

O-793-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3203702
BY FASHION ONE (EUROPE) N.V. TO REGISTER:**

ADDACUS

AS A TRADE MARK IN CLASSES 9, 16 AND 41

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 409516 BY ADDACUS LTD**

Background & Pleadings

1. On 22 December 2016, Fashion One (Europe) N.V. (“the applicant”) applied to register the above trade mark for the following goods and services:

Class 9: *Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards; video films.*

Class 16: *Paper; cardboard; printed publications; printed matter; computer printers (Inking ribbons for -); bookbinding materials; books; adhesives for stationery or household purposes; artists' paint brushes; music sheets; music scores; periodical magazines; photographs; stationery and educational supplies; typewriters; Instructional and teaching material (except apparatus); plastic materials for packaging; printing blocks.*

Class 41: *Teaching; education; training; entertainment services; production of television programs; film distribution; production of shows; production of films; provision of non-downloadable films and television programs via a video-on-demand service; arranging, conducting and organisation of workshops; conducting of seminars and congresses; arranging of exhibitions for cultural purposes; organizing and arranging exhibitions for entertainment purposes; organizing and presenting displays of entertainment [relating to style and fashion]; organization of [fashion] shows for entertainment purposes.*

The application was published for opposition purposes on 10 March 2017.

2. On 12 June 2017, the application was opposed in full by ADDACUS Ltd (“the opponent”). The opposition is based upon sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon the following trade mark:

European Union Trade Mark (“EUTM”) 4595237:

ADDACUS

Filing date: 18 August 2005

Registration date: 12 September 2007

The opponent indicates that it intends to rely upon all goods and services for which its mark is registered. It is worth mentioning at this point that the opponent’s specification has been reduced during the course of these proceedings further to a decision issued by the EUIPO¹. The opponent’s trade mark is *currently* registered for the following:

Class 9: *Sound and video recordings; pre-recorded discs, CD's; parts and fittings for all the aforesaid goods; all the aforesaid goods being for use in the teaching of children with learning difficulties.*

Class 16: *Printed matter; manuals; books; instructional and teaching materials; posters; stationery; instructional and teaching material; parts and fittings for all the aforesaid; all the aforesaid goods being for use in the teaching of children with learning difficulties.*

Class 41: *Educational services; teaching services; organisation of teaching activities; arranging and conducting of seminars and workshops; advisory, information and consultancy services relating to all the aforementioned; all the aforesaid services being related to the teaching of children with learning difficulties but not including private tutoring services.*

3. In its Notice of Opposition, the opponent states:

“...The applicant has applied for the mark ADDACUS which is identical to the mark registered by the opponent. ...The applicant has applied for use in classes

¹ In its submissions, the opponent drew my attention to an outstanding revocation action at the EUIPO initiated by American Franchise Marketing Ltd (AFM), signed by its president, Michael Gleissner. It asserts that Mr Gleissner is the founder of the applicant in the current proceedings.

9, 16 and 41 – identical to the classes registered in the EU by the opponent.
...The opponent, Addacus Ltd, is concerned that use of the mark in the UK by the applicant will confuse customers and potential customers of the opponent.”

4. In its counterstatement, the applicant initially acknowledges that there are some similarities in the specifications of the two marks and accepts that the marks are visually, aurally and conceptually similar. However, it concludes that:

“26. ...the goods and services offered by the respective marks are entirely different. This level of dissimilarity is sufficient to offset any potential similarity between the marks. As a result, a likelihood of confusion cannot exist”.

5. The applicant in these proceedings is represented by Trademarkers Merkenbureau C.V., whilst the opponent is unrepresented. Only the opponent filed evidence during the evidence rounds. Neither party requested a hearing; only the opponent filed written submissions in lieu. This decision is taken following a careful reading of all the papers which I will refer to, as necessary.

Decision

6. The opposition is based upon sections 5(1) and 5(2)(a) of the Act, which read as follows:

“5. - (1) - A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b)...

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

7. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. Given its filing date, the opponent’s trade mark qualifies as an earlier mark under the provisions outlined above. In accordance with section 6A of the Act, having completed its registration procedure more than five years prior to publication of the applicant’s mark, it is subject to the proof of use provisions. In its Notice of Opposition, the opponent indicated that it had used its earlier mark in respect of all goods relied upon. In its counterstatement, the applicant requested that the opponent provide evidence to support its claim.

9. Under section 6A, the relevant period for proof of use is the five-year period ending on the date that the opposed mark was published. For the purpose of the opposition, the relevant period is, consequently, from 11 March 2012 until 10 March 2017.

Proof of use requested for a wider specification

10. Question 7 of the form TM8 allows the applicant the opportunity to request that the opponent provides proof of use and, if it chooses to do so, to specify for which of the goods and/or services relied upon proof of use is required. I note that the applicant

has listed several goods and services which are no longer present within the opponent's specification. These are set out below:

Class 9: Pre-recorded tapes, cassettes; electronic publications (downloadable); educational apparatus and instruments; teaching apparatus and instruments; audio visual teaching apparatus; [parts and fittings for all the aforesaid goods; all the aforesaid goods being for use in the teaching of children with learning difficulties].

Class 16: Writing instruments; note pads; ring binders; folders; [all the aforesaid goods being for use in the teaching of children with learning difficulties].

Class 41: Hire of teaching apparatus and instruments; publication of books; publication of educational teaching materials.

11. The opponent cannot be expected to provide proof of use in respect of a wider specification than it holds. The opponent's evidential burden extends only to those goods and services for which its earlier mark is *currently* registered. In short, proof of use is not required for the goods and services set out in paragraph 10.

Evidence summary

Opponent's evidence

12. The opponent filed evidence comprising a witness statement from its director, Mr Richard Keith Parkes, originally dated 12 November 2017 and later signed on 31 March 2018. Mr Parkes' statement is supported by exhibits E.1.1 to E.26.2.

13. The following can be gleaned from Mr Parkes' statement:

- Since the mark was first used in 2006, its use has been "widespread and consistent" and made in respect of the following goods and services:

“Class 9: Sound recordings on CDs, video recordings on disc and on line, downloadable electronic documents, plastic moulded strips called “number strips” and the “Addacus” device; all used for teaching mathematics.”

“Class 16: Manuals and work books for ADDACUS packs 1 to 3, the book “101 More Ways to use Addacus”, banners for use at exhibitions, printed cards for creation of mathematical formulae... number cards in bronze, silver and gold, colour printed cardboard boxes to contain ADDACUS Packs 1, 2 and 3. Each of these packs contains dozens of individual card and plastic items”.

