

**O-464-16**

**IN THE MATTER OF THE TRADE MARKS ACT 1994**

**APPLICATIONS Nos. 3055444 and 3077984  
By ALPHA-TEK ASSOCIATES LIMITED**

**To register the trade marks:**

**CEM 11+  
CEM 11 plus  
(a series of 2 marks)**

**and**



**AND OPPOSITIONS thereto nos. 402725 and 403772  
By the UNIVERSITY OF DURHAM**

**AND**

**APPLICATIONS nos. 3057993 and 3057994  
By the UNIVERSITY OF DURHAM  
To register the trade marks**

**CEM 11 plus  
and  
CEM 11+**

**AND OPPOSITIONS thereto nos. 402965 and 402964  
By ALPHA-TEK ASSOCIATES LIMITED**

**AND**

**APPLICATION no. 500438 by AMIT MATALIA for trade mark no. 2654219**

**CEM**

**owned by THE UNIVERSITY OF DURHAM to be declared invalid**

**DECISION OF THE APPOINTED PERSON**

1. This is an Appeal from a decision of the Hearing Officer, Mr Allan James, on behalf of the Registrar of Trade Marks, in a consolidated set of oppositions and an application for a declaration of invalidity.

2. I will first provide a short history of the parties and their involvement with the trade marks in issue, in order to put this dispute into context.
3. For about the last 20 years, the University of Durham has operated a department formally called the 'Centre for Evaluation and Monitoring'. This has at all relevant times been referred to as 'CEM' both internally and externally. There is no dispute that CEM is now one of the largest independent providers of educational assessment and monitoring systems in the world.
4. CEM is probably best-known in the United Kingdom for providing many of the '11+' tests used by a number of local authorities in the process of selection for grammar school entry.
5. Alpha-Tek Associates Limited is a company owned and controlled by a Mr Amit Matalia. The business of Mr Matalia and Alpha-Tek seems to lie in the provision of educational materials.
6. In January 2013 the University discovered the existence of a web-site under the name **cem11plus.co.uk** registered in Mr Matalia's name. The use of the letters CEM in the context of this web-site was a reference to the University's Centre for Evaluation and Monitoring. Thus, the web-site included the following statements:

*'CEM is the Centre for Evaluation and Monitoring at the University of Durham'*

*'CEM is one of the largest independent providers of educational assessment and monitoring systems in the world and sets 11-plus tests for various English grammar schools and regions, including Bexley, Birmingham, Buckinghamshire, CCHS (Essex), Henrietta Barnet, Shropshire, Walsall, Warwickshire and Wolverhampton.'*

*'Past CEM 11-plus papers are not released and cannot be purchased. Usually, two weeks before the test, applicants receive a sample sheet containing example questions.'*

7. The web-site also contained pages with sample 11+ questions headed:

*'CEM 11+*

*CEM is the Centre for Evaluation and Monitoring at the University of Durham'*

These questions included actual sample questions which had been provided by CEM in the past and in which the University claims copyright.

8. A disclaimer appeared at the end of the sample questions, as follows:

*'The Centre for Evaluation and Monitoring is an independent not-for-profit research group based at Durham University and neither are associated with cem11plus.co.uk. The views expressed are those of cem11plus.co.uk. All tradenames and trademarks are acknowledged.'*

Another disclaimer stated:

*'The copyright of these sample questions belong to CEM. ©2008-2012. They may be used for personal use only. All tradenames and trademarks acknowledged.'*

9. As the Hearing Officer remarked, it appears that this web-site was not offering anything for sale, but was being used to promote Mr Matalia's other business interests. This seems to have included the sale of mock 11+ papers.

