O/1124/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3763721
BY JEFF WILKINSON & LEE WILKINSON

TO REGISTER:

The New Ivy League

AS A TRADE MARK IN CLASS 41

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 434729 BY
COUNCIL OF IVY GROUP PRESIDENTS

BACKGROUND AND PLEADINGS

1. On 9 March 2022, Jeff Wilkinson and Lee Wilkinson ("the applicants") applied to register **The New Ivy League** as a trade mark in the United Kingdom in respect of the following services:

> *Class 41*
>
> *Music group services; Musical group entertainment services; Entertainment services provided by a musical group; Rendering of musical entertainment by vocal groups; Rendering of musical entertainment by instrumental groups; Entertainment services performed by a musical group; Entertainment services provided by a musical vocal group; Presentation of live performances by a musical group; Entertainment services in the form of musical group performances; Entertainment services in the form of musical vocal group performances; Live performances by rock groups; Music concerts; Musical performances; Music recording; Music performances; Presentation of live performances by rock groups; music education; Musical entertainment; Music education; Music festival services; Live musical concerts; Live musical performances; Music publishing services; Musical entertainment services; Performance of music; Musical instruction services; Teaching of music; Live music concerts; Live music performances; Music production services; Music-hall services; Music transcription services; Musical performance services; Provision of children's educational services through play-groups; Music composition services; Music concert services; Live music services; Music competition services; Instruction in music; Tuition in music; Musical concert services; Music library services; Recording of music; Live music shows; Production of music; Publishing of music; Music entertainment services; Music performance services; Music mixing services; None of the aforesaid relating to the production or organisation of entertainment events.*

2. On 1 July 2022, the application was opposed by Council of Ivy Group Presidents ("the opponent"). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act") and concerns all the services in the application. The opponent is relying on UKTM No. 900205773, **THE IVY LEAGUE**, which is a UK

comparable mark and so retains its original filing date of 1 April 1996 and registration date of 3 March 1999. The mark is registered in respect of the following goods and services:

> *Class 21*
> *Household or kitchen utensils and containers; crockery; coasters; drinking flasks; goblets; tankards; holders for flowers and plants; candlesticks; mugs; cups; vases; glassware; crystal glassware; decanters; corkscrews; napkin rings; porcelain ware; earthenware; pottery; ornaments, works of art all made from porcelain, terracotta or glass, combs; all for personal use.*
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> *Class 25*
> *T-shirts, shirts, tops, blouses, shorts, skirts, swimwear, exercise-wear, athletic wear, sportswear; pants, jeans, sweatshirts, jumpers, jumpsuits, sweaters, vests, jackets, coats, raincoats, nightgowns; pyjamas; undergarments, hats, caps, scarves, mufflers, shawls, bibs, neckties; aprons, gloves; neckbands, armbands, headbands; sandals, slippers, shoes; socks; stockings; belts.*
>
> *Class 41*
> *Conducting educational and athletic activities at the college and university levels; conducting an intercollegiate athletic conferences; higher education; publication of books, instructional texts and leaflets; organisation of competitions; lending libraries; production of radio and television programmes; providing recreation facilities; production and organisation of entertainment events.*

3. This mark qualifies as an earlier mark under section 6(1)(a) of the Act. As the opponent's mark was registered more than five years before the application date of the contested mark, it has made a statement that it has used the mark for all the goods and services listed above.

4. Under section 5(2)(b), the opponent claims that the marks are similar and that the Class 41 services covered by the marks are either identical or highly similar, although earlier in the form it ticked the box to say that it was relying on all the goods and

services. The opponent claims that there exists a likelihood of confusion on the part of the relevant public in the UK.

5. Under section 5(3), the opponent claims that the earlier mark and sign have a reputation for all the goods and services for which it stands registered, and that use of the contested mark, which would be without due cause, would take unfair advantage of and be detrimental to the distinctive character and repute of the earlier mark and sign.

6. The opponent claims that the contested mark further offends against sections 5(2)(b) and 5(3) as it is similar to the sign **THE IVY LEAGUE** which qualifies as an earlier mark under section 6(1)(c) of the Act, being a well-known trade mark in the UK as defined in section 56(1) of the Act. The opponent claims that the contested services are similar to the services protected by this earlier sign, namely *Educational services namely, conducting educational activities such as courses, seminars and conferences; providing information about education; production and organisation of entertainment events.*

7. On 23 August 2022, the applicants filed a defence and counterstatement which explained that the applicants were in a band that wanted to continue the name of a 1960s British band called The Ivy League. The members of that band had consented on the proviso that the new band would be called The New Ivy League. The applicants denied any connection with the opponent.

