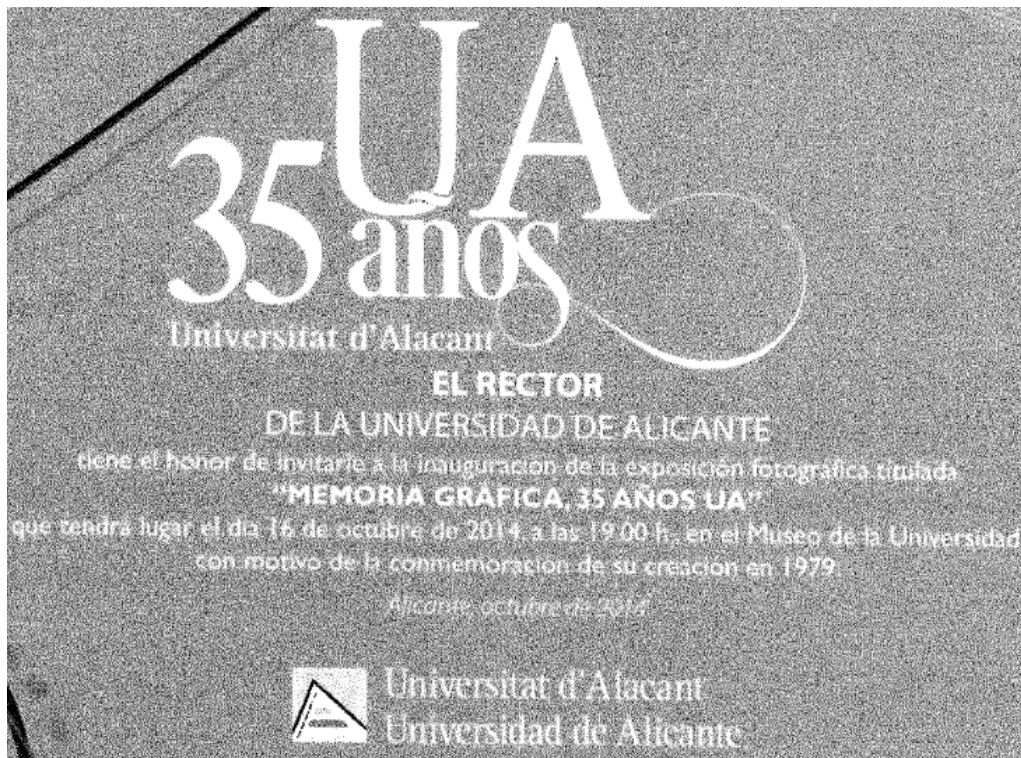
12) It should be noted that these figures have been gathered from an Affidavit² filed as an exhibit to Ms Molina's witness statement by Ms Monica Marti Sempere, who is the opponent's Vice Chancellor of Economic Planning.

13) Exhibit CM4 to the witness statement consists of various Spanish "brochures and leaflets" which include the mark UA. The opponent has provided very brief translations of what the events refer to which I list below:

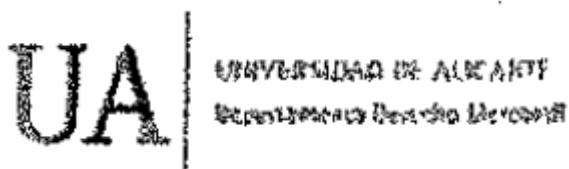
- Hiking trails in 2013-2014 and 2015-2016
- Rugby beach tournaments on 1 August 2018
- Official invitation to join the University Selection season 2012-2013
- Sport in "UA" for 2013-2014, monthly physical activities
- "Triathlon of business ideas 7 May 2015"
- Valencian Courses in UA 2015-2016

14) The exhibit also includes the following advertisement. The opponent has translated the text as follows: "...the University of Alicante has honor to invite you to the opening of the photo exhibition entitled "Graphic memory, 35 years UA" that will take place on October 16, 2014, at 19.00, at the Museum of the University, on the occasion of the commemoration of its creation in 1979":

² Exhibit CM2



15) There is a further advertisement for “Plant Variety Right Intensive Module being held at the University on 13 and 14 November 2014. The mark is presented as follows:



16) Further examples of the mark being presented in this form include advertisements promoting a Workshop of molecular and cellular techniques applied to the environment, from 26 October to 6 November 2015.

