

O/080/20

TRADE MARKS ACT 1994

**IN THE MATTER OF UK TRADE MARK APPLICATIONS
Nos. 3263482 NATURE RESEARCH SOCIETY
and 3263483**



**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS
NOS. OP000411150 AND OP000411154
BY HM PUBLISHERS HOLDINGS LIMITED AND
MACMILLAN PUBLISHERS LIMITED**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE OPPONENTS
FROM THE DECISION OF MR MARK BRYANT
DATED 27 MARCH 2019**

DECISION

1. This is an appeal from a decision of Mr Mark Bryant, on behalf of the Registrar, BL O/160/19, in which he rejected the oppositions by HM Publishers Holdings Limited and Macmillan Publishers Limited¹ (“the Opponents”) to two trade mark applications in the name of the Nature Research Society (“the Applicant”).

Background

2. On 15 October 2017, the Applicant applied to register two trade marks:
 - a. No. 3263482 (“the Applicant’s Word mark”) consisted of the words NATURE RESEARCH SOCIETY,

¹ The Opponents have since changed their names to Springer Nature Holdings and Springer Nature Ltd respectively and the earlier marks are now registered in those names.

- b. No. 3263483 (“the Applicant’s Device mark”) consisted of a device containing the acronym NRS in stylised form, and the words Promoting Science and Nature Research Society:



3. The applications had overlapping but not identical specifications. Both of them included a wide range of services in Classes 41, such as a raft of publishing services and arranging of conferences of various kinds, and scientific services or software services of various kinds in Class 42. Many terms are repeated in the specifications. See the full specifications in Annex A.
4. The Opponents filed their oppositions based upon sections 5(2)(b) and 5(3) and upon 6 earlier marks (2 UK marks and 4 EUTMs) belonging to one or other of them, consisting of the word NATURE or the stylised words:

natureresearch.

- Three of the earlier marks were registered; of the rest, one was an EUTM application which was later withdrawn, one was pending, and one was opposed. The specifications of the earlier marks included goods in Classes 9 and 16 and services in Classes 35, 41 (including publishing services and arranging and conducting of conferences), 42 (including scientific and technological services and research and design and development of computer hardware and software) and 45. Goods and services in Classes 9, 16 and 41 were relied upon for the 5(3) objection.
5. The Opponents claimed a huge reputation for NATURE and **nature**research in relation to publishing goods and services. They filed evidence to support that claim. No evidence was filed by the Applicant.
6. There was a hearing on 21 February 2019 attended only by Mr Stobbs of Stobbs IP for the Opponents. Mr Stobbs also appeared before me on the appeal, which again was

not attended by the Applicant, nor did the Applicant file any written submissions on the appeal.

7. The Hearing Officer found, in summary:

- a. The Opponents' best case for s 5(2)(b) was the opposition based upon the earlier UK mark **nature**research, filed on 11 July 2016, which included publishing services in Class 41 which were identical to the Class 41 services in the opposed applications.
- b. The words nature and research will clearly be understood in **nature**research, and are its dominant part.
- c. The three words in the Applicant's Word mark will be read as a unit and are together its dominant part. That mark has a "medium high" level of visual and conceptual similarity, and a "medium to high" level of aural similarity to the earlier mark.
- d. The letters NRS and the three device elements of the Applicant's Device mark are together its dominant part, though the words Nature Research Society also have an independent distinctive role within it. Comparing the Applicant's Device mark to the earlier mark, it has a low level of visual similarity, medium to high aural similarity if referred to as NRS Nature Research Society, less similarity if referred to as "NRS Nature Research" and aural dissimilarity if the mark is simply described as "NRS" (the most likely usage). It has a medium level of conceptual similarity.
- e. Consumers (who mostly would be commercial undertakings but could include individuals) would pay an average degree of attention in purchasing publishing services. The purchase is likely to be visual in nature.
- f. The earlier mark must be accepted as having the minimum degree of inherent distinctiveness necessary to justify its registration, but the words tend to designate a characteristic of the goods and services, such as publishing, so that the conjoining of the two words and addition of the colour contrast add the necessary distinctive character.
- g. **nature**research had a modest amount of enhanced distinctiveness for academic and scientific journals in Class 16 and online publishing and

publication of such journals in Class 41. Such enhanced distinctiveness was in respect of the particular presentation of the words 'nature research.'

