

O/0350/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003746052

BY NCFE

TO REGISTER:



AS A TRADE MARK IN CLASSES 9, 16, 35, 41 & 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 433288 BY

ENABLING ENTERPRISE CIC

BACKGROUND AND PLEADINGS

1. On 21 January 2022, NCFE (“the applicant”) applied to register the trade mark on the cover page of this decision in the UK (“the application”). The application was published for opposition purposes on 11 February 2022 and registration is sought for the goods and services listed in the **Annex** of this decision.
2. On 5 May 2022, the application was partially opposed by Enabling Enterprise CIC (“the opponent”). The opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and was aimed at only the applicant’s goods and services in classes 9, 35, 41 and 42. In bringing the opposition, the opponent relies on the following mark:



UK registration no. 3348107

Filing date 24 October 2018; registration date 1 March 2019

Relying on all goods and services, namely:

Class 9: Education software.

Class 35: Testing to determine employment skills.

Class 41: Education and training consultancy; Educational and teaching services; Educational services relating to business; Education; Education services; Educational services; Educational examination; Education examination; Educational examination services; Education information; Educational information services; Education information services; Educational information; Education services relating to vocational training; Educational testing; Educational consultancy services; Educational services provided for teachers of children;

Educational services provided to industry; Educational advisory services; Educational assessment services; Educational research; Education services relating to commerce; Education, teaching and training; Training relating to employment skills; Consultancy relating to vocational skills training; Teaching services for communication skills; Training in business skills; Education services relating to communication skills; Provision of skill assessment courses; Educational assessment services; Providing information about online education.

("the opponent's mark")

3. The opponent claims that the marks at issue are highly similar and that the applicant's goods and services subject to the present opposition are identical and/or highly similar to the goods and services in its own mark. As such, the opponent claims that there is a clear likelihood of confusion, including a likelihood of association, between the marks.
4. The applicant filed a counterstatement wherein it denied the claims against it.
5. Upon the filing of the counterstatement in this matter and in accordance with Rule 19 of the Trade Mark Rules 2008 and Tribunal Practice Notice 3/2007, the Tribunal issued a preliminary indication on 28 November 2023. The result of the preliminary indication was that due to the similarity of the marks and the identity/similarity of some of the goods and services at issue, there was a likelihood of confusion in respect of the same. The goods and services that were deemed to be identical/similar were as follows:

Class 9: Education software; educational computer applications; downloadable educational media; downloadable educational course materials; parts, fittings and accessories for the aforesaid goods.

Class 41: Provision of education, instruction, tuition and training; educational services; provision of training facilities and

programmes; accreditation of educational services; examination services; assessment services; mentoring of applicants; provision of examinations and other forms of assessment leading to qualifications, including national vocational qualifications; certification in relation to examinations and other forms of assessment; curriculum development relating to the development and specification of standards, practices, syllabuses and accreditation systems to enable national and international assessment of candidates; production of educational sound and video recordings; vocational guidance; arranging and conducting of tutorials; arranging and conducting exhibitions and seminars in relation to assessment of services, standards, qualifications, practices and syllabuses; information, advice and consultancy services in relation to the aforesaid services.

6. As for the remaining goods and services, the preliminary indication set out that there was insufficient similarity between them for a likelihood of confusion to arise. As a result, the outcome of the preliminary indication was that the opposition should succeed for some goods and services but be rejected for others.

7. The above being said, preliminary indications include a mechanism by which parties can declare their intention to proceed with their application/opposition in the ordinary way by filing a Form TM53 by a set deadline. It is noted that, on 21 December 2023, the applicant filed a Form TM53. No form was filed by the opponent. By failing to file the relevant form, the preliminary indication in respect of the goods and services for which there was no likelihood of confusion was upheld.¹ As a result, and because the applicant did file the relevant form, the opposition will only proceed in respect of the goods and services listed in the preceding paragraph.² These points were confirmed to the parties via written correspondence from the Tribunal dated 27 January 2024.

¹ These goods and services will, therefore, proceed to registration regardless of the outcome of this decision.

² It is noted in its written submissions that upon the issuance of the preliminary indication, the opponent stated that it limited its opposition so that it proceeded only against those goods and services for which the Hearing Officer indicated that the opposition would likely succeed. While I note that is no such correspondence in respect of this point, it may be the case that what the opponent means is that by not filing a Form TM53, it technically amended its claim according to the preliminary indication.

