

O-076-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2635231
BY
KING'S EDUCATION, S.L.
TO REGISTER THE TRADE MARK**

KING'S COLLEGE ST. MICHAEL'S

IN CLASS 41

AND

**THE OPPOSITION THERETO
UNDER NO 104637
BY
KING'S SCHOOL OF ENGLISH (TUITION) LIMITED**

Background and pleadings

1. King's Education S.L. ("the applicant") has applied to register the trade mark KING'S COLLEGE ST. MICHAEL'S in Class 41 for *Education services offered in a boarding environment; teaching services offered in a boarding environment; entertainment services; information services in the field of education; organisation and management of training workshops, colloquiums, conferences, seminars, symposiums; teaching by correspondence; organisation of exhibitions for cultural and educational purposes; text edition services (non advertising texts); publication of books; operation of on-line electronic publications (not downloadable by data transmission); electronic publication of books and newspapers on-line (not downloadable)*. The application was filed on 19 September 2012 and published for opposition purposes on 21 December 2012.

2. King's School of English (Tuition) Limited ("the opponent") objects to the application achieving registration because it claims there would be a likelihood of confusion with two of its own trade mark registrations. These are:

(i) 2513991

KING'S COLLEGES

Class 16: *Printed matter; periodicals; magazines; prospectuses; promotional materials; books; brochures and catalogues; leaflets, manuals, guides; instructional and teaching materials; stationery; office requisites; paper; writing paper; writing and drawing materials; pens, pencils, binders, flipcharts, noticeboards, blackboards, whiteboards.*

Class 41: *Education, instruction and training services; language teaching services; language schools; provision of pre-university academic, education and training programmes, including A level, GCSE and university foundation courses for international students; vocational training for international and United Kingdom students; summer schools and summer residential courses.*

Filed 21 April 2009; registration procedure completed 24 July 2009.

(ii) 2239477



Class 16: *Printed matter; periodicals; magazines; prospectuses; promotional materials; books; brochures and catalogues; leaflets, manuals, guides; instructional and teaching materials; stationery; office requisites; paper; writing paper; writing and*

drawing materials; pens, pencils, binders, flipcharts, noticeboards, blackboards, whiteboards.

Class 41: Education, instruction and training services; language teaching services; language schools; provision of pre-university academic, education and training programmes, including A level, GCSE and university foundation courses for international students; vocational training for international and United Kingdom students; summer schools and summer residential courses.

Filed 18 June 2009; registration procedure completed 18 September 2009.

3. The section of the Trade Marks Act 1994 (“the Act”) under which the opponent makes its opposition is section 5(2)(b). This states:

“(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.”

4. The opponent claims that the distinctive and dominant elements in the respective marks are “KING’S COLLEGE” and “King’s Colleges”, which are clearly similar. The opponent claims that the goods and services are identical or similar, and that there would be a likelihood of confusion as a consequence.

5. The applicant filed a counterstatement in which it denies the opponent’s claims. The applicant claims that the element ST. MICHAEL’S is equal in dominance to KING’S COLLEGE. The applicant states that there are five existing trade mark registrations on the UK trade mark register comprising the words King’s College, and that a Google search reveals that a large number of King’s College’s coexist in the education sector. The applicant claims that the average consumer will not attach any importance to the words King’s College because they cannot, without addition or modification, denote trade origin. The applicant claims that since it founded its King’s College in 1969, there have been no instances of confusion.

6. Both parties are represented by trade mark attorneys. Both parties requested that a decision be made from the papers, without a hearing. Both sides filed evidence and submissions during the evidence rounds, but no written submissions were filed in lieu of a hearing.

