

O-011-20

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3220699
BY CAMBRIDGE SPARK LIMITED
TO REGISTER IN CLASSES 9 & 41
THE TRADE MARK**



AND

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

BACKGROUND

1) On 23 March 2017, Cambridge Spark Ltd (hereinafter the applicant) applied to register the trade mark shown on the previous page in respect of the following goods and services:

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

In Class 41: Education and training consultancy; Arranging and conducting of educational discussion groups, not on-line; Arranging and conducting of competitions [education or entertainment]; Academies [education]; Academy services (Education -); Academy education services; Arranging and conducting of educational courses; Arranging and conducting of educational events; Arrangement of conventions for educational purposes; Education and training services; Arranging and conducting educational conferences; Education in the field of data processing; Arrangement of seminars for educational purposes; Education services relating to vocational training; Education services relating to computer systems; Arranging and conducting of educational seminars; Adult education services; Advisory services relating to education; Education in the field of computing; Education in the field of computing science; Education, teaching and training; Education services relating to the application of computer software; Arrangement of conferences for educational purposes.

2) The application was examined and accepted, and subsequently published for opposition purposes on 7 April 2017 in Trade Marks Journal No. 2017/014.

3) On 5 July 2017 The Chancellor, Masters and Scholars of the University of Cambridge (hereinafter the opponent) filed notice of opposition. The opponent in these proceedings is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
CAMBRIDGE	UK 3015609	26.07.13 04.09.15	9	Electronic publications, downloadable; printed publications in electronically readable form; training manuals in the form of a computer

				program; computer software for the provision of training, education, examination and assessment.
			16	Instructional and teaching material (except apparatus); manuals; handbooks.
			41	Education; providing of training; arranging and conducting of conferences; arranging and conducting of seminars; advisory and consultancy services relating to the aforesaid services.
CAMBRIDGE	EU 12019733	26.07.13 29.08.15	9	Computer software; electronic publications, downloadable; printed publications in electronically readable form; training manuals in the form of a computer program; computer software for the provision of training, education, examination and assessment;
			16	instructional and teaching material (except apparatus); manuals; handbooks; manuals;
			41	Education; providing of training; arranging and conducting of conferences; arranging and conducting of seminars; advisory and consultancy services relating to the aforesaid services.
CAMBRIDGE	UK 3015696	29.07.13 18.07.14	9	Teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; audiovisual teaching apparatus; bags adapted for laptops; electronic pocket translators; mouse pads; portable telephones; mobile telephones; smartphones; handheld electronic devices for teaching and learning;

				portable electronic devices for teaching and learning; handheld electronic devices for examination and assessment; portable electronic devices for examination and assessment; handheld electronic devices for reading; portable electronic devices for reading; sleeves for laptops; sleeves for tablet computers; sleeves for portable computers; cases for mobile phones, tablets or portable computers; sound transmitting apparatus; sound recording apparatus; sound reproduction apparatus; teaching apparatus; electronic whiteboards; satellite telephones; solar powered telephones; video communications apparatus; wireless telephony apparatus; stands for computer equipment; digital book readers; parts and fittings for all the aforesaid goods.
--	--	--	--	---

- a) The opponent claims that it has reputation in the marks above in relation to the goods and services set out above, and for which its marks are registered. The opponent contends that the marks of the two parties are very similar and that the goods and services applied for are identical and/or similar to the goods and services set out above for which the earlier marks are registered. As such the mark in suit offends against Section 5(2)(b) of the Act.
- b) The opponent claims that it has reputation in the marks and goods and services shown above and claims that use of the mark in suit would take unfair advantage as the marks/goods and services are identical/ similar. Use of the mark in suit would also dilute the distinctiveness of its mark. As such the mark in suit offend against section 5(3) of the Act.
- c) The opponent claims that it has used the word CAMBRIDGE since the thirteenth century in respect of educational services and printing. As such use of the mark in suit would lead to misrepresentation amongst the public which will result in damage to the opponent. The mark in suit offends against section 5(4)(a) of the Act.

4) On 10 January 2019 the applicant filed a counterstatement basically denying all the grounds of opposition. The opponent seeks proof of use where appropriate.

5) Both parties filed evidence; both sides seek an award of costs in their favour. The matter came to be heard on 19 September 2019 when the applicant was represented by Mr Reeves of Messrs

Basck Ltd; the opponent was represented by Mr Stobbs of Messrs Stobbs IP Ltd.

OPPONENT'S EVIDENCE

6) The opponent filed two witness statements. The first, dated 28 March 2019, is by Lucy Cundliffe the opponent's Trade Mark Attorney. She provides a dictionary definition of the word "Spark" which gives the following, inter alia, results: A fiery particle thrown out or left by burning material or caused by the friction of two hard surfaces; a momentary flash of light; an electrical discharge; anything that serves to animate, kindle or excite; a trace or hint; vivacity, enthusiasm or humour; a fashionable or gallant man.

7) The second witness statement, dated 29 March 2019, is by Clare Dewhurst the brand protection manager of the opponent. She provides a history of the university dating back to 1209. She claims that the university has always referred to itself simply as Cambridge as she claims "because the public knows that in the contexts of education, publishing, sport, academia and research the word Cambridge always refers to the University of Cambridge". She states that the University offers 30 undergraduate courses and 330 postgraduate courses and has some 20,000 students. There are also 140 centres and institutes managed by the University which carry out research. Not all of these have the name Cambridge within their titles, (of the 57 listed at exhibit CD3 less than half had the word "cambridge" anywhere in their name); but Ms Dewhurst states that where they do "it is clear that this is a reference to the university". Why the average consumer would view it thus as opposed to seeing it as an indication of geographical location is not made clear. It is clear from the evidence (exhibit CD5) that the university is regarded as one of the best universities in the world.

