

O-454-20

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3371454 BY
THE INTENSIVE SCHOOL OF ENGLISH AND
BUSINESS COMMUNICATION LIMITED**

TO REGISTER:



AS A TRADE MARK IN CLASS 41

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60001201 BY
TRINITY COLLEGE LONDON**

Background & pleadings

1. On 30 January 2019, The Intensive School of English and Business Communications Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision for *School services for the teaching of languages*, in Class 41. The application was published for opposition purposes on 7 June 2019.

2. On 9 September 2019, the application was opposed under the fast track opposition procedure by Trinity College London (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon two trade mark registrations:

(i) UK 3095225

ISE

Relying on its registered services in class 41: Educational services; teaching services, including in the areas of music, drama, dance and other areas of the arts, and languages and communication; organising educational courses, classes and seminars, including in the areas of music, drama, dance and other areas of the arts, and languages and communication; providing the services of an examination board, including in the areas of music, drama, dance and other areas of the arts, and languages and communication; educational examination, testing and assessment services, including in the areas of music, drama, dance and other areas of the arts, and languages and communication; setting and marking of examinations, tests and assessments, including in the areas of music, drama, dance and other areas of the arts, and languages and communication; certification of examination, test and assessment standards, including in the areas of music, drama, dance and other areas of the arts, and languages and communication; moderation of examinations, including in the areas of music, drama, dance and other areas of the arts, and languages and communication; certification of teacher and other training courses, as well as examination of trainees on such courses; publishing services, including on-line publishing services; advisory and consultancy services in relation to all the aforesaid services; none of the aforesaid services relating to undergraduate and postgraduate

courses in the social sciences and/or any undergraduate and postgraduate courses in the fields of economics, politics, law, sociology, anthropology, accounting and finance and/or any training courses relating to social sciences, economics, politics, law, sociology, anthropology, accounting and finance.

Filing date: 19 February 2015; date registration procedure completed: 19 June 2015.

(ii) European Trade Mark (“EUTM”) 17017401

ISE

Relying on the services registered in class 41 which are almost identically worded to the earlier UK registration.

Filing date: 21 July 2017; date registration procedure completed: 20 January 2018.

3. The opponent claims the services of the application are identical or similar to the services for which its earlier marks are registered, and that the marks are highly similar. The opponent claims, as a result, that there is a likelihood of confusion between the marks.

4. The applicant filed a counterstatement. Whilst admitting that the services are similar, the applicant denies that there is a likelihood of confusion, claiming the following:

We acknowledge that goods and services are similar in so much as Intensive School of English is an English language school and the opponent's trade mark is for an English exam. However, the school is an organisation and limited company whereas the opponent's registration is for an exam, and does not appear to have a logo of any kind. We deny the grounds set out by the other party as our application is for a logo, whereas the letters "ISE" are used by a variety of businesses and entities.

We wish the following to be considered: The ISE school logo has been used since the launch of Intensive School of English & Business Communication in 1997, incorporated on 20 April 2001. The logo is used by Intensive School of English & Business Communication, known as ISE Brighton, and ISE Language Ltd known as ISE Hove, which was incorporated in 2006.

ISE Brighton and ISE Hove are partner schools, owned by the same family.

A previous version of the ISE school logo was successfully filed at IPO on 18 October 2007, UK trade mark number UK00002469823. The current, updated version of the ISE school logo, trade mark application number UK00003371454, was filed on 30 January 2019 and was originally designed and brought into use from 2017, replacing the previous logo.

Use of a circular ISE logo for both ISE language schools pre-exists the opponent's Trade Mark, filed 21 July 2017. Neither ISE language school's were consulted or notified of the opponent's intention to file trade mark number EU17017401, which was filed at a time when the schools' trade mark UK00003371454 was still registered under the same classes 16 & 41.

The purpose of the current application UK00003371454 is to register our current logo which is the identity and brand of the school that has been built up over the last 23 years.

5. The opponent is represented by Bates Wells and Braithwaite London LLP; the applicant represents itself.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Marks Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

7. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings. Evidence constitutes facts. Since leave must be sought to file evidence, the contents of the counterstatement which relate to facts concerning the applicant’s business cannot be deemed admissible in these proceedings. I will say more about this content of the counterstatement later in this decision.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. The opponent filed written submissions in lieu of a hearing. The applicant did not file written submissions, but I will treat the contents of its counterstatement as its written submissions.

Decision

9. Section 5(2)(b) of the Act states:

“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.”

10. The registrations upon which the opponent relies qualify as earlier trade marks because they were filed prior to the filing of the contested application. I say more about this below.

11. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

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

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

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

Comparison of goods and services

12. I note from the counterstatement that the applicant considers the opponent's services to be "an exam". Although the opponent's services do cover the administration of examinations, they also list a variety of other services relating to education. As the earlier marks had been registered for less than five years on the date on which the contested application was applied for, they are not subject to proof that they have been used (under section 6A of the Act).¹ Consequently, the opponent is entitled to rely upon its registrations for all of the services upon which its opposition is based. I must make the assessment based upon the full width of the services relied upon by the opponent, regardless of whether or not the marks have actually been used in relation to those services. This is because the opponent is entitled to protection across the breadth of what it has registered on a 'notional' use basis.

13. The applicant's services are *School services for the teaching of languages*. The earlier marks both cover "Educational services; teaching services, including in the areas of music, drama, dance and other areas of the arts, and languages and communication" (my emphasis). In determining which services are identical and which are highly similar, the law requires that goods/services be considered identical where one party's description of its goods/services encompasses the specific goods/services covered by the other party's description (and vice versa): see *Gérard Meric v OHIM*, Case T-33/05, General Court ("GC"). On this principle, the services of the application are identical to the opponent's 'educational services', which is a broad term. The services of the application are also identical to the opponent's "teaching services, including in the areas of ... languages and communication". This is because, although differently worded, both parties' services cover teaching of languages.

The average consumer and the nature of the purchasing process

¹ As these proceedings commenced after 14 January 2019, when the Trade Mark Regulations 2018 came into force, the relevant period for proof of use purposes is the five years prior to and ending on the date of application of the contested application.¹

14. As the case law above indicates, it is necessary for me to determine who the average consumer is for the parties' services; I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

15. Although I bear in mind that there may be an aural aspect to the purchasing process, the services will be purchased primarily visually after examination of e.g. websites and prospectuses. On a notional view, these are services which will cause some degree of care to be used in the selection process, but not the highest level of care. The more advanced or expensive the teaching, the closer will be the attention paid to its selection.

Comparison of trade marks

16. As both of the earlier trade marks are identical, I will refer to the opponent's mark in the singular from hereon.

17. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*:

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

18. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

The opponent's trade mark	The applicant's trade mark
<p>ISE</p>	

19. The opponent's mark comprises a single component, ISE. The overall impression of the mark resides solely in this component. The applicant's mark also contains the element ISE, but it is surrounded by a circular device in the manner of a border which is half solid, half dots. Although both elements contribute to the overall impression of the mark, the central component ISE is large, and its position in the centre of the circular device causes the eye to be drawn to it. Consequently, it is ISE which is the more dominant and distinctive element in the applicant's mark.

20. The marks coincide visually and aurally in the ISE element. Since the device only appears in the applicant's mark, the marks are visually similar to a medium, rather than a high degree. Aurally, I find that the marks are identical because they will be

articulated in the same way; either as a word (sounding like 'ice') or the separate letters I, S and E. Neither mark has a meaning, so the conceptual comparison is neutral.

21. The fact that the applicant's mark is represented in blue and red makes no difference to the assessments of visual similarity and whether there is a likelihood of confusion. The Court of Appeal has stated on two occasions following the CJEU's judgment in *Specsavers*, that registration of a trade mark in black and white, as the opponent's mark is registered, covers use of the mark in colour.² This is because colour is an implicit component of a trade mark registered in black and white (as opposed to extraneous matter).³ Thus a black and white version of a mark should normally be considered on the basis that it could be used in any colour. Notional and fair use of the opponent's mark would include use in blue, which is how the element ISE is represented in the applicant's mark.

Distinctive character of the earlier trade mark

22. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

23. I note that the applicant's counterstatement makes reference to ISE being used by a variety of businesses and entities. If the applicant intended to make the point that ISE is not greatly distinctive as a trade mark, the point cannot be accepted because there is no evidence as to whether any of these business and entities also provide the

² Paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47.

³ See paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47

same or similar services; how they are used and whether the average consumer is accustomed to differentiating between them.

24. As the opponent has filed no evidence of any use it may have made of the trade mark upon which it relies, I have only its inherent characteristics to consider. The mark has no meaning. The mark has a high degree of inherent distinctive character or, at least, a good level of distinctive character, because it does not describe or allude to the services for which the mark is registered.

Likelihood of confusion

25. The applicant makes reference, in its counterstatement, to the fact that it owns a trade mark registration for a previous version of its ISE logo and that this registration pre-exists the opponent's registrations. This fact does not assist the applicant. The opponent's earlier registrations are valid by virtue of section 72 of the Act, and may be relied upon for the purposes of an opposition under section 5(2)(b) of the Act. The Registrar's Tribunal Practice Notice 4/2009 states:⁴

"1. A number of counterstatements in opposition and invalidation actions have sought to introduce as a defence that the applicant for registration/registered proprietor has a registered trade mark (or trade mark application) for the same or a highly similar trade mark to that which is the subject of the proceedings that predates the earlier mark upon which the attacker relies.

2. Sections 5(1) and 5(2) of the Act turn upon whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. Whether the applicant for registration/registered proprietor has another registered trade mark (or trade mark application) that predates the earlier mark upon which the attacker relies cannot affect the outcome of the case in relation to these grounds.

⁴ Entitled "The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark".

3. The position was explained by the Court of First Instance in *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) T-269/02*:

"24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener's mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.

26 The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (Case T 6/01 *Matratzen Concord v OHIM - Hukla Germany (MATRATZEN)* [2002] ECR II 4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities."

26. Despite the applicant's statement that it has used its mark (or versions of it) for twenty-three years, the opponent has not filed evidence so it is not possible to make a finding that there has been no confusion between the marks. There is no basis upon which to assess whether or not the average consumer for the parties' services has had the opportunity to distinguish between the two undertakings. There is no evidence that the opponent has used its mark, and no evidence that the average consumer has

been exposed to both parties' marks in relation to similar or identical services, so it is not possible to find that the average consumer has not, in fact, been confused.⁵

27. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. I have found that the parties' services are identical.

28. The parties' marks are not conceptually similar. The parties' services are predominantly a visual purchase and the marks are visually similar to a medium degree; importantly, they share an identical dominant and distinctive element. Given the presence of the applicant's device, which is also prominent, I consider that the marks as wholes will not be directly confused for one another. By this, I mean that the average consumer will recognise that they are different marks because of the additional device in the applicant's mark. They will not, therefore, mistake the marks for one another.

29. Despite there being no likelihood of direct confusion, I nevertheless find that there will be indirect confusion. This type of confusion was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms,

⁵ *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220.

is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

30. Although the services will be bought with some care, this is not of such a high level that consumers will dismiss the likelihood that the marks are economically linked. ISE is the only word element in the applicant’s mark. In *Wassen International Ltd v OHIM*, Case T-312/03, the GC stated:

“... where a trade mark is composed of verbal and figurative elements, the former should, in principle, be considered more distinctive than the latter, because the average consumer will more easily refer to the goods in question by quoting their name than by describing the figurative element of the trade mark.”

31. This does not undermine my finding earlier that the marks will be perceived predominantly visually, rather than referred to orally, but it highlights that the average consumer’s focus is more naturally pointed towards distinctive word elements in marks which are composed of words and devices.

32. Not only is the common element between the marks the dominant and distinctive element in them both, ISE forms the entirety of the earlier mark. The services are identical, a factor which, coupled with the high level of distinctive character of the earlier mark, is likely to lead average consumers to presume that the identical dominant and distinctive device elements are the result of the marks being variations on the same brand; or that one is a sub-brand of the other belonging to one of the parties, or to an undertaking which is economically linked thereto.

33. Putting all of the factors and findings together, I find that there is a likelihood of confusion under section 5(2)(b) of the Act.

Outcome

34. The opposition succeeds. The application is refused.

Costs

35. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in fast track opposition proceedings are governed by Tribunal Practice Notice 2/2015. Using that TPN as a guide, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement:	£200
Opposition fee:	£100
Written submissions	£200
Total:	£500

36. I order The Intensive School of English and Business Communications Limited to pay to Trinity College London the sum of £500. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of September 2020

Judi Pike
For the Registrar,
the Comptroller-General