10. Not surprisingly, the University was not impressed by Mr Matalia's use of their copyright material without consent, nor his adoption of **cem11plus.co.uk** (and also **cem11plus.com**) as domain names. No amicable resolution was achieved, and the University ultimately brought proceedings before Nominet and UDRP (the organisations which administer the .uk and .com top level domains). These proceedings were successful and the domain names were duly transferred to the University at the end of 2013.
11. On 8<sup>th</sup> February 2013 (probably prompted by the impending dispute with Mr Matalia), the University applied to register **CEM** as a trade mark for a range of services in classes 41 and 42. I shall refer to this as 'the CEM mark'. The CEM mark was granted under no. 2654219 on 2<sup>nd</sup> August 2013.
12. On 14 May 2014, Mr Matalia (operating though his company Alpha-Tek) applied to register **CEM 11+** and **CEM 11 Plus** as a series of 2 marks for printed matter and publications in class 16, electronically readable publications in class 9 and various educational services including the provision of mock tests and study material in class 41. I shall refer to these as 'Alpha-Tek's CEM 11+ applications'.
13. On 31 May 2014, the University also applied to register **CEM 11+** and **CEM 11 Plus** for the same range of services as the CEM mark in classes 41 and 42, together with a range of goods in class 16. I shall refer to these as 'the University's CEM 11+ applications'.
14. The final act was the application by Alpha-Tek for the mark



for the same goods and services as Alpha-Tek's CEM 11+ applications, together with the addition of computer software in class 9. I shall refer to this as 'Alpha-Tek's CEM 11+ device application.'

15. The upshot of all this was the following series of proceedings which all came on for hearing together before the Hearing Officer:
  - (i) Mr Matalia's application for a declaration of invalidity in relation to the CEM mark;
  - (ii) Alpha-Tek's opposition to the University's CEM 11+ applications;
  - (iii) The University's opposition to Alpha-Tek's CEM 11+ applications;
  - (iv) The University's opposition to Alpha-Tek's CEM 11+ device application.
  
16. Mr James rejected Mr Matalia's application and Alpha-Tek's opposition. He upheld both of the University's oppositions. All those decisions are under appeal before me. Like Mr James, I consider it sensible to deal with the challenge to the University's CEM mark first.

Application for declaration of invalidity of the CEM mark

17. The mark was challenged by Mr Matalia on the following grounds:
  - (i) s3(1)(d) (the mark consists exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practice of the trade')
  - (ii) s3(1)(b) (the mark was devoid of distinctive character)
  - (iii) s3(6) (the mark was applied for in bad faith) and
  - (iv) s5(4)(a) (the use of the mark at the relevant date [February 2013] could have been prevented by Mr Matalia on the grounds of passing off).

18. Each of these challenges was rejected by Mr James. Each of them is maintained in this appeal. I shall take them in turn.

*s3(1)(d)*

19. Mr Matalia claims that as of February 2013 the term CEM had become customary in the current language of the relevant trade (here the trade in the services in classes 41 and 42 for which the mark had been registered) and therefore ought not to have been registered.
20. The scope of the s3(1)(d) objection was considered by the CJEU in Merz & Krell (C-517/99). The Court made clear that s3(1)(d) [Article 3(1)(d) of the Directive] is part of the overall scheme of the Directive seeking to permit only the registration of signs which can fulfill the proper function of a trade mark – namely guaranteeing the origin of the goods or services to which the mark is applied. The objection must be construed with that purpose in mind. They further clarified the scope of the objection by concluding that the role of the court confronted with a s3(1)(d) objection was to determine whether the signs or indications had become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by the mark.
21. The objection obviously extends beyond signs which are actually descriptive of some particular quality or characteristic of a product or service (in which case they would be likely to be objectionable under s3(1)(c) in any event). It covers any sign which is so widely used in the field in question as a means of designation of particular goods or services that it cannot serve to identify goods or services as coming from any individual trader. The Registry Work Manual gives some good examples – the use of a bunch of grapes for wine, or a representation of a spanner for car repair services.