8) Ms Dewhurst states that the University also offers a range of on-line, weekend, residential, summer and other part time courses for both personal development and professional development. These are referenced at exhibit CD6. The university also has a division known as Cambridge Assessment (CA) which provides assessment and examination services throughout the UK. It provides examinations in the UK via one of its divisions Oxford, Cambridge and RSA Examinations or OCR. Amongst the

examinations on offer are Cambridge Nationals, Cambridge Technicals and Cambridge Progression. It also offers school examinations for 5-19 year old students via Cambridge Assessment International Education, some 10,000 students in the UK took such exams in 2007-2008 (exhibits CD 8-10 refers).

9) Ms Dewhurst states that Cambridge University Press (CUP) is the world's oldest publisher starting in 1534; UK sales during the period 1 May 2011 to 30 April 2012 were £24.3 million. It produces a number of academic books as well as course materials and teaching manuals for use in regard of the examinations designed by the University. At exhibit CD14 is a photograph of some of the books published by CUP which shows the word CAMBRIDGE prominently on the spine and on the front cover. CUP has won a number of awards for publishing, a list of recent awards is provided at exhibit CD15. She provides the following turnover figures:

Year	Total income £million	From education and research £million	Cambridge Assessment £million	CUP £million
2010	1,190	719	266	223
2011	1,251	757	274	235
2012	1,322	799	309	247
2013	1,438	857	324	275
2014	1,504	909	351	265
2015	1.638	1,015	369	297

10) Ms Dewhurst claims that the word CAMBRIDGE “has been widely used in reference to the University in relation to the provision of educational services and as a centre of educational excellence”. She provides copies of press reports (exhibit CD20) and also excerpts from works of literature (exhibit CD21). She states that the University was a pioneer in computer science, and still remains at the forefront of teaching and research in computer science. She states that the courses offered by the university cover all aspects of modern computer science and that students are taught by leading researchers in the field. She provides the following exhibits which require further comment:

- CD6: The three pages all have The University of Cambridge prominently displayed. They also refer to the “Institute if Continuing Education (ICE)”and offer part time study at the university. They offer A levels, GCSEs and vocational qualifications.

- CD20: There are a number of stories from leading national UK newspapers which simply mention Cambridge initially. But they very quickly mention the University or state that the person in the story is a student at the university.
- CD21: Whilst a number of literary works mention Cambridge in relation to education or learning, many are set in periods where there were few if any schools and even fewer universities, and only the very wealthy were educated. Cambridge only really began to expand in the 19th century, and even at the end of the 19th century the university made up a considerable amount of the town (it only became a city in 1951). Perceptions today might differ considerably.

APPLICANT'S EVIDENCE

11) The applicant filed a witness statement, dated 29 May 2019, by Raoul-Gabriel Urma, the Managing Director of the applicant company a position he has held since 2016. He states that his company's principal activities are: "data science and software engineering, talent attraction, assessment and development through our proprietary software platform. My company is engaged in the development of computer software for training and providing technical training related to data science and software development for those engaged in various professional activities in the workplace". He states that the services offered by his company are directed at professionals and businesses who "wish to organise intensive bootcamps, apprenticeships, recruitment solutions and bespoke team training courses". He states that as they are located in Cambridge they chose this word to describe their geographical location.

12) Mr Urma states:

"11. I acknowledge that the opponent, the University of Cambridge is, without a doubt, a prominent and well recognised provider of student education, whose reputation extends well beyond the boundaries of Cambridge itself."

13) Mr Urma accepts that he and some of his team are graduates of Cambridge University and this is mentioned on the website but has never associated the company with the University. They also mention on the website the names of various companies such as IBM, Nokia, PWC and Microsoft who they have worked with or cooperated with previously.

14) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

15) Subsequent to the hearing, but with my permission, the applicant offered the following revised specification as a backstop.

In Class 9: Training software; Training manuals in the form of a computer program; Training guides in electronic format; Training manuals in electronic format; all the aforesaid related to high-tech, AI, data science and software development vocational training provided to professionals and companies.

In Class 41: Training services and training consultancy: training and consultancy services in the field of computer science, computer systems and in the application of computer software; training and consultancy services in the field of data processing; all the aforesaid related to high-tech, AI, data science and software development vocational training provided to professionals and companies.

16) The opponent was provided with the opportunity to comment and I shall record its views as and when necessary in my decision.

17) The first ground of opposition is under section 5(2)(b) which reads:

“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.”

18) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

19) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. The mark in suit was published on 7 April 2017 at which point the opponent’s marks had not been registered for over five years. Therefore, the proof of use requirements do not bite and the opponent can rely upon the full specifications registered.

20) When considering the issue under section 5(2)(b) I take into account 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

21) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine 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. 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.”

22) The goods and services sought to be registered are, broadly speaking, training manuals and software and education and training courses and services connected to education and training. The applicant contended that the average consumer would be primarily professionals looking to improve their skills, whereas the opponent contended:

“19. The terms at issue in both class 9 and class 41 are quite general and are not limited to any particular kind of specialised field that would identify the class of average consumers as being made up of a professional, specialised public. As they appear in the specification, the kind of training software, training manuals, education services and arrangement of conferences etc., could range from very general goods and services designed for the general public right through to specialised goods and educational services on very particular topics.

20. The Opponent’s submission is that the average consumer in this case is an ordinary consumer, who will be reasonably well-informed, observant and circumspect but will not pay a higher than average degree of attention during the purchasing act of the services at issue, despite the fact that the relevant public of average consumer could encompass a professional consumer (i.e. someone with an interest in a particular professional field).”

23) I accept that professional workers may wish to improve their skills but the specification covers all training software and manuals and education and training courses and services connected to education and training which would include goods and services for people who are illiterate (such as toddlers) and those who wish to learn a new skill or hone an existing one in areas such as DIY,

knitting, sewing or painting. Such consumers may purchase books /software or book a training course. In my opinion, the average consumer for the goods and services under consideration will be the general public including businesses. Turning now to the level of attention the average consumer will display when selecting the goods and services. I accept that, for the most part, the cost of the goods and services will vary considerably, but bearing in mind that the average consumer will wish to ensure they are selecting the correct type of software/manual or training course in terms of detail and level of training and in particular the subject matter, particularly in more specialised subjects or topics, they will pay an above average level of attention when selecting the goods so as to ensure they meet their criteria for personal improvement. An employer selecting training goods or courses for use by its employees is, if anything, likely to pay an even higher level of attention so as to meet its obligations to ensure that its employees have the requisite skills or can improve their existing skills, thus boosting their worth to the employer. I therefore find that relevant average consumers will pay at an above average degree of attention (or higher) when selecting the goods and services at issue.

