O/516/20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 3220699
IN THE NAME OF CAMBRIDGE SPARK LIMITED

AND IN THE MATTER OF OPPOSITION No. 409694 THERETO
BY THE CHANCELLOR, MASTERS AND SCHOLARS OF THE UNIVERSITY OF CAMBRIDGE

AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE OPPONENT
AGAINST A DECISION OF MR GW SALTHOUSE
DATED 9 JANUARY 2020

DECISION

Introduction

1. This is an appeal by The Chancellor, Masters and Scholars of the University of Cambridge ("the Opponent") against a decision by Mr George W Salthouse, acting for the Registrar, dated 9 January 2020 (BL O/011/20) in which he rejected the opposition brought by the Opponent against Application number 3220699 standing in the name of Cambridge Spark Limited ("the Applicant").

2. Application number 3220699 was filed by the Applicant on 23 March 2017 requesting registration of the designation represented below for use as a trade mark in the UK:

CAMBRIDGE SPARK

3. The goods and services for which registration was requested were:

Class 9
Training software; Training manuals in the form of a computer program; Training guides in electronic format; Training manuals in electronic format

Class 41
Education and training consultancy; Arranging and conducting of educational discussion groups, not on-line; Arranging and conducting of competitions [education or entertainment]; Academies [education]; Academy services (Education -); Academy

education services; Arranging and conducting of educational courses; Arranging and conducting of educational events; Arrangement of conventions for educational purposes; Education and training services; Arranging and conducting educational conferences; Education in the field of data processing; Arrangement of seminars for educational purposes; Education services relating to vocational training; Education services relating to computer systems; Arranging and conducting of educational seminars; Adult education services; Advisory services relating to education; Education in the field of computing; Education in the field of computing science; Education, teaching and training; Education services relating to the application of computer software; Arrangement of conferences for educational purposes

4. The Application was published for opposition purposes in the Trade Marks Journal dated 7 April 2017.

5. On 5 July 2017, the Opponent filed Notice of opposition and statement of grounds against the Application under Section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994, which stated:

> "**5.** - (2) A trade mark shall not be registered if because –
>
> […]
>
> (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.
>
> (3) A trade mark which –
>
> (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC) in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.
>
> (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade …"

6. The earlier trade marks relied upon by the Opponent for the purposes of Section 5(2)(b) and 5(3) included the following that were not subject to proof of use:

Number	**Mark**	**Filing/registration date**	**Classes of goods/services**

UK 3015609	CAMBRIDGE	26.07.13/04.09.15	9,16, 41
EU 12019733	CAMBRIDGE	26.07.13/29.08.15	9, 16, 41
UK 3015696	CAMBRIDGE	29.07.13/18.07.14	9

7. In respect of Section 5(4)(a), the Opponent relied on use of CAMBRIDGE since the thirteenth century in respect of education and printing.

8. The Applicant took issue with the grounds of opposition in a Notice of defence and counterstatement dated 10 January 2019.

9. Both parties filed evidence and the opposition came to be heard by Mr Salthouse on 19 September 2019. At that hearing Mr Christian Bunke and Mr Simon Reeves appeared for the Applicant; Mr Julius Stobbs of Stobbs IP Limited appeared for the Opponent.

Hearing Officer's decision

Section 5(2)(b)

10. The Hearing Officer would be guided by the Registrar's usual summary of applicable principles gleaned from the case law of the Court of Justice of the European Union ("CJEU") (para. 20).

11. The average consumer was the general public including businesses (para. 23). The average consumer would pay an above average degree of attention when selecting the goods and services at issue:

> "23) … I accept that, for the most part, the cost of the goods and services will vary considerably, but bearing in mind that the average consumer will wish to ensure they are selecting the correct type of software/manual or training course in terms of detail and level of training and in particular the subject matter, particularly in more specialised subjects or topics, they will pay an above average level of attention when selecting the goods so as to ensure they meet their criteria for personal improvement. An employer selecting training goods or courses for use by its employees is, if anything, likely to pay an even higher level of attention so as to meet its obligations to ensure that its employees have the requisite skills or can improve their existing skills, thus boosting their worth to the employer…"

12. The goods in Class 9 such as training manuals and software would be sold via retail outlets, catalogues and on-line. The purchase would primarily be visual but might involve discussions with staff in, for example, some book stores (para. 24).