22. In the present case, as argued before Mr James, Mr Matalia's argument that CEM had become 'customary in the current language of the trade' was primarily based on the use of the same acronym by the College of Estate Management, an institution specializing in vocational education of those involved in the property and construction business. Mr James rejected this argument on the basis that use by a third party of the same sign as a trade mark was irrelevant to a s3(1)(d) objection. He cited the decision of Floyd J in Nude Brands v Stella McCartney [2009] EWHC 2154 to this effect at para 29:

*'Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly does not go as far as establishing ground 7(1)(d) – customary indication in trade....'*

23. On appeal, Mr Bragiel sought to challenge Mr James' reliance on Nude Brands, pointing out that it was an interim injunction case and the law had not been considered in any detail. This is certainly true, but it is in my view perfectly clear as a matter of law that Floyd J's interim conclusion was correct. The fact that another trader has adopted the same sign as a trade mark cannot even begin to establish that it has become 'customary in the trade'. If anything it tends to point the other way because one may assume that the trader thinks it can function as a useful way of distinguishing his or her services, as opposed simply to designating the services themselves. If the sign was an established way of designating the services generically, then it would not be much use as a trade mark.
24. The other point made by Mr Bragiel concerned Mr Matalia's evidence of a screenshot taken from a website called acronymfinder.com which

included a number of entries for 'CEM' including 'Cyprus Educational Mission' and 'Columbus Electronic Musicians'. Mr James had dealt with this in his Decision by pointing out that the website was undated, the source of the compilation was unknown and that there was no evidence corroborating the existence of any of the entities referred to.

25. Mr Bragiel sought to persuade me that Mr James should have placed more reliance on [acronymfinder.com](http://acronymfinder.com) but I am at a loss to understand why he should have done so. Given the absence of any evidence of how or when the entries had been discovered or compiled, or indeed any evidence linking the entries to the United Kingdom, I cannot see how any tribunal could reasonably be expected to have taken it into account. But even leaving that point aside, I do not see how this evidence could have helped Mr Matalia's case anyway. At best, the entries on [acronymfinder](http://acronymfinder.com) would simply establish the unsurprising fact there are a number of bodies in the world with a name whose initials are CEM, and that those initials may be used as shorthand to refer to them. This in no way establishes that the sign CEM has become 'customary' in any particular trade to designate goods or services, such that it cannot perform its function as a trade mark, whether in the UK or anywhere else. *A fortiori* if one is only considering the trade in the services covered by the CEM mark.

26. I therefore reject the attack on Mr James' decision under s3(1)(d).

s3(1)(b)

27. The s3(1)(b) objection seems to have been founded on the same evidence as the s3(1)(d) objection. It is argued that because of the 'widespread' use of CEM it simply cannot serve to distinguish the goods or services of one undertaking from those of another, thus making it devoid of distinctive character.



28. Once again it is hard to understand the basis for this objection from the evidence which was filed. Even if one takes a generous view and is prepared to rely on the [acronymfinder.com](http://acronymfinder.com) entry as establishing that there are a number of traders in the world using CEM as shorthand for their full names, this does not mean that the sign is devoid of distinctive character. As Floyd J put it pithily in Nude Brands

*'Ground 7(1)(b) is concerned with the inherent character of the mark, not what other traders have done with it. The traders in question are plainly using the mark as a brand name...'*

29. The same applies here. If the evidence shows anything, it is that traders in a variety of fields consider that the sign CEM is perfectly capable of distinguishing their services or products from those of other people in the marketplace.

s5(4)(a)

30. The s5(4)(a) objection required Mr Matalia to demonstrate that he had established sufficient goodwill in the name CEM that he had the right to prevent the University from using that name in relation to the goods and services for which it was applied in February 2013, notwithstanding that the University had established its own goodwill in the name through its use on a substantial scale from at least 1996.

