

O-0730-23

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3651109
BY CAMBRIDGE MOLECULAR LTD
TO REGISTER

CAMBRIDGE MOLECULAR

AS A TRADE MARK
IN CLASSES 9 & 42
AND OPPOSITION THERETO (UNDER NO. 428078)
BY
THE CHANCELLOR, MASTERS AND SCHOLARS OF THE UNIVERSITY OF
CAMBRIDGE

Background & pleadings

1. Cambridge Molecular Ltd (“the applicant”) applied to register the trade mark CAMBRIDGE MOLECULAR on 4 June 2021. The mark was published on 6 August 2021 in classes 9 and 42 for the following goods and services.

Class 9: Computer software in the field of medicinal chemistry; Computer software in the field of molecular biology; Computer software in the field of pharmaceuticals; Computer software in the field of molecular screening; Computer software in the field of machine learning; Computer software in the field of data science; Computer software in the field of machine learning for molecular screening or analysis; Computer software in the field of machine learning for pharmaceuticals.

Class 42: Cheminformatics services; Data science services in the field of medicinal chemistry; Data science services in the field of pharmaceuticals; Data science services in the field of molecular screening; Data science services in the field of molecular biology; Machine learning services in the field of medicinal chemistry; Machine learning services in the field of pharmaceuticals; Machine learning services in the field of molecular screening; Machine learning services in the field of molecular biology; Non-downloadable software; Non-downloadable software in the field of medicinal chemistry; Non-downloadable software in the field of molecular biology; Non-downloadable software in the field of pharmaceuticals; Non-downloadable software in the field of molecular screening; Non-downloadable software in the field of machine learning; Non-downloadable software in the field of data science; Non-downloadable software in the field of machine learning for molecular screening or analysis; Non-downloadable software in the field of machine learning for pharmaceuticals; Providing, hosting, managing, developing and maintaining applications, software, websites and databases in the field of molecular screening or analysis.

2. The Chancellor, Masters and Scholars of the University of Cambridge (“the opponent”) opposed the application in full on 8 November 2021 based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections

5(2)(b) and 5(3) the opponent relies on the following trade marks¹. Prior to the hearing referred to in paragraph 7 below, the opponent provided a revised table of goods and services relied on under section 5(2)(b) via an email dated 9 February 2023. This is set out in Annex 1 of this decision.

| | |
|---|--------------------------------|
| UK TM No.900896449 Section 5(3) Filing date: 4 August 1998 Registration date: 7 March 2000 | UNIVERSITY OF CAMBRIDGE |
| UK TM No.912019733 Sections 5(2)(b) & 5(3) Filing date: 26 July 2013 Registration date: 29 August 2015 | CAMBRIDGE |
| UK TM No.3243445 Sections 5(2)(b) & 5(3) Filing date: 13 July 2017 Registration date: 20 July 2018 | CAMBRIDGE |
| UK TM No. 3268106 Sections 5(2)(b) Filing date: 3 November 2017 Registration date: 6 April 2018 | CAMBRIDGE ASSESSMENT |
| UK TM No.3294047 Sections 5(2)(b) | CAMBRIDGE MATHEMATICS |

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of the opponent having an EUTM being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade marks shown here are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing date.

| | |
|--|--------------------------|
| Filing Date: 2 March 2018 Registration date: 16 November 2018 | |
| UK TM No.2634072 Section 5(2)(b) Filing date: 10 September 2012 Registration date: 5 April 2013 | CAMBRIDGE ENGLISH |

3. Also in its email of 9 February 2023, the opponent set out a revised list of goods and services for which it claims a reputation under section 5(3). This is contained in Annex 2 of this decision.

4. Under section 5(4)(a) the opponent claims use of the sign **CAMBRIDGE** in the UK since the 13th Century AD for the same goods and services as set out in Annex 2.

5. The applicant submitted a counterstatement in which it denied all the grounds of opposition. In addition the applicant did not request that the opponent should be put to proof of use.

6. Both sides are represented in these proceedings. The applicant is represented by Basck Limited and the opponent by Keltie LLP.

7. Both sides filed evidence. A hearing was requested and was held before me on 21 February 2023. The applicant was represented by Aaron Wood of Brandsmiths, instructed by Basck and the opponent was represented by Guy Tritton of Counsel, instructed by Keltie. Both sides filed skeleton arguments in advance of the hearing.

8. I make this decision based on a reading of all the material before me and the submissions presented at the hearing.

9. 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.

Preliminary issues

10. At the hearing Mr Tritton identified earlier marks nos. 912019733 (“the ‘733 mark”) and 3243445 (“the ‘445 mark”), both for **CAMBRIDGE** solus, as being the opponent’s best case. With that in mind I will proceed with this decision in relation to these marks and their respective goods and services and will return to the other earlier marks if it proves necessary to do so.

Opponent’s evidence in chief

11. The opponent filed a witness statement in the name of Andrea Ward, Head of Brand and Trade Marks at the University of Cambridge. Ms Ward appended 24 exhibits. I have read and considered the evidence provided. I do not intend to summarise every exhibit in detail but will highlight those which are most pertinent.

12. Firstly, Ms Ward states that there has been a continuous site of teaching, learning, education and research in Cambridge since the university’s foundation in 1209. Moreover she states

“The University has consistently referred to itself as simply CAMBRIDGE, and is known as such, due to its fame and reputation. There is no need to include the words “The University of”, because the public knows that in the contexts of education, publishing, sport, academia and research the word CAMBRIDGE always refers to the University of Cambridge”.

