

**IN THE MATTER OF APPLICATION No 2171448
BY THE AMERICAN COLLEGE IN LONDON LIMITED
TO REGISTER A TRADE MARK IN CLASS 41**

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER No 49919 BY RICHMOND, THE AMERICAN
INTERNATIONAL UNIVERSITY IN LONDON INC.**

BACKGROUND

1. On 7 July 1998, The American College in London Limited applied to register the trade mark shown below in Classes 41 and 42.

**AMERICAN
INTERCONTINENTAL
UNIVERSITY**

2. The application was accepted and published for opposition in respect of the following specification of services:-

Class 41

University education services; arranging and conducting of lectures; provision of instruction and courses of study and research programmes leading to the examination and award of Certificates, Diplomas or Degrees for undergraduate and postgraduate students both internal and external; open access courses for instruction and study by way of lectures, classes, library facilities and other teaching aids; the award of prizes and scholarships; development of audio-visual techniques in teaching, research and

administration; library services; library advisory and consultancy services; advisory services in connection with library collections, including conservation publication of printed matter.

Class 42

Information and advisory services relating to job opportunities and careers; computing facilities for research and teaching through communications networks; research services relating to education; research and development of computerised information storage and retrieval systems.

3. On 29 June 1999, Richmond, The American International University in London, Inc. filed notice of opposition.

PLEADINGS

4. The grounds of opposition have been amended (twice). The final version of the grounds of opposition claims that:-

(a) The opposed mark is devoid of any distinctive character in that it consists merely of the three common words "AMERICAN", "INTERCONTINENTAL" and "UNIVERSITY" which are arranged in a non-distinctive manner. The words "AMERICAN UNIVERSITY" are in common use by the opponent and others as part of a trade mark with other distinctive elements. The opponent submits that the application should therefore be refused under Section 3(1) of the Act.

(b) The opponent is the proprietor of the following earlier trade marks:

Application No 2051132A for a series of four marks:

- RICHMOND
THE AMERICAN UNIVERSITY IN LONDON

RICHMOND COLLEGE
THE AMERICAN UNIVERSITY IN LONDON

RICHMOND, THE AMERICAN UNIVERSITY IN LONDON

RICHMOND COLLEGE, THE AMERICAN UNIVERSITY IN LONDON

Application No 2051132B for a series of five marks:

- RICHMOND
THE AMERICAN INTERNATIONAL UNIVERSITY IN LONDON

- RICHMOND COLLEGE
THE AMERICAN INTERNATIONAL UNIVERSITY IN LONDON

- RICHMOND, THE AMERICAN INTERNATIONAL UNIVERSITY IN
LONDON

- RICHMOND COLLEGE, THE AMERICAN INTERNATIONAL
UNIVERSITY IN LONDON

- RICHMOND COLLEGE, THE AMERICAN INTERNATIONAL
UNIVERSITY IN LONDON INC.

Both these applications were filed on 13 January 1996 in Classes 16, 25 and 41.

- (c) The applicant's mark is similar to the opponent's earlier trade marks and the services specified in the application are similar to the goods and services specified in the opponent's applications. In consequence, there exists a likelihood of confusion and/or association on the part of the public and registration would therefore be contrary to Section 5(2)(b) of the Trade Marks

Act 1994 (hereinafter "the Act").

- (d) The opponent has used the above trade marks extensively in the UK since at least 1986. The opponent has also been trading under the name "RICHMOND COLLEGE, THE AMERICAN UNIVERSITY IN LONDON" since at least 1992.
- (e) In consequence, use of the mark applied for is liable to be prevented by "any rule of law and specifically the law of passing off." Registration would therefore be contrary to Section 5(4) of the Act.

5. The applicant filed a counterstatement denying the grounds of opposition. In particular, the applicant denies that the mark applied for is devoid of any distinctive character when considered as a whole and in the form filed. The applicant does not accept that the words AMERICAN UNIVERSITY (in immediate juxtaposition) are in common use by the opponent and others, as claimed by the opponent. The applicant further denies that the opponent has made extensive use of the marks listed in the grounds of opposition. The applicant accepts that the opponent has made earlier applications to register the marks included in application numbers 2051132A and B, but points out that it has opposed these applications.

6. Both sides seek an award of costs.

7. Neither side requested an oral hearing. The matter will therefore be decided on the basis of the pleadings and the supporting evidence.

THE EVIDENCE

8. The opponent's evidence consists of a statutory declaration dated 11 January 2000 by Walter McCann, who is President of Richmond, The American University in London. Mr McCann's declaration is accompanied by 11 exhibits.

