

**O/0071/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3881439  
BY MULRONEY CREATIVE CONSULTANCY LTD.**

**TO REGISTER:**

**P.U.L.S.E.**

**AS A TRADE MARK IN CLASSES 9,16, 35, 38, 41 AND 42**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 441097  
BY TEACHERCENTRIC LIMITED**

## BACKGROUND AND PLEADINGS

1. On 23 February 2023, Mulrone Creative Consultancy Ltd. (“the applicant”) applied to register the trade mark shown on the cover page of this decision (“the contested mark”) in the UK. The application was accepted and published for opposition purposes on 17 March 2023, in respect of goods and services in classes 9,16, 35, 38, 41 and 42.<sup>1</sup>

2. On 31 May 2023, the application was opposed by Teachercentric Limited (“the opponent”), based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods and services in the application. The opponent relies upon the following UK trade marks (“UKTM”):

i)  Pulse

UKTM no. 3366121

Filing date: 10 January 2019; registration date: 5 April 2019

Relying upon all the goods and services for which the mark is registered.<sup>2</sup>

(“the First Earlier Mark”)

ii) Staff Pulse

UKTM no. 3428332

Filing date: 12 September 2019; registration date: 13 November 2020

Relying upon all the goods and services for which the mark is registered.<sup>3</sup>

(“the Second Earlier Mark”)

3. The above marks qualify as earlier marks under section 6(1) of the Act. As they had not completed their registration procedure more than five years before the application date for the contested mark, they are not subject to the use provisions contained in section 6A of the Act. Consequently, the opponent may rely upon all the goods and

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<sup>1</sup> See goods and services comparison.

<sup>2</sup> See goods and services comparison.

<sup>3</sup> See goods and services comparison.

services for which the earlier marks are registered without having to establish genuine use.

4. When it filed its opposition, the opponent correctly completed section A of the Form TM7 by indicating that the opposition is based on section 5(2)(b) of the Trade Marks Act, that is, that the contested mark is similar to the earlier marks, and that the respective goods and services are either identical or similar.

5. Furthermore, in Section A of the Form TM7, the opponent indicated the following:

- the goods or services covered by the earlier trade marks relied upon for the opposition;
- statement of use – confirmed that the registration process for the earlier marks was not completed 5 years or more before the application date;
- the goods and services in the application that are identical or similar to those covered by the earlier marks;

6. It is noted that at 'Q5' of section A of the Form TM7, the opponent can provide further information as to why they consider there to be a likelihood of confusion, for example, why do they consider that the respective marks, and the goods and services are sufficiently similar. However, it is noted that the opponent did not provide any information in this section, nor did they include a statement of grounds, expanding on why they consider the respective marks and goods and services to be similar, under section 5(2)(b) and why it is considered that there is a likelihood of confusion.

7. The applicant filed a counterstatement denying that the respective marks and the goods and services at issue are similar to the degree that the marks cannot co-exist.

8. The applicant is represented by The Trademark Helpline, whereas the opponent is unrepresented.

9. Only the applicant filed evidence. Neither party requested a hearing, and neither filed written submissions in lieu of a hearing. This decision is taken following a careful review of the papers.

## **EVIDENCE AND SUBMISSIONS**

10. The applicant filed evidence in the form of the witness statement of Jenna Mulrone, dated 19 February 2024, which is accompanied by 7 exhibits (JM1 to JM7). Ms Mulrone is the applicant's Director, a position she has held since 20 February 2023. Her evidence provides an overview of the applicant's company and an overview of the creation and use of the applied-for mark 'P.U.L.S.E.'

11. The applicant's evidence was accompanied by written submissions.<sup>4</sup>

12. I do not consider it necessary to summarise the evidence or submissions here. However, I have taken them into consideration in reaching my decision and where necessary, will refer to them below.

## **RELEVANCE OF EU LAW**

13. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

## **DECISION**

### **Section 5(2)(b)**

14. Sections 5(2)(b) is relied on and reads as follows:

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<sup>4</sup> Filed on 19 February 2024.

“5(2) A trade mark shall not be registered if because-

(a)...

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

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

15. Section 5A states:

[...]

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

16. I am guided by the following principles which are gleaned from the decisions of the EU courts 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:

(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 great 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **Comparison of goods and services**

17. The goods and services to be compared are:

### Applicant's goods and services

#### *Class 9*

Podcasts; Downloadable podcasts.

#### *Class 16*

Workbooks containing exercises; Educational books; Exercise books; Printed reports; Printed research reports; Printed consumer reports.

#### *Class 35*

Marketing; Digital marketing; Promotional marketing; Marketing services; Marketing consulting; Marketing advice; Marketing information; Marketing forecasting; Marketing research; Marketing consultation services; Marketing management advice; Advertising and marketing; Business marketing consultancy; Marketing plan development; Marketing advisory services; Marketing agency services; Marketing analysis services; Direct marketing consulting; Search engine marketing services; Analysis relating to marketing; Investigations of marketing strategy; Provision of marketing information; Planning of marketing strategies; Preparation of marketing plans; Administration relating to marketing; Marketing research or analysis; Analysis of marketing trends; Design of marketing surveys; Business marketing consultation services; Development of marketing concepts; Provision of marketing reports; Professional consultancy relating to marketing; Marketing, advertising, and promotional services; Creative marketing plan development services; Statistical evaluations of marketing data; Video recordings for marketing purposes (Production of -); Provision of marketing advisory services for manufacturers; Consumer profiling

for commercial or marketing purposes; Arranging and conducting marketing promotional events for others; Providing marketing consulting in the field of social media; Providing advice in the field of business management and marketing; Business project management services; Management of business projects [for others]; Advisory services relating to sales promotion; Consulting in sales techniques and sales programmes; Providing advice relating to sales methods and techniques; Brand strategy services; Consultancy regarding public relations communications strategy; Consultancy regarding advertising communications strategy; Business strategy and planning services; Consultancy and advisory services in the field of business strategy; Consultancy regarding advertising communication strategies; Writing of business project reports; Advertising; Advertising analysis; Advertising services; Advertising copywriting; Advertising and advertisement services; Consultations relating to business advertising; Arranging of presentations for business purposes.

