

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2171459
BY THE AMERICAN COLLEGE IN LONDON LIMITED
TO REGISTER THE MARK AMERICAN COLLEGE IN LONDON
IN CLASSES 41 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 50517
BY RICHMOND, THE AMERICAN INTERNATIONAL UNIVERSITY
IN LONDON INC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2171459
by The American College In London Limited
to register the Mark American College In London
in Classes 41 and 42**

and

**IN THE MATTER OF Opposition thereto under No 50517
by Richmond, The American International University
in London Inc**

DECISION

1. On 7 July 1998 The American College in London Ltd applied to register the mark AMERICAN COLLEGE IN LONDON for the following specification of services

Class 41:

University education services; arranging and conducting of lectures; provision of instruction and courses of study and research programmes leading to the examination and award of Certificates, Diplomas or Degrees for undergraduate and postgraduate students both internal and external; open access courses for instruction and study by way of lectures, classes, library facilities and other teaching aids; the award of prizes and scholarships; development of audio-visual techniques in teaching, research and administration; library services; library advisory and consultancy services; advisory services in connection with library collections, including conservation; provision of training courses relating to computerised information storage and retrieval systems; publication of printed matter.

Class 42:

Information and advisory services relating to careers; provision of computing facilities for research and teaching through communications networks; research and development of computerised information storage and retrieval systems.

2. The application is numbered 2171459. The advertisement of the application in the Trade Marks Journal indicates that it proceeded because of distinctiveness acquired through use and on the basis of honest concurrent use with registrations Nos. 2051132A, 2147349 and another.

3. On 16 December 1999 Richmond, The American International University in London, Inc (Richmond) filed notice of opposition to this application. The statement of grounds was amended during the course of the proceedings. The sole remaining ground is under Section

5(2)(b) of the Act having regard to two earlier trade marks details of which appear in the Annex to this decision. Reference is also made to related another action between the parties in relation to which a decision has since been issued. I will come to this in due course.

4. The applicants filed a counterstatement denying the above ground.

5. Both sides ask for an award of costs in their favour.

6. Only the applicants filed evidence.

7. Neither side has asked to be heard. The applicants have filed written submissions under cover of a letter dated 14 February 2002 from D Young & Co, their Trade Mark Attorneys. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

Background

8. This is not the first action between the parties. Both sides refer to two previous proceedings where the parties' roles were reversed and the current applicants opposed registration of the marks shown in the Annex to this decision. Those oppositions (Nos 49471 and 49211) were decided in favour of Richmond with the result that Nos. 2051132A and 2051132B have now proceeded to registration and thereby constitute earlier trade marks which in turn underpin the current opposition. The current applicants have filed copies of the decisions resulting from their unsuccessful opposition proceedings against Richmond's marks in support of this application. Those opposition proceedings were decided under Section 5(4)(a) by reference to the law of passing off. The Hearing Officer concluded in each case that

- The American College in London Ltd had goodwill in the UK under their mark THE AMERICAN COLLEGE IN LONDON for the provision of education services
- the mark THE AMERICAN COLLEGE IN LONDON had a small amount of distinctiveness from the combination of descriptive words
- the applicants' mark had as its most distinctive feature the word RICHMOND and that the succeeding words would be seen as a description
- as a result there was no misrepresentation and the second leg of the passing off test had not been met.

9. I should also record that I have been referred to a yet further action where the Richmond marks were prayed in aid of an opposition (No. 49919) to The American College in London Ltd's application for the mark AMERICAN INTERCONTINENTAL UNIVERSITY. That case was decided, inter alia, under Section 5(4)(a) and again the Hearing Officer found that the opposition failed because of the absence of misrepresentation. The Richmond marks relied on as earlier trade marks in the action before me were still pending at the time Opposition No. 49919 came to be decided. The Hearing Officer considered whether he should suspend

Opposition No. 49919 until the fate of applications Nos. 2051132A and B was known but concluded that, as he had found no misrepresentation for the purposes of Section 5(4), even assuming use of the respective marks for identical services, there would be no likelihood of confusion for the purposes of Section 5(2)(b).

10. With that background in mind I turn to the law in the present case.

Section 5(2)(b) 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."

11. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

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*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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.* paragraph 27;

(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*, paragraph 23;

(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*, paragraph 23;

(e) 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*, paragraph 17;

- (f) 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*, paragraph 24;
- (g) 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*, paragraph 26;
- (h) 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*, paragraph 41;
- (i) 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*, paragraph 29.

Distinctiveness of the earlier trade mark

12. Different Registry Hearing Officers have concluded in relation to the opponents' marks that

"The strongest source identifier in the opponent's sign is RICHMOND" Opp 49919 (paragraph 21)

and

"To my mind the applicant's mark has at its start the most distinctive part of its mark namely the word "Richmond". The prominence and positioning of "Richmond" in the applicant's mark suggests itself as the name of the college of which "The American University in London" is a description." Opps 49471 and 49211 (paragraph 29)

13. I do not consider that those findings are at all surprising and represent a view that I would have come to independently. It appears from the previous cases that the Hearing Officers had the benefit of evidence from Richmond as to their use of the various marks making up the two series. The opponents' statement of grounds in the action before me claims that "the opponent has made substantial use of its trade marks in the United Kingdom in relation to the goods and services" However, the opponents have elected not to file evidence in substantiation of the above claim so there are only the inherent characteristics of the marks to be considered. Like my colleagues before me I consider that the strongest component of the opponents' marks is the word RICHMOND.