13. Training courses, seminars, conferences and so on in Class 41 were likely to be selected from brochures and on-line, and in person at premises such as colleges and universities. The initial selection process would predominantly be visual but aural considerations would play a greater role in the overall purchase:

> "24) … Simpler more straightforward courses and events will be self-selected and booked on-line or by phone with little if any discussion with the provider. However, more complex courses will require a discussion to determine if the course suits the person and vice versa …"

14. The goods and services at issue were identical[1] (paras. 35 and 37).

15. The overall perceptions of the marks in the minds of the relevant public were paramount in the assessment of the visual, aural, and conceptual similarities between the marks (Case C-251/95, *Sabel BV v. Puma AG* [1997] ECR I-6191, para. 23, Case C-591/12P, *Bimbo SA v. OHIM* EU:C:2014:305, para. 34) (para. 38).

16. The trade marks to be compared were:

Opponent's trade marks	**Applicant's trade mark**
CAMBRIDGE	

17. There was a low degree of visual similarity in the marks:

> "44) Visually the applicant's mark starts with a logo device. Although the applicant has accepted that it consists of the letters "C" and "S" to my mind, this is not apparent when one first encounters the mark. The letters are highly stylised and almost intertwined, with a large amount of shading such that it, at first glance, appears to be a geometric device. Clearly, both marks have the word "cambridge" within them, but the applicant's mark also has the word "spark" as its final element. Despite the opponent's whole mark appearing in the applicant's mark there are significant visual differences between the marks such that they have only a low degree of visual similarity."

18. The marks were phonetically similar to a medium degree:

> "45) The device element of the applicant's mark, even if it is seen as the letters "CS" would not in my view be pronounced. Aurally the marks are "Cambridge spark" and "Cambridge". There is initial identity with a difference in that the applicant's mark has an additional word …"

19. On conceptual similarity, the Hearing Officer had been referred to *NEWPORT CREEK Trade Mark*, BL O/223/16, where the Appointed Person held that there was neither a low (as found by the Hearing Officer in that case) nor high but a medium degree of conceptual similarity between NEWPORT on the one hand and NEWPORT CREEK on the other hand because of the possibility that with the latter the consumer would perceive the creek to be situated in Newport (para. 46).

[1] The Applicant put forward revised specifications in Classes 9 and 41 as "back-stops" after the hearing. The Hearing Officer found that the wordings of both were open to criticism and even if accepted would make no difference because the goods/services remained identical. He therefore rejected the revisions and proceeded on the basis of the specifications as originally filed (see para. 3 above).

20. In the present case, however, the marks were not conceptually similar:

> "47) The opponent's mark consists of the single word "Cambridge" which is both the name of a city and is also the name of the county. Whilst technically it is Cambridgeshire it is common for county names to be shortened such as Glamorgan rather than Glamorganshire. It will therefore be seen as a geographical location, clearly alluding to the location of the provider. However, as the opponent has claimed it is well known as a university city and a seat of learning. I do not accept the entirety of the opponent's claims regarding reputation but to this limited extent I do. The applicant's mark consists of two words "Cambridge spark" and a logo. Whilst the logo is a highly stylised version of the letters "c" and "s" it will as the opponent claims reinforce the name of the applicant. To my mind, the two words form a unit in that it is clear that the "spark" or clever person is from Cambridge, or that the flash of inspiration is Cambridge based. Whichever way the consumer considers the applicant's mark it is clear that it refers to a specific person or idea from Cambridge, rather than giving an image of the city or county. Although both originate from the same geographical location the applicant's mark has a different overall conceptual message from that of the opponent. In respect of the type of goods and services concerned in the instant case the term "Cambridge" is not distinctive as it is well known that a number of research bodies, not all linked to the university, are based there. The average consumer will not know that the research bodies that are connected to the university but do not have the word "Cambridge" within their title (see exhibit CD3 and paragraph 7 above). Conceptually they are not similar."