#### *Class 38*

Podcasting; Podcasting services; Provision of access to content, websites and portals; Providing access to platforms and portals on the Internet.

#### *Class 41*

Training services relating to retail marketing; Training courses in strategic planning relating to advertising, promotion, marketing and business; Creation [writing] of podcasts; Creation [writing] of educational content for podcasts; Production of podcasts; Educational services relating to sales training; Arranging of workshops; Conducting workshops [training]; Conducting courses, seminars and workshops; Arranging professional workshop and training courses; Conducting educational workshops in the field of business; Consultancy and information services relating to arranging, conducting and organisation of workshops; Digital video, audio and multimedia entertainment publishing services; Provision of non-downloadable videos; Video recordings [not downloadable] provided from the internet; Training in the field of advertising; Arranging of presentations for educational purposes; Arranging of presentations for training purposes.

#### *Class 42*

Hosting of podcasts; Preparation of design reports.

Opponent's goods and services

UKTM 3366121 (First Earlier Mark)

*Class 9*

Educational computer software; Software and applications for mobile devices; Software applications; Software applications for use with mobile devices; Software; Surveying software; Software for the analysis of business data.

*Class 35*

Human resources consultancy; Human resources management; Data processing; Psychometric testing for the selection of personnel; Surveys (Business -); Surveys (Market -); Surveys for business purposes.

*Class 41*

Educational advisory services; Educational and teaching services; Educational services; Educational services provided for teachers of children.

*Class 42*

Software as a service; Software as a service [SAAS] services; Software as a service [SaaS].

UKTM 3428332 (Second Earlier Mark)

*Class 9*

Software and applications for mobile devices; Software applications; Software applications for mobile devices; Software applications for use with mobile devices; Software for computers; Software for smartphones; Software for tablet computers; Software; Computer programs; none relating to or connected with healthcare or social care.

### Class 35

Human resources consultancy; Human resources consultation; Human resources management; Data processing; none being services relating to or connected with healthcare or social care.

### Class 42

Software as a service; Software as a service [SAAS] services; Software as a service [SaaS]; Software as a service [SaaS] featuring computer software platforms for artificial intelligence; Software as a service [SaaS] featuring software for deep learning; Software as a service [SaaS] featuring software for deep neural networks; Software as a service [SaaS] featuring software for machine learning; none being services relating to or connected with healthcare or social care.

18. Where the goods or services in the specification of one party are included in a broader term from the other party's specification, those goods or services are considered to be identical: See *Gérard Meric v OHIM*, Case T-133/05 at [29].

19. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

"23. In assessing the similarity of the goods or services concerned, ... all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

20. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* ("Treat") [1996] R.P.C. 281 include an assessment of the users and the channels of trade of the respective goods or services.

21. In *Kurt Hesse v Office for Harmonisation in the Internal Market (Trade Mark and Designs)* ("OHIM"), Case C-50/15 P, the 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 General Court (“GC”) stated that “complementary” means:

“82. ...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”.

22. For the purposes of considering the issue of similarity of the goods, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.

23. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

"12. ... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. ... Nevertheless the principle should not be taken too far. ... 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."

24. In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms: *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), at [56].

25. As previously stated, with regards to the opponent’s viewpoint on the similarity of the goods and services, when it filed its opposition, although the opponent indicated that the opposition is based on section 5(2)(b) of the Act, that is, that the respective goods and services are either identical or similar, the opponent has not expanded on this. I am of the view that this has left the applicant substantially in the dark about why the goods and services at issue are claimed to be identical or similar. It seems to me

therefore that the applicant did the best it could when it addressed the similarity between the respective goods and services in its written submissions,<sup>5</sup> namely:

“The marks may share classes but there are no shared terms, literally or semantically, in class 9, 35 or 42. Only the '121 mark shares similar terms with the Pulse mark in class 41. However, the terms in the '121 mark point towards educational services related to teaching, whereas the terms in class 41 of the Pulse mark indicate the provision of training and education in relation to marketing and business services.”

26. Taking guidance from Iain Purvis KC, sitting as Appointed Person in the *SmartX* trade mark decision,<sup>6</sup> in the absence of the opponent’s statement of grounds or any submissions regarding the similarity of the goods and services at issue, I will proceed to make my own comparison. Accordingly, as per *Separode*, I will approach the comparison of the goods and services at issue by grouping them collectively in as few groups as I consider logical. Further, where the terms listed are particularly wide or vague, I will endeavour to follow the principles outlined in *YouView* and *Skykick* by comparing what I consider to be the core meaning of the goods or services, without affording them neither a too liberal, nor an artificially narrow, interpretation.

27. Pursuant to section 60A of the Act, I am mindful of the fact that the goods and services are not to be automatically regarded as being similar to each other merely on the ground that they appear in the same class, nor automatically regarding them as dissimilar from each other on the ground that they appear in different classes. I also note that in *Unicorn Studio Inc v Veronese* Case CH-2023-000214, Iain Purvis, KC, sitting as deputy High Court judge, stated that any finding of similarity (between goods and services) requires the exercise of common sense.<sup>7</sup> Meanwhile, in *RALEIGH INTERNATIONAL Trade Mark* [2001] RPC 11, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, observed that when goods or services are not identical or self-evidently similar, the opposition should be supported by evidence as to their similarity.<sup>8</sup>

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<sup>5</sup> Filed on 19 February 2024.

<sup>6</sup> BL O/0911/24, at [32].

<sup>7</sup> At [24].