17) The mark UA is also present in a brochure for what appears to be a conference headed “Research Forum gender studies. The advantages in introducing...gender equality in your company? November 24, 2015”.

18) Exhibit CM5 consists of several photographs which include reference to the mark UA. Three of the photographs are of triathletes participating in an event held in 2013 and 2014. The exhibit also includes a photograph of what appears to be the front cover of the University’s prospectus which includes the mark UA but is not dated.

Further undated evidence³ is a list of undergraduate degrees available at the University. The extract includes references to UA at the top, but they are barely legible.

19) Exhibit CM6 consists of two archived extracts from the University's website obtained from the Wayback machine and exhibit CM7 are translations thereof. The first is in Spanish, dated 2015, and headed "RESEARCH AT THE UA". The article begins with "The University of Alicante is fully committed...". The second is dated 7 February 2014 and headed "The UA creates a spin-off for biological control...". The article begins by stating "The UA and the Alicante Science Park Alicante promote the creation...". Further extracts from the website⁴ are dated 9 and 26 April 2013 and headed "UA researchers create an unlimited colour palette..." and "UA researchers transform..." respectively.

20) Further Spanish press articles dated 2014 and 2015 have been filed under exhibit CM8 with "key information"⁵ for each of the 10 extracts being translated. The extracts include references to the University as UA relating to sporting events such as athletics, triathlons and football plus product development, engineering achievements and videogames being adapted for people with cerebral palsy.

21) Ms Molina acknowledges that many of the exhibits provided demonstrate use of the mark in Spain. However, she states that the trade mark UA is used internationally to promote its services to international students in the UK and throughout the EU. Exhibit CM10 to the witness statement includes extracts from the opponent's website which is headed "Admission with International Qualifications" with the sub-headings, *inter-alia*, "UA official Master's", "UA doctoral programmes", "UA postgraduate and specialised diplomas".

22) The opponent also submits copies of agreements and contracts involving the University which it claims to demonstrate use of the trade mark UA. They are dated 2013-2015. The opponent does not explain their relevance.

³ Save for the date it was printed, i.e. 22 November 2018.

⁴ Filed under exhibit CM7

⁵ Paragraph 11 of the witness statement

Proof of use

23) The earlier mark qualifies as an acceptable basis to oppose the application as defined in section 6 of the Act. Since the earlier mark was more than 5 years old at the date of publication of the application, and the applicant has requested proof of use, section 6A of the Act is applicable:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

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

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

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

Proof of use case-law

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

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009]

ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the

form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a

genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

25) Since the opponent’s earlier relied upon mark is an EUTM, I also take into account the Court of Justice comments in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, whereby it stated that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

26) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-

[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

27) The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

28) Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5-year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- iv) The geographical extent of the use shown

Relevant period

29) The relevant period for proof of use is the five-year period ending on the date of publication of the application in the UK, namely 28 April 2013 to 27 April 2018. Under section 100 of the Act the onus is on the opponent to show genuine use of its mark during this period in respect of the services relied upon.

Sufficient use?

30) Proven use of a mark which fails to establish *that “the commercial exploitation of the mark is real”* because the use would not be *“viewed as warranted in the economic sector concerned to maintain or create a share in the [European Union] market for the goods or services protected by the mark”* is therefore not genuine use.

31) An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁶

32) As indicated in the case law cited above, use does not need to be quantitatively significant to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as *“warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”*.

33) During the hearing Mr Smyth was highly critical of the opponent’s evidence. For example, he argues that the use made of the mark is confined to Alicante, Spain. He states that since the services are provided *in situ* they can only be accessed in Alicante. As explained in the case law above, use in one Member State, or even one city, may be sufficient to prove use of an EUTM. Therefore, whilst I keep this valid criticism in mind it is one aspect of a multi-factorial assessment.

⁶ *New Yorker SHK Jeans GmbH & Co KG v OHIM* T-415/09

34) The applicant also states that the opponent's mark was never used in conjunction with a TM or ® symbol. However, this is not a requirement to demonstrate genuine use of the mark. Therefore, I dismiss this argument.

