

O/593/18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION UK00003211628

**BY CHITHAMBARA MATHEMATICS CHALLENGE (CMC) LTD TO REGISTER
THE FOLLOWING TRADE MARK IN CLASS 41:**



AND


OPPOSITION THERETO (NO. OP000409201) BY

SOORIYALINGAM RAMESH

Background and Pleadings

1. CHITHAMBARA MATHEMATICS CHALLENGE (CMC) LTD (hereinafter called the Applicant) applied to register the trade mark shown above on the cover page of this decision for “Education” in class 41, on the 8th February 2017. It was accepted and published in the Trade Marks Journal on 21st April 2017 in respect of Education services in class 41.

2. SOORIYALINGAM RAMESH (hereinafter called the Opponent) opposes the trade mark on the basis of Sections 5(1), and 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK Trade Marks registration numbers 3115153 which was filed on 26th June 2015 and registered on 2nd October 2015 and 3110396 which was filed on 26th May 2015 and registered on the 18th September 2015 for services relied upon under class 41 below:

Earlier Mark 1 - 3115153	Earlier Mark 2 - 3110396
<p data-bbox="204 1245 671 1279">Chithambara Maths Challenge</p> <p data-bbox="204 1559 778 1760">CLASS 41: Education; Organisation of competitions for education or entertainment; Certification of education and training awards; Education examination.</p>	 <p data-bbox="834 1547 1409 1704">CLASS 41: Teaching mathematics, mathematics competition services; teaching services; teaching.</p>

3. The Opponent relies on all the services in class 41 for which the marks are registered. The Opponent claims that the marks are identical and the services are identical and that the application should be refused under s. 5(1). Alternatively, under

s. 5(2)(a), the Opponent claims that there is a likelihood of confusion because the marks are identical and because the goods and services are identical or similar or under 5(2)(b) that the trade marks are similar and are to be registered for services identical with or similar to those for which the earlier marks are protected. The Opponent submits that the Applicant's mark is

"exactly the same as the earlier mark I had registered"

"The identical emblem is used and the exact wordings in Tamil used".

"The applicant is making use of our name and trademark to create confusion among public and thereby make personal gains."

The Opponent also states that

"the writing within the shield is in Tamil and that the "wordings in Tamil says "Om Kalviye Kann" which means "Education is vision" or in other words "Knowledge is Power"."

4. The Applicant filed a counterstatement denying the claims made and requesting that the Opponent provides proof of use of its earlier trade marks relied upon. The Applicant submits that

"their logo is no way identical to the opponent's trademark."

"The logo used by the opponent is a logo of a school in Sri Lanka, the opponent has just copied the school trademark with the wording."

"The school trademark and the wording are in the public domain for many years"

"the documentation that was provided clearly indicates that there exists a Chithambara College Past Pupil's Association, based in the United Kingdom, who clearly use as their logo, the trademark registered by the opponent in this matter.... The top left hand corner of the past pupils association of Chithambara College clearly shows that the opponent in this matter has trademarked the school's logo."

“Our client’s logo is completely different and is no way near the trademark of the opponent”

5. Initially the Applicant was represented by Clapham law LLP however as of their email dated the 5th March 2018 they are no longer acting for the applicant. Both parties are therefore unrepresented at the time of considering the papers. Neither party filed evidence in these proceedings in the correct format other than the forms TM7 and TM8. The Applicant’s solicitor did file a letter with attachments dated the 8th September 2017 but not in the correct format by way of a witness statement, affidavit or statutory declaration as per Rule 64 of the Trade Mark Rules 2008.

6. Neither party filed submissions and no hearing was requested. This decision is taken following a careful perusal of the papers.

Proof of use

7. The Applicant has requested proof of use regarding of the Opponent’s earlier marks. The relevant statutory provision regarding proof of use is set out in section 6A of the Act, which reads as follows:

6A. - (1) This section applies where -

- (a) an application for registration of a trade mark has been published,
 - (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
 - (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

8. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. In these proceedings, the Opponent is relying upon the UKTM registrations shown above, both of which qualify as earlier trade marks under the above provisions. As these earlier trade marks had been registered for less than five years at the date the application was published, they are not subject to the proof of use provisions contained in section 6A of the Act. As a consequence the Opponent is entitled to rely upon them in relation to the services claimed without having to establish genuine use.

Decision

10. Sections 5(1) and 5(2)(a) require the respective marks to be identical. The Act states:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because—

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

11. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA, Case C-291/00, the Court of Justice of the European Union (“CJEU”)* held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

12. The Applicant’s trade mark constitutes a stylised device/image in the shape of a circle. The outer rim/circumference is a darker shade of blue which includes three

words written in white followed by an acronym, “Chithambara Mathematics Challenge(CMC)”, which is duplicated around the edge.