8. For the avoidance of doubt, the above-mentioned preliminary indication was issued by a Hearing Officer other than myself. Further, I am not bound by its outcome, and I only mention it in such detail because of its effect on the proceedings I must now decide. Having dealt with this point, I will say no more about the preliminary indication.

9. The opponent is represented by Baker & McKenzie LLP and the applicant is represented by Bates Wells & Braithwaite London LLP. Neither party filed evidence. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful consideration of the papers.

10. 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): legislation and case law

11. Section 5(2)(b) of the Act reads as follows:

“(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 or association with the earlier trade mark.”

12. Section 5A of the Act states as follows:

“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.”

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

- (a) a registered trade mark or international trade mark (UK) 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.

14. The opponent’s mark qualifies as an earlier trade mark under the above provisions. However, the opponent’s mark had not completed its registration process more than five years before the filing date of the application. This means that it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent may rely on all of the goods and services for which its mark is registered.

15. The following principles 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“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 the goods and services

16. The applicant's goods and services that remain subject to this opposition are set out at paragraph 5 above. The opponent's goods and services are listed at paragraph 2 above.

17. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"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".

18. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

19. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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 für 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.”

20. The opponent has made submissions in respect of the goods and services comparison. While these are noted, I do not intend to reproduce them here but will, if necessary, discuss them further below.

Class 9

21. “Education software” appears in both parties’ specifications. These goods are clearly self-evidently identical. I note that the applicant’s specification also includes the term “educational computer applications” which is clearly a type of educational software and, as such, it either describes the same goods as the opponent’s

“education software” or will fall within it. Therefore, these goods are either self-evidently identical or identical under the principle outlined in *Meric*.

22. In respect of the above terms, I note that the applicant’s specification includes “parts, fittings and accessories for the aforesaid goods”. Insofar as this applies to the software/application goods of the applicant, I find that this term is similar to a medium degree with the opponent’s “education software”. I say this because while the goods differ in nature, method of use and purpose, they overlap in trade channels as they will be produced/sold by the same undertakings. Further, the goods will be targeted at the same consumers meaning that there is also an overlap in user. Additionally, the education software is important to the parts, fittings and accessories for the same. Such a relationship is, in my view, sufficient to lead the consumer to believe that the goods are the responsibility of one undertaking.³ As such, they are complementary to one another.

23. The applicant’s terms of “downloadable educational media” and “downloadable educational course materials” are not items of educational software. Therefore, they are not identical to the opponent’s term of “education software”. Saying that, they are still similar. I say this because whilst their natures and methods of use differ, there is an overlap in purpose on the basis that both goods aim to educate the user. Further, the goods are likely to be produced by the same undertakings and available via the same distribution channels. As such, there is an overlap in trade channels. Additionally, the goods share the same user on the basis that someone looking for an education is likely to use both software and downloadable media/materials in respect of the same. On this point, there may also be a degree of competition between the goods on the basis that if a user did not use both, they would likely choose between them. Lastly, while there may be some instances where the media/materials are viewable on the opponent’s software, I do not consider that they are necessarily important/indispensable to one another. As such, they are not complementary to one another. Taking all of this into account, I find that these goods are similar to a medium degree.

³ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

24. As was the case with the software/application terms assessed above, the applicant's term of "parts, fittings and accessories for the aforesaid goods" applies to its downloadable educational media and materials also. In comparing this with the opponent's "education software", I find that while they differ in nature, method of use and purpose, they share the same trade channels. I say this because an undertaking that provides the opponent's software goods is also likely to produce and sell downloadable educational media/materials and as such, will also deal in the parts, fittings and accessories of the same. Further, the goods will all be aimed at the same consumer. While I found complementarity at paragraph 22 above, I do not consider the same applies here. This is on the basis that parts, fittings and accessories for educational media/materials are not important to education software, or vice versa. Overall, I find that these goods are similar to a low degree.

Class 41

25. "Educational services", "examination services" appear in both parties' specifications. These services are self-evidently identical.

26. "Assessment services" in the applicant's specification is a service sufficiently broad enough to cover the opponent's term of "educational assessment services". These services are, therefore, identical under the principle outlined in *Meric*.

27. The opponent's term of "educational services" is a very broad term and can cover any type of service that can be said to relate to the provision of education, be that by way of tuition, training or instruction. As such, I find that this term encompasses the applicant's terms of "provision of education, instruction, tuition and training mentoring of applicants", "arranging and conducting of tutorials" and "provision of training [...] programmes". These services are, therefore, identical under the principle outlined in *Meric*.

