

O/1187/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003770008
BY INSPIRE STUDIES LIMITED
TO REGISTER



IN CLASSES 9, 16 & 41

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 434876 BY
INSPIRED EDUCATION HOLDINGS LIMITED

BACKGROUND AND PLEADINGS

1. On 25 March 2022, Inspire Studies Limited (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the goods and services set out in **Annex 1**. The applicant’s mark was published for opposition purposes on 8 April 2022 and, on 8 July 2022, it was opposed by Inspired Education Holdings Limited (“the opponent”).
2. The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under the 5(2)(b) and 5(3) grounds, the opponent relies upon the following marks:

The logo for 'inspired' is written in a blue, lowercase, serif font. The letters are closely spaced, and the 'i' and 'e' have distinct dots.

International Registration designating the UK no. 1592822

International registration date 20 April 2021

Date protection granted in the UK 1 October 2021

Relying on all services, namely:

Class 41: Education.

(“the opponent’s first mark”); and

INSPIRED EDUCATION

International Registration designating the UK no. 1632384

International registration date 8 September 2021

Date protection granted in the UK 11 August 2022

Relying on all services, namely:

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 services; blogging services.

("the opponent's second mark").

3. In respect of the 5(2)(b) ground, the opponent pleads that the applicant's mark, whether judged visually, aurally or conceptually, is highly similar to the opponent's marks. Further, the opponent argues that the goods and services are identical or, at minimum, similar. As such, the opponent claims that there is a clear likelihood of confusion between the marks at issue.
4. Under the 5(3) ground, the opponent claims that its marks enjoy a substantial and valuable reputation and that the relevant public will believe that there is an economic connection between the parties' marks. Such a connection, the opponent claims, will give rise to unfair advantage in favour of the applicant and that use of the applicant's mark will be detrimental to the opponent's reputation and detrimental to the distinctive character of its marks.
5. Lastly, under the 5(4)(a) ground, the opponent relies on the following unregistered rights:

INSPIRED

INSPIRED EDUCATION

INSPIRED EDUCATION GROUP

INSPIRED EDUCATION HOLDINGS LIMITED



6. The opponent claims to have used all of the above signs throughout the UK since 1 January 2015. As for the services relied upon, I note that these are the same across all six earlier rights. However, in my view, the way in which the services have been pleaded is somewhat unorthodox and potentially unclear. Rather than discuss the issues I have with the pleadings here, I will discuss them below when considering the 5(4)(a) ground as a whole.
7. As a result of the use of these unregistered signs, the opponent claims that it enjoys a substantial and valuable trading goodwill. As such, the opponent argues that use of the applicant's mark will constitute a relevant misrepresentation for the purposes of passing off and, therefore, actual or likely damage is inevitable.
8. The applicant filed a counterstatement wherein it denied all of the claims against it. That being said, I note that the applicant did make a concession in respect of the similarity of the parties' class 41 services; however, I will discuss this further below.
9. The opponent is represented by Bear & Wolf (UK) LLP and the applicant is represented by J A Kemp LLP. I note that the applicant's representatives have only been on the record as acting for the applicant since 27 January 2023. Prior to this, the applicant was professionally represented by a different firm. Both parties filed evidence with the opponent also electing to file evidence in reply. I note that during the evidence rounds, both parties also filed written submissions. No hearing was requested and neither party elected to file written submissions in lieu. This decision is taken following a careful perusal of the papers.
10. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

11. The opponent's evidence in chief came in the form of the witness statement of Mr Mark Heritage dated 7 December 2022. Mr Heritage is a partner at the opponent's legal representative and is, therefore, duly authorised to file evidence on behalf of the opponent. Mr Heritage's evidence is accompanied by thirteen exhibits, being those labelled MH1 to MH13.

12. The applicant's evidence came in the form of the witness statement of Mr Thomas Allister Webb dated 7 February 2023. Mr Webb is a trade mark attorney at the applicant's representative firm and is, therefore, duly authorised to make a statement on the applicant's behalf. Mr Webb's statement is accompanied by two exhibits, being those labelled TAW1 and TAW2.

13. As above, the opponent also filed evidence in reply. This came in the form of the second witness statement of Mr Heritage dated 28 April 2023. Mr Heritage's second statement includes just one exhibit, being that labelled MH14.

14. I do not propose to summarise the parties' evidence or submissions here. However, I have taken them all into consideration in reaching my decision and will refer to them below, where necessary.

PRELIMINARY ISSUE

15. The applicant has filed evidence regarding six third party businesses that use the word 'INSPIRE' or 'INSPIRED' in relation to education goods or services.¹ In its accompanying submissions, the applicant discusses this evidence in support of a

¹ TAW1

claim that the opponent's marks only enjoy a low level of distinctive character. In respect of this point, I refer to the case of *Zero Industry Srl v OHIM*, Case T-400/06 wherein the General Court ("GC") stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II 4865, paragraph 68, and Case T 29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II 5309, paragraph 71)."

16. Without anything substantive to demonstrate any actual use of these third-party marks in the marketplace, I am not willing to infer that the mere existence of the marks by way of just six screenshots is sufficient to point to a weakening of the distinctive character of the opponent's use of 'inspired'. In any event, I note that the screenshots before me are all undated and, therefore, are not even capable of pointing towards the position in the marketplace as at the relevant date for these proceedings (being the filing date of the applicant's mark). As a result, I find that the evidence provided by the applicant is of no assistance and I will say no more about it.

DECISION

Section 5(2)(b): legislation and case law

17. Section 5(2)(b) of the Act reads as follows:

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

(a) ...

(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 or association with the earlier trade mark.”

18. Section 5A of the Act states as follows:

“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.”

19. The opponent’s marks qualify as “earlier trade marks” for the purposes of this decision since they were applied for (designated for protection) at an earlier date than the applicant’s mark.² Neither of the opponent’s marks completed their registration process more than five years prior to the filing date of the applicant’s mark meaning that they are not subject to proof of use pursuant to section 6A of the Act. This means that the opponent can rely upon all services for which its marks are registered.

20. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson*

² See Section 6(1)(a) of the Act

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.

Comparison of goods and services

21. The applicant's goods and services are set out in the **Annex** to this decision. The opponent's services are set out at **paragraph two** above.

22. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if the goods specified in the contested trade mark application are included in a more general category covered by a term under the earlier mark (or vice versa).

23. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

24. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

25. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM), Case T-325/06, the GC stated that “complementary” means:

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

26. I have detailed submissions and evidence in respect of the goods and services comparison from both parties. It is not my intention to set these out in full

throughout my comparison. However, where I consider it appropriate to do so, I will discuss certain aspects of the parties' submissions.

Class 9

27. The applicant's position in respect of the class 9 goods (and class 16, for that matter) is that the opponent's marks are not registered for goods in class 9. While this is clearly the case, I remind myself of Section 60A of the Act which sets out that goods and services are not to be regarded as dissimilar on the ground that they appear in different classes under the Nice Classification. Therefore, it is incumbent upon me to consider the similarity of the goods of the applicant and the services of the opponent using the guidance set out in the case law cited above.

Education software; educational software; downloadable educational media; educational computer applications; children's educational software; educational computer software; educational mobile applications; computer software for education; downloadable educational course materials; Master of Education Software; educational tablet applications.

28. While the above goods are different in nature and method of use from the services of the opponent, namely "education" in the opponent's first mark's specification and "educational services" in its second, I am of the view that they share an overlap in purpose. I say this because the ultimate aim of the parties' goods and services is to educate the customer. In addition, I consider that there is an overlap in user as someone looking to seek educational services may also seek software/media that supports that education. Additionally, there may be a competitive relationship between the goods and services. For example, a user looking to gain an education may do so by seeking the services of the opponent rather than buying/downloading the educational software of the applicant or vice versa. Further, I consider it likely that educational service providers also provide software and other types of media for the purpose of educating its customers. While I do not consider that these goods are complementary (on the basis that software is not necessarily important or indispensable to classroom learning services, for example), I am of the view that

the overlapping factors are sufficient to warrant a finding that the above goods are similar to a medium degree with the services of the opponent.

E-books; audio books; downloadable e-books; downloadable electronic books.

29. The opponent's position in respect of the above goods is that they can (and are) used in the provision of education (and as part of entertainment, which is pertinent to the services of its second mark). The opponent claims that this means that the goods share a nature and use. Despite these submissions, the nature of the goods and services at issue here are clearly not the same. On one side, there are "education" and "entertainment and educational services" (in the opponent's first and second marks' specifications, respectively) and, on the other, the above goods are downloadable, electronic books. As for use, I appreciate that there may be some overlap as the applicant's goods are not limited in any way so can, therefore, be said to electronic books for educational or entertainment purposes. As such, there is a degree of overlap in purpose. Following on from the fact that the applicant's goods can cover educational and entertainment purposes, I am of the view that there is also some overlap in user and trade channels on the basis that someone looking for educational/entertainment services may also seek to buy e-books that cover educational/entertainment topics. Further, based on the same reasoning set out in the preceding paragraph, I consider that there may be a competitive relationship between the goods and services also. Taking all of this into account, I am of the view that these goods and services are similar to a medium degree.

Electronic publications; electronic publications, downloadable; publications (electronic -), downloadable; downloadable electronic publications; electronic publications (downloadable); downloadable publications; publications in electronic format.