24) Goods in class 9 such as training manuals and software will be sold through a range of channels, including retail premises such as book stores and computer stores as well as in less specialised outlets (where the goods are normally displayed on shelves and are obtained by self-selection). They will also be sold on-line and via catalogues. The initial selection is therefore likely to be a visual one, although I accept that the consumer may enter into a discussion with staff, for instance in better quality book stores. Considered overall, the selection process is likely to be predominantly a visual one, although I accept that aural considerations will also play their part.

24) Turning to the services in class 41, training courses, seminars & conferences etc. are likely to be selected from brochures, on-line and in person at premises such as colleges and universities. Simpler more straightforward courses and events will be self-selected and booked on-line or by phone with little if any discussion with the provider. However, more complex courses will require a discussion to determine if the course suits the person and vice versa. Considered overall, the selection process is likely to be, initially, predominantly a visual one, although I accept that aural considerations will play a much greater role in the selection process.

Comparison of goods and services

25) 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 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, 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”.

26) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (GC) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut 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”.

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

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

28) In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

29) In *Kurt Hesse v 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

30) As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

31) I shall first consider the goods in class 9, using the revised specification provided post hearing. The specifications of both parties are as follows:

Applicant's goods	Opponent's goods
In Class 9: Training software; Training manuals in the form of a computer program; Training guides in electronic format; Training manuals in electronic format; all the aforesaid related to high-	3015609: class 9: Electronic publications, downloadable; printed publications in electronically readable form; training manuals in the form of a computer program; computer software for the provision of training, education, examination and assessment.

tech, AI, data science and software development vocational training provided to professionals and companies.	12019733: class 9: As 3015609 above but with the addition of “computer software”.
--	---

32) Clearly, the opponent’s specification of “computer software for the provision of training” is identical to the applicant’s “Training software”. Equally, the opponent’s specification of “ training manuals in the form of a computer program” is identical to the applicant’s “Training manuals in the form of a computer program”. Equally clearly, the whole of the opponent’s specification encompasses the remainder of the applicant’s specification namely “Training guides in electronic format; Training manuals in electronic format”. The specifications in class 9 of the two parties are therefore identical. I must therefore turn to consider the limitation proposed by the applicant after the hearing to see if this affects the outcome.

33) The opponent’s provided submissions on the limitation to the effect that it was not compliant with the requirements of the *Postkantoor* case, which it contends:

“makes it clear that a trade mark cannot be accepted for registration for certain goods or services on condition that those goods and services do not possess a particular characteristic. The limitation that the Applicant has proposed effectively limits the coverage of e.g. training software to training software provided exclusively to professionals and companies, and excludes the same goods provided to other types of consumers. There is no recognisable sub-category of the goods and services at issue based on the type of consumer they are provided to. The limitation is therefore unacceptable.”

34) The opponent also attacks the wording used in the limitation, stating:

“The wording of the limitation is also open to interpretation. It is not clear if the listed terms “high-tech”, “AI” and “data science” are independent within the limitation (such that the limitation could be read as synonymous in meaning to “all of the aforesaid related to high-tech provided to professionals and companies, AI provided to professionals and companies, data science provided to professionals and companies and software development vocational training provided to professionals and companies”) or if they each also qualify “vocational training” (such that the limitation should be read as synonymous in meaning to “all of the aforesaid related to high-tech vocational training provided to professionals and companies, AI vocational training provided to

professionals and companies, data science vocational training provided to professionals and companies and software development vocational training provided to professionals and companies”). We suspect the latter, but it is not clear from the wording of the limitation and the limitation should only be accepted where its meaning is unambiguous.”

35) Whilst I do not accept the characterisation of the *Postkantoor* case as meaning that such a limitation cannot be accepted (see the comments of Arnold J. in *Omega SA (Omega AG) (Omega Ltd) v Omega Engineering Incorporated* [2012] EWHC 3440 (Ch)), I do accept some of the criticism of the wording used, which is less than clear and precise in its meaning and far too open to interpretation. However, this is not the biggest problem faced by the applicant. Even if I were to accept the limitation was correctly worded and was acceptable despite *Postkantoor*, the opponent’s specification suffers no limitation and so would encompass “high-tech vocational training provided to professionals and companies, AI vocational training provided to professionals and companies, data science vocational training provided to professionals and companies and software development vocational training provided to professionals and companies”. **The goods in class 9 remain identical even if the limitation is in force.** As the limitation makes no difference to the outcome of the instant case and is poorly worded I reject the limitation and the specification remains in its original form.

36) I now turn to the class 41 services of the two parties. The specifications are as follows:

Applicant’s services	Opponent’s services
In Class 41: Training services and training consultancy: training and consultancy services in the field of computer science, computer systems and in the application of computer software; training and consultancy services in the field of data processing; all the aforesaid related to high-tech, AI, data science and software development vocational training provided to professionals and companies.	3015609: class 41: Education; providing of training; arranging and conducting of conferences; arranging and conducting of seminars; advisory and consultancy services relating to the aforesaid services. 12019733: class 41: Education; providing of training; arranging and conducting of conferences; arranging and conducting of seminars; advisory and consultancy services relating to the aforesaid services.

37) The revised specification offered by the applicant is not a simple “blue lining” of the original specification applied for by the applicant. Whilst in the original specification it had “training services” and “training consultancy” it has narrowed these general terms as can be seen above and introduced a limitation. Unfortunately for the applicant the opponent has the term “providing of training” which encompasses all training irrespective of the field. It also has “consultancy services relating to the aforesaid services” which would include training and so encompasses any training consultancy services offered by the applicant. As the limitation does not affect the outcome and because its wording is open to criticism (see above) I reject the limitation and the specification remains in its original form. **The class 41 services of the two parties are identical.**

Comparison of trade marks

38) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. 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.”