31. This allegation was in my view always hopeless. As I have pointed out at the beginning of this Decision, Mr Matalia himself stated on his website in February 2013 that the name CEM belonged to the University. In the light of this contemporaneous acknowledgement, it is extraordinary that he should now be claiming that they were in fact passing themselves off as his business. It is still more extraordinary when one considers the feeble nature of Mr Matalia's evidence that CEM was distinctive of him. This comprised (i) an MS-DOS screen shot

apparently with instructions to install a floppy disc with software called 'MEDI-QUEST CEM' and 'MEDI-CASE CEM' dating from 1991 (software said to relate to the pharmacy business); (ii) a screenshot from 2011 or later containing the phrase 'continuing educational material (CEM)'; (iii) screenshots from two other websites controlled by Mr Matalia of uncertain date which appear to use the sign CEM to refer to 'children's educational material'. I see nothing in this evidence which comes close to establishing that Mr Matalia had established any business goodwill in relevant field associated with the sign CEM as at February 2013. Mr James was plainly right to reject the objection under s5(4)(a).

s3(6)

32. Finally, Mr Matalia claims that the CEM mark was applied for in bad faith and is therefore objectionable under s3(6) of the Act. Specifically, he claims that the scope of the goods and services for which the mark was applied extends beyond those for which the University had either used or intended to use the mark at the date of application.
33. The basis for an objection under s3(6) of the Act on the basis of lack of use or intention to use is s32(3) of the Trade Marks Act 1994:  
  
*'The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services [the goods or services in relation to which it is sought to register the mark] or that he has a bona fide intention that it should so be used.'*
34. The statement required by this sub-section is contained in box 13 on Form TM3 which is the form by which a UK trade mark application must be made. The declaration of intent must be signed by the applicant.

35. As Jacob J put it in Laboratoire de la Mer [2002] FSR 51 at 19 (though it was not directly in issue in that case):

*'If that statement is untrue then it seems fairly plain that the registration is vulnerable to an attack as one made in bad faith...'*

36. There has been discussion both in case law and academically as to whether the requirement of s32(3) and the consequent indirect introduction of a 'lack of intention to use' objection to trade mark applications is consistent with the Trade Marks Directive. No such requirement explicitly exists under the Directive, and none has been incorporated into the Trade Marks Regulation governing applications for Community Trade Marks. It is possible that s32(3) may ultimately be found incompatible with the Directive, if a reference were to be made on this issue to the Court of Justice. It is also possible, as Arnold J pointed out in his thorough account of this area in Red Bull GmbH v Sun Mark Limited [2012] EWHC 1929 (the whole section between paras 139 and 160 should be read) that the Directive must or can itself be read as requiring some form of intention to use.

37. For the purpose of this appeal it is not necessary to delve any further into these complex issues. It is necessary simply to identify three well-established principles of UK law as it has developed in this area, in relation to the objection of bad faith generally and in relation to the specific question of 'intention to use':

- (i) Bad faith requires dishonesty or at least dealings falling short of the standards of acceptable commercial behavior observed by reasonable and experienced men in the particular area being examined [Gromax v Don & Low [1999] RPC 367 at 379, approved many times in the UK, and generally considered consistent with the approach to bad faith taken by the Court of Justice]

- (ii) A person is presumed to have acted in good faith unless the contrary is proved. An application of bad faith is a serious allegation which must be distinctly proved by cogent evidence. It is not enough to prove facts which are also consistent with good faith. [Red Bull para 133 and the cases there cited].
- (iii) Intention to use, so far as s32(3) (and the law of bad faith) is concerned, may include a '*possible or contingent use at some future date*' (depending on all the circumstances). [Red Bull para 163, citing Neuberger J in Knoll AG's Trade Mark [2003] RPC 10 and the Court of Appeal in 32Red [2012] EWCA Civ 19.]
38. In the present case, it is not suggested by Mr Matalia that the University did not intend to use the trade mark at all. Indeed, it is common ground that they had been using it on a substantial scale in relation to various educational services provided by the University through the Centre for Evaluation and Monitoring including the provision of 11+ papers since long before the application was made. Rather Mr Matalia simply asserts that the scope of the services for which the CEM mark was applied for extends beyond those for which the University had used the mark or intended to use it in the future.
39. Before me Mr Bragiel primarily relied on the fact that the CEM mark had been applied for in relation to services which had not yet been provided by the University and yet the University had chosen to put in no evidence as to its intention to use the mark in respect of those services.
40. It seems to me that this argument is essentially seeking to reverse the burden of proof in a case of this nature. Unless and until a cogent and compelling case is put forward by the party alleging bad faith which amounts to a *prima facie* case that there was no intention to use, there