<sup>8</sup> Paragraph 20

## The opponent's Second Earlier Mark

28. For the avoidance of doubt, I do not consider that the limitation, '*none relating to or connected with healthcare or social care*', contained in classes 9, 35 and 41 of the opponent's specification to be relevant to my comparison of the parties' goods and services.

### **Class 9 of the contested application**

#### Podcasts; Downloadable podcasts

29. In general terms, a podcast is a digital audio or video file which can be downloaded over the internet to, for example, a personal device. To download and listen and/or view a podcast users will ordinarily access it via the appropriate application software. It is noted that both earlier marks contain *software* and *software applications* in class 9. Therefore, as the opponent's goods can be used to access the contested goods, I find that the respective goods can target the same end user, can be distributed via the same trade channels and can coincide in producers. Furthermore, I find that there is complementarity between the goods. Accordingly, I find these goods to be similar to a low degree.

### **Class 16 of the contested application**

#### Workbooks containing exercises; Educational books; Exercise books; Printed reports; Printed research reports; Printed consumer reports

30. It is noted that neither of the opponent's earlier marks contain class 16. That said, I note that the opponent's First Earlier Mark contains *educational advisory services; educational and teaching services; educational services; educational services provided for teachers of children*, in class 41. In general, I acknowledge that goods and services are different in their nature, purpose and method of use, neither are they typically interchangeable. As such, I am of the view that the same can be said of the

parties' respective goods and services, although, that said, I find that the respective goods and services may be targeted towards the same end users.

31. It is not uncommon for educational service providers to supply materials which accompany their courses such as teaching aids, for example, workbooks, exercise books and reference materials, such as reports and educational books, etc. With that in mind, I find that some similarity exists between the above goods and the opponent's class 41 services contained in its First Earlier Mark, on the basis that they would be complementary. As such, I am of the view that the average consumer of the respective goods and services may assume that they come from the same source. Therefore, I find that the respective goods and services are similar to a low degree.

### **Class 35 of the contested application**

#### Design of marketing surveys

32. Broadly speaking, a survey is a method of gathering information by using relevant questions from a sample of people with the aim of understanding the relevant public as a whole. Surveys can be used for, *inter alia*, research, business, marketing and academic purposes, etc. The above contested services relate to the *design* of marketing surveys. Marketing surveys are a type of market research which can be used to assist businesses, by, for example, tailoring strategies and improving products, etc. The opponent's First Earlier Mark contains *surveys (market -)* in class 35. Whilst it is acknowledged that the services are not the same, I consider the opponent's services to be the end result of its design. As such, I find that there exists a complementary relationship with the above contested services and the opponent's *surveys (market -)*, on the basis that without the above services there would be no *surveys (market -)* end product. Whilst I acknowledge that the nature, purpose and method of use of the services may differ, there may be an element of competition, with the consumer selecting either bespoke services from the designer or choosing a marketing survey already on the market, for example. As such, I do not consider it unreasonable for the consumer to believe that the respective services derive from the same or related undertakings. Overall, I find there to be a medium degree of similarity between the above services.

Marketing research; Marketing research or analysis

33. In general terms, *market research* is the process of gathering information about target markets and customers, and understanding who they are and what they need. Whereas *surveys (market-)*, contained in Class 35 of the opponent's First Earlier Mark is a research method involving the collection of feedback and opinions from a target audience. Whilst the respective services are not strictly the same, I find that there are clear similarities between them, on the basis that market surveys can be used as a tool within market research. Accordingly, I find the respective services similar to a high degree on the basis that the services are likely to share a similar nature, purpose, channels of trade and end users.

Marketing; Digital marketing; Promotional marketing; Marketing services; Marketing information; Marketing analysis services; Analysis relating to marketing; Provision of marketing information; Analysis of marketing trends; Marketing consulting; Marketing advice; Marketing forecasting; Marketing consultation services; Marketing management advice; Business marketing consultancy; Marketing plan development; Marketing advisory services; Marketing agency services; Marketing analysis services; Direct marketing consulting; Search engine marketing services; Investigations of marketing strategy; Planning of marketing strategies; Preparation of marketing plans; Administration relating to marketing; Business marketing consultation services; Development of marketing concepts; Provision of marketing reports; Professional consultancy relating to marketing; Creative marketing plan development services; Statistical evaluations of marketing data; Video recordings for marketing purposes (Production of -); Provision of marketing advisory services for manufacturers; Consumer profiling for commercial or marketing purposes; Providing marketing consulting in the field of social media; Providing advice in the field of business management and marketing

34. In my view, there would be an overlap in users of the above contested broad terms and the opponent's *surveys (market -)*, contained in class 35 of its First Earlier Mark, and an overlap in producers and channels of trade. Broadly speaking, a market survey is a form of market research and a marketing tool used to gather data and insights

from a target audience about their preferences, behaviours and opinions, etc. Although it is acknowledged that the respective services differ in nature, I find that the data gathered by the opponent's *surveys (market -)* may prove pertinent in the provision of the above contested services. That said, I do not consider them to be complementary in a trade mark sense, on the basis that while market surveys may prove a useful tool in relation to the above marketing services, I am of the view that the two are not, as outlined in *Boston Scientific*, indispensable to each other. Overall, I find that the respective services can target the same end user, can be distributed via the same trade channels and can coincide in producers. As such, I am of the view that the average consumer of the respective services may assume that they come from the same source. Accordingly, I find there to be a low degree of similarity between the opponent's *surveys (market -)* and the above contested services.

