

O-289-10

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS IN THE MATTER OF:

- 1) GRADED QUALIFICATIONS ALLIANCE'S OPPOSITION (NO 98671)
TO A TRADE MARK APPLICATION (NO 2498139)
BY GLASS QUALIFICATIONS AUTHORITY LIMITED
TO REGISTER THE TRADE MARK:**



AND

- 2) GLASS QUALIFICATIONS AUTHORITY LIMITED'S APPLICATIONS TO
INVALIDATE (NOS 83445 & 83446) TWO TRADE MARK
REGISTRATIONS (2453167A & 2453167B)
IN THE NAME OF GRADED QUALIFICATIONS ALLIANCE
FOR THE MARKS:**

QQAL/GQal (A SERIES REGISTRATION)

And



The background and the pleadings

1) These are consolidated proceedings involving Graded Qualifications Alliance (“Graded”) on the one hand and Glass Qualifications Authority Limited (“Glass”) on the other. Glass applied (on 19 September 2008) for the registration of the following trade mark for the following goods and services:



Class 16: Loose leaf publications; printed matter; paper, cardboard and goods made from these materials, not included in other classes; reports; promotional material, publications, albums, almanacs, booklets, books, brochures, diaries, directories, guides, handbooks, journals, leaflets, notebooks, pamphlets, magazines, manuals and periodicals; statements and prospectuses; printed labels of paper or plastic; paper and plastic bags, boxes, cases, containers, cartons, other packaging materials and parts and fittings thereof; office requisites; stationery and printed forms; computer print-outs; computer reference manuals; computer users guides; computer instruction manuals; computer manuals; database listings; instructional and teaching materials; bookbinding material; photographs; stationery; plastic materials for packaging (not included in other classes); printers' type; printing blocks; artwork, diagrams and illustrations; calendars; charts; graphic prints and posters; graphic reproductions; drawing boards, pads and materials; etchings and engravings; paintings and pictures (framed or un-framed); paper weights; posters; scrap books; signboards of paper or cardboard; stamps (seals); stencils; wrappers; wrapping and packing paper; writing pads; writing paper; parts and fittings for all the aforesaid goods.

Class 35: Advertising, marketing and promotional services provided via the Internet or otherwise; consultation and advisory services; retail services relating but not limited to printed matter, education and training services; bonus, loyalty and incentive schemes; publicity services; advertising and retail in online, on-demand and other media, in particular in the aforesaid media and via the aforesaid media; direct mail advertising; operating, management, advertising and marketing services; public relations; direct marketing services; business management and administration; market surveys, analysis and research; sales promotion services; preparing and placing of advertisements; the bringing together, for the benefit of others, of a variety of printed materials, education and training services, enabling customers to conveniently view and purchase

those goods and services from a general retail outlet or online via an Internet website; information, consultation and advisory services relating to all the aforesaid services, including such services provided online from a computer network or via the Internet or extranets.

Class 41: Entertainment; education; training; production, recording and distribution of films; publication services; organising, arranging and conducting of entertainment and educational shows, exhibitions, demonstrations, conferences, competitions, seminars and contests; examination services; setting educational and training standards; information relating to education and entertainment; devising, reviewing, revising and provision of qualifications; certificating of candidates achieving such qualifications; publishing; direct mail publicity campaigns; providing on-line electronic publications (not downloadable); publication of texts (other than publicity texts); publication of texts and printed matter, also in electronic form and via the Internet; online publication of electronic books; drafting of texts (other than publicity texts); publication of books; arranging and conducting of conferences and congresses; organisation of lectures, fora, congresses and colloquia; training services; coaching services; information, consultation and advisory services relating to any of the aforesaid services, including such services provided online from a computer network or via the Internet or extranets.

2) Graded oppose the registration of Glass' application for registration under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), relying on two of its earlier trade marks, namely UK trade mark registrations 2453167A & 2453167B. The earlier marks and the goods and services (as of the date of its opposition and as of the date of the hearing before me) for which they are registered are:

2453167A: GQAL & GQal (series of 2)

2453167B:



Class 16: Printed matter for use in teaching; printed matter relating to examinations; printed publications for use in teaching; examination certificates; leaflets; pamphlets; instructional and teaching materials; books; manuals; journals; stationery; binders; reports; worksheets; notebooks; newsletters; writing instruments; all the aforesaid relating to the awarding of educational qualifications to learners, young people and adults, including professionals.

Class 35: Business examination services; all the aforesaid relating to the awarding of educational qualifications to learners, young people and adults, including professionals.

Class 41: Educational services; provision of education and training services; provision and administration of educational examinations; provision of educational information; organisation of educational seminars, exhibitions and congresses; career information and advisory services; computer assisted education and training services; business training services; publication of educational and training materials; certification of education and training awards; library services; all of the aforesaid relating to the awarding of educational qualifications to learners, young people and adults, including professionals.

3) The above two registrations were initially filed on 20 April 2007 as a single application for a series of three trade marks. The marks in the application were divided (as set out above) following a series objection raised by the Intellectual Property Office. The limitation: “all of the aforesaid relating to the awarding of educational qualifications to learners, young people and adults, including professionals” was added to the specifications on 18 March 2008. The marks then completed their registration procedures on 16 May 2008.

4) Glass seeks a declaration of invalidity in respect of the two registrations that Graded rely upon. Its grounds are: 1) under section 5(4)(a) of the Act in that the use by Graded of its registrations would be liable to be prevented under the law of passing-off, and 2) under section 3(6) of the Act, Glass state that Graded previously used the mark GQA and was required to cease such use by the Qualifications Curriculum Authority (“QCA”) (the qualifications governing body) due to it [the sign GQA] being established and recognized as its [Glass’] mark and that Graded continued to use the mark up “until recently”; it sums up its pleading by stating:

“Based on the facts, it is clear that the Proprietor has applied for the Registration in bad faith, knowing full well at the time the Registration was filed that the Applicant is actively using the Applicant’s mark and notwithstanding the QCA’s order that the proprietor cease using the Applicant’s mark.”

5) Given the relationship between the various cases, the proceedings were consolidated. Both parties filed evidence which I summarise below. The matter then came to be heard before me on 16 April 2010 at which Graded were represented by Mr Alan Fiddes of Urquhart-Dykes & Lord and Glass by Ms Denise McFarland, of Counsel, instructed by Silverman Sherliker LLP.

The evidence

First witness statement of Neil David Eagleton (16 September 2009)

6) Mr Eagleton is a Solicitor who works for Silverman Sherliker. He has principal conduct of this matter on behalf of Glass. The evidence he gives comes from his own knowledge, from information derived from the books, records or web pages of Glass or from information given to him by one or more of Glass' personnel. Mr Eagleton's witness statement contains both fact and submission; I will summarise the former but not the latter.

7) Mr Eagleton sets out a summary of Glass' position which is that it has been using its mark in the UK for a continuous period of at least 10 years without any instances of confusion with the goods or services of Graded having come to its attention. He obtained this information from Mr Allan Murray, Glass' chief executive since 2002 (Mr Murray also worked for Glass' predecessor from 1984). He states that Glass were incorporated on 12 December 2001 but that it had a long established business (since the early 1980s) prior to this, trading in materially the same manner. All this, he says, has been confirmed to him by Mr Murray. It is later stated that when Glass became independent in 2001 all accrued goodwill and reputation were assigned to it.

8) Mr Eagleton states that Glass' predecessor in business was a division of the awarding and certification body known as "Glass Training Limited". He knows this because he reviewed the documents and records of this company. He says that Glass' mark was approved by the relevant regulatory body, the QCA (then the NCVQ) for use in the mid 90s (and thereafter) and was used on all NVQ and SVQ certificates issued by Glass and its predecessors. He refers to Exhibit NDE1 which contains a copy front cover of the qualification "Automotive Glazing" (July 1997-April 2001), the same for the NVQ for "Production of Glass Supporting Fabrications" (October 1997-July 2001) and a copy of a "national licence" dated 1 November 1999. All three clearly depict the trade mark the subject of its application for registration. I note that in all three examples the words "Glass Qualifications Authority" appear directly below the trade mark.

9) Exhibit NDE2 shows a front page cover of the minutes of a Glass Qualification Authority committee meeting dated 20 November 1997 which, again, shows the trade mark the subject of its application for registration. It has the words "Glass Qualifications Authority" underneath it. Exhibit NDE3 shows further examples of the use of the mark on business cards, compliments slips, invoices and letterheads. Further information is provided to show the purchase of this business stationery in 1997. The documents purchased/ordered show the mark, again, with the words Glass Qualifications Authority either underneath or alongside it¹.

¹ One document does not, but this seems to be the footer of a second page of a certificate, the words Glass Qualifications Authority appear on the first page.

10) Mr Eagleton states that Glass operate a website which was first registered and went live in June 2001. The relevant URL (which he says has been accessible at all material times) is: www.glassqualificationsauthority.com. Exhibit NDE4 provides some pages from the website which were printed on 16 September 2009. The home page depicts the trade mark the subject of Glass' application for registration. The words Glass Qualifications Authority do not appear alongside or underneath, instead, directly alongside, is what appears to be a mission statement reading:

"To achieve a world class qualified workforce in glass and glass related occupations".

11) The words "Glass Qualifications Authority Ltd (GQA)" also appear. The rest of the pages then use GQA (which Mr Eagleton describes as the applicant's mark) in plain letters. The other pages provide information about the qualifications.

12) Mr Eagleton states that Glass carry on a business as an awarding body in respect of glass and glass-related qualifications. Persons receiving such qualifications are those who have trained in a wide range of predominantly glass related industries. He says that this embraces a wide range of occupations and different market and commercial sectors, such as automotive design, sales and aftermarket, architecture and building, structural design and refurbishment, as well as the arts, decorative professions, fabrications, painting, coatings and industrial and commercial lifting [sic]. He states that teachers and trainers associated with such areas will know of its business, services and trade names and marks. Mr Murray confirmed to Mr Eagleton that these sectors include manufacture, construction, surveying, installation and processing.

13) Mr Eagleton states that Glass have hosted government sponsored Commonwealth visitors who wished to learn about standard based qualifications. He also says that Glass have run events in unrelated sectors. An example is given from the late 1980s when it ran a workshop for the Financial Times on new style qualifications. He says that Glass co-authored a book in the mid 1980s on supporting "Open Learners" with no reference to the glass industry. He says that he has been told, and has seen from Glass' fiscal records, that it invests heavily in pursuing approved research and development projects, many of which have not been glass industry specific, for example, on topics such as e-learning, e-testing and e-portfolios.

14) Mr Eagleton contrasts Glass' use with that of Graded. He states that Graded were incorporated on 2 December 2003. He states that Glass are aware (and that Mr Murray confirmed this to him) that Graded first carried on a business under the name GQA [as opposed to GQal]. In Exhibit NDE5 there is an e-mail dated 1 August 2005 from Michelle Alpren who was then the Project Coordinator at the relevant regulatory body the QCA. The e-mail refers to a "conditions report"

for Graded which was sent to Glass in error. In an e-mail apology Ms Alpren states:

“We are very sorry that this conditions report was sent out to you in error. You can be assured that we have taken steps to ensure that this does not happen in the future.

It is common for awarding bodies to have very similar acronyms as organizations wish them to be closely related to their company name. I have been advised that in this case, the awarding body was asked to amend their original request from GQA to GQAL before it would be agreed.

In cases where there are similarities it is our responsibility to ensure that our contacts lists are clear so the correct communications are sent out to the correct awarding bodies. We have updated our contacts to ensure that this is the case.”

15) Mr Eagleton highlights that Graded wished to be known as, and to use the mark, GQA but was unable to do so because it was too closely associated with Glass. Mr Eagleton says that despite this, Graded, in late 2008/early 2009, were still using GQA and not the marks the subject of its trade mark registrations. He says that this flouts the requirement of the QCA and demonstrates that Graded did not intend to use its registrations but rather GQA which, he says, has become associated distinctively with Glass and in which they own goodwill. At Exhibit NDE6 there are some prints from Graded’s website. It was printed on 29 January 2009. It includes the image below:



16) I also note that the text of the webpage highlights that Graded run graded qualifications of the sort familiar in the performing arts, but which, apparently, have a much wider appreciation in business, education, medicine and lifelong learning.

17) Mr Eagleton says that when Glass became aware of Graded’s use of GQA (instead of the GQal mark) there was an exchange of correspondence between the parties, following which Graded changed its website. The print from the website can be seen in Exhibit NDE7 – it shows the mark as per registration 2453167B rather than the image depicted above.

18) The remainder of the witness statement is more submission than fact. I note, though, the statement that Glass have issued 32,000 qualification related candidate documents including qualification booklets, certificates, licenses and qualifications since July 1997.

Witness statement of Helen Mence (10 September 2009)

19) Ms Mence is the General Secretary of Graded, a position she has held for 6 years. The evidence she gives comes from her personal knowledge or from the records of Graded.

20) Ms Mence states that Graded were formed in 2003 with the objective of awarding performance based qualifications to students in education and industry. The founding partners were the University of Exeter (providing qualifications in higher education and research), the British Theatre Dance Association (providing qualifications in performing arts) and the Manchester College for Performing Arts and Technology (providing qualifications in further and vocational education). She states that Graded were the first examination board to offer qualifications based on graded examinations which combine higher education, further education and performing arts. Exhibit HM1 is a print from Companies House showing Graded's date of incorporation (2 December 2003). Ms Mence states that Graded received accreditation from the QCA to provide general, vocational related and higher level qualifications. Exhibit HM2 is a letter from the QCA confirming this (it is dated 14 April 2004). I note that the subjects/sectors to which the qualifications relate are:

“Sectors/subjects: Foundations for Learning and Life, Health and Social Care, Hospitality and Catering, Preparation for Work, Performing Arts.”

21) It is stated that upon launch, the mark GQA was used to advertise its goods and services and that a logo was created containing these letters. Various examples of this are shown in Exhibits HM3 through to HM6. These include a 2004 advertisement (a 2005 version is also shown) in the Dancing Times Magazine. This publication is said to be a monthly publication with an international readership with a typical circulation of 8,500 copies per month. For the period March 2004 to January 2005 the cost of placing this advertisement was approximately £3,222. Advertising material is also provided from the March 2004 edition of the Leicester Mercury. Other advertising material was produced for the British Theatre Dance Association (Exhibit HM5) who, Ms Mence says, have attended the “Move It” exhibition at Olympia in London for the last 4 years and that it is likely that the mark GQA/GQAL was displayed there.

22) At Exhibit HM6 there are the minutes of a meeting that Graded held on 28 February 2007 where the change from GQA to GQAL was agreed. The minutes state that the “Council of Management” had agreed to change the name/logo. No exact date of the decision is given. An invoice is provided in Exhibit HM7 showing

the cost of producing new certificates with the new logo. It shows a cost of just over £1000. The invoice is dated April 2007. An example of the new certificate is shown in Exhibit HM8 – it features the GQAL logo as per registration 2453167B. Further certificates showing the new logo are shown in Exhibit HM9.

23) Ms Mence states that Graded advertise on its website at www.gqal.org and, also, on the websites of one of its associate members at www.developinghospitality.co.uk. Copies of pages from the latter are shown in Exhibit HM10, the logo is not used but the letters GQAL are. The print was obtained on 9 September 2009. Exhibit HM11 is a *Google* report (for worldwide hits rather than the UK) for gqal. 7,430 results were found. The first page of hits are provided which, Ms Mence states, all relate to Graded – I note, though, that one clearly does not as it relates to an acronym for “good quality agricultural land”. Ms Mence states that GQAL qualifications are run throughout the UK and that an estimated total of 35,000 are taken each year.

24) Ms Mence then refers to the lead up to these proceedings which I do not need to summarise. She notes Glass’ agreement (in its application for invalidation) that the marks are similar. She also notes that Glass uses its mark in relation to glass and glass related qualifications. She provides in Exhibit HM13 a print from Glass’ website and also one from the National Database of Accredited Qualifications showing a large number of its qualifications. Mr Eagleton comments on this list below.

Second witness statement of Neil David Eagleton (16 November 2009)

25) This is in reply to Ms Mence’s evidence. Most, though, is submission rather than fact. Whilst the submissions will be borne in mind, I will not summarise them here. In terms of new factual evidence I note the following:

Exhibit NDE1: This contains prints from Graded’s website dated 5 July 2007, 12 December 2007 and 15 April 2008 showing use of the old GQA logo.

Exhibit NDE2: This contains e-mails from the Sector Skills Council, PROSKILLS, from 2009, asking whether Glass would assist in other sectors such as an ERP project for a paper company and also in relation to “coatings and ceramics”.

Exhibit NDE3: This consists of the minutes of a meeting of the Coatings Qualifications Reform Group (June 2009) confirming GQA as the new awarding body.

Exhibit NDE4: This is the CPD record for Mr Murray between April 1999 and January 2008. Mr Eagleton says that Mr Murray attended many events on behalf of Glass several of which were not related to the glass

industry. An example highlighted is that, on 6 June 2000, Mr Murray attended an EMP NTO EV FORUM on the subject of D-UNITS which, it is explained, are generic assessment and verification units which have no specific relationship with the glass industry.

26) I also note Mr Eagleton's statement that the list of qualifications in Ms Mence's witness statement (her Exhibit HM13) itself includes Glass' non glass related qualifications including generic awards for assessing and verifying competence, quality assurance of assessment processes, and the fabrication and installation of fascias, soffits and barge boards. He further states that this list does not cover all of the qualifications offered by Glass or all industries that Glass operate in.

27) Graded filed submissions in reply to Glass' evidence. I will not summarise them here but will, of course, take them into account.

Decision

28) Given that Graded's opposition to Glass' trade mark application is based on two earlier trade mark registrations which are the subject of invalidity claims, I will firstly determine the validity of Graded's trade mark registrations.

TRADE MARK REGISTRATIONS 2453167A & 2453167B – VALIDITY

29) I have already set out the details of Graded's two registrations in paragraphs 2 & 3 above. I will not repeat the details here. However, in relation to the specifications as registered, I noted earlier that the specifications I recorded were those as of the date of Graded' opposition and as of the date of the hearing before me. I highlighted this because Graded have, since the hearing, requested a partial surrender of the specifications of its two registrations. Before coming to the partial surrender in more detail, I should add some context to this matter. At the hearing, and when discussing the issue of misrepresentation, matters turned to the goods and services for which Graded's marks were registered. When doing so I put it to Mr Fiddes that Graded's specifications (as they stood at the hearing) could be taken to include within its ambit goods and services relating to the awarding of glass related qualifications (where Glass claim, at the very least, to have a goodwill). In view of this I asked Mr Fiddes whether Graded had put forward a fall-back specification. He confirmed that it had not and despite me indicating the potential impact of this², he did not ask for consideration of any fall-back position. It should also be noted that the tribunal, when writing to all parties prior to a hearing, advises them that specifications will be regarded as they stand unless a fall-back specification, which can be conditional, is provided; this practice was followed in the case before me.

² In the context of the passing-off claim, that the registered specifications notionally put Graded in the same field of activity as Glass.

30) Despite Mr Fiddes comments at the hearing, on 29 April 2010, some two weeks later, Graded filed a form TM23 requesting a partial surrender of its registrations. After its first form of wording was rejected by the Intellectual Property Office the following form of wording, which is to be added to the relevant list of goods/services, was accepted (the new wording is highlighted in *italics*):

“all the aforesaid relating to the awarding of educational qualifications to learners, young people and adults, including professionals, *all in the field of arts, entertainment, hospitality, catering, business management, engineering, law, financial studies, science and social sciences, philosophical studies and religious subjects, medicine, health related subjects, nutrition, travel and tourism, photography, environmental subjects, languages, computer studies, agriculture, horticulture, outdoor recreational activities, child care services*”

31) In view of the above, I wrote to both parties in order to afford them an opportunity to provide any further written submissions as to the impact of the above specification on Glass’ invalidation applications and, also, on Graded’s opposition to Glass’ trade mark application, should its earlier registrations survive. I also asked for any views on what impact Graded’s action should have on the matter of costs. Graded’s response was brief, simply indicating that it still wished to pursue its opposition to Glass’ application for registration. Glass’ response was more detailed. Glass argues that the proposed partial surrender does not commensurately and relevantly narrow or lessen the specification. In terms of the not “relevantly” lessened or narrowed it says that the specification should be limited in scope to those areas where Graded actually operate (it says that this is dance, theatre studies, ballet etc) and/or to exclude the areas where Glass operate and is known. It argues that the resulting specification includes and encompasses areas of education and training where Glass operate (and gives examples of this).

32) In terms of the requirement to be “relevantly” surrendered, I reject Glass’ submission. A proprietor of a registered trade mark may surrender or partially surrender its registration at any time. The registrar shall take action on such a request and cannot apply any further requirement to the extent that a partial surrender and the form of wording selected should necessarily reflect the substance of any ongoing proceedings. This, of course, leaves the proprietor in a precarious position as regards the specification and whether it has any effect on the ongoing proceedings, but this is something that will have to be dealt with later. Glass, however, also say that:

“The language chosen for the wording of the proposed “new specification” seems to be deliberately ambiguous and unclear. It commences with the words “all of the aforesaid relating to...” thereby encompassing all that precedes it. It then goes on to claim that it is intended to be “including

professionals all in the field of arts, etc.”, i.e. including ***but not excluding or precluding others***”.

33) Again, I do not accept the above submission. Whilst the resulting specification now has a double limitation, namely:

1) all the aforesaid relating to the awarding of educational qualifications to learners, young people and adults, including professionals,

and

2) *all in the field of arts, entertainment, hospitality, catering, business management, engineering, law, financial studies, science and social sciences, philosophical studies and religious subjects, medicine, health related subjects, nutrition, travel and tourism, photography, environmental subjects, languages, computer studies, agriculture, horticulture, outdoor recreational activities, child care services,*

the combined effect of the limitations is, in my view, clear in that it limits Graded’s goods and services to those that relate to the awarding of educational qualifications (to learners, young people and adults, including professional) in the fields set out. Whilst the use of the word “including” in the specification is noted, this relates to the term “professionals” (they are a subset of learners, young people and adults) but does not, in my view, go on to relate to the field to which the educational qualifications relate. The point, though, is academic because whether a partial surrender should be actioned is, strictly speaking, a matter between the proprietor and the registrar and the registrar, from the information contained on the official file, is content with it. I should say that so am I. The impact of the specification is, though, another matter altogether and will be returned to later.

34) Glass also refers to the lateness of the partial surrender, that it was effectively made in bad faith, and that a costs issue may arise. As I have said, the registrar is duty bound to action a partial surrender so long as the trade mark is still registered (as it was when the partial surrender was requested). A costs issue may arise, but I will return to the issue of costs at the end of this decision. For the time being, the result of all this is that the invalidation of Graded’s trade mark registrations will be based upon the revised specifications set out above.

The section 3(6) ground of opposition – bad faith

35) I summarised the pleading earlier as:

“Based on the facts, it is clear that the Proprietor has applied for the Registration in bad faith, knowing full well at the time the Registration was filed that the Applicant is actively using the Applicant’s mark and notwithstanding the QCA’s order that the proprietor cease using the Applicant’s mark.”

36) Glass’ pleading is supplemented by a reference to the taking of an advantage of Glass’ goodwill. This is repeated in its evidence, which also includes an allegation of the making of an application without any intention to use it (presumably due to the continued use of the GQA mark rather than GQAL etc).

37) There was no real dispute between the parties on the law. To this extent, bad faith includes dishonesty and “some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular field being examined”³. It is necessary to apply what is referred to as the “combined test”⁴. This requires me to decide what Graded knew when it made its application for registration and then, in the light of that knowledge, whether its behaviour fell short of acceptable commercial behaviour. Bad faith impugns the character of an individual or the collective character of a business, as such it is a serious allegation. The more serious the allegation the more cogent must be the evidence to support it.

38) Of some relevance here is the decision of Arnold J. in *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others* [2008] EWHC 3032(Ch)⁵ where he held:

“189. In my judgment it follows from the foregoing considerations that it does not constitute bad faith for a party to apply to register a Community trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their

³ See *Gromax Plasticulture Limited v. Don and Low Nonwovens Ltd* [1999] RPC 367.

⁴ See the judgment in (1) *Barlow Clowes International Ltd. (in liquidation)* (2) *Nigel James Hamilton and (3) Michael Anthony Jordon v (1) Eurotrust International Limited (2) Peter Stephen William Henwood and (3) Andrew George Sebastian* Privy Council Appeal No. 38 of 2004 and also the decision in *Ajit Weekly Trade Mark* [2006] RPC 25.

⁵ Arnold J’s judgment was recently upheld in the Court of Appeal - [2008] EWHC 3032 (Ch).

position. Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration. The applicant may not intend to seek to enforce the trade mark against the third parties and/or may know or believe that the third parties would have a defence to a claim for infringement on one of the bases discussed above. In particular, the applicant may wish to secure exclusivity in the bulk of the Community while knowing that third parties have local rights in certain areas. An applicant who proceeds on the basis explicitly provided for in Article 107 can hardly be said to be abusing the Community trade mark system.”

39) Also, in *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* Case C-529/07 the European Court of Justice (“ECJ”), when considering the concept of bad faith, stated:

“40 However, the fact that the applicant knows or must know that a third party has long been using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought is not sufficient, in itself, to permit the conclusion that the applicant was acting in bad faith.....

46 Equally, the fact a third party has long used a sign for an identical or similar product capable of being confused with the mark applied for and that that sign enjoys some degree of legal protection is one of the factors relevant to the determination of whether the applicant was acting in bad faith.

47 In such a case, the applicant’s sole aim in taking advantage of the rights conferred by the Community trade mark might be to compete unfairly with a competitor who is using a sign which, because of characteristics of its own, has by that time obtained some degree of legal protection.

48 That said, it cannot however be excluded that even in such circumstances, and in particular when several producers were using, on the market, identical or similar signs for identical or similar products capable of being confused with the sign for which registration is sought, the applicant’s registration of the sign may be in pursuit of a legitimate objective.

49 That may in particular be the case, as stated by the Advocate General in point 67 of her Opinion, where the applicant knows, when filing the application for registration, that a third party, who is a newcomer in the market, is trying to take advantage of that sign by copying its presentation, and the applicant seeks to register the sign with a view to preventing use of that presentation.

50 Moreover, as the Advocate General states in point 66 of her Opinion, the nature of the mark applied for may also be relevant to determining whether the applicant is acting in bad faith. In a case where the sign for which registration is sought consists of the entire shape and presentation of a product, the fact that the applicant is acting in bad faith might more readily be established where the competitors' freedom to choose the shape of a product and its presentation is restricted by technical or commercial factors, so that the trade mark proprietor is able to prevent his competitors not merely from using an identical or similar sign, but also from marketing comparable products.

51 Furthermore, in order to determine whether the applicant is acting in bad faith, consideration may be given to the extent of the reputation enjoyed by a sign at the time when the application for its registration as a Community trade mark is filed."

40) At the hearing, Ms McFarland summarised Glass' argument under section 3(6) thus:

"We say then in summary, sir, in terms of the bad faith, there are three factors. One, they went into this with open eyes at the date of the application knowing that they were treading on our toes. They knew there was a problem. We say that is clear from the information from the regulatory body and also from Ms Mence's own minutes of the meeting at exhibit 2.

Secondly, they went into this recognising that the so-called amendment was so minor as to be irrelevant.

Thirdly, they went into it identifying as two trade marks that apparently they intended to use, the two as set out in A and B, when in fact they did not do that."

41) Although Graded did not explain why, in 2007, it changed its mark/logo, Graded have not challenged Glass' evidence that it was told (as early as 2005) to no longer use GQA due to the use, by Glass, of this designation. This, at the very least, informs me that Graded were aware of Glass' use of GQA. There is, though, nothing to inform me as to the degree of knowledge that Graded had of Glass' business beyond its mere existence.

42) One of the limbs of Ms McFarland's argument relates to a lack of intention to use. I have doubts whether such a claim can really be said to fall within the case as originally pleaded. That being said, it would not/does not succeed. There is clear evidence that Graded not only intended to use the marks (the minutes from its meeting in February 2007 demonstrate this as do the ordering of new certificates in April 2007) but there is also evidence that it has actually used the marks, or at least the logo version (by issuing certificates containing the new

logo). I accept, from the evidence, that Graded's website continued to use the old logo rather than the new one and there is no real explanation for this. Ms McFarland described all this (and the making of the application) as a stalking horse, but I struggle to see how this can be so against the background of actual, albeit inconsistent use. The ordering of 20,000 certificates can hardly be said to be indicative of a cover-up. Whilst I do not know why the website was not changed sooner, there is nothing in the evidence to suggest that there was anything sinister in this which could possibly be read back into some form of bad faith in the making of the application for registration.

43) In terms of the other limbs of the argument, Ms McFarland highlighted that in the 2007 minutes the change from GQA to GQAL was described as just a minor presentational amendment. This, she argued, showed that Graded were just going through the motions and that the making of an application for something with only a minor difference to something which they knew could not be used was an act of bad faith. I understand the argument but I do not agree with it. As I pointed out to Ms McFarland at the hearing, in the e-mail from Ms Alpren to Mr Murray, it was stated that Graded were asked by the QCA to change from GQA to GQAL. If this is the case then all Graded have done is to file for new trade marks for names with which the QCA were content. A minor change or not, I cannot find that Graded have acted in bad faith. This is more so when the judgments in *Cipriani* and *Lindt* are factored in.

44) Although not part of Ms McFarland's arguments, I will deal briefly with a claim in the evidence that there may have been an attempt to pass-off, or to trade off Glass' reputation. There is nothing to support this in the evidence. As I said earlier, there is nothing to suggest that Graded knew of Glass' business, or the nature of it, beyond its mere existence. There is nothing to suggest that the applications were made with the intention of benefiting from any goodwill that Glass may own. The ground of opposition under section 3(6) of the Act fails.

Section 5(4)(a)

45) Section 5(4)(a) of the Act reads:

“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, or

(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.”

46) The elements of passing-off (often referred to as the classic trinity) can be summarised as: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position quite succinctly when he stated:

“The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff...Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

47) Matters must be assessed at a material date. In terms of this I note the judgment of the General Court in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07 where it was stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (Cadbury Schweppes v Pub Squash (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

48) The date of filing of the trade mark registrations is, therefore, the material date. However, if the trade mark registrations were used prior to this then such use must also be taken into account. It could establish that Graded is the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed which, in turn, could mean that the use of the marks could not be prevented under the law of passing-off at the material date⁶.

49) Applied to the circumstances here, the material date is 20 April 2007. In terms of Graded's use of its registered marks, I note that although incorporated in 2003, it initially used GQA rather than the marks the subject of its registrations. In terms of the use of the marks as registered, it is clear that this did not commence until the early part of 2007 at the earliest. The exact date is not clear. The decision to change the name/logo was mentioned in the minutes of a meeting in February 2007 (although the decision may have been made earlier). I also note that the invoices relating to the purchase of certificates with the new logo are dated April 2007. To that extent, there is no evidence that Graded used its mark in the public domain any earlier than when it applied for the trade marks. In view of this, Graded's use of the marks the subject of its registration cannot assist.

50) Mr Fiddes primary argument at the hearing before me was that Glass' evidence was insufficient to prove that it would have been in a position at the material date to have prevented the use of Graded's marks. However, as will become apparent shortly, the argument in relation to this relates, principally, to a failure to prove that Glass benefits from a protectable goodwill. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom.

⁶ See, for instance: *Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42.

It is the one thing which distinguishes an old-established business from a new business at its first.”

51) I note from the relevant case-law that to qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature⁷. However, being a small player does not prevent the law of passing-off from being relied upon - it can be used to protect a limited goodwill⁸.

52) In terms of whether Glass has proven that it possessed a goodwill, Mr Fiddes referred me to the judgment of Pumfrey J in *South Cone Inc v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 where it was stated:

“27 There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). **Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.**

28 Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”⁹

53) Mr Fiddes argued that Glass' case did not even get off the ground. To summarise his concern, the following is taken from his submissions at the hearing:

“What is the date of first use of the mark? At most we have a vague claim, in paragraph 6 of Mr Eagleton's witness statement, that it was "sort of about ten years". That is not particularly helpful. More importantly, what is the scale of the use of the mark? What is the turnover of the business? What are the number of sales? What are the number of students? How many certificates have been issued? How many courses have they run? Yes, we have a list of the courses they offer but we have no idea how

⁷ *Hart v Relentless Records* [2002] EWHC 1984

⁸ See, for instance, *Stannard v Reay* [1967] FSR 140, *Teleworks v Telework Group* [2002] RPC 27 and *Stacey v 2020 Communications* [1991] FSR 49).

⁹ Emphasis has been added to reflect the part referred to by Mr Fiddes.

many courses they have actually run. Where are these courses available? Who has attended these courses?

There is nothing in any of this evidence which goes to these fundamental issues. How much have they spent on promoting their activities? How much have they spent on advertising?

Do we have any copies of any marketing materials? No, we do not. What we have, sir, is the evidence upon which Ms McFarland relies for her case of reputation. We are not denying that the applicants have made use of their mark and we are not attacking the truthfulness of the statement. What we are saying is that the statements are simply not sufficient to even get a passing off action off the ground.”

54) As well as taking me through the evidence in some detail earlier in the hearing, Ms McFarland responded to the above submission thus:

“He said that I would have a right of reply and he invited me to meet his challenges. Some of his challenges in terms of evidence were we have not given any figures and we have not provided any dates. You remember he was saying, "How many certificates have you issued?" That sort of thing. Sir, there are three short answers to that challenge. First, paragraph 38 of Mr Eagleton's first witness statement specifically says: "Since July 1997 the applicants have issued over 32,000 qualification related candidate documents including qualification booklets, certificates, licences and qualifications." So we have some numbers there.

Secondly, in exhibit 1 to his first witness statement, which I know you have already seen, sir, we do have certificates there dated from 1999. Exhibit NDE2 shows documents from 1997. You remember, probably, the file copy of the Quality Audit Committee showing the logo and the acronym. Exhibit NDE3, which were the invoices from 1997, actually, sir, all show numbers of goods. So we have business cards, invoices, compliments slips, certificates, etcetera with the logos and with the PDF examples. It is 500 of this and 500 of that and so on. So numbers are given. So, sir, that is meeting the gauntlet challenge hopefully.”

55) Whilst I agree with Mr Fiddes that the detail in Glass' evidence could have been better, the comments in the *South Cone* judgment should not be applied too prescriptively. For example, Professor Annand (sitting as the appointed person) accepted in *Loaded* (BL O/191/02) that proof of goodwill could be accomplished by other means. The position was summed up by Mr Justice Floyd when he stated (when commenting on *South Cone*) in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat):

“8 Those observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down

any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

56) It is, therefore, a matter of considering the evidence as a whole and determining whether Glass has established that (at the material date) it had a business with more than a trivial goodwill associated with the sign in question. In terms of the sign in question, I note from the pleadings that the business is said to be operated under the mark "GQA" - no mention of the logo version of the mark (as per its own application for registration) is made. However, later in the pleadings, when making submissions as to similarity, reference is also made to a figurative form. I will consider which of these forms, if any, are associated with the goodwill.

57) In terms of Glass' evidence of goodwill, I note that Mr Fiddes did not invite me to disbelieve any of the individual statements made by Mr Eagleton (even though some of them were hearsay given that parts of the information he provided were given to him by Mr Murray). I therefore intend to accept the statements made on face value. Mr Eagleton has explained that Glass' business has been conducted continuously for at least 10 years by it or its predecessor. Examples have been provided showing its mark, or the GQA sign in plain letters, in use. It has produced examples of business stationery. It has issued over 35,000 pieces of such material from 1997 to date. Whilst this may not be a terrifically substantial figure for a business that awards qualifications, the qualifications are not, whatever way one looks at them, ones directed at the general public. I accept that this does not mean that Glass have had 35,000 different "customers" given that a customer may have received more than one item of this material. Regardless of this, the business is, in my view, more than a trivial one. Glass have established that they have a protectable goodwill as of the material date.

58) Glass' business clearly focuses on glass and glass related qualifications. Glass claims that its business goes wider than this citing the e-mails from the Sector Skills Council and some work it undertook in the mid 1980s. It also cites Mr Murray's CPD record and also the list of qualifications as detailed in Ms Mence's evidence. The Sector Skills Council e-mails are from after the material date and cannot assist in proving that it had any wider form of business before the material date. It is not reasonable to assume that this sheds light on what was going on before the material date because the only other real evidence comes from the mid 1980s. The mid 1980s evidence is not particularly informative, nor is it reasonable to assume that any non-glass related work was particularly known. These examples are not compelling, nor is Mr Murray's CPD record. Attending events on behalf of Glass does not, in itself, generate goodwill. The tribunal was

not informed as to what Mr Murray was doing at these events. It cannot be assumed that whilst attending such events he was generating any goodwill for Glass. The evidence suggests that the qualifications Glass award relate to the specialist field of glass, its installation and its use etc. Whilst this may cross industries e.g. automotive glass, glass used in buildings etc, the business is still a specialist one in terms of the educational qualifications it awards. The list of qualifications does include qualifications beyond glass itself (such as soffits). This may be indicative of a slightly wider business but still limited to areas such as construction and areas ancillary to glass.

59) Having a goodwill is all well and good, but it is of little benefit in these proceedings if the goodwill is not associated with the sign(s) in question. Mr Eagleton makes reference primarily to the logo version as per its application for registration. He does, though, also refer to the letters "GQA" as its (Glass') mark. The documentation such as official certificates and letter headed business stationery makes use of the logo version. The letters GQA are, though, used in the body of some of the documentation that has been provided. Although after the relevant date, the e-mails from the Sector Skills Council illustrate that Glass' qualification and its business as an awarding body is referred to as GQA. This, taken into account with the fact that the logo version of the mark also contains prominently within it the letters GQA, satisfies me that the letters solus form part of the fabric of Glass' goodwill. This is also consistent with how people normally perceive qualifications and awarding bodies. The logo version will also, of course, be associated with the goodwill.

60) I stated earlier that Mr Fiddes argument focused more on goodwill than anything else. This is because, in terms of whether the use of Graded's marks would lead to a misrepresentation, Graded have themselves stated, in its opposition, that the marks are similar enough to cause confusion. This is based, of course, on Glass' logo version of the mark, but the same must apply to the letters GQA. Mr Fiddes did not attempt to resile from this and, in view of this, he made no submissions in terms of the degree of similarity between GQA and Graded's registered marks. Ms McFarland argued that the sign and the marks were similar bearing in mind that they all commenced GQA and that all that had been done was to add an L to the end of Graded's mark, an alteration which Graded themselves described as a minor change. The similarity of sign and mark is, of course, just one of the factors to take into account. I do not, though, need to debate the matter in any further detail given that Graded themselves have claimed in its opposition that the marks are similar. There is nothing in the signs and the marks for me to come to any different view to those of the parties.

61) In determining whether the use of Graded's registrations would amount to a misrepresentation it is necessary to consider the goods and services of the registration in comparison to the area of trade of Glass' business. Although there is no requirement in passing-off for goods or services to be similar, it is

nevertheless a highly relevant factor to bear in mind. This can be seen in *Harrods Ltd v Harrodian School* [1996] RPC 697 where Millett LJ stated:

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

and

“The name "Harrods" may be universally recognised, but the business with which it is associated in the minds of the public is not all embracing. To be known to everyone is not to be known for everything.”

and

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant's goods or services.”

62) In a passing-off action before the Court such an assessment would, of course, be based purely on the actual trade conducted by the defendant compared to the area in which the claimant has a goodwill. However, it is the notional use of the registrations that I must consider for all of the goods and services set out in the registered specifications. This is so because, inevitably, the goods and services in a registered mark often go beyond any trade which may have already been conducted, if any has been conducted at all.

63) Graded's specifications cover educational, training and examination type services together with associated items of printed matter etc. All of its goods and services relate, though, to the awarding of educational qualifications. This is clear from the addition to its specifications of the following words:

“all the aforesaid relating to the awarding of educational qualifications to learners, young people and adults, including professionals”.

64) However, the fields in which such educational qualifications are awarded are as follows:

“entertainment, hospitality, catering, business management, engineering, law, financial studies, science and social sciences, philosophical studies and religious subjects, medicine, health related subjects, nutrition, travel and tourism, photography, environmental subjects, languages, computer studies, agriculture, horticulture, outdoor recreational activities, child care services”

65) Whilst Glass argue that such fields are wider than those in which Graded operate, it is a matter for Graded as to what fields it limits its goods and services to, the question then being whether Glass would be in a position to restrain such notional use. That being said, Glass provided submissions on some of the above fields with which it is concerned. The following comes from Glass' written submissions:

- (i) **“engineering”** – of direct and close relevance to glass and glazing, and touching and concerning areas of direct influence and relevance to our client.
- (ii) **“science”** – ditto as above – moreover the performance of glass and glazing products, tolerance, glass production and the chemical analysis of glass and glass made products, forensic analysis of glass etc., all could and would potentially come under such a broad umbrella classification as “science”;
- (iii) Similar arguments can be made in relation to **“medicine”** (glass used in medical applications, syringes, pipettes, slide plates, etc.) **“health related subjects”**, **“photography”** (glazing, lighting and mounting pictures and the coalition between art, glass and photography, etc) and **“horticulture”** (glazing, glass houses, growing frames, hydroponics tanks etc.) and **“agriculture”** (watering, glazing agricultural buildings, tanking etc.).

66) Whilst I understand the above submissions, the argument made in relation to medicine, health related subjects, photography, horticulture and agriculture seems to be made on the basis that glass could be used in certain devices, apparatus and equipment within those fields. There seems to me to be a significant stretch to come to the view that someone encountering goods and services relating to an education qualification in these fields under the GQAL marks will believe that such goods and services are the responsibility of Glass who provide, under the sign GQA, qualification type services in relation, principally, to the glass industry, and to a much lesser extent ancillary fields. In my view, any similarity between the marks and the sign will be put down, in these fields, to co-incidence. This is particularly so in the field of educational qualifications where, as Ms Alpren put it in her email, an email which Glass filed in evidence, organisations often use similar sounding acronyms.

67) The same applies to goods and services relating to awarding educational qualifications in the field of science. Whilst it is possible that a trained scientist may work with glass, there is nothing to suggest that educational qualifications are awarded in scientific glass based fields. The suggestion is simply hypothetical and I come to the view, again, that any similarity will be put down to co-incidence. In any event, and this applies to the fields discussed in the previous paragraph, the likelihood of someone who is familiar with Glass' awards then

encountering Graded's awards is remote in itself and, therefore, the likelihood of a misrepresentation to a substantial number of persons¹⁰ is even slimmer.

68) The final term I need to consider are those goods and services relating to the awarding of educational qualifications in the field of engineering. I agree with Glass that there is a clear and obvious overlap given that engineering per se would include engineering using glass as a principle method of construction (in buildings and construction for example). There is also a greater degree of propensity of overlap between those who are familiar with Glass and its goodwill and those likely to encounter an engineering based qualification award. For this reason, and bearing in mind that Graded concede that the sign/marks are similar, my finding is that a misrepresentation will occur here. Although there is no evidence that Glass have provided each and every item listed in Graded's specification, the fact that they all, by Graded's own wording, relate to the awarding of qualifications (in the field of engineering), is a strong factor pointing towards misrepresentation.

69) In relation to damage, there seems to me to be a likelihood of damage on a number of fronts. There could be loss of sales, e.g. people using Graded's engineering based qualification to the extent that it could cover glass based engineering rather than use Glass' qualification. There could also be damage to the business in a more general sense. This can clearly be seen in *Ewing v Buttercup Margarine Co Ltd*, 34 RPC 232 where it was stated:

“To induce the belief that my business is a branch of another man's business may do that other man damage in all kinds of ways. The quality of goods I sell; the kind of business I do; the credit or otherwise which I might enjoy – all those things may immensely injure the other man who is assumed wrongly to be associated with me.”

70) This is particularly relevant in the area of the awarding of qualifications as some qualifications are more regarded than others so an assumption of economic connection with a potentially less regarded qualification, or one that moves too far away from its core specialism, could have a negative impact on Glass and its goodwill.

71) In summary, whilst Glass succeed in respect of goods and services relating to the awarding of educational qualifications in the field of engineering, it fails in relation to everything else. Graded's registrations are, therefore, valid in relation to:

Class 16: Printed matter for use in teaching; printed matter relating to examinations; printed publications for use in teaching; examination certificates; leaflets; pamphlets; instructional and teaching materials; books; manuals; journals; stationery; binders; reports; worksheets;

¹⁰ See for example *Neutrogena Corporation and Anr. V Golden Limited and Anr.* [1996] RPC 473.

notebooks; newsletters; writing instruments; all the aforesaid relating to the awarding of educational qualifications to learners, young people and adults, including professionals, all in the field of arts, entertainment, hospitality, catering, business management, law, financial studies, science and social sciences, philosophical studies and religious subjects, medicine, health related subjects, nutrition, travel and tourism, photography, environmental subjects, languages, computer studies, agriculture, horticulture, outdoor recreational activities, child care services.

Class 35: Business examination services; all the aforesaid relating to the awarding of educational qualifications to learners, young people and adults, including professionals, all in the field of arts, entertainment, hospitality, catering, business management, law, financial studies, science and social sciences, philosophical studies and religious subjects, medicine, health related subjects, nutrition, travel and tourism, photography, environmental subjects, languages, computer studies, agriculture, horticulture, outdoor recreational activities, child care services.

Class 41: Educational services; provision of education and training services; provision and administration of educational examinations; provision of educational information; organisation of educational seminars, exhibitions and congresses; career information and advisory services; computer assisted education and training services; business training services; publication of educational and training materials; certification of education and training awards; library services; all of the aforesaid relating to the awarding of educational qualifications to learners, young people and adults, including professionals, all in the field of arts, entertainment, hospitality, catering, business management, law, financial studies, science and social sciences, philosophical studies and religious subjects, medicine, health related subjects, nutrition, travel and tourism, photography, environmental subjects, languages, computer studies, agriculture, horticulture, outdoor recreational activities, child care services.

TRADE MARK APPLICATION 2498139 – OPPOSITION

72) Given that Graded's registrations have survived an attack as to their validity, to the extent set out in the preceding paragraph, I now need to go on to consider Graded's opposition to Glass' application for registration. The opposition is based purely on section 5(2)(b) of the Act which reads:

“5.-(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 of association with the earlier trade mark.”

73) In reaching my decision I have taken into account the guidance provided by the ECJ in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

74) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods/services are similar (and to what degree), other factors are relevant including:

The nature of the average consumer of the goods/services in question and the nature of his or her purchasing act. This is relevant because it is through such a person's eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of “imperfect recollection”;

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).

75) There are a number of complexities to this opposition. I have to consider the limited specifications of Graded's registrations with the full specification of Glass as it stands now. I also have to bear in mind that Glass have put forward revised specifications (x2) as a fallback position should the opposition succeed to any extent. There may also be goods and services in Glass' application that are simply not similar to anything within Graded's registrations. I will also need to compare the marks and to bear in mind what the parties have already said in the invalidation case (both parties agreed that the sign/marks were similar) and what differences may be present in the opposition case. I will then need to balance all these factors, amongst others, and decide whether there is a likelihood of confusion.

76) I will begin by looking at the goods and services sought to be registered by Glass and I will do so on a class by class basis. When comparing the respective goods and services I note the judgment In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* where the ECJ stated:

“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.”

Guidance on this issue also came from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

77) In terms of understanding what a “complementary” relationship consists of, I note the judgment of the General Court in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-325/06 where it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and

Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48.”

78) In construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade¹¹. I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning¹². In relation to services, I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

79) In terms of my approach, if a term clearly falls within the ambit of a term in the competing specification then identical goods/services must be held to in play (*Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05).

80) Firstly, in class 16, Glass' goods are:

Loose leaf publications; printed matter; paper, cardboard and goods made from these materials, not included in other classes; reports; promotional material, publications, albums, almanacs, booklets, books, brochures, diaries, directories, guides, handbooks, journals, leaflets, notebooks, pamphlets, magazines, manuals and periodicals; statements and prospectuses; printed labels of paper or plastic; paper and plastic bags, boxes, cases, containers, cartons, other packaging materials and parts and fittings thereof; office requisites; stationery and printed forms; computer print-outs; computer reference manuals; computer users guides; computer instruction manuals; computer manuals; database listings; instructional and teaching materials; bookbinding material; photographs; stationery; plastic materials for packaging (not included in other classes); printers' type; printing blocks; artwork, diagrams and illustrations; calendars; charts; graphic prints and posters; graphic reproductions; drawing boards, pads and materials; etchings and engravings; paintings and pictures (framed or un-framed); paper weights; posters; scrap books; signboards of paper or cardboard; stamps (seals); stencils; wrappers;

¹¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

¹² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

wrapping and packing paper; writing pads; writing paper; parts and fittings for all the aforesaid goods.

81) I note¹³ that Graded's class 16 specification reads:

Printed matter for use in teaching; printed matter relating to examinations; printed publications for use in teaching; examination certificates; leaflets; pamphlets; instructional and teaching materials; books; manuals; journals; stationery; binders; reports; worksheets; notebooks; newsletters; writing instruments; all the aforesaid relating to the awarding of educational qualifications to learners, young people and adults, including professionals, all in the field of arts, entertainment, hospitality, catering, business management, law, financial studies, science and social sciences, philosophical studies and religious subjects, medicine, health related subjects, nutrition, travel and tourism, photography, environmental subjects, languages, computer studies, agriculture, horticulture, outdoor recreational activities, child care services.

82) I make my analysis in the following table:

Glass' term(s)	Comparison and analysis
Loose leaf publications; printed matter; paper, cardboard and goods made from these materials, not included in other classes; reports; promotional material, publications, albums, almanacs, booklets, books, brochures, directories, guides, handbooks, journals, leaflets, notebooks, pamphlets, magazines, manuals and periodicals; statements and prospectuses.	Graded's specification includes the term printed matter. Even though it is for teaching/examination purposes, and even though it is subject to the limitation previously discussed in this decision, identical or highly similar goods are in play because, notionally, the unrestricted specification of Glass could also cover such goods.
Printed labels of paper or plastic; paper and plastic bags, boxes, cases, containers, cartons, other packaging materials and parts and fittings thereof; plastic materials for packaging (not included in other classes); wrappers; wrapping and packing paper.	The goods set out opposite are various wrapping, packing, labelling or container type products. I see no reason to regard them as similar to Graded's printed matter or its term stationery. I see nothing obviously similar to any of its other goods and services. I find no similarity here.
Office requisites; stationery and printed forms; stationery; writing pads; writing paper; drawing boards, pads and materials; bookbinding material; stencils.	Graded's specification covers stationery at large (subject to the limitation previously discussed) and, thus, the various stationery type products opposite must be held to be similar.
Computer reference manuals; computer users guides; computer instruction manuals; computer manuals.	Graded's specification covers manuals at large. The limitation brings the goods closer as one of the fields relates to computers. These goods are

¹³ Although I also bear in mind, as I do with the other comparisons, Graded's other classes.

	identical/highly similar.
Instructional and teaching materials; charts; diagrams and illustrations; computer print-outs; database listings.	The goods opposite are either instructional/teaching material or goods that could be categorised as such. Graded's specification covers instructional and teaching materials and even though limited, the goods opposite could, notionally, cover the same goods. These goods are identical or highly similar.
Printers' type; printing blocks.	I do not regard these as normal items of stationery. I see nothing obviously similar to any other goods or services set out in Graded's specifications. I find no similarity here.
Artwork, photographs, graphic prints and posters; graphic reproductions; etchings and engravings; paintings and pictures (framed or un-framed); posters; calendars; diaries	The goods opposite are primarily for decorative purposes or for keeping track of dates. I see no real similarity with the goods or services of Graded. I find no similarity here.
Paper weights; scrap books; signboards of paper or cardboard; stamps (seals).	These are not normal items of examination/training printed matter nor would they fall within the term stationery. I find no similarity here.
Parts and fittings for all the aforesaid goods.	The finding here will mirror the finding on the relevant "aforesaid goods".

83) Glass' specification in class 35 reads:

Advertising, marketing and promotional services provided via the Internet or otherwise; consultation and advisory services; retail services relating but not limited to printed matter, education and training services; bonus, loyalty and incentive schemes; publicity services; advertising and retail in online, on-demand and other media, in particular in the aforesaid media and via the aforesaid media; direct mail advertising; operating, management, advertising and marketing services; public relations; direct marketing services; business management and administration; market surveys, analysis and research; sales promotion services; preparing and placing of advertisements; the bringing together, for the benefit of others, of a variety of printed materials, education and training services, enabling customers to conveniently view and purchase those goods and services from a general retail outlet or online via an Internet website; information, consultation and advisory services relating to all the aforesaid services, including such services provided online from a computer network or via the Internet or extranets.

84) I note that Graded's class 35 specification reads:

Class 35: Business examination services; all the aforesaid relating to the awarding of educational qualifications to learners, young people and adults, including professionals, all in the field of arts, entertainment, hospitality, catering, business management, law, financial studies, science and social sciences, philosophical studies and religious subjects, medicine, health related subjects, nutrition, travel and tourism, photography, environmental subjects, languages, computer studies, agriculture, horticulture, outdoor recreational activities, child care services.

85) Again, I make my analysis in the following table:

Glass' term(s)	Comparison and analysis
Advertising, marketing and promotional services provided via the Internet or otherwise; publicity services; advertising in online, on-demand and other media, in particular in the aforesaid media and via the aforesaid media; direct mail advertising; direct marketing services; advertising and marketing services; public relations; market surveys, analysis and research; sales promotion services; preparing and placing of advertisements.	The services set out opposite are various advertising, promotional and marketing type services. There is nothing in Graded's class 35 specification that is remotely similar as it merely covers business examination services. In relation to Graded' other goods and services, whilst it is possible (indeed likely) that they will be advertised, this does not mean that an advertising or promotional service itself should be regarded as similar. The purpose, method of use, potential users etc., are all different. There is no real complementary or competitive relationship. I find no similarity here.
Retail services relating but not limited to printed matter, education and training services; retail in online, on-demand and other media, in particular in the aforesaid media and via the aforesaid media; the bringing together, for the benefit of others, of a variety of printed materials, education and training services, enabling customers to conveniently view and purchase those goods and services from a general retail outlet or online via an Internet website.	To the extent that these services relate (or could relate) to the sale of education and training services and printed matter relating thereto, then there is similarity here. This is line with the judgment of the General Court in <i>Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs)</i> Case T-116/06.
Bonus, loyalty and incentive schemes.	I see nothing remotely similar between these services and those covered by Graded's specification. I find no similarity here.
Business management and administration; operating, management; consultation and advisory services.	A business management/administration services bears no real relationship with a business examination service or any other term in Graded's specifications. Whilst the term "consultation and advisory services" are not

	<p>specially qualified, the relevance in class 35 is likely to be directed at business consultation and advice and, as such, are not similar either. I find no similarity here.</p>
<p>Information, consultation and advisory services relating to all the aforesaid services, including such services provided online from a computer network or via the Internet or extranets.</p>	<p>The finding here will mirror the finding on the relevant “aforesaid services”.</p>

86) Glass’ specification in class 41 reads:

Entertainment; education; training; production, recording and distribution of films; publication services; organising, arranging and conducting of entertainment and educational shows, exhibitions, demonstrations, conferences, competitions, seminars and contests; examination services; setting educational and training standards; information relating to education and entertainment; devising, reviewing, revising and provision of qualifications; certificating of candidates achieving such qualifications; publishing; direct mail publicity campaigns; providing on-line electronic publications (not downloadable); publication of texts (other than publicity texts); publication of texts and printed matter, also in electronic form and via the Internet; online publication of electronic books; drafting of texts (other than publicity texts); publication of books; arranging and conducting of conferences and congresses; organisation of lectures, fora, congresses and colloquia; training services; coaching services; information, consultation and advisory services relating to any of the aforesaid services, including such services provided online from a computer network or via the Internet or extranets.

87) I note that Graded’s class 41 specification reads:

Class 41: Educational services; provision of education and training services; provision and administration of educational examinations; provision of educational information; organisation of educational seminars, exhibitions and congresses; career information and advisory services; computer assisted education and training services; business training services; publication of educational and training materials; certification of education and training awards; library services; all of the aforesaid relating to the awarding of educational qualifications to learners, young people and adults, including professionals, all in the field of arts, entertainment, hospitality, catering, business management, law, financial studies, science and social sciences, philosophical studies and religious subjects, medicine, health related subjects, nutrition, travel and tourism, photography, environmental subjects, languages, computer studies, agriculture, horticulture, outdoor recreational activities, child care services.

88) Again, I make my analysis in the following table:

Glass' terms	Comparison and analysis
Entertainment; information relating to entertainment; organising, arranging and conducting of entertainment shows, exhibitions, demonstrations, conferences, competitions, seminars and contests.	I see no real relationship with entertainment based services to anything in Graded's specifications. I find no similarity here.
Education; training; examination services; setting educational and training standards; information relating to education; organising, arranging and conducting of educational shows, exhibitions, demonstrations, conferences, competitions, seminars and contests; devising, reviewing, revising and provision of qualifications; certificating of candidates achieving such qualifications; training services; arranging and conducting of conferences and congresses; organisation of lectures, fora, congresses and colloquia; coaching services.	All of the services opposite cover education/training related services of one form or another. I consider Graded's class 41 specifications to result in all the terms opposite being identical or highly similar.
Production, recording and distribution of films.	The terms opposite strike me as specialist services provided by specialist businesses. I can see no real corollary with any of the goods and services covered by Graded's specifications. There is no similarity here.
Publication services; publishing; publication of texts (other than publicity texts); publication of books; providing on-line electronic publications (not downloadable); online publication of electronic books; publication of texts and printed matter, also in electronic form and via the Internet.	All of the services opposite cover publishing which would include, as some of the terms specifically provide, publishing of information, text and printed matter online. Against this context, and against the context that all the published material could be educational in nature, there is a clear overlap with Graded's educational goods and services.
Direct mail publicity campaigns.	The running of a publicity campaign is a specialist service akin to advertising/promotion. As per my finding in class 35, I find no similarity here.
Drafting of texts (other than publicity texts);	Drafting of text is another specialist service and, again, I see no real similarity with anything covered by Graded's specification. I find no similarity here.
Information, consultation and advisory services relating to any of the aforesaid services, including such services provided online from a computer network or via the Internet or extranets	The finding here will mirror the finding on the relevant "aforesaid services"

89) In terms of the average consumer of the above goods and services, where I have found identity or similarity, it is in areas which focus, or potentially focus, on goods and services with an educational/training/examination slant. The average consumer of the identical/similar goods and services will, therefore, be the same. Such an average consumer will be a member of the general public or a business engaging a service provider to train its staff. Either way, the case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I consider that at least a reasonable degree of care and attention will be deployed by the average consumer during the selection process – these are certainly not grab and go purchases; the process in relation to the ancillary goods in class 16 may be a little different though, with perhaps slightly less care and attention being deployed than in relation to the services themselves.

90) When comparing the marks, I must do so with reference to the visual, aural and conceptual similarities between the respective marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, paragraph 23). For ease of reference, the marks are set out below:

Graded's marks	Glass' mark
<p data-bbox="231 1037 322 1104">GQAL GQal</p> 	

91) At the hearing, Mr Fiddes highlighted that Glass had conceded that the marks were similar (similar enough to contribute to a misrepresentation under section 5(4)(a)) and that this must also apply here. Ms McFarland argued that she was able to argue differently here because the sign relied upon under section 5(4)(a) was the letters GQA (not the logo version of her client's mark). She went on to argue that the logo version of the GQA mark puts distance between the respective marks.

92) Whilst Ms McFarland may have argued the point, Glass' own pleadings in the invalidation case were based not just on the letters GQA but also on the figurative mark. In its statement of case reference is made to the dominant and distinctive elements of Glass' figurative mark as being the letter Q and the letters GQA. In any event, this coincides with my view in that the logo version does not remove all similarity. Whilst the GQA logo has a number of elements to bear in

mind, the letters GQA still form a dominant and distinctive component of the mark and this element is, in my view, the element which is likely to be most remembered. There is certainly at least a moderate degree of visual similarity compared with Graded's GQAL mark (which I consider to represent its best case) as its first three letters are shared with GQA, a dominant and distinctive element in Glass' mark. In terms of aural similarity, I believe that the letters GQAL will be pronounced as four separate letters. In terms of Glass' mark, I consider that the average consumer will most likely pronounce it as "GQA" (as three separate letters) "Qualifications" and will not pronounce the letter Q as its manner of presentation will indicate that the Q is simply there to reinforce the word "qualifications". Bearing in mind that the word QUALIFICATIONS is descriptive, there is a good deal of aural similarity. Neither mark has any specific context beyond being merely letters so this does not take matters any further forward. Overall, I consider there to be a reasonable (neither high nor low) degree of similarity.

93) The distinctiveness of the earlier mark(s) are another factor to consider because the more distinctive they are (based either on inherent qualities or because of the use made of them) the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). I have already said that Graded's earlier marks have not been used prior to their application, but given that I am assessing the position as of Glass' application date, I can consider use following Graded's application up until September 2008 (Glass' filing date). There is a bare claim that 35,000 awards are made every year, but there is very little supporting detail. The degree and extent of advertising and promotion appears relatively insignificant. In view of this, I do not consider that the use of the marks can enhance their inherent distinctiveness to any significant extent. In terms of the earlier marks inherent qualities, whilst letters and acronyms may often be used in the educational field, the letters GQAL have no specific allusive quality and can be regarded as a mark of at least a reasonable degree of distinctive character.

94) There are a number of factors to consider when deciding whether there is a likelihood of confusion. It is clear that the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

95) For Glass' goods and services which I have found not to be similar to anything in Graded's specification, I do not need to consider them any further as without any similarity in the goods/services, there can be no likelihood of confusion¹⁴. In relation to those other goods and services which, broadly

¹⁴ See, for example, the ECJ's judgment in *Waterford Wedgwood plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-398/07*.

speaking, cover identical and highly similar goods and services with an educational slant, then I need to consider the goods and services as they currently stand (unqualified), but also, if I find a likelihood of confusion, I need to consider the impact of Glass' fall-back specification which serve to limit the goods and services to either:

“all in relation to the manufacturing, installation, processing and construction sectors”

or

“save insofar as relates to dance, training, education or dancing as entertainment”

96) I was reminded by Ms McFarland at the hearing that section 5(2) states that the likelihood of confusion must be “...with the earlier trade mark” (emphasis added). Ms McFarland suggested that this brings in a flow of confusion. To illustrate her point she stated at the hearing:

“That, to my mind, is vital because it sets up what I call the direction of flow of confusion. In other words, the onus is on the opponent to prove that, if our mark were to be considered as it is applied for, the relevant confusion or likelihood of association is that that will be confused or associated with their earlier trade marks.”

97) There are a number of problems with the above submission. Firstly, I am not aware of any authority (neither was Ms McFarland) which suggests that there is an operative orientation or flow of confusion. Furthermore, the average consumer rarely knows who conducts matters behind a trade mark and will rarely be in a position to appreciate any flow of confusion. They will either be confused or they will not. Furthermore, if the argument were valid then it would amount to a requirement that earlier marks always be used in order to succeed in an opposition otherwise the flow of confusion would never operate in their direction. Beyond the proof of use conditions (which do not apply in these proceedings) this cannot be right. In any event, in the context of the consolidated proceedings I have found Glass' application for invalidation to have failed (other than in the field of engineering) and, therefore, Graded has the earlier right (in its specified fields) even if it may not have used its mark whereas Glass' right, to the extent that it is unqualified, brings it into Graded's notional field. This must surely be enough, subject to the relevant factors combining to cause the average consumer to be confused. I place no weight on this argument in terms of its relevance on whether there exists a likelihood of confusion.

98) In terms of the other factors, I have found the goods/services to be identical or highly similar, all being examination/educational/training based. I have found the earlier mark to be at least reasonably distinctive and I have found there to be

a reasonable (not high or low) degree of similarity between the marks when one bears in mind the dominant and distinctive elements. I have said that the selection process is reasonably well considered – whilst this could mitigate, to a degree, against imperfect recollection, I do not consider that this rules out confusion completely. Bearing in mind the factors assessed, and bearing in mind the concept of imperfect recollection, particularly when the goods and services could notionally be used in identical fields of examination/education/training, there is a likelihood of confusion.

99) That is not the end of it because Glass have put forward two fall-back specifications in terms of limitations. The second “save insofar as relates to dance, training, education or dancing as entertainment” does not help as the fields of education Graded’s registrations cover are wider than that excluded. However, Glass’s other specification limitation reads:

“all in relation to the manufacturing, installation, processing and construction sectors”

100) It is useful to compare this with the educational fields of Graded which are:

“all in the field of arts, entertainment, hospitality, catering, business management, law, financial studies, science and social sciences, philosophical studies and religious subjects, medicine, health related subjects, nutrition, travel and tourism, photography, environmental subjects, languages, computer studies, agriculture, horticulture, outdoor recreational activities, child care services”

101) Despite an invitation to do so (when I asked for further written submission) Graded made no specific submissions in relation to the above fields. It merely indicated that it still pursued its opposition. In my view, and bearing in mind that the marks are not identical and that educational awarding bodies will often use letters and acronyms, the respective fields set out above adequately avoid any likelihood of confusion. None of the fields of Graded strike me as being to do with the manufacturing, installation, processing or construction sectors. Although these sectors can be said to be a little vague (construction/installation of what?) they are nevertheless different from the type of fields set out in Graded’s specification. For this limited specification there is no likelihood of confusion.

Summary

102) In view of my findings, Graded’s two trade mark registrations remain registered for:

Class 16: Printed matter for use in teaching; printed matter relating to examinations; printed publications for use in teaching; examination certificates; leaflets; pamphlets; instructional and teaching materials;

books; manuals; journals; stationery; binders; reports; worksheets; notebooks; newsletters; writing instruments; all the aforesaid relating to the awarding of educational qualifications to learners, young people and adults, including professionals, all in the field of arts, entertainment, hospitality, catering, business management, law, financial studies, science social sciences, philosophical studies and religious subjects, medicine, health related subjects, nutrition, travel and tourism, photography, environmental subjects, languages, computer studies, agriculture, horticulture, outdoor recreational activities, child care services.

Class 35: Business examination services; all the aforesaid relating to the awarding of educational qualifications to learners, young people and adults, including professionals, all in the field of arts, entertainment, hospitality, catering, business management, law, financial studies, science and social sciences, philosophical studies and religious subjects, medicine, health related subjects, nutrition, travel and tourism, photography, environmental subjects, languages, computer studies, agriculture, horticulture, outdoor recreational activities, child care services.

Class 41: Educational services; provision of education and training services; provision and administration of educational examinations; provision of educational information; organisation of educational seminars, exhibitions and congresses; career information and advisory services; computer assisted education and training services; business training services; publication of educational and training materials; certification of education and training awards; library services; all of the aforesaid relating to the awarding of educational qualifications to learners, young people and adults, including professionals, all in the field of arts, entertainment, hospitality, catering, business management, law, financial studies, science and social sciences, philosophical studies and religious subjects, medicine, health related subjects, nutrition, travel and tourism, photography, environmental subjects, languages, computer studies, agriculture, horticulture, outdoor recreational activities, child care services.

103) To the extent that the goods and service previously (as per the partial surrender) covered educational qualifications in relation to engineering, the registration of the marks for such goods and services is deemed never to have been made (this is in accordance with Rule 46(6) of the Act).

104) Glass' application for registration is refused except as set out below. It should be noted that the fall-back limitation has been applied only to those goods and services for which the opposition was successful. The goods and services for which the opposition failed are not the subject of the fall-back limitation.

Class 16: Loose leaf publications; printed matter; paper, cardboard and goods made from these materials, not included in other classes; reports; promotional material, publications, albums, almanacs, booklets, books, brochures, directories, guides, handbooks, journals, leaflets, notebooks, pamphlets, magazines, manuals and periodicals; statements and prospectuses; office requisites; stationery and printed forms; computer print-outs; computer reference manuals; computer users guides; computer instruction manuals; computer manuals; database listings; instructional and teaching materials; bookbinding material; stationery; diagrams and illustrations; charts; drawing boards, pads and materials; stencils; writing pads; writing paper; parts and fittings for all the aforesaid goods; all in relation to the manufacturing, installation, processing and construction sectors; diaries; printed labels of paper or plastic; paper and plastic bags, boxes, cases, containers, cartons, other packaging materials and parts and fittings thereof; photographs; plastic materials for packaging (not included in other classes); printers' type; printing blocks; artwork; calendars; graphic prints and posters; graphic reproductions; etchings and engravings; paintings and pictures (framed or un-framed); paper weights; posters; scrap books; signboards of paper or cardboard; stamps (seals); wrappers; wrapping and packing paper; parts and fittings for all the aforesaid goods.

Class 35: Retail services relating but not limited to printed matter, education and training services; retail in online, on-demand and other media, in particular in the aforesaid media and via the aforesaid media; the bringing together, for the benefit of others, of a variety of printed materials, education and training services, enabling customers to conveniently view and purchase those goods and services from a general retail outlet or online via an Internet website; information, consultation and advisory services relating to all the aforesaid services, including such services provided online from a computer network or via the Internet or extranets; all in relation to the manufacturing, installation, processing and construction sectors; advertising, marketing and promotional services provided via the Internet or otherwise; consultation and advisory services; bonus, loyalty and incentive schemes; publicity services; advertising online, on-demand and other media, in particular in the aforesaid media and via the aforesaid media; direct mail advertising; operating, management, advertising and marketing services; public relations; direct marketing services; business management and administration; market surveys, analysis and research; sales promotion services; preparing and placing of advertisements; information, consultation and advisory services relating to all the aforesaid services, including such services provided online from a computer network or via the Internet or extranets.

Class 41: Education; training; publication services; organising, arranging and conducting of educational shows, exhibitions, demonstrations,

conferences, competitions, seminars and contests; examination services; setting educational and training standards; information relating to education; devising, reviewing, revising and provision of qualifications; certificating of candidates achieving such qualifications; publishing; providing on-line electronic publications (not downloadable); publication of texts (other than publicity texts); publication of texts and printed matter, also in electronic form and via the Internet; online publication of electronic books; publication of books; arranging and conducting of conferences and congresses; organisation of lectures, fora, congresses and colloquia; training services; coaching services; information, consultation and advisory services relating to any of the aforesaid services, including such services provided online from a computer network or via the Internet or extranets; all in relation to the manufacturing, installation, processing and construction sectors; entertainment; production, recording and distribution of films; organising, arranging and conducting of entertainment shows, exhibitions, demonstrations, conferences, competitions, seminars and contests; information relating to entertainment; direct mail publicity campaigns; drafting of texts (other than publicity texts); information, consultation and advisory services relating to any of the aforesaid services, including such services provided online from a computer network or via the Internet or extranets.

Costs

105) As can be seen from the preceding paragraph, the overall outcome is something of a score draw. Ordinarily in these circumstances I would not have favoured either party with an award of costs. However, I agree with Glass' further written submissions that the filing of such a late partial surrender by Graded should have an impact on this analysis. Glass asked for an opportunity to make further submissions on costs having had the chance to see the impact of the partial surrender on these proceedings. I agree that such an opportunity should be provided. Graded may, of course, avail itself of the same opportunity. That being said, the submissions should be carefully marshalled to reflect what additional costs were incurred by the late partial surrender (relevant bills showing the time spent and cost incurred should also be provided). I say this because even if the partial surrender had been put in as a fall-back specification at (or shortly before) the hearing this would have had little impact on the proceedings prior to this point and may not have even disposed of the need for a hearing. It is the post surrender costs which are more relevant.

106) I will allow a period of 28 days from the date of this decision in order for written submissions on costs to be made. I will then issue a supplementary decision dealing with the costs issue. The appeal period for this substantive decision will run concurrently with the appeal period for my decision on costs.

Dated this 11 day of August 2010

**Oliver Morris
For the Registrar
The Comptroller-General**