35) I do agree with the applicant that the evidence is not without fault. It is poorly presented and as identified by the applicant it has been filed by the opponent's representatives in Spain rather than being first hand which means it is hearsay. Hearsay evidence should be treated in line with the guidance provided in, inter alia, Tribunal Practice Notice ("TPN") 5 of 2009. Whilst the evidence is from a third party which does affect the weight attributed to it, there is no suggestion that it was presented in this way to conceal or misrepresent matters, nor that it was edited for these proceedings. Moreover, the opponent's claims are based on the contemporaneous documents filed as exhibits to the witness statement and so I am not relying upon statements made by Ms Molina. Taking these factors into account, I find that the evidence may be attributed reasonable weight.

36) It is true that it is the opponent's responsibility to provide sufficiently solid evidence to demonstrate proof of use of the registration in order to rely upon it; a task which should be relatively easy to attain⁷. On this point, I also note Mr Alexander's comments in *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14). He stated:

"The Registrar says that it is important that a party puts its best case up front with the emphasis both on "best case" (properly backed up with credible exhibits, invoices, advertisements and so on) and "up front" (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just "use it or lose it" but (the less catchy, if more reliable) "use it – and file the best evidence first time round- or lose it"
[original emphasis].

⁷ *Awareness Limited v Plymouth City Council*, Case BL O/236/13

37) Taking all of the above into account, whilst I sympathise and agree with the applicant's criticisms of the evidence, I find that the opponent has, on the balance of probability, genuinely used its mark. As identified by the applicant, the evidence demonstrates that the "UA" mark is ancillary to the University de Alicante house mark. However, given the significant turnover, the numerous advertisements, website usage and third-party press articles referring to "UA", these all build a sufficient picture to demonstrate that the mark has been genuinely used to a sufficient extent for it to be relied upon.

Fair specification

38) I must now consider whether, or the extent to which, the evidence shows use for all or only some of the relied upon goods. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

39) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

"iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

40) I begin by reminding myself that the services which the opponent must demonstrate genuine use are:

Education; providing of training; sporting and cultural activities.

41) The earlier relied upon services are broad and it is clear from the evidence that the use is not sufficient to warrant the extent of protection that the specifications currently provide. The opponent is essentially a university and the evidence demonstrates that there is a particular emphasis on holding sporting events. Accordingly, I find a fair specification to be:

University services; sporting activities carried out through a University.

42) Whilst I accept that University services are relatively broad, limiting the services any further would be pernicky.

Section 5(2)(b)

The law

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

The case-law

44) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods and services

45) 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”.

46) 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.

47) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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”.

48) 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."

49) The respective services to be compared are:

Earlier services	Applied for services
<p><i>University services; sporting activities carried out through a University.</i></p>	<p><i>Education, teaching, providing of training; entertainment; university services; university education services in the field of art, design, fashion, communication and performing arts; organising, arranging and conducting workshops, seminars, lectures, tutorials, exhibitions, conferences, presentations and conventions for educational purposes; provision of electronic publications in the field of education, art, design, fashion, communication and performing arts; publication of books, films, texts, journals, magazines and periodicals in the field of education, art, design, fashion, communication and performing arts; production of shows, films and video tapes; presentation of live performances and art displays; theatre productions; career advisory services; library services; museum services; art gallery services; arranging and conducting award ceremonies; accreditation services; provision of conference and exhibition services; consultancy advisory and information services in relation to all the aforesaid.</i></p>

50) The term *university services* are identically contained in both lists of services.

51) Applying the principle set out in *Meric*, the applied for *education, teaching, providing of training; university education services in the field of art, design, fashion, communication and performing arts; organising, arranging and conducting workshops, seminars, lectures, tutorials, exhibitions, conferences, presentations and conventions for educational purposes* are all sufficiently broad to contain, and therefore be identical to, the earlier *university services*.

52) Universities are high-level educational institutions which students study or train for educational qualifications. Universities also carry out research and publish their findings. They are services which will be sought by those seeking to gain qualifications. On this basis, I make the following findings, grouping the various services where appropriate.