Advertising; Advertising, and promotional services; Advertising; Advertising analysis; Advertising services; Advertising copywriting; Advertising and advertisement services; Consultations relating to business advertising; Consultancy regarding advertising communications strategy; Arranging and conducting marketing promotional events for others; Advisory services relating to sales promotion

35. The class 35 services in the opponent's earlier marks, contain, amongst other things, *human resource consultancy and consultation, human resource management, psychometric testing for the selection of personnel, data processing and surveys (business and market)*. In my view, the opponent's services are stand-alone services which have no direct connection with any of the above contested services. I find that the competing services will satisfy different consumer needs, will ordinarily originate from different providers and will move through different trade channels. Furthermore, I am of the view that the services are neither in competition nor are they complementary. Moreover, the opponent has not provided any submissions in relation to the comparison between the competing services, beyond suggesting that they are identical or similar. Accordingly, I find that the above contested services are dissimilar to all the opponent's class 35 services contained in its earlier marks. The same conclusion also applies to the opponent's remaining goods and services in classes 9, 41 and 42 of the earlier marks, on the basis that they share no direct similarities with the above contested services.

Business project management services; Management of business projects [for others]; Consulting in sales techniques and sales programmes; Providing advice relating to sales methods and techniques; Brand strategy services; Consultancy regarding public relations communications strategy; Business strategy and planning services; Consultancy and advisory services in the field of business strategy; Writing of business project reports; Arranging of presentations for business purposes

36. I do not find any obvious similarity between the applicant's remaining class 35 services, listed above, and the opponent's class 35 services contained in its earlier marks. I find that the services at issue will satisfy different consumer needs, will ordinarily originate from different providers and will be provided via different trade channels. Furthermore, the services at issue are neither in competition, nor are they complementary. Moreover, as previously stated, the opponent has not provided any submissions in relation to the respective services beyond its suggestion that they are identical or similar. Accordingly, I find that the above contested services are dissimilar to all the opponent's class 35 services in both its earlier marks. The same conclusion also applies to the opponent's remaining goods and services in classes 9, 41 and 42 of the earlier marks, on the basis that they share no direct similarities with the above contested services.

### **Class 38 of the contested application**

Podcasting; Podcasting services

37. In general, podcasting is the preparation and distribution of a radio show, for example, via a digital audio file to the electronic devices, such as computers and mobile phones, etc., of subscribed users. In order to access/listen to podcasts via electronic devices, users (subscribers) will be required to access the relevant software, such as a podcast app (application). It is noted that both earlier marks contain *software* and *software applications* in class 9. Therefore, as the opponent's goods can be used to access the contested services, I find there to be a degree of similarity between the respective goods and services. Whilst I acknowledge that the nature, purpose and method of use of the goods and services at issue is different, I do not consider it

unreasonable for the consumer to believe that the goods and services at issue derive from the same or related undertakings. Furthermore, I find that there is complementarity between the respective goods and services. Accordingly, I find these goods to be similar to a low degree.

Provision of access to content, websites and portals; Providing access to platforms and portals on the Internet

38. Broadly speaking, the above services relate to varying forms of telecommunication services. I do not find any obvious similarity between these services and any of the opponent's goods and services contained in its earlier marks. Even if it could be said that the above services might be needed to provide some of the opponent's services in class 41, for example, this is not sufficient to render the respective services similar or to consider them complementary. The contested services have a different nature (telecommunication versus education), and method of use. Further, they are not complementary in the sense that consumers may think that responsibility for provision of the services at issue lies with the same undertaking. Neither are they in competition with each other. Furthermore, they are not likely to be provided by the same undertakings (as they require different knowledge and expertise) and they are likely to be distributed/offered through different trade channels. Moreover, the opponent has not provided any submissions in relation to the comparison between the competing goods and services beyond its suggestion that they are identical or similar. Therefore, it is not obvious to me how these services could be similar to the opponent's goods and services. Accordingly, I find the contested services to be dissimilar to all the opponent's goods and services contained in its earlier marks.

**Class 41 of the contested application**

Educational services relating to sales training

39. As a broad term, I find that the opponent's *educational services* contained in class 41 of its First Earlier Mark encompasses the above contested services. Therefore, these services are identical in line with the principle set out in *Meric*.

Conducting educational workshops in the field of business; Arranging of presentations for educational purposes; Creation [writing] of educational content for podcasts; Training services relating to retail marketing; Training courses in strategic planning relating to advertising, promotion, marketing and business; Arranging of workshops; Conducting workshops [training]; Conducting courses, seminars and workshops; Arranging professional workshop and training courses; Training in the field of advertising; Arranging of presentations for training purposes

40. In my view, the above contested services are all types of *educational services* on the basis that educational services are commonly provided by way of training courses, educational presentations, educational podcasts, workshops and seminars, etc. As such, I find that the above contested services all fall within the opponent's broad term *educational services* contained in class 41 of its First Earlier Mark. These services are therefore identical in line with the principle set out in *Meric*. However, if I am wrong in my analysis, then I find that the respective services are similar to a high degree, on the basis that the services share a similar purpose and can coincide in producers, channels of trade and end users.

Consultancy and information services relating to arranging, conducting and organisation of workshops

41. Broadly speaking, *workshops* are interactive educational/training sessions. Therefore, I find that *workshops* are a type of educational service, and as such I am of the view that the contested *consultancy and information services relating to arranging, conducting and organisation of workshops* is manifestly similar in nature to the opponent's broad term *educational services* contained in class 41 of its First Earlier Mark. The services share a similar purpose and method of use, and trade channels and users may overlap. Furthermore, potentially the respective services could have a competitive relationship. Therefore, I find the services to be similar to at least a medium degree.

### Creation [writing] of podcasts; Production of podcasts

42. Generally, the production and creation of a podcast will involve, amongst other things, the planning of a topic, the writing of a script, and recording and editing the recording prior to its distribution. In general, podcasts are a form of entertainment. Whilst I acknowledge that the above contested services could feasibly incorporate some element of education, on balance I find these services to be dissimilar to the opponent's class 41 services contained in its First Earlier Mark, namely, *educational advisory services; educational and teaching services; educational services; educational services provided for teachers of children*. In my view the respective services have a different purpose and nature. They are provided in a different way and, therefore, do not share methods of use. Furthermore, they are not obviously in competition or complementary and they do not obviously share trade channels. Therefore, in the absence of any evidence or submissions to the contrary, I am of the view that the contested services and the opponent's class 41 services are dissimilar. The same conclusion also applies to the opponent's remaining goods and services in classes 9, 35 and 42 of its earlier marks, on the basis that they share no direct similarities with the above contested services.