8. The Registry wrote to the applicants on 24 August 2022 informing them that they were required to admit or deny the grounds set out by the opponent and inviting them to file an amended counterstatement on or before 14 September 2022.

9. The applicants filed an amended defence and counterstatement on 14 September 2022. They argue that the marks are not the same and that *"the trademark does not clash with Council of Ivy Group Presidents"*. Under section 5(3), they claim that no unfair advantage would occur as the only services they offer are those of a live band, carrying on from what they describe as *"the original UK 60s band"*. They put the opponent to proof of use of its earlier UKTM.

10. The Registry wrote to the applicants again on 1 October 2022. It noted that, under section 5(2)(b), they had addressed the claim in regard to the similarity of marks, but had not addressed the similarity of goods and services. The Registry also noted that the section 5(3) claim required further particularisation and that the applicants had not addressed the opponent's claim to protection for a well-known trade mark. The applicants were informed that if the counterstatement were not amended the Registry might move to strike out any parts of the defence that were not adequately particularised. In a further letter of 25 October 2022, the applicants were provided with a list of the points that needed to be addressed in their defence. A deadline of 8 November 2022 was given for a response.

11. The Registry did not receive a response by the deadline, but the defence was admitted into the proceedings on 28 November 2022.

EVIDENCE AND SUBMISSIONS

12. Only the opponent filed evidence. This comes in the form of a witness statement from Robin Harris, Executive Director at the opponent, a position she has held since 2009. Her evidence, which is dated 21 February 2023, goes to the use made of the mark, its enhanced distinctive character and reputation, and the claims to own a well-known mark.

13. Neither side requested to be heard and the opponent filed final written submissions on 10 May 2023. The applicant had filed short final submissions on 13 April 2023.

REPRESENTATION

14. In these proceedings, the opponent is represented by Dechert LLP and the applicant is unrepresented.

PROCEDURAL ISSUES

15. The need for pleadings to be fully particularised was emphasised by Mr Phillip Johnson, sitting as the Appointed Person, in *SkyClub Trade Mark*, BL O/044/21,

paragraphs 23-28. He quoted Lord Hoffmann's statement in *Barclays Bank Plc v Boulter* [1999] 1 WLR 1919 at [1923]:

> "The purpose of the pleadings is to define the issues and give the other party fair notice of the case which he has to meet."[1]

16. Tribunal Practice Notice ("TPN") 4/2000 contains the following guidance on the content of counterstatements:

> "19. A defence should comment on the facts set out in the statement of case and should state which of the grounds are admitted or denied and those which the applicant is unable to admit or deny but which he requires the opponent to prove.
>
> 20. The counter-statement should set out the reasons for denying a particular allegation and if necessary the facts on which they will rely in their defence. For example, if the party filing the counter-statement wishes to refer to prior registrations in support of their application then, as above, full details of those registrations should be provided."

17. In *SkyClub*, Mr Johnson explained that, while it would be possible to file an adequately particularised notice of opposition by completing the boxes on Form TM7, the same could not be said for the defence and Form TM8. It would be wrong for me to proceed on the basis that claims are denied where the applicants are silent. As the TM8 had been admitted, I considered that the applicants may have believed that the previously identified deficiencies were no longer an issue. I therefore wrote to the applicant (copied to the opponent) on 25 October 2023 setting out that I would proceed on the basis that the undenied claims were admitted. A deadline of 8 November 2023 was given for the applicant to make any comments to the letter, and none were received.

[1] Quoted at paragraph 26.

DECISION

Section 5(2)(b)

18. Section 5(2) of the Act is as follows:

> "A trade mark shall not be registered if because–
>
> …
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

19. The applicants required the opponents to prove use of the earlier UKTM. However, the opponents also claim that **THE IVY LEAGUE** qualifies for protection as a well-known mark under section 56(1) of the Act as a well-known mark under Article 6*bis* of the Paris Convention for the Protection of Industrial Property. The applicant has not denied that this mark enjoys such protection for *Educational services namely, conducting educational activities such as courses, seminars and conferences; providing information about education; production and organisation of entertainment events* or that the services for which it enjoys protection are similar to those in the application.