Provision of electronic publications in the field of education, art, design, fashion, communication and performing arts; publication of books, films, texts, journals, magazines and periodicals in the field of education, art, design, fashion, communication and performing arts

53) As previously stated, students, professors and lecturers of universities conduct research and publish their findings. These findings will be published in paper and e-formats and so the trade channels and users of the respective services may overlap. However, I do not consider them to be in competition nor complementary. Accordingly, I find there to be a low to medium degree of similarity between the services.

Library services; Career advisory services

54) Library users are looking for books to read for leisure, reference or for educational purposes. Therefore, there is an overlap in users between library services and university services. However, they differ in nature, trade channels and are not in competition with one another. In other words, those that are seeking to gain an educational qualification will not consider using library services as an alternative. Taking all of these into account, I find that there is (at best) a low degree of similarity.

55) I also consider it likely that most universities will offer career advice for students for once they leave university and so the uses will overlap. They are not in competition with one another and I do not consider them to be complementary, nevertheless I consider the services to be similar to a low degree.

Arranging and conducting award ceremonies

56) Arranging and conducting award ceremonies are not educational services *per se*. However, universities will arrange an award ceremony at the end of the academic year to celebrate the successful completion of the mode of study. Therefore, I consider there to be a complementary relationship and overlap in user since one would expect the university to also arrange and conduct the award ceremony. They are similar to a low degree.

Provision of conference and exhibition services

57) The applied services listed above could involve conference and exhibition services for educational purposes which may be provided through universities. Universities often host and provide conferences and exhibitions. Therefore, there is an overlap in users and nature, to a limited extent. I do not consider them to be in competition since you would not choose to attend a conference or exhibition rather than attend university, nor are they complementary since they are not indispensable to one another. I find that they are similar to a medium degree, at best.

Accreditation services

58) Accreditation is the act or process of recognising someone or something as having met a certain standard or status. Many universities will be “accredited” by the bodies but they will not provide such services themselves. Therefore, they are different in nature, they are not in competition or complementary to one another. They are dissimilar to all of the opponent’s services.

Museum services; art gallery services

59) With regard to the above-mentioned services, I do not find there to be any similarity. The users of *museums* and *art gallery services* are not the same as those seeking university services (and even less so for *sporting activities carried out through a University*). They are also different in nature, purpose and are certainly not in competition with one another. They are dissimilar.

Entertainment; production of shows, films and video tapes; presentation of live performances and art displays; theatre productions

60) All of the above services are various types of entertainment. The production of shows, films and video tapes typically refers to performances or recordings aimed at entertaining others. The opponent's services are aimed at people seeking to gain qualifications or participate in sporting events at universities. Therefore, the core nature of the respective services differ. I do accept that some universities (or their students) may organise shows, films, etc either through the courses they provide or through student unions. However, applying the principles set out in the *Treat* case I do not consider there to be similarity.

61) With regard to the term *consultancy advisory and information services in relation to all the aforesaid*, to the extent that the consultancy and advisory services relate to services where I have found similarity then there will be a degree of similarity between the consultancy and information and the applicant's services.

Comparison of marks

62) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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.”

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

64) The respective trade marks are shown below:

Earlier mark	Opposed mark
UA	ual:

65) The earlier mark is comprised of the letter string UA which is presented in fairly standard type-face and capital lettering. The overall impression lies in the mark as a totality.

66) The opposed mark consists of the lowercase standard font letters “ual” followed by a colon. Whilst the colon does contribute to the distinctive character of the mark, the letters “ual” dominate the overall impression.

67) In making my visual comparison of the respective marks, I bear in mind that notional and fair use of the marks would include use in both upper and lower case⁸, so letter case is irrelevant to the comparison. The respective marks coincide with the first two letters being U and A, but the opposed mark also includes the letter “l” followed by a colon, neither of which are present in the earlier mark. It is accepted that the shorter a mark the more prominent any differences become. Therefore, I find that the marks are visually similar to a below medium degree, but not low.

68) Aurally, both marks will most likely be perceived as abbreviations or acronyms, they will be pronounced by reference to each letter, i.e. U-A and u-a-l respectively.