- h. As the earlier mark has such low distinctiveness, the words NATURE and RESEARCH in the Applicant's Word Mark would be seen as descriptive of the field of activity, so there was no likelihood of direct or indirect confusion.
- i. The earlier mark NATURE had a more significant level of enhanced distinctiveness, but given the greater differences to the Applicant's Word mark, there was again no likelihood of confusion.
- j. The differences between the earlier marks and the Applicant's Device mark meant there was again no likelihood of confusion.
- k. For the s 5(3) objection, both **nature**research and Nature had sufficient reputation, and a link would be made to the marks applied for, but it would be very weak and insufficient for detriment to occur or unfair advantage to be taken.

All the grounds of opposition therefore failed.

- 8. The Opponents' lengthy Grounds of Appeal appear to me to raise the following main points:
 - a. The Hearing Officer erred in focussing on the distinctiveness of the elements of the earlier mark rather than on its dominant elements. Similarly, he was wrong to say that the enhanced distinctiveness of the earlier mark lay only in its stylisation.
 - b. He failed to assess the distinctiveness of the earlier mark by reference to the full breadth of its specification.
 - c. He erred in ignoring the independent distinctive role played by NATURE and RESEARCH in the Applicant's marks.
 - d. He erred in his assessment of the likelihood of confusion in relation to both of the Applicant's marks and in relation to both **nature**research and Nature.
 - e. He failed to give any independent reasoning for his findings under s 5(3) for the **nature**research mark, and failed to consider the objection under Nature separately.

Standard of appeal

9. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. The relevant principles were set out in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 by Daniel Alexander QC sitting as the Appointed Person at [14]-[52] and his conclusions were approved by Arnold J in *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch). Mr Alexander QC said in particular that

“... In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country* and others).”

10. Subsequently, the Supreme Court in *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671 dealt with the role of the appellate court at [78] to [81]. Lord Hodge said:

“78. ... Where inferences from findings of primary fact involve an evaluation of numerous factors, the appropriateness of an intervention by an appellate court will depend on variables including the nature of the evaluation, the standing and experience of the fact-finding judge or tribunal, and the extent to which the judge or tribunal had to assess oral evidence: *South Cone Inc v Bessant, In re Reef Trade Mark* [2002] EWCA Civ 763; [2003] RPC 5, paras 25-28 per Robert Walker LJ.

...

80. What is a question of principle in this context? An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. What is the nature of such an evaluative error? In this case we are not concerned with any challenge to the trial judge's conclusions of primary fact but with the correctness of the judge's evaluation of the facts which he has found, in which he weighs a number of different factors against each other. This evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible. ...

81. Thus, in the absence of a legal error by the trial judge, which might be asking the wrong question, failing to take account of relevant matters, or taking into account irrelevant matters, the Court of Appeal would be justified in differing from a trial judge's assessment of obviousness if the appellate court were to reach the view that the judge's conclusion was outside the bounds within which reasonable disagreement is possible. It must be satisfied that the trial judge was wrong ..."

11. In relation to an appeal from a Hearing Officer who has assessed the likelihood of confusion for an opposition based upon section 5(2)(b) of the Act, Mr Iain Purvis QC sitting as the Appointed Person in *Rochester* BL O/049/17 said at [33]:

"... the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

- (i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case
- (ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person.

(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal.

(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. ... Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.”

12. I have borne those principles in mind on this appeal.

Merits of the appeal

13. The Opponents suggested that the Hearing Officer had gone wrong in his analysis of the earlier mark. In comparing the marks he said:

“17) The earlier mark consists of the words nature and research conjoined. Despite being conjoined, the separate identity of the two words is maintained by the word nature being in the colour red and the word research being black. Both of these words will be readily understood by the average consumer in the UK in the way that is highlighted in the following dictionary references:

Nature: The phenomena of the physical world collectively, including plants, animals, the landscape, and other features and products of the earth, as opposed to humans or human creations.

Research: The systematic investigation into and study of materials and sources in order to establish facts and reach new conclusions.

18) When taking these meaning together, the average consumer is likely to understand the earlier mark as a reference to studies of aspects of the physical world. The two words form a unit because they combine to create a clear term that is likely to be readily understood by the average consumer. It is this term that is the dominant part. I also recognise that the difference in colour of the two words cancels out the conjoining of the two words so that the mark clearly retains its impression of consisting of these two easily understood words rather than potentially leading to some artificial separation of the letters present in the mark.

In the recent judgment of the GC in *Sumol + Compal Marcas v EUIPO*, T-656/17, paragraph 35, it confirmed that “the colours of [...] signs are constituent elements which must be taken into account.””