30. The above terms are seven differently worded iterations of the same goods, being electronic publications, and I will assess them as such. My view is that electronic publications share a degree of similarity with "education" and "entertainment and educational services" in the opponent's first and second mark's specifications, respectively. I say this following a similar reason to that of the preceding paragraph,

namely that the above terms can all be used for the purposes of education and entertainment meaning that, while the nature and methods of use differ, I consider that there is some overlap in user, purpose and trade channels. Further, while they are not complementary, I consider that they may be competitive in nature. As such, I find that these goods are similar to a medium degree with the opponent's services.

31. For the avoidance of doubt, I have given consideration to whether any degree of similarity between the above goods and "publication of electronic texts" in the opponent's second mark's specification offers anything beyond the assessment made above. While the opponent's service here relate to publishing services, the nature, method of use, purpose and user all differ. I appreciate that the trade channels are likely to overlap and that there may be a complementary relationship between them. However, I am of the view that, at best, it would offer only a low to medium degree of similarity and, therefore, offers a lesser degree of similarity when compared to those discussed above.

Downloadable electronic newsletters.

32. The purpose of the above goods is to provide news to the reader. It is my understanding that a newsletter can cover both educational issues or entertainment topics. For example, it is common in the trade for providers of various types of services to offer its customers the chance to sign up to its newsletters so it can keep up to date with activities of that provider and have access to any early offers or discount codes and so on. As such, I consider that the provider of "education" and "entertainment and educational services" (in the opponent's first and second marks' specifications, respectively) would also provide the above goods meaning that they overlap in trade channels. Further, I consider that the users would also overlap as one that seeks education or entertainment services is also likely to sign up for a newsletter covering those topics. That being said, I am of the view that the natures, methods of use and purposes for these goods and services differ. Lastly, I do not consider that they share a complementary or competitive relationship. Taking all of this into account, I am of the view that the goods and services are similar to a low degree.

33. For the avoidance of doubt, I have also compared the above goods of the applicant to “providing electronic publications online (not downloadable by telematic means)” in the opponent’s second mark’s specification. I am of the view that this offers the same degree of similarity as the comparison made above. This is on the basis that downloadable electronic newsletters are a type of online publication and given that the opponent’s service is not limited in any way, it can be said to cover publication of online newsletters.³ While I appreciate that the user and purposes differ (and the opponent’s goods expressly exclude downloadable publications), there is still an overlap in trade channels on the basis that undertakings that provide downloadable newsletters are also likely to be able to publish their own non-downloadable articles (on this point, I note that online publishing is a distinct service from physical publishing). Further, I am of the view that the goods and services may share a complementary relationship on the basis that the publishing of an electronic newsletter (be that downloadable or not) is important to the provision of the electronic newsletter itself. As such, I consider that the average consumer will believe that they are provided for by the same undertaking.

Electronic book readers; digital book readers.

34. Having considering the opponent’s submissions, it does not appear to me that it has made any comments in respect of the above goods.⁴ While this is noted, I do not take it to be an admission that they are dissimilar so I will consider them in the ordinary way. Having considered the position, it is clear to me that the nature and methods of use of the above goods are not the same as any of the services of the applicant. While I appreciate that there is an overlap in user on the basis that those who seek the educational or entertainment services of the opponent are also those who are likely to use the above goods of the applicant. However, such an overlap is, in my view, somewhat fleeting due to the broad user base of the parties’ goods and services. As for purpose, I appreciate that someone may use an electronic or

³ I say this on the basis that, as per definition 2.a of the Online Oxford Dictionary (see https://www.oed.com/dictionary/publication_n?tab=meaning_and_use#27766205) publication is defined as ‘the action of making material publicly accessible or available in electronic form’. This can, therefore, cover the making of any material public which includes newsletters.

⁴ I note that it has made submissions in respect the rental services in relation to the same.

digital book reader to view educational material (be that in a classroom or not)⁵, however, the actual purpose of the device is not to educate but is to facilitate the viewing of the electronic material. In this scenario, it is the material itself that has the purpose of educating, not the device itself. As such, I do not consider that there is any overlap in purpose between these goods and services. The same can be said for trade channels on the basis that, as far as I understand it, education providers do not produce and sell their own branded electronic book readers. On this point, there is no evidence before me that such a practice is common in the trade. I do not consider that the goods or services share a complementary relationship with one another as an electronic book reader is not important or indispensable to education or entertainment services, or vice versa. Lastly, there is also no competitive relationship between these goods and services as I cannot see any reason why a user would buy an electronic book reader over seeking education or entertainment services, or vice versa. Taking all of the above into account, I am of the view that the somewhat fleeting overlap in user is not sufficient to warrant a finding that these goods are similar to any degree. As a result, I consider that these goods and services are dissimilar.

35. In respect of the above goods, I have also given consideration to the position as to any degree of similarity between them and the opponent's "publication of electronic texts" which is present in the opponent's second mark's specification. While the opponent's service relates to electronic texts which can be displayed on the applicant's electronic readers, I do not consider this sufficient to warrant a finding of similarity between them. In my view, the nature, methods of use and purposes all differ. Further, the user of the opponent's services will be different from those who actually use the electronic/digital readers themselves and I see no reason to find that a publisher of an electronic publication would also produce and sell its own electronic/digital readers. On this point, I appreciate that some very large companies (such as Amazon, as a prime example) may do so. However, I do not consider this to be something that is common in the trade. Lastly, there is no complementary relationship between the goods and services. I accept that the goods and services are important to one another, however, I do not believe that

⁵ On this point, I note that evidence has been filed at Exhibits MH10.1, 10.2 and 10.3 regarding use of computer devices (such as laptops, computers and tablets) in schools.

consumers would think that the undertaking responsible for the electronic/digital reader is the same as that which published the electronic publication itself. As a result, I consider that these goods and services are also dissimilar.

36. I also note that the opponent's second mark's specification includes the term "electronic book reader rental". In short, I do not consider that these goods and services overlap in nature, method of use or purpose. As for user, I do not consider that a user of an electronic book reader would also look to rent one and I have nothing to suggest that this would be the case. That being said, I appreciate that there may be some degree of competition between them as a consumer will either buy an electronic book reader or seek to rent one. As for trade channels, it is my understanding that a producer of electronic book readers would not be the same undertaking that rents them out. On this point, I have no evidence to suggest that such a practice is common in the trade. Instead, I am of the view that the rental will be provided by an un-associated third party. Lastly, I note that the goods are essential in the provision of the service but I do not consider that consumers would consider the responsibility of the goods and services to lie with the same undertaking. Instead, it is my view that consumers are accustomed to rental services being provided by un-associated third parties and, again, I have no evidence to suggest otherwise. Taking all of this into account, I do not consider the fact that the goods and services may be competitive is sufficient to warrant a finding that they share any degree of similarity. The goods and services are, therefore, dissimilar.

Electronic book reader covers.

37. Bearing in mind that I have found electronic book readers dissimilar to the opponent's services, I see no reason why I should find the covers for the same are similar to any degree with the opponent's services. As such, these goods are dissimilar.

Memo books [electronic].

38. I have no submissions as to what the above term covers. In the absence of such, it is my view that it is an electronic tablet device that can be used to take notes (with input via either a keypad or a stylus). Following the same reasoning as set out in paragraphs 34 to 36 above, I am of the view that these goods are dissimilar to the opponent's services.

Lithium secondary batteries.

39. The opponent has provided evidence in respect of the above term. Firstly, it seeks to explain the difference between a primary and secondary battery.⁶ This sets out that a 'secondary' battery is one that can be re-charged. Secondly, the evidence sets out that, GLS, a UK-based education supplies websites, offers lithium secondary rechargeable batteries for sales alongside a wide range of other educational supplies and materials.⁷ The submissions of the opponent state that the reason such websites supply lithium batteries is fairly simple, namely that batteries are increasingly used in a variety of educational equipment in schools, college and universities, such as laptops, tablets, learning and gaming materials (such as LEGO). This argument is noted but is of no assistance here. It cannot be the case that batteries are similar to educational or entertainment services simply because some devices used with the intention of providing education/entertainment are powered with batteries. This is an argument that may carry more weight if the opponent's specification included electronic goods. However, it does not. If such an argument was relevant here, it could be said that any service that may be provided via battery operated devices (such as legal advice services that offer advice that is written on laptop, for example) is similar to batteries in class 9 and vice versa simply because said service may be prepared or viewed on a laptop. This would offer far too broad a scope of protection for such goods and services and, clearly, cannot be the case. As such, this argument is dismissed. In respect of the comparison of these goods and services, clearly there is no obvious level of similarity between them and they are plainly dissimilar.

⁶ MH9

⁷ MH10

Class 16 goods

Workbooks containing exercises; textbooks; educational books; printed answer sheets; reference books; educational publications; printed educational materials; educational and instructional material; [...] educational supplies; educational equipment.

40. All of the above goods can be said to be those that are used for educational purposes. For this reason, there is clearly an overlap in purpose on the basis that the opponent's "education" and "educational services" (in its first and second marks' specifications, respectively) also aim to provide education to the user. Further, I am of the view that someone who buys the above goods is also likely to be those that seek the education services of the opponent. As for trade channels, while it may not always be the case, I consider that it is common in the trade for providers of educational services to also provide the printed materials that are used in conjunction with those services. The goods do not overlap in nature or method of use and neither do I consider that the goods are competitive or complementary. While the educational services of the opponent may be important to the goods of the applicant, I am of the view that consumers are not likely to believe that the publications are always the responsibility of the service provider itself (for example, it is my understanding that some of the above goods may be provided by examination governing bodies and not the educational provider itself). Taking all of this into account, I am of the view that the goods and services are similar to a medium degree.