Evidence

7. The opponent’s evidence comes from its trade mark attorney, William Tennant, of Tennant IP Limited. His evidence consists of the opponent’s 2012 price list for English courses, on which is shown the second of the two earlier marks upon which

the opponent relies, and which refers to the opponent's St. Michael's campus in Oxford. The other exhibit to Mr Tennant's witness statement is a page from the opponent's 2012 brochure, which gives details of its St. Michael's campus at its "Oxford King's College". The remainder of Mr Tennant's witness statement consists of submissions, which I will of course bear in mind.

8. The applicant's evidence comes from Sir Roger Fry, the applicant's founder and chairman. Sir Roger founded his first King's College school in 1969, in Madrid. More schools were opened over time, including a boarding school in Worcestershire (St Michael's College) in 1992 and several more schools in Spain. The school in Worcestershire was known as King's College at Cloisters until 1995, when it changed to King's College at St Michael's, which Sir Roger states is also known as St Michael's College. The evidence shows that the school is an international secondary level boarding school aimed at Spanish students, teaching English as a foreign language (amongst other subjects). In later years, the school has been known as King's College St Michael's.

9. Sir Roger states that he owns several trade mark applications or registrations falling in class 41 around the world which include the words King's College. He provides a list of these; six are Spanish national registrations; one international registration which designates (amongst other jurisdictions) the European Community; and the remaining marks on the list are registered, or have been applied for, as national marks in Panama, the Dominican Republic, India, Costa Rica, Chile, Brazil and Peru.

10. Sir Roger states:

"14. During the many years of the existence of King's College St Michael's, I have been aware of other educational entities within the UK known as King's Colleges. Parents need to be sure of the nature of the education their children need and it was therefore felt important to distinguish our college from other schools or colleges known as King's in the UK. This is why we changed our college's name in 1995. I am not aware of any confusion between our college and any other college known as King's or Kings in the years since we changed its name in 1995.

15. I have seen the 2012 brochure of the Opponent. It is headed "Prices, dates and key information" and refers to courses at Kings Boston, Kings Los Angeles, Kings Bournemouth, Kings London and Kings Oxford. I can see no reference to Kings St Michael's. I therefore take it that this brochure does not show use of the name St Michael's by the Opponent. Accordingly, since it does not appear to have used the mark it allegedly owns whilst the Applicant has used the term King's College St Michael's, King's College at Michael's and/or King's College in St Michael's for many years, it seems to me that this opposition should fail. Furthermore, I believe the Opponent should cease its use of St Michael's to prevent confusion between the marks."

11. The applicant's written submissions say that the applicant also owns the following trade mark registration in the UK:



King's St. Michael's

Filed 24 January 2012; registration procedure completed 27 July 2012.

12. I will come back to the relevance of this point later in this decision.

Decision

13. The leading authorities which guide me in relation to section 5(2)(b) of the Act are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant

public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

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

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

Average consumer and purchasing process

14. The pleadings and evidence show that both parties are involved in the foreign language school sector, with the applicant's school in the UK being a boarding school, which it has reflected in an amendment to its specification. However, the assessment of the nature and purchasing behaviour of the average consumer is to be carried out according to the notional scope of the parties' specifications. In *Och-Ziff Management Europe Limited and another v Och Capital LLP and others* [2010] EWHC 2599 (Ch), Arnold J said:

"76. It is common ground that it is now clear that there is an important difference between the comparison of marks in the registration context and the comparison of mark and sign in the infringement context, namely that the former requires consideration of notional fair use of the mark applied for, while the latter requires consideration of the use that has actually been made of the sign in context."

The earlier marks are not subject to the proof of use provisions because they had been registered for less than five years at the date on which the application was published¹. This means that the opponent's marks must be considered upon the basis of notional and fair use for the full range of goods and services for which they are registered.

15. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. Although I bear in mind that there may be an aural aspect to the purchasing process, the goods and services will be purchased primarily visually after examination of e.g. websites, brochures (both parties have provided paper brochures in their evidence), and the goods themselves. On a notional view, there are goods and services of ordinary cost and complexity covered by the parties' specifications which will cause some degree of care to be used, but not the highest level of care. The more advanced or expensive the education, the closer will be the attention paid to its selection; that said, where the services selected are for children and young people, parents and young people are likely to be highly attentive almost regardless of cost, owing to the importance of making the 'right' choice.