21. Overall, there was a low degree of similarity between the marks (para. 49).

22. The earlier trade marks CAMBRIDGE had at least a low degree of inherent distinctive character, which had been enhanced through use in respect of graduate and post graduate education, the setting of examinations and assessment criteria, and publishing:

> "53) The opponent has provided evidence of its use and has made various claims regarding its reputation. Clearly, in respect of undergraduate and postgraduate studies and education the opponent has considerable world-wide reputation. It also has considerable reputation and use in respect of setting assessment and examinations for use by schools. But the opponent does not actually deliver the teaching in order to take the examinations. It does not provide teaching services to nursery, kinder-garden, primary or secondary school pupils. Whilst it may offer a limited amount of summer and other part time courses these will require participants to have more than a basic knowledge of the subject before being accepted onto the course. I do not consider that the opponent can claim to have a reputation in education, but only in graduate and post graduate education and the setting of examinations and assessment criteria. It is also clear that the opponent has used its mark extensively in respect of publishing. **As such the opponent can benefit from an enhanced degree of distinctives through use in relation to the**

"electronic publications, downloadable; printed publications in electronically readable form; examination and assessment" in class 9, the whole of its class 16 specification as registered and "providing of graduate and postgraduate education" in class 41."

23. Taking account of the above circumstances and the principles of interdependency and imperfect recollection there was no likelihood of confusion direct or indirect:

> "61) When a consumer is seeking training materials or a course for himself or employees care will be taken to ensure that it is the correct (in terms of subject and level) type of training and is compiled or carried out by a competent body with the necessary accreditation. Given the differences in the marks of the two parties and all the other factors outlined above, even allowing for the concept of imperfect recollection, there is no likelihood of consumers being confused, directly or indirectly, into believing that the goods and services applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it. **The opposition under Section 5(2)(b) therefore fails in respect of all the goods and services**."

24. The Hearing Officer had ignored in his global appreciation of likelihood of confusion, the Applicant's argument that *in fact* the parties traded in different spheres. The correct assessment was on the basis of the goods and services as registered versus the goods and services as applied for (para. 59).

Section 5(3)

25. The Hearing Officer would be guided by the Registrar's summary of applicable principles set down by the CJEU in relation to Section 5(3).

26. The Opponent had established that at the relevant date it had reputation in the UK in the trade mark CAMBRIDGE in respect of: "electronic publications, downloadable; printed publications in electronically readable form; examination and assessment" in class 9, the whole of its class 16 specification as registered and "providing of graduate and postgraduate education" in class 41." That reputation supported also for the purposes of Section 5(3) the Opponent's EU registration for CAMBRIDGE relied upon (Case C-125/14, *Iron & Smith kft v. Unilever NV* EU:C:2015:539) (para. 66).

27. The goods and services applied for were identical to those in respect of which the earlier trade marks had reputation with the exception of the consultancy services applied for, which were dissimilar (paras. 68 – 69). The respective trade marks were similar to a low degree (para. 69).

28. The Hearing Officer accepted that: "… use of the term "Cambridge" may bring to mind the opponent when they [consumers] see the goods and services of the applicant advertised." (para. 72).

29. Having considered the UK/EU case law on the need to establish the risk of one or more of the types of injury specified in Section 5(3) resulting through registration/use of the mark applied (paras. 73 – 76), the Hearing Officer concluded that neither unfair advantage nor detriment had been made out by the Opponent. The opposition under Section 5(3) failed:

> "77) It is clear from this judgment [*Argos Ltd v. Argos Systems Inc.*[2018] EWCA Civ 2211, Floyd LJ] that there would have been unfair advantage if the image of the ARGOS trade mark transferred to the goods/services provided by Argos Systems or if there was a likelihood of confusion, including indirect confusion. Earlier in this decision I determined that there would not be direct or indirect confusion between the marks. I do not believe that the "link" formed in the minds of applicant's consumers will affect their economic activity as the process of purchasing taring materials or courses will involve ascertaining the credentials of the supplier and thus reveal that the applicant is not connected to the opponent."
>
> 78) In the Argos case, having decided that the advantage gained was not unfair, the Court of Appeal decided that it did not need to consider whether the defendant had "due cause" to use the ARGOS.COM mark. I do not need to consider the submissions made regarding the *Kenzo* case subsequent to the hearing and filed without seeking my permission. **The ground of opposition under section 5(3) fails**."

Section 5(4)(a)

30. The Opponent had goodwill and reputation at the relevant date, 23 March 2017, in relation to the goods and services already mentioned (see para. 26 above). The Hearing Officer had already found that use of the trade mark applied for would not result in confusion with the Opponent's earlier trade marks:

> 82) "… Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. **The opposition under Section 5(4)(a) of the Act must fail**."