14. Then, when considering the distinctive character of the earlier mark, he said:

“35) I also keep in mind the guidance of Mr Iain Purvis Q.C. as the Appointed Person in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, where he discussed the issue of the level of ‘distinctive character’ and that it is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

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

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

36) In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask, ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out. In the current case, the earlier mark contains the words “Nature Research”. Section 72 of the Act requires that, in the absence of a specific challenge to its validity, I must proceed on the basis that the earlier mark is endowed with at least the minimum level of distinctive character. I have already commented that the words themselves describe “studies of aspects of the physical world”. This is a meaning that designates a characteristic of the services, including publishing services, namely it designates the subject matter. Taking this view, it must be the conjoining of the two words and the colour of the first word that add the

necessary distinctive character. However, it is my view that, when considering the mark as a whole, its inherent distinctive character is the minimum required for registration in respect of goods and services, including publications and publishing relating to research in the field of nature.”

15. The Hearing Officer decided that the Opponents’ evidence showed that the mark had been used to identify an extensive portfolio of scientific journals, albeit just for a relatively short time, and concluded that the mark had acquired a modest amount of enhanced distinctive character in respect of some goods/services (see [7(g)] above).

16. In making the global assessment of the likelihood of confusion, he said:

“46) In the current case the applicant’s mark shares the words “nature research”. I have already commented that these words indicate “studies of aspects of the physical world” and the fact that they have such a meaning contributes to the mark, as a whole, having only the minimum distinctive character required for registration. I recognise that the weak distinctive character of an earlier mark does not preclude a likelihood of confusion (as per *L’Oréal SA v OHIM*, Case C-235/05 P), but also that descriptive matter is given less weight when comparing marks (as per *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97). I also need to factor in that I have found that the mark benefits from a modestly increased distinctive character as the result of the use made of it. Nevertheless, this enhanced level of distinctive character is in respect of the particular presentation of the words “Nature Research” and not merely the words.

47) The particular presentation is that the words are conjoined and each word appears in a different colour. Taking all of this into account, together with recognising that the respective publishing services are identical and that the nature of the purchasing act is at least average and predominantly visual in nature, I conclude that because of the very low level of distinctive character, the average consumer, upon encountering the respective marks is likely to believe that the common occurrence of the words “Nature Research” is a description of the field of activity and no more than coincidence that both marks contain the term. As a consequence, there is no likelihood of direct confusion where one mark

is confused with the other, nor indirect confusion where the consumer notices that the marks are not the same but, nevertheless, believes that because of their similarity, the goods or services provided under the respective marks originate from the same or linked undertaking.”

17. The Opponents’ substantive complaint about the Hearing Officer’s comparison of the parties’ marks was that he had in effect treated the earlier mark as having no distinctiveness and given too little weight to the elements of the earlier mark which he held to be its dominant element – the words ‘nature research.’ I do not accept that this complaint is correct. The Hearing Officer specifically referred at [36] to the need to attribute at least the minimum level of distinctiveness to the mark and at [46] to the fact that the weak distinctiveness of an earlier mark may not exclude a likelihood of confusion.
18. The Opponents also submitted that the Hearing Officer was wrong to say that the distinctive element of the earlier mark lay in its modest stylisation, and the enhanced distinctiveness was also linked to the stylisation. Mr Stobbs argued that the Hearing Officer could not take the stylisation of the earlier mark into account, by reference to a number of decided cases, such as Case T-383/12 *Ferienhäuser zum See v OHMI – Sunparks Group*. However, these sorts of cases all turn on their individual facts. Cases such as *Sunparks* merely serve to show that where a mark consists of simply stylised descriptive words, the tribunal may find that the words are its dominant element and that the visual elements are of such low distinctiveness as to be of secondary importance. However, it is for the tribunal to decide what it is about the earlier mark which gives it distinctive character, which may well (as here, and as in the *Jura* case mentioned below) pose a problem to a tribunal where that mark is of low inherent distinctiveness.
19. It was suggested that the Hearing Officer had misdirected himself by concentrating on the distinctive elements of the earlier mark instead of its dominant elements. The Hearing Officer was, to my mind, following the approach suggested in BL O/075/13 *Kurt Geiger*, which he had cited at [35]. That does not seem to me to be an approach

for which he can be criticised, nor can it be said that, as a matter of law, the Hearing Officer could not give *any* weight to the stylisation of the mark. I accept that there could be seen to be some tension between the finding at [18] that the 2-word phrase 'Nature Research' is the dominant element of the earlier mark, and the finding at [36] that the descriptive character of the words means that it is the presentation of those words (conjoined and in contrasting colours) which endows the mark with sufficient inherent distinctiveness to be registrable. However, the impact of distinctiveness of the stylisation (however modest) was a 'judgment call' for him to make and in my view the Hearing Officer's analysis of the distinctiveness of the earlier mark does not disclose any error of approach or principle. This element of the appeal therefore fails.