Books; hand books.

41. The above goods are not limited in any way and can, therefore, cover books for educational (and entertainment, for that matter) purposes. As such, I consider that the overlaps discussed in the preceding paragraph also apply here. Therefore, I consider that the goods and services are similar to a medium degree.

42. In addition to the above, I am of the view that there is also some degree of similarity between the above goods of the applicant and “publication of books” in the opponent’s second mark’s specification. I say this because while the nature, methods of use, purpose and users differ, publishers of books are commonly the providers of books also meaning that there is an overlap in trade channels between them. Further, I am of the view that goods and services are complementary on the basis that the publishing of books is important and/or indispensable to the books themselves and I am of the view that the average consumer will believe that the same undertaking will be responsible for both. Taking all of this into account, I am of the view that the goods and services are similar to a medium degree.

Book binders.

43. The above goods are, in my view, those that are used to bind books. I have considered this goods against the service of “publication of books” in the opponent’s second mark’s specification. These goods and services clearly do not share nature, methods of use or purpose. I also do not consider that they overlap in trade channels or user. Firstly, the undertaking that provides the book binders themselves will not be the undertaking that actually publishes the books. Instead, the binders will be provided by a separate producer that the publisher will then use in the process of publishing books. Secondly, in respect of user, the purchaser of book binders will be the publishing undertaking itself and not the customer of said publishing undertaking. The goods and services are not competitive and neither do I consider them to be complementary. This is on the basis a book binder may be important to the publishing of a book as it is what will bind the pages in place, however, I do not consider that the average consumer will believe that the responsibility of the binder rests with the same undertaking as that which provides the publishing services. Taking all of this into account, I am of the view that these goods and services are dissimilar.

Activity books; poster books; score books; birthday books; memorandum books; guide books; annuals [printed publications].

44. I see no reason to find that any of the above goods can be said to be plainly read as relating to educational services. They are, therefore, dissimilar to “education” in its first mark’s specification.

45. As for the opponent’s second mark, I also consider the above goods to be dissimilar to the services of “entertainment and educational services”. While I have covered education above (namely that these goods are not for educational purposes), I have not considered the entertainment aspect of the above goods. Firstly, the nature and methods of use for these goods and services differ. While I appreciate that some of the above goods may be used for entertainment purposes, the nature of entertainment at large is so broad that any overlap here is, in my view, minimal. As for user, again, I consider that the broad user base for entertainment services and the above goods is such that any overlap is fleeting. Turning to trade channels, I appreciate that some entertainment providers will sell both goods and services for entertainment purposes. However, these are commonly very large undertakings and such a practice is not, as far as I am aware, common in the trade. Therefore, the fact that some undertakings may provide both entertainment books and entertainment services at large, this is not sufficient to warrant a finding that the trade channels for these goods and services overlap. Taking all of this into account, these goods are dissimilar.

46. Having said all of the above, I am of the view that there is some degree of similarity between the above goods and “publication of books” in the opponent’s second mark’s specification. The nature, method of use, user and purposes of these services all differ. However, I do consider that there is an overlap in trade channels on the basis that publishers of books are often the same as those who provide the books themselves. Further, I consider that the publishing of said books is important to the books themselves and that the average consumer will believe that they are the responsibility of the same undertaking. Taking all of this into account, I am of the view that the overlap in trade channels and strong complementary relationship

between the services results in a medium degree of similarity between these goods and services.

Instructional materials.

47. While I appreciate that it could be said that instructional materials cover instruction manuals provided with the sale of other types of items such as electronic devices, for example. However, it is my view that it can also be said to cover teaching and learning materials. As such, I consider that it shares a level of similarity with “education” and “educational services” in the opponent’s first and second marks’ specifications, respectively. This is on the basis that while the goods and services differ in nature and method of use, they overlap in user, trade channels and purpose. Further, I accept that there may be a degree of complementary between them. As such, I consider that these goods and services are similar to a medium degree.

Printed information sheets; printed questionnaires; printed brochures; newsletters; printed newsletters; printed publications; publications (printed -); periodical publications; printed periodical publications.

48. As above, I have found between a medium degree of similarity between the various publications of the applicant and the publishing of books of the opponent. I note that in addition to publishing of just books, the opponent’s second mark’s specification consists of the term “publication of texts other than advertising texts”. Given that the above goods of the applicant are text publications, I am of the view that the same level of similarity applies to these goods and services, namely that they are similar to a medium degree.

Advertising publications; promotional publications.

49. In my view, the above terms do not cover books, being one of the specific items covered by the opponent’s publishing services (“publication of books”). Further, the other publication service in the opponent’s second mark (“publication of texts other than advertising texts”) explicitly excludes advertising texts. As such, there is no

overlap in nature, user, purpose or method of use. The goods and services are not competitive and neither are they complementary. Further, as far as I am aware, a provider of the above goods is also not likely to also publish other types of texts or books. On this point, I note that there is no evidence before me to suggest that such a practice is common in the trade. Without such, I am unwilling to find that there is any overlap in trade channels. As a result, I am of the view that these goods are dissimilar to the opponent's services.

Manuscript books; writing books; note books; drawing books; sketch books; autograph books.

50. While the above goods are type of books, they are items of stationery and not printed, published materials in the same way that the goods assessed at paragraphs 41 and 43 to 48 above are. As such, I am of the view that they are dissimilar to the opponent's publication services. That being said, I appreciate that they are goods that may be used in conjunction with education and/or entertainment. While the above goods clearly differ in nature and method of use with the opponent's "education" and "entertainment and educational services" in its first and second marks' specifications, respectively, I consider that there is an overlap in user between them. As for purpose, I am of the view that the above goods are for keeping notes (be that educational notes or otherwise), drawings and autographs. That being said, the actual purpose of these books is not for the provision of education or entertainment services and, therefore, I do not consider that they share the same purpose as the services of the opponent. Further, I do not consider that the trade channels overlap as I am not convinced that a provider of education or entertainment services also provides the above goods and have nothing before me to suggest otherwise. While I appreciate that there is an overlap in user, I do not consider that this is sufficient to warrant a finding that these goods are similar to any degree with the opponent's services.

Printed stationery; publication paper; paper; paper stock [printing paper]; directory paper; calendered paper; printing papers.

51. The above goods are a range of blank paper goods that are provided to customers in order for those customers to print their own materials on them or even write on them by hand. They are not goods that are published and neither can they be said to relate to educational or entertainment services. As such, I see no reason to find that there is any obvious overlap between the relevant factors of these goods and any of the opponent's services. Therefore, I consider these goods to be dissimilar.

Stationery supplies.

52. The above goods can cover a range of stationery goods as those discussed in the preceding paragraph and, in addition, writing materials such as pens and pencils. While they can be used by students taking notes for the purposes of their own education, I do not consider that this means that they are sufficiently similar to the opponent's "education" or "educational services". As such, I consider that they are dissimilar to the opponent's services.

Class 41 services

53. As I have mentioned above, the applicant has made a concession that there are "some similarities within class 41."⁸ Despite this, it has not set out which services it considers similar (or to what degree) and which it doesn't. For the avoidance of doubt, I do not take the concession of the applicant to mean that it concedes that all of its services have some degree of similarity with the services of the opponent. As such, I will proceed to consider the comparison in full in the ordinary way.

Secondary school education services; tuition; education and training consultancy; educational services for providing courses of education; education, teaching and training; teaching; education and training; educational testing; teaching services; education; educational seminars; education services; academies [education]; primary

⁸ See paragraph 12 of the applicant's submissions

education services; academy education services; educational services provided by institutes of higher education; educational services provided by institutes of further education; higher education services; pre-school education; academy services (education -); educational examination services; career counseling [education]; adult education services; secondary school educational services; further education; lingual education; health education; educational instruction; educational demonstrations; educational examination; educational services; conducting distance learning instruction at the secondary level; education examination; practical training in the field of welding; vocational education; legal education services; residential education courses; business educational services; technological education services; online education services; club education services; university education services; boarding school education; educational assessment services; providing of education; education academy services; computer education training; management education services; education and instruction; providing educational demonstrations; computer assisted education services; second language educational services; services of schools [education]; foreign language education services; education and instruction services; training in public relations; practical training; practical training [demonstration]; training (practical -) [demonstration]; practical training services; teaching of meditation practices; education (religious -); educational certification services, namely, providing training and educational examination; setting of educational standards; physical education instruction; team building (education); educational and training services; workshops for educational purposes; education and training services; English language education services; computer based educational services; educational courses (provision of -); educational and teaching services.

54. All of the above services are types of education services and, therefore, fall within the broader terms “education” and “educational services” in the opponent’s first and second marks’ specifications, respectively. As such, I find that the above services are identical under the principle outlined in *Meric*.

