

O/0787/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF  
INTERNATIONAL REGISTRATION NOS. 1589095 & 1589087  
DESIGNATING THE UNITED KINGDOM  
IN THE NAME OF KING'S EDUCATION LIMITED  
FOR THE FOLLOWING TRADE MARKS:



IN CLASS 41

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NOS. 430320 & 430324  
BY THE CORPORATION OF KING'S COLLEGE SCHOOL

## **Background and pleadings**

1. On 14 January 2021, King's Education Limited (“the holder”) registered the international trade marks displayed on the cover page of this decision, under numbers 1589095 and 1589087 (“the first IR” and “the second IR”, respectively; collectively “the IRs”). With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IRs under the terms of the Protocol to the Madrid Agreement. The IRs both claim a priority date of 20 October 2020 (Spain). Protection of both IRs is sought in relation to the following services:

Class 41: Entertainment and educational services; information regarding education; information related to education, provided online from a computer database or from the Internet; organization and conducting of face-to-face educational forums, training workshops, colloquiums, conferences, seminars and symposiums; teaching by correspondence courses; organization of online seminars; teaching services; language teaching services; organization of exhibitions for cultural and educational purposes; publishing of texts (other than advertising); publication of books; providing electronic publications online (not downloadable by telematic means); electronic publication of books and periodicals on line (not downloadable); provision of publications online; publication of electronic texts; publication of texts other than advertising texts; book lending; blogging services.

2. The IRs were published for opposition purposes on 15 October 2021. On 18 January 2022, The Corporation of King's College School (“the opponent”) opposed the protection of the IRs in the UK based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. For the purposes of its claims under section 5(2)(b), the opponent relies upon the following trade marks:

**KING'S COLLEGE SCHOOL**

UK registration no. 3175806

Filing date: 19 July 2016

Registration date: 11 November 2016

("the first earlier mark")

**King's College School**

UK registration no. 2594483

Filing date: 14 September 2011

Registration date: 30 December 2011

("the second earlier mark")

4. The first earlier mark is registered in respect of goods and services in classes 16, 18, 25 and 41. However, for the purposes of its claims under this ground, the opponent only relies upon the following services:

Class 41: Education; education services; school services; day school services; tuition; arranging of courses of instruction; conducting educational courses; educational examination services; provision of educational examination facilities; providing facilities educational purposes; arranging for students to participate in educational courses; arranging for students to participate in educational activities; arranging for students to participate in recreational activities; arranging for students to participate in recreational courses; arranging of award ceremonies; arranging of award ceremonies to recognise achievement; publication of educational teaching materials; publication of books; publication of texts; arranging musical and theatrical events; provision of facilities for musical and theatrical events; arranging and conducting conferences, seminars and exhibitions; arranging group recreational activities; organising events for cultural purposes; organisation of exhibitions for cultural or educational purposes; physical education instruction; sporting education services; provision of sports and recreational facilities; sports club services; providing sports tuition, coaching and instruction; sports entertainment services; sports camp services; organising of sports and sports events; organising of sports competitions.

5. As for the second earlier mark, the opponent relies upon '*education independent school*' in class 41, the only service for which it stands registered.

6. The opponent's marks qualify as earlier marks in accordance with section 6 of the Act. As the first earlier mark had not completed its registration process more than five years before the priority date claimed by the IRs, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all the services identified, without having to demonstrate genuine use. The second earlier mark had completed its registration process more than five years before the priority date claimed by the IRs. It is, therefore, subject to the proof of use provisions.

7. The opponent claims that the IRs are similar to its earlier marks and that the parties' services in class 41 are identical or similar. On this basis, the opponent submits that there is a likelihood of confusion. In respect of the second earlier mark, the opponent made a statement of use within its notice of opposition.

8. Under section 5(4)(a), the opponent claims that it has a protectable goodwill in relation to which it has used the signs **KING'S COLLEGE SCHOOL**, **KING'S COLLEGE** and **KING'S** throughout the UK since 1829. The signs are said to have been used in respect of the services listed above at paragraph 4. The opponent argues that the similarity between the signs and the IRs, as well as the identity or similarity between the parties' respective services, would give rise to misrepresentation and damage.

9. The holder filed counterstatements, denying the grounds of opposition. Within its counterstatements, it indicated that it would require the opponent to demonstrate use of the second earlier mark. Moreover, whilst the holder concedes that some of the parties' services are identical or similar, it disputes that there is a likelihood of confusion under section 5(2)(b). It also argues that a large number of undertakings (including the holder) have been using names such as 'KING'S COLLEGE' and 'KING'S' in respect of educational services, and have peacefully co-existed in the UK, for many years. As for the claims under section 5(4)(a), the holder put the opponent to proof of its alleged goodwill and denies that there would be misrepresentation or damage.

10. On 4 May 2021, the proceedings were consolidated pursuant to rule 62(1)(g) of the Trade Marks Rules 2008.

11. Both parties filed evidence in these proceedings. A hearing was requested and held before me, by video conference, on 26 May 2023. The opponent was represented by Jamie Muir Wood of counsel, instructed by Farrer & Co LLP. The holder was represented by Jessie Bowhill of counsel, instructed by Bear & Wolf (UK) LLP. Both filed skeleton arguments in advance of the hearing.

12. 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 and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

### **Evidence**

13. The opponent's evidence in chief is given in the witness statement of Andrew Stewart, dated 1 July 2022, and one accompanying exhibit (AS1). Mr Stewart is the Deputy Bursar of the opponent. Mr Stewart's evidence goes to the opponent's use of the earlier marks.

14. The holder's evidence in chief is given in the witness statement of Nadim Marwan Nsouli, dated 5 September 2022, and sixty-nine accompanying exhibits (NMN1 to NMN69). Mr Nsouli is the Director of the holder. He is also the Founder, Chairman and CEO of the Inspired Education Group ("Inspired"), which he says owns the group of companies of which the holder is a part. Mr Nsouli's evidence predominantly goes to the background and activities of the holder, as well as third-party use of the word 'KING'S'.

15. The opponent filed evidence in reply in the form of the second witness statement of Mr Stewart, dated 7 November 2022, and one accompanying exhibit (AS2). His second statement serves to respond to Mr Nsouli's evidence.

16. Following a request which was granted by the Registrar, the holder filed additional evidence consisting of the witness statement of Carmen Ortega, dated 6 March 2023, and nine accompanying exhibits (CO1 to CO9). Ms Ortega is an Attorney at Balder IP Law S.L., a firm of Spanish attorneys who instruct the holder's UK representatives. Ms Ortega contends that her evidence goes to the probity and weight that ought to be placed on Mr Stewart's evidence.

17. After being permitted time by the Registrar in which to do so, the opponent filed evidence in reply to the holder's additional evidence. This is given in the third witness statement of Mr Stewart, dated 14 April 2023, and one accompanying exhibit (AS3). Mr Stewart responds to Ms Ortega's evidence within the same.

18. I have read all the evidence and will return to it to the extent I consider necessary in the course of this decision.