20. Article 6*bis* of the Paris Convention states that:

> "(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of registration or use to be well

known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. The provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

…"

21. The opponent qualifies as a person entitled to benefit from this provision as a legal person established in the US, which is a party to the Convention. In her witness statement, Ms Harris says that her organisation is a non-profit, unincorporated association representing eight elite US universities and colleges (Brown, Colombia, Cornell, Dartmouth College, Harvard, Princeton, University of Pennsylvania, and Yale). These institutions collectively organised intragroup athletics and football competitions and were known as "The Ivy League" since 1937. In 1954, they entered into the "Presidents' Agreement" governing their activities and constituting themselves members of a group to be known as "The Ivy Group".[2] A printout from the website of The Ivy League provides a more detailed history and shows that the name "Council of Ivy Group Presidents" was adopted in 1977.[3] I am satisfied that the opponent is the owner of the earlier sign **THE IVY LEAGUE**. As noted above, I shall proceed on the basis that the applicants have admitted that the sign is entitled to protection as a well-known mark for the claimed services.

22. For reasons of procedural economy, I shall not carry out an assessment of use for the earlier UKTM, and shall assess the claim under section 5(2)(b) on the basis of the well-known mark.

23. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union ("CJEU") in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen*

[2] Witness statement, paragraphs 4 and 5; Exhibit RH1, pages 1 and 2.
[3] Exhibit RH1, pages 8-13.

Handel BV (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):[4]

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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;

[4] 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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to refer to the trade mark case-law of EU courts, although the UK has left the EU.

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

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

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

i) mere association, in the strict sense that the later mark brings 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; and

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

Comparison of services

24. The similarity of the services has not been denied by the applicants. I will not conduct a full comparison here but proceed on the basis that the services are similar to at least some degree.

Average consumer and the purchasing process

25. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purposes 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 and services in question: see *Lloyd Schuhfabrik*, paragraph 26.

26. I find it convenient to divide the opponent's services into three groups, as follows:

> *Music group services; Musical group entertainment services; Entertainment services provided by a musical group; Rendering of musical entertainment by vocal groups; Rendering of musical entertainment by instrumental groups; Entertainment services performed by a musical group; Entertainment services provided by a musical vocal group; Presentation of live performances by a musical group; Entertainment services in the form of musical group performances; Entertainment services in the form of musical vocal group performances; Live performances by rock groups; Music concerts; Musical performances; Music performances; Presentation of live performances by rock groups; Musical entertainment; Music festival services; Live musical concerts; Live musical performances; Musical entertainment services; Performance of music; Live music concerts; Live music performances; Music-hall services; Musical performance services; Music concert services; Live music services; Music competition services; Musical concert services; Live music shows; Music entertainment services; Music performance services* ("musical entertainment services")
>
> *Music education; Musical instruction services; Teaching of music; Provision of children's educational services through play-groups; Instruction in music; Tuition in music* ("educational services")
>
> *Music recording; Music publishing services; Music production services; Music transcription services; Music composition services; Music library services; Recording of music; Production of music; Publishing of music; Music mixing services* ("services for the music industry")

27. The opponent submits that the average consumer of the services is a member of the general public and that the level of attention would be high for the services related to education and medium for the remaining services. I agree with these submissions

in so far as they relate to the opponent's services and the first group of services identified in the previous paragraph. The services in the third group would be purchased by professionals in the music industry and in my view they would be paying a slightly higher than medium degree of attention, given the importance of these services for their livelihoods.

28. I agree with the opponent that the purchasing process for all these services is likely to be primarily visual, although the consumer may receive oral recommendations. Therefore, I cannot ignore the aural impact of the marks.

Comparison of marks

29. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks: see *Bimbo*, paragraph 34.

30. The respective marks are shown below:

Contested mark	**Earlier mark**
The New Ivy League	**THE IVY LEAGUE**

31. Both marks are plain word marks. In *LA Superquimica v European Union Intellectual Property Office*, Case T-24/17, the General Court held that such plain word marks protected the word or words contained in the mark in whatever form, colour or

typeface.[5] Therefore, the fact that one is shown in title case and the other in upper case has no bearing on my comparison.

32. The earlier mark consists of three words which, in my view, hang together as a single unit. The overall impression of the mark lies in the unit. The contested mark contains the same three words with the addition of "New" between "The" and "Ivy". The opponent submits that the dominant and distinctive element of this mark is "The Ivy League" and that the additional word has no trade mark significance, being promotional or laudatory. I agree with the opponent that the word "new" suggests that the services supplied are more advanced or improved in some way. I find that the phrase "The … Ivy League" is the dominant and distinctive element of the contested mark and "New" is non-distinctive.