20. The Opponents also submitted that the Hearing Officer was wrong to attribute the modest enhanced distinctiveness acquired by the earlier mark to its visual elements. Mr Stobbs suggested that the Hearing Officer had erred in assuming that the evidence of use all showed use of the earlier mark in the colours in which it was registered, but if he did so, he cannot be criticised for that assumption, as the evidence filed by the Opponents was in black and white. Furthermore, if the Opponents wished to rely upon use which had been made in black and white, it seems to me that this was not use of the earlier mark as registered and the Hearing Officer would have been entitled to ignore it in terms of assessing its enhanced distinctiveness. Again, it does not seem to me that the Opponents have identified any error of principle or of fact in the Hearing Officer's analysis of this point, and this ground of appeal must also fail. In the Grounds of Appeal the Opponents added that the Hearing Officer was wrong to limit the enhanced distinctiveness to Class 16 goods and Class 41 services, but that complaint was not pursued at the hearing of the appeal.

21. The Opponents next complained that the Hearing Officer was wrong to find, in effect, that the words in the earlier mark were descriptive of all publishing services, and this indicated that he had not considered the case on the basis of notional fair use of the Applicant's marks across the whole of its specifications. They pointed by way of example to the music publishing services within the Applicant's specifications, as a

subset of the earlier publishing services, saying that the earlier mark would be more distinctive in relation to such services. That may of course be right, but the term “publishing services” at large plainly would be descriptive of some services contained within the umbrella term, such that the Hearing Officer was not wrong to deem the general term inherently descriptive. Indeed, Mr Stobbs very properly accepted that to the extent that the Hearing Officer could use the same analysis across the specification, in dealing with elements set out in general terms which could relate to nature research as much as to any other kind of subject matter, the Hearing Officer was entitled to look only at the single point.

22. Turning to the Hearing Officer’s analysis of the likelihood of confusion, in addition to raising the matters set out above, the Opponents said that the Hearing Officer had erred in ignoring the independent distinctive role played by NATURE and RESEARCH in the Applicant’s marks. I do not accept that the Hearing Officer did this. His analysis of the similarities between the marks cannot be criticised, and he factored that into the global assessment of the likelihood of confusion. Further, even where an element of the composite mark is identical or similar to the earlier trade mark and has an independent distinctive role in the mark applied for, it does not automatically follow that there is a likelihood of confusion: see *Whyte and Mackay Ltd v Origin Wine UK Ltd (Jura)* [2015] EWHC 1271 (Ch), [2015] E.T.M.R. 29. In particular, Arnold J held at paragraph 44 that “what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.” I therefore reject this criticism of the decision.
23. Next the Opponents submitted that the Hearing Officer had erred in [47] when he concluded that because of the earlier mark's very low level of distinctive character, the average consumer, on encountering the respective marks, would be likely to believe that the words "nature research" in both marks described the field of activity, so that there was no likelihood of confusion as to trade origin. That conclusion, they submitted, could not apply in relation to some of the services within the Applicant's

specifications which had no relevance to nature or research, such as music publishing, or music recording services.

24. It seems to me that there is some force in this point. The Hearing Officer was plainly taking the approach that he would analyse the likelihood of confusion by reference to the strongest of the Opponents' earlier marks and by reference to identical services in the earlier specification to services within the Applicant's specifications. If the Opponents failed on this strongest case, the rest of the opposition would also fall away. However, as a result of doing this he appears to have failed to consider the whole of the Applicant's specifications whether in categories of services or individually. In particular, there is nothing in the decision which indicates that he considered separately a limited number of terms in the Applicant's specifications which, I accept, have nothing to do with nature or nature research. For example, in the Class 41 specification for the Applicant's Word mark one finds (repetitively) publishing of music, and publishing of printed matter relating to French wines, as well as certain services of arranging conferences in relation to matters divorced from nature/nature research. Following the hearing the Opponents provided me with lists of those parts of the Applicant's specifications which they said had nothing to do with nature or nature research, and to the extent that I agree that some (but not all) of the identified terms fall into that category they are highlighted in bold in Annex A. I shall call these "the Specific Services."
25. It seems to me that the Hearing Officer concentrated on what he saw as the Opponents' best case scenario (their strongest earlier mark No 3174032, registered for 'publishing services' which encompassed all of the kinds of publishing services in the Applicant's specifications) but when assessing the likelihood of confusion he failed to take into account the fact that the Applicant's specifications included the Specific Services which are unconnected with nature or nature research. He failed to consider whether there was a likelihood of confusion in relation to those services in contradistinction to the broader terms in the specifications. I therefore accept that the Hearing Officer erred in his assessment of the likelihood of confusion in relation to the

Specific Services for which the term “nature research” cannot be said to be descriptive.