### **Preliminary remarks**

19. In her evidence, Ms Ortega outlines that the parties have been engaged in opposition proceedings in India, regarding the opponent's designation of International Registration number 1325475 in that territory ("the Indian proceedings").<sup>1</sup> Documents relevant to that opposition have been provided.<sup>2</sup>

20. Ms Ortega also exhibits an affidavit from Anna Maria Clarke, sworn on 28 November 2019.<sup>3</sup> Ms Clarke was the Bursar of the opponent at the time of her affidavit. A printout from her LinkedIn page suggests that she held this position from 2016 to September 2022.<sup>4</sup> Ms Ortega highlights several parts of Ms Clarke's affidavit which, she says, directly contradict, or are inconsistent with, the opponent's position in these proceedings, as well as the direct evidence from Mr Stewart.<sup>5</sup> For example, I note that Ms Clarke makes the following statement, with other similar comments appearing throughout the affidavit:

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<sup>1</sup> Witness statement of Carmen Ortega, §§8

<sup>2</sup> Exhibits CO1-CO6 and Exhibit CO9

<sup>3</sup> Exhibit CO7

<sup>4</sup> Exhibit CO8

<sup>5</sup> Ortega, §§15-18

“[...] [the opponent’s] mark has already been peacefully co-existing with the [holder’s] mark since at least 50 years internationally, including in the home jurisdiction i.e. United Kingdom, and there is no reason why there shall be any likelihood of confusion/association now. Also, there are several ‘KING’S COLLEGES’ around the globe, a few of them even older than the [holder’s] school and the relevant public has been able to distinguish between them since time immemorial.”

21. In response, Mr Stewart highlights that these are different proceedings to those being conducted in India, in a different territory with different legal jurisdictions; he also says that the factual circumstances and marks at issue are different.<sup>6</sup> He states that the Indian proceedings were commenced before the COVID-19 pandemic and argues that there is no longer a distinction in the eyes of the public between online and physical schools with online offerings.<sup>7</sup> Mr Stewart clarifies that the statements as to co-existence in the Indian proceedings were in the context of the opponent’s desire to potentially establish a physical school in that territory, where co-existence could be possible with another physical school.<sup>8</sup> He adds that the holder designated its marks for protection in the UK once the shift to online education had already become established, and there is no geographical demarcation online.<sup>9</sup> Mr Stewart acknowledges that the holder ran a school in Tenbury called King’s College St. Michaels, which is now closed.<sup>10</sup> However, due to the holder never previously trading under ‘KING’S’ or ‘KING’S COLLEGE’ in the UK, he says that there was no issue of co-existence until its website was launched.<sup>11</sup> As Ms Clarke’s affidavit was prepared for the purposes of the Indian proceedings prior to that launch, he feels that there is no inconsistency.<sup>12</sup>

22. The above appears to raise two questions. Firstly, can Ms Clarke’s comments in the Indian proceedings be taken as an admission as to peaceful co-existence in these

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<sup>6</sup> Third witness statement of Andrew Stewart, §4

<sup>7</sup> Stewart 3, §6

<sup>8</sup> Stewart 3, §6

<sup>9</sup> Stewart 3, §§7-8

<sup>10</sup> Stewart 3, §10

<sup>11</sup> Stewart 3, §11

<sup>12</sup> Stewart 3, §11

proceedings and, secondly, do they affect the reliability of Mr Stewart's evidence. In respect of both questions, it is my view that the answer is no. Although the earlier marks are identical to that which formed the subject of the Indian proceedings (the base application of which is the first earlier mark) and the same services are at issue here, the holder's mark in those proceedings, i.e. 'KING'S COLLEGE' in word-only format, was not the same as the IRs which are the subject of these proceedings. In addition, Ms Clarke's comments were made in the context of the Indian proceedings, which concerned the application of Indian law in that territory, rather than these proceedings, which concern the application of UK law in this territory. Co-existence is fact specific, and the circumstances of the two sets of proceedings are, to my mind, too different to use Ms Clarke's comments against the opponent or Mr Stewart. Moreover, it seems to me that Ms Clarke and Mr Stewart – who are clearly two different individuals – have simply given their opinions as to the way in which the parties have been operating; neither claim to possess any knowledge of the law on peaceful coexistence. Whilst the two positions may seem unsatisfactory to the holder, the holder has not identified any authority which establishes that a party cannot make arguments in one set of proceedings which (on the face of it) appear to contradict its position in other proceedings in a different territory. The matter of whether there has been peaceful co-existence between the marks at issue in these proceedings will be determined on the basis of the evidence before me, and I do not consider Ms Ortega's evidence to provide any justifiable basis for disbelieving Mr Stewart.

23. I also note that Mr Nsouli claims that the opponent has been fully aware of the holder's use of 'KING'S COLLEGE' inside and outside of the UK.<sup>13</sup> He provides copy correspondence between the parties to support this contention.<sup>14</sup> The first is an email from Ms Clarke dated 2 March 2017. Although she acknowledges that the parties "share a prestigious name" and that the King's Group has "expanded internationally with great success", the email concerned proceedings in China. The second is a letter from Ms Clarke dated 24 April 2017. Whilst she suggests that the parties ought to agree terms upon which they might coexist, the letter was sent within the context of the Chinese proceedings. None of this evidence relates to these proceedings or,

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<sup>13</sup> Witness statement of Nadim Marwan Nsouli, §75

<sup>14</sup> Exhibits NMN52 and NMN53

indeed, use of the competing marks in the UK; it does not establish that the opponent was aware of any commercial activity in the UK under the IRs. To my mind, it is of no assistance to the holder.

24. Finally, Mr Nsouli gives an overview of several UK trade marks registered by the holder between 2006 and 2017, and states that they were not challenged by the opponent.<sup>15</sup> I must clarify that this will have no bearing on the outcome of these proceedings. Whether the opponent did or did not challenge the registration of other marks is not a relevant factor I must consider. A party's commercial and legal strategies are matters for them; they do not involve the Registrar. It is not open to me to infer the reasons for a party's decision to oppose or not oppose an application, for example, simply on the basis of the state of the register. Furthermore, Section 72 of the Act stipulates that registration shall be taken as *prima facie* evidence of the validity of a registered mark. Section 5(2) of the Act, for instance, turns upon whether the 'attacker' has an earlier trade mark compared to the mark under 'attack', as defined by section 6 of the Act. As I understand it, the holder has not sought to invalidate the registrations relied upon by the opponent in these proceedings. Consequently, the opponent's trade marks must be regarded as validly registered. Under this ground, a likelihood of confusion between the competing marks, based on their notional use throughout the UK, would be enough to justify the refusal of the IRs.

### **Section 5(2)(b)**

#### **The law**

25. Sections 5(2)(b) and 5A of the Act read as follows:

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

[...]

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<sup>15</sup> Nsouli §§84 and 85, Exhibit NMN55

(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.”

“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.”

26. 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:

(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.

## **My approach**

27. Within his skeleton argument, Mr Muir Wood indicated that the opponent no longer relied upon the second earlier mark for the purposes of this ground. I will, therefore, proceed on the basis of the first earlier mark only and will say no more about the second earlier mark.

## **Comparison of services**

28. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, [...] 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”.

29. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 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.

30. 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 OHIM*, Case T-325/06, the General Court 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”.

31. 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."

32. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold set out the following summary of the correct approach to interpreting broad and/or vague terms:

“[...] the applicable principles of interpretation are as follows:

- (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.
- (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.
- (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.
- (4) A term which cannot be interpreted is to be disregarded.”

33. At the hearing, Mr Muir Wood indicated that, for reasons of procedural economy, the opponent would focus on ‘*education*’ and ‘*education services*’ in class 41 of the first earlier mark. He argued that the holder’s services are all highly similar or identical to these services. Ms Bowhill, for the holder, conceded that the parties’ respective educational services are identical and that the remaining services were all similar. In the following assessment, I will follow Mr Muir Wood’s approach whilst bearing in mind the holder’s concessions.

