

**O-341-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**APPLICATION No. 3285484  
BY BUSINESS OF SCIENCE LIMITED  
TO REGISTER**



**IN CLASS 41**

**AND**

**OPPOSITION THERETO (UNDER No 412160)  
BY BOURNEMOUTH UNIVERSITY HIGHER EDUCATION CORPORATION**

## **Background and pleadings**

1. The relevant details of the application the subject of these proceedings are as follows:

Mark:	
Filing date:	26 January 2018
Publication date:	23 February 2018
Applicant:	Business of Science Limited

**Class 41** - Education and training services; arranging and conducting conferences, symposia, conventions, seminars, training workshops, courses; hosting and arranging of award ceremonies; coaching; consultancy and information services relating to arranging, conducting and organisation of conferences, symposia, conventions, seminars, training workshops, courses; entertainment; sporting and cultural activities; organisation of meetings and conferences, exhibitions and competitions; organisation of galas; organisation of