26. In the circumstances, I consider that I should re-assess the likelihood of confusion in relation to the Specific Services, accepting (as I have) the Hearing Officer’s views of the dominant elements of the earlier mark and of the Applicant’s marks, and his view of their levels of visual, aural and conceptual similarity:

a. As far as the Applicant’s Word mark is concerned, the global assessment must balance:

- i. the medium to high similarity of the marks;
- ii. the dominance of the words ‘nature research’ in the earlier mark;
- iii. the identity of such of the Specific Services as are publishing services to the Opponents’ services;
- iv. the identity of the remainder of the Specific Services to the services of “arranging and conducting of conferences” in the Opponents’ specification;
- v. the fact that ‘nature research’ is not descriptive of any of the Specific Services; and
- vi. the average degree of attention likely to be paid by the consumer to the purchase of such services.

I conclude that use of the Applicant’s Word mark in relation to all of the Specified Services would lead to a likelihood of confusion, such that the section 5(2)(b) objection should succeed to that extent.

b. As far as the Applicant’s Device mark is concerned, the global assessment must balance:

- i. the low to medium similarity of the marks;
- ii. the dominance of the words ‘nature research’ in the earlier mark but the dominance of the acronym NRS and/or device elements in the Applicant’s Device mark;
- iii. the identity of such of the Specific Services as are publishing services to the Opponents’ services;

- iv. the identity of the remainder of the Specific Services to the services of “arranging and conducting of conferences” in the Opponents’ specification;
- v. the fact that ‘nature research’ is not descriptive of any of the Specific Services; and
- vi. the average degree of attention likely to be paid by the consumer to the purchase of such services.

The significant differences between the marks make this a more nuanced assessment, but I conclude that use of the Applicant’s Device mark in relation to all of the Specified Services would lead to a likelihood of confusion, such that the section 5(2)(b) objection should succeed to the same extent in relation to the Device mark application.

27. The Opponents also submitted that the Hearing Officer’s analysis of the likelihood of confusion as between the NATURE mark and the Applicant’s marks was inadequate, especially given the enhanced distinctiveness of the mark. They submitted that he had failed to factor in the enhanced distinctiveness of NATURE in that assessment, but it is plain to me that he did do so. The Hearing Officer had, not surprisingly, found that Nature is a very well-known title for a scientific or academic journal, and he did take the enhanced distinctiveness into account in his analysis at [49]. His conclusion was, in essence, that the conceptual difference between NATURE and both of the Applicant’s marks would preclude a likelihood of confusion. In the circumstances, I do not accept that there is an error of principle in this respect and I do not consider that the Hearing Officer’s failure to consider the position with particular reference to the Specified Services means that I should re-assess the likelihood of confusion as between the earlier mark NATURE and the Applicant’s marks.
28. That leaves the Opponents’ appeal in relation to their section 5(3) objection to the remaining services. The Hearing Officer found that both **nature**research and NATURE had a reputation in respect of publishing of scientific journals. At [56] he found that the common element in the marks, the words ‘nature research’ designate a characteristic, such that the consumer is likely to see any similarity between the

marks as coincidence. Hence, whilst one mark might bring the other to mind, the link between them was very weak and too weak for any detriment or unfair advantage to flow from it.

29. The Opponents again complained that the Hearing Officer's analysis flowed from his narrow view that the words 'nature research' designate a characteristic of all of the services in the Applicant's specifications. I have already found that the applications should be refused in respect of the Specified Services. For much the same reasons set out above, I do not consider that the Hearing Officer erred in his analysis of the case based on 5(3) for the **nature**research mark, once the Applicant's specifications are shorn of the Specified Services.
30. The Opponents pointed out that the Hearing Officer's analysis in [56] referred only to the **nature**research mark and so he erred in failing to consider the potential objection under s 5(3) based upon the much more famous NATURE mark. It is right that there was no separate analysis of the position. Possibly the Hearing Officer again considered that the Opponents' best case was based on the **nature**research mark, but he does not say so. This is, I accept, a gap in the decision.
31. I discussed with Mr Stobbs whether the point should be remitted to the Registry. He invited me to decide the point. However, the Applicant was not present, and may have wished to object to that approach. In those circumstances I think it right to remit the issue to the UKIPO.