Costs

31. The Applicant had been successful. The Opponent would be ordered to pay the Applicant a contribution towards the Applicant's costs of defending the opposition in the sum of £2,000 (paras. 84 – 85).

The appeal

32. On 6 February 2020, the Opponent filed Notice of appeal to the Appointed Person under Section 76 of the Act against the Hearing Officer's decision.

33. The grounds of appeal were briefly as follows:

Against the decision under Section 5(2)(b)

1) The Hearing Officer erred in relation to his assessment of (a) the visual and (b) the conceptual similarity in the trade marks;

2) The Hearing Officer failed to differentiate between the various goods and services when attributing the level of attention paid by the average consumer to the purchase act;

3) The Hearing Officer made several errors in his assessment of the likelihood of confusion by: (1) taking into account: (a) the wrong degree of similarity in the marks; (b) the wrong level of care paid by the average consumer to the purchase act; and (c) that the consumer will check the provider of the course; and (2) failing to take into account: (d) the reputation of the Opponent; and (e) types of notional and fair use like advertising, referral use and use by recommendation.

Against the decision under Section 5(3)

4) The Hearing Officer erred in concluding that there would be no unfair advantage taken by the Applicant in using the mark applied for by finding that there can be: (a) no unfair advantage in the absence of confusion; and (b) no transfer of image in the absence of confusion; and (c) by failing to take account of the Opponent's reputation in overlapping fields.

Against the costs order

5) The Hearing Officer failed to factor in that the Applicant restricted its specifications after the hearing but before the decision

34. There was no appeal against the Hearing Officer's decision to reject the opposition under Section 5(4)(a).

35. The Applicant filed a Respondent's Notice on 5 March 2020 basically upholding the Hearing Officer's decision and putting arguments against the grounds of appeal.

36. At the hearing of the appeal, which was held by video conference, Mr Julius Stobbs of Stobbs appeared for the Opponent; Mr Christian Bunke of Basck Limited appeared for the Applicant.

Standard of review

37. It was accepted that the appeal is by way of review and not rehearing, and that I should be reluctant to interfere with the Hearing Officer's decision in the absence of an error of principle (*REEF Trade Mark* [2002] EWCA Civ 763, para. 28).

38. The applicable principles were summarised by Mr Daniel Alexander QC sitting as the Appointed Person in *TALK FOR LEARNING Trade Mark*, BL O/017/17 at paragraph 52, and reviewed more recently by Lord Hodge in *Actavis Group PTC v. Icos Corporation* [2019] UKSC 15, at paragraphs 78 – 81.

39. Mr Bunke referred me in particular to the following passage from the decision of Mr Iain Purvis QC sitting as the Appointed Person in *ROCHESTER Trade Mark*, BL O/049/17:

> "33. … the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:
>
> (i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a

> matter of judgment for the tribunal on the particular facts of each case
> (ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person
>
> (iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal
>
> (iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence …
>
> Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case."

40. Mr Bunke also relied on similar observations in *GREYBOX Trade Mark*, O/106/20, where the same Appointed Person rejected grounds of appeal against the Hearing Officer's decision under Section 5(2)(b), 5(3) and 5(4)(a) that Mr Bunke argued bore a "striking resemblance" to the grounds of appeal being argued in the present case.

Merits of the appeal

Section 5(2)(b)

Visual aspect

41. The first ground of appeal concerned the Hearing Officer's assessment of the visual similarity of the marks. The Opponent contended that he should have found the marks to be visually similar to a medium degree rather than his actual finding that there was a low degree of similarity in the marks.

42. It appeared to be suggested that the Hearing Officer erred in not recognising that the Opponent's earlier trade marks were for the word only mark CAMBRIDGE, and that the Hearing Officer somehow applied his comparison as if there were 2x figurative marks.

43. Further, it was argued that the only real visual difference in the trade marks was the addition of the logo "CS" in the CAMBRIDGE SPARK trade mark applied for, and since this merely reinforced the words CAMBRIDGE SPARK, the difference was visually minimal.

44. I reject these arguments. First, it is clear from the decision that the Hearing Officer recognised that CAMBRIDGE was a word only trade mark.