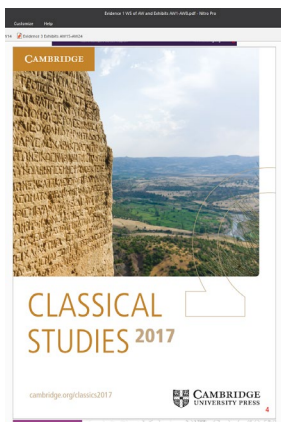
13. The annual turnover for the opponent is given as

| Year ending 31 July | Income (£millions) |
|---------------------|--------------------|
| 2016 | 1,799 |
| 2017 | 1,870 |
| 2018 | 1,965 |

| | |
|------|-------|
| 2019 | 2,192 |
| 2020 | 2,075 |

14. In addition Ms Ward states that the opponent is consistently ranked as one of the best universities in the world according to the “most influential and widely observed” university ranking authorities². The university also provides English language examination services in addition to examinations at GCSE, A level and International Baccalaureate under CAMBRIDGE formative brands such as CAMBRIDGE ASSESSMENT, CAMBRIDGE ENGLISH and CAMBRIDGE INTERNATIONAL³.

15. Ms Ward also refers to the prestige of the opponent’s publishing service under the Cambridge University Press (“CUP”) which is stated to be the world’s oldest publisher. In addition to having published several books of historical significance, the opponent publishes books and journals (both print and electronic formats) for a number of academic subjects.⁴ There are examples given of catalogues and eBooks where the word ‘CAMBRIDGE’ solus is used in addition to Cambridge University press, viz



16. Ms Ward makes reference to a number of media articles dated between 2010 and 2015 about the opponent, where the article refers to ‘CAMBRIDGE’. These include articles from the BBC, The Guardian, The Independent and Daily Mail online⁵. Headlines include

- Maths prodigy, 15, makes Cambridge history

² Exhibit AW4

³ Exhibits AW5 & 6

⁴ Exhibits AW7 & 8

⁵ Exhibit AW12

- Chip and pin ‘weakness’ exposed by Cambridge researcher
- Candyfloss girl who conquered Cambridge

17. Turning to the opponent’s research services, Ms Ward states that between 2008 and 2017, £3.3bn was received in research grants from a broad range of donors which include UK Government Departments, the European Commission, multi-national companies and charities. She also gives a short abstract of some of the research projects undertaken and a summary of the news/press coverage the research received. Ms Ward lists the large number of awards won by researchers at the university for a diverse range of research projects in the Arts, Humanities and Science fields and also presents a list of Cambridge University related Nobel prize winners.⁶ Furthermore Ms Ward states that in addition to research carried out within the university’s six schools, namely Arts and Humanities, Humanities and Social Science, Clinical Medicine, Technology, Physical Sciences and Biological sciences, there are also two additional groups, “Strategic Research Initiatives & Networks” and “Interdisciplinary Research Centres” set up for multi-disciplinary research and building research capabilities and collaborations. These group are staffed by the Opponent’s employees and their websites hosted on the opponent’s domain name, namely **cam.ac.uk** . The Strategic Research Initiatives & Networks include,

- Cambridge Big Data
- Cambridge Academy of Therapeutic Sciences
- Cambridge Cardiovascular
- Cambridge Public Policy
- Synthetic Biology in Cambridge
- Cambridge Trustworthy Technologies
- Cambridge Digital Humanities
- Cambridge Immunology
- Cambridge Metabolic Network
- Public Health at Cambridge
- Cambridgesens Strategic Network for Sensor Research at Cambridge University

⁶ Andrea Ward Witness statement paragraphs 36-40 and Exhibits AW10 to AW17

The Interdisciplinary Research Centres include,

- Cambridge Stem Cell Institute
- Cambridge Infectious Diseases
- Cambridge Language Sciences
- Cambridge Neuroscience
- CRUK Cambridge Centre
- Energy@Cambridge

18. Ms Ward exhibits three screenshots illustrating the opponent's laboratory research facilities. The first is taken from the website of the Cambridge Clinical Research Centre and has ©2020 in its footer and a reference to 2015 underneath the photographic image of the Cambridge Biomedical Campus. The second image is taken from the opponent's website and features The Sainsbury Laboratory Cambridge University (SLCU) which also has a date of ©2020 in its footer. The third image is also from the opponent's website and features information on The Cavendish Laboratory which is part of the opponent's Department of Physics. The screenshot is undated but has a news feed sidebar which include articles dated January and September 2020.

19. Ms Ward also states that the opponent founded an initiative known as "Cambridge Enterprise" in 2007 as a way for researchers "to commercialise their expertise and ideas and share University research with industry and government". Cambridge Enterprise is stated to have dealt with £105m worth of contracts and licensing of research between 2008 and 2017.