### Digital video, audio and multimedia entertainment publishing services

43. Broadly speaking, the above publishing services allow individuals/businesses to create, edit and share digital video, audio and multimedia content online, via, for example, websites and podcasts, etc. Whilst I acknowledge that the above contested services could feasibly incorporate some element of education, on balance I find these services to be dissimilar to the opponent's class 41 services contained in its First Earlier Mark, namely, *educational advisory services; educational and teaching services; educational services; educational services provided for teachers of children*. I find that the nature and purpose of the contested services is not teaching or educational services but rather is entertainment. Therefore, there is little crossover of producers, users and trade channels. Accordingly, in the absence of any evidence or submissions to the contrary, I am of the view that the contested services and the opponent's class 41 services are dissimilar. The same conclusion also applies to the

opponent's remaining goods and services in classes 9, 35 and 42, of its earlier marks, on the basis that they share no direct similarities with the above contested services.

Provision of non-downloadable videos; Video recordings [not downloadable] provided from the internet

44. The class 41 services contained in the opponent's First Earlier Mark are all concerned with education and training, whereas the above contested services relate to the provision of videos/video recordings. Whilst I acknowledge that the above contested services could feasibly incorporate some element of education, on balance I find these services to be dissimilar to the opponent's class 41 services contained in its First Earlier Mark. As such, 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 at issue are unlikely to have the same intended purpose or methods of use and will likely target different consumers via different commercial channels and will be provided by different undertakings. Furthermore, they are neither in competition, nor are they complementary. As such, I see no reasonable basis for a finding of similarity between the respective services. Accordingly, in the absence of any evidence or submissions to the contrary I am of the view that the contested services and the opponent's class 41 services contained in its First Earlier Mark are dissimilar. The same conclusion also applies to the opponent's remaining goods and services in classes 9, 35 and 42, of its earlier marks, on the basis that they share no direct similarities with the above contested services.

**Class 42 of the contested application**

Hosting of podcasts

45. In the context of IT services and podcasts, the contested *hosting of podcasts* refers to the service that stores and delivers audio files for podcasts. Further, it allows creators to upload podcasts and distribute them to various podcast platforms. The opponent's class 42 services contained in both of its earlier marks contains the broad terms *software as a service; software as a service [SAAS] services; software as a service [SaaS]*. It is acknowledged that SaaS platforms can be used to host podcasts

by providing the infrastructure and tools necessary for creating, hosting and distributing podcasts, while podcasting can generate leads for SaaS companies. Accordingly, I find that there is a degree of similarity between the respective services. I find that it is entirely probable that a user of the contested services would access the services via the opponents SaaS services. I am of the view that the respective services may overlap in nature, users, trade channels and methods of use. Moreover, the services at issue are complementary in that they are important for one another, resulting in the consumer seeing a connection between the two and believing that the responsibility for both lies with the same undertaking. Accordingly, I find there to be a medium degree of similarity between the stated services.

#### Preparation of design reports

46. Broadly speaking, a design report is a written technical report normally produced by a specialist in a particular field, such as engineering or IT, etc. The purpose of the report is to, amongst other things, provide a written record of a particular project, document the process and outcomes of a design task, etc, and form an intrinsic component of a particular design process. The objectives of the reports will include, amongst other things, the development of new products, processes or services, or to bring about a significant improvement in existing products, processes or services. I do not find any obvious similarity between the contested services and the opponent's class 42 services contained in its earlier marks, which all relate to SaaS services. I find that the services at issue will satisfy different consumer needs, will ordinarily originate from different providers and will move through different trade channels. Even if the contested services can be accessed via the opponents SaaS services, this in my view is a general similarity which does not result in a shared method of use. Moreover, the opponent has not provided any submissions in relation to the comparison between the competing services beyond its suggestion that they are identical or similar.

47. Furthermore, I find that the contested services are in no way indispensable or important to the provision of the opponent's services,<sup>9</sup> and I see no reason why consumers would consider them to be provided by the same undertakings.

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<sup>9</sup> See *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL-O/255/13

Additionally, there is no complementary relationship between the respective services. There is unlikely to be any overlap in the trade channels, nor any degree of competition between them. Therefore, I find the above services and the opponent's class 42 services contained in the earlier marks to be dissimilar. Furthermore, this is even truer when comparing the contested services with all the remaining opposing goods and services in classes 9, 35, and 41, contained in the earlier marks, on the basis that they share no direct similarities with the above contested services.

48. Similarity of goods and services is essential for a finding of a likelihood of confusion.<sup>10</sup> As a consequence, the opposition fails with respect of the following services:

Class 35 Advertising; Advertising, and promotional services; Advertising; Advertising analysis; Advertising services; Advertising copywriting; Advertising and advertisement services; Consultations relating to business advertising; Consultancy regarding advertising communications strategy; Arranging and conducting marketing promotional events for others; Advisory services relating to sales promotion; Business project management services; Management of business projects [for others]; Consulting in sales techniques and sales programmes; Providing advice relating to sales methods and techniques; Brand strategy services; Consultancy regarding public relations communications strategy; Business strategy and planning services; Consultancy and advisory services in the field of business strategy; Writing of business project reports; Arranging of presentations for business purposes

Class 38 Provision of access to content, websites and portals; Providing access to platforms and portals on the Internet.

Class 41 Creation [writing] of podcasts; Production of podcasts; Digital video, audio and multimedia entertainment publishing services; Provision of non-downloadable videos; Video recordings [not downloadable] provided from the internet.