Comparison of goods and services

16. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

"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."

17. 'Complementary' was defined by the General Court ("GC") in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

"82 It is true that goods are complementary if 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...".

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

19. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held that:

¹ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

20. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"... 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."

21. The specifications of the opponent's two earlier marks are identical. The table below sets out the parties' competing specifications:

Opponent	Applicant
<p>Class 16: <i>Printed matter; periodicals; magazines; prospectuses; promotional materials; books; brochures and catalogues; leaflets, manuals, guides; instructional and teaching materials; stationery; office requisites; paper; writing paper; writing and drawing materials; pens, pencils, binders, flipcharts, noticeboards, blackboards, whiteboards.</i></p> <p>Class 41: <i>Education, instruction and training services; language teaching services; language schools; provision of pre-university academic, education and training programmes, including A level, GCSE and university foundation courses for international students; vocational training for international and United Kingdom students; summer schools and summer residential courses.</i></p>	<p>Class 41: <i>Education services offered in a boarding environment; teaching services offered in a boarding environment; entertainment services; information services in the field of education; organisation and management of training workshops, colloquiums, conferences, seminars, symposiums; teaching by correspondence; organisation of exhibitions for cultural and educational purposes; text edition services (non advertising texts); publication of books; operation of on-line electronic publications (not downloadable by data transmission); electronic publication of books and newspapers on-line (not downloadable).</i></p>

22. As per the judgment of the GC in *Gérard Meric v OHIM* Case T-133/05, goods and services can be considered as identical when the goods and services of the earlier mark are included in a more general category, included in the specification of

the trade mark application. Vice versa, if the goods or services of the application are included in a more general category included in the specification of the earlier mark, they must be identical. Applying this to the parties' specifications, the opponent's *Education, instruction and training services* are identical to the applicant's *Education services offered in a boarding environment; teaching services offered in a boarding environment; teaching by correspondence* because the latter are included within the former.

23. The applicant's *information services in the field of education; organisation and management of training workshops, colloquiums, conferences, seminars symposiums* are closely associated with education, instruction and training services. Providers of education, instruction and training services will provide information about subjects, courses and funding etc and will organise workshops, seminars and conferences at which the education takes place. There is a high degree of complementarity. The channels of trade are shared, as are the users. The services are similar to a high degree.

24. The applicant has cover for *organisation of exhibitions for cultural and educational purposes*; here the purpose of the exhibitions is defined as for education. Such exhibitions are, for example, put on by museums which have a strong educational function, playing an interactive role with visiting school parties. The opponent's term *education* is wide, covering all aspects of education. Even if it does not strictly cover organisation of educational exhibitions, the applicant's services will be provided to the same users as the opponent's; they are complementary in the sense that the organiser of an exhibition, such as a museum or gallery, will be perceived as being responsible for the educational content of the event; and the purpose of both is to instruct. The services are highly similar.

25. In relation to the applicant's *text edition services (non advertising texts); publication of books; operation of on-line electronic publications (not downloadable by data transmission); electronic publication of books and newspapers on-line (not downloadable)* these all appear to be publishing services. I assume that *text edition services* is the updating of editions of e.g. text books, which is a subset of publishing services. The users will not be the same, however: the user of a book will not be the same as a user of a publication service; the method of accessing the goods and the services will not be the same; and their nature and purpose also differ. However, these services are complementary to printed matter, which is a wide term covered by the opponent's specification. Printed matter such as books, periodicals, manuals, instructional and teaching materials cannot exist without being published. Without printed matter, there would be no need for publishing services.