“Class 41: Workshops and training sessions, educational exhibitions and conferences, training and teaching of teachers in the use of the ADDACUS packs, publishing of workbooks and creation of training videos”.²

- The mark has been used in Belgium, Cyprus, Denmark, Eire, Germany, Greece and (predominantly) the United Kingdom, with ADDACUS goods and services sold to over 1500 schools in the UK.
- The opponent’s annual turnover from March 2012 to March 2017 is set out below:

Period	Sales turnover for EU including the UK (£) ³
03/2012 – 03/2013	32, 552
03/2013 – 03/2014	43, 999
03/2014 – 03/2015	23, 335
03/2015 – 03/2016	11, 927
03/2016 – 03/2017	12, 115
Total:	123, 928

- £122,917 of the £123,928 relates to sales made within the UK.

² See Mr Parkes’ response to ‘Question 1’ of his witness statement.

³ Mr Parkes explains that, as sales of the Addacus packs often include the provision of training, it is not possible to list the turnover figures attributable to each individual trade mark class.

14. Exhibits 1.1 to 6.1.3 comprise a sample of 53 invoices in total, 10 each year from 2012 to 2016 and 3 from 2017. All recipients are schools based in the UK and the invoice totals range from £110.40 to £4987.15. The goods and services itemised on the invoices include, inter alia, *Addacus Half Day Training*, *Addacus Books 1/2/3*, *Addacus Packs 1/2/3*, *CDs*, *Number Squares*, *Number Strips* and *Addacus training videos*. In the description of the goods and services, Addacus is recorded in the plain word form. Its presentation is enhanced at the top of each invoice, which is headed as shown below, reading 'ADDACUS, THE ABC OF NUMBERS':



15. The mark can be seen presented in the same way on a variety of Addacus products shown in a selection of photographs provided at Exhibit E.7.1-2. The exhibited products include CDs, teaching materials and books. The exhibit is not dated and there is no indication as to when or where the goods were available for purchase.

16. Exhibit E.8.1 consists of five photographs, each displaying what the opponent describes as the 'Addacus device' being used by children in a school environment. Later, in E.21 and E.22.1-2, the opponent provides a close-up photograph of the mould used for the plastic injection moulding of the Addacus device, and the device itself, both of which are clearly embossed with the word 'ADDACUS'. The device is clearly an interactive one. From what I can tell, it comprises a base unit with a pull-out drawer and three vertical prongs positioned atop the unit, between which users can distribute (and presumably redistribute) a number of individual cubes.

17. Provided at Exhibit 9.1 is a 'price list and order form' offering customers the opportunity to select which goods from the opponent's inventory they wish to purchase. The listed goods include 'COMPLETE PACKS', 'DISCOVERY PACKS' and 'TRAINING VIDEOS'. Each of the packs comprise a variety of teaching materials including number sheets, number strips, unit cubes, CDs, arrow cards, reading and spelling sheets and timetable wheels. Though the document is not dated, the opponent

indicates in its evidence summary that the price list reflects the “current version”. There is no clarification as to the scale of distribution, neither is it clear how much custom was generated via this medium.

18. The opponent describes Exhibit 10.1-3 as evidence of its email advertising campaign. Two emails are enclosed displaying promotional material advertising the Addacus programme; one sent from Meridian Delta to the opponent on 22 September 2015 and the other sent from Addacus to Meridian Delta on 23 February 2016. In the former, Addacus is described as a highly structured, multi-sensory numeracy programme. The latter explains that Addacus were finalists in the ‘prestigious Education Resources Awards 2016’. Alongside the promotional and explanatory text within the emails are images displaying examples of various printed materials and teaching aids. There is no evidence of further circulation, though the opponent’s evidence summary indicates that the advertisement was sent to UK primary schools.

19. Further correspondence is enclosed at Exhibit 11.1-5 between the opponent and Findel Education (based in the UK). The correspondence shows Findel Education praising the opponent’s Addacus product and suggesting its inclusion in the LDA catalogue. The proposed catalogue pages are also provided, detailing the benefits of the Addacus programme and the various sets available for purchase. The sets comprise goods such as the Addacus device, workbooks, instructional CDs, number strips and number and clock cards. The opponent confirms that the material was used for the 2017 LDA Educational Catalogue. There is no indication of readership or distribution outlets.

20. Exhibited at E.12.1-4 is another email exchange between the opponent and Findel Education. Enclosed with the correspondence is an extract from the 2017 Hope Educational Catalogue. A page of the catalogue is dedicated to Addacus, showcasing a variety of Addacus products, in isolation and in use, alongside details of the products collectively headed Addacus Set One, Two and Three. Though the text is difficult to make out, the images indicate that the listed products include a range of educational resources including printed matter such as number cards and clock cards and a number of interactive 3-D educational devices. Again, there is no indication of readership or distribution outlets.

21. Exhibit E.13.1-2 comprises an Addacus leaflet listing available products, contact information and examples of positive feedback. Products include workbooks, CDs, times table square, number strips and training courses. Exhibit E.14.1 comprises an Addacus poster showing a student using the Addacus device, headed 'Investing in happy children'. Exhibit E.16.1-2 is a promotional flier headed 'NEW PRIMARY MATHEMATICS INTERVENTION STRATEGY'. It advertises the Addacus activity packs and offers half day training courses for teachers, SENCOs, support assistants or parents. It is not clear how, when or where these materials were circulated.

22. Exhibit E.15.1 consists of a page of A4 paper and a compliment slip, both headed with the stylised ADDACUS mark (as shown at paragraph 14).

23. Exhibit E.17.1-2 comprises a single email from *Nielsen Book* dated 23 September 2014 providing the opponent a publisher prefix reference unique to Addacus Ltd. The correspondence states that the prefix allows for 10 ISBNs (*International Standard Book Numbers*) and confirms the registration of their first title.

24. YouTube data is enclosed as Exhibit E18.1-7. The opponent provides screenshots showing the number of 'views' attributed to a selection of publicly available Addacus videos up to 2017. Of the 7 videos, I note that only 2 were published during the relevant period; 'Addacus Training Video – Stringalongs (sample)', published in 2014 and garnering 711 views and 'Addacus Training Video – Introduction', published in 2014 and garnering 272 views.

25. At Exhibit 19.1-5, the opponent provides statistics relating to its website, www.addacus.co.uk. The data shows the total number of annual site 'hits' made per country, from 2012 to 2017. For ease of reference, I have condensed the data into the following table to show the three EU member states to make the greatest number of visits to the site per annum and an estimated number of visits made⁴. As seen, after 'Great Britain', there is a notable reduction in the number of visits elsewhere in Europe.