is no reason why the proprietor should be expected to advance positive evidence of such an intention. As I have noted above at para 37(ii), the law is clear that the burden is on the applicant for invalidity and the burden is a heavy one. Having signed the TM3 with its accompanying declaration, the proprietor has stated its intention and the tribunal will presume in the first instance that this was done *bona fide*.

41. It is of course possible for the burden to be shifted if an applicant for revocation can point to particular facts or circumstances which are plainly inconsistent with an intention to use across the whole scope of the application. For example the applicant might have gone on record stating that it does not have any intention in the foreseeable future of ever entering a particular field or of licensing the use of its trade mark in that field. I would also suppose that a *prima facie* case of bad faith might be made out against a small trader in a limited area of business who had applied to register its mark across an unfeasibly wide range of goods and services in almost every single class. However, unless such facts or circumstances are identified, the proprietor is in my view under no obligation to 'prove' its intentions.
42. Mr Bragiel relied on three matters as supporting his case on lack of intention to use.
  - (i) The class 41 services include '*teaching tuition and examining in connection with the provision of education*'. In his skeleton argument Mr Bragiel alleged that the University had a '*well known and publicised policy*' of not providing such services. At the Hearing it became clear that this was a reference to the evidence from the University, recorded by Mr James at para 14 that '*It is the University's policy not to make any legitimate practice materials available to the public commercially*'. The purpose of this is to try to ensure a 'level playing field' for

children facing the 11+, with no advantage provided by excessive preparation (although some limited sample questions are in fact provided by them to schools, as stated on Mr Matalia's own website).

I do not understand the relevance of this policy to the question of intention to use in relation to the particular services identified by Mr Bragiel. Those services are far wider than simply the provision of practice materials on a commercial basis to the public. The policy would therefore not exclude the offer of services under the mark within the scope of that part of the specification.

- (ii) Mr Bragiel's second point concerned the services in class 42. He relied on a response given by the University to a Freedom of Information Request filed on behalf of Mr Matalia asking, in relation to all those services whether they had supplied any of them under the CEM mark or intended to do so within the next 5 years. The response which was obtained stated as follows:

*'Yes – CEM, IBE, MidYIS, Yellis, InCAS, Assessment for Excellence, IPIPS, CHM entrance tests, associated information provision, advisory services and consultation. In terms of future plans, information not held.'*

Mr Bragiel asserted that this response was *'tantamount to an admission'* that there was no intention to use across the scope of the specification, or particularly in relation to the design and development of computer hardware, software, websites etc. I do not agree. First of all, I do not know and no-one has explained in the evidence what 'IBE, MidYIS, Yellis' etc. are. Assuming that they are educational schemes of some kind, they

may well comprise or include the use of computer programs written or maintained by the University and/or have associated websites which the University maintains. Secondly, the reply says nothing about intention. The statement *'In terms of future plans, information not held'* is in no way inconsistent with the existence of such future plans, whether contingent or otherwise, which would include the use of the mark across the full scope of the specification. The reference to the holding of information would appear to be a reference to the kind of recorded data which is accessible under the Freedom of Information legislation.