20. Ms Ward's evidence also draws attention to the "Cambridge Cluster", a term given to the various business parks situated within the Cambridge area which comprise a large number of technological and science based companies. Ms Ward states:

"It is my belief that the name CAMBRIDGE as used in respect of research has become synonymous with the University, and is understood to refer to the

University. When there is research being undertaken under the Cambridge name, that name refers to the University of Cambridge. This is due in part to the strong connection that the University has to the 'Cambridge Cluster', a set of companies and industry initiatives that has been built upon the research of the University, and which grows under the support and aegis of the University.”⁷

21. Ms Ward goes on to state that through Cambridge Enterprise and another University founded company Cambridge Initiative Capital plc,

“The University also contributes to the growth of the cluster by carrying out research which is commercialised, and by providing solutions to business problems through consultancy activity and through the licensing of discoveries to new and existing companies. Cambridge Enterprise currently manages 1,473 active IP, licensing and consultancy projects and more than 74 equity contracts, working with more than 1,714 researchers at all stages of the commercialisation process. In year ending 31 July 2017 it invested £5.2 million in spin out companies. In addition the University has been behind the formation of Cambridge Innovation Capital. Cambridge Innovation Capital plc (CIC) develops IP-rich companies emerging from the University of Cambridge or based in the Cambridge Cluster. It is a preferred investor for the University and has financial support from the Cambridge University Endowment Fund. In August 2016, CIC raised £75 million from a range of existing and new investors, including further funding from the Cambridge University Endowment Fund, to increase its capital resources to £125 million. During 2016-17, CIC invested £41 million of these funds as it helped eight new and 11 portfolio businesses to develop their plans further.”⁸

22. Specifically in relation to research in science and molecular science fields, Ms Ward states that the opponent has published a series of textbooks and research material, via CUP, between 2003 and 2017 under the title 'Cambridge Molecular

⁷ Ibid, paragraph 46

⁸ Andrea Ward First Witness statement paragraph 47

Science'⁹. Ms Ward also exhibits screenshots (undated but with ©2022 in the footer) from the opponent's website giving a summary of the opponent's undergraduate course material in relation to biology and molecular biology¹⁰. With regard to collaboration with outside bodies in the field of molecular science research, Ms Ward states that the opponent houses The Innovation Centre of Digital Molecular Technologies and the Centre for Molecular Informatics within its aegis. These centres involve the opponent's own academic researchers funded by SMEs and pharmaceutical multinational organisations to support research and development of molecular science in various fields such as medicine, genetics and pathology among others¹¹. The screenshots in the exhibit are undated, although a date of 2019 is given within a hyperlink embedded in the text. The screenshots also contain details of the Innovation Centre's commercial partners such as Eli Lilly, Astra Zeneca and GSK among others.

23. Ms Ward also states that approximately 130 research projects were carried out by the opponent in conjunction with commercial partners in the field of molecular science between 2014-2018¹².

24. Finally, Ms Ward ends her evidence with examples of where the opponent's research has been commercialised and developed into new treatments for a number of medical conditions including vasculitis, osteoporosis, lung cancer and Covid 19.¹³

Applicant's evidence

25. The applicant filed three witness statements in support of its application. The first witness statement is filed in the name of Alan Wiltshire, Contracts Director at Cambridge Consultants, who appends 5 exhibits. The second witness statement is filed in the name of Guy Peter Lewy, Founder and Director of the applicant, who appends 8 exhibits. Finally there is a witness statement filed in the name of Christian Bunke, Founder and Director of Basck Ltd who are the applicant's appointed legal representatives. Mr Bunke appends 3 exhibits.

⁹ Exhibit AW20

¹⁰ Exhibit AW21

¹¹ Exhibit AW24

¹² Andrea Ward First Witness statement paragraph 61

¹³ Exhibit AW24

26. Mr Wiltshire's evidence comprises some contextual information from Wikipedia (dated 28 June 2021), The Guardian/Observer (dated 1 December 2013) and The Telegraph (dated 14 October 2009) on the growth of the "Silicon Fen", also known as the Cambridge Cluster, the term given to the various business parks situated within the Cambridge area which over some 5 decades have become synonymous with the start-ups of significant technological and science based companies. Mr Wiltshire's own company, Cambridge Consultants, is stated to be one of the keys to the success of the business parks. The Wikipedia article says that the first business park, "The Cambridge Science Park", was founded in 1970 as an initiative of Trinity College, one of the colleges of Cambridge University¹⁴.

27. Mr Lewy's evidence is focussed on the nature of the applicant's business and how it attracts its customers through networking and building relationships. He also focusses on the differences between the applicant's customers and the opponent's customers. The former being pharmaceutical and Biotech companies and the latter being young people seeking educational provision. Mr Lewy also provides information on the number of companies registered at Companies House using the word "Cambridge" within their company names.

28. Mr Bunke's evidence is largely a rebuttal of the Opponent's evidence in chief. He states that the use of CAMBRIDGE is only used within media articles as a reference to the opponent as an educational institution.

Opponent's evidence in reply

29. The opponent filed a second witness statement in the name of Andrea Ward. Ms Ward reiterated two exhibits¹⁵ within her previously given evidence which she said indicated that CAMBRIDGE was used in relation to research services in addition to its use to refer to the educational institution.

30. That concludes my summary of the evidence.

¹⁴ Exhibit AW2

¹⁵ Exhibits AW12 & 25

Section 5(2)(b)

31. 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”.

32. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

33. The following principles are gleaned from the judgments 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 C3/03, *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 the 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 greater 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 to mind the earlier mark, is not sufficient;

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

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

Comparison of the goods and services

34. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*¹⁶, the court stated at paragraph 23 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”.

35. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case¹⁷, 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;

¹⁶ Case C-39/97

¹⁷ [1996] R.P.C. 281

(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.