*‘Entertainment [...] services’*

34. Mr Muir Wood argued that these services are highly similar, if not identical, to the opponent’s services, since entertainment services can be used to educate and education services can be entertaining. Whilst I appreciate that entertainment can be educational and vice versa, I do not agree that this renders the respective services identical or highly similar. The core purposes of entertainment and educational services are different, as are their fundamental natures. Although both are available to the general public at large, the holder’s services are used by those seeking enjoyment, whereas the opponent’s services target those seeking opportunities for learning. In my view, the respective services do not typically reach the market through

shared channels of trade; the opponent's services are typically accessed through learning establishments, whereas the holder's services will be purchased direct from the entertainment provider or, for instance, a ticket agency. I do not consider the respective services to be in competition, nor complementary in the sense outlined in case law. Taking into account all of the above, whilst giving effect to the holder's concession, I find that there is a low degree of similarity between the respective services.

*'[...] educational services; information regarding education; information related to education, provided online from a computer database or from the Internet; organization and conducting of face-to-face educational forums, training workshops, colloquiums, conferences, seminars and symposiums; teaching by correspondence courses; organization of online seminars; teaching services; language teaching services; organization of exhibitions for cultural and educational purposes'*

35. As noted above, the holder has conceded that the above services – categorised by Mr Muir Wood in his skeleton argument as “education services” – are identical to the opponent's services.

*'Publishing of texts (other than advertising); publication of books; providing electronic publications online (not downloadable by telematic means); electronic publication of books and periodicals on line (not downloadable); provision of publications online; publication of electronic texts; publication of texts other than advertising texts'*

36. Mr Muir Wood contended that the above services are complementary to the opponent's services because undertakings that provide education services also publish material in association with those services. On this basis, he submitted that the above services and the opponent's services are highly similar. I agree that, whilst the nature, method of use and core purpose of the respective services differs, there is a complementary relationship between them. Particularly considering the holder's services include the publication and provision of educational materials, the respective services are important to one another in such a way that customers may think that the responsibility for those services lies with the same undertaking. Moreover, the trade channels of the respective services overlap, since it is not uncommon for educational

establishments to publish or provide educational materials. There is also likely to be an overlap in user. Balancing the similarities against the differences, I would not go so far as to say the respective services are highly similar. Rather, I find that there is a medium degree of similarity between them.

*'Book lending; blogging services'*

37. Although Mr Muir Wood grouped these services of the IRs together with those compared at paragraph 36, I do not consider these to be “publishing services” for which the same findings can be applied. Firstly, although there is a connection between the above services and education services, I am not convinced that the relationship is sufficiently proximate to warrant a finding of complementarity; these services may operate entirely independently of one another, and I do not believe that consumers would think that they are provided by the same undertakings. Furthermore, there is no evidence to suggest that it is typical in trade for the respective services to reach the market through the same undertakings. There may be a degree of overlap in user insofar as users of educational services may also be users of book lending/blogging services. Overall, and bearing in mind the holder’s concession, I find that there is a low degree of similarity between the respective services.

### **The average consumer and the nature of the purchasing process**

38. The average consumer is deemed to be reasonably well informed, 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.<sup>16</sup>

39. 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:

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<sup>16</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97

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

40. At the hearing, Mr Muir Wood submitted that the average consumer would be a member of the general public, including parents and children in respect of educational services. He submitted that a medium to high level of attention will be paid by the average consumer of educational services. He also highlighted that the specifications are not limited to situations in which consumers will be selecting a school. In relation to entertainment services and publishing services, a varying level of attentiveness will be exhibited (submitting that, for the purposes of the assessment, those paying the lowest level of attention should be considered). Ms Bowhill focused upon the level of attention of consumers of educational services, contending that it would be extremely high.

41. Average consumers of educational services are likely to be members of the general public, whether that be adults or children. Such services are likely to be selected with varying frequency, from a one-off module or topic of learning to repeated enrolment on a course or at a school. The cost of the services will also vary; some will be inexpensive, whilst others will attract a significant outlay. The thought process for more occasional learning opportunities or seeking information about education may be fairly casual. However, some purchases will be far more important and involve a much more considered thought process. The average consumer will consider factors such as the quality of the services provided, previous outcomes, support, cost and (for educational services provided at a physical premises) the location of the provider. Whilst I appreciate Ms Bowhill’s argument in respect of selecting a school, particularly fee-attracting establishments, I concur with Mr Muir Wood’s overall assessment on the matter of the level of attention paid in respect of educational services, i.e. I find that, overall, between a medium and high level of attentiveness will be displayed. These services are typically purchased direct from the provider, after viewing information in

brochures or on the internet, or after attending the premises for an open day. For this reason, although I do not discount aural considerations in the form of discussions with the provider or word of mouth recommendations, it is my view that visual considerations will dominate the purchasing process.

42. Likewise, average consumers of *'entertainment [...] services'*, *'providing electronic publications online (not downloadable by telematic means)'*, *'provision of publications online'* and *'book lending'* are likely to be members of the general public. Although I appreciate that some entertainment services are only purchased occasionally, overall, these services are likely to be purchased relatively frequently for the purposes of satisfying an ongoing interest in entertainment or reading. In terms of outlay, most of the services are likely to be relatively inexpensive, whilst others (particularly some forms of entertainment) will be fairly expensive. The purchasing of these services is not likely to follow an overly considered though process. However, they are not merely casual purchases; consumers will have regard to factors such as the content/subject of the entertainment, the range of books or publications on offer, cost and ease of access when selecting the services. In light of all this, I find that, overall, the average consumer will demonstrate a medium level of attention during the purchasing process. The services are likely to be purchased directly from the provider or through ticket agencies after viewing information in printed materials or on websites, or after viewing the goods on shelves at the premises. As such, the purchasing process will be predominantly visual in nature. However, aural considerations in the form of word of mouth recommendations or discussions with the provider, for instance, cannot be excluded entirely.

43. To my mind, those wishing to use the remaining services, namely, *'publishing of texts (other than advertising); publication of books'*, *'electronic publication of books and periodicals on line (not downloadable)'*, *'publication of electronic texts; publication of texts other than advertising texts'* and *'blogging services'*, are more likely to be business or professional users, rather than the general public at large. Businesses may wish to engage with writing services for blogs to promote or discuss their goods or services, whereas authors would engage the services of a publisher (whether physical or electronic) to publish their works. I accept that the end product is likely to be directed towards the general public and that these consumers may wish to view a

particular blog or search the details of a publisher of a particular author, for example, but, generally, the provision of these services are not directed towards them. The services are likely to be relatively frequent purchases and, although their cost may vary, it is my view that, overall, they are likely to attract not insignificant sums. The average consumer will consider factors such as reach, previous performance of the publisher and artistic style and artistic appeal when purchasing the services. The selection is likely to be of relative importance, given the provider will thereafter be responsible for the circulation of the author's artistic works or responsible for creating content for the business' blog. It is my view that these consumers will demonstrate between a medium and high level of attention during the purchasing process. The services will be purchased direct from the provider after viewing information in printed materials or on the internet. As such, visual considerations will dominate the purchasing process. However, I do not discount aural considerations entirely, as it is possible that businesses and authors may wish to discuss the service offering prior to making a purchase.

### **Distinctive character of the earlier mark**

44. In *Lloyd Schuhfabrik Meyer*, 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 *WindsurfingChiemsee*, paragraph 51).”

45. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods and services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods and services will be somewhere in between. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

46. The first earlier mark is in word-only format and consists of the words ‘KING’S COLLEGE SCHOOL’. The words in the mark will be understood in accordance with their ordinary meanings. In combination, the words give the impression of a school operated by a college belonging to, established by, endorsed by or in some way connected with, a king.