⁴ Included in each year's list of 'hits' is reference to 'European country'. Without an explanation of which country(/ies) this relates to, it is impossible to grasp the relevance of this data. Consequently, it has not been

<u>2012</u>	<u>2013</u>	<u>2014</u>	<u>2015</u>	<u>2016</u>	<u>2017</u>
199,386 (Great Britain)	106,800 (Great Britain)	86,963 (Great Britain)	87,460 (Great Britain)	65,687 (Great Britain)	73,527 (Great Britain)
2,302 (Ireland)	1,804 (Germany)	1,979 (Germany)	5,296 (France)	4,494 (France)	4,130 (France)
1,641 (Germany)	1,223 (Ireland)	1,306 (Italy)	3,702 (Germany)	1,231 (Germany)	2,196 (Sweden)

26. Exhibited at 20.1-3 are web extracts showing the opponent's goods and services available online. The pages include a brief description of what each product comprises alongside a photograph or representation of the product and its cost, provided in GBP, offering customers the facility to add a specified quantity to their basket. 'Addacus' is presented in as a plain word throughout. The goods include the Addacus device, books, worksheets, strings, cubes, cards, pre-recorded CDs and training videos. The opponent has not provided a specific URL, nor has it clarified precisely *when* the web pages were live.

27. The opponent describes Exhibit E.23 as 'Marketing – Meridian Delta, Evidence of disk from e.mail provider'. The exhibit comprises an email sent from a representative of *Meridian Delta* to a representative of the opponent, both parties identifiable by their respective domain names. From what I can tell, it appears to be a fairly generic circulation email promoting a new all-in-one marketing package. It prices the package at £499 +VAT, offering recipients 3 free managed email campaigns. There is no supplementary correspondence to show that the opponent invested in the advertised marketing package, nor does the exhibit indicate that the opponent deliberately sought out the information, though it may have been an existing member of the relevant distribution list (to have been eligible to receive the email).

considered. In the interest of completeness, the 'hits' annually attributed to 'European country' are 1,780 in 2012, 136 in 2013, 305 in 2014, 292 in 2015, 217 in 2016 and 135 in 2017.

28. At Exhibits 24.1-6, Mr Parkes provides one invoice from each year from 2012 to 2016, describing them as “Examples of Addacus spend on marketing 11/03/12 – 10/03/17”. It is not clear whether this is an indication of only a portion of the opponent’s marketing expenditure or whether the figures represent the full extent of its expenditure. If only an indication, the evidence provides no additional clarification as to the *total* amount spent on marketing during this period. I have summarised the information in each invoice in the table below:

Invoice date	Amount (£)
7 July 2012	10
10 May 2013	2,000
13 June 2014	600
27 August 2015	840
16 February 2016	852

29. Exhibit 25.1-6 shows what Mr Parkes describes as “Examples of Addacus spend on stock 11/03/12 – 10/03/17”. Again, it is unclear how the examples relate to the opponent’s entire stock spend during this time. The following details can be gleaned from the exhibit:

Invoice date	Amount (£)
25 February 2013	240
22 October 2013	6,096
23 November 2015	1,476
8 July 2016	480
24 February 2017	2,760

30. Enclosed as Exhibit 26.1-3 is a document providing a description of ‘The Addacus /Beat Dyscalculia Programme’; its purpose and method of accomplishment. The opponent explains that the document reflects its entry for an ERA award in 2016. It is not clear whether any recognition was generated as a result of the entry, nor has the opponent explained the level of public interest in the ERA awards.

31. As the applicant filed no evidence, that concludes my summary. The opponent filed written submissions which I have reviewed in their entirety but will refer to only as necessary.

Proof of use

32. The first issue is to establish whether, or to what extent, the opponent has shown genuine use of the goods and services relied upon. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A- (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services”.

33. Section 100 of the Act also applies, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it”.

34. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch); [2013] F.S.R. 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *Pasticceria e Confetteria Sant Ambroeus Srl v G&D Restaurant*

Associates Ltd (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV (C-40/01) [EU:C:2003:145]; [2003] E.T.M.R. 85*, *La Mer Technology Inc v Laboratories Goemar SA (C-259/02) [EU:C:2004:50]; [2004] E.T.M.R. 47* and *Silberquelle GmbH v Maselli-Strickmode GmbH (C495/07)[EU:C:2009:10]; [2009] E.T.M.R.28* (to which I added references to *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-416/04 P) [EU:C:2006:310]*). I also referred at [52] to the judgment of the CJEU in *Leno Merken BV v Hagelkruis Beheer BV(C149/11) EU:C:2012:816; [2013] E.T.M.R. 16* on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-141/13 P) EU:C:2014:2089* and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd (O/528/15) [2016] E.T.M.R. 8*.

218. [...]

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein RadetskyOrder v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others

which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of

the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

35. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the

evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

36. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person, stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

37. As the opponent’s earlier mark is an EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, are also relevant. The court noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

and

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

and

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."

38. In *London Taxi*, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

"228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of

London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

39. The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

40. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient

to create or maintain a market for the goods at issue in the Union during the relevant five year period.

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods for which use has been shown
- iv) The nature of those goods and the market(s) for them
- iv) The geographical extent of the use shown

Variant use

41. When making an assessment as to whether genuine use of the opponent's mark has been shown, I begin by considering the way in which it has been used. Section 46(2) of the Act provides for use of trade marks in a form differing in elements which do not alter the distinctive character of the mark as registered. In *Nirvana Trade Mark*, Case BL O/262/06, Richard Arnold Q.C. (as he then was), as the Appointed Person, considered the law in relation to the use of marks in different forms and summarised the s.46(2) test as follows:

"33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

42. Although this case was decided before the judgment of the CJEU in *Colloiseum*⁵, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered.

43. In *hyphen GmbH v EU IPO*, Case T-146/15, the General Court (“GC”) held that use of the mark shown on the left below constituted use of the registered mark shown on the right:



44. The court set out the following approach to the assessment of whether additional components are likely to alter the form of the registered mark to a material extent.

“28 [...] a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see judgment of 10 June 2010, *ATLAS TRANSPORT*, T-482/08, not published, EU:T:2010:229, paragraph 31 and the case-law cited; judgments of 5 December 2013, *Maestro de Oliva*, T-4/12, not published, EU:T:2013:628, paragraph 24, and 12 March 2014, *Borrajo Canelo v OHIM — Tecnoazúcar (PALMA MULATA)*, T-381/12, not published, EU:T:2014:119, paragraph 30).

29 For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the [registered] mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse

⁵ *Colloiseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

is also true (judgment of 24 September 2015, *Klement v OHIM — Bullerjan (Form of an oven)*, T-317/14, not published, EU:T:2015:689, paragraph 33).

30 It has also been held that where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of those elements or their omission is not such as to alter the distinctive character of that trade mark as a whole (judgment of 21 January 2015, *Sabores de Navarra v OHIM — Frutas Solano (KIT, EL SABOR DE NAVARRA)*, T-46/13, not published, EU:T:2015:39, paragraph 37 and the case-law cited).

31 It must also be remembered that, in order for the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character (judgment of 21 June 2012, *Fruit of the Loom v OHIM — Blueshore Management (FRUIT)*, T-514/10, not published, EU:T:2012:316, paragraph 38).