36. I also find that the following case law is useful in these proceedings where in *Gérard Meric v Office for Harmonisation in the Internal Market (“OHIM”)*¹⁸, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

37. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

38. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose

¹⁸ Case T- 133/05

of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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

Whilst on the other hand:

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

39. The goods and services to be compared are:

| Opponent’s goods & services | Applicant’s goods & services |
|---|--|
| <p><u>The ‘733 mark</u> Class 9: computer software</p> | <p><i>Class 9: Computer software in the field of medicinal chemistry; Computer software in the field of molecular biology; Computer software in the field of pharmaceuticals; Computer software in the field of molecular screening; Computer software in the field of machine learning; Computer software in the field of data science; Computer software in the field of machine learning for molecular screening or analysis; Computer software in the field of machine learning for pharmaceuticals.</i></p> |

The '445 mark

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; research, testing and analysis services; computer-aided research, testing and analysis services; laboratory research, testing and analysis services; scientific research, testing and analysis; industrial research, testing and analysis; medical research, testing and analysis; technological research, testing and analysis; biological research, testing and analysis; chemical research, testing and analysis; physics research, testing and analysis; biochemical research, testing and analysis; biomedical research, testing and analysis; biotechnological research, testing and analysis; bacteriological research, testing and analysis; therapeutics research, testing and analysis; chemical engineering research, testing and analysis; genetic engineering research, testing and analysis; pharmaceutical research, testing and analysis; scientific research and development; medical research and development; industrial research and development; technological research and development; pharmaceutical research

Class 42: Cheminformatics services; Data science services in the field of medicinal chemistry; Data science services in the field of pharmaceuticals; Data science services in the field of molecular screening; Data science services in the field of molecular biology; Machine learning services in the field of medicinal chemistry; Machine learning services in the field of pharmaceuticals; Machine learning services in the field of molecular screening; Machine learning services in the field of molecular biology; Non-downloadable software; Non-downloadable software in the field of medicinal chemistry; Non-downloadable software in the field of molecular biology; Non-downloadable software in the field of pharmaceuticals; Non-downloadable software in the field of molecular screening; Non-downloadable software in the field of machine learning; Non-downloadable software in the field of data science; Non-downloadable software in the field of machine learning for molecular screening or analysis; Non-downloadable software in the field of machine learning for pharmaceuticals; Providing, hosting, managing, developing and maintaining applications, software, websites and

and development; information technology research and development; consultancy relating to research, testing, analysis and development in the fields of science, medicine, drug discovery, engineering, therapeutics, technology, information technology; providing technical advice in the fields of science, medicine, drug discovery, engineering, therapeutics, technology, information technology, preparation of scientific reports; preparation of medical reports; preparation of technical reports; preparation of technological reports; providing advice, information and data relating to research, analysis, testing and development in the fields of science, medicine, drug discovery, engineering, therapeutics, technology, information technology; providing information and data relating to research, analysis, testing and development in the fields of science, medicine, drug discovery, engineering, therapeutics, technology, information technology from an on-line searchable database; development and testing of computing methods, algorithms and software; software engineering; scientific surveys; drug discovery services; drug development services; clinical trials; DNA screening for

databases in the field of molecular screening or analysis.

| | |
|--|--|
| <i>scientific research purposes; genetic testing for scientific research purposes;</i> | |
|--|--|

Class 9

40. In its skeleton argument dated 17 February 2023¹⁹, the applicant conceded that its entire class 9 specification is identical under the *Meric* principle to *computer software* at large in class 9 of the opponent's '733 mark.

Class 42

41. In the same document²⁰, the applicant conceded that its terms *Cheminformatics services; Data science services in the field of medicinal chemistry; Data science services in the field of pharmaceuticals; Data science services in the field of molecular screening; Data science services in the field of molecular biology; Machine learning services in the field of medicinal chemistry; Machine learning services in the field of pharmaceuticals; Machine learning services in the field of molecular screening; Machine learning services in the field of molecular biology* were identical under *Meric* to the following terms in the opponent's '445 registration namely *Scientific and technological services; computer-aided research, testing and analysis services; development and testing of computing methods, algorithms and software; software engineering*.

42. Turning to the applicant's remaining services in class 42, I take first the non-downloadable software terms namely *Non-downloadable software; Non-downloadable software in the field of medicinal chemistry; Non-downloadable software in the field of molecular biology; Non-downloadable software in the field of pharmaceuticals; Non-downloadable software in the field of molecular screening; Non-downloadable software in the field of machine learning; Non-downloadable software in the field of data science; Non-downloadable software in the field of machine learning for molecular screening or analysis; Non-downloadable software in the field of machine learning for pharmaceuticals*. I find these services to be highly similar to the opponent's *computer software* in class 9 of the '733 mark. The nature

¹⁹ Paragraph 8

²⁰ Paragraphs 9, 10 and 11

of the software is only slightly different in that one is either in physical or downloaded form on a device whereas the other is not able to be downloaded to a device but can be used via another method. The purpose of the software will be the same and there will be a crossover of users and trading channels.

43. This leaves the applicant's terms *Providing, hosting, managing, developing and maintaining applications, software, websites and databases in the field of molecular screening or analysis*. In its skeleton argument and at the hearing, the opponent accepted these services were more directly comparable to services within its registrations for **CAMBRIDGE ASSESSMENT** and **CAMBRIDGE MATHEMATICS** rather than its **CAMBRIDGE** solus marks. However the '733 mark has *computer software* and the '445 mark has the term *design and development of computer software*, both are terms which I find overlap to some extent with the applicant's terms. Software itself can be purchased from an undertaking who also provide related services such as updates, patches and fixes. There would be an overlap in user and trade channels. As such I find there is some complementarity leading me to find similarity to a low degree.