Publication of textbooks; publication of educational teaching materials; book publishing; publishing of books; publishing of educational material; publication of educational materials; publishing of newsletters; services for the publication of newsletters; publishing of educational matter; publication of educational texts;

publication of posters; publication of magazines; magazines (publication of -); publication of journals; publication of calendars; publication of printed matter, other than publicity texts; publication of manuals; publication of leaflets; publication of texts; books (publication of -); publication of booklets; publication of prospectuses; publication of educational books; publication of books, reviews; publication of printed directories; publication of musical texts; publication of audio books; publication of fact sheets; publication of instructional literature; publishing of medical publications; production [...] of educational and instructional materials; publication of year books; publication of text books; publication of training manuals; newspaper publication; publication services; publication of texts, other than publicity texts; issue of publications; publication of printed matter and printed publications; publication of brochures; publication of books; publication of newspapers; publication of catalogs; publication of medical texts.

55. The above services are publication services relating to the publication of physical goods. I note that the opponent's second mark's specification includes "publishing of texts (other than advertising)", "publication of books" and "publication of texts other than advertising texts". These services, in my view, either encompass the above terms of the applicant (meaning that they are identical under the principle outlined in *Meric*) or are self-evidently identical to the above terms (whether directly or worded slightly differently).

Publication of sheet music.

56. I appreciate that in the preceding assessment, I found that "publication of musical texts" in the applicant's specification was identical under the principle outlined in *Meric* with "publishing of texts (other than advertising)", "publication of books" and "publication of texts other than advertising texts" in the opponent's second mark's specification. While I consider the publication of sheet music may still, technically, be a 'text publication' (meaning that it is also identical under the principle outlined in *Meric* with the opponent's service), I consider it necessary to make a specific back up finding in the event that I am wrong to find identity on this basis. I do so because it can be said that, technically, sheet music is not text so the publication of the same is not covered by the publication of texts. If this is the case then instead

of the services being identical, I am of the view that they are highly similar on the basis that they overlap in nature, method of use, purpose, trade channels and user.

Publication of photographs.

57. The above term can, in my view, cover the publication of photographic books and, therefore, can be said to be identical to “publication of books” in the opponent’s second mark’s specification. However, if I am wrong in finding that the above term of the applicant covers photograph books, then it is similar to a high degree with the publication services of the opponent (namely with “publishing of texts (other than advertising)”, “publication of books” and “publication of texts other than advertising texts”, all of which are present in the opponent’s second mark’s specification) on the basis that these services overlap in nature, method of use, purpose, trade channels and user.

Online electronic publishing of books and periodicals; publication of electronic books and journals online; electronic online publication of periodicals and books; online publication of electronic books and journals; publication of periodicals and books in electronic form; publishing of electronic books and journals on-line; publication of electronic books and periodicals on the internet; on-line publication of electronic books and journals [not downloadable]; providing online newsletters in the fields of sports entertainment; providing newsletters in the field of computer games via e-mail; providing electronic publications; electronic publication services; providing on-line publications; providing online electronic publications; non-downloadable electronic publications; publication of electronic magazines.

58. All of the above services are types of online publication services, as such, I am of the view that they are identical under the principle outlined in *Meric* to publication of electronic texts in the opponent’s second mark’s specification.

Educational research.

59. The above service of the applicant is for the research in relation to education. Such a service is, amongst other things, likely to cover research into new courses to

provide and new learning techniques. These are the type of services that I would expect an education provider to also undertake. Therefore, I consider there to be an overlap in trade channels between the above service and “education” and “educational services” in the opponent’s first and second mark’s specifications, respectively. That being said, the nature and methods of use will plainly differ. As for user, I do not consider that a consumer looking to seek educational services is likely to also seek the research of the same. Instead, it is my view that education research is likely to be sought by education institutes or exam governing bodies, for example. Therefore, I consider the users differ. So too will the purpose of the services on the basis that the above service is to conduct research whereas the opponent’s services are to provide education itself. I appreciate that they both relate to education but the core purpose of each service differs. In respect of complementarity, I am of the view that research of education is likely to be important to the provision of education itself. I say this because education is a constantly evolving discipline that requires constant research in relation to subject matter (and the accuracy, thereof) and delivery techniques, and so on. It is my view that average consumers are likely to believe that the provider of the educational service is also responsible for the research behind said education. As such, I consider there to be a complementary relationship between these services. Taking the overlap in trade channels and the prominent complementary relationship between the services into account, I am of the view that the services are similar to a medium degree.

Educational consultancy; educational consultancy services; educational advisory services.

60. The above terms are consultancy and advisory services. While they relate to education, they are not educational services themselves. Having said that, they are similar to a degree with “information regarding education” in the opponent’s second mark’s specification. While the natures differ (one side has consultancy/advisory services whereas the other is simply the provision of information), I am of the view that the methods of use and purpose overlap to a degree. I say this because the services on both sides are so broad that they will inevitably cover services that will be sought and provided in the same manner.

Further, consultancy and advisory services are likely to have an informational aspect to them meaning that there is some scope for an overlap in purpose between them. In addition, I consider that the users will overlap on the basis that a user who seeks information in respect of education is also likely to seek consultancy and advisory services in relation to the same. Alternatively, they may be competitive in nature as a user may elect to seek information services over advice/consultancy services or vice versa. Further, I am of the view that the above services are likely to be provided by the same undertakings meaning that there is also an overlap in trade channels. Lastly, I do not consider that the goods and services are complementary. Taking all of this into account, I am of the view that they are similar to a high degree.

Rental of educational materials; hire of educational materials; leasing of educational material; rental of educational and instructional materials.

61. The above services are rental, hire and leasing services. While they cover educational materials, they are not educational services and are, therefore, not similar to the education services of the opponent. However, I note that the opponent's second mark's specification includes "book lending services". Given that books can be used for educational purposes, I am of the view that the services of the opponent can reasonably be said to cover rental of a type of educational material. As such, I am of the view that the above services encompass the opponent's, meaning that these services are identical under the principle outlined in *Meric*.

Development of educational materials; developing educational manuals.

62. The above services are those that are, in my view, provided by educational providers meaning that there is an overlap in trade channels between the above services and "education" and "educational services" in the opponent's first and second marks' specifications, respectively. While that may be the case, I do not consider that they overlap in user. This is because a user looking for educational services is unlikely to also seek the above services of the applicant. As for nature and methods of use, I consider that these are different. In respect of purpose of

these services, their core purposes differ (on one side the intention is to develop materials whereas on the other side's purpose is to educate). Having said that, I am of the view that their end purposes overlap to some degree, which is ultimately, to provide education. As for complementarity, I am of the view that the services are important to one another. For example, the provision of education itself is important for a developer of education materials. Further, consumers are likely to consider that the services are the responsibility of the same undertaking. As such, I consider there to be a strong level of complementarity between these services. Taking all of this into account, I am of the view that these services are similar to a medium degree.

Dissemination of educational material.

63. Dissemination is the act of spreading something widely. In the context of the above term, this simply means the provision of education material. As far as I am aware, education providers will also provide educational material to its students. Therefore, there is an overlap in trade channels with "education" and "educational services" in the opponent's first and second marks' specifications, respectively. As for purpose, the above services cover the provision of educational material and the opponent's services cover the provision of the actual education service itself. In my view, this result in some overlap in purpose. At their core, the natures of the services are the provision of something relating to education (be that in the form of lectures, for example, or textbooks). As such, I also consider there to be a limited overlap in nature. The methods of use differ, so too do the user. The services are not competitive but I do consider that they are complementary as the provision of textbooks, for example, is likely to be considered important to the education services. Further, the end user is likely to believe that the services are provided by the same undertaking. Taking all of this into account, I am of the view that the services are similar to a high degree.

Educational information; education information; information on education; information (education -); educational information services; education information services; provision of educational information; education (information relating to -).

64. The opponent's second mark's specification includes the term "information regarding education". This is identical to the above services, either because it is self-evidently identical to them or because it encompasses the above services (or vice versa) meaning that it is identical under the principle outlined in *Meric*.

Organisation of educational events; arranging of educational events; organising of education exhibitions; organising of educational congresses; organisation of educational seminars; organising of educational lectures; organization of educational symposia; organization of educational conferences; organising of education conventions; organisation of educational shows; conducting of educational events.

65. The opponent's second mark's specification includes "organization of exhibitions for cultural and educational purposes" and "organization and conducting of face-to-face educational forums, training workshops, colloquiums, conferences, seminars and symposiums". The above services of the applicant are all in-person events and can, therefore, be said to cover the organisation of 'face to face' events. It is my view that the above services are identical to the services of the opponent either on the basis that they are self-evidently identical (albeit some may be worded slightly differently, for example, a convention may be considered the same as a conference) or through the principle outlined in *Meric* (be that by virtue of the opponent's services encompassing the applicant's, or vice versa).

Issuing of educational awards.

66. The above services are typically those that are provided by awards bodies. While they are educational awards, they are not the same as "education" or "educational services" in the opponent's first and second marks' specifications. I do not consider that these services share the same nature, method of use, purpose or user. I do not consider that the services are competitive in nature and neither are they complementary. In respect of the latter point, I appreciate that education is clearly

important to the provision of awards for education but I see no reason to find that the consumers would believe that they originate from the same undertaking. For example, it may be the case that some educational providers do give awards to their students (meaning that there is some overlap in trade channels), however, awards may also be provided by governing bodies or local authorities rather than the provider itself. Without anything (by way of evidence) to support such a practice being common in the trade, I am not willing to find that the consumer would believe that the responsibility for both services falls to just one undertaking. Taking into account that I have only found that the services may overlap in trade channels, I am of the view that these services are dissimilar.