Conclusion

32. The Appeal succeeds under s 5(2)(b) in relation to the Specified Services identified in bold in Annex A, but not otherwise.
32. The Appeal is dismissed in relation to the objection based upon s 5(3) in so far as it is based upon the **nature**research mark.
33. I will remit the opposition based upon s 5(3) but only in so far as it is based upon trade mark 3174031 NATURE.

34. In those circumstances, I make no order as to the costs of the appeal.

Amanda Michaels
The Appointed Person
10 February 2020.

Mr Julius Stobbs of Stobbs IP appeared for the Opponents/Appellants
The Applicant did not appear and was not represented

ANNEX A

Application 3263482

Class 41

Publishing; Publishing a newspaper for customers on the Internet; Publishing and issuing scientific papers in relation to medical technology; Publishing and reporting; Publishing by electronic means; Publishing of books; Publishing of books and reviews; Publishing of books, magazines; Publishing of documents; Publishing of educational material; Publishing of educational matter; Publishing of electronic books and journals on-line; Publishing of electronic books and journals online; Publishing of electronic publications; Publishing of instructional books; Publishing of interactive computer and video game software; Publishing of journals; Publishing of journals, books and handbooks in the field of medicine; Publishing of magazines in electronic form on the Internet; Publishing of maps; Publishing of medical publications; **Publishing of music; Publishing of musical works**; Publishing of newsletters; Publishing of newspapers; Publishing of printed matter; **Publishing of printed matter relating to French wines**; Publishing of reviews; Publishing of scientific papers; Publishing of scientific papers in relation to medical technology; Publishing of scripts for theatrical use; Publishing of stories; Publishing of web magazines; Publishing scientific papers in relation to medical technology; Publishing services; Publishing services (including electronic publishing services); Publishing services carried out by computerised means; Publishing services for books; Publishing services for books and magazines; Publishing services for periodical and non-periodical publications, other than publicity texts; Publishing services, except printing; Advisory services relating to publishing; Book and review publishing; Book publishing; Desk top publishing; Digital video, audio and multimedia entertainment publishing services; Electronic desktop publishing; Electronic publishing; Electronic publishing services; Electronic text publishing services; Magazine publishing; Multimedia entertainment software publishing services; Multimedia publishing; Multimedia publishing of books; Multimedia publishing of electronic publications; Multimedia publishing of journals; Multimedia publishing of magazines; Multimedia publishing of magazines, journals and newspapers; Multimedia publishing of newspapers; Multimedia publishing of printed matter; **Music publishing; Music publishing and music recording services; Music publishing services**; Newspaper publishing; On-line publishing services; Online electronic publishing of books and periodicals; Provision of information relating to publishing; Writing and publishing of texts, other than publicity texts; Conference services; Conferences (Arranging and conducting of -); Arrangement of conferences for educational purposes; Arrangement of conferences for recreational purposes; Arranging and conducting conferences; Arranging and conducting conferences and seminars; Arranging and conducting educational conferences; Arranging and conducting of commercial, trade and business conferences; Arranging and conducting of conferences; Arranging and conducting of conferences and congresses; Arranging and conducting of conferences, congresses and symposiums; Arranging conferences; **Arranging of an annual conference relating to**