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<sup>10</sup> *Waterford Wedgwood plc v OHIM*, Case C-398/07 P, CJEU

### **The average consumer and the nature of the purchasing act**

49. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

50. 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. (as he then was) 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.”

51. The average consumer of the goods and services at issue is likely to include members of the general public as well as businesses and professional users. The goods and services will be available via both general retailers and more specialist ones, and their online or catalogue equivalents. At the retailers' physical premises, the goods will be displayed on shelves and in cabinets and information about the services will be displayed on signs and placards, both being self-selected by the consumer. A similar process will apply when the goods and services are selected online or via catalogues, in that a consumer will select them after seeing an image, on, for example, a webpage or in a catalogue. In my view, the visual component will dominate all methods of sale, although I do not discount an aural component playing a part given that orders may be placed by telephone or that word-of-mouth recommendations and advice may be received from sales assistants. Given the range of goods and services

at issue, the price and frequency of purchase will vary depending on their nature and type. In this regard, when selecting the goods and services at issue, the average consumer is likely to pay at least a medium degree of attention.

### **Comparison of the marks**


52. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

53. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

54. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

55. The respective trade marks are shown below:

The opponent's marks	The applicant's mark
<p data-bbox="435 344 724 421"><u>UK3366121</u> ("First Earlier Mark")</p>  <p data-bbox="427 591 735 667"><u>UK3428332</u> ("Second Earlier Mark")</p> <p data-bbox="501 694 660 725">Staff Pulse</p>	<p data-bbox="959 383 1110 414">P.U.L.S.E.</p>

56. With regard to the similarity of the marks, only the applicant filed submissions,<sup>11</sup> namely:

"The Applicant disputes that the Application and the Opponent's marks are similar to the degree that the marks cannot co-exist particularly as:

a. It has been well established that the average consumer perceives a mark as a whole and does not proceed to analyse its various details and that 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.

b. A side-by-side comparison of the marks shows significant differences; most notably the '121 mark is figurative, in colour and features a three-colour device in front of the text. The '332 mark is made up of two words, 'staff' and 'pulse' which combine to create a single meaning. The words 'staff' and 'pulse' are, even when combined, in such common usage that they do not have any distinctiveness on their own. Without further context, in assessing the mark to determine meaning, the public would put more weight on the word 'staff' in the '332 mark to rightly assume there is a link to human resources.

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<sup>11</sup> Filed on 19 February 2024.

c. In contrast, the Pulse mark is a word mark only and is comprised of capital letters each punctuated by a full stop. This style of punctuation denotes that the word is an acronym. The public is familiar with this common way of showing that a word is an acronym and would rightly read the Pulse mark in this way even if they could not discern the meaning of the acronym. It is highly unlikely that the relevant public would conflate the Applicant's acronym with either of the Teachercentric marks.

The Applicant's and the Opponent's marks both rely on additional devices (e.g., Punctuation, the colourful figurative device and the word "Staff") to further distinguish the marks. It is incredibly unlikely that the relevant public would confuse the respective parties' branding, business or products.

The visual, aural and conceptual differences are to such a significant degree as to negate any similarity in classes and terms regarding human resources.”

### Overall impression

#### *The opponent's marks*

57. The First Earlier Mark is figurative. It comprises the word 'Pulse' presented in a dark blue standard title case font. This word is preceded by a figurative device comprising three triangles of varying sizes, presented in the colours red, green and blue. The eye is naturally drawn to the element of the mark that can be read, resulting in the word 'Pulse' playing the greater role in the overall impression, with the figurative device playing a slightly lesser role.

58. The Second Earlier Mark consists of the words 'Staff Pulse' presented in a standard title case font. Neither of the words are particularly distinctive, and therefore I consider the overall impression of the mark resides in them equally.

### *The application*

59. The overall impression of the application is of the letters which comprise the word 'PULSE', presented in uppercase letters which are separated by full stops, in the manner of an acronym ('P.U.L.S.E.').

### Visual comparison

#### *The application and the First Earlier Mark*

60. The competing marks are visually similar in that they share the same dominant element, being the word 'PULSE'. The visual differences between the marks are the figurative device in the opponent's mark and the full stops between the letters in the application. Whilst I have found the device element to play a lesser role in the earlier mark, it will not be entirely overlooked by consumers. In respect of the punctuation marks in the application, it is my view that these elements would be overlooked by at least a significant proportion of consumers. Furthermore, whilst I acknowledge that the word 'Pulse' in the opponent's mark is presented in upper and lowercase coloured text, I bear in mind that notional and fair use of word marks would include use in any font and any colour,<sup>12</sup> so these are not distinguishing features between the marks. Overall, I find the marks to be visually similar to a medium degree.

#### *The application and the Second Earlier Mark*

61. Visually, the marks coincide in the presence of the word 'PULSE'. However, the additional word 'Staff' in the opponent's mark, and the full stops between the letters in the application are points of visual difference. As previously stated, it is my view that the punctuation marks in the application would be overlooked by at least a significant proportion of consumers. Furthermore, notional and fair use of the marks would include use in both upper and lower case, so the letter case used in the marks is irrelevant to the comparison. Taking all of this into account, I consider the marks to be visually similar to a medium degree.

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<sup>12</sup> *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17

## Aural comparison

### *The application and the First Earlier Mark*

62. The device element in the opponent's mark will not be articulated. As for the word element, as 'Pulse' is an English dictionary word it will likely be pronounced in the ordinary way. With regards to the applicant's mark, if it is seen and pronounced as the individual letters, there is no aural similarity between the marks. However, I find that it is more likely that the application is seen as an acronym, being a pronounceable abbreviation, and therefore, as the punctuation marks will not be pronounced, the mark will likely be pronounced as 'PULSE'. The longer an abbreviation is, which is capable of being pronounced (as acronyms are), the more likely and natural it is that consumers will pronounce it because this is easier, for example, NATO (North Atlantic Treaty Organisation) and BAFTA (British Academy of Film and Television Arts). Given that for UK consumers the letters 'P.U.L.S.E.' form a recognisable English word, to sound out each letter or the word each letter represents individually would, for example, be cumbersome, resulting in a lengthy phrase, therefore I find that it is more likely than not that the applicant's mark will be articulated as 'PULSE', which is aurally identical to the opponent's mark.