13. The Opponent’s trademarks comprise of 2 differing marks with the first being the words “Chithambara Maths Challenge” (mark 1) and the second being a device which I would describe as a shield (mark 2). The Applicant’s mark consists of words and a device.

14. Taking into account the above case of *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, the differences between the marks cannot be considered insignificant. The Applicant’s mark is not identical to either mark 1 or mark 2. The Opponent’s opposition therefore fails under s5(1) and s5(2)(a).

15. I will go on therefore to consider the opposition under section 5(2)(b), which states:

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

(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”.

16. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG, Case C-251/95, Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc, Case C-39/97, Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. Case C-342/97, Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98, Matratzen Concord GmbH v 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.

The principles:

(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 greater 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 to mind the earlier mark, 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.

Comparison of services

17. The competing services are as follows:

Opponent's Services: Mark 1

Class 41 - Education; Organisation of competitions for education or entertainment; Certification of education and training awards; Education examination.

Mark 2

Class 41 - Teaching mathematics, mathematics competition services; teaching services; teaching.

Applicant's Services: Class 41 – Education

18. The Opponent argues that the services are identical. The Applicant does not address the issue of identical services in his submissions.

19. The actual use by the parties is not relevant in a case such as this where proof of use does not apply, because the comparison must be made on the basis of notional use of the marks across the full width of the specifications. This was outlined in the case of *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, where Kitchen L.J. stated that:

“78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

20. It is clear therefore that my assessment must take into account only the applied-for mark (and its specification) and any potential conflict with the earlier trade marks. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

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

21. Both the applicant's specification and the earlier Mark 1 cover "Education" and so are identical. Education in the Applicant's specification is clearly a broad generic term encompassing all the teaching services protected under the Opponent's trademark Mark 2 and so are identical using the principles outlined in *Meric*.

Average consumer and the purchasing process

22. When considering the opposing trade marks I must determine first of all who the average consumer is for the services and the method of selecting these services.

23. 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."

24. The parties have made no submissions on the average consumer or the purchasing process for the services in question. The services provided will be provided to members of the UK general public, searching for mathematics competitions, examinations and services as well as general education services. The services could also be provided to business users, organisations and professional educational establishments (colleges, teachers, lecturers, universities and businesses) wishing to provide services to their employees or students.

25. The most probable method by which the services are selected is likely to be through self selection via the internet and or brochures, but could include signage on the high street, aural telephone enquiries and aural recommendations. The visual impact of the mark would play an important part in this selection process but aural considerations cannot be discounted. The level of attention paid by the average consumer in selecting the services would be medium given the nature of the services offered being infrequent purchases and taking into account the particular requirements of the consumer in selecting the appropriate course content.

Comparison of the Trade Marks

26. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by 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.”

27. It would be wrong, therefore, artificially to 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 they create.

28. Mark 1 comprises of the words “Chithambara Maths Challenge with no particular significant features regarding font, colour or size. “Maths Challenge” would be read together to signify the type of service offered. The applicant in his submissions refers to the Opponent’s logo as having Sri Lankan or Tamil origins; however there is no formal evidence to confirm this. “Chithambara” would not be clearly identified as having any particular meaning to the average consumer in the UK and will be seen as an invented word. The distinctive and dominant component of this mark is therefore “Chithambara”.

29. The Applicant’s trade mark consists of a number of components. The most dominant feature is the complex shield device in the inner circle because the eye is naturally drawn to the centre of the mark. This is superimposed over what appears to be an image of Tower Bridge, in London. However the words still have significant weight in the overall impression, particularly “Chithambara” which appears to be an invented word, although the words “Mathematics Challenge” will be seen as descriptive.

30. I will now compare both these competing marks taking into account the visual, aural and conceptual similarities of each.

31. The only point of visual similarity between the competing marks are the words “Chithambara Maths Challenge” and “Chithambara Mathematics Challenge”. The words “Chithambara” and “Challenge” are identical in both marks, the only difference being “Maths” as opposed to “Mathematics”. Maths is a well established shortened version of the word Mathematics. The Applicant’s mark is much more complex than the earlier mark, consisting of the words in a roundel, the superimposed shield over the bridge and contents of the shield: an ornate candlestick, foodstuff and a decorated pot and writing presented at the top being in a foreign language. Weighing up the similarities and differences between the two marks there is a low degree of visual similarity between them.

32. The only component of the Applicant's mark which is capable of pronunciation by the average UK consumer is in the use of the words within the mark above with the addition of (CMC). It is well established that where a mark consists of a combination of words and visual components that it is by the words that the mark is more likely to be referred to. The words "Chithambara" and "Challenge" are identical. The difference between the use of Maths and Mathematics is slight. Therefore I consider there to be a high degree of aural similarity between the two marks.