9. The applicant's evidence consists of a statutory declaration and four exhibits dated 11 May 2000 by Raphael Lago, who is the President of American Intercontinental University in London.

FINDINGS OF FACT

10. After a review of this evidence, I have reached the following findings of fact:

- (a) The opponent has been trading in the UK as an educational establishment since around 1975.
- (b) The opponent's business is principally identified by the name RICHMOND COLLEGE or (since 1996) by RICHMOND.
- (c) From 1992, the opponent's styled itself THE AMERICAN INTERNATIONAL UNIVERSITY IN LONDON, but the use of these words has normally been subsidiary to the words RICHMOND COLLEGE, or more recently, just RICHMOND.
- (d) The opponent has its roots in the USA and, although it has an international student base, by far the largest single constituent of its students are Americans studying in the UK. In these circumstances the opponent's use of THE AMERICAN INTERNATIONAL UNIVERSITY IN LONDON is *prima facie* descriptive of the type of educational establishment in question. The opponent has not established in evidence that the words THE AMERICAN UNIVERSITY IN LONDON (without RICHMOND) had come to distinguish its services by the material date (7 July 1998).
- (e) Although the applicant has operated an educational establishment in the UK since the late 1970s, this trade was, until 1998, conducted under the name AMERICAN COLLEGE IN LONDON. The trading name AMERICAN

INTERCONTINENTAL UNIVERSITY was adopted in 1998. The opponent has not established any use of this mark prior to the material date in these proceedings.

DECISION

11. I will first consider the objection that the applicant's mark is excluded from registration by Section 3(1) of the Act because it is devoid of any distinctive character. Although the opponent has not been specific on this point, I take this objection to be founded on Section 3(1)(b) of the Act.

12. The essential function of a trade mark is to guarantee that the goods or services in respect of which it is used repeatedly originate from, or under the control of, a single undertaking which is responsible for their quality. A trade mark that is unable to perform this function until the public have been educated to perceive it as a trade mark is devoid of any distinctive character. The matter is to be assessed by way of the likely reaction of the average consumer of the goods or services in question. See L.J. Robert Walker's comments in *Procter and Gamble's Application* 1999 RPC 673, and the comments of L.J. Morritt in *Bach Flower Remedies* 2000 RPC page 513 .

13. The opponent says that "American", "Intercontinental" and "University" are common words. So they are, but there is nothing to prevent the registration of marks consisting of common words as such. The question is whether the words are already common in the relevant trade, or are liable to be used in that trade in future as a description of characteristics of the goods or services, or otherwise lack a distinctive character for the goods or services at issue.

14. The opponent says that "American" and "University" are in common use by itself and by others as parts of trade marks. Exhibit WM9 to Mr McCann's declaration consists of a copy of The Education (Listed Bodies) Order 1999. This appears to cover those bodies providing courses leading to a degree. There are four separate establishments listed with the name "International" in their title but none with the word "Intercontinental". The opponent appears

to be the only one with the word American in its title. This list is clearly not an exhaustive list of the educational establishments in the UK. I am prepared to accept that the word "American" is non-distinctive for an American based educational establishment providing goods and services in the UK, or for goods/services provided by any organisation in the UK for Americans studying here. In my view, the opponent is correct in submitting that the words "American University" are not inherently distinctive for educational goods and services.

15. The applicant's mark does not consist exclusively of these words. It incorporates the word "Intercontinental". This word appears between the words "American" and "University". It is in a smaller typeface, but it is not so small as to be de minimis. I do not think that the average consumer would overlook this word in the normal course of events.

16. The applicant says it adopted the name AMERICAN INTERCONTINENTAL UNIVERSITY in 1998 because of the international 'flavour' of the American Colleges. The applicant's parent has three colleges in Los Angeles, London and Dubai - hence "intercontinental". I do not believe that these circumstances are sufficiently common that it can be said that the words AMERICAN INTERCONTINENTAL UNIVERSITY are, in combination, a sign that may serve in trade in the UK to designate characteristics of the goods or services listed in the application. In particular, the word INTERCONTINENTAL appears so grandiose that I have difficulty in believing that there will be a wide demand to use such a term in this trade in the UK. I believe that the average consumer of educational services and associated goods would readily regard the words AMERICAN INTERCONTINENTAL UNIVERSITY as identifying the goods and services of a single undertaking, and would be surprised if it turned out that there was more than one organisation in the UK providing goods or services under this name. I do not therefore believe that the applicant's mark is devoid of any distinctive character. It is a relatively weak mark and this must be reflected in the scope of protection, but the mark is not so weak as to be denied protection *prima facie*. The opposition under Section 3(1)(b) fails.