39) 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 them. The opponent’s marks UK 3015609 and EU 12019733 are identical and provide the opponent with its strongest case. The trade marks to be compared are:

Opponent’s trade mark	Applicant’s trade mark
CAMBRIDGE	 CAMBRIDGE SPARK

40) When comparing the marks I take into account the views expressed in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix ‘mundi’ are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

41) I note that in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU found 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)."

42) The opponent submitted:

"16. The marks in this case are clearly very similar. In the Opponent's best case, the comparison is between CAMBRIDGE and CAMBRIDGE SPARK and Device. These marks coincide in the common verbal element CAMBRIDGE and as such are obviously visually, phonetically and conceptually similar to at least a medium degree.

17. Factors in favour of a finding of a high degree of similarity between the marks include:

17.1. The only element of the Opponent's distinctive CAMBRIDGE mark is contained entirely within the CAMBRIDGE SPARK and Device mark;

17.2. The Applicant admits in its Counterstatement (at paragraphs 9, 10 and 11) that the device element of its mark "depicts the initials CS, being the combination of Cambridge and Spark" or an "abbreviation of Cambridgespark". Whilst the device cannot be ignored in the overall analysis of similarity, it simply refers back to and reinforces the mark's verbal elements and as such is of reduced impact within the mark as a whole;

17.3. The additional verbal element "SPARK" within the Applicant's device is a point of difference but is the second of two verbal elements and a number of its potential meanings allude to a cerebral quality which weakens its distinctive impact, especially in the context of goods and services which are (or are linked) to education and training."

43) Whilst the applicant submits:

“3. Considering the above, the Applicant submits their trade mark, unlike the Opponent’s word marks, consist of other than the word CAMBRIDGE, highly distinctive elements, i.e. the turquoise logo element and the word SPARK.

4. The turquoise logo is an imaginative and creative representation of the letters “C” and “S” put together, thus highly distinctive for the goods and services it is applied to.

5. Further, according to Oxford dictionary, the word “spark” means “A small fiery particle thrown off from a fire, alight in ashes, or produced by striking together two hard surfaces such as stone or metal” (<https://www.lexico.com/en/definition/spark>), therefore, is highly distinctive for the goods and services it is applied to, despite the Opponent’s Witness Statements. None of the definitions provided by the Opponent render the word as used in the Applicant’s mark non distinctive. The word SPARK implies ingenuity and as such is a covert and skilful allusion to the quality of the Applicant’s goods and services and the word is therefore a separate distinctive element within the Applicant’s composite mark which assists in making the composite mark as a whole memorable in the minds of the relevant public.

6. Therefore, the Applicant submits that taking into account the other, distinctive elements of the Applicant’s mark, the Applicant’s mark is not visually, aurally or conceptually similar to the Opponent’s marks to the degree causing a confusion among consumers.”

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

45) The device element of the applicant’s mark, even if it is seen as the letters “CS” would not in my view be pronounced. Aurally the marks are “Cambridge spark” and “Cambridge”. There is initial identity with a difference in that the applicant’s mark has an additional word. The marks are phonetically similar to a medium degree.

46) Turning to the conceptual similarity I was referred to the decision of Mr Mitcheson QC acting as the Appointed Person in the NEWPORT CREEK case O-223-16, where he stated:

“22. In my opinion neither the fact that NEWPORT is a geographical location nor the *Formula One/Whyte and Mackay* case law provides sufficient justification for the finding of very low distinctiveness for the goods in issue, and on this basis I am entitled to assess afresh this aspect of the case and the resultant likelihood of confusion between the marks for the relevant goods. Even if, contrary to my primary view, this is not strictly an error of law or of principle, I consider that it falls within Lord Neuberger’s category (v) identified above.

23. I consider that NEWPORT for textile goods is a moderately distinctive mark. It is of course correct that there are a number of geographical locations called Newport, but as noted above there is no evidence of any link between these locations and textile goods, nor is there any other descriptive element in the mark. No doubt the inhabitants of or near any of the locations called Newport are used to the word being used more usually in a descriptive sense, but for the population as a whole I do not consider that the average consumer would attribute a low level of distinctiveness just because Newport is a geographical term. There are many other geographical terms which would have much lower levels of inherent distinctiveness than NEWPORT generally or more particularly for goods in class 24.

24. As for the level of conceptual similarity between the marks, the Hearing Officer found that this was low. The Opponent suggested that this was a further error and was only reached because of her incorrect application of the law relating to geographical locations. The Hearing Officer touched upon this in paragraph 19 under the heading “Comparison of Marks”, where she pointed out that Newport is the name of at least three locations and went on to conclude that there was a low level of conceptual similarity between Newport and Newport Creek:

“19. ...I consider the same to be true of NEWPORT CREEK: Newport qualifies Creek. A creek is a stream or inlet. There is some conceptual similarity in that both marks reference a place called Newport, but there are also differences. To the average UK consumer, Newport is the name of at least three locations, one of which is a city in South Wales, whereas the image of the opponent’s mark is of a stream or inlet named Newport, which may be a creek in one of the locations called Newport, or

simply a creek so named but without a connection to a place called Newport. There is a low level of conceptual similarity between the marks NEWPORT and NEWPORT CREEK.”

25. The Opponent criticised this and submitted that the Hearing Officer ought to have found a higher level of conceptual similarity between the two marks. Although there was no express link made by the Hearing Officer between her reasoning in paragraphs 19 and 22 of the Decision, I consider that for the reasons given above in relation to geographical locations the Hearing Officer also wrongly downplayed the conceptual similarity between the marks. I do not consider that there is a high level of conceptual similarity between NEWPORT and NEWPORT CREEK, but neither do I consider that it is low – like the visual and oral similarity I consider that there is a medium degree because of the possibility that the consumer will perceive the creek to be situated in Newport.”