Electronic book reader rental.

67. I note that the opponent's second mark's specification includes the term "book lending services". In my view, there is some degree of similarity between these services on the basis that they share the same nature (as forms of rental services) and are likely to overlap in method of use as the consumer will select them in the same way. Further, I consider that there is some degree of overlap in purpose as both aim to rent something to the user (albeit the services cover different end products). Overall, I consider that these services are similar to a medium degree.

Caves for public admission; gardens for public admission.

68. I note that the opponent's submissions set out that consumers do not realistically visit caves or gardens for public admission other than for the purpose of education, entertainment or to engage in some form of cultural activity. While I appreciate that, as an example, a school may organise a school trip to caves or gardens, I do not agree with the opponent's position that this means that the above services are similar to its own education or entertainment services. This is because, in accordance with the case of *Sky v Skykick* [2020] EWHC 990 (Ch), I am required to interpret the above terms as covering the services covered by their literal meanings, which is the provision of caves or gardens for public admission. As such, I do not consider that the above services are educational or entertainment services and neither are they similar to those services to any sufficient degree.

69. In respect of the opponent's term that relates to cultural services, I note that this is "organization of exhibitions for cultural [...] purposes" in its second mark's specification. While I appreciate that the above services of the applicant may be cultural in nature, the opponent's term is an organisational service. It is, therefore, not the same as the provision of the cultural activity itself. Therefore, I consider that these services share no overlap in nature, method of use or purpose. However, I accept that the provider of a cave or garden for public admission may also organise cultural exhibitions in relation to those caves or garden meaning that there is an overlap in trade channels. Further, I also accept that a user of the opponent's organisational services may also visit the applicant's caves or garden. However, any overlap in user is, in my view, minimal given the broad nature of the user base for the applicant's goods. Overall, I do not consider that the overlap in trade channels and minimal overlap in user between these services is sufficient to find that they are similar to any degree. As such, I find that they are dissimilar.

70. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, the application aimed against those services that I have found to be dissimilar will fail.⁹ These services will, therefore, survive the section 5(2)(b) regardless of its outcome. They are as follows:

Class 9: Electronic book readers; digital book readers; memo books; electronic book reader covers; lithium secondary batteries.

Class 16: Advertising publications; promotional publications; book binders; manuscript books; writing books; note books; drawing books; sketch books; autograph books; stationery; printed stationery; publication paper; paper; paper stock [printing paper]; directory paper; calendered paper; printing papers.

Class 41: Issuing of educational awards; caves for public admission; gardens for public admission.

⁹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

The average consumer and the nature of the purchasing act

71. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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. (as he then was) described the average consumer in these terms:

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

72. The opponent's position is that the average consumer will be members of the general public that will select the goods and services more or less frequently at varying price points. It submits that while some goods and services will be selected with a high level of attention (such as private/fee paying education for juniors/non-adults), many will not be. The opponent goes on to state that the average consumer will tend to pay an average to reasonably above average degree of attention. As for the applicant, I note that it does not make any comment as to the identity of the average consumer but does submit that the average consumer would pay a high level of attention owing to the specialist nature of the goods and services because they will be inherently focused on the quality of what they are selecting. I note that in giving its submissions, the applicant also mentions the fact that the degree of attentiveness would be more than average.

73. While I agree that the average consumer will consist of members of the general public, I am of the view that it will also include professional users. I say this because

the applicant's mark includes terms that, for example, cover practical training in the field of welding and both parties' marks include a range of publishing services. Clearly such services will be sought by professional users in the welding industry or in the business of publishing.

74. The frequency with which the goods and services at issue are purchased will vary. Some goods will clearly be selected frequently (such as activity or poster books, for example) but some services (such as organisational services, for example) are likely to be selected far less frequently. The goods and services are likely to be available via a range of retailers and this can include general retailers (for books, for example) and specialist providers (such as educational institutes, for example) and their online equivalents. The goods will be self-selected by the consumer after having inspected them on shelves or racks or, in the case of online purchases, after having viewed an image of them on a website. As for the services, these will be selected after having viewed a list of services in catalogues, placards or online. The goods and services will be selected predominantly visually but I do not discount an aural component playing a role, particularly for more specialised services that are selected directly from educational institutes, for example, which, in my view, are likely to also involve discussions with sales representatives.
75. For the most part, I am of the view that the average consumer will pay a medium degree of attention when selecting the goods and services at issue. Given the wide range of goods and services at issue, I am of the view that the level of attention paid will vary quite considerably. For the most part, the selection process will involve a medium degree of attention. However, some goods, such as activity or poster books, for example, are likely to attract a lower degree of attention. That being said, there are clearly some services that will attract a higher degree of attention on the basis that they will be selected by professional users (such as those I have discussed above) who will look to ensure that the selection of the same is suitable for their business needs. Further, on this point, I agree with the opponent in that some private/fee paying customers of educational services are also likely to pay a higher degree of attention.

76. For the avoidance of doubt, I consider that I find that the level of attention paid for the goods and services at issue will range from low to relatively high (but not the highest).

Comparison of the marks


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

78. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

80. The respective trade marks are shown below:

The opponent's marks	The applicant's mark
<p data-bbox="357 309 778 412">inspired</p> <p data-bbox="357 432 735 468">("the opponent' first mark")</p> <p data-bbox="347 539 743 575">INSPIRED EDUCATION</p> <p data-bbox="323 595 767 631">("the opponent's second mark")</p>	

81. I have detailed submissions from both parties in respect of the marks comparison. I do not intend to reproduce these here but confirm that I have taken them into account in conducting my assessment.

Overall Impression

The applicant's mark

82. The applicant's mark is a figurative mark that consists of both word and device elements. The device element, which sits at the beginning of the mark is an unknown shape presented in two different shades of purple. The applicant submits that this is a book device. While noted, and I appreciate that this may have been the intention of the applicant, I am not convinced that consumers would see it as such. As for the word elements, these are the words 'inspire', which is in the same lighter shade of purple as found in the device element. While it is presented in a standard typeface, I note that the two letter i's are styled slightly differently (albeit still standard). The word 'inspire' sits above the smaller second word, being 'studies', which is presented in a standard typeface and in the darker shade of purple as found in the device element. In considering the overall impression of the mark as a whole, I remind myself that average consumers tend to focus on elements of marks that can be read. So while the device element sits at the beginning of the mark, it is 'inspire' that dominates the overall impression of the

mark on the basis by virtue of being the largest word element. It is my view that the device element and the word 'studies' will play equal, but lesser, roles.

The opponent's marks

83. The opponent's first mark is a figurative representation of the word 'inspired'. The word is presented in a unique stylised typeface with the letters 'inspir' in grey and the letters 'ed' presented in blue. Despite the colour split, I am of the view that the mark will still be read as the word 'inspired'. I say this because I do not consider that consumers will split the mark up to read as two separate elements, being 'inspir' and 'ed'. In my view, this would have no obvious recognisable meaning and the consumers would consider it to be illogical (notwithstanding the fact that, as set out above, average consumers do not artificially dissect marks). As such, I am of the view that 'inspired' dominates the overall impression of the mark with the stylisation and colour split playing lesser roles.

84. As for the opponent's second mark, this is a figurative mark presented in a particular, but standard black typeface. It consists of the words 'INSPIRED EDUCATION' presented in a black standard typeface. Given the varying nature of the services for which this mark is registered, I am of the view that 'EDUCATION' will play different roles. For example, where the mark is viewed on educational services, it will play a lesser role (with 'INSPIRED' playing the greater role). However, where it is not, it will play an equal role with 'INSPIRED'.

Visual Comparison

The applicant's mark and the opponent's first mark

85. Visually, these marks share the letters 'I-N-S-P-I-R-E'. This forms the entirety of the dominant word of the applicant's mark and six of the seven letters in the opponent's sole verbal element. The marks differ in the presence of the device element and the word 'studies' in the applicant's mark and the letter 'd' in the opponent's. Further, the marks are stylistically different and also, do not overlap in use of the same colours. While the points of difference come in elements that all

play lesser roles, or sit at the end of the marks (namely the letter 'd' in the opponent's mark), they are numerous and play quite an impact on the visual comparison. That being said, the dominance and similarity between the 'inspire'/'inspired' elements is sufficient to find that the marks are similar to a medium degree.

The applicant's mark and the opponent's second mark

86. These marks share the same similarity as the one discussed above, namely that they share the letters 'I-N-S-P-I-R-E'. They differ in the stylisation, the word 'studies' and the device element in the applicant's mark and the letter 'D' that sits at the end of the shared element and the word 'EDUCATION' in the opponent's mark. While the opponent's mark is figurative, it is still a word only mark and may, therefore, be presented in the same typeface as used in the applicant's mark. Further, it is registered in black so may, therefore, be used in either shade of purple used in the applicant's mark.¹⁰ Taking all of this into account, I am of the view that they are similar to between a medium and high degree.

Aural Comparison

87. The aural component of the applicant's mark is 'inspire studies'.¹¹ This consists of four syllables that will be pronounced in the ordinary way. As for the opponent's marks, these will also be pronounced in the ordinary way with the first mark consisting of three syllables and the second consisting of seven syllables.