33. Given that the sole difference between the marks is the word "NEW", and that this is a short and less distinctive element of the contested mark, I find that the marks are visually, aurally and conceptually highly similar.

Distinctive character of the earlier mark

34. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*:

> "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

[5] Paragraph 39.

statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

35. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

36. The earlier mark consists of words that are common in the English language. They do not describe or allude to the services. I find that the earlier mark has a medium degree of inherent distinctive character.

37. The inherent distinctive character of a mark may be enhanced through the use that has been made of it. The opponent submits that the earlier mark has a high degree of distinctive character and points to its inclusion in online dictionaries and reference materials to denote the group of eight universities and colleges listed in paragraph 21 above. As an example, the Cambridge Online Dictionary defines "the Ivy League" as *"a group of eight respected colleges and universities in the northeast of the U.S."*.[6] Ms Harris's evidence also includes a large selection of news articles from sources such as *The Guardian*, *The Daily Telegraph, The Independent, Scotsman, Financial Times, Daily Mail, Evening Standard* and *The Sunday Times* dated from 16 July 2010 to 7 March 2022, all using the phrase "The Ivy League" to refer to these institutions as a group and all on the subject of higher education.[7] I can accept that the earlier mark has a high degree of distinctive character for services relating to higher education.

38. Turning to the remaining services, I bear in mind that the applicant is deemed to have admitted that the mark is well-known for all the services claimed by the opponent. I remind myself that for the purposes of section 56(1), it is the UK in which the mark must be well-known. Given this admission, it would be logical to proceed on the basis that the mark has a high degree of distinctive character for all the services.

[6] Exhibit RH1, page 277.
[7] Exhibit RH1, pages 14-75, 80-121, 141-179.

Conclusions on likelihood of confusion

39. There is no arithmetical formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services or vice versa. I keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them they have in their mind.

40. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but for some reason assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16.

41. I have found that the marks are highly similar and that the earlier mark is highly distinctive. Furthermore, the dominant and distinctive element of the later mark is the earlier mark. Where the average consumer is paying a medium degree of attention, I consider that it is likely that they will, under the influence of imperfect recollection, mistake one mark for the other and be directly confused, whatever the degree of similarity of the services. This is the case for those services listed in my first group in paragraph 26 above.

42. Where the average consumer is paying a higher degree of attention, as in the second and third groups of services, imperfect recollection is less likely to be a factor. However, given that the dominant and distinctive element of the contested mark is the earlier mark, I consider that the average consumer will still be directly confused. However, in case I am wrong in this, I will also assess whether there is a likelihood of indirect confusion.

43. In paragraph 17 of his decision in *LA Sugar*, Mr Iain Purvis QC, sitting as the Appointed Person, gave the following examples of when indirect confusion could occur:

> "(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)."

44. As Mr Purvis stated, these are only examples. However, it is my view that the present case falls squarely within his example (b). The only addition is the word "NEW" which is a non-distinctive element one would expect to find in a sub-brand or brand extension. If the average consumer identifies that the marks are different, there is a likelihood of indirect confusion.

45. The opposition has been successful under section 5(2)(b), based on a well-known earlier mark as defined in section 56(1) of the Act.

Section 5(3)

46. As the opposition has been successful under section 5(2)(b), I shall not consider the section 5(3) grounds in detail. The opponent was also relying on its well-known mark under these grounds. I note that the applicant did not deny that the earlier mark had a reputation, that there would be a link between the marks and that damage would occur through dilution. The section 5(3) ground is also successful.

OUTCOME

47. The opposition has been successful, and Application No. 3763721 is refused registration.

COSTS

48. The opponent has been successful and is entitled to a contribution towards the costs of these proceedings in line with the scale set out in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent £1600 which has been calculated as follows:

Preparing a statement and considering the other side's statement: £300
Preparing evidence: £800
Preparation of written submissions in lieu of a hearing: £300
Official fee: £200
TOTAL: £1600

49. I therefore order Jeff Wilkinson and Lee Wilkinson, being jointly and severally liable, to pay Council of Ivy Group Presidents the sum of £1600. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 27th day of November 2023

Clare Boucher,
For the Registrar,
Comptroller-General