### *The application and the Second Earlier Mark*

63. With regards to the applicant's mark, if it is seen as the individual letters, there is no aural similarity between the marks. However, for the reasons already stated above, I am of the view that as the letters 'P.U.L.S.E.' form a recognisable English word, it is more likely than not that these letters will be articulated as 'PULSE', and therefore are aurally identical to the 'Pulse' element in the opponent's mark. The word 'Staff' in the opponent's mark will be a point of aural difference. Overall, I find the marks to be aurally similar to a medium degree.

## Conceptual comparison

64. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

### *The application and the First Earlier Mark*

65. The dominant element of the earlier mark is the ordinary English dictionary word 'Pulse', and whilst this word has numerous meanings which I do not intend detailing, these meanings will be well-known to UK consumers. As for the applicant's mark, it is my view that at least a significant proportion of consumers will overlook the punctuation marks between the letters in 'P.U.L.S.E.' and will, instead, perceive it as the ordinary dictionary word 'PULSE', and regardless of how this word is understood, the consumer will derive the same meaning from the opponent's mark. As for the figurative device element in the opponent's mark, this will not, in my view, convey any message to the consumer. Accordingly, where the punctuation is overlooked in the applicant's mark, the marks are conceptually identical. Even in the event that the punctuation marks between the letters cause consumers to separate the letters in their mind, and perceive 'P.U.L.S.E.' as an acronym, in my view, given the commonness of the word 'PULSE', I find that it is inevitable that the acronym 'P.U.L.S.E.' will be pronounced and recognised as the English dictionary word 'PULSE', and will therefore be given that conceptual meaning.

### *The application and the Second Earlier Mark*

66. For the reasons already stated, it is my view that the applicant's mark, for at least a significant proportion of consumers, will overlook the punctuation marks between the letters in 'P.U.L.S.E.' and will, instead, perceive it as the ordinary dictionary word 'PULSE', and even if the punctuation marks between the letters cause consumers to separate the letters in their mind, and perceive 'P.U.L.S.E.' as an acronym, in my view, I find that it is inevitable that 'P.U.L.S.E.' will be pronounced and recognised as the English dictionary word 'PULSE'.

67. The opponent's mark consists of the words 'Staff Pulse'. Each of these words will have well-known meanings to the UK consumer. However, when viewed in combination, I do not consider that the applicant's mark will have any obvious unitary meaning. As a result, its concept will be derived from the individual words themselves. Both words have multiple meanings and I do not intend to go into detail in respect of those meanings here as, regardless of how the word 'PULSE' is understood in the opponent's mark, the consumer will derive that same meaning from the applicant's mark. As for the word 'Staff' in the opponent's mark, the meaning derived from it is irrelevant as, regardless, it will be viewed as a point of conceptual difference between the marks. In my view, the marks are conceptually similar to a medium degree.

### **Distinctive character of the earlier trade marks**

68. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, 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).”

69. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

70. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use. Consequently, I have only the inherent position to consider.

#### *The First Earlier Mark*

71. The opponent’s mark is figurative consisting of the word ‘Pulse’ along with a figurative device. Whilst the word ‘Pulse’ will be understood as an ordinary dictionary word with a well-known meaning, it has no obvious connection with the goods or services for which the opponent’s mark is registered. With regards to the device element, whilst it cannot be overlooked, I do not find it particularly striking, nor does it have any obvious meaning in respect of the goods and services at issue. Considering the mark as a whole, I find the First Earlier Mark to be inherently distinctive to a medium degree.

#### *Second Earlier Mark*

72. The word mark consists of the words ‘Staff Pulse’. Individually, both words have well-known meanings to the UK consumer, though when viewed in combination I do not consider that the mark will have any obvious unitary meaning. Whether viewed individually or combined, the words have no obvious connection with the goods or services for which the opponent’s mark is registered. Therefore, considering the mark

as a whole, I find the Second Earlier Mark to be inherently distinctive to a medium degree.

### **Likelihood of confusion**


73. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services, and the nature of the purchasing process. In doing so, I must be mindful to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

74. 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.

75. Earlier in the decision I found that:

- The First Earlier Mark and the applicant's mark are visually similar to a medium degree, and either aurally and conceptually identical or dissimilar, depending on how the applicant's mark is perceived;
- The Second Earlier Mark and the applicant's mark are visually similar to a medium degree, and either aurally and conceptually similar to a medium degree or dissimilar, depending on how the applicant's mark is perceived;

- In respect of the First Earlier Mark, I have found the parties' goods and services to range between identical and dissimilar;
- In respect of the Second Earlier Mark, I have found the parties' goods and services to range between similar to a medium degree and dissimilar;
- The earlier marks have a medium degree of inherent distinctive character for the goods and services at issue.
- The average consumer would be a member of the general public as well as a business and professional user, who will pay at least a medium degree of attention during the selection of the goods and services at issue. The purchasing process would be predominantly visual, although aural considerations cannot be excluded entirely.

76. Taking into account all of the above, I find that the opponent's best case is represented by their First Earlier Mark, UKTM3366121 ' Pulse'. I will therefore consider the likelihood of confusion based on this mark first. I will return to the Second Earlier Mark only if necessary.