The applicant's mark and the opponent's first mark

88. In considering the comparison with the opponent's first mark, I note that the words 'inspire' and 'inspired' are highly similar from an aural perspective. However, they are not the same as their pronunciations differ slightly at the end. That being said,

¹⁰ While it may be presented as either, it cannot be both as notional use of black and white marks does not cover contrived colour splits.

¹¹ While studies may be descriptive for some goods and services (as I will discuss below), this does not render it aurally invisible. On this point, see the comments of Mr Phillip Harris in *Purity Hemp Company Improving Life as Nature Intended*, Case BL O/115/22

I consider that the similarity between them is sufficient to give rise to an overall level of aural similarity between the marks. On this point, I remind myself that beginnings of marks tend to be the parts of marks that consumers focus on.¹² I say this whilst bearing in mind that ‘studies’ in the applicant’s mark has no aural counterpart in the opponent’s first mark. Taking all of this into account, I am of the view that the marks are aurally similar to between a medium and high degree.

The applicant’s mark and the opponent’s second mark

89. Turning to the opponent’s second mark, this shares the same point of aural similarity as discussed above (‘inspired’ against ‘inspire’). The difference in the presence of the word ‘studies’ in the applicant’s mark still exists. In addition, there is a further point of difference between the marks in the presence of ‘education’ at the end of the opponent’s second mark. While the additional aural difference is noted, it sits at the end of the marks and, as above, the beginnings of marks tend to have more of an impact. Taking all of the above into account, I am of the view that the marks are aurally similar to a medium degree.

Conceptual Comparison

90. I note that the opponent submits that the marks are conceptually similar to a high degree. The applicant denies this by referencing the fact that ‘inspired’ and ‘inspire’ have standalone definitions.¹³ Despite denying the high level of similarity it offers no alternative aside from simply sufficing they have significant differences. While I have taken these submissions into account, I do not agree that the differences are significant from a conceptual point of view. I appreciate that ‘inspire’ and ‘inspired’ have different dictionary definitions, however, they are words that have very similar meanings and will immediately be associated with each other from a conceptual standpoint. As such, I consider that while ‘inspired’ and ‘inspire’ are not conceptually identical, they are highly similar.

¹² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

¹³ And indeed, it has provided evidence of the meaning of ‘inspired’ at Exhibit TAW2 in support of the same.

The applicant's mark and the opponent's first mark

91. The concept that the consumer will take from the applicant's mark (as a whole) is the idea of one being inspired to study or studies with the aim of inspiring the user. This is particularly the case given that the majority of the goods and services at issue relate to education and learning. As for the opponent's first mark, the sole message here is 'inspired', this is a well-known dictionary word. To borrow the evidenced definition put forward by the opponent, this means '*having excellent qualities or abilities' produced with the help of inspiration.*'¹⁴ While it lacks the reference to studies, the dominance of the concept of 'inspire'/'inspired' across both marks will, in my view, result in a high degree of conceptual similarity.

The applicant's mark and the opponent's second mark

92. Turning to the opponent's second mark, I consider its concept, as a whole, will be taken as a reference to the idea of one being inspired to educate or education with the aim of inspiring the user.¹⁵ While the reference to 'study' and 'education' are slightly different, they both relate to the idea of learning and I am of the view that they convey pretty much the same message. As such, I find that these marks are conceptually similar to a very high degree.

Distinctive character of the opponent's marks

93. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

¹⁴ See page 2 of TAW2

¹⁵ I say this regardless of whether the mark is viewed on services that relate to education or not.

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

94. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods or services for which it is registered, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has claimed that its marks enjoy enhanced degrees of distinctive character through use and has filed evidence to that effect.

95. Before considering the position in respect of enhanced distinctiveness through use, it is necessary to consider the inherent position. I note that the applicant has filed evidence of various education providers that use the words ‘inspired’ or ‘inspire’ in their marks. However, I have discussed this evidence as a preliminary issue above and have found that it is of no assistance. The opponent’s first mark, as I have discussed above, is the word ‘inspired’ in a stylistic typeface and presented in two colours (the letters ‘I-N-S-P-I-R’ in grey with ‘E-D’ in blue). The word ‘inspired’ will be given its ordinary dictionary. In the context of educational goods and services, I consider it somewhat allusive to the idea that the education provided is inspiring or that it inspires its users to learn. As such, I am of the view that, inherently, its distinctiveness sits somewhere between low and medium. Having said that, I am of the view that the stylisation of the word together with the contrived colour split

are such that they increase the distinctive character of the mark to the point that, as a whole, it is inherently distinctive to a medium degree. In making this finding, I remind myself that I have found the stylistic elements to play lesser roles in the overall impression of the mark. However, for the avoidance of doubt, I wish to clarify that this does not mean that they cannot contribute to the distinctiveness of the mark as a whole.

96. Turning to the second mark, this consists solely of the words 'INSPIRED EDUCATION' with no stylisation whatsoever. As above, I consider 'INSPIRED' to be distinctive somewhere between a low and medium degree. When viewed on educational services, the addition of 'EDUCATION' does nothing to advance the distinctiveness of the mark any higher. This is because it is directly descriptive of education services. In such a scenario, the opponent's second mark, as a whole, is only distinctive to between a low and medium degree. However, where the services covered by the second mark do not relate to education (such as publishing and entertainment services, for example), it can be said that 'education' has no allusive or descriptive qualities. As such, it can be said to increase the distinctiveness of the mark to a medium degree for those services unrelated to education.

97. I turn now to consider the position in respect of enhanced distinctiveness due to the alleged use made of the opponent's marks. In considering the present assessment, I remind myself that for use to be sufficient to prove enhanced distinctiveness, it must be use within the UK.

98. Having considered the evidence, it appears to me that the opponent operates a range of schools across the world. These schools all form part of 'the inspired group'.¹⁶ The evidence sets out that the inspired group is:

"[A] leading global premium schools group operating in Europe, Australia, Africa, the Middle East and Latin America educating over 70,000 students across a global network of more than 80 schools."¹⁷

¹⁶ MH1

¹⁷ See page 6 of MH3

99. While this may be the case, the evidence before me in respect of actual use of the marks relied upon in the UK is limited. I note that, of the schools discussed, only two (the Fulham School and Reddam House school) are ones that are actually situated in the UK.¹⁸ Further, I note the presence of one offering, being an online school that operates in the UK (the 'InterHigh' school).¹⁹ While this online school is noted, it appears to be one that is not only aimed at UK consumers but also consumers across the world.²⁰ In addition to the above schools, I note that there is reference to 'British Schools King's College'.²¹ However, while this school teaches the English curriculum, it operates out of schools that are located outside of the UK itself.²² As a result, I fail to see how the existence of the 'King's College' schools are of any assistance to the opponent regardless of whether they teach the English curriculum.

100. As above, the evidence sets out that the opponent has 70,000 students across more than 80 schools around the world. While noted, there is no breakdown as to how many students are present in the different countries within which the opponent operates. I have already explained that the assessment I must make at present is based on use in the UK. The lack of evidence of customers in the UK is a significant problem for the opponent, especially given that the opponent, as above, operates across a number of different continents. Further, I note that there is nothing to suggest the level of turnover the opponent achieves due to tuition costs or other alternative streams of income, for example.

101. While evidence of student numbers or turnover would be of great assistance to the opponent in proving its claim, I appreciate that it is not essential for proving enhanced distinctiveness. For example, evidence of advertising or promotional activities could be of assistance. However, I note that the evidence before me appears to be simply made up of a series of print-outs taken from the opponent's own website pages. There is nothing further to demonstrate any advertising efforts

¹⁸ MH2 and MH3

¹⁹ MH5

²⁰ See page 2 of MH5

²¹ MH4

²² See page 3 of MH4 for a list of schools

or expenditure from the opponent that could be said to point to a wider level of knowledge amongst the UK consumer base.

102. Taking all of the above into account, I accept that the opponent operates a range of schools across the world that form part of the 'inspired group'. Further, I accept that those schools may teach the English curriculum. However, the lack of clarity as to how many students attend the UK based schools (be that the actual schools or the online school) and lack of any additional supporting evidence is, in my view, fatal to the opponent's claim to enjoy enhanced distinctiveness in its marks. As a result, I am not willing to find that the opponent's use of its mark is at a level that demonstrates that the distinctiveness of its marks have been enhanced through use of the same. Therefore, the inherent position applies, namely that the opponent's first mark is distinctive to a medium degree and its second mark is either distinctive to between a low and medium degree (if viewed on educational services) or a medium degree (if on other types of services such as publishing or entertainment services).

Likelihood of confusion

103. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he or she has retained in his or her mind.