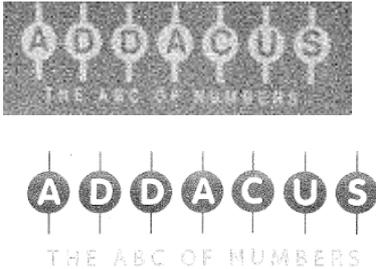
32 It is in the light of those considerations that it must be determined whether the Board of Appeal was correct in finding, in paragraph 9 of the contested decision, that it had not been proven that the European Union trade mark rights had been used in a manner so as to preserve them either in the form registered or in any other form that constituted an allowable difference in accordance with the second subparagraph of Article 15(1)(a) of Regulation No 207/2009”.

45. These findings indicate that the relative distinctiveness of the registered mark and the components added to (or omitted from) it in use are relevant factors to take into account in the required assessment. In this instance, the Court held that the addition of a circle, being merely a banal surrounding for the registered mark, did not alter the distinctive character of the mark as registered.

46. In *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, Professor Ruth Annand, sitting as the Appointed Person, stated:

“16. A word trade mark registration protects the word itself (here BENTLEY) written in any normal font and irrespective of capitalisation and, or highlighting in bold (see e.g. Case T-66/11, *Present-Service Ullrich GmbH & Co. KG v. OHIM*, EU:T:2013:48, para. 57 and the cases referred to therein, BL O/281/14,).”

47. The opponent has shown use of its mark as the plain word in several of its exhibits. Whilst not an exhaustive indication, it is displayed in this way throughout the opponent’s invoices, in its price lists, promotional material, descriptions of its Youtube videos and its web pages. Collectively, I find this to be sufficient. However, I will also consider the acceptability of the variant use shown. The registered trade mark and the mark(s) shown on several of the exhibits are set out below:

Registered trade mark	Trade mark(s) used
ADDACUS	

48. The first question to be answered is “what is the distinctive character of the registered trade mark?”. It is clear at the outset that the earlier mark relied upon by the opponent is a plain word mark. Its distinctiveness, consequently, lies solely in the word itself; ‘ADDACUS’.

49. In the stylised representation of the mark, each letter is encased within a circular shape and presented in a colour which starkly contrasts that with which the circle itself is populated. Each circle is layered upon a vertical line, which emerges from the central point of the top and bottom extremities. Consequently, and particularly emphasised given the similarity in the words’ composition, consumers are likely to be met with an impression of an ‘abacus’, which traditionally adopt the same structure. Indeed, the opponent admits that ADDACUS was chosen deliberately as a play on the word ‘abacus’. Written beneath the image is ‘THE ABC OF NUMBERS’. In my view, this is

likely to be seen purely as a brand strapline. As to whether the presentation of the mark as registered is acceptable, I consider the letters themselves. Whilst additional embellishments have been added to the periphery and are unlikely to go unnoticed, the adopted font is, in my opinion, fairly ordinary and the letters of which the opponent's mark is comprised are, essentially, unaltered. This would clearly signify to the average consumer that it originates from the same undertaking as the registered mark; its distinctive character remaining primarily in the word 'ADDACUS'. Taking each of the above considerations into account, I find the form used to be an acceptable variant.

50. I now turn to consider whether genuine use of the mark has been established, and on what goods and/or services. For reasons such as chronology and a general lack of clarity, I have attributed very little evidential weight to some exhibits. Overall, however I find that the opponent has shown that it has sought to create and preserve a share in the market, having made continual use of its mark throughout the relevant period. Its turnover figures, though not necessarily on a grand scale, I find to be sufficient. Whilst I appreciate that education, at large, is clearly a market of considerable value, the opponent's specification extends only to goods and services for use in the teaching of children with learning difficulties, which, in my view, limits the scope of the economic sector fairly considerably. Still, use of the mark need not be quantitatively significant for it to be deemed genuine. The purpose of the provision is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case(s) where large-scale commercial use has been made of the marks⁶. The invoices show ongoing sales throughout the relevant period to a variety of UK schools and the opponent's website generates a substantial amount of interest throughout Europe, though to a lesser extent for member states outside of the United Kingdom, which consistently boasts the highest number of annual visits. Though sometimes absent of chronological and distributional clarification, the evidence also indicates that the opponent has sought to promote its goods and services within the UK. On that point, although the exhibits clearly show that the opponent's primary focus is maintaining a market share within the UK, case law directs that use in only one member state can be sufficient to show genuine use⁷

⁶ *Sunrider v OHIM — Espadafor Caba (VITAFRUIT) T 203/02*

⁷ *TVR Automotive Ltd*

of its earlier mark. In assessing the evidence as a whole, I am satisfied that the opponent has made use of its mark within the relevant period to the extent necessary to satisfy use in the EU. That being so, I must now determine precisely which goods and services the mark has been used in relation to and then arrive at a fair specification.

51. In terms of devising a fair specification, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned”.

52. Carr J summed up the relevant law in regard to fair specifications in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch). This was a revocation case, but the same principles apply in an opposition:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average

consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].”

53. When considering the fair specification, I note that all goods and services for which the opponent’s mark is registered are limited to use in or relating to the teaching of children with learning difficulties, for which I am satisfied that the opponent has shown sufficient use. I remain mindful of *Omega SA (Omega AG) (Omega Ltd) v Omega Engineering Incorporated* [2012] EWHC 3440 (Ch), in which Arnold J. provided the following guidance on the application of the *POSTKANTOOR* principle.

“43. *The POSTKANTOOR principle.* In *POSTKANTOOR* the applicant applied to register the word *POSTKANTOOR* (Dutch for *POST OFFICE*) in respect of goods and services in Classes 16, 35–39, 41 and 42. The Benelux Trade Mark Office refused registration on the grounds that the sign was descriptive. On appeal, the *Gerechtshof te s’-Gravenhage* (District Court of The Hague) referred nine questions of interpretation of the Directive to the Court of Justice, of which the eighth was as follows:

“Is it consistent with the scheme of the Directive and the Paris Convention for a sign to be registered for specific goods or services subject to the limitation that the registration applies only to those goods and services in so far as they do not possess a specific quality or specific qualities (for example, registration of the sign ‘Postkantoor’ for the services of direct-mail campaigns and the issue of postage stamps, provided they are not connected with a post office’)?”

44. The Court of Justice answered this question as follows:

“113. ... when registration of a mark is sought in respect of an entire class within the Nice Agreement, the competent authority may, pursuant to Article 13 of the Directive, register the mark only in respect of some of the goods or services belonging to that class, if, for example, the mark is devoid of any distinctive character in relation to other goods or services mentioned in the application.

114. By contrast, where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.

115. Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties — particularly competitors — would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods.”