77. Whilst the marks are clearly not identical, I have found them to be visually similar to a medium degree and aurally and conceptually identical (for some consumers), on the basis that the marks identically share the letters 'PULSE', with the only difference being that the word 'Pulse' in the opponent's mark is preceded by a figurative device, whereas in the applicant's mark, the letters in the word 'PULSE' are separated by punctuation (full-stops).

78. For the reasons already stated, it is my view that at least a significant proportion of consumers will overlook the punctuation marks between the letters in 'P.U.L.S.E.' in the applicant's mark and will, instead, perceive it as the ordinary dictionary word 'PULSE', and even if the punctuation marks between the letters cause consumers to separate the letters in their mind, and perceive 'P.U.L.S.E.' as an acronym, in my view, I find that it is inevitable that 'P.U.L.S.E.' will be pronounced and recognised as the English dictionary word 'PULSE'. The fact that the marks share the letters 'Pulse /

P.U.L.S.E' is an important point of coincidence. Given the stated similarities between the marks, I am of the view that the average consumer is likely to remember the marks as 'PULSE' marks and either overlook or misremember the figurative element in the opponent's mark and the punctuation in the applicant's mark. As such, I am of the view that a significant proportion of consumers will mistake one trade mark for the other, despite some of the goods and services being only similar to a low degree. Accordingly, taking all these factors into account, I find that there is a likelihood of direct confusion.

79. I will also assess if there is a likelihood of indirect confusion.

80. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even

where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

82. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

83. In the event that the punctuation in the applicant’s mark and the figurative device in the opponent’s mark are not overlooked or misremembered, in my view these elements are consistent with a brand variant. The opponent’s mark is likely to be seen as a logo version of the ‘PULSE’ mark, and with regards to the applicant’s mark, I am of the view that even if the punctuation (full-stops) between the letters cause average consumers to separate the letters in their mind, I find that it is nevertheless unavoidable, given the commonness of the word ‘PULSE’, that the mark formed by the letters ‘P.U.L.S.E.’ will be recognised as ‘PULSE’ and given that conceptual meaning. Accordingly, I am of the view that consumers will simply consider that the parties’ marks, for the goods and services that I have found to be identical and similar to varying degrees, are variations used by the same or economically linked undertakings. Therefore, I find that there is a likelihood of indirect confusion.

## **Conclusion**

84. The opposition under section 5(2)(b) is partially successful in respect of the following goods and services, for which the application is refused:

Class 9      Podcasts; Downloadable podcasts.

Class 16 Workbooks containing exercises; Educational books; Exercise books; Printed reports; Printed research reports; Printed consumer reports.

Class 35 Design of marketing surveys; Marketing research; Marketing research or analysis; Marketing; Digital marketing; Promotional marketing; Marketing services; Marketing information; Marketing analysis services; Analysis relating to marketing; Provision of marketing information; Analysis of marketing trends; Marketing consulting; Marketing advice; Marketing forecasting; Marketing consultation services; Marketing management advice; Business marketing consultancy; Marketing plan development; Marketing advisory services; Marketing agency services; Marketing analysis services; Direct marketing consulting; Search engine marketing services; Investigations of marketing strategy; Planning of marketing strategies; Preparation of marketing plans; Administration relating to marketing; Business marketing consultation services; Development of marketing concepts; Provision of marketing reports; Professional consultancy relating to marketing; Creative marketing plan development services; Statistical evaluations of marketing data; Video recordings for marketing purposes (Production of -); Provision of marketing advisory services for manufacturers; Consumer profiling for commercial or marketing purposes; Providing marketing consulting in the field of social media; Providing advice in the field of business management and marketing

Class 38 Podcasting; Podcasting services.

Class 41 Educational services relating to sales training; Conducting educational workshops in the field of business; Arranging of presentations for educational purposes; Creation [writing] of educational content for podcasts; Training services relating to retail marketing; Training courses in strategic planning relating to advertising, promotion, marketing and business; Arranging of workshops; Conducting workshops [training]; Conducting courses, seminars and workshops; Arranging professional workshop and training courses; Training in the field of advertising; Arranging of presentations for training purposes; Consultancy and information services relating to arranging, conducting and organisation of workshops.

Class 42 Hosting of podcasts.

85. The application can proceed to registration in respect of the following services for which the opposition has been unsuccessful:

Class 35 Advertising; Advertising, and promotional services; Advertising; Advertising analysis; Advertising services; Advertising copywriting; Advertising and advertisement services; Consultations relating to business advertising; Consultancy regarding advertising communications strategy; Arranging and conducting marketing promotional events for others; Advisory services relating to sales promotion; Business project management services; Management of business projects [for others]; Consulting in sales techniques and sales programmes; Providing advice relating to sales methods and techniques; Brand strategy services; Consultancy regarding public relations communications strategy; Business strategy and planning services; Consultancy and advisory services in the field of business strategy; Writing of business project reports; Arranging of presentations for business purposes

Class 38 Provision of access to content, websites and portals; Providing access to platforms and portals on the Internet.

Class 41 Creation [writing] of podcasts; Production of podcasts; Digital video, audio and multimedia entertainment publishing services; Provision of non-downloadable videos; Video recordings [not downloadable] provided from the internet.

Class 42 Preparation of design reports.

### **Costs**

86. On balance, I consider both parties have enjoyed a share of success, with the greater part going to the opponent, who is, in principle, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 1/2023. I have made a reduction to the costs to reflect the partial extent of the success. Applying the guidance in that TPN, I consider the following to be fair:

Notice of Opposition fee	£100
Preparing the Notice of Opposition and considering the Counter Statement	£200
Considering the applicant's evidence and written submissions <sup>13</sup>	£150
<b>Total</b>	<b>£450</b>

56. I therefore order Mulroney Creative Consultancy Ltd. to pay Teachercentric Limited the sum of £450. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 27<sup>th</sup> day of January 2025**

**Sam Congreve  
For the Registrar**

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<sup>13</sup> Filed on 19 February 2024.