28. The opponent's specification includes the terms "educational assessment services", "educational examination services", "educational consultancy services" and "educational testing". It is my understanding that these terms are sufficiently broad so as to cover the provision of examinations in order to lead to various types

of qualifications as well as the provision of advice to educational institutions that may look to develop curriculums. Further, it is my understanding that the provision of such services would ordinarily be expected to cover the setting of the curriculums by which the assessments/examinations are intended to cover. As a result, I find that these services encompass the applicants' terms of "provision of examinations and other forms of assessment leading to qualifications, including national vocational qualifications" and "curriculum development relating to the development and specification of standards, practices, syllabuses and accreditation systems to enable national and international assessment of candidates." As a result, I find that these services are identical under the principle outlined in *Meric*. If I am incorrect on this point, then the services will still enjoy a degree of similarity with one another on the basis that they overlap in nature (being educational services), end purpose (being services aimed at ultimately developing the education of the user), trade channels and user. As such, if these services are not identical then they are similar to a medium degree.

29. As far as I am aware, the applicant's terms of "accreditation of educational services" and "certification in relation to examinations and other forms of assessment" are not actual educational services. That being said, they are services relating to educational exams and assessments relating to education. I say this because in order to certify or accredit educational services, there needs to be some educational assessment or examination services. As such, I find that the above services of the applicant fall within the opponent's terms of "educational examination services" and "educational assessment services". These services are, therefore, identical under the principle outlined in *Meric*. If I am wrong on this point, however, then I find that such services overlap in nature, purpose, trade channels and user resulting in a medium degree of similarity.

30. The applicant's terms of "provision of training facilities" is not an educational service, per se. However, it is similar to the opponent's "training relating to employment skills". I say this because while their natures, methods of use and purposes differ, there is an overlap in trade channels and user. I say this because, firstly, the provider of the opponent's term is also likely to provide facilities for their training services and will target those services at the same user. I do not consider

that the services are complementary or in competition. Overall, I consider that these services are similar to a low degree.

31. In respect of the applicant's "arranging and conducting exhibitions and seminars in relation to assessment of services, standards, qualifications, practices and syllabuses", I consider that these are similar to the opponent's "educational assessment services" on the basis that they overlap in trade channels and user. Similarly to the services assessed in the preceding paragraph, these services will be provided by the same undertakings and will be aimed at the same users. As such, they are similar to a low degree.

32. The applicant's term of "production of educational sound and video recordings" is not an educational service. While that may be the case, as the opponent's goods and services all relate to education, I will compare this term with the opponent's "educational services". These services clearly differ in nature and method of use. While the applicant's term covers the production of sounds/videos for educational purposes, the purpose of the actual service itself is to produce something. The purpose of the opponent's term is to provide education. As such, the purposes of the services differ. In respect of trade channels, I appreciate that some providers of educational services are likely to also produce educational materials such as video and sound recordings though I have nothing to suggest that this is common in the trade. As for user, I accept that the user of educational services would also use sound/video recordings relating to education, but they will not be the ones who actually seek the production service itself. As such, there is no overlap in user. Lastly, the services are not complementary, and neither are they in competition. Overall, I consider that while the services may relate to education, this is not sufficient in itself to warrant a finding of similarity. Even if there could be said to be an overlap in trade channels, I do not consider that this alone is sufficient to give rise to a finding of similarity. These services are, therefore, dissimilar.

33. "Vocational guidance" in the applicant's specification is a service aimed at consumers in order to provide them with advice in respect of their career prospects and choices. I note that the opponent's specification includes the term "educational advisory services". While relating to education, I see no reason why it cannot

encompass the applicant's term. I say this because when seeking an education advisory service, it can include the provision of a service akin to a guidance counsellor in school who provides advice as to what educational courses or subjects the user will need to take in order to gain the appropriate qualifications for the career they wish to pursue. As such, I am of the view that these services can be said to be identical under the principle outlined in *Meric*. Even if this is not the case, I find that the services are similar to a high degree on the basis that they share the same nature, purpose, trade channels and user.