47. At the hearing, Ms Bowhill submitted that the first earlier mark has no, or virtually no, inherent distinctive character. This was on the basis of the descriptiveness of the words ‘COLLEGE’ and ‘SCHOOL’, as well as her contention that the word ‘KING’S’ is a commonly used name in the education sector. Whilst I accept that the words ‘COLLEGE’ and ‘SCHOOL’ are descriptive of the services relied upon, I do not accept that the first earlier mark lacks distinctive character. As a registered trade mark (the validity of which is not in question in these proceedings), the mark must be assumed to have some distinctive character.<sup>17</sup> Moreover, I acknowledge Mr Nsouli’s evidence of other educational establishments in the UK whose names include the word ‘King’s’ and that these appear to be relatively widespread, geographically; in addition, at least some of them appear to have been in operation for a significant amount of time.<sup>18</sup>

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<sup>17</sup> *Formula One Licensing BV v OHIM*, Case C-196/11P

<sup>18</sup> Nsouli §§96-99; Exhibits NMN59 to NMN61

However, I do not accept that the plurality of similar names by which individual establishments are known, even in the same sector, can support the contention that the word 'KING'S' lacks distinctive character in respect of educational services. Such an argument is reminiscent of *Nude Brands Limited v Stella McCartney Limited and others* [2009] EWHC 2154 (Ch), in which Floyd J stated:

“29. Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly does not go as far as establishing ground 7(1)(d) - customary indication in trade. Ground 7(1)(b) is concerned with the inherent character of the mark, not with what other traders have done with it. The traders in question are plainly using the mark as a brand name: so I do not see how this use can help to establish that the mark consists exclusively of signs or indications which may serve to indicate the kind or quality or other characteristics of the goods, and thus support an attack under 7(1)(c).”

48. Although the word 'KING'S' is not extremely distinctive, particularly given the existence of other educational establishments also using it to designate trade origin, it is not descriptive or allusive of the services relied upon; it still reasonably distinctive, inherently. Given its relative position, as well as the fact that the words 'COLLEGE' and 'SCHOOL' are both descriptive of the services relied upon, it is my view that the distinctive character of the first earlier mark predominantly lies in the word 'KING'S'. Overall, I find that the first earlier mark possesses a medium level of inherent distinctive character.

49. Evidence has been filed by the opponent and I am now required to assess whether it has demonstrated that the first earlier mark had an enhanced degree of distinctive character at the relevant date of 20 October 2020.

50. Mr Stewart gives evidence that the opponent is an independent school and registered charity.<sup>19</sup> It was founded by Royal Charter on 14 August 1829,<sup>20</sup> and remained incorporated following the annulment of the Charter by the King's College London Act (1882).<sup>21</sup> According to Mr Stewart, the opponent was originally based on the Strand, London, and, during the Victorian period, offered educational services to youths; student numbers at this time were said to have been between 200 to 600 pupils.<sup>22</sup>

51. Mr Stewart states that the opponent has used the name 'KING'S COLLEGE SCHOOL', as well as variants including 'KING'S COLLEGE' and 'KING'S', since its incorporation.<sup>23</sup> Its premises in Wimbledon opened on 4 May 1897 with 181 pupils.<sup>24</sup> In the 2021/22 academic year, there were around 1,400 pupils at the opponent's school, aged between 7 and 18.<sup>25</sup> According to Mr Stewart, the opponent attracts pupils from across the UK; moreover, he says that it is common for families relocating to London from abroad to choose to live in south-west London to access the opponent's services.<sup>26</sup> Mr Stewart says that the opponent has over 6,700 alumni in over 47 countries across the world, but around 94% of those are based in the UK.<sup>27</sup>

52. Reports and financial statements in evidence establish that the opponent's turnover generated through tuition fees were as follows.<sup>28</sup>

<b>Year</b>	<b>Tuition fees (£)</b>	<b>Ancillary tuition fees (£)</b>	<b>Combined tuition fees (£)</b>
2016	27,396,000	571,000	27,967,000
2017	28,982,000	624,000	29,606,000
2018	29,275,000	489,000	29,764,000
2019	30,360,000	530,000	30,890,000

<sup>19</sup> The first witness statement of Andrew Stewart, §6

<sup>20</sup> Stewart 1, §6, and Exhibit AS1, page 1

<sup>21</sup> Exhibit AS1, pages 3-4

<sup>22</sup> Stewart 1, §7

<sup>23</sup> Stewart 1, §8

<sup>24</sup> Stewart 1, §9

<sup>25</sup> Stewart 1, §10

<sup>26</sup> Stewart 1, §18

<sup>27</sup> Stewart 1, §19

<sup>28</sup> Exhibit AS1, pages 10-25

2020	30,405,000	526,000	30,931,000
2021	32,215,000	483,000	32,698,000
<b>Total</b>	<b>178,633,000</b>	<b>3,223,000</b>	<b>181,856,000</b>

53. Sample invoices dated 22 August 2017, 2 August 2018, 31 July 2019, 8 July 2020 and 16 July 2021, relating to the payment of school fees, are in evidence.<sup>29</sup> The recipient details have been redacted, but the fees are charged in pound-sterling. The words 'KING'S COLLEGE SCHOOL' are visible in normal font throughout the invoices and the following figurative sign appears at the top of each invoice:



54. An extract from a bursary leaflet has also been exhibited.<sup>30</sup> Mr Stewart indicates that this was the latest edition at the time of his statement.<sup>31</sup> The same figurative sign is presented on the cover page, while the words 'King's College School' and 'King's' are visible in normal font throughout. The extract contains imagery of the school, as well as details about bursaries offered to new students.

55. In addition to the services provided at the opponent's physical premises, Mr Stewart explains that, since the outbreak of COVID-19 pandemic in March 2020, all pupils have been learning regularly online.<sup>32</sup> An online learning overview document (undated) is in evidence.<sup>33</sup> It says that 'King's' experienced three significant periods of remote learning: 19 March 2020 to June 2020, October to November 2020 and 1 December 2020 to 8 March 2021. It details pupils' experiences of attending lessons via Microsoft Teams and OneNote, a mixture of live and independent lessons and a full timetable of live lessons. It shows examples of pupils' online lesson work and

<sup>29</sup> Exhibit AS1, pages 26-30; Stewart 1, §11

<sup>30</sup> Exhibit AS1, pages 31-32

<sup>31</sup> Stewart 1, §12

<sup>32</sup> Stewart 1, §14

<sup>33</sup> Exhibit AS1, pages 44-47

contains positive testimonials from parents and pupils regarding the online provision of lessons.

56. Mr Stewart says that the opponent has invested considerable resources in the development of its brand.<sup>34</sup> I note that the opponent's marketing expenditure in the UK was as follows:<sup>35</sup>

<b>Year</b>	<b>Marketing expenditure (£)</b>
2016/17	126,888
2017/18	100,181
2018/19	128,147
2019/20	82,338
2020/21	68,899
<b>Total</b>	<b>506,453</b>

57. These figures relate to a range of activities, such as, for example, printing school publications, photography costs, school advertising and school website costs. The evidence suggests that the opponent spent a further £104,821 across this period in respect of producing its print and online prospectuses. Examples of marketing and advertising initiatives are in evidence,<sup>36</sup> which include samples of London bus adverts (2017 to 2021), banners for open days (2017 to 2020), newspaper and magazine advertisements (*The Times*: 2017, 2018; *The Evening Standard*; *Tatler*: 2019, 2020), prospectuses (2017 to 2021), the opponent's branded magazines (issued regularly and consistently between 1873 and 2021), as well as open day and event advertisements (2017 to 2020). The words 'King's College School' and 'King's' can be seen throughout.