45. Second, it is well established that the consumer perceives trade marks overall and no element can be disregarded unless it is negligible in the trade mark in question:

> "21. The global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks at issue, must be based on the overall impression given by the marks, account being taken, in particular, of their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global assessment of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, to that effect, *SABEL* EU:C:1997:528, paragraph 23; *OHIM v Shaker* EU:C:2007:333, paragraph 35; and *Nestlé v OHIM* EU:C:2007:539, paragraph 34).
>
> 22. The assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole (*OHIM v Shaker* EU:C:2007:333, paragraph 41).
>
> 23. The overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*OHIM v Shaker* EU:C:2007:333, paragraphs 41 and 42, and *Nestlé v OHIM* EU:C:2007:539, paragraphs 42 and 43 and the case-law cited)." (Case C-591/12 P, *Bimbo SA v. OHIM* EU:C:2014:305)

46. Third, it was not and could not have been suggested that either the logo or indeed SPARK elements were negligible in the trade mark applied for.

47. Fourth, whilst acknowledging that the Applicant had admitted that the logo comprised the letters "C" and "S" he did not think this would be immediately apparent on first encounter:

> "44. … The letters are highly stylised and almost entwined, with a large amount of shading such that it, at first glance, appears to be a geometric device …"

48. This was a matter for evaluation by the Hearing Officer and in fact I agree with his analysis.

49. Fifth in sum I see nothing wrong with the Hearing Officer's estimation of the degree of visual similarity in the marks being at a low degree.

Average consumer

50. The second ground of appeal related to the Hearing Officer's findings in relation to the average consumer although it is difficult to identify the exact nature of the Opponent's complaint other than an alleged inconsistency in the level of attention paid by the average consumer, which as far as I can see works in the Opponent's favour.

51. The Opponent agreed with the Hearing Officer's findings that the training software and services concerned could cover a range of subjects at varying costs.

52. The Opponent also appeared to agree that the average consumer was the general public and business who would be reasonably well-informed and reasonably observant and circumspect (Case C-342/97, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV* [1999] ECR I-3819, para. 26).

53. The Hearing Officer went on to find that the average consumer would pay an above average level of attention in selecting the goods and services at issue, although businesses might pay an even higher level of attention when selecting the right training materials/courses for their employees.

54. The Opponent did not specify why these findings were wrong other than that the Hearing Officer failed in his assessment to take account of the various types of goods and services at issue, and their respective costs, which he clearly did – moreover, in the same paragraph as arriving at his conclusion that the average consumer would pay an above average (or higher) level of attention to the purchase act (para. 23 reproduced at para. 11 above).

55. The apparent inconsistency fastened on by the Opponent was that at paragraph 54 the Hearing Officer stated when listing the circumstances relevant to his global assessment of likelihood of confusion that the average consumer would pay: "at least an average degree of attention (or higher) to the selection of the goods and services" (rather than "an above average level of attention").

56. I think the Opponent's criticism is purely a matter of semantics.

57. The Hearing Officer was clearly being guided in his global assessment of likelihood of confusion by the lower level of attention he had attributed to a member of the buying general public (as opposed to businesses) be that "above average" or "at least average" (see, e.g., Case T-66/18, *Soundio A/S v. EUIPO* EU:T:2019:825, para. 24).

58. If as suggested by the Opponent there was a disparity between those 2x findings (which I doubt), the level of attention the Hearing Officer took into account when determining the likelihood of confusion was the latter level of attention arguably increasing the risk of confusion in the Opponent's favour.

59. I dismiss the second ground of appeal.

Conceptual aspect

60. The first part of the third ground of appeal was that the Hearing Officer misapplied the decision in *NEWPORT CREEK Trade Mark*, BL O/223/16. The Appointed Person decided in the particular circumstances of that case that there was a medium degree of conceptual similarity between the trade marks NEWPORT and NEWPORT CREEK because of the possibility that the consumer will perceive the creek to be situated in Newport (para. 25). A particular circumstance was that the Appointed Person found the trade mark NEWPORT to be moderately distinctive for the Class 24 textile goods in question, there being no evidence of any link between these Newport locations and textiles.

61. The Hearing Officer distinguished *NEWPORT CREEK* in the present case.

62. CAMBRIDGE would be seen as referring to the geographical location of the provider of the goods/services, whereas CAMBRIDGE SPARK formed a unit indicating that the "spark" or clever person was from Cambridge, or that the flash of inspiration was Cambridge based. Whilst recognising that on one level Cambridge was common to both, the respective trade marks conveyed a different overall message to the average consumer.