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

48) I take into account the views in *The Picasso Estate v OHIM*, Case C-361/04 P, the Court of Justice of the European Union found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

49) **Overall, I believe that the marks have a low degree of similarity.**

Distinctive character of the earlier trade mark

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

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

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

51) I was referred to the NEWPORT CREEK case set out at paragraph 46 above. The applicant submitted:

“On behalf of the Applicant, we believe that the decision on appeal number BL/0422/15 in respect of Opposition OP000403585 can be distinguished in so far as it relates to the assessment of the distinctive character of the Opponent's earlier Trade Mark Registrations of CAMBRIDGE [EU Registration no 012019733 and UK Registration no 3015609] in the context of the present Opposition no 40969B against the Applicant's mark CAMBRIDGE SPARK and device, the subject of Application number 3220699

1. The Applicant agrees with the Hearing Officer Ms Judi Pike when, at paragraphs 19 and 21 of the Appeal decision she concludes that not all geographic locations automatically have a very low level of distinctiveness. The context is important and it is very different in the present case. She provides the example of BRAZIL as being potentially highly distinctive for software but not coffee. By analogy, CAMBRIDGE may be highly distinctive for coffee but not for education or high-tech goods and services.

2. At paragraph 23 she assesses the trade mark NEWPORT, in the context, for textile goods to be 'a moderately distinctive mark.' However in the same paragraph, she noted that there 'is no evidence of any link' between the three NEWPORT locations and textile goods [for which the trade mark NEWPORT is registered] nor is there 'any other descriptive element in the mark.'

3. By contrast Mark Bryant for the Registrar in the UKIPO decision 0-102-19 at para 55 in Opposition no. 410856 brought by the 'University of Cambridge' against the mark CAMBRIDGE NEUROTECH and device No 3233695 concluded that, in the context, the Trade mark CAMBRIDGE as a geographical location had a very low level of distinctive character which was confirmed by the evidence in that case linking Cambridge as a recognised location of a high tech cluster of companies.

4. The Applicant, Cambridge Spark Limited is one of those high tech cluster of companies, specialising in the development of software and other IT related products as well as high level training of working professionals in the IT and AI space, which is reflected in the amended list of goods and services proposed via email dated 25 September 2019. We would again refer you to paragraph 6 of our skeleton argument and exhibit RU2 of Roaul-Gabriel Urma for links to active websites of other trading companies in that high tech cluster where CAMBRIDGE appears as part of their names.

5.Finally, in the appeal decision no BL /0-422/15 relating to NEWPORT in which there was only one trade mark Registration of NEWPORT in class 24, Ms Judi Pike stated that 'the fact that there were no other NEWPORT marks in class 24 does not of itself support a finding of low distinctiveness; indeed it could be said to do the opposite' We agree and would draw your attention again to paragraph 7 and exhibits RU3 -RU9 of Raoul- Gabriel Urma's witness statement which details numerous coexisting registrations, inter alia , in classes 9 and 41 on both the EU and UK Registers , which stand in the name of different parties and incorporate the word CAMBRIDGE'."

52) The opponent contended:

"The Applicant's submissions in relation to this case acknowledge that the level of inherent distinctiveness of a geographical mark may vary in accordance with the goods and services at issue. The Applicant then proceeds to suggest that CAMBRIDGE lacks distinctive character in relation to the goods and services at issue on the basis that there would be an association between the place name and the goods in the mind of the consumer owing to the alleged existence of a high-tech cluster of companies in Cambridge. The Applicant points again Exhibit RU2 in support of this.

This point was dealt with at the hearing. Exhibit RU2 provides no useful information to the tribunal on whether or not there is a high-tech cluster in Cambridge, as it is simply a list of names and website links. Similarly, Exhibits RU3-9 to which the Applicant refers as showing additional registrations containing 'CAMBRIDGE' are as irrelevant now as they were deemed to be on the day of the hearing to the assessment of the distinctive character of the Opponent's mark."

53) Whilst I agree with the criticism of the applicant's evidence regarding other companies trading in the Cambridge area, using the term "Cambridge" and/or being in high tech, the opponent's own evidence shows this to be the case. Whilst the opponent filed its list of associated companies to show that it had an extensive reputation, over half of those listed did not have the term "Cambridge" within their title but were located within either Cambridge City and /or Cambridgeshire. The others which did

have “Cambridge” within their title would not necessarily be known to be associated with the University as contended by the opponent but considered to be merely located within the city and/or county. To my mind, **it has at least a low degree of inherent distinctiveness**. The opponent has provided evidence of its use and has made various claims regarding its reputation. Clearly, in respect of undergraduate and postgraduate studies and education the opponent has considerable world-wide reputation. It also has considerable reputation and use in respect of setting assessment and examinations for use by schools. But the opponent does not actually deliver the teaching in order to take the examinations. It does not provide teaching services to nursery, kinder-garden, primary or secondary school pupils. Whilst it may offer a limited amount of summer and other part time courses these will require participants to have more than a basic knowledge of the subject before being accepted onto the course. I do not consider that the opponent can claim to have a reputation in education, but only in graduate and post graduate education and the setting of examinations and assessment criteria. It is also clear that the opponent has used its mark extensively in respect of publishing. **As such the opponent can benefit from an enhanced degree of distinctives through use in relation to the “electronic publications, downloadable; printed publications in electronically readable form; examination and assessment” in class 9, the whole of its class 16 specification as registered and “providing of graduate and postgraduate education” in class 41.**

Likelihood of confusion

54) In determining whether there is a likelihood of confusion, 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 services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and 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 he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods and services is a member of the general public including businesses who will select the goods and services by predominantly visual means, although I

do not discount aural considerations and that they are likely to pay at least an average degree of attention (or higher) to the selection of the goods and services.

- the marks of the two parties have a low degree of similarity.
- the opponent's mark has a low degree of inherent distinctiveness but can benefit from an enhanced distinctiveness through use in relation to "electronic publications, downloadable; printed publications in electronically readable form; examination and assessment" in class 9, the whole of its class 16 specification as registered and "providing of graduate and postgraduate education" in class 41.
- the goods and services of the two parties are identical.