Average consumer and the purchasing process

44. I next consider who the average consumer is for the contested goods and services and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.²¹ 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.²²

45. The average consumer for the goods and services at issue will likely be a technical or scientific specialist, being either an individual or a business. The goods and services will be selected by primarily visual means probably through online means such as websites or through technical literature. There is also an aural element to consider if advice is sought from technical staff. Given that the specialist

²¹ *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)

²² *Lloyd Schuhfabrik Meyer*, Case C-342/97.

nature of the contested goods and services and their purpose in the scientific field is to aid research and development, they are likely to be relatively expensive.

Therefore I find the consumer will be paying a high degree of attention during the purchasing process.

Comparison of the marks

46. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*²³, 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.”

47. 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.

48. The respective trade marks to be compared are:

| | |
|--------------------------|----------------------------|
| Opponent's registrations | Applicant's mark |
| CAMBRIDGE | CAMBRIDGE MOLECULAR |

²³ Case C-591/12P

49. The opponent's two earlier marks are for the same single word namely **CAMBRIDGE** so any further references I make will cover both marks. There are no other aspects such as stylisation or devices so the overall impression is derived solely from the word itself.

50. The applicant's mark is a word mark comprising two words namely **CAMBRIDGE MOLECULAR** with no other aspect to it so again the overall impression is derived solely from the words themselves. However the applicant's goods and services relate to science so the **MOLECULAR** element of the mark has very weak distinctive character.

51. In a visual comparison the respective marks share the common word **CAMBRIDGE**. The point of difference is that the applicant has an additional word namely **MOLECULAR** which has no counterpart in the opponent's mark. This additional word makes a visual impact so overall I find there is a medium level of visual similarity.

52. In an aural comparison, I find the common element in the respective marks **CAMBRIDGE** will be pronounced identically in each case. Again the difference lies in the applicant's additional word **MOLECULAR**. I find there is a medium degree of aural similarity.

53. With regard to the conceptual comparison, the opponent for its part, in its skeleton argument, states that the shared word can mean both the English city and the university, but "to a significant group of people it will mean the university". Whereas the applicant states in its skeleton argument that the shared element **CAMBRIDGE** will be taken as a reference to the city. Clearly the applicant's additional word **MOLECULAR** will be understood by its usual dictionary definition as an adjective relating to molecules. Therefore the whole mark is slightly odd in a purely grammatical sense but is likely to be understood as something to do with molecules and Cambridge, which brings about a somewhat different concept to the earlier marks, albeit that the respective marks share the word **CAMBRIDGE**. Overall I find there is a medium degree of conceptual similarity

Distinctiveness of the earlier marks

54. The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive an earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer*²⁴ 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).”

55. Registered trade marks possess varying degrees of inherent distinctive character starting from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, scaling up to those with high inherent distinctive character, such as invented words.

²⁴ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

56. I begin by considering the inherent position. The word **CAMBRIDGE** is a city in the east of England where the opponent is located. Evidence from both sides referenced the “Cambridge Cluster” which the applicant states will reinforce its position that the word will be seen as the geographical location for its business whereas the opponent’s says will refer back to the university, as it has a “strong connection”²⁵ to the cluster, being “a set of companies and industry initiatives that has been built upon the research of the university and which grows under the support and aegis of the university”²⁶. I bear in mind the fact that Cambridge is a geographical location which the evidence shows is well-known by reference to its world-renowned University and that the average consumer is likely to be aware that there are industries and trades of various kinds (including sciences) in and around the City. Consequently, I would consider the **CAMBRIDGE** marks to have a low level of inherent distinctiveness.

57. Having considered the inherent position, I will consider whether the distinctiveness of the earlier marks has been enhanced through use. There was no specific use of the opponent’s class 9 goods, namely *computer software* at large albeit that there were some examples of smart device apps but under the names of Cam Reader, University of Cambridge Sports and DS Files²⁷. I understand that computer software may be considered as an integral part of research but there was no evidence demonstrating computer software itself was produced, marketed or sold under the opponents marks. With regard to the services, it is clear from the evidence provided the opponent has a substantial reputation as a provider of educational, university and academic services. In addition I find that the opponent has provided considerable evidence of its scientific research services which have been commercialised by means of partnerships with business and government. In particular the evidence provided pointed to an enhancement of the earlier registrations’ distinctiveness for the following services: *laboratory research, testing and analysis services; scientific research, testing and analysis; industrial research, testing and analysis; medical research, testing and analysis; technological research, testing and analysis; biological research, testing and analysis; chemical research,*

²⁵ Andrea Ward First Witness statement paragraphs 46 & 47

²⁶ Ibid.