63. Further, the term "Cambridge" was non-distinctive in the context of the goods/services at issue. The Hearing Officer was prepared to accept to a limited extent that Opponent's claim that Cambridge was well known as a university city and a seat of learning but observed that the Opponent's evidence showed that a number of research bodies both connected (but without "Cambridge" in their title) and unconnected to the Opponent were based in Cambridge.

64. *NEWPORT CREEK* was decided on its own facts, which were not on all fours with the present case, and the Hearing Officer was not bound to follow it.

65. The Opponent criticised the Hearing Officer for not finding at least a low degree of conceptual similarity in the marks since on his own reasoning the geographical location Cambridge was common to both.

66. That was however taken into account by the Hearing Officer but in his evaluation the trade marks still conveyed different messages.

67. In my view the Opponent was splitting hairs here. Whether one assesses the conceptual similarity as none or at a low level the point was that the Hearing Officer found that the respective trade marks conveyed different messages to the average consumer: CAMBRIDGE solus – as the name of a city/county, a geographical location of the provider; CAMBRIDGE SPARK – a person or idea. On that basis there was a conceptual dissonance in the trade marks. I am not prepared to interfere with the Hearing Officer's evaluation on the complaint that he should have found the marks conceptually similar to a low degree.

68. The second part of the third ground of appeal was that the Hearing Officer failed to take account of the Opponent's reputation. It appears however from the express terms of the decision that he did, albeit not accepting the Opponent's claims in this regard in full (para. 47 reproduced at para. 20 above).

69. I was unclear of the exact nature of the Opponent's complaint under this head.

70. First, it is well established that the acquired distinctiveness of an earlier trade mark is a relevant factor in determining the scope of protection afforded to the earlier trade mark in the global ascertainment of likelihood of confusion under Section 5(2)(b), but not in assessing the degree of similarity in the marks (Case C-115/19 P, *China Construction Bank Corp. v. EUIPO* EU:C:2020:469, paras. 56 – 59).

71. Second, in exceptional cases a well known meaning of an earlier trade mark or indeed a later trade mark can affect the conceptual and then overall similarity in the marks

(Case C-361/04 P, *Claude Ruiz-Picasso v. EUIPO* [2006] ECR I-643, Case C-*Lionel Andrés Messi Cuccittini* EU:C:2020:722[2]) but the Hearing Officer clearly decided for the reasons he gave at paragraph 47 (see above) that this was not such an exceptional case.

72. The Opponent criticised the Hearing Officer's reference in paragraph 47 to "research" bodies (I assume rather than educational/training establishments) and suggested this may have misled him. I think this was just a question of language. The Hearing Officer clearly appreciated the goods and services at issue.

73. I do accept that at paragraph 47 when assessing the conceptual aspect, the Hearing Officer spoke of CAMBRIDGE not being distinctive in relation to the goods and services concerned yet later in his findings on the distinctiveness he referred to the earlier trade marks having: "at least a low degree of distinctive character". This disparity while unfortunate, did not in my judgment impact materially on the findings in relation to conceptual similarity.

Likelihood of confusion

74. The fourth ground of appeal as I understood it was that the Hearing Officer erred in his global appreciation of likelihood of confusion in taking into account that:

> "61) When a consumer is seeking training materials or a course for himself or employees care will be taken to ensure (in terms of subject and level) type of training and is compiled or carried out by a competent body with the necessary accreditation …"

75. It was submitted by the Opponent that this was taking account of extraneous material which went beyond the scope of notional and fair use.

76. I disagree. It seems to me that the Hearing Officer was merely repeating his earlier findings about the level of care that would be taken by an average consumer when purchasing the goods/services in question. He was quite properly looking at the objective circumstances in which such goods and services are marketed and the normal behaviour of customers in selecting them[3].

77. The Hearing Officer went on to find that given *inter alia* the differences in the marks and even allowing for imperfect recollection there was no likelihood of direct or indirect confusion between the marks.

78. I was not persuaded that his evaluation was wrong.

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[2] Not yet available in English.

[3] The Hearing Officer had referred earlier in his consideration of likelihood of confusion to Case T-385/09, *Annco, Inc v. OHIM* [2011] ECR II-0455:

> "50. Indeed, the likelihood of confusion cannot be determined in the abstract, but must be assessed in the context of an overall analysis that takes into consideration, in particular, all of the relevant factors of the particular case (*SABEL*, paragraph 18 above, paragraph 22; see, also, Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37), such as the nature of the goods and services at issue, marketing methods, whether the public's level of attention is higher or lower and the habits of that public in the sector concerned. The examination of the factors relevant to this case, set out in paragraphs 45 to 48 above, do not reveal, prima facie, the existence of a likelihood of confusion between the signs at issue."