55) I take into account the views expressed in *Anncos, Inc. V OHIM*, Case T-385/09, where the General Court considered an appeal against OHIM's decision that there was no likelihood of confusion between ANN TAYLOR LOFT and LOFT (both for clothing and leather goods) and found that:

"48. In the present case, in the light of the global impression created by the signs at issue, their similarity was considered to be weak. Notwithstanding the identity of the goods at issue, the Court finds that, having regard to the existence of a weak similarity between the signs at issue, the target public, accustomed to the same clothing company using sub-brands that derive from the principal mark, will not be able to establish a connection between the signs ANN TAYLOR LOFT and LOFT, since the earlier mark does not include the 'ann taylor' element, which is, as noted in paragraph 37 above (see also paragraph 43 above), the most distinctive element in the mark applied for.

49 Moreover, even if it were accepted that the 'loft' element retained an independent, distinctive role in the mark applied for, the existence of a likelihood of confusion between the signs at issue could not for that reason be automatically deduced from that independent, distinctive role in that mark.

50 Indeed, the likelihood of confusion cannot be determined in the abstract, but must be assessed in the context of an overall analysis that takes into consideration, in particular, all of the relevant factors of the particular case (*SABEL*, paragraph 18 above, paragraph 22; see, also, Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37), such as the nature of the goods and services

at issue, marketing methods, whether the public's level of attention is higher or lower and the habits of that public in the sector concerned. The examination of the factors relevant to this case, set out in paragraphs 45 to 48 above, do not reveal, prima facie, the existence of a likelihood of confusion between the signs at issue."

56) I also consider the issue of indirect confusion, and take into account the case of *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.

57) I further note that in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

58) The applicant submitted:

"7. Further, the Applicant submits that even if the goods and services of both parties' trade marks may be found similar "on paper", the target public and channels of trade need to be taken into account before making such assessment. In this regard, we further reiterate our arguments contained in paragraphs 13-15 (page 6) of the continuation sheets to our Counterstatement around the dissimilarity of goods and services between the opponent's earlier marks and the Applicant's goods and services covered by their Application number UK00003220699. In particular, we emphasise that the Applicant's goods and services are delivered to a very

different target clientele to the Opponent. The Applicant is focused on developing software in the field of data sciences and delivering professional development courses based on that software to those in the workplace as well as individual professionals, whereas the Opponent is focussed broadly on the student population. As a result, there is no likelihood of confusion arising between the two marks or association with the Opponent's earlier marks, as the parties do not operate in the same markets and do not target the same audiences.

8. Considering the above, the Applicant submits that there is no likelihood of confusion and therefore the Opposition under Section 5(2)(b) of the Trade Marks Act 1994 shall be rejected.”

59) The applicant is wrong in believing that because in real life it provides its services to a very different clientele to the opponent that this is material in my judgment under this ground of opposition. Under section 5(2)(b) I have to consider the specification applied for, and that for which the opponent's mark/s is/are registered, not what they actually do in reality. The marks are not subject to proof of use, and, at the time the opposition was launched, the opponent's marks could not be the subject of a revocation action. Undoubtedly the fact that the opponent's marks are registered for such a sweeping description as “education” would, in my opinion, be unsustainable (based on the evidence provided in the instant case) if either proof of use was applicable or a revocation action were filed. However, this is immaterial as I have to consider the specifications as registered and clearly under such a system the applicant's comments on “audiences” cannot be upheld.

60) For their part the opponent submits:

“21. The high degree of similarity between the marks, coupled with the identity and/or close similarity of the goods and services, means that there is a clear likelihood of confusion in this case. Factors that increase the likelihood of confusion are as follows:

21.1. The identity and very close similarity of the goods and services is a factor in the multi-factorial analysis that will play into the increased likelihood of confusion;

21.2. The distinctive character of the Opponent's CAMBRIDGE mark is important here. The Opponent owns registrations of its CAMBRIDGE mark in relation to a wide range of goods and services overlapping with those of the Opponent. Inherently, the mark has an average degree of distinctive

character in the context of the goods and services. However, the evidence of the Opponent shows that it has generated a significant reputation in the fields of education and publishing in relation to its CAMBRIDGE mark;

21.3. The evidence shows that the Opponent can rely on an enhanced distinctive character and reputation in relation to publishing and printed publications in class 16, and education in all fields in classes 16 and 41. As such, where the Opponent relies on these goods and services, for the purposes of similarity of goods and services as compared the application, then this enhanced degree of distinctive character can be taken into account;

21.4. It is plain that there would be a likelihood of confusion and that the Opponent should succeed under section 5(2)(b).”

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

62) I next turn to the ground of opposition under section 5(3) which reads:

“5. (3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

63) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-*

Salomon, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L’Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L’Oreal v Bellure*).

64) I must first determine, if at the relevant date for the opposition (23 March 2017) the opponent had a reputation in relation to its Cambridge marks and if so in what goods and services. The test for 'reputation' was set out by the CJEU in *General Motors*. The earlier mark must be known by 'a significant part' of the relevant public. Some commentators have regarded this as setting a low threshold. In *Iron & Smith kft v Unilever NV*, Case Case C-125/14, the CJEU was asked whether a CTM (now an EUTM) with a reputation 'in the Community' (now the European Union), but not in the member state where infringement was alleged, was capable of being infringed under provisions of the Community Trade Mark Regulation (now the European Union Trade Mark Regulation) broadly equivalent to s.5(3) of the Act. The court answered that:

“If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the

proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future.”

65) A European Union trade mark may therefore be known to “a commercially significant part of the public concerned by the products or services covered by that trade mark” in the Union, without meeting the usual threshold in a particular Member State. Nevertheless, provided that the mark is known to “a commercially significant part of” the relevant public in the Member State in which protection is sought it may be entitled to extended protection on account of its reputation in the Union. It is apparent from the court’s judgment that the latter requirement is intended to cover situations where there is a lower, but still significant, degree of recognition of the EUTM in the Member State. This is confirmed by other language versions of the judgment. The French version says that a “commercially non-negligible” part of the relevant public in the Member State must be aware of the earlier CTM (now EUTM) and make a link with the later national trade mark. As a matter of logic, a national trade mark with a qualifying reputation in the UK must therefore be known to more than the lower ‘non-negligible’ part of the relevant public described in *Iron & Smith*.”