34. Lastly, I note that the applicant's services include the term "information, advice and consultancy services in relation to the aforesaid services" at their end. As the majority of the services covered by the applicant's specification relate to educational services, I am of the view that this term is identical to the opponent's terms of "education information services", "educational consultancy services" and "educational advisory services". Even where it cannot be said to be identical, there remains a sufficient degree of similarity between the information, advice and consultancy services in respect of the applicant's services and the broad range of services of the opponent. At worst, this will be as a result of overlaps in trade channels and user, thereby warranting a low degree of similarity. That being said, I do not consider that this finding applies to the applicant's term insofar as it relates to "production of educational sound and video recordings". I say this because the opponent's terms do not cover advice, consultancy or information in relation to production services. Further, I have found those services to be dissimilar in any event so I see no reason why advice, consultancy or information in relation to the same would be similar to any of the opponent's terms.

Conclusion in respect of the goods and services comparison

35. While I have found identity/similarity in respect of the majority of the above goods and services, I have found the following terms to be dissimilar:

Class 41: Production of educational sound and video recordings; information, advice and consultancy services in relation to the aforesaid services.

36. In respect of this point, I remind myself that in order for there to be a likelihood of confusion in respect of the section 5(2)(b) ground, there needs to be some degree of similarity between goods and services.⁴ As a result, the opposition may proceed against all of the applicant's goods and services, save for those listed immediately above, which will proceed to registration regardless of the outcome of this decision.

The average consumer and the nature of the purchasing act

37. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services 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. (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.”

38. For the most part, the goods and services at issue are directed at the public at large. However, I do not discount the fact that the consumer base will also include professional users looking to gain qualifications as part of their employment. The goods and services are likely going to be available from educational providers directly. The purchasing process for the goods and services is likely to be largely visual as the average consumer will browse websites, see reviews in print and online media, and view promotional material (either in print or online). They may

⁴ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

also receive word-of-mouth recommendations and discussions with representatives from the provider. This means that there will also be a role for the aural aspect of the marks.

39. I consider that the price of the goods and services is likely to vary. For the most part, they will be relatively infrequent selections but I appreciate that some consumers may select them with a greater degree of frequency. For example, some professional users may require routine accreditations as part of their job roles. In respect of the degree of attention paid, I remind myself that the goods and services all relate to education and, as such, consumers will, generally, consider factors such as the subject/topic of the education, expertise of the provider, the length of the educational course, the eventual qualifications/certification gained and testimonials/reviews from previous customers. These are relatively ordinary factors that will result in the consumer paying a medium degree of attention when selecting the goods and services at issue. For the avoidance of doubt, I find that this outcome applies regardless of whether the goods or services are selected by members of the general public or professional users.

Comparison of the marks

40. It is clear from *Sabel v Puma AG* (particularly paragraph 23) 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 the trade marks, bearing in mind their distinctive and dominant components.



41. 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.”

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

43. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
 The logo for Skills Builder Partnership. It features a circular icon on the left composed of several colored segments (red, orange, yellow, green, blue). To the right of the icon, the words "Skills Builder" are written in a large, bold, sans-serif font, with "PARTNERSHIP" in a smaller, all-caps, sans-serif font below it.	 The logo for Skills Builder. It features two black chevrons pointing to the right on the left side. To the right of the chevrons, the words "SKILLS" and "BUILDER" are stacked vertically in a bold, all-caps, sans-serif font.

44. I have submissions from the opponent in respect of the comparison of the marks at issue. I can confirm that I have given these due consideration but will not reproduce them here.

Overall impression

45. The applicant's mark is a figurative mark that consists of both word and device elements. The word element consists of the word 'SKILLS' that sits above the word 'BUILDER'. Both words are presented in an ordinary black typeface with 'BUILDER' appearing in bold. Despite one word being in bold and the other not, I consider that 'SKILLS BUILDER' will form a unit. To the left of these words are two black chevrons that are pointing to the right. Given that consumers tend to be drawn to elements of marks that can be read, I find that the words 'SKILLS BUILDER' play the greater role in the overall impression of the mark. While the device element sits at the beginning of the mark (which usually tends to be the

point of focus for consumers),⁵ it plays a lesser role due to its nature as a fairly banal device element.