26. In *Sanco SA v OHIM*² the General Court indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different; in that case, chickens against transport services for chickens. The GC accepted that chickens and chicken transport services are complementary because

² T-249/11.

professional businesses that purchase chickens may expect the same provider to provide both chickens and specialist transportation services for chickens.

27. I must assess whether the average consumer is liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC, sitting as the appointed person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited*³:

“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.

...

.....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.”

28. The complementary relationship between goods and services is but one aspect of the similarity assessment which should not be given undue weight or be applied too rigidly. In relation to publishing services, educational and academic institutions commonly publish academic works such as dictionaries and text books. The average consumer is likely to believe that the same undertaking is responsible for both the printed matter and the publishing of the printed matter, such as a university press, or a research foundation. Viewing the applicant's *text edition services (non advertising texts); publication of books; operation of on-line electronic publications (not downloadable by data transmission); electronic publication of books and newspapers on-line (not downloadable)* in this light, I find that they are similar to a good degree with both the opponent's *printed matter* and its *education, instruction and teaching services*.

29. That leaves *entertainment services*. The opponent has not explained where it considers similarity to lie. I have considered possible convergence in terms of, for example, educational television programmes, but this is stretching the comparison too far away from the core meaning of entertainment. Entertainment services are not similar in nature, purpose, channels of trade or in method of use, and are not complementary to any of the opponent's goods or services. There is no similarity.

Comparison of trade marks

30. The opponent's word-only mark is the closer of its two marks when compared with the applicant's mark, because there is no additional stylisation. I will start by comparing this mark.

31. The marks to be compared are:

KING'S COLLEGES

KING'S COLLEGE ST. MICHAEL'S

³ BL O/255/13.

32. The authorities cited earlier in this decision direct that, in making a comparison between the marks, I must compare each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details, as per *Sabel BV v Puma AG*, paragraph 23:

“That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their dominant and distinctive components.”

There is a good level of visual and aural similarity between the marks because, notwithstanding the plural/singular version of 'COLLEGE'/COLLEGES' the entirety of the opponent's mark makes up the first half of the applicant's mark. KING'S COLLEGE(S) is the first element which will be seen and spoken. This gives the phrase some dominance over ST. MICHAEL'S. Conceptually, the two marks share the meaning of one or more colleges named KING'S. The applicant's mark has the added concept of a saint. Its juxtaposition with KING'S COLLEGE, but without 'of', 'at' or 'in' to qualify the St. Michael's part of the mark, does not make for an obvious overall meaning. The two halves of the applicant's mark appear separate in meaning. Overall, there is a good deal of similarity between the parties' marks.

Distinctiveness of the earlier mark

33. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*⁴ 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).”

⁴ Case C-342/97

34. The opponent's evidence lacks any specificity as to when, how and in relation to what goods or services the opponent has used its mark, so I have only the inherent position to consider. The applicant submits that 'King's Colleges' is not distinctive by itself and that additional elements are needed for distinctiveness. The applicant appears to take this position on the basis of five trade mark registrations owned by three other unrelated parties and because of a Google search which it attached to the counterstatement, which was not filed as evidence. Even if it had been, I cannot see how the plurality of similar names by which individual establishments are known, assuming that they are all in use for the same or similar services, supports an argument that the words KING'S COLLEGES are not distinctive for educational services. This is reminiscent of the argument in *Nude Brands Limited v Stella McCartney Limited and others* [2009] EWHC 2154 (Ch), in which Floyd J. Stated:

"29. Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly does not go as far as establishing ground 7(1)(d) - customary indication in trade. Ground 7(1)(b) is concerned with the inherent character of the mark, not with what other traders have done with it. The traders in question are plainly using the mark as a brand name: so I do not see how this use can help to establish that the mark consists exclusively of signs or indications which may serve to indicate the kind or quality or other characteristics of the goods, and thus support an attack under 7(1)(c)."