45. The guidance given by the Court of Justice must be seen in the context of the question to which it was addressed, namely whether it was acceptable to restrict the goods or services by reference to the absence of “a specific quality”. What the District Court of The Hague meant by this can be seen from the example it gave, viz. “the services of direct mail campaigns and the issue of postage stamps provided that they are not connected with a post office”. When the Court of Justice referred in its answer to “a particular characteristic”, it must have meant the same thing as the District Court meant by “a specific quality”.

46. The application of this guidance has caused some difficulty in subsequent cases. In *Croom’s Trade Mark Application [2005] R.P.C. 2* at [28]–[29] Geoffrey Hobbs QC sitting as the Appointed Person held that the *POSTKANTOOR*

principle precluded the applicant from limiting a specification of goods in Classes 18 and 25 by adding the words “none being items of haute couture” or “not including items of haute couture”. He went on at [30] to refer to “characteristics that may be present or absent without changing the nature, function or purpose of the specified goods”. Mr Hobbs QC made the same distinction in *WISI Trade Mark* [2007] E.T.M.R. 5; [2006] R.P.C. 22 at [16].

47. In *Oska's Ltd's Trade Mark Application* [2005] R.P.C. 20 at [56] I observed *en passant* when sitting as the Appointed Person that I did not consider that it would be permissible to limit the specification by reference to the applicant's intended target market.

48. In *MERLIN Trade Mark (BL O/043/05)* [1997] R.P.C. 871 at [27]–[28] I held when sitting as the Appointed Person held that the disclaimer “but not including the provision of venture capital” was acceptable, because it was not framed by reference to the absence of particular characteristics of the services, but rather it was a restriction on the scope of the services embraced by the specification. Accordingly, “the effect of [the disclaimer] is simply to excise a particular service from the specification. The mere fact that it is more convenient to express it in negative than positive terms does not make it objectionable.”

49. I also allowed a second disclaimer “and not including the provision of any such services to the pharmaceutical biotechnological [or] bioscientific sectors” for reasons which I expressed at [29] as follows:

“The position with regard to the second disclaimer is more debatable, but in my judgment the disclaimer does not relate to a characteristic of the services. I consider that there is a distinction between goods and services here. An article of clothing is an article of clothing regardless of whether it is of a particular style or quality and regardless of the identity and proclivities of the intended purchaser. By contrast, services can be defined in part by the recipient of the service. The opponent's registration is an example of this, since both the Class 35 and the Class 36 specification are limited to services provided to the pharmaceutical biotechnological and bioscientific sectors. In

my view *POSTKANTOOR* does not make it impermissible to define services in this way. That being so, I consider that it makes no difference if the definition is expressed negatively rather than positively.”

50. In *Patak (Spices) Ltd's Community Trade Mark Application (R746/2005-4) [2007] E.T.M.R. 3* at [28] the Fourth Board of Appeal at OHIM refused to allow a proposed limitation “*none of the aforesaid being dart games or darts*” to a class 28 specification as offending the *POSTKANTOOR* principle. I find this decision difficult to follow, since the exclusion related to categories of goods, rather than the characteristics of goods. It appears that the objection may have been down to the fact that the exclusion was negatively worded, but as I explained in *MERLIN [1997] R.P.C. 871* that is a matter of form, not substance, and so should not have been determinative.”

And

“56. Against this background, counsel for Swiss submitted that the limitation “intended for a scientific or industrial application in measuring, signalling, checking, displaying or recording heat or temperature (including such having provision to record heat or temperature over a period of time and/or to display the time of day)” contravened the *POSTKANTOOR* principle because it purported to restrict the specification of goods by reference to whether the goods possessed particular characteristics.

57. I do not accept that submission for the following reasons. First, if and insofar as the *POSTKANTOOR* principle depends on the limitation being expressed in negative terms, the limitation in the present case is expressed in positive terms. Secondly, and more importantly, I do not consider that the limitation refers to whether the goods possess particular characteristics in the sense in which the Court of Justice used that term in *POSTKANTOOR*. Rather, the limitation refers to the functions of the goods. To revert to the analogy discussed above, it is comparable to a limitation of “clocks” to “clocks incorporating radios”. Accordingly, in my judgment it falls on the right side of the line drawn by Mr Hobbs

QC in *Croom's Trade Mark Application [2005] R.P.C. 2* and *WISI Trade Mark [2007] E.T.M.R. 5; [2006] R.P.C. 22.*"

54. Having regard to the preceding case law, I am content that the opponent's limitation in its specification, which limits its goods and services to those used for the teaching of children with learning difficulties, is an acceptable one.

55. The opponent has shown use of its mark in respect of pre-recorded discs and CDs, videos, books, teaching materials, training courses and its often referred to 'Addacus packs' and 'sets' which comprise a number of printed educational resources including number strips, number sheets, card packs, arrow cards, strings, unit cubes and workbooks. It has also shown provision of educational services and training activities, with courses delivered both in person and online, not only by way of invoices but also in its promotional materials. When considered alongside the relevant case law, the evidence leads me to conclude that a fair specification for the opponent would read as follows:

Sound and video recordings; pre-recorded discs, CD's; all the aforesaid goods being for use in the teaching of children with learning difficulties (class 9)

Printed matter; manuals; books; instructional and teaching materials; all the aforesaid goods being for use in the teaching of children with learning difficulties (class 16)

Educational services; teaching services; organisation of teaching activities; arranging and conducting of seminars and workshops; all the aforesaid services being related to the teaching of children with learning difficulties but not including private tutoring services (class 41)

56. This represents the goods and services which the opponent may rely upon for the purpose of the opposition. I bear in mind that the opponent has retained some fairly broad terms in its specification but I am satisfied that sufficient use has been shown

for them to be maintained without having allowed the opponent to maintain a specification which is too broad.

Section 5(1) and 5(2)(a) - Case law

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

The principles:

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

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

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

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

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

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

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

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

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

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

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

58. Though reproduced in their entirety, I acknowledge that some principles are applicable only to section 5(2)(b) of the Act and are, consequently, irrelevant to these proceedings given that the marks are identical.

Comparison of goods and services

59. The competing goods and services are as follows:

Opponent's goods and services	Applicant's goods and services
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Class 9: *Sound and video recordings; pre-recorded discs, CD's; all the aforesaid goods being for use in the teaching of children with learning difficulties*

Class 16: *Printed matter; manuals; books; instructional and teaching materials; all the aforesaid goods being for use in the teaching of children with learning difficulties*

Class 41: *Educational services; teaching services; organisation of teaching activities; arranging and conducting of seminars and workshops; all the aforesaid services being related to the teaching of children with learning difficulties but not including private tutoring services*

Class 9: *Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards; video films.*

Class 16: *Paper; cardboard; printed publications; printed matter; computer printers (Inking ribbons for -); bookbinding materials; books; adhesives for stationery or household purposes; artists' paint brushes; music sheets; music scores; periodical magazines; photographs; stationery and educational supplies; typewriters; Instructional and teaching material (except apparatus); plastic materials for packaging; printing blocks.*

Class 41: *Teaching; education; training; entertainment services; production of television programs; film distribution; production of shows; production of films; provision of non-downloadable films and television programs via a video-on-demand service; arranging, conducting*

	<p><i>and organisation of workshops; conducting of seminars and congresses; arranging of exhibitions for cultural purposes; organizing and arranging exhibitions for entertainment purposes; organizing and presenting displays of entertainment [relating to style and fashion]; organization of [fashion] shows for entertainment purposes.</i></p>
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60. In its counterstatement, the applicant makes the following submission with regard to the goods applied for in class 9:

“16. ... its goods under Class 9 are in no way identical to that of the earlier mark. The subject mark’s goods pertains to Computer hardware, computer software and computer peripherals, among others.