46. The opponent's mark is also a figurative mark that consists of word and device elements. The words are 'Skills Builder' which sits above the word 'PARTNERSHIP'. The words are presented in a standard typeface. The words 'Skill's and 'PARTNERSHIP' are in grey whereas 'Builder' is in black. To the left of these words is a circular device. Around the outside of the device is a series of multi-coloured arrow shapes flowing into each other. The centre of the device is white. While the eye of the consumer will be drawn to the words, the word 'PARTNERSHIP' simply indicates the nature of the business (in that it is a partnership) so will, therefore, play a lesser role to the words 'Skills Builder', which will ultimately play the greater role in the overall impression of the mark. While the words are presented in different colours, I consider that 'Skills Builder' forms a unit. As was the case with the device element in the applicant's mark, I find that while it sits at the beginning of the mark, it plays a lesser role due to its nature as a fairly banal device.

Visual comparison

47. Visually, the marks share their dominant elements, being the words 'SKILL BUILDER'. While presented differently, they are both fairly standard presentations of words. As such, the difference in presentation is not of any great impact to the visual comparison of the mark. The marks differ in their device elements and in the addition of the word 'PARTNERSHIP' in the opponent's mark. While playing lesser roles, they will still constitute points of visual difference. Overall, bearing in mind their overall impressions, I find that the marks are visually similar to a high degree.

Aural comparison

48. Aurally, the applicant's mark will consist of three syllables that will be pronounced in the ordinary way. As for the opponent's mark, it is likely that a significant

⁵ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

proportion of consumers will not seek to articulate 'PARTNERSHIP' due to its sole role as an indicator of the nature of the opponent's business. Therefore, I am of the view that the opponent's mark will also be pronounced as three syllables and in the ordinary way, therefore rendering it aurally identical to the applicant's mark. In the event that I am wrong to find that 'PARTNERSHIP' will not be pronounced then, in this scenario, I find that the marks are similar to a medium degree on the basis that their first three syllables remain identical and because, as above, consumers tend to focus on the beginnings of marks.⁶

Conceptual comparison

49. The concept of the applicant's mark will vest in the words 'SKILLS BUILDER'. This forms a unitary meaning and will be understood as a reference to something that assists the user in 'building' (i.e. developing or enhancing) their skills. As for the opponent's mark, I am of the view that because the addition of the word 'PARTNERSHIP' will simply be viewed as an indication of the nature of the opponent's business, it will be ignored from a conceptual viewpoint. As such, the concept of the mark will lie in the 'Skills Builder' element. This will be attributed the same meaning discussed above, therefore rendering the marks conceptually identical. That being said, even if 'PARTNERSHIP' is attributed a concept within the opponent's mark as a whole, it will only act as a slight point of conceptual difference. I say this because consumers are used to seeing marks that consist of indicators of the nature of businesses and will therefore, give it very little attention. Therefore, in this scenario, I find that the marks are conceptually similar to a high degree.

Distinctive character of the opponent's mark

50. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

⁶ On this point, I remind myself that, visually, the beginnings of the marks are device elements. However, aurally, the beginnings of the marks are the verbal elements discussed here.

“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).”

51. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Despite its initial pleading to enjoy an enhanced degree of distinctiveness, the opponent has not filed any evidence of use. Therefore, I have only the inherent position to consider.

52. The opponent’s mark is, as above, a figurative mark that consists of the words ‘Skills Builder’ sitting above the word ‘PARTNERSHIP’. To the left of these words is a colourful circular device element. In considering the words ‘Skills Builder’, based on everything I have said above, I find that this is clearly the dominant element of the mark. However, I am of the view that on a range of educational goods and services (being those at issue here), this will be somewhat allusive of the fact that the goods and services will assist the user in ‘building’ (i.e. developing)

their skills. The word 'PARTNERSHIP' will have very little impact on the mark as a whole as, as I have said already, it is a simple indicator of the nature of the opponent's business. As for the device, this will not be ignored and while it may be colourful, it does not, in my view, contribute to any material degree to the distinctiveness of the mark. Taking all of this into account and bearing in mind the allusive nature of the dominant element, I find that the opponent's mark only enjoys between a low and medium degree of inherent distinctive character.

Likelihood of confusion

53. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. 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. The first 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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive 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 minds.