Whilst undoubtedly the word COLLEGE(S) is descriptive in relation to educational services, the mark as a whole must be considered. King's qualifies 'colleges'. The phrase hangs together⁵. There is nothing descriptive or allusive in the mark as a whole when considered in relation to the goods and services for which it is registered. The earlier mark has a good level of inherent distinctive character.

Likelihood of confusion

35. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified. This includes keeping in mind the whole mark comparison, because the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. It also includes the principle of interdependency, whereby a lesser degree of similarity between the goods/services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). In these proceedings, I have found that the parties' goods and services are identical, highly similar, similar to a good degree, or not similar. Where there is no similarity between the goods/services there can be no likelihood of confusion⁶. Accordingly the opposition fails in respect of *entertainment services*.

⁵ As per the GC, in *Ella Valley Vineyards (Adulam) Ltd v OHIM* T-32/10.

⁶ *Waterford Wedgwood plc v OHIM* Case C-398/07.

36. A factor which I should consider is the ‘beginnings of marks’ rule of thumb, which allows for the propensity of the average consumer to notice, particularly, the beginnings of marks because that is what is seen or heard first. It is a rule of thumb, and it does not always follow, but, in the current case, the position of KING’S COLLEGE(S) as the first half of the applicant’s mark is important. The two halves of the applicant’s mark, King’s College and St. Michael’s, do not ‘hang together’ as a composite phrase; rather they are two separate phrases. Each phrase has an independent role to play in the applicant’s mark.

37. In *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, the CJEU stated:

“29 In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34 This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35 Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36 It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.

37 Accordingly, the reply to the question posed must be that Article 5(1)(b) of the directive is to be interpreted as meaning that where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein.”

38. The applicant’s mark is different to the opponent’s mark but it has the near-identical dominant and distinctive element in common: KING’S COLLEGE(S). I, of course, bear in mind that the assessment means that I should not simply take just this component of the applicant’s mark and compare it with the opponent’s mark. It is an assessment of the whole mark. It seems to me that the KING’S COLLEGE(S) component stands as a ‘company name’, in the sense described in *Medion* and that it has a significance which is independent in the applicant’s mark. In *Aveda Corporation v. Dabur India Limited* [2013] EWHC 589 (Ch), Arnold J said, at paragraph 45:

“I entirely accept the basic proposition which the Court of Justice has repeated many times, namely that the assessment of likelihood of confusion must be made by considering and comparing each of the signs as a whole. As the Court of Justice recognised in *Medion v Thomson*, however, there are situations in which the average consumer, while perceiving a composite sign as a whole, will recognise that it consists of two signs one or both of which has a significance which is independent of the significance of the composite whole. Thus when the well-known pharmaceutical company Glaxo plc acquired the well-known pharmaceutical company Wellcome plc, the average consumer of pharmaceutical goods confronted with the composite sign GLAXO WELLCOME or GLAXOWELLCOME would perceive the significance of both the whole and its constituent parts and conclude that this was an undertaking which combined the two previously separate undertakings (see *Glaxo Group Ltd v Glaxowellcome Ltd* [1996] FSR 388). The essence of the Court of Justice’s reasoning in *Medion v Thomson* is that an average consumer of leisure electronic products confronted with the composite sign THOMSON LIFE could perceive both the whole and its constituent parts to have significance and thus could be misled into believing that there was a similar kind of connection between the respective undertakings.

39. This fits well in the present case: the average consumer will perceive both the whole of the applicant’s mark and its constituent parts to have significance; as in the