²⁷ Exhibit AW11

testing and analysis; physics research, testing and analysis; biochemical research, testing and analysis; biomedical research, testing and analysis; biotechnological research, testing and analysis; bacteriological research, testing and analysis; therapeutics research, testing and analysis; chemical engineering research, testing and analysis; genetic engineering research, testing and analysis; pharmaceutical research, testing and analysis; scientific research and development; medical research and development; industrial research and development; technological research and development; pharmaceutical research and development; information technology research and development; consultancy relating to research, testing, analysis and development in the fields of science, medicine, drug discovery, engineering, therapeutics, technology, information technology; providing technical advice in the fields of science, medicine, drug discovery, engineering, therapeutics, technology, information technology, preparation of scientific reports; preparation of medical reports; preparation of technical reports; preparation of technological reports; providing advice, information and data relating to research, analysis, testing and development in the fields of science, medicine, drug discovery, engineering, therapeutics, technology, information technology; providing information and data relating to research, analysis, testing and development in the fields of science, medicine, drug discovery, engineering, therapeutics, technology, information technology from an on-line searchable database; development and testing of computing methods, algorithms and software; software engineering; scientific surveys; drug discovery services; drug development services; clinical trials; DNA screening for scientific research purposes; genetic testing for scientific research purposes. Therefore I find the distinctiveness of the earlier marks have been enhanced through use to a medium degree for these services.

Likelihood of confusion

58. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind²⁸. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency

²⁸ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

59. 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.

60. In *L.A. Sugar Limited*²⁹, Mr Iain Purvis Q.C., sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

61. So far in this decision I have found that,

- There is identity and similarity between the goods and services
- The average consumer is a technical or scientific specialist (whether an individual or a business) paying a high degree of attention in a predominantly visual purchasing process
- There is a medium degree of visual, aural and conceptual similarity between the respective marks

²⁹ *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

- The distinctiveness of the earlier marks is inherently distinctive to a low degree but have been enhanced through use to a medium degree for some services listed above in paragraph 57

62. The heart of this case is whether consumers seeing the applicant's mark would understand it as being a business undertaking molecular science in Cambridge (the English City) or being a business undertaking molecular science at or in conjunction with Cambridge (the University). The applicant, in the evidence of Guy Lewy, states it is the former and that "it is not unusual for businesses to wish to express their locality through their business and trading names". Mr Lewy also exhibits a list of 3260 active company registrations using the word Cambridge within their legal names³⁰. However this is not determinative to the trade mark decision I must make.

63. The opponent for its part has sufficiently demonstrated that it has used the word **CAMBRIDGE** solus in relation to both educational services and to scientific research including molecular science and that it has enhanced the distinctiveness of these marks with that use. I therefore find there is a likelihood of confusion. I do not find this it is a likelihood of direct confusion as there are sufficient differences between the marks for a consumer not to directly confuse the respective marks but I find there is likelihood of indirect confusion as the addition of the word **MOLECULAR** could be seen as a natural brand extension for goods and services in that specialist field.

Section 5(3)

64. The opponent opposes the contested trade mark under Section 5(3) of the Act on the basis of its earlier marks for which it claims to have a reputation. In particular the opponent argues that use of the contested mark "would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or repute of its earlier CAMBRIDGE or CAMBRIDGE- formative marks" for the following goods and services set out in its email dated 9 February 2023 namely *Printed matter; provision of training, teaching, examination and assessment services; education; provision of courses of instruction; lectures and seminars; arranging and conducting conferences and seminars; library services; publication services; provision of distance learning*

³⁰ Exhibit GPL04

courses; provision of recreational and sporting facilities; academic research; downloadable publications; educational consultancy; educational information services which have coverage in the '733 registration and *scientific research* which has coverage in the '445 registration

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

“5(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

66. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

67. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case C-252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a

characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

68. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its marks are similar to the applicant's mark. Secondly, it must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

69. In my previous assessment of the opponent's evidence I have found it has demonstrated the requisite reputation for educational services and for scientific research services including for molecular science. There was no evidence before

me in this case for the *provision of recreational and sporting facilities*, although I do not doubt that such services would ordinarily form part of a university's facilities for its student body. However no evidence was provided on this specific term so I shall not consider it further. The evidence that was provided showed that the opponent's educational and research services using the mark **CAMBRIDGE** are substantial. The opponent is consistently ranked as one of the world's best universities. It has won many prestigious awards and has generated far reaching research into a number of science fields including molecular science through grants and funding of approximately £3.3bn from a diverse range of sources including government, medical and pharmaceutical companies and other multi-nationals. In addition the research services have been successfully commercialised by the opponent through its own initiatives namely Cambridge Enterprise and Cambridge Initiative Capital. As a consequence I find that the opponent has demonstrated that its research services operate in both an academic and commercial sphere. Therefore I find the opponent has demonstrated a reputation for *Printed matter; provision of training, teaching, examination and assessment services; education; provision of courses of instruction; lectures and seminars; arranging and conducting conferences and seminars; library services; publication services; provision of distance learning courses; scientific research; academic research; downloadable publications; educational consultancy; educational information services.*

Link

70. Having found that the opponent has established the requisite reputation, I will go on to make the assessment of whether the public will make the required mental 'link' between the marks, taking account of all relevant factors. The factors identified in *Intel* (underlined below) are:

The degree of similarity between the conflicting marks

71. For the reasons given previously I find there is a medium degree of visual, aural and conceptual similarity

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

72. The applicant is seeking to register its mark for good and services in the field of molecular sciences. This is the same field for which the opponent has demonstrated a reputation more broadly in printed matter, publication services, educational services and research services. As such the relevant consumer concerned with molecular sciences will perceive the degree of closeness between the respective goods and services as identified in *Intel*.

The strength of the earlier mark's reputation

73. I found that the opponent's evidence has demonstrated a substantial reputation for *Printed matter; provision of training, teaching, examination and assessment services; education; provision of courses of instruction; lectures and seminars; arranging and conducting conferences and seminars; library services; publication services; provision of distance learning courses; scientific research; academic research; downloadable publications; educational consultancy; educational information services* in the UK at the relevant date.