54. I have found the goods and services to be identical or similar to various degrees, including low. The average consumer base is formed of members of the general public, though I appreciate that professional users may also seek the goods and services. The consumer will select the goods via primarily visual means (although I do not discount an aural component) after having paid a medium degree of attention. I have found the marks at issue to be visually similar to a high degree and aurally and conceptually identical (though I appreciate that this may instead be similarities to medium and high degrees, respectively, in the event that I was

wrong to treat 'PARTNERSHIP' in the opponent's mark as I have). Lastly, I have found that the opponent's mark is inherently distinctive to between a low and medium degree. In respect of the latter point, I remind myself that a weak distinctive character of an earlier mark does not preclude a likelihood of confusion.⁷

55. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am of the view that the marks at issue are likely to be misremembered or inaccurately recalled for one another. I say this because the marks share identical dominant elements, being the words 'SKILLS BUILDER'. Despite its lower distinctive character, the points of difference across the marks lie in their lesser elements, being their devices and the word 'PARTNERSHIP'. Further, any presentational differences between the distinctive elements are likely to be overlooked. As such, I consider that consumers will seek to recall the marks by using the words 'SKILLS BUILDER'. Therefore, they are likely to misremember the differences so will not be able to recall which mark has the word 'PARTNERSHIP', which had the colourful circular device and which had the device of sideways chevrons. Additionally, even if the marks as wholes are not necessarily conceptually identical (if 'PARTNERSHIP' is attributed an actual concept), the conceptual hook of the shared element is and, again, this will lead to consumers being directly confused as to which mark was which. Consequently, I find that there exists a likelihood of direct confusion. For the avoidance of doubt, the high level of similarity between the marks is such that I consider confusion exists regardless of the level of similarity between the goods or services at issue.

56. For the avoidance of doubt, I will now proceed to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein 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

⁷ *L'Oréal SA v OHIM*, Case C-235/05 P

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)".

57. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances wherein indirect confusion occurs.

58. In the event that the differences in the marks are noticed to the point that they result in the consumer not being directly confused, I am of the view that they represent a

paradigm case of indirect confusion. I say this because I consider it likely that the addition of the word 'PARTNERSHIP' will simply be viewed as a non-distinctive element that consumers will understand as a reference to the nature of the business, i.e. it is a partnership. Consumers will consider this a logical element that will be used in some circumstances but not in others. Further, it is logical to suggest that its removal or addition would be seen as an attempted re-branding of the 'SKILLS BUILDER' mark. The same goes for the difference in the device elements and in the presentation of the marks. In my view, they will simply be viewed as alternative marks used by the same undertakings in different scenarios or are logical indicators pointing to a rebranding. Consequently, I find that there exists a likelihood of indirect confusion. As was the case above, I find that the high level of similarity between the marks is such that confusion exists regardless of the level of similarity between the goods or services at issue.

CONCLUSION

59. For the most part, the opposition succeeds. Subject to any successful appeal of my decision, the application is refused for the following goods and services:

Class 9: Education software; educational computer applications; downloadable educational media; downloadable educational course materials; parts, fittings and accessories for the aforesaid goods.

Class 41: Provision of education, instruction, tuition and training; educational services; provision of training facilities and programmes; accreditation of educational services; examination services; assessment services; mentoring of applicants; provision of examinations and other forms of assessment leading to qualifications, including national vocational qualifications; certification in relation to examinations and other forms of assessment; curriculum development relating to the development and specification of standards, practices, syllabuses and accreditation systems to enable national and international

assessment of candidates; vocational guidance; arranging and conducting of tutorials; arranging and conducting exhibitions and seminars in relation to assessment of services, standards, qualifications, practices and syllabuses; information, advice and consultancy services in relation to the aforesaid services.

60. However, the applicant's mark may proceed to registration for not only those services I have found dissimilar but the goods and services that were not subject to the present opposition and those which the preliminary indication issued by the Tribunal determined to be dissimilar. The goods and services for which the applicant's mark may proceed to registration are, again subject to any successful appeal of my decision, as follows:

Class 9: Computer software and computer applications for creating, authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organising text, graphics, images, and electronic publications; computer software for e-commerce and downloadable magazines or downloadable publications; data recordings including audio, video, still and moving images and text downloadable electronic publication, magazines, periodicals, multi-media publications and other publications; computer, electronic and video games programmes; computer software and computer applications for accessing, browsing and searching online databases; CDs and DVDs; podcasts; downloadable podcasts; parts, fittings and accessories for the aforesaid goods.

Class 16: Paper and cardboard; printed matter; publications; magazines; books; activity books; periodicals; instructional and training materials; manuals; photographs; posters; cards; diaries; calendars; prints; leaflets; journals; syllabuses; notepads; writing instruments and crayons; personal organisers; address books; note books; educational equipment; educational publications; educational and instructional material; stationery and educational

supplies; printed educational materials; educational books; examination papers and certificates; parts, fittings and accessories for the aforesaid goods.

