o/969/22

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3,587,255 BY FUTURE (AWARDS AND QUALIFICATIONS) LIMITED

AND IN THE MATTER OF AN OPPOSITION UNDER NUMBER 425,171 BY QUALSAFE LIMITED

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF ARRAN COOPER (O/561/22) DATED 30 JUNE 2022

DECISION

Introduction

1. This is an appeal from the decision of Mr Arran Cooper, for the Registrar, dated 30 June 2022 (O/561/22) where he partially upheld the opposition of Qualsafe Limited to Future (Awards and Qualifications) Limited's trade mark application (No. 3,587,255) under section 3(1)(b) and (c) of the Trade Marks Act 1994. The opposition under section 3(1)(d) failed. Future (Awards and Qualifications) Limited appeals.

2. The Appellant applied to register the word mark CERAD in Classes 9, 16 and 41. But before me the appeal was initially confined to the following services in Class 41 only:

> Class 41: Education; training; all relating to the training of paramedic and ambulance personnel; information, advisory and consultancy services relating to the aforesaid services.

Standard of review

3. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion nor a belief that he or she has reached the wrong decision will suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. I remind myself of the principles to be applied, which were summarised by Joanna Smith J in *Axogen Corporation v Aviv Scientific Ltd* [2022] EWHC 95 (Ch) at [24]. When considering this appeal, and applying these principles, it is important to remember the high bar set.

The Appeal

4. The only ground of appeal in this case is that the Hearing Officer was mistaken in his finding that the Appellant has not established acquired distinctiveness in the acronym CERAD. Initially, the Appellant also challenged the Hearing Officer's assessment of

the relevant public. In the end, I did not need to consider this as my reading of the Hearing Officer's decision accorded with what the Appellant sought to establish as the correct relevant public.

Background

5. The Appellant created a new qualification called the Certificate in Emergency Response Ambulance Driving. It is aimed at those training to become (or progress their careers) as ambulance drivers or paramedics. It is claimed that the qualification became known by the acronym CERAD. The Hearing Officer held that the relevant public, comprising people looking to receive training or achieve an education in the fields of paramedics or ambulance personnel (Decision, 15), would see CERAD and understand it to mean the Certificate in Emergency Response Ambulance Driving. The Hearing Officer went on to conclude that the sign CERAD was descriptive and devoid of distinctive character. He finished by finding that the Appellant had not acquired distinctiveness in CERAD and therefore the objections under section 3(1)(b) and (c) of the Trade Marks Act 1994 succeeded.

6. The Appellant does not itself teach the CERAD courses, in that it does not have classrooms where teachers directly interact with students. Instead, it approves certain third parties to deliver its CERAD course. The Hearing Officer suggested that the Appellant therefore provides accreditation services. The word accreditation is not directly referred to in the specification at all, but accreditation would fall within the scope of "Education" in Class 41 (but would not cover its entire scope). In any event, during the appeal the Appellant applied to limit its specification (without objection from the Respondent) to the following educational services in Class 41:

> Development of qualifications, standards, approval of training providers, quality assurance of training providers, awarding of certificates, assessment and certification services, all relating to the training of paramedics and ambulance personnel

7. Therefore, the appeal is confined to these services.

Descriptiveness of CERAD

8. The evidence showed that before the relevant date only the Appellant had developed a Certificate in Emergency Response Ambulance Driving (CERAD) course (and so there were no competitors using the same course title). This does not mean the Appellant's use of CERAD could not be descriptive. As it was explained *obiter* by Fry LJ in *In re Leonard & Ellis's Trade Mark* (1884) 26 Ch. D. 288 at 304:

> When a new material is invented, and at the same time a new single word is invented which is applied to that material alone, I am by no means satisfied at present that that single word can be treated as a special and distinctive word within the meaning of the section [10 of the Trade Marks Registration Act, 1875]. It is difficult to suppose that one word can both describe the thing as made by anybody and the thing as made by a particular maker.

9. The key point is that where a word has been used to identify a particular good or service, rather than a particular trader, it is not functioning as an indication of origin but as a

description of the goods (see In *Re Chesebrough's Trade-Mark "Vaseline."* [1902] 2 Ch 1).