66) Earlier in this decision I found that the opponent had provided evidence that it had a reputation in its registered marks in the UK in respect of “electronic publications, downloadable; printed publications in electronically readable form; examination and assessment” in class 9, the whole of its class 16 specification “Instructional and teaching materials; manuals, handbooks” and “providing of graduate and postgraduate education” in class 41. As such it gets over the first hurdle of reputation in respect of its earlier marks.

67) It is clear that the two parties are both involved in education in its broadest sense, but within that overarching definition they serve different markets. However, under this section of the Act I must consider the real life activities of the opponent against the specification applied for by the applicant. For ease of reference the applicant is seeking to register the following goods and services:

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

In Class 41: Training services and training consultancy: training and consultancy services in the field of computer science, computer systems and in the application of computer software; training and consultancy services in the field of data processing;

68) Earlier in this decision I rejected the limitation sought by the applicant which read “all the aforesaid related to high-tech, AI, data science and software development vocational training provided to professionals and companies” as I consider it less than clear and precise in its meaning and far too open to interpretation. What is covered by the terms “high tech”, “data science” or “software development” for instance? Further who are the consumers considered to be “professionals”? There are so many different definitions of all of these terms that the limitation is unsatisfactory and cannot be accepted. Clearly, the opponent has reputation in precisely the class 9 goods that the applicant is seeking to register, and so the goods of the two parties must be considered identical.

69) Turning to the services, although I have reduced the opponent’s specification to that in which it enjoys reputation, namely “providing of graduate and postgraduate education” in class 41 this would clearly encompass the provision of training “in the field of computer science, computer systems and in the application of computer software; training services in the field of data processing”. As such these services must be regarded as identical. This leaves the consultancy services offered in these fields. The opponent has not shown that it enjoys any reputation in consultancy services and so these must be regarded as not similar, although of course this is not fatal to the opposition, but it is relevant to the likelihood of the relevant public making a link between the marks. Earlier in this decision I also determined that the marks of the two parties are similar to a low degree.

70) In deciding this issue I take into account the comments of Mr Geoffrey Hobbs Q.C. (sitting as a Deputy Judge) in *Electrocoin Automatics Limited and Coinworld Limited and Others* [2005] FSR 7:

“102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, ‘the link’ established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.”

71) I also look to the case of *Intel Corporation Inc v CPM United Kingdom Ltd* [2006] EWCH 1878 where Patten J said at para 28:

“But the first step to the exploitation of the distinctive character of the earlier mark is necessarily the making of the association or link between the two marks and all that Neuberger J is, I think, saying in this passage [Premier Brands at p. 789] is that the existence of a later mark which calls to mind the earlier established mark is not sufficient to ground an objection under s.5(3) or s.10(3) unless it has one or other of the consequences specified by those provisions. It must be right that the making of the association is not necessarily to be treated as a detriment or the taking of an unfair advantage in itself and in cases of unfair advantage it is likely to be necessary to show that the making of the link between the marks had economic consequences beneficial to the user of the later mark. But in relation to detriment the position is more complicated. The association between two marks and therefore potentially between the products or services to which they relate may be detrimental to the strength and reputation of the earlier mark if it tarnishes it by association or makes it less distinctive. This is likely to take place as a consequence of the same mental process which links the two marks in the minds of consumers and is essentially a negative reaction and effect.”

72) I accept that use of the term “Cambridge” may bring to mind the opponent when they see the goods and services of the applicant advertised.

UNFAIR ADVANTAGE AND DUE CAUSE

73) I now have to consider whether such a link gives an unfair advantage to the applicant’s mark or whether it is detrimental to the reputation of the opponent’s mark, and whether the applicant had due cause to use its mark. In considering these issues I take into account the comments of Arnold J. in *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) where he considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate

case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.

81. The second question is whether there is a requirement for evidence of a change in the economic behaviour of consumers or a serious likelihood of such a change. As counsel for House of Fraser pointed out, the CJEU has held that proof that the use of the sign is or would be detrimental to the distinctive character of the trade mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the trade mark is registered or a serious likelihood that such change will occur in the future: see *Intel* at [77], [81] and Case C-383/12 *Environmental Manufacturing LLP v Office for Harmonisation in the Internal Market* (unreported, 14 November 2013) at [34]-[43]. As counsel for House of Fraser accepted, there is no requirement for evidence of a change in the economic behaviour of consumers of the *trade mark proprietor's* goods or services in order to establish the taking of unfair advantage of the distinctive character or repute of the trade mark. He submitted, however, that it was necessary that there should be evidence of a change in the economic behaviour of the consumers of the *defendant's* goods or services.

82. Counsel for Jack Wills did not dispute that, in order for advantage to be taken of the trade mark's distinctive character or repute, it was necessary for there to be some change in the behaviour of the defendant's consumers as a result of the use of the allegedly infringing sign, or a serious likelihood of such a change. Nor did he dispute that what was required was a change in the behaviour of the consumers as consumers of the relevant goods and services, and in that sense in their economic behaviour. He submitted, however, that the trade mark proprietor could not be expected to adduce positive evidence that consumers had changed their behaviour as a result of the use of the sign.

83. In my judgment the correct way to approach this question is to proceed by analogy with the approach laid down by the Court of Justice in *Environmental Manufacturing* in the following passage:

“42. Admittedly, Regulation No 207/2009 and the Court's case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on ‘an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’.”

74) I also take into account the case of *Mäurer + Wirtz GmbH & Co KG v OHIM*, Case T-63/07, where the General Court held that:

“40. It is possible, particularly in the case of an opposition based on a mark with an exceptionally high reputation, that the probability of a future, non-hypothetical risk of detriment to the earlier mark or of unfair advantage being taken of it by the mark applied for is so obvious that the opposing party does not need to put forward and prove any other fact to that end. However, it is also possible that the mark applied for does not, at first sight, appear capable of giving rise to one of the risks covered by Article 8(5) of Regulation No 40/94 with respect to the earlier mark with a reputation, even though it is identical with or similar to the earlier mark, in which case the non-hypothetical, future risk of detriment or unfair advantage must be established by other evidence, which it is for the opposing party to put forward and prove (Case T-215/03 *Sigla v OHIM –Elleni Holding (VIPS)* [2007] ECR II-711, paragraph 48).”