104. In my goods and services comparison above, I found the parties' goods and services to range from being identical to similar to a low degree. I have found the average consumer for the goods and services to be members of the general public at large and professional users who will select the goods at issue via primarily visual means, although I do not discount an aural component playing a part (especially for the selection by business users which is likely to take place after an aural discussion with salespersons). I have concluded that the average consumer will, generally, pay a medium degree of attention when selecting the goods and services at issue but I appreciate that this may extend to both lower and higher (but not the highest) degrees for certain goods and services. In respect of the similarity of the marks at issue, I have found that the applicant's mark is visually similar to a medium degree, aurally similar to between a medium and high degree and conceptually similar to a high degree with the opponent's first mark. As for the comparison between the applicant's mark and the opponent's second mark, I have found them to be visually similar to between a medium and a high degree, aurally similar to a medium degree and conceptually similar to a very high degree. Lastly, I have found the opponent's first mark to be inherently distinctive to a medium degree. As for the opponent's second mark, I have found this to be either inherently distinctive to between a low and medium degree (where the services relate to education) or to a medium degree (where the services are unrelated to education). In respect of the lower degree of distinctive character for the second mark, I remind myself that a weak distinctive character of an earlier mark does not preclude a likelihood of confusion.²³

105. In considering all of the above, I am of the view that, in the present case, the differences between the dominant element of all marks, namely the words 'inspire' and 'inspired', are such that they are likely to be overlooked. I find this to be especially the case given the presence of other elements that may draw the eye of the consumer meaning that this difference may not be noticed. The overlooking of such a point in the marks will lead the consumer, when taking into account the principle of imperfect recollection, to misremember which mark was which. While I

²³ *L'Oréal SA v OHIM*, Case C-235/05 P

appreciate that 'inspire' and 'inspired' are different words with different dictionary definitions, I make the aforementioned finding on the basis that they are so strikingly similar and, ultimately, the marks carry highly similar concepts which will, in my view, aid in the fact that the consumers will be confused between them. As for the differing elements, these play lesser roles in the overall impressions of their respective marks and, in my view, are not sufficient to offset the fact that, when looking to recall the marks for one another, the consumer will focus on the highly similar elements of 'inspire'/'inspired' and, as such, are still likely to inaccurately recall the marks at issue.²⁴ Consequently, I consider that there exists a likelihood of direct confusion in respect of all of the marks at issue, regardless of the level of attention paid. I am of the view that this finding applies to all of those goods and services that are similar to any degree. In making this finding, I have borne in mind the principle of interdependence and remind myself that the only term that I have found to be similar to a low degree was "downloadable electronic newsletters". In my view, the similarity between the marks at issue and the clear overlap in likely users and trade channels between these goods and those services of the opponent are such that confusion will still arise regardless of the level of similarity.

106. I turn now to consider a likelihood of indirect confusion. In respect of such, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., 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

²⁴ I find that this also applies regardless of whether 'EDUCATION' in the opponent's second mark is viewed on educational services or not.

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)”.

107. In the present case, I am of the view that if consumers notice the differences between ‘inspire’ and ‘inspired’, there will be no likelihood of indirect confusion. This is on the basis that those consumers will not believe it logical for the opponent to change the dominant element of its mark, being ‘inspired’ to ‘inspire’. Conversely, I am of the view that the same applies in the opposite scenario, namely where the consumer is considering whether the applicant would change ‘inspire’ to ‘inspired’.

108. The above being said, indirect confusion does not require an assessment on the basis that all differences are noticed. In the present case, I am of the view that regardless of whether the average consumer is able to recall the lesser elements of the marks (such as the stylisation, use of colour and additional word elements),

there is at least a significant proportion of them who are still likely to overlook the difference between 'inspire' and 'inspired'. As such, I am of the view that the differences that will be noticed are those that are likely to be considered logical indicators of sub-brand or brand extensions. When considering the applicant's mark, the average consumer may consider it a brand extension of the opponent's marks on the basis that it is logical for an educational service provider to create an extension that focuses on studies. For example, when confronted with the applicant's marks on goods that may be used to support the user in studying for exams (such as text books or educational software), it is logical that the word 'studies' would be used by the opponent as an indicator that it has extended its brand from the provision of education services to education supplies such as textbooks. As for the presentational differences, I consider that these will either be viewed as indicators or alternative marks used by the same or economically linked undertakings or representative of an attempt at re-branding. Consequently, I consider that there is a likelihood of indirect confusion. For the same reasons when discussing the principle of interdependence above, I consider that this finding also applies to those goods that are only similar to a low degree.

109. As a result of the above, the opposition under the 5(2)(b) ground is partially successful. I will reserve summarising the level of success here as there are two grounds remaining that may ultimately render any summary at this point meaningless.

110. I will now proceed to consider the remaining grounds.

Section 5(3)

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

“5(3) A trade mark which –

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or

international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

112. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

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

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

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

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

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

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

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

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

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

113. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its marks and the applicant's marks are similar. Secondly, the opponent must show that its marks have achieved a level of knowledge/reputation amongst a

significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

114. I can deal with this ground swiftly. I have discussed the evidence of the opponent above at paragraphs 97 to 102. While this summary was made for the purpose of assessing enhanced distinctiveness, it is relevant here. Further, the issues discussed in that assessment are also relevant to the existence of a reputation. While I acknowledge that use outside of the UK (namely in the EU) may be relevant to the issue of reputation where EUTMs or comparable marks based on EUTM or International Registrations designated the EU, this is not the case here.²⁵ As such, as was the case above, the lack of specificity in relation to UK use is a major issue for the opponent. Put simply, I do not consider that the evidence does anything to demonstrate that either of the opponent's marks enjoy a reputation amongst a significant part of the relevant public in the UK. Consequently, the opposition based upon section 5(3) falls at the first hurdle.

Section 5(4)(a)

115. Section 5(4)(a) of the Act reads as follows:

“(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,

²⁵ While the opponent's marks are international registrations, they are designated for protection in the UK, not the EU.

(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.”

116. 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.”

117. Firstly, in considering the present ground, I note that the opponent seeks to rely on six unregistered rights. While two of these are figurative signs similar to that of the opponent’s first mark (that was relied upon under the other grounds of this opposition), the remaining four are simply word only signs consisting of the word ‘INSPIRED’ followed by a non-distinct or allusive word element. On balance, I see no need for the addition of the word only rights beyond the reliance upon the one that consists simply of the word ‘INSPIRED’.

118. Secondly, I do not consider that the services relied upon under the present ground are particularly clear or coherent. For illustrative purposes, the way in which the opponent has pleaded the reliance upon its services is as follows:

“(a) Education and teaching services – covering the British and International (“international baccalaureate”) educational curricula, on both a day basis and boarding student basis, and across all educational levels up to and including sixth form (i.e. from nursery/kindergarten through pre-prep, prep school and secondary GCSE / A-level / IBDP level) - from and at physical school sites in London (Fulham School) and Wokingham (Reddam House, Berkshire).

(b) Education and teaching services – in the form of online school offerings, which offer online education in both short term and long term programmes to students in the UK and around the world, who access such offerings and schooling online; as well as to local school authorities, schools and other organisations.

(c) Summer camps and extracurricular education courses and activities, on both a day basis and boarding basis, providing sporting, outdoor pursuits and language education and activities to pupils.

(d) As part of the above services, student and teacher recruitment services; teacher training and professional development services; human resources services; financial, marketing and sales services; business development services; and management services.”

119. My primary view is that while the services described at sub-paragraphs (a) to (c) above may be clear, some of the services described at sub-paragraph (d) are not. For example, are the ‘human resources services’ meant to be services in relation to education (on the basis that sub-paragraph (d) above refers to them as ‘part of the above services’) or ‘human resources’ at large? The same question can be asked of the remaining services set out in sub-paragraph (d). These pleadings offer me some difficulty as I am of the view that such an issue should have been highlighted at an earlier stage in these proceedings (namely upon the initial filing of the notice of opposition). That being said, I do not consider that this is of any consequence here. This is on the basis that, even ignoring the above points, that issues with the evidence that I have highlighted throughout this decision remain relevant here. In short, there is nothing before me by way of sufficiently solid trading activities that allows me to make any finding whatsoever that the opponent enjoys a protectable level goodwill in any of its signs. I say this whilst also bearing in mind that the level of use required to prove a protectable level of goodwill is far less than the level required for a finding that there exists a reputation or an enhanced distinctive character.

120. As a result of the above, I find that the opponent has failed to prove that it enjoys a protectable level of goodwill with which its signs are associate. I, therefore, conclude that the reliance upon the present ground fails at the first hurdle.

CONCLUSION

121. The opposition has succeeded under the 5(2)(b) ground for a majority of the goods and services applied for. Those goods and services that are to be refused are as follows:

Class 9: Downloadable electronic newsletters; downloadable electronic books; e-books; audio books; downloadable e-books; education software; educational software; downloadable educational media; educational computer applications; children's educational software; educational computer software; educational mobile applications; computer software for education; downloadable educational course materials; master of education software; educational tablet applications; downloadable publications; electronic publications; electronic publications, downloadable; publications (electronic -), downloadable; downloadable electronic publications; electronic publications (downloadable); publications in electronic format.

Class 16: Activity books; poster books; score books; birthday books; memorandum books; guide books; instructional materials; annuals [printed publications]; workbooks containing exercises; textbooks; educational books; books; printed answer sheets; printed information sheets; printed questionnaires; printed brochures; reference books; hand books; educational publications; printed educational materials; educational and instructional material; educational supplies; newsletters; printed newsletters; educational equipment; printed publications; publications (printed -); periodical publications; printed periodical publications.