10. This basic proposition, which is over a hundred years old, explains how consumers identify whether something is a trade mark or not. Accordingly, the principle is just as relevant under the current law today as it was when it was first stated and there is no principled distinction between goods and services as to its application. Indeed, recently in the passing off case of *Wirex Ltd v Cryptocarbon Global Ltd* [2021] EWHC 617 (IPEC) it was found by Judge Hacon that just because a trader had coined a neologism (in that case Cryptoback) did not stop the sign being descriptive (at [29]).

11. Thus, where a new service is introduced (such as a training course) and only a new invented word (CERAD) is used in relation to that service then that new word can be descriptive of the service. In this case, the issue is complicated further because CERAD is an acronym for a course name - Certificate in Emergency Response Ambulance Driving.

12. As I have explained, the Hearing Officer considered the issue in terms of whether the sign was descriptive/devoid of distinctive character and then he moved on to consider whether it had acquired distinctiveness as a trade mark (a sequential approach). Acquired distinctiveness is relevant where a sign begins as descriptive, but through a trader's use it has acquired distinctiveness as a mark. In other words, it has moved from being descriptive to being distinctive. The current case is different.

13. First, there is the fact that the relevant public had to be educated that CERAD was an acronym for the course (see T-16/02 *Audi v OHIM* [2003] ECR II-5167). If they did not know this fact then the relevant public would see CERAD as a distinctive arbitrary series of letters. Secondly, the question the Hearing Officer should have considered is similar to that in *VASELINE*; namely, when the relevant public saw the mark CERAD was that public associating the sign with a training course having certain characteristics or was it associating the sign with a course linked to the Appellant and only the Appellant?

14. In general, therefore, the educating process for the sign CERAD (both in terms of descriptiveness and distinctiveness) was happening at the same time and it was not sequential. So, this is not a case where acquired distinctiveness is relevant.

15. There could in theory be a part of the relevant public where acquired distinctiveness was relevant because the public changes its mind, initially learning that CERAD was descriptive and then subsequently linking it to a particular undertaking (or vice versa). But such a case requires chronological evidence of consumer education and then re-education. No such evidence was provided by either party.

16. In this case, the Hearing Officer had to consider each piece of evidence to determine whether the use of the sign educated consumers to see CERAD as descriptive of a type

of course or whether it educated them to see CERAD as linked to the Appellant's course only.

17. In other words, once the Hearing Officer had considered each piece of evidence and concluded that on balance the evidence showed that the relevant public saw the sign CERAD as descriptive that should have been the end of it. The same evidence could not then show that in fact the relevant public came to associate CERAD with the Appellant and only the Appellant. Such a conclusion would be a nonsense as it would mean the relevant public would be seeing the same use as both descriptive *and* distinctive at the same time.

18. The Hearing Officer's approach was therefore flawed and so I allow the appeal. Furthermore, his consideration of descriptiveness was intertwined with that for acquired distinctiveness (see, for instance, Decision, [33]). While the issues are very similar, I do not think it is safe or appropriate to unpick his findings on descriptiveness and acquired distinctiveness and then try to stitch them back together on appeal.

19. This means it is necessary for all the evidence to be considered afresh to determine whether the objections under section 3(1)(b) and (c) should stand. In these circumstances, the proper course of action is for me to remit the case back to the registrar for a fresh determination and for it to be heard by a different Hearing Officer.

Conclusion

20. The appeal is allowed, and the matter is remitted back to the registrar for the objections under section 3(1)(b) and (c) of the Trade Marks Act 1994 to be considered again. The Appellant was successful in its appeal and so it is entitled to a contribution towards its costs of £1,000. However, as the Appellant may ultimately be unsuccessful, I will leave it to the Hearing Officer who rehears the matter to determine the final allocation of costs.

PHILLIP JOHNSON
APPOINTED PERSON
6 November 2022

For the Appellant: Mr Tim Blower, IP-Active.com
For the Respondent, Mr Matt Sammon, Sonder & Clay