The degree of the earlier marks' distinctive character, whether inherent or acquired through use

74. I found that the earlier marks are inherently distinctive to a low degree but that this has been enhanced through use to a medium degree in respect of *laboratory research, testing and analysis services; scientific research, testing and analysis; industrial research, testing and analysis; medical research, testing and analysis; technological research, testing and analysis; biological research, testing and analysis; chemical research, testing and analysis; physics research, testing and analysis; biochemical research, testing and analysis; biomedical research, testing and analysis; biotechnological research, testing and analysis; bacteriological research, testing and analysis; therapeutics research, testing and analysis; chemical engineering research, testing and analysis; genetic engineering research, testing and analysis; pharmaceutical research, testing and analysis; scientific research and development; medical research and development; industrial research and development; technological research and development; pharmaceutical research*

and development; information technology research and development; consultancy relating to research, testing, analysis and development in the fields of science, medicine, drug discovery, engineering, therapeutics, technology, information technology; providing technical advice in the fields of science, medicine, drug discovery, engineering, therapeutics, technology, information technology, preparation of scientific reports; preparation of medical reports; preparation of technical reports; preparation of technological reports; providing advice, information and data relating to research, analysis, testing and development in the fields of science, medicine, drug discovery, engineering, therapeutics, technology, information technology; providing information and data relating to research, analysis, testing and development in the fields of science, medicine, drug discovery, engineering, therapeutics, technology, information technology from an on-line searchable database; development and testing of computing methods, algorithms and software; software engineering; scientific surveys; drug discovery services; drug development services; clinical trials; DNA screening for scientific research purposes; genetic testing for scientific research purposes.

Whether there is a likelihood of confusion

75. Previously in this decision, I found a likelihood of indirect confusion.

76. Taking the above factors into account, I find that the required link will be made.

Damage

77. I next assess whether unfair advantage will arise, as claimed by the opponent.

78. I bear in mind that unfair advantage has no effect on the consumers of the goods/services of the earlier marks, but instead the taking of unfair advantage of the reputation and distinctive character of earlier marks means that consumers are more likely to purchase the goods and services of the later mark than they would otherwise have done if they had not been reminded of the earlier marks.

79. In *Jack Wills Limited v House of Fraser (Stores) Limited*³¹, Arnold J. (as he then was) considered the earlier case law and concluded that:

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

80. As set out above, I found sufficient evidence that the opponent enjoys a reputation for *Printed matter; provision of training, teaching, examination and assessment services; education; provision of courses of instruction; lectures and seminars; arranging and conducting conferences and seminars; library services; publication services; provision of distance learning courses; scientific research; academic research; downloadable publications; educational consultancy; educational information services*. Given the strength of that reputation and the identity and complementarity of the goods and services, it is clear that there is the potential for the applicant to gain an unfair commercial advantage, namely benefitting from the opponent's reputation without paying financial compensation.

81. As damage is made out on the basis of unfair advantage, it is not necessary for me to go on and consider the other heads of damage.

³¹ [2014] EWHC 110 (Ch)

82. The opposition is therefore successful under section 5(3).

Section 5(4)(a)

83. The opponent opposes the application under Section 5(4)(a) of the Act on the basis of its alleged earlier rights in the sign **CAMBRIDGE**, for which it claims use in the UK since the 13th Century AD for *printed matter; provision of training, teaching, examination and assessment services; education; provision of courses of instruction; lectures and seminars; arranging and conducting conferences and seminars; library services; publication services; provision of distance learning courses; provision of recreational and sporting facilities; scientific research; academic research; downloadable publications; educational consultancy; educational information services*. The opponent moreover claims that use of the applicant's mark in the course of trade "would amount to a misrepresentation to the public causing damage".

84. Section 5(4)(a) states:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

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

85. Subsection (4A) of Section 5 states:

"(4A) 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.”

86. The three elements which the opponent must show are therefore goodwill; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation.³²

Relevant date

87. In terms of the relevant date for assessment of this ground, in *Advanced Perimeter Systems Limited v Multisys Computers Limited*,³³ Mr Daniel Alexander QC, sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*:³⁴

‘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.’”

88. Therefore the relevant date in this case is the filing date for the applicant’s mark namely 4 June 2021.

Goodwill

89. The first hurdle is for the opponent to show that it had the requisite goodwill at the relevant date and that the sign relied upon, **CAMBRIDGE**, is associated with, or distinctive of, that business.

³² *Discount Outlet v Feel Good UK* [2017] EWHC 1400 (IPEC), Her Honour Judge Melissa Clarke, sitting as a deputy judge of the High Court.

³³ BL O-410-11

³⁴ BL O-212-06

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

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

91. Given my previous analysis of the opponent's evidence, I find that it has established sufficient goodwill for *printed matter; provision of training, teaching, examination and assessment services; education; provision of courses of instruction; lectures and seminars; arranging and conducting conferences and seminars; library services; publication services; provision of distance learning courses; scientific research; academic research; downloadable publications; educational consultancy; educational information services* at the relevant date. As per my finding under section 5(3), there was no evidence provided in this case for *provision of recreational and sporting facilities* so I do not need to consider this term further.