⁸ See *Peek & Cloppenburg v OHIM*, T-386/07 at paragraph 47 and *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, C-291/0 at paragraph 54.

The colon in the opposed mark will not be verbalised. Accordingly, I find that there is a medium degree of verbal similarity.

69) Conceptually, the applicant argues that since the marks incorporate the letter U it is likely to indicate to the average consumer that the letter stands for University. During the hearing Mr Smyth referred to universities such as UWIC (University of Worcester), UCL (University of London), UEA (University of East Anglia). In his written submissions he lists 13 other universities which have trade mark registrations which being with the letter “U”. However, it is noted that two are in Ireland and two in the US. In the absence of sufficient cogent evidence, I do not consider universities abbreviating their names to be a fact too notorious to be the subject of serious dispute⁹. With this in mind, I find that neither mark has any meaning and so a conceptual comparison is not possible resulting in the position being conceptually neutral.

Average consumer and the purchasing act

70) 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*.

71) 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

⁹ See Ms Anna Carboni’s comments, sitting as the Appointed Person, in *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08.

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

72) Consumers of the services in question would ordinarily be members of the public who are seeking education. They could be (relatively) young people of traditional university age, but also older people. The applicant argues that “the relevant public will be extremely attentive as to the service provider in defining where the educational services will be provided, the qualification to be achieved and the costs associated therewith”. I accept that the selection process for an appropriate service provider in this field is likely to be a fairly considered one, but not to the extent that the applicant argues.

73) The marks will be encountered on brochures, prospectus, websites etc., all of which suggests a predominantly visual process, but aural considerations should not be ignored due to the impact of speaking to people at career and educational fairs etc.

Distinctive character of the earlier trade mark

74) 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).”

75) The opponent has not explicitly claimed that it has an enhanced degree of distinctive character by virtue of the use made of it. Even if it had done so, given the flaws identified in the evidence listed above I would not have concluded that there was sufficient use.

76) From an inherent perspective, the earlier mark capitalised letters “UA”. The mark is not descriptive or allusive for any of the services in question. However, acronyms are commonly used in the English language and therefore do not warrant any more than a medium degree of inherent distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

77) Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 parties’ goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

78) I have found that the respective marks are visually similar to a degree below medium, but not low. They are aurally similar to a medium degree and that a conceptual comparison is not possible and so the position is neutral. The respective services range from being identical to dissimilar. Since similarity between the services is a prerequisite for finding a likelihood of confusion under section 5(2)(b) the opposition fails in respect of the services where no similarity is found.

79) In respect of the remaining services I do not consider there to be a likelihood of direct confusion. Consumers are accustomed to encountering acronyms and can distinguish between signs when, as is the case here, there is an additional letter in the contested mark and the inclusion of a colon. They will not be directly confused.

80) I go on now to consider indirect confusion. This was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:¹⁰

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised 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’.

¹⁰ BL O/375/10

17. 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).”

81) I also bear in mind the guidance of Mr James Mellor QC, sitting as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH*:¹¹

“81.4. Fourth, I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’ (my emphasis).”

82) Whilst the examples given by Mr Purvis in *L.A. Sugar* are intended to be illustrative of the general approach rather than an exhaustive list, I conclude that

¹¹ BL O/547/17

there is no likelihood of indirect confusion.¹² I do not consider the additional 'l' and a colon to be a natural brand extension or variant so that the average consumer would consider the marks to stem from the same undertaking, or economically linked undertaking.

CONCLUSION

83) The opposition fails in its entirety and the application shall, subject to appeal, be accepted for registration.

COSTS

84) The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £900 as a contribution towards the cost of the proceedings. This reflects that the applicant has not filed evidence and is calculated as follows:

Considering the opponent's statement of case and preparing a counterstatement	£200
Considering and commenting on the other side's evidence	£300
Preparing for and attending a hearing	£400
TOTAL	£900

85) I therefore order Universidad de Alicante to pay University of the Arts, London the sum of £900. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this day of 16 August 2019

MARK KING

For the Registrar,

The Comptroller-General

¹² See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82]