- (iii) Finally, Mr Bragiel relied on the fact that Mr James had himself *'wondered whether the University had a real intention to use the mark in relation to all the services covered by the registration, particularly the services in class 42.'* Again, I do not understand the point here. Any fact-finding tribunal will naturally 'wonder'. But it must apply the rules of evidence. Here, as Mr James went on to explain, the burden was firmly on the applicant for revocation, and no *prima facie* case was made out.

43. I therefore reject the case based on s3(6). Each of the objections to the CEM mark fail, and I thus uphold the Hearing Officer's finding that the University's CEM mark is valid.

#### The University's Opposition to Alpha-Tek's CEM 11+ applications

44. I turn next to the University's Opposition to Alpha-Tek's CEM 11+ applications which it will be recalled were for a range of goods and services in classes 9, 16 and 41. Mr James upheld that Opposition under s5(2)(b), based on likelihood of confusion with the CEM mark.

45. I should stress at this point the limited role for an Appellate Court when dealing with a decision under s5(2)(b). The Courts have repeatedly emphasised that the scope for appeals from decisions of experienced first instance tribunals on questions of degree involving a 'multifactorial assessment' is limited. The issue of 'likelihood of confusion' is a paradigm example of such a question (others include negligence and issues of unreasonable behavior).
46. In Digipos Store Solutions Group Limited v Digi International Inc [2008] RPC 24 at [5]-[6], Daniel Alexander QC sitting as the Appointed Person explained the approach to be taken as follows:

*5. It is clear from Reef Trade Mark [2003] RPC 5 ('Reef') and BUD Trade Mark [2003] RPC 25 ('BUD') that neither surprise at a Hearing Officer's conclusion nor a belief that he has reached the wrong decision suffice to justify interference by this Court. Before that is warranted, it is necessary for this court to be satisfied that there is a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong (Reef). As Robert Walker LJ (as he then was) said:*

*'an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle' (Reef para 28)'*

*6. This was reinforced in BUD where the Court of Appeal made it clear that it preferred the approach of the appellate judge but nonetheless held that there was no error of principle justifying departure from the Hearing Officer's decision. As Lord Hoffmann said in Biogen v Medeva [1997] RPC 1 at 45, appellate review of nuanced assessments requires an appellate court to be very cautious in differing from a judge's evaluation. In the context of appeals from the Registrar relating to*



*section 5(2)(b) of the Act, alleged errors that consist of wrongly assessing similarities between marks, attributing too much or too little discernment to the average consumer or giving too much or too little weight to certain factors in the multi-factorial global assessment are not errors of principle warranting interference.'*

47. This approach has consistently been applied by the Appointed Persons on appeal from Hearing Officers and it was not challenged by Mr Bragiel.
48. In the present case, Mr James took a careful and structured approach to the question of likelihood of confusion. He first reminded himself of the well-known set of 11 principles of law established by the Court of Justice and approved by the UK Courts in a number of cases up to the Court of Appeal. He went on to remind himself of the various further points recently made by the Court of Appeal in Roger Maier v ASOS [201] EWCA Civ 220 at 78 and 84, specifically (i) that the tribunal was concerned with the mark as registered, not on other material (ii) that the test involved considering notional and fair use of the registered mark in relation to all the goods and services for which it was registered [though for unused goods and services the mark may be less distinctive] (iii) the role of the evidence of actual confusion [or the lack of such evidence].
49. He then compared the goods and services of the two marks. He concluded that the class 41 services for which Alpha-Tek were applying were identical with the class 41 services for which the University's CEM mark was registered, and the class 9 and 16 goods were similar to a high degree (since they covered printed publications for use with the services for which the CEM mark was registered).
50. Having identified the average consumer and the nature of the purchasing process, he then compared the marks, noting that there

was a high level of visual and aural similarity between them, although recognizing a *'low level of conceptual dissimilarity'* due to the presence of the descriptive 11+ reference in Alpha-Tek's marks. Overall he considered that the marks were 'highly similar'.