Misrepresentation

92. Having cleared the first hurdle of goodwill I now go on to consider the second hurdle of misrepresentation. In *Neutrogena Corporation and Another v Golden Limited and Another*³⁵, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is “is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

³⁵ [1996] RPC 473

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

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

93. On the subject of how many of the relevant public must be deceived or confused for the opponent to be successful in a claim under this ground, I bear in mind the decision in *Lumos Skincare Limited v Sweet Squared Limited and others*³⁶, where Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the “substantial number” of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

94. Accordingly, once it has been established that the party relying on the existence of an earlier right under section 5(4)(a) had sufficient goodwill at the relevant date to found a passing-off claim, the likelihood that only a relatively small number of

³⁶ [2013] EWCA Civ 590

persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

95. I have found that the opponent has established goodwill in the sign **CAMBRIDGE** for printed matter, publication services, educational services and research services relating to molecular science. The contested mark is **CAMBRIDGE MOLECULAR** which I have found to be visually, aurally and conceptually similar to a medium degree. The parties both operate in the field of molecular science.

96. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires "a substantial number of members of the public are deceived" rather than whether the "average consumers are confused". However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*³⁷, it is doubtful whether the difference between the legal tests will produce different outcomes. I find that misrepresentation will occur in respect of the contested goods and services as they are in competition with those goods and services of the opponent.

Damage

97. Having found that the goodwill and misrepresentation limbs of the test have been satisfied, damage to the opponent's goodwill can be inferred, the most obvious example being the diversion of trade from the opponent to the applicant.

98. In conclusion I find the opposition succeeds under section 5(4)(a).

Conclusion

99. The opposition has been successful and subject to any appeal against this decision, the application will be refused.

³⁷ [2012] EWCA (Civ) 1501

Costs

100. The opponent has been successful and is entitled to a contribution to its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the TPN, I award costs as follows:

| | |
|--------------|---|
| £200 | Official fee |
| £600 | Preparing a statement and considering the counterstatement |
| £1500 | Preparing evidence and considering the applicant's evidence |
| £1000 | Preparing for and attending the hearing |
| £3300 | Total |

101. I order Cambridge Molecular Ltd to pay The Chancellor, Masters and Scholars of the University of Cambridge the sum of £3300. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 31th day of July 2023

June Ralph
For the Registrar
The Comptroller-General

Annex 1

UK TM No. 912019733 CAMBRIDGE

Class 9: *Computer software*

UK TM No. 3243445 CAMBRIDGE

Class 42: *Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; research, testing and analysis services; computer-aided research, testing and analysis services; laboratory research, testing and analysis services; scientific research, testing and analysis; industrial research, testing and analysis; medical research, testing and analysis; technological research, testing and analysis; biological research, testing and analysis; chemical research, testing and analysis; physics research, testing and analysis; biochemical research, testing and analysis; biomedical research, testing and analysis; biotechnological research, testing and analysis; bacteriological research, testing and analysis; therapeutics research, testing and analysis; chemical engineering research, testing and analysis; genetic engineering research, testing and analysis; pharmaceutical research, testing and analysis; scientific research and development; medical research and development; industrial research and development; technological research and development; pharmaceutical research and development; information technology research and development; consultancy relating to research, testing, analysis and development in the fields of science, medicine, drug discovery, engineering, therapeutics, technology, information technology; providing technical advice in the fields of science, medicine, drug discovery, engineering, therapeutics, technology, information technology, preparation of scientific reports; preparation of medical reports; preparation of technical reports; preparation of technological reports; providing advice, information and data relating to research, analysis, testing and development in the fields of science, medicine, drug discovery, engineering, therapeutics, technology, information technology; providing information and data relating to research, analysis, testing and development in the fields of science, medicine, drug discovery, engineering, therapeutics, technology, information technology from an on-line searchable database; development and testing of*

computing methods, algorithms and software; software engineering; scientific surveys; drug discovery services; drug development services; clinical trials; DNA screening for scientific research purposes; genetic testing for scientific research purposes

UK TM No. 3268106 CAMBRIDGE ASSESSMENT

Class 9: Computer software

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; research and development of new products for others; surveying; technical research; conversion of computer programs and data, other than physical conversion; electronic data storage; data encryption services; technical research; hosting of digital content; computer services; online hosted computer services; cloud computing; software as a service; databases; providing information on computer technology via a website; website design consultancy; designing, managing and monitoring online forums for discussion; creating electronically stored web pages for online services and the internet information, advisory and consultancy services relating to the aforesaid services.

UK TM NO. 3294047 CAMBRIDGE MATHEMATICS

Class 9: Computer software

Class 42: Research services; design and development of computer hardware and software; conversion of computer programs and data, other than physical conversion; data encryption services; technical research; mathematical research services; providing information and data relating to research, analysis, testing and development in the fields of science, medicine, drug discovery and communications from an on-line searchable database; development and testing of computing methods, algorithms and software; software engineering; hosting of digital content; computer services; online hosted computer services; cloud computing; databases; providing information on computer technology via a website; creating and

maintaining websites for others; creating and designing website based indexes of information for others; creating and designing website based indexes of information for others [information technology services].

UK TM No. 2634072 CAMBRIDGE ENGLISH

Class 9: Computer software

Annex 2

Goods and services relied on by the opponent under section 5(3) & 5(4)(a):

Printed matter; provision of training, teaching, examination and assessment services; education; provision of courses of instruction; lectures and seminars; arranging and conducting conferences and seminars; library services; publication services; provision of distance learning courses; provision of recreational and sporting facilities; scientific research; academic research; downloadable publications; educational consultancy; educational information services.