Computer hardware is defined as the physical components of a computer or computer system, including peripheral devices such as monitors and printers⁸. It is the collection of physical parts of a computer system...

Computer software refers to the programs and other operating information used by a computer⁹.”

61. Of the competing goods in class 9, the opponent submits the following:

“2. ...a typical, probably non-technical customer will see the goods in Class 9 as similar for both marks, and many will see them as largely identical.

It is the Opponent’s view that members of the general public will not carry dictionary definitions of these terms in their heads and will potentially be confused

⁸ https://en.oxforddictionaries.com/definition/computer_hardware

⁹ <https://en.oxforddictionaries.com/definition/software>

by the presence of both marks in the market place, at the very least to the extent that they will believe the companies using the marks to be related.”¹⁰

62. In its assessment of the competing specifications in classes 16 and 41, the applicant asserts that there is a clear distinction on the basis that the opponent’s goods and services are limited to use for the purpose of, or alongside, the teaching of children with learning difficulties, whereas the applicant’s are not subject to restriction. Consequently, it finds a variation in their purpose and target consumer(s). It states:

“17. Further, as regards to goods under Class 16 of the subject mark. The same goods are not within the ambit of the goods offered by the earlier mark... In contrast to those goods of the subject mark wherein it caters to different (sic) consumers and clientele not limited or restricted to only those children with learning difficulties.”

“18. ...The fact that the services of Education and Teaching of the earlier mark are intended for those children with learning difficulties... is enough to conclude that the services of the contesting marks are not identical nor similar. The services referred to by the subject mark are intended for entertainment purposes and not limited to children with learning difficulties as that of the earlier mark.”

63. The opponent responds in its written submissions, stating that the lack of limitation in the applicant’s specification allows it unrestricted use of the goods and services applied for, threatening to encroach on the domain of the opponent. It states:

“3. ...the Applicant makes the point that it has not placed any such restriction on its application to register the mark in connection with goods in Class 16. This then gives the Applicant unrestricted use, allowing it the freedom to use the mark in precisely the areas of the market in which the Opponent is already using the mark and with very significant overlap in the goods”.

¹⁰ See the submissions filed alongside the opponent’s evidence

“4. ...the Applicant is asking for unrestricted use of a mark that will lead to confusion in the market place and would not prevent the Applicant from using the mark in the same field as the Opponent. The Applicant protests that it has no such intention, but the Opponent submits that companies frequently change ownership and frequently change strategy”¹¹.

64. The opponent’s approach is correct insofar as it identifies the potential for conflict between the goods and services in the opponent’s specification which are subject to limitation and the broader terms of the applicant’s specification which could incorporate those of the opponent. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

Though strictly relating to goods, the principle can also be applied to the comparison of services. On that basis, make the following assessments. I keep in mind that the opponent’s goods and services are all subject to limitation.

- The applicant’s *video films* in class 9 is incorporated, and therefore identical to, the opponent’s *video recordings* (of the same class).
- In class 16, the applicant’s *printed matter; printed publications; books; music sheets; music scores; periodical magazines* and *photographs* fall within the ambit of the opponent’s *printed matter*. The goods are, therefore, identical.
- Also in class 16, the applicant’s *educational supplies* are encompassed by, and identical to, the opponent’s *teaching materials*.

¹¹ See the submissions filed alongside the opponent’s evidence

- The applicant's *teaching* and *education* in class 41 are identical to the opponent's *educational services* and *teaching services*.
- The applicant's *training* in class 41 is a fairly general term which could include the opponent's *conducting of seminars and workshops* and, moreover, could be encompassed by the opponent's *teaching services* and *educational services*. The services are identical.
- The applicant's *organisation of workshops* and *conducting of seminars* are identical to the opponent's *arranging and conducting of seminars and workshops* in class 41.

65. For the purpose of comparing the remaining goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* BL O/399/10 and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

66. I am guided by the relevant factors for assessing similarity identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, which were as follows:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

67. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

68. In *Kurt Hesse v OHIM*, Case C-50/15 P, the Court of Justice of the European Union (“CJEU”) stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

69. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of

examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings.

The applicant's remaining goods in class 9

Computer software

70. The applicant describes computer software as “the programs and other operating information used by a computer”, which generally marries with my understanding of the term. The use of software is extremely wide ranging. Whilst there would be the opportunity for software to be created for educational purposes, generally there is likely to be little conflict between the use of software (at large) and that of the opponent's goods. Consequently, there is unlikely to be a direct similarity between the goods' users; software often targets business users but can also appeal to the general public whereas the opponent's goods are likely to be selected strictly by those with a vested interest in education. None of the opponent's goods share their physical nature with computer software, appearing instead to encourage a much more interactive, hands-on experience. The respective trade channels are likely to be distinct and the competing goods are not typically sold in any degree of proximity. The goods are not immediately competitive, nor are they complementary in accordance with the case law; one cannot be said to be indispensable for the other and consumers would not expect the same entity to be responsible for the provision of both. Taking all findings into account, I conclude that the goods are not similar.

Computer hardware; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards

71. To my knowledge, there is no similarity of use to be found between the above goods and the opponent's goods. Though there may be a small degree of overlap in

the goods' respective users, the applicant's goods are, prima facie, of a considerably more technical nature, which may widen the opportunity for disparity in the users each set of goods attracts. There is unlikely to be any tangible similarity in the goods' physical nature, nor are they likely to reach the market via the same trade channels. In my experience, the competing goods are not typically sold in the same vicinity, given their dissimilar purpose(s). Whilst there may be occasions whereby the goods are sold in the same establishment, this is not sufficient for a finding of similarity, since shops can sell very different kinds of goods without consumers assuming they have the same origin¹². The goods are not interchangeable, bypassing the opportunity for competition, nor are they indispensable for one another, thus they are not complementary. All things considered, I find there to be no similarity.