51. Turning to distinctive character, he considered that the CEM mark itself had a normal or average level of distinctive character, but that this had been enhanced through substantial use made of it by the University before the relevant date. The significance of that use had of course been recognised by Mr Matalia's own website at the time.
52. Having done that analysis, Mr James considered the likelihood of confusion. He held that confusion was likely, noting in particular that the only distinguishing feature, namely the term '11+' or '11 plus', was highly descriptive of services and goods falling within the scope of the registration – 11+ tests and practice papers, and services relating to such tests.
53. He also concluded for the avoidance of doubt that he would have reached the same conclusions even if he had found that the University's marks had not acquired an enhanced level of distinctiveness through use.
54. I have struggled to identify any ground of appeal relied on by Alpha-Tek which could properly be said to amount to an error of principle, or indeed begins to convince me that Mr James' decision might have been wrong. On the contrary, I find it hard to imagine how a competent and experienced tribunal could have reached a different conclusion in this case.
55. I shall attempt to summarise the points that were made by Mr Bragiel below:

- (i) He said that Mr James ought not (in the light of the evidence about the existence of other users of the letters CEM) have found that the mark had an above average level of inherent distinctive character.

First of all, as I read his Decision, Mr James did not make such a finding. He found that the level of inherent distinctive character of the mark was average or normal. Secondly, as I have already noted, the evidence of other users of CEM was very weak and was insufficient to support any suggestion that it might affect the inherent distinctiveness of the mark, particularly in the specific fields of trade in which the mark was registered.

- (ii) He disputed the basis for Mr James' finding that the mark had acquired an above average level of distinctiveness through use, relying on the fact that this use had been as an acronym for the full name of the Department – the Centre for Evaluation and Monitoring. I do not really see how the fact that a mark is known to be an acronym for a full name makes it any less distinctive. I can see no reason on the evidence to doubt Mr James' conclusion that the letters CEM had become highly distinctive of the University's educational business through use. Furthermore, as already noted, Mr James stated that his conclusion would have been the same even without this finding.

- (iii) He contended that Mr James should have taken into account the lack of evidence of actual confusion with the business of Mr Matalia (or Alpha-Tek). But I was not taken to any evidence demonstrating that either of them had made sufficiently substantial use of the mark CEM 11+ for the absence of evidence of confusion to be significant. Numerous cases, including Roger Maier, cited above, have stressed the need to

be careful about drawing conclusions from the absence of evidence of confusion. It is not surprising therefore that Mr James did not draw any such conclusion in the present case.

- (iv) He alleged that Mr James had failed to take into account the high degree of care which would be taken when purchasing the goods and services in issue. This is not in fact correct. Mr James noted at para 96 of his Decision that the likely users of the services covered by the marks would pay an '*above average level of attention*'.
- (v) He said that Mr James should have taken into account the fact that the goods and services covered by the registrations were at opposite ends of the price spectrum. I do not understand this. As Mr James held, the services were identical, and the goods which were the subject of the Alpha-Tek application would be used with the services of the University's mark. We are of course concerned with 'notional and fair use' here, not the actual nature of goods and services provided by the parties in real life, let alone the prices charged by the parties.
- (vi) He said that the average consumer would be well aware that the University had a well-established policy of not providing 'most of' the services covered by the Alpha-Tek mark in class 41. This argument came back to the point (mentioned above) that the University does not supply practice materials commercially to the general public. At the hearing, this was generalized out into an assertion that the University did not supply practice materials to anyone, including education professionals. However, that assertion was not supported by the evidence, and indeed was inconsistent with Mr Matalia's own website. In any event, whatever the University's present policy, I do not see its relevance to this case. First of all, Alpha-

Tek's application is not limited to the supply of practice materials to the general public, and the University's mark plainly covers such supply. Secondly, there is no reason to believe that the average consumer of the goods and services in question can be taken to be aware of the precise policy adopted by the University. Thirdly, I cannot see how possession of this knowledge would actually reduce the likelihood of confusion between the marks.