79. Finally the Opponent contended that the Hearing Officer did not consider use in advertising, referrals or recommendations which was plainly unjustified because the Hearing Officer rehearsed the different ways in which the goods and services would be marketed/selected in the section of his decision entitled: "**The average consumer and the nature of the purchasing decision**" (paras. 21 – 24).

80. The fifth ground of appeal was that the Hearing Officer failed to give enough emphasis to his findings of identicality of goods/services and that the Opponent's earlier trade mark was entitled to enhanced protection through use. No specific error was identified, and I find that the true nature of the Opponent's complaint is that it disagreed with the result.

81. To conclude at this point, the grounds of appeal against the decision under Section 5(2)(b) fail.

Section 5(3)

82. The sixth ground of appeal was against the Hearing Officer's decision under Section 5(3) of the Act. The ground was that the Hearing Officer wrongly appeared to find that the taking of unfair advantage of the distinctive character or the repute of the earlier trade marks was dependent on there being a likelihood of confusion between the marks, which he had found did not exist.

83. I think this was a mis-reading of the decision.

84. The Hearing Officer reviewed the applicable case law in detail including the more recent Court of Appeal decision in *Argos Limited v. Argos Systems Inc* [2018] EWCA Civ 2211.

85. He rightly concluded that in order for there to be unfair advantage, the registration/use of the mark applied for must result in a change in the economic behaviour of consumers of the applicant's goods/services.

86. Although the serious risk of such damage occurring would suffice, and allowed for the use of logical deductions from the evidence:

> "… such deductions must not be the result of mere suppositions but, … must be founded on 'an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case'." (Case C-383/12 P, *Environmental Manufacturing LLP v. OHIM* EU:C:2013:741, paras. 42 – 43)

87. Having reviewed his previous findings including that the Opponent's earlier trade marks had reputation for identical goods and services, the low degree of similarity in the marks and the normal selection process of the goods and services concerned, the Hearing Officer decided that neither registration nor use of the CAMBRIDGE SPARK figurative trade mark would lead to a likelihood of confusion with, or a transfer of image from, the CAMBRIDGE earlier trade marks, and that therefore there was no unfair advantage to be taken.

88. The Opponent particularly criticised the Hearing Officer's observation that:

> "77) … I do not believe that the "link" formed in the minds of applicant's consumers will affect their economic activity as the process of purchasing taring materials or courses will involve ascertaining the credentials of the supplier and thus reveal that the applicant is not connected to the opponent."

89. However, when read in context (see para. 29 above) I am satisfied that this observation was directed to the question of image transfer and not as the Opponent suggested repeating or reinforcing the Hearing Officer's preceding statement to the effect that he had already found that there was no likelihood of confusion.

90. The seventh ground of appeal was effectively that given the reputation of the Opponent in CAMBRIDGE in relation to identical goods and services there must be image transfer were CAMBRIDGE SPARK figurative to be registered and used in the UK. This ground of appeal amounts in my view just to disagreeing with the end result.

91. To conclude on this section, the grounds of appeal against the decision on Section 5(3) fail.

Costs

92. There was no justification in the Opponent's challenge to the costs award.

93. The Applicant put forward a "fall-back" position after the hearing but before the decision. This was rejected first, because there remained identicality of goods and services; second, because the proposed fall-back position was subject to valid criticism.

94. The opposition was, therefore, decided on the basis of the goods and services originally specified.

95. That was a rejection of the Applicant's fall-back position, not a partial success for the Opponent. The Hearing Officer's costs award stands.

Conclusion

96. In the result the appeal has failed.

97. I will order the Opponent to pay to the Applicant the sum of £1,000 as a contribution towards the Applicant's costs of this appeal.

98. The Opponent is to pay the Applicant the total sum of £3,000 (i.e., including costs in the sum of £2,000 ordered by the Hearing Officer) within 28 days of the date of this decision.

Professor Ruth Annand, 19 October 2020

Mr Julius Stobbs of Stobbs IP appeared for the Opponent/Appellant

Mr Christian Bunke of Basck Limited appeared for the Applicant/Respondent