GLAXO WELLCOME example, the consumer is likely to conclude that the mark belongs to an undertaking which has combined two separate undertakings, King's College and St Michael's. KING'S COLLEGE will be perceived as a 'house' or company mark. In the case of academic institutions, St. Michael's may be perceived as one part or campus of the wider collegiate institution known as King's. In my view, as per paragraph 31 of *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, the average consumer is likely to believe that the goods derive from companies which are linked economically; alternatively, that the ST. MICHAEL'S part denotes an extension to the KING'S COLLEGE brand. I do not think that the plural/singular versions of the word 'college' will make any appreciable difference to these perceptions. Either way, this means that there is a likelihood of confusion. I say this despite the high level of attention which will be paid to the purchase of some of the services. A high level of attention may lessen the likelihood of imperfect recollection. However, the situation here is that the average consumer will notice that there is a difference between the marks and so will not imperfectly recall them; but, they will put the point of similarity down to the marks, for identical and similar goods and services, being another brand of the same undertaking or a linked undertaking, as explained above. I would also have come to the same view in relation to the opponent's composite mark because of the dominance of the word KING'S and the clear presence of the word COLLEGES, which is far from negligible.

40. The opponent's earlier registrations are valid by virtue of section 72 of the Act, and may be relied upon for the purposes of an opposition under section 5(2)(b) of the Act. In *Ion Associates Ltd v Philip Stainton and Another*⁷, the applicant, facing an opposition under section 5(2)(b), considered that its unregistered rights ought to mean that it had the right to register its mark. The Appointed Person, Ms Anna Carboni said:

"Even if the evidence were sufficient to establish the existence of an earlier right within a locality, of the sort recognised under article 6(2), that provision is about the owner of such a right being able to continue using it notwithstanding the registration of a national trade mark by a third party. As implemented in the Act, section 11(3) could be relied on to defend an action for infringement of a UK trade mark if, say, the defendant owned a local passing off right. I agree with the hearing officer that there is nothing in either article 6(2) (or, I would add, section 11(3)) to assist the Applicant in the second step of the argument to the effect that the owner of such a locally based right should itself be entitled to register the mark underlying its earlier right."

41. There is no automatic entitlement to a registration simply because a mark has been used. An opposition raised under Section 5(2) operates on the basis of the 'first to file' UK trade mark registration system. Ms Carboni's decision was referred to in the Registrar's Tribunal Practice Notice 4/2009:

"The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark

⁷ BL O/211/09.

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

42. Even if the present applicant's own earlier registered trade mark, shown in paragraph 11 of this decision, had predated the opponent's registrations, this still would not have assisted it; the same Tribunal Practice Notice states:

"1. A number of counterstatements in opposition and invalidation actions have sought to introduce as a defence that the applicant for registration/registered proprietor has a registered trade mark (or trade mark application) for the same or a highly similar trade mark to that which is the subject of the proceedings that predates the earlier mark upon which the attacker relies.

2. Sections 5(1) and 5(2) of the Act turn upon whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. Whether the applicant for registration/registered proprietor has another registered trade mark (or trade mark application) that predates the earlier mark upon which the attacker relies cannot affect the outcome of the case in relation to these grounds.

3. The position was explained by the Court of First Instance in *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) T-269/02*:

"24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener's mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.

26 The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State

concerned (Case T 6/01 Matratzen Concord v OHIM - Hukla Germany (MATRATZEN) [2002] ECR II 4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities."

43. The applicant submits that there have been no instances of confusion between the parties' marks and that this must partly be because of the non-distinctive nature (it claims) of KING'S COLLEGES and the plurality of undertakings operating under the name.

44. The first point to note is that if the consumer is completely confused, he or she will not know it. Lack of evidence of confusion does not mean that there has been no confusion. There must be evidence to suggest that the relevant public has shown that it distinguishes between the undertakings' goods and services. School names may be local, provided in specific localities, not bumping up against each other in the marketplace; the applicant itself refers to the names of educational institutions including their geographical locations in their names.