Class 41: Secondary school education services; publication of textbooks; tuition; education and training consultancy; educational services for providing courses of education; education, teaching and training; publication of educational teaching materials; teaching; education and training; teaching services; electronic book reader rental; online electronic publishing of books and periodicals; publication of electronic books and journals online; electronic online publication of periodicals and books; online publication of electronic books and journals; publication of periodicals and books in electronic form; publishing of electronic books and journals on-line; publication of electronic books and periodicals on the internet; book publishing; on-line publication of electronic books and journals [not downloadable]; publishing of books; education; educational research; educational testing; educational consultancy; educational seminars; education services; education information; educational information; academies [education]; primary education services; academy education services; educational services provided by institutes of higher education; educational services provided by institutes of further education; higher education services; pre-school education; academy services (education -); educational examination services; career counseling [education]; adult education services; educational consultancy services; educational advisory services; educational certification services, namely, providing training and educational examination; educational assessment services; educational and training services; workshops for educational purposes; education and training services; English language education services; computer based educational services; educational courses (provision of -); educational and teaching services; conducting of educational events; publishing of newsletters; services for the publication of newsletters; providing online newsletters in the fields of sports entertainment; providing newsletters in the field of computer games via e-mail; secondary

school educational services; rental of educational materials; publishing of educational material; publication of educational materials; hire of educational materials; leasing of educational material; educational demonstrations; educational examination; further education; production and rental of educational and instructional materials; educational instruction; educational services; conducting distance learning instruction at the secondary level; lingual education; health education; education examination; vocational education; information (education -); legal education services; residential education courses; business educational services; information on education; technological education services; online education services; club education services; university education services; boarding school education; providing of education; education academy services; educational information services; education information services; computer education training; management education services; education and instruction; providing educational demonstrations; organising of education exhibitions; computer assisted education services; setting of educational standards; organising of educational congresses; second language educational services; organisation of educational seminars; services of schools [education]; provision of educational information; education (information relating to -); organisation of educational events; arranging of educational events; foreign language education services; publishing of educational matter; publication of educational texts; organising of educational lectures; organization of educational symposia; organization of educational conferences; organising of education conventions; organisation of educational shows; education and instruction services; newspaper publication; publication services; publication of texts, other than publicity texts; issue of publications; publication of printed matter and printed publications; publication of brochures; publication of books; publication of newspapers; publication of catalogs; publication of posters; publication of magazines;

magazines (publication of -); providing electronic publications; publication of journals; publication of calendars; publication of photographs; publication of printed matter, other than publicity texts; publication of manuals; publication of leaflets; publication of texts; books (publication of -); publication of booklets; publication of prospectuses; electronic publication services; publication of educational books; publication of books, reviews; publication of sheet music; publication of medical texts; providing online electronic publications; non-downloadable electronic publications; publication of electronic magazines; training in public relations; publication of printed directories; publication of audio books; publication of fact sheets; publication of instructional literature; publishing of medical publications; publication of musical texts; publication of year books; publication of text books; providing on-line publications; publication of training manuals; practical training; practical training [demonstration]; training (practical -) [demonstration]; practical training services; teaching of meditation practices; education (religious -); practical training in the field of welding; physical education instruction; team building (education); development of educational materials; dissemination of educational material; developing educational manuals.

122. However, those goods that I have either found to be dissimilar or similar to only a low degree survive the opposition and, subject to any appeal, they are permitted to proceed to registration. Those goods and services are:

Class 9: Memo books [electronic]; Electronic book readers; digital book readers; electronic book reader covers; lithium secondary batteries.

Class 16: Manuscript books; sketch books; autograph books; drawing books; writing books; note books; book binders; advertising publications; promotional publications; printed stationery;

publication paper; paper; paper stock [printing paper]; directory paper; calendered paper; printing papers; stationery supplies.

Class 41: Issuing of educational awards; caves for public admission; gardens for public admission.

COSTS

123. As the opponent has succeeded against a majority of the applicant's goods and services, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. While some goods and services of the applicant may proceed to registration, I am of the view that the scope of success enjoyed by the opponent does not warrant any reduction in the costs award I make. In the circumstances, I award the opponent the sum of **£1,200** as a contribution towards its costs. The sum is calculated as follows:

Preparing the notice of opposition and considering the counterstatement:	£200
Filing evidence, considering the applicant's evidence and filing evidence in reply:	£500
Written submissions in lieu:	£300
Official fees:	£200
Total:	£1,200

124. I hereby order Inspire Studies Limited to pay Inspired Education Holdings Limited the sum of £1,200. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 15th day of December 2023

A COOPER
For the Registrar

Annex 1

Class 9

Memo books [electronic]; Downloadable electronic books; Electronic book readers; Electronic book reader covers; E-books; Audio books; Downloadable e-books; Digital book readers; Education software; Educational software; Downloadable educational media; Educational computer applications; Children's educational software; Educational computer software; Educational mobile applications; Computer software for education; Downloadable educational course materials; Master of Education software; Downloadable electronic newsletters; Lithium secondary batteries; Educational tablet applications; Downloadable publications; Electronic publications; Electronic publications, downloadable; Publications (Electronic -), downloadable; Downloadable electronic publications; Electronic publications (downloadable); Publications in electronic format.

Class 16

Workbooks containing exercises; Textbooks; Educational books; Books; Printed answer sheets; Printed information sheets; Printing papers; Printed questionnaires; Printed brochures; Printed stationery; Activity books; Writing books; Guide books; Poster books; Drawing books; Manuscript books; Score books; Birthday books; Autograph books; Sketch books; Memorandum books; Reference books; Book binders; Hand books; Note books; Educational publications; Printed educational materials; Educational and instructional material; Stationery and educational supplies; Newsletters; Printed newsletters; Educational equipment; Instructional materials; Printed publications; Publications (Printed -); Periodical publications; Publication paper; Advertising publications; Promotional publications; Printed periodical publications; Annuals [printed publications]; Paper; Paper stock [printing paper]; Directory paper; Calendered paper.

Class 41

Secondary school education services; Publication of textbooks; Tuition; Education and training consultancy; Educational services for providing courses of education; Education, teaching and training; Publication of educational teaching materials; Teaching; Education and training; Teaching services; Electronic book reader rental;

Online electronic publishing of books and periodicals; Publication of electronic books and journals online; Electronic online publication of periodicals and books; Online publication of electronic books and journals; Publication of periodicals and books in electronic form; Publishing of electronic books and journals on-line; Publication of electronic books and periodicals on the Internet; Book publishing; On-line publication of electronic books and journals [not downloadable]; Publishing of books; Education; Educational research; Educational testing; Educational consultancy; Educational seminars; Education services; Education information; Educational information; Academies [education]; Primary education services; Academy education services; Educational services provided by institutes of higher education; Educational services provided by institutes of further education; Higher education services; Pre-school education; Academy services (Education -); Educational examination services; Career counseling [education]; Adult education services; Educational consultancy services; Educational advisory services; Educational certification services, namely, providing training and educational examination; Educational assessment services; Educational and training services; Workshops for educational purposes; Education and training services; English language education services; Computer based educational services; Educational courses (Provision of -); Educational and teaching services; Conducting of educational events; Publishing of newsletters; Services for the publication of newsletters; Providing online newsletters in the fields of sports entertainment; Providing newsletters in the field of computer games via e-mail; Secondary school educational services; Rental of educational materials; Publishing of educational material; Publication of educational materials; Hire of educational materials; Leasing of educational material; Development of educational materials; Dissemination of educational material; Educational demonstrations; Educational examination; Further education; Production and rental of educational and instructional materials; Educational instruction; Educational services; Conducting distance learning instruction at the secondary level; Lingual education; Health education; Education examination; Vocational education; Information (Education -); Legal education services; Residential education courses; Business educational services; Information on education; Technological education services; Online education services; Developing educational manuals; Club education services; University education services; Boarding school education; Providing of education; Education academy services; Educational information services; Education information services; Computer education training;

Management education services; Education and instruction; Providing educational demonstrations; Organising of education exhibitions; Computer assisted education services; Setting of educational standards; Organising of educational congresses; Second language educational services; Organisation of educational seminars; Services of schools [education]; Provision of educational information; Education (Information relating to -); Organisation of educational events; Arranging of educational events; Issuing of educational awards; Foreign language education services; Publishing of educational matter; Publication of educational texts; Organising of educational lectures; Organization of educational symposia; Organization of educational conferences; Organising of education conventions; Organisation of educational shows; Education and instruction services; Newspaper publication; Publication services; Publication of texts, other than publicity texts; Issue of publications; Publication of printed matter and printed publications; Publication of brochures; Publication of books; Publication of newspapers; Publication of catalogs; Publication of posters; Publication of magazines; Magazines (Publication of -); Providing electronic publications; Publication of journals; Publication of calendars; Publication of photographs; Publication of printed matter, other than publicity texts; Publication of manuals; Publication of leaflets; Publication of texts; Books (Publication of -); Publication of booklets; Publication of prospectuses; Electronic publication services; Publication of educational books; Publication of books, reviews; Publication of sheet music; Gardens for public admission; Publication of medical texts; Providing online electronic publications; Non-downloadable electronic publications; Publication of electronic magazines; Training in public relations; Caves for public admission; Publication of printed directories; Publication of audio books; Publication of fact sheets; Publication of instructional literature; Publishing of medical publications; Publication of musical texts; Publication of year books; Publication of text books; Providing on-line publications; Publication of training manuals; Practical training; Practical training [demonstration]; Training (Practical -) [demonstration]; Practical training services; Teaching of meditation practices; Education (Religious -); Practical training in the field of welding; Physical education instruction; Team building (education).