58. Mr Stewart says that the opponent has maintained a website at [kcs.org.uk](http://kcs.org.uk) since 1999.<sup>37</sup> Printouts from the website have been provided.<sup>38</sup> The first is dated 16 January 1999 and was obtained via the *Wayback Machine*. The remainder are labelled as

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<sup>34</sup> Stewart 1, §22

<sup>35</sup> Exhibit AS1, page 143

<sup>36</sup> Exhibit AS1, pages 144-242

<sup>37</sup> Stewart 1, §24

<sup>38</sup> Exhibit AS1, pages 243-246

being from 2016, 2017 and 2022. The words 'King's College School' appear in normal font throughout the printouts, while those from 2016 onwards also use the word 'King's' solus. Mr Stewart says that the opponent also maintains social media accounts which are regularly updated.<sup>39</sup> Printouts from its Twitter, Facebook and Instagram accounts have been exhibited.<sup>40</sup> The printouts show that the opponent had 3,064 followers on Twitter and 2,696 followers on Instagram at the time of Mr Stewart's statement. Further, the opponent joined Twitter in January 2013. Its page is entitled 'King's News'. Its pages on the other platforms are entitled 'King's College School Wimbledon' and 'King's College School'. Mr Stewart says that the Facebook and Instagram accounts have been in operation since around October 2013 and July 2017, respectively, while its Facebook page has 2,747 followers.<sup>41</sup> The opponent also received national press coverage in 1914, 1939, 1953, 1963, 1987, 2000, and 2016 to 2018 in publications including *The Evening Standard*, *The Telegraph* and *Daily Mail*.<sup>42</sup>

59. An article from the *Sunday Times* is in evidence,<sup>43</sup> which ranked 'King's College School' as second in its 'Top 150 Independent Secondary Schools' feature, based upon average examination results between 2017 and 2019. Within *The Times* published school GCSE results in August 2017,<sup>44</sup> the opponent was ranked second for boys, with 96.3% of 159 students obtaining A\* and A grades. In 2018, it was ranked first in the *Sunday Times* Parent Power Schools Guide, based upon A-level and GCSE results in 2017.<sup>45</sup> The same *Sunday Times* feature based upon 2018 and 2019 results ranked the opponent third and fourth, respectively.<sup>46</sup>

60. The opponent has received numerous awards for the quality of its services.<sup>47</sup> For example, the opponent was awarded 'London independent secondary school of the year' in 2014/15 and 2017/18 by the *Sunday Times*; 'top boys' and co-educational independent school in the UK' in 2017 and 2018 by the *Sunday Times*; 'best for IB (International Baccalaureate)' in 2014 and 2016 by *The Week*; 'great for Oxbridge' in

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<sup>39</sup> Stewart 1, §25

<sup>40</sup> Exhibit AS1, pages 247-249

<sup>41</sup> Stewart 1, §25

<sup>42</sup> Exhibit AS1, pages 250-262

<sup>43</sup> Exhibit AS1, page 49

<sup>44</sup> Exhibit AS1, page 50

<sup>45</sup> Exhibit AS1, page 51

<sup>46</sup> Exhibit AS1, pages 52-54

<sup>47</sup> Stewart 1, §16; Exhibit AS1, pages 55-140

2020 by *The Week*; 'great for sixth form' in 2018 by *The Week*; and 'winner of the outstanding progress award' in 2015 by *Education Business Awards*. The opponent was also awarded 'excellent' in every category and '100% compliant' following inspections by the Independent Schools Inspectorate in 2012 and 2017, respectively. Within this evidence, the words 'KING'S COLLEGE SCHOOL' appear in normal font throughout, as does the figurative sign shown above. I also note that parents, students and reviewing bodies (such as the *Sunday Times*, *Tatler*, *The Good Schools Guide*, *The Telegraph Independent Schools Guide* and *Talk Education Review*) refer to the school as 'King's'.

61. No details have been provided by the opponent to indicate the size of the relevant market. Neither is there any evidence before me to that effect. However, Mr Stewart's evidence indicates that the first earlier mark has been used in relation to the opponent's school in Wimbledon for many decades. The school has thousands of alumni across the world, though an overwhelming majority are based in the UK. Even in the context of what I consider to be an extremely large market, the tuition/turnover figures shown in the reports and financial statements are significant; between 2016 and 2020, the school's combined tuition fees were in excess of £149million. Whilst I accept that a small proportion of the figures for 2020 may have resulted from turnover generated after the relevant date, in the context of the overall figures this is not determinative. A selection of invoices has been provided, which demonstrates the provision of education services under the first earlier mark prior to the relevant date. Use of the first earlier mark (or acceptable variants thereof) can also be seen in bursary leaflets, school materials and printouts of the school's website. I note that not insignificant sums were spent in marketing the opponent's brand; prior to the relevant date, around £500,000 was spent on a range of promotional activities, with a further £100,000 spent on producing print and online prospectuses. Evidence of such activities are in evidence, including London bus adverts, and newspaper and magazine adverts. Further, I note that promotional magazines were published by the opponent for many decades prior to the relevant date. A website for the school has been operated since 1999 and use of the first earlier mark is visible throughout the printouts provided. Printouts from the opponent's social media accounts are in evidence, albeit that there is no information as to where their followers are based. From the evidence, I note that the school, and the first earlier mark, has received

national press coverage for many years, and, prior to the relevant date, the school featured highly in school-ranking publications. The school received numerous awards for the quality of its education services prior to the relevant date and its inspection reports have been positive. Although it appears that the opponent's one physical establishment is in Wimbledon, the evidence suggests that it has a reach far outside of that location and that consumers across the UK have likely been exposed to the first earlier mark. Taking all of the above into account, I am satisfied that the distinctive character of the first earlier mark as a whole had been enhanced to between a medium and high level by the relevant date.



### **Comparison of trade marks**

62. It is clear from *Sabel* 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 *Bimbo* 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. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

64. The competing trade marks are as follows:

The first earlier mark	The first IR
<p style="text-align: center;"><b>KING'S COLLEGE SCHOOL</b></p>	
	<p style="text-align: center;">The second IR</p> 

Overall impressions

65. The first earlier mark consists of the words 'KING'S COLLEGE SCHOOL'. As it appears at the beginning of the mark and is neither descriptive nor allusive of the services relied upon, it is my view that the word 'KING'S' is more dominant in the overall impression of the mark. The words 'COLLEGE' and 'SCHOOL' are descriptive in the context of the relied-upon services and, as such, they play a much lesser role.

66. The first IR is figurative and comprises several elements. At the top of the mark appears a device, which consists of a stylised lion in the shape of a shield and a crown. The words 'KING'S ONLINE' are presented below the device element in a basic font. All of the elements are presented in blue or red. Although the eye is naturally drawn to elements of marks which can be read, given the relative size and positioning of the device, I am of the view that the device and the words dominate the overall impression of the mark in roughly equal measure. Of the words, the word 'KING'S' has much more impact, given that it appears first and the word 'ONLINE' merely indicates that the services are provided or accessed on the internet. The use of colour, whilst still contributing, plays a much lesser role in the overall impression.

67. The second IR is also a figurative mark. At the top of the mark sits the same lion and crown device. Below the device element appear the words 'KING'S COLLEGE ONLINE' in a basic font. For the same reasons as discussed above, it is my view that the device and the words dominate the overall impression of the mark in roughly equal measure. Of the words, the word 'KING'S' has the most impact. This is because it appears first and has no descriptive or allusive qualities. The word 'COLLEGE' is descriptive of the designated services, whilst the word 'ONLINE' simply indicates that the services are provided or accessed on the internet. As such, these words have less impact. Again, the use of colour provides a contribution, but plays a much lesser role in the overall impression.

### Visual comparison

#### *The first IR and the first earlier mark*

68. The competing marks are visually similar in that they both contain the word 'KING'S'; this word dominates the overall impression of the first earlier mark and forms part of the co-dominant element of the first IR. The common word also appears at the beginning of the competing marks (or the beginning of the verbal element in the first IR). Clearly, the competing marks are different from a visual perspective as the first earlier mark contains the words 'COLLEGE SCHOOL' and the first IR contains the word 'ONLINE'; although these elements play lesser roles in the respective overall impressions, they will not be overlooked entirely. Moreover, the first IR includes a

device; this element is co-dominant in the overall impression of the IR but has no counterpart in the first earlier mark. Bearing in mind my assessment of the overall impressions, I find that there is between a low and medium degree of visual similarity between the competing marks.