logistics; Arranging of an annual conference relating to procurement; Arranging of an annual conference relating to telecommunications; Arranging of an annual educational conference; Arranging of conferences; **Arranging of conferences relating to advertising; Arranging of conferences relating to business; Arranging of conferences relating to commerce;** Arranging of conferences relating to cultural activities; Arranging of conferences relating to education; **Arranging of conferences relating to entertainment; Arranging of conferences relating to trade;** Arranging of conferences relating to training; Arranging of educational conferences; Arranging, conducting and organisation of conferences; Conducting of business conferences; Conducting of educational conferences; Consultancy and information services relating to arranging, conducting and organisation of conferences; Consultancy relating to arranging and conducting of conferences; Organisation of conferences and symposia in the field of medical science; Organisation of conferences related to entertainment; Organisation of conferences relating to education; Organisation of conferences relating to training; Organisation of conferences relating to vocational training; Organisation of conferences, exhibitions and competitions; Organisation of congresses and conferences for cultural and educational purposes; Organisation of meetings and conferences; Organisation of seminars and conferences; Organising of conferences for educational purposes; Organising of conferences relating to education; Organising of education conferences; Organising of educational conferences; Organization of educational conferences; Planning of conferences for educational purposes; Publishing; Publishing a newspaper for customers on the Internet; Publishing and issuing scientific papers in relation to medical technology; Publishing and reporting; Publishing by electronic means; Publishing of books; Publishing of books and reviews; Publishing of books, magazines; Publishing of documents; Publishing of educational material; Publishing of educational matter; Publishing of electronic books and journals on-line; Publishing of electronic books and journals online; Publishing of electronic publications; Publishing of instructional books; Publishing of interactive computer and video game software; Publishing of journals; Publishing of journals, books and handbooks in the field of medicine; Publishing of magazines in electronic form on the Internet; Publishing of maps; Publishing of medical publications; **Publishing of music; Publishing of musical works;** Publishing of newsletters; Publishing of newspapers; Publishing of printed matter; **Publishing of printed matter relating to French wines;** Publishing of reviews; Publishing of scientific papers; Publishing of scientific papers in relation to medical technology; Publishing of scripts for theatrical use; Publishing of stories; Publishing of web magazines; Publishing scientific papers in relation to medical technology; Publishing services; Publishing services (including electronic publishing services); Publishing services carried out by computerised means; Publishing services for books; Publishing services for books and magazines; Publishing services for periodical and non-periodical publications, other than publicity texts; Publishing services, except printing; Advisory services relating to publishing; Book and review publishing; Book publishing; Desk top publishing; Digital video, audio and multimedia entertainment publishing services; Electronic desktop publishing; Electronic publishing; Electronic publishing services; Electronic text publishing services; Magazine publishing; Multimedia entertainment software publishing services; Multimedia publishing; Multimedia publishing of books; Multimedia publishing of electronic publications; Multimedia publishing of journals; Multimedia publishing of magazines; Multimedia publishing of magazines, journals and newspapers; Multimedia publishing of newspapers; Multimedia publishing of printed matter; **Music publishing; Music publishing and music recording services; Music publishing services;** Newspaper publishing; On-line publishing services; Online electronic publishing of books and periodicals; Provision of information relating to publishing; Writing and publishing of texts, other than publicity texts; Arranging and conducting of meetings in the field of education; Organisation of meetings and conferences; Organising of meetings in the field of education.

Class 42

Scientific advisory services; Scientific analysis; Scientific and technological services; Scientific computer programming services; Scientific consultancy; Scientific investigations for medical purposes; Scientific research; Scientific research and analysis; Scientific research services; Advisory services

relating to computer software used for publishing; Providing temporary use of on-line, non-downloadable software for use in publishing and printing; Software development in the framework of software publishing; Advisory services relating to computer software used for publishing; Providing temporary use of on-line, non-downloadable software for use in publishing and printing.

Application 3263483

Class 41:

Publishing; Publishing a newspaper for customers on the Internet; Publishing and issuing scientific papers in relation to medical technology; Publishing and reporting; Publishing by electronic means; Publishing of books; Publishing of books and reviews; Publishing of books, magazines; Publishing of documents; Publishing of educational material; Publishing of educational matter; Publishing of electronic books and journals on-line; Publishing of electronic books and journals online; Publishing of electronic publications; Publishing of instructional books; Publishing of interactive computer and video game software; Publishing of journals; Publishing of journals, books and handbooks in the field of medicine; Publishing of magazines in electronic form on the Internet; Publishing of maps; Publishing of medical publications; **Publishing of music; Publishing of musical works**; Publishing of newsletters; Publishing of newspapers; Publishing of printed matter; **Publishing of printed matter relating to french wines**; Publishing of reviews; Publishing of scientific papers; Publishing of scientific papers in relation to medical technology; Publishing of scripts for theatrical use; Publishing of stories; Publishing of web magazines; Publishing scientific papers in relation to medical technology; Publishing services; Publishing services (including electronic publishing services); Publishing services carried out by computerised means; Publishing services for books; Publishing services for books and magazines; Publishing services for periodical and non-periodical publications, other than publicity texts; Publishing services, except printing; Advisory services relating to publishing; Book and review publishing; Book publishing; Desk top publishing; Digital video, audio and multimedia entertainment publishing services; Electronic desktop publishing; Electronic publishing; Electronic publishing services; Electronic text publishing services; Magazine publishing; Multimedia entertainment software publishing services; Multimedia publishing; Multimedia publishing of books; Multimedia publishing of electronic publications; Multimedia publishing of journals; Multimedia publishing of magazines; Multimedia publishing of magazines, journals and newspapers; Multimedia publishing of newspapers; Multimedia publishing of printed matter; **Music publishing; Music publishing and music recording services; Music publishing services**; Newspaper publishing; On-line publishing services; Online electronic publishing of books and periodicals; Provision of information relating to publishing; Writing and publishing of texts, other than publicity texts; Conference services; Conferences (Arranging and conducting of -); Arrangement of conferences for educational purposes; Arrangement of conferences for recreational purposes; Arranging and conducting conferences; Arranging and conducting conferences and seminars; Arranging and conducting educational conferences; Arranging and conducting of commercial, trade and business conferences; Arranging and conducting of conferences; Arranging and conducting of conferences and congresses; Arranging and conducting of conferences, congresses and symposiums; Arranging conferences; **Arranging of an annual conference relating to logistics; Arranging of an annual conference relating to procurement; Arranging of an annual conference relating to telecommunications**; Arranging of an annual educational conference; Arranging of conferences; **Arranging of conferences relating to advertising; Arranging of conferences relating to business; Arranging of conferences relating to commerce**; Arranging of conferences relating to cultural activities; Arranging of conferences relating to education; **Arranging of conferences relating to entertainment; Arranging of conferences relating to trade**; Arranging of conferences relating to training; Arranging of educational conferences; Arranging, conducting and organisation of conferences; Conducting of business conferences; Conducting of educational conferences; Consultancy and information services relating to arranging, conducting and organisation of conferences; Consultancy relating to arranging and conducting of conferences; Organisation of

conferences and symposia in the field of medical science; Organisation of conferences related to entertainment; Organisation of conferences relating to education; Organisation of conferences relating to training; Organisation of conferences relating to vocational training; Organisation of conferences, exhibitions and competitions; Organisation of congresses and conferences for cultural and educational purposes; Organisation of meetings and conferences; Organisation of seminars and conferences; Organising of conferences for educational purposes; Organising of conferences relating to education; Organising of education conferences; Organising of educational conferences; Organization of educational conferences; Planning of conferences for educational purposes; Publishing; Publishing a newspaper for customers on the Internet; Publishing and issuing scientific papers in relation to medical technology; Publishing and reporting; Publishing by electronic means; Publishing of books; Publishing of books and reviews; Publishing of books, magazines; Publishing of documents; Publishing of educational material; Publishing of educational matter; Publishing of electronic books and journals on-line; Publishing of electronic books and journals online; Publishing of electronic publications; Publishing of instructional books; Publishing of interactive computer and video game software; Publishing of journals; Publishing of journals, books and handbooks in the field of medicine; Publishing of magazines in electronic form on the Internet; Publishing of maps; Publishing of medical publications; **Publishing of music; Publishing of musical works;** Publishing of newsletters; Publishing of newspapers; Publishing of printed matter; **Publishing of printed matter relating to french wines;** Publishing of reviews; Publishing of scientific papers; Publishing of scientific papers in relation to medical technology; Publishing of scripts for theatrical use; Publishing of stories; Publishing of web magazines; Publishing scientific papers in relation to medical technology; Publishing services; Publishing services (including electronic publishing services); Publishing services carried out by computerised means; Publishing services for books; Publishing services for books and magazines; Publishing services for periodical and non-periodical publications, other than publicity texts; Publishing services, except printing; Advisory services relating to publishing; Book and review publishing; Book publishing; Desk top publishing; Digital video, audio and multimedia entertainment publishing services; Electronic desktop publishing; Electronic publishing; Electronic publishing services; Electronic text publishing services; Magazine publishing; Multimedia publishing; Multimedia publishing of books; Multimedia publishing of electronic publications; Multimedia publishing of journals; Multimedia publishing of magazines; Multimedia publishing of magazines, journals and newspapers; Multimedia publishing of newspapers; Multimedia publishing of printed matter; Newspaper publishing; On-line publishing services; Online electronic publishing of books and periodicals; Provision of information relating to publishing; Writing and publishing of texts, other than publicity texts.

Class 42

Advisory services relating to computer software used for publishing; Providing temporary use of on-line, non-downloadable software for use in publishing and printing; Software development in the framework of software publishing; Advisory services relating to computer software used for publishing; Providing temporary use of on-line, non-downloadable software for use in publishing and printing; Software development in the framework of software publishing.