Class 35: Advertising; business management assistance; provision of business and business management advice; analysis of business skills and resources; office functions. database management; advertising; analysis of business skills and resources; office functions; business information and research services; business management consultancy; business consultancy; business advice; recruitment and placement services; recruitment schemes; employment agency services; personnel management and recruitment consultancy services; career advisory and information services (other than education and training advice) information, advice and consultancy services in relation to the aforesaid services.

Class 41: Non-downloadable electronic publications; publication of books and texts; publication of educational matter, materials, teaching materials, training guides, books and texts; organisation, production and presentation of shows, awards ceremonies, competitions, workshops, exhibitions and events; production of educational sound and video recordings; information, advice and consultancy services in relation to the aforesaid services.

Class 42: Quality control procedures in relation to examinations and other forms of assessment; quality control services in relation to examinations and other forms of assessment; certification of education services; information, advice and consultancy services in relation to the aforesaid services.

COSTS

61. While the goods and services permitted to proceed to registration outweigh those that are not, I remind myself that (1) the opponent did not attack the full specification of the applicant and (2) it did not pursue the opposition in respect of some goods and services after the preliminary indication. The outcome of my decision was to refuse all bar two terms that remained opposed in these proceedings. Therefore, I am of the view that the opponent has enjoyed the greater degree of success in these proceedings. As such, the opponent is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2016. In the circumstances, I do not consider it necessary to reduce the costs award to any degree to reflect the minor level of success enjoyed by the applicant and I hereby award the opponent the sum of £500 as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition and considering the counterstatement:	£200
Filing written submissions in lieu:	£300
Total:	£500

62. I hereby order NCFE to pay Enabling Enterprise CIC the sum of £500. 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 14th day of April 2025

A COOPER
For the Registrar

ANNEX

Class 9

Computer software and computer applications for creating, authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organising text, graphics, images, and electronic publications; computer software for e-commerce and downloadable magazines or downloadable publications; data recordings including audio, video, still and moving images and text downloadable electronic publication, magazines, periodicals, multi-media publications and other publications; computer, electronic and video games programmes; computer software and computer applications for accessing, browsing and searching online databases; CDs and DVDs; podcasts; downloadable podcasts; education software; educational computer applications; downloadable educational media; downloadable educational course materials; parts, fittings and accessories for the aforesaid goods.

Class 16

Paper and cardboard; printed matter; publications; magazines; books; activity books; periodicals; instructional and training materials; manuals; photographs; posters; cards; diaries; calendars; prints; leaflets; journals; syllabuses; notepads; writing instruments and crayons; personal organisers; address books; note books; educational equipment; educational publications; educational and instructional material; stationery and educational supplies; printed educational materials; educational books; examination papers and certificates; parts, fittings and accessories for the aforesaid goods.

Class 35

Advertising; business management assistance; provision of business and business management advice; analysis of business skills and resources; office functions. database management; advertising; analysis of business skills and resources; office functions; business information and research services; business management consultancy; business consultancy; business advice; recruitment and placement services; recruitment schemes; employment agency services; personnel management and recruitment consultancy services; career advisory and information services (other than education and training advice) information, advice and consultancy services in relation to the aforesaid services.

Class 41

Provision of education, instruction, tuition and training; educational services; provision of training facilities and programmes; accreditation of educational services; examination services; assessment services; mentoring of applicants; provision of examinations and other forms of assessment leading to qualifications, including national vocational qualifications; certification in relation to examinations and other forms of assessment; curriculum development relating to the development and specification of standards, practices, syllabuses and accreditation systems to enable national and international assessment of candidates; non-downloadable electronic publications; publication of books and texts; publication of educational matter, materials, teaching materials, training guides, books and texts; production of educational sound and video recordings; vocational guidance; organisation, production and presentation of shows, awards ceremonies, competitions, workshops, exhibitions and events; arranging and conducting of tutorials; arranging and conducting exhibitions and seminars in relation to assessment of services, standards, qualifications, practices and syllabuses; information, advice and consultancy services in relation to the aforesaid services.

Class 42

Quality control procedures in relation to examinations and other forms of assessment; quality control services in relation to examinations and other forms of assessment; certification of education services; information, advice and consultancy services in relation to the aforesaid services.