*The second IR and the first earlier mark*

69. These marks share the same visual similarities and differences as discussed above. However, the second IR also contains the word 'COLLEGE'. Given that this word is present in the first earlier mark, this increases the visual similarity between these competing marks, though to no more than a medium degree.

Aural comparison

*The first IR and the first earlier mark*

70. When confronted with the first IR, consumers will make no attempt to articulate the device. Moreover, although the word 'ONLINE' merely indicates services which are provided or accessed on the internet, that does not necessarily render it aurally invisible.<sup>48</sup> In this instance, it is my view that both words in the first IR will be pronounced and it, therefore, consists of three syllables, i.e. "KINGS-ON-LINE". The first earlier mark comprises four syllables, i.e. "KINGS-COL-LEGE-SCHOOL". The competing marks aurally coincide in that their respective first syllables are identical. This common syllable appears at the beginning of the competing marks. They differ in that the remaining syllables are distinct. Overall, I find that there is a medium degree of aural similarity between the competing marks.

*The second IR and the first earlier mark*

71. Again, consumers will make no attempt to articulate the device present in the second IR. I also maintain that the word 'ONLINE' will be pronounced in this IR, notwithstanding its clear informative meaning. Therefore, the second IR comprises five

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<sup>48</sup> *The Stockroom (Kent) Ltd V Purity Wellness Group Ltd*, Case BL O/115/22

syllables, i.e. “KINGS-COL-LEGE-ON-LINE”. The competing marks are aurally similar in that their respective first three-syllables are identical. They differ in the pronunciation of their respective endings. In my view, the competing marks are aurally similar to between a medium and high degree.

### Conceptual comparison

#### *The first IR and the first earlier mark*

72. As previously outlined, the words in the first earlier mark convey the concept of a school operated by a college belonging to, established by, endorsed by or in some way connected with, a king. The word ‘KING’S’ in the first IR will be understood as referring to something (unspecified) belonging to a king. The device serves to reinforce these royal connotations, given that crowns, lions and shields are commonly used in heraldic imagery (albeit not precisely in this form). The word ‘ONLINE’ will be understood as referring to the internet. The competing marks conceptually overlap to the extent that they both convey a sense of belonging to a king. They conceptually differ in that they both convey meanings that are not replicated by the other, i.e. those associated with the words ‘COLLEGE’ and ‘SCHOOL’ in the first earlier mark and the word ‘ONLINE’ in the first IR. However, I note that these differences are non-distinctive. Bearing in mind my assessment of the overall impressions, I find that the competing marks are conceptually similar to between a low and medium degree.

#### *The second IR and the first earlier mark*

73. The words ‘KING’S COLLEGE’ in the second IR convey the concept of a college belonging to, established by, endorsed by or in some way connected with, a king. This meaning is shared by the first earlier mark. Again, the device reinforces the connection with royalty. The competing marks conceptually differ in that the first earlier mark conveys the meaning associated with the word ‘SCHOOL’ and the second IR conveys the meaning of ‘ONLINE’; these meanings, although emanating from elements which play lesser roles in the respective overall impressions, are not common to both marks. I also note that these differences are non-distinctive. Overall, I find that there is a medium degree of conceptual similarity between the marks.

## **Likelihood of confusion**

74. 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. One such factor 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 services, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be mindful 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 they have retained in their mind.

75. Earlier in this decision, I concluded that:

- The parties' respective services are identical or similar to at least a low degree;
- Relevant consumers are likely to include members of the general public as well as business or professional users;
- The general public will exhibit either a medium or between a medium and high degree of attentiveness during the purchasing process;
- Business or professional users are likely to demonstrate between a medium and high level of attention during the purchasing process;
- The purchasing process is predominantly visual in nature, though aural considerations have not been discounted;
- The first earlier mark enjoys a medium level of inherent distinctive character, which has been enhanced to between a medium and high level through use;

- The overall impression of the first earlier mark predominantly lies in the word 'KING'S', while the words 'COLLEGE' and 'SCHOOL' play lesser roles;
- The device and the words 'KING'S ONLINE'/'KING'S COLLEGE ONLINE' dominate the respective overall impressions of the IRs in roughly equal measure;
- The first IR and the first earlier mark are visually and conceptually similar to between a low and medium degree, and aurally similar to a medium degree;
- The second IR and the first earlier mark are visually and conceptually similar to a medium degree, and aurally similar to between a medium and high degree.

76. At the hearing, Ms Bowhill submitted that there had been no instances of actual confusion between the parties and that this was a factor pointing away from there being a likelihood of confusion. However, while evidence of actual confusion may be persuasive where it exists, the absence of confusion in the marketplace is rarely significant. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchin LJ stated that:

“80. [...] the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

77. Furthermore, in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett LJ stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

78. For reasons that will become apparent when I come on to discuss honest concurrent use, I do not consider the evidence in these proceedings to be sufficient for the purposes of demonstrating that the marks in issue have been used side by side, or whether there has been any real possibility for confusion between them to occur. As such, I shall say no more about a perceived absence of actual confusion.

79. At the hearing, Mr Muir Wood conceded that there is no likelihood of direct confusion between the competing marks. Accordingly, the following global assessment will be limited to indirect confusion. Whilst direct confusion involves the average consumer mistaking one mark for the other, 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 services down to the responsible undertakings being the same or related. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, 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.

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).”

80. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.<sup>49</sup> I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.<sup>50</sup> The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.<sup>51</sup>

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<sup>49</sup> *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

<sup>50</sup> *Duebros Limited v Heirler Cenovis GmbH*, Case BL O/547/17

<sup>51</sup> *Liverpool Gin Distillery*

*The first IR and the first earlier mark*

81. I acknowledge that consumers may immediately notice and recall the differences between the competing marks; indeed, given that the device in the second IR plays an important role in its overall impression and the words 'COLLEGE SCHOOL' and 'ONLINE' in the competing marks will not be entirely overlooked, I consider it likely. Nevertheless, consumers will also identify the identical word 'KING'S'; this word dominates the overall impression of the first earlier mark and has most impact within a co-dominant element of the first IR. It also appears at the beginning of the competing marks' verbal elements, a position which is generally considered to have more impact.<sup>52</sup> Whether consciously or unconsciously, this will lead consumers through the mental process described in *L.A. Sugar*. I have found that the words 'COLLEGE' and 'SCHOOL' in the first earlier mark are descriptive of the services relied upon, whereas the word 'ONLINE' in the first IR merely describes services which are provided or accessed on the internet. To my mind, the removal of two descriptive words from the first earlier mark and the addition of the descriptive word 'ONLINE' readily lends itself to indicating a sub-brand or brand extension, i.e. the first IR will be seen as an alternate brand of the first earlier mark, shortening the latter and indicating that the services offered under the mark are provided or accessed online. Furthermore, distinctive though it may be, the inclusion of the device may be perceived as an alternate 'KING'S' mark with additional decorative elements. The same is true of the use of colour. Taking all of the above into account, I am satisfied that consumers – even paying a higher than medium level of attention – will assume a commercial association between the parties, or sponsorship on the part of the opponent. As a result, I consider there to be a likelihood of indirect confusion, even in relation to services which are only similar to a low degree.