45. Secondly, although the applicant claims a long history, there is no evidence of trade under the mark by the opponent. The opponent's evidence consists of a single brochure and no other details. This is not evidence which points to concurrent trade in the UK. There is no evidence of concurrent trade. If there has been no concurrent trade, it is not possible to demonstrate an absence of actual confusion. Section 5(2)(b) is concerned with whether there is a likelihood of confusion, not what has actually happened. The opponent's earlier marks had not been registered for five years or more at the date on which the applicant's mark was published and so it does not have to prove that it has used its marks: trade mark registration owners have five years in which to make genuine use of their marks before they become liable to revocation on the grounds of non use. The test in this case is whether there is a likelihood of confusion 'notionally', i.e. whether all the factors I have discussed throughout this decision combine to lead to a conclusion that there is, or is not, a likelihood of confusion, on the part of the average consumer, between the marks.

46. I have no information about the so-called 'King's College' marks on Google; how they are being used and on what goods or services; what the average consumer's perception of these marks may be in relation to the various goods or services; and whether the average consumer is used to distinguishing between them on account of the prevalence of King's 'marks'⁸. Even if I were to accept that KING'S COLLEGE(S) has a reduced level of distinctiveness, that does not mean I should ignore it (*Shaker di L. Laudato & C. Sas v OHIM*). In case C-655/11 P *Seven for all mankind LLC v OHIM*, the CJEU stated:

"44 In order to respond to this ground of appeal, the Court notes that SAM, at paragraph 45 of its response lodged with the General Court, submitted that it is clear from a 'search' in the trade mark registers that there are numerous

⁸ See the judgment of the General Court in Case T-285/12 *The Cartoon Network, Inc v OHIM*.

marks in the European Union containing the word 'seven' or the numeral '7'. Furthermore, in an earlier decision, a Board of Appeal of OHIM indicated that the Community trade mark database showed some 80 trade marks consisting of or beginning with the word 'seven'. 'More generally', OHIM had already indicated that 'it is common experience that numbers are frequently used', in particular on clothing items and accessories.

45 SAM thus alleges that the General Court did not take that argument into account and, therefore, committed a breach of procedure.

46 In that respect, it should be noted that the General Court found, at paragraph 38 of the judgment under appeal, that the fact that the word 'seven' may have only a very weak distinctive character does not affect the finding that that word is not insignificant in the overall impression produced by the earlier trade marks, since it is clear that that word is likely to attract consumers' attention and be remembered by them.

47 In those circumstances, even if, as the appellant claims, the General Court had committed a breach of procedure by not examining the arguments presented by SAM as to the existence of numerous marks registered in the European Union containing the word 'seven' or the numeral '7', that would not have had any bearing on the General Court's finding.

48 Furthermore, the mere existence, even in high numbers, of marks which have that characteristic is not sufficient to establish the weak distinctive character of those marks.

49 For that claim to be relevant to such a finding, it must be shown that there are significant similarities as regards not only the presence of the word 'seven' or the numeral '7' in the earlier marks but also the position, type-face, ornamental presentation, any special font of a particular letter of that word, and the shape of the numeral '7', as well as, if that be the case, the presence of verbal or figurative additional elements before or after that word or number. Furthermore, the marks at issue must refer to the same goods and services."

47. The average consumer is likely to believe that the goods derive from undertakings which are linked economically. **There is a likelihood of confusion (except for entertainment services).**

Outcome

48. The opposition succeeds except in relation to *entertainment services*. The application is to be refused for all services except for *entertainment services*.

49. The application may proceed to registration for *entertainment services*.

Costs

50. The opponent has been largely successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice

4/2007. The opponent's evidence was very brief and did not assist me in finding a likelihood of confusion. Consequently, I will not make an award for the opponent's evidence, but will make an award as a contribution towards the cost of making the opposition and filing its submissions. There is an offset for the failure of the opposition against entertainment services.

Preparing a statement and considering the counterstatement	£200
Opposition fee	£200
Written submissions	£150
Offset	- £50
Total:	£500

51. I order King's Education S.L. to pay King's School of English (Tuition) Limited the sum of £500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated 11th February 2014

**Judi Pike
For the Registrar,
the Comptroller-General**