Use of the applicants' mark

14. The applicants filed a witness statement by Rafael Antonio Lago, the President of American Intercontinental University in London which is owned by American Intercontinental University - London Limited (previously titled The American College in London Limited). The applicant company was incorporated on 13 June 1978 and has traded since then until 1 June 2001 under the name American College in London Limited. Turnover figures and student numbers are given for the years 1986 to 1999. I note that turnover has increased from £1.6 million in 1986 to £5.5 million in 1998 by means of a steady progression. Student numbers have remained reasonably constant averaging about 3500 per annum. As I do not consider I need to rely on the applicants' evidence to reach a view on the case I do not propose to summarise it further.

Similarity of services

15. It is conceded in the written submissions filed on the applicants' behalf that the services of the mark applied for are identical or similar to those protected by the opponents' earlier trade marks.

Similarity of marks

16. The opponents two earlier trade mark registrations consist of a series of four and five marks respectively. They have not indicated that they rely on any particular mark or marks in the respective series. There is, of course, no obligation on them to do so. For convenience, however, I propose to approach the matter on the basis of the mark RICHMOND COLLEGE, THE AMERICAN UNIVERSITY IN LONDON as this mark incorporates all the elements of the applied for mark. The other marks do not appear to offer the opponents any better prospect of success.

17. I am required to assess the overall similarities between the respective marks from a visual, aural and conceptual standpoint bearing in mind their distinctive and dominant components and looking at the matter from the point of view of the average consumer.

18. The applicants' mark is quite clearly composed of individual elements that are descriptive and/or non-distinctive in nature. The totality is likely to carry a relatively low penumbra of protection. It is nevertheless visually distinct from the opponents' mark. The mere fact that the same descriptive/non-distinctive words appear in both marks does not of itself render the marks visually similar. Nor, in my view, is there likely to be aural similarity given the dominant presence of the word(s) RICHMOND or RICHMOND COLLEGE in the opponents' mark.

19. Conceptually both marks refer to or convey the idea of American academic institutions with a presence in London but it is in the nature of their businesses that they should wish to do so. That brings me to the nature of the services in question. University and college education services are of a sophisticated nature and are likely to be chosen with care. There are likely to be a relatively small number of higher level academic institutions in any given location even one the size of London. If that is true of academic institutions generally it must, a fortiori, be the case with American owned or run universities/colleges in the capital. It would be surprising if

there were more than a very small number of such institutions based here. They are also the sort of organisations that are likely to be selected with a great deal of care and attention by anyone seeking to join one of their courses. In these circumstances it seems to me that the average consumer (which in the main I take to be potential students or their parents) would familiarise themselves with the options available to them and would not find it difficult to differentiate between organisations whose titles may have descriptive elements in common.

Likelihood of confusion

20. Albeit that I have had to approach the matter from the standpoint of Section 5(2) I believe that the conclusion I have reached is in effect the same as that in the preceding opposition cases (49471 and 49211). In those cases (and with roles reversed) the view was that there was no misrepresentation within the meaning of the passing off tests. I find here that there is no likelihood of confusion for the purposes of Section 5(2)(b). The opposition, therefore, fails.

21. The applicants are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £535. 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 this 20TH day of March 2002

**M REYNOLDS
For the Registrar
the Comptroller-General**

Details of opponents' earlier trade marks

No.	Mark	Class	Specification
2051132A	RICHMOND THE AMERICAN UNIVERSITY IN LONDON	16	Printed publications; instructional and teaching materials (except apparatus); stationery, pens and pencils.
	RICHMOND COLLEGE THE AMERICAN UNIVERSITY IN LONDON	25	T-shirts, sweatshirts, baseball caps.
	RICHMOND, THE AMERICAN UNIVERSITY IN LONDON	41	University educational services; adult teaching services; library services; provision of sports and recreational services; publishing services.
	RICHMOND COLLEGE, THE AMERICAN UNIVERSITY IN LONDON		
2051132B	RICHMOND THE AMERICAN INTERNATIONAL UNIVERSITY IN LONDON	16	Printed publications; instructional and teaching materials (except apparatus); stationery, pens and pencils.
	RICHMOND COLLEGE THE AMERICAN INTERNATIONAL UNIVERSITY IN LONDON	25	T-shirts, sweatshirts, baseball caps.
	RICHMOND, THE AMERICAN INTERNATIONAL UNIVERSITY IN LONDON	41	University educational services; adult teaching services; library services; provision of sports and recreational services; publishing services.
	RICHMOND COLLEGE, THE AMERICAN INTERNATIONAL UNIVERSITY IN LONDON		
	RICHMOND COLLEGE, THE AMERICAN INTERNATIONAL UNIVERSITY IN LONDON, INC.		