The applicant's remaining goods in class 16

Paper; cardboard; stationery; adhesives for stationery or household purposes; artists' paint brushes; printing blocks

72. Whilst there is certainly the opportunity for the above goods to be utilised within an educational environment, their primary purpose is not restricted in this manner; the goods are not limited to use for the purpose of educating children with learning difficulties, as the opponent's *instructional and teaching materials* are. That said, there may be potential for a degree of similarity in the goods' users. To my knowledge, it would not be unusual for schools to purchase paint brushes or paper for use in the classroom, for example. I keep in mind, however, that the applicant's goods are likely to attract a much wider consumer group, including large scale businesses or the general public. Any scope for crossover in the respective trade channels is limited and, given the fairly niche nature of the opponent's specification, I find it unlikely that the goods would be available in any reasonable degree of proximity. The goods are not competitive, nor are they complementary. In my experience, consumers would not expect an entity specialising in learning aids and educational services to also provide the above listed goods (at large). Although I acknowledge that materials such as paper and cardboard may be the foundation for the *printed matter* or *teaching materials*

¹² *Znine Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), Case T-363/08*

offered by the opponent, this does not render the goods similar. The average consumer is unlikely to face a choice between purchasing pre-prepared teaching aids and purchasing the materials required to make their own. Despite the potential for use in the same (or a similar) setting, and for one to be a component of the other, all things considered, I do not find there to be any tangible similarity.

Computer printers (Inking ribbons for -)

73. As far as I can tell, there is nothing within the opponent's specification that is sufficiently comparable to the above goods, the use of which is distinctly narrow. There is unlikely to be any real similarity in the goods' respective users or in their physical nature. Given their dissimilar use(s), I find it highly unlikely that the goods would reach their respective markets via the same channels of trade or that they would be sold alongside one another, if even available in the same establishment. The goods do not occupy competitive roles, nor are they complementary. All things considered, I find that the goods are not similar.

Bookbinding materials

74. The opponent's mark is registered for *books*. Whilst books are often used for entertainment or educational purposes, bookbinding materials have a much more limited function; to physically bind the pages. Books at large are likely to be purchased by the general public, whereas bookbinding materials are likely to appeal only to the manufacturers. There is unlikely to be any similarity in the goods' physical nature and the trade channels for each are likely to be distinctive. In my experience, the goods are not traditionally sold alongside one another. Although there may be a relationship to be found between the goods, they are not competitive, nor are they complementary in the sense that consumers would expect the same undertaking to be responsible for both. On balance, I do not consider the goods to be similar.

Typewriters

75. Typewriters are mechanical devices used for imprinting characters onto paper by selecting individual keys. Their purpose is, therefore, different to that of the opponent's

goods. Though typewriters *may* be used (or at least, may *have been* used) in the field of education, it would, in my opinion, be far too convoluted an approach to find a conflict with the opponent's *instructional and teaching materials*. On this basis, I find it unlikely that there would be a significant overlap in the users of the respective goods; typewriters presumably appealing to a relatively limited consumer group. Any similarity in the goods' physical nature seems limited to the possibility that both may enable users to become accustomed to the letters of the alphabet. To my knowledge, the goods do not typically occupy the same trade channels, nor are they sold in the same area of the relevant establishment. There is little opportunity for competition between the respective goods and, whilst both could be used in an educational environment, the goods are not complementary insofar as consumers would expect the same undertaking to provide both, typewriters being a fairly specialist product. On balance, I find there is no similarity.

Plastic materials for packaging

76. Whilst some of the opponent's *teaching materials* could, in theory, incorporate plastic materials into their respective packaging(s), the core purpose of the competing goods remains entirely different. Furthermore, such a connection is purely speculative and one good being a component of the other is insufficient for a finding of similarity¹³. There is likely to be little overlap in the goods' users; it does not naturally follow that those interested in purchasing teaching materials will also take an interest in purchasing plastic packaging materials. There will be little correlation in the goods' physical composition. To my knowledge, they each reach the market via entirely different trade channels and are highly unlikely to be sold alongside one another. I cannot identify any degree of competition between the goods, nor do I find them to be complementary. All things considered, I find that there is no similarity.

The applicant's remaining services in class 41

Conducting of congresses

¹³ *Les Éditions Albert René v OHIM*, Case T-336/03

77. To my knowledge, a congress refers to a meeting held between peers or colleagues to discuss a specific topic of shared interest, which parallels my understanding of the word 'seminar'. To that end, I find *conducting of congresses* to be synonymous with the opponent's *arranging and conducting of seminars* and conclude that the services are identical. However, even if I am wrong in my understanding, there remains a close relationship between the services, both of which seek to facilitate discussions between their attendees. There is also the potential for an overlap in the services' users and the trade channels each moves through. Given the similarity in the nature of the services, they could easily be competitive. Taking all findings into account, if the goods are not identical, they are at least highly similar.

Production of television programs; film distribution; production of films; provision of non-downloadable films and television programs via a video-on-demand service

78. The services for which the opponent's mark is registered are purely educational. Be it the provision of training or arrangement of seminars, all are provided to benefit the education of children with learning difficulties and, presumably, comprise fairly specific content. The applicant's above services pertain to the production of television programs and films and the arrangement of their distribution. In my view, this is likely to result in an inconsistency between the respective users, the opponent's selected by those responsible for providing educational facilities and the applicant's, to my knowledge, often available to other businesses. There is unlikely to be any significant overlap in the nature of the services provided or the trade channels through which they reach the market, given their varying purpose. The services are not competitive, nor are they complementary. In conclusion, I do not find there to be any similarity between the competing services.

79. The opponent is also relying upon *sound and video recordings* which, prima facie, may appear to have a closer relationship with the applicant's above services. However, the opponent's recordings are subject to a relatively narrow limitation and there is no evidence to suggest that they take the same format as television programs or films. Regardless, whilst a video or film may, of course, be used for training purposes, this is by no means analogous to the provision of video or film production services; there is a stark contrast between providing a film and television production

service and providing CDs with pre-recorded sound or video content. There remains a disparity in the users, nature and trade channels. I would not naturally assume, nor would I expect the average consumer to assume, that an entity providing CDs or recordings to support the education of children is also responsible for creating and distributing content within the film and television industry. Consequently, I do not find the opponent's goods to be similar to the applicant's aforementioned services (beginning *production of television programs*).

Entertainment services; production of shows; organizing and arranging exhibitions for entertainment purposes;

80. The above represents a variety of services intended to provide entertainment. Though 'production of shows' does not specify entertainment as its purpose, in my experience, 'shows' typically refers to performances intended to entertain, albeit in widely varying formats. In terms of use, this creates a clear distinction with the opponent's goods, the core purpose of which is to support the education of children with learning difficulties. Though I accept that there may be an overlap between the goods' users, due to the limitation attributed to the opponent's services, the scope for this seems fairly limited. The nature of the services will differ, given their contrasting intentions, although it would not be unusual for educational services to incorporate an entertaining element. There is unlikely to be a correlation in the services' trade channels. To my knowledge, educational services and training are likely to generate custom through deliberate promotion via the relevant channels (learning establishments, for examples), whereas consumers often independently seek opportunities for entertainment. The services are not competitive, nor are they complementary. On balance, I find no similarity.