75) In *Leidseplein Beheer BV v Red Bull*, Case C-65/12, the CJEU held that:

“43. In a system for the protection of marks such as that adopted, on the basis of Directive 89/104, by the Benelux Convention, however, the interests of a third party in using, in the course of trade, a sign similar to a mark with a reputation must be considered, in the context of Article 5(2) of that directive, in the light of the possibility for the user of that sign to claim ‘due cause’.

44. Where the proprietor of the mark with a reputation has demonstrated the existence of one of the forms of injury referred to in Article 5(2) of Directive 89/104 and, in particular, has shown that unfair advantage has been taken of the distinctive character or the repute of that mark, the onus is on the third party using a sign similar to the mark with a reputation to establish that he has due cause for using such a sign (see, by analogy, Case C-252/07 *Intel Corporation* [2008] ECR I-8823, paragraph 39).

45. It follows that the concept of 'due cause' may not only include objectively overriding reasons but may also relate to the subjective interests of a third party using a sign which is identical or similar to the mark with a reputation.

46. Thus, the concept of 'due cause' is intended, not to resolve a conflict between a mark with a reputation and a similar sign which was being used before that trade mark was filed or to restrict the rights which the proprietor of that mark is recognised as having, but to strike a balance between the interests in question by taking account, in the specific context of Article 5(2) of Directive 89/104 and in the light of the enhanced protection enjoyed by that mark, of the interests of the third party using that sign. In so doing, the claim by a third party that there is due cause for using a sign which is similar to a mark with a reputation cannot lead to the recognition, for the benefit of that third party, of the rights connected with a registered mark, but rather obliges the proprietor of the mark with a reputation to tolerate the use of the similar sign.

47. The Court thus held in paragraph 91 of the judgment in *Interflora and Interflora British Unit* (a case concerning the use of keywords for internet referencing) that where the advertisement displayed on the internet on the basis of a keyword corresponding to a trade mark with a reputation puts forward – without offering a mere imitation of the goods or services of the proprietor of that trade mark, without being detrimental to the repute or the distinctive character of that mark and without, moreover, adversely affecting the functions of the trade mark concerned – an alternative to the goods or services of the proprietor of the trade mark with a reputation, it must be concluded that such a use falls, as a rule, within the ambit of fair competition in the sector for the goods or services concerned and is thus not without 'due cause'.

48. Consequently, the concept of 'due cause' cannot be interpreted as being restricted to objectively overriding reasons.

76) In *Argos Ltd v Argos Systems Inc.*, [2018] EWCA Civ 2211, the Court of Appeal again considered whether an advantage gained by the defendant was unfair. The Court of Appeal found that Argos Systems website 'targeted' UK consumers. It was therefore using the ARGOS[.com] sign in the UK in relation to the service of providing advertising space. UK consumers would make a link between the ARGOS trade mark and the use of ARGOS[.com] by Argos Systems. And the latter gained a commercial advantage from such use. Nevertheless, the Court of Appeal found that the use of the Argos name for the advertising space services provided via the website was fair. Consequently, there

was no infringement of s.10(3) of the Act. L.J. Floyd, who gave the lead judgment, explained why it was fair, as follows:

“109.I do not accept that the judge made any error of principle in his approach to the issue of unfair advantage. He correctly identified that the case was not one involving any transfer of image to ASI's goods or services. He went on to consider factors which have a bearing on unfairness. These were that (a) ASI had not done anything to seek out the unwanted internet traffic which arrived at its website, and which it had no power to prevent; (b) ASI's display of AdSense ads was of some benefit to AUL by restoring misdirected customers to AUL who might otherwise have lost interest; (c) participation in AdSense was a normal and commercially unobjectionable activity; (d) the income stream derived from it by ASI was small in the context of both parties' businesses; (e) on arriving at the website even moderately observant customers would see it had nothing to do with AUL.”

77) It is clear from this judgment that there would have been unfair advantage if the image of the ARGOS trade mark transferred to the goods/services provided by Argos Systems or if there was a likelihood of confusion, including indirect confusion. Earlier in this decision I determined that there would not be direct or indirect confusion between the marks. I do not believe that the “link” formed in the minds of applicant’s consumers will affect their economic activity as the process of purchasing taring materials or courses will involve ascertaining the credentials of the supplier and thus reveal that the applicant is not connected to the opponent.

78) In the *Argos* case, having decided that the advantage gained was not unfair, the Court of Appeal decided that it did not need to consider whether the defendant had “due cause” to use the ARGOS.COM mark. I do not need to consider the submissions made regarding the Kenzo case subsequent to the hearing and filed without seeking my permission. **The ground of opposition under section 5(3) fails.**

79) Lastly, I turn to the ground of opposition under section 5(4)(a). In respect of section 5(4)(a) Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

80) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

81) First, I must determine the date at which the opponent’s claim is to be assessed; this is known as the material date. I take into account the views expressed in *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11 by Mr Daniel Alexander QC as the Appointed Person at paragraphs 39 – 43. The applicant did not file evidence of use of the mark applied for and so the material date is the date that the mark in suit was applied for, 23 March 2017.

82) I have already found that the opponent has goodwill and reputation in its mark, albeit to a lesser extent than contended by the opponent (see paragraph 66 above). I also found earlier in this decision

that use of the mark in suit, actual or on a fair and notional basis would not result in confusion with the opponent's marks. Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. **The opposition under Section 5(4)(a) of the Act must fail.**

CONCLUSION

83) The opposition under sections 5(2)(b), 5(3) and 5(4)(a) all fail.

COSTS

84) As the applicant has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering the other side's evidence	£800
Attending the hearing	£1000
TOTAL	£2000

85) I order The Chancellor, Masters and Scholars of the University of Cambridge to pay Cambridge Spark Limited the sum of £2,000. This sum to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of January 2020

George W Salthouse
For the Registrar,
the Comptroller-General