33. There is no formal evidence in the proceedings from either party as to whether the average consumer would have any understanding of the meaning of Chithambara or its relevance to Maths/Mathematics Challenges. Even if there had been formal evidence that Chithambara is the name of a Tamil school, it is the perception of the UK average consumer which is key. Since Chithambara will be seen as an invented word, this element is conceptually neutral; however, maths/mathematics challenge conveys an identical concept. I bear in mind that there are other elements in the Applicant's mark which have a concept; the representation Tower bridge, the shield and its contents. These are absent from the earlier mark. On balance the marks have a low to medium degree of conceptual similarity.

34. Mark 2 comprises the shield above. The Opponent states that the writing within the shield is in Tamil and that the *"wordings in Tamil says "Om Kalviye Kann" which means "Education is vision" or in other words "Knowledge is Power"*. The average UK consumer would not have this degree of understanding of the writing or necessarily recognise it as Tamil. There are no aural references attached to this mark and it is purely visual; there is therefore, no aural similarity. The shield does not convey any conceptual similarity to the extent that the contents of the shield have meaning.

Visually, the shield is a significant feature of the Applicant's mark and it is identical to the earlier mark. Taking into account the absence of the roundel and the words from the earlier mark there is a medium degree of visual similarity between the two marks.

Distinctive character of the earlier marks

35. No evidence has been filed by either party and the Opponent has not filed any evidence to establish that either of its marks have enhanced their distinctiveness through use. I must therefore determine the matter on inherent characteristics.

36. 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).”

37. Registered marks possess varying degrees of inherent distinctive characteristics on a sliding scale of low to high depending on the message they are trying to convey through the mark. Some are suggestive or allusive of a characteristic of the goods or services and others have no such qualities if they are made up or invented and with no particular link between the mark and the service provided.

38. The earlier mark, Mark 1 consists of words where the most distinctive and dominant feature is the word Chithambara but this has no apparent link to Mathematics Challenge. It may convey a greater meaning if this was a targeted service to the Tamil community as submitted by the Opponent “*We are a reputed institution providing “Maths Challenge” exams and our exams are very popular especially within the Tamil community*”. However, there is no formal evidence filed about such matters. Even if there had been, I bear in mind that in the case of *Pooja Sweets & Savouries Ltd V Pooja Sweets Limited, BL O-195-15*, Ms Anna Carboni, as the Appointed Person, held that

“where goods are targeted at the general public the mere fact that they might be of greater interest to a particular sub-set of the relevant public did not justify narrowing the assessment of distinctiveness to just that sub-set of the relevant public.”

39. In this case the mark is written in English. Chithambara is not an English word. It would be seen by the average UK consumer as an invented word and of high distinctive character. Maths Challenge is descriptive of services which involve mathematics competitions.

40. With regards Mark 2, the average UK consumer would be unlikely to recognise the words within the shield as Tamil and therefore be unaware that they translate to be “*Education is Vision*”. The shield is not associated with the services covered by the registration. I find therefore that there is a medium degree of inherent distinctiveness in this mark.

Likelihood of Confusion

41. There are two types of relevant confusion to consider. Direct confusion is where one mark is mistaken for the other and indirect confusion is where the similarities

between the marks lead the consumer to believe that the respective services stem from the same or related source.

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

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

42. In determining whether there is a likelihood of confusion there are a number of factors to bear 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent’s trade marks, the average consumer for the services and the nature of the purchasing process. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

43. Taking into account the impact of the device in the Applicant’s mark and the roundel, I think it unlikely that the application would be directly confused with the earlier word only mark. However, the dominant element of the earlier mark is CHITHAMBARA, which features in the application, together with the highly similar

wording MATHEMATICS/MATHS CHALLENGES. CHITHAMBARA is a highly distinctive word which has an independent distinctive role within both marks. Furthermore, the services are identical. In my view, this falls squarely within the explanation given above in the *LA Sugar* case about indirect confusion. I consider that the average UK consumer will believe that the respective services come from the same or related trade source. There is a likelihood of confusion.

44. Given this finding, it is, strictly speaking, unnecessary to consider the other earlier mark, Mark 2. However, for the sake of completeness, I also find that there is a likelihood of indirect confusion in relation to this earlier mark. Again, the services are identical and the dominant and distinctive part of the application is identical to the entirety of the earlier mark.

45. The opposition under section 5(2)(b) therefore succeeds regarding the Opponents' two marks; subject to any successful appeal, the application is refused.

Costs

46. The Opponent being unrepresented was invited by the Tribunal to complete and return a proforma indicating the time spent on various activities associated with the proceedings. As the Opponent has not provided such information, I therefore make no award as a contribution towards the cost of the proceedings other than to reimburse the opposition fee of £100.

Dated this 24th day of September 2018

Leisa Davies

For the Registrar