Organizing and presenting displays of entertainment [relating to style and fashion]; organization of [fashion] shows for entertainment purposes; arranging of exhibitions for cultural purposes

81. The above services specify the *type* of entertainment on offer. In my view, this takes them even further away from the opponent's services. As stated in the previous paragraph, the core purpose of the respective services is clearly distinctive. I am

unable to identify a direct similarity between the services' users or nature and, to my knowledge, they are likely to occupy entirely independent trade channels. Given the discrepancy in their purpose(s), the services are not competitive, nor are they complementary. I find there to be no similarity.

82. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

“49. ...I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. **If there is no similarity at all, there is no likelihood of confusion to be considered.** If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.” [my emphasis]

83. It follows that the opposition fails in respect of the following goods and services, and is dismissed accordingly:

Class 9: *Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards.*

Class 16: *Paper; cardboard; computer printers (Inking ribbons for -); bookbinding materials; adhesives for stationery or household purposes; artists' paint brushes; stationery; typewriters; plastic materials for packaging; printing blocks.*

Class 41: *Entertainment services; production of television programs; film distribution; production of shows; production of films; provision of non-downloadable films and television programs via a video-on-demand service; arranging of exhibitions for cultural purposes; organizing and arranging*

exhibitions for entertainment purposes; organizing and presenting displays of entertainment [relating to style and fashion]; organization of [fashion] shows for entertainment purposes.

The average consumer and the nature of the purchasing act

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

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

85. I have already dismissed the opposition in respect of some of the applicant’s goods and services. Consequently, it is only necessary for me to consider the average consumer for those which remain, i.e. those which still require an assessment of the likelihood of confusion. For all goods and services pertaining, at least peripherally, to education, the average consumer is likely to be a professional representative looking to source educational aids and/or training facilities for the relevant audience, which may be teachers or support assistants, for example. The end users are likely to be the students themselves who will personally interact with the goods and benefit vicariously from the training. For the goods, the average consumer is likely to consider factors such as suitability and durability and for the services, it is likely to also consider cost and time implications, as well as possible qualifications or credentials to be attained. The cost of the goods and services can vary considerably, and purchases are made on a fairly infrequent basis. All things considered, I find it likely that the average

consumer would pay an above average level of attention to the selection process. When it comes to the remaining goods and services (not specifically related to education), the purchases may be made more frequently. Whilst the average consumer is less likely to be influenced by a sense of delegated responsibility (to ensure the appropriate standard of learning for others), factors such as suitability, content and potential benefits are likely to remain essential to their consideration process. That being so, it seems probable that the attention paid will still be at least of an average level.

86. For all goods and services at issue, keeping in mind the typical method of selection and given that much of the promotional and marking material is generally of a visual nature (catalogues, websites and traditional retail establishments, for example), visual considerations are likely to dominate the selection process. That said, given that it would not be unusual for recommendations to be made orally or for enquires to be made over the telephone, for example, aural considerations cannot be ignored.

Comparison of trade marks

87. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
ADDACUS	ADDACUS

88. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

89. Both the opponent's mark and the applicant's mark consist solely of the word 'ADDACUS'. They are clearly identical in every respect (visually, aurally and conceptually).

Distinctive character of the earlier trade mark

90. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

91. Whilst the opponent has not claimed that the distinctive character of its earlier mark has been enhanced through use, it has filed evidence in support of its use. Although I have found the exhibits sufficient for the purpose of demonstrating use, the opponent

has not provided the additional context required to make a finding of enhanced distinctiveness; the market value and its share, for example. Consequently, an assessment must be made purely on the basis of the mark's inherent distinctiveness.

92. It is widely accepted, though only a guideline, that words which are invented often possess the highest degree of distinctive character, whilst words which are suggestive or allusive of the goods and/or services relied upon generally possess the lowest. The average consumer is, in my view, likely to interpret the opponent's mark as an invented word with no clear meaning. Though I accept that some consumers may find 'ADDACUS' reminiscent of the word 'abacus', particularly given the goods and services for which the opponent's mark is registered, the opponent's mark is not directly suggestive or descriptive of the goods and services for which it is registered. Consequently, I find it to possess a fairly high degree of inherent distinctiveness.

Likelihood of confusion

93. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

94. Earlier in this decision I reached the following conclusions:

- Some competing goods and services are identical, some are similar to a high degree (if not identical) and others are not similar at all;
- The average consumer is a professional representative seeking to organise educational services and attain the relevant resources. Visual considerations are likely to dominate the selection process. Aural considerations are also relevant;
- At least an average degree of attention will be paid to the selection of goods and services;
- The competing trade marks are identical;

- The opponent's trade mark possesses a fairly high degree of inherent distinctive character.

95. To make the assessment, I must adopt the global approach advocated by the case law and take account of each of the above conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them retained in its mind.

96. Taking all relevant factors into account and, in particular, on the basis that the opponent's mark possesses a fairly high degree of inherent distinctiveness and given that the competing marks are identical, I find it likely that direct confusion would arise in relation to all goods and services whereby at least a low degree of similarity has been identified, given that consumers have no mechanism by which they can distinguish between the marks.

Conclusion

97. Subject to any successful appeal, the application **will proceed to registration** for:

Class 9: *Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards.*

Class 16: *Paper; cardboard; computer printers (Inking ribbons for -); bookbinding materials; adhesives for stationery or household purposes; artists' paint brushes; stationery; typewriters; plastic materials for packaging; printing blocks.*

Class 41: *Entertainment services; production of television programs; film distribution; production of shows; production of films; provision of non-downloadable films and television programs via a video-on-demand service; arranging of exhibitions for cultural purposes; organizing and arranging*

exhibitions for entertainment purposes; organizing and presenting displays of entertainment [relating to style and fashion]; organization of [fashion] shows for entertainment purposes.

and **will be refused** for:

Class 9: *Video films.*

Class 16: *Printed publications; printed matter; books; music sheets; music scores; periodical magazines; photographs; educational supplies; instructional and teaching material (except apparatus)*

Class 41: *Teaching; education; training; arranging, conducting and organisation of workshops; conducting of seminars and congresses;*

Costs

98. Whilst both parties have achieved a measure of success, the applicant's success is proportionately greater and it is entitled to a contribution toward its costs. Awards of costs in proceedings are governed by Annex A of TPN 2 of 2016. Applying the guidance in that TPN, I award costs to the applicant on the following basis:

Preparing a counterstatement: £300

Total: £300

99. I order ADDACUS Ltd to pay Fashion One (Europe) N.V. the sum of £300. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of December 2018

**Laura Stephens
For the Registrar**