- (vii) He contended that the Hearing Officer was wrong to find that the term 11+ was a '*weak distinguishing element*'. The argument was that the term 11+ was somewhat obscure. I disagree. Whilst the test itself is presently in use only by a limited number of education authorities and schools, the term 11+ is commonly used in political discourse, by newspapers and on the television. The debate about the merits of selective education is very much alive. I thus believe that the term would be well known to most people as descriptive of the selective test taken to allocate grammar school places. I note in passing the striking discrepancy between Mr Bragiel's submission that the average consumer would not have heard of the 11+ and the submission referred to above that the average consumer would be aware of the precise policy of the University on making 11+ papers available to the public.

56. I therefore uphold Mr James' decision to refuse the Alpha-Tek CEM 11+ applications under s5(2)(a) based on the CEM mark. It is therefore unnecessary for me to deal with Alpha-Tek's appeal against his decision under s5(2)(a) based on another (device) mark held by the University.

Alpha-Tek's Opposition to the University's CEM 11+ applications

57. Obviously, the rejection of the appeal against the successful Oppositions to Alpha-Tek's CEM 11+ applications means that these cannot be relied on in Opposition to the University's CEM 11+ applications.
58. However, Alpha-Tek maintains an independent attack on the University's CEM 11+ applications on the ground of bad faith under s3(6). This is essentially based on the same argument which I have already rejected in the case of the CEM mark. However, Mr Bragiel urges on me that the argument is stronger in respect of these applications because they are broader in scope, extending to goods in class 16, namely printed materials and other associated goods.
59. To my mind, the addition of another class, which includes a number of goods which one would expect a University department to create and issue to the public, particularly a department engaged in the provision of examination materials, is not an indicator of bad faith. I therefore reject the bad faith objection on the same basis as I rejected the bad faith objection to the CEM mark.

#### The University's Opposition to Alpha-Tek's CEM 11+ Device Mark

60. Finally I turn to the appeal against Mr James' finding that the final application made by Alpha-Tek, for the device mark including the green 'tick', was also invalid under s5(2)(b).
61. Whilst it is true to say that this mark is less similar to the CEM mark than is the case with Alpha-Tek's CEM 11+ applications, this is merely through the addition of the generic and hackneyed device of a tick, together with some text written in tiny writing underneath ('children's educational material for the 11+'). Neither feature adds very much distinctive character to the mark, and the primary message of the mark remains CEM 11+. It is therefore hardly surprising

therefore that the Hearing Officer reached the same decision on this Opposition as he had on the Oppositions to Alpha-Tek's CEM 11+ applications.

62. No particular error of principle in this decision has been identified and I see no basis upon which to overturn it. For the avoidance of doubt, having considered the evidence, I would certainly have reached the same decision myself.

### Conclusion and costs

63. I therefore uphold all the decisions of the Hearing Officer.
64. So far as costs are concerned, the University represented itself. In fact it chose to take no formal steps in the Appeal, including not serving any skeleton argument on the basis that they were supporting the reasons given by Mr James. However, it clearly had to read and understand the documents filed on behalf of the Appellants and it sent an observer to the hearing.
65. I note that Mr James received separate submissions following his Decision as to costs. He ultimately ordered payment of about ½ of the sums which would have been payable on the usual scale had the University instructed legal representatives. This came to £2250.
66. Neither party sought to address me on costs. However, given the small amount of money at stake so far as the Respondent's costs of the Appeal are concerned, I think it would be disproportionate to call for such submissions at this stage. Taking a common sense view, I will order that the Appellant pays the Respondent the sum of £300 in costs, on the rough and ready basis of 10 hours employee time for reading and considering the documents and attending Court (at the

rate of £20 per hour which Mr James considered reasonable) plus  
£100 travel expenses.

**IAIN PURVIS QC  
THE APPOINTED PERSON**

**30 September 2016**