*The second IR and the first earlier mark*

82. Again, consumers may immediately notice and recall the differences between the competing marks. This is considered likely, since the device in the second IR plays an important role in its overall impression and the words 'SCHOOL' and 'ONLINE' in the

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<sup>52</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

competing marks will not be entirely overlooked. However, consumers will also recognise the identical words 'KING'S COLLEGE'; the former dominates the overall impression of the first earlier mark and has most impact (of the verbal elements) in the second IR. It also appears at the beginning of the competing marks' verbal elements. This will similarly lead consumers through the mental process described in *L.A. Sugar*. I have found that the word 'SCHOOL' in the first earlier mark is descriptive of the services relied upon, whilst the word 'ONLINE' in the second IR simply informs consumers that the services are provided or accessed on the internet. It is my view that the removal of the word 'SCHOOL' and the addition of the word 'ONLINE' readily lends itself to a sub-brand or brand extension, i.e. the second IR will be seen as an alternate brand of the first earlier mark informing consumers that the services offered under the mark are provided or accessed online. As was the case with the first IR, although I accept that the device in the second IR is distinctive, its inclusion may be perceived as an alternate 'KING'S COLLEGE' mark with additional decorative elements. The use of colour is also likely to be seen in this manner. Taking all of this into account, I am satisfied that consumers – even paying a higher than medium level of attention – will assume a commercial association between the parties, or sponsorship on the part of the opponent. Consequently, I consider there to be a likelihood of indirect confusion, even where there is only a low degree of similarity between the services.

### **Honest concurrent use**

83. Within its counterstatements, the holder contended that it has been using trade marks with the words 'KING'S COLLEGE'/'KING'S' for many years in the UK educational sector without any confusion occurring with the opponent's marks. The holder then filed evidence outlining its background and activities. Ms Bowhill also advanced the holder's position regarding honest concurrent use at the hearing. Whilst I do not intend to reproduce the parties' submissions on this issue, I have taken them all into account in making the following assessment.

84. It is settled law that a long period of honest concurrent use may defeat a claim of confusion.<sup>53</sup> However, circumstances that give rise to this defence must be exceptional.<sup>54</sup>

85. Mr Nsouli says that Inspired is a global group of premium schools which owns and operates over 80 schools across five continents and educates over 60,000 students.<sup>55</sup> The first 'King's College' school was founded in 1969 in Madrid.<sup>56</sup> Since that time, the King's Group expanded, and more schools were opened; its schools are said to be located Spain, Panama, Latvia, Bahamas and Portugal.<sup>57</sup> Inspired acquired the King's Group in October 2019; however, Mr Nsouli confirms that the holder, being a UK registered company, owns, uses and licenses various 'KING'S COLLEGE' marks.<sup>58</sup>

86. Mr Nsouli says that the King's Group and its schools have always been intrinsically linked to the UK, even when operating outside of it.<sup>59</sup> A brochure, said to be from 2018/19,<sup>60</sup> has been provided, which states that its British schools are based in the UK, as well as in Spain, Panama, Latvia and Germany.<sup>61</sup> In the school enrolment figures for 2009 to 2019, none are given for UK schools. However, there are details about each school, including one in Worcestershire, England.

87. According to Mr Nsouli, 'KING'S COLLEGE' schools have provided high-quality education to thousands of students, both inside and outside the UK, under this name.<sup>62</sup> The King's Group was the winner of the 'Private Education group of the year' 2017/18, at an awards ceremony in London organised by *Education Investor Global*.<sup>63</sup> As part of the provision of education services, each school has used the 'KING'S COLLEGE' mark, as well as the school logo.<sup>64</sup> He adds that this is included on paperwork,

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<sup>53</sup> *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/09, and *Victoria Plum Ltd v Victorian Plumbing Ltd* [2016] EWHC 2911 (Ch)

<sup>54</sup> *Budejovicky Budvar*

<sup>55</sup> Nsouli, §6

<sup>56</sup> Nsouli, §15, Exhibit NMN1

<sup>57</sup> Nsouli, §17, Exhibits NMN3 to NMN9

<sup>58</sup> Nsouli, §18, Exhibits NMN10 and NMN11

<sup>59</sup> Nsouli, §20

<sup>60</sup> Nsouli, §20

<sup>61</sup> Exhibit NMN13

<sup>62</sup> Nsouli, §26

<sup>63</sup> Exhibit NMN12

<sup>64</sup> Nsouli, §25 and §27

marketing materials, in recruitment of staff and students, for internal training, internal human resources, internal financial purposes, and generally in relation to the running and operation of the schools.<sup>65</sup> Mr Nsouli says that the school logo has changed over time, but always consists of an image of a lion with the words 'KING'S COLLEGE' or 'KING'S GROUP'.<sup>66</sup> He provides an overview of the logos in use between the 1960s and 2019/20.<sup>67</sup>

88. Mr Nsouli gives evidence as to the holder's use of 'KING'S COLLEGE' and the school logos outside of the UK.<sup>68</sup> However, Mr Nsouli also provides an overview of use of such marks in the UK by the holder and wider King's Group. He says that the King's Group took over the premises of Saint Michael's College, Worcestershire, in 1992.<sup>69</sup> The school at these premises was opened that year as an independent international boarding school; the school offered secondary education to mostly international students.<sup>70</sup> A printout from *New Horizons Education* has been provided,<sup>71</sup> which describes 'King's College Saint Michael's' as a small and friendly international boarding school under one hour from Birmingham. It confirms that the school offers secondary education services and specialises in the teaching of English as a foreign language. It also indicates that boarding fees were £8,665 per term in 2016/17. Mr Nsouli says that the school was first named 'KING'S COLLEGE AT CLOISTERS'.<sup>72</sup>

89. Extracts from brochures and pricelists between 1991 and 1993 are in evidence.<sup>73</sup> The words 'KING'S COLLEGE IN CLOISTERS' can be seen in normal font throughout, as can the following logo:

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<sup>65</sup> Nsouli, §25

<sup>66</sup> Nsouli, §27

<sup>67</sup> Nsouli, §28-35, Exhibits NMN19-NMN23

<sup>68</sup> Nsouli, §39-50, Exhibits NMN13 and NMN24-NMN32

<sup>69</sup> Nsouli, §52

<sup>70</sup> Nsouli, §53

<sup>71</sup> Exhibit NMN33

<sup>72</sup> Nsouli, §55

<sup>73</sup> Exhibits NMN36 and NMN37



90. The contents of the brochures are in Spanish. The school fees are said to have been 2,200,000 pesetas (roughly £11,000) per year during this time. Prospectuses from 1995 and 1996 have also been provided.<sup>74</sup> They indicate that the school fees were over £3,000 per term. Whilst the 'King's Education Group' is mentioned, the logo of the school is as follows:



91. Mr Nsouli says that the school changed its name to 'KING'S COLLEGE SAINT MICHAEL'S' in 1997 and continued under that name until its closure in 2020.<sup>75</sup> Extracts from brochures and prospectuses from 1997 to 1999 and 2003 have been provided.<sup>76</sup> Indeed, they show use of this name in normal font during these years. The logo shown above at paragraph 89 can also be seen throughout. Fee schedules for 2018/19 and 2019/20 are also in evidence.<sup>77</sup> The words 'KING'S COLLEGE SAINT MICHAEL'S' and the logo are visible in the same. The schedules show that the fees for each academic year were over £27,000. Extracts from further prospectuses and marketing materials from 2017 to 2020 have been exhibited.<sup>78</sup> Mr Nsouli says that,

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<sup>74</sup> Exhibits NMN38 and NMN39

<sup>75</sup> Nsouli, §§60 and 61

<sup>76</sup> Exhibit NMN41

<sup>77</sup> Exhibit NMN42

<sup>78</sup> Exhibit NMN43

since the early 1990s, thousands of such materials have been printed and distributed to students, parents and schools in the UK and elsewhere.<sup>79</sup>

92. The holder's school at this location educated up to 120 boarding students annually.<sup>80</sup> For the years ending 31 August 2020 and 31 August 2019, turnover of SAINT MICHAEL'S COLLEGE (TENBURY) LIMITED (another member of the King's Group<sup>81</sup>) was over £2.4million and £2.3million, respectively.<sup>82</sup> A selection of invoices for the payment of school fees are in evidence.<sup>83</sup> They were sent from the school to customers in, *inter alia*, the UK, China, Thailand, Latvia and France. The invoices are dated between 18 July 2017 and 2 November 2018.

93. According to Mr Nsouli, the school was consistently ranked highly by the Office for Standards in Education and the Independent Schools Inspectorate.<sup>84</sup> A report by OFSTED from 2010 is in evidence, as is one by ISI in 2011; ratings across various categories were either good, excellent or outstanding.<sup>85</sup>

94. Due to the COVID-19 pandemic, the physical premises of Saint Michael's was closed at the end of June 2020.<sup>86</sup> In October of that year, Inspired announced its fully online offering 'KING'S COLLEGE ONLINE' for students in and outside of the UK.<sup>87</sup> This was launched in January 2021, as recorded by the *Financial Times*.<sup>88</sup> Printouts of the holder's website at kingscollegeonline.com have been provided.<sup>89</sup> The second IR is visible on the website, as are the words 'King's College Online' in normal font. The printout is undated, though indicates that enrolment for September 2021 was in operation.

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<sup>79</sup> Nsouli, §63

<sup>80</sup> Nsouli, §65, Exhibit NMN44

<sup>81</sup> Nsouli, §71, Exhibit NMN50

<sup>82</sup> Exhibit NMN45

<sup>83</sup> Exhibit NMN49

<sup>84</sup> Nsouli, §§66 and 67

<sup>85</sup> Exhibit NMN46

<sup>86</sup> Nsouli, §68 and Exhibit NMN48

<sup>87</sup> Nsouli, §69 and Exhibit NMN56

<sup>88</sup> Exhibit NMN57

<sup>89</sup> Exhibit NMN58

95. Much of the evidence filed by the holder in these proceedings relates to operations outside of the UK and, therefore, cannot assist it in demonstrating that there has been peaceful co-existence between the competing marks in the UK. I accept that the evidence establishes that the holder (or its parent company) operated a school in the UK between 1992 and 2020. That is clear from Mr Nsouli's narrative evidence, as well as the publications, brochures, pricelists, fee schedules, prospectuses, marketing materials, turnover figures and invoices in evidence.

96. Nevertheless, for a defence of honest concurrent use to succeed, I would need to be satisfied that the parties have traded in circumstances where the relevant public has been exposed to the marks at issue in these proceedings and has been able to differentiate between them without confusion as to the trade origin of the services. None of the evidence relating to the holder's school in Worcestershire relates to the provision of services under the contested IRs; to my mind, it is clear that this commercial activity was conducted in connection with 'KING'S COLLEGE SAINT MICHAEL'S' and, formerly, 'KING'S COLLEGE IN CLOISTERS'. As such, it is my view that the holder's evidence relating to the operation of the school does not assist it in establishing a defence of honest concurrent use in relation to the IRs.

97. I acknowledge that there is evidence of use of at least one of the contested IRs. Following the closure of the physical premises in Worcestershire due to the COVID-19 pandemic, a fully online offering was launched; the second IR was displayed on the holder's website, as were the words 'King's College Online' in normal font. However, the relevant date in these proceedings is 20 October 2020. The launch of the holder's online offering under these marks was in January 2021 and the printouts from its website also appear to have been from that year. The evidence of use of the IRs is extremely limited and, even if it was more significant, there is no evidence of any use of the IRs before the relevant date. I find this to be far below the exceptional circumstances required for a defence of honest concurrent use to succeed.

98. It is my view that the evidence before me is insufficient to establish that there had been peaceful coexistence between the competing marks that resulted in relevant consumers being accustomed to distinguishing between the parties. The circumstances of this case are plainly not consistent with those outlined in case law. I

am not satisfied that confusion would be avoided because of honest concurrent use. Consequently, the holder's defence is dismissed.

## **Conclusion**

99. The opponent's claims under section 5(2)(b) of the Act are successful.

## **Section 5(4)(a)**

### **The law**

100. 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.”

101. 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.”

102. 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.”

103. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

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

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

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

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

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

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

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

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

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

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

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

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

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

## **Relevant date**

105. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, Case BL O/410/11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the Registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

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

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

106. For the same reasons outlined at paragraphs 95 to 98, I do not consider there to be any evidence that the IRs had been used prior to their priority dates or the earliest claimed use of the opponent's earlier signs. Accordingly, the relevant date for assessing the opponent's claim under section 5(4)(a) is the priority date of the IRs, that being 20 October 2020.

## **Goodwill**

107. The first hurdle for the opponent is to show that it had the necessary goodwill resulting from the trading activity relied on under the signs at the relevant date. I remind myself that the opponent claims that it has a protectable goodwill in relation to which it has used the signs 'KING'S COLLEGE SCHOOL', 'KING'S COLLEGE' and 'KING'S'.

108. I have already found that the evidence filed by the opponent was sufficient to support a finding that a registered mark identical to the first of these signs had an

enhanced distinctive character at the relevant date. For the same reasons provided at paragraph 61, I am satisfied that the opponent had accrued a relatively strong level of goodwill in relation to its business in ‘*education; education services*’ prior to the relevant date. I am also satisfied that the sign ‘KING’S COLLEGE SCHOOL’ was distinctive of that goodwill.

109. For reasons which will become apparent, I do not consider it necessary to go on to consider the opponent’s claim as to goodwill in respect of ‘KING’S COLLEGE’ or ‘KING’S’.

### **Misrepresentation and damage**

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

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

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

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

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.”

111. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen LJ concluded:

“[...] if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

112. Although this was an infringement case, the principles apply equally under section 5(2).<sup>90</sup> In *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501, Lewison LJ had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, considering the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

113. I have already found that there is a likelihood of confusion between the IRs and a mark identical to the opponent’s earlier sign. For the same reasons provided at paragraphs 81 and 82, I find that a substantial number of members of the public will be deceived into believing that the services provided under the competing marks are

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<sup>90</sup> *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch)

offered by the same or economically linked undertakings. Furthermore, I consider that damage through diversion of sales is entirely foreseeable.

114. I should add that my findings as to honest concurrent use at paragraphs 95 to 98 are equally applicable here. For the same reasons, I am not satisfied that misrepresentation would be avoided because of honest concurrent use. The holder's defence is, again, dismissed.

## **Conclusion**

115. The opponent's claims under section 5(4)(a) are successful.

## **Overall outcome**

116. The oppositions under section 5(2)(b) and 5(4)(a) have succeeded in full. Subject to any appeal against my decision, the UK designation of the IRs will be refused.

## **Costs**

117. As the opponent has been successful, it is entitled to a contribution towards its costs. At the hearing, Mr Muir Wood and Ms Bowhill agreed that such an award should be made in accordance with the scale. These proceedings were commenced after 1 July 2016 but before 1 February 2023, meaning that the appropriate scale is that published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£2,700**, which has been calculated as follows:

Preparing statements and considering the holder's counterstatements	£500
Preparing evidence and considering the holder's evidence	£1,200
Preparing for and attending a hearing	£600

Official fees	£400
<b>Total</b>	<b>£2,700</b>

118. I order King's Education Limited to pay The Corporation of King's College School the sum of **£2,700**. 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 the proceedings if any appeal against this decision is unsuccessful.

**Dated this 16th day of August 2023**

**James Hopkins**  
**For the Registrar**