17. The opponent's case under Section 5(4) of the Act is based upon its common law rights arising from its use of the name RICHMOND COLLEGE, THE AMERICAN

INTERNATIONAL UNIVERSITY IN LONDON in respect of educational services from 1992.

18. The opponent claims that the applicant's use was liable to be prevented at the material date, by "any rule of law". However, the only specific rules of law stated is the law of passing off. There is no obvious alternative rule of law upon which the opponent can rely. In any event it is for the opponent to plead its grounds rather than for me to guess what they might be. Consequently, I intend to proceed on the footing that the applicant's case is based upon s5(4)(a) of the Act and founded upon its claim that use of the applicant's mark at the material date was liable to be prevented by the law of passing off.

19. The necessary elements of the action for passing off have been restated by the House of Lords (see *Reckitt and Colman Products Ltd v Burden Inc* 1990 RPC 341) as:

- (a) the plaintiff's goods or services have acquired a goodwill in the market and are known by some distinguishing feature;
- (b) there is a misrepresentation by the defendant (whether or not international) leading or likely to lead the public to believe that the goods or services of the defendant are those of the claimant; and
- (c) the claimant has suffered or is likely to suffer damage as a result of the defendant's misrepresentation.

20. It appears from the opponent's catalogues for 1992 - 1998 (copies of which are exhibited WM5 - WM7 to Mr McCann's declaration) that the opponent promotes its educational services primarily under the name RICHMOND. The indications "College" and "The American International University in London" represent a subsidiary part of the of the opponent's title. The former seems to have been abandoned altogether. The opponent's catalogues record that the opponent is a member of the Association of American International Colleges and Universities, which would rather confirm the descriptive significance of these

words to those in receipt of the opponent's promotional material.

21. Even accepting that, by July 1998, the opponent's educational business in the UK was known by the composite name of RICHMOND, THE AMERICAN INTERNATIONAL UNIVERSITY IN LONDON, I see no likelihood of the public being confused or deceived by the applicant's use of the mark AMERICAN INTERCONTINENTAL UNIVERSITY in the form filed. There is nothing inherently distinctive about the words AMERICAN and UNIVERSITY for educational services, which are the only words that are common to both marks. The strongest source identifier in the opponent's sign is RICHMOND. By contrast the applicant's mark depends upon the rather quirky combination of AMERICAN and INTERCONTINENTAL for its spark of distinctiveness. The opponent's case appears to depend upon the notion that the public will believe that there can only be one organisation in the UK entitled to use the words AMERICAN and UNIVERSITY in its name. I see nothing in the evidence to support that assumption. Further, it seems at odds with the opponent's own pleadings about the applicant's mark under s3(1), which allege that the words AMERICAN UNIVERSITY are not distinctive of any one undertaking.

22. In the absence of misrepresentation the opponent's case under Section 5(4)(a) is bound to fail. I so find.

23. This brings me to the opponent's case under Section 5(2)(b) based upon its earlier applications to register two series of a total of nine trade marks. These applications (Numbers 2051132A & B) are still pending as a result of oppositions by the applicant in this case. These applications have an earlier filing date than this application. The opponent's trade marks are therefore "earlier trade marks" as defined by Section 6(1) of the Act, but according to Section 6(2), this is subject to the opponent's marks reaching registration. Accordingly, if the outcome of this case is likely to depend upon the outcome of applications 2051132A and B, the proper course of action would be to suspend this opposition until the outcome of the oppositions to the opponent's own applications is known.

24. I do not believe that is necessary. The closest of the opponent's nine pending earlier trade

marks is probably RICHMOND, THE AMERICAN INTERNATIONAL UNIVERSITY IN LONDON. The application covers identical services in Class 41 and related goods in Classes 9 and 16. I have already considered the opponent's claim to own a goodwill identified by such a mark in considering the ground of opposition under Section 5(4)(a) of the Act. I decided that the applicant's use of the mark applied for would not constitute a misrepresentation in these circumstances. Similarly, even assuming use of the respective marks for identical services, I do not believe that use of the applicant's mark is likely to cause confusion on the part of the public, including the likelihood of association (as to a common trade source). The opposition under Section 5(2)(b) therefore fails for the same reasons as the case under Section 5(4)(a) failed (see paragraph 21 above).

COSTS

25. The opposition having failed, the applicant is entitled to a contribution towards its costs. The applicant has not had to incur the cost of being represented at a hearing. Bearing this in mind, I order the opponent to pay the applicant the sum of £500. This sum to be paid within seven days of the end of the period allowed for appeal, or in the event of an unsuccessful appeal, within seven days of the final determination of the matter.

Dated this 12 Day of December 2000

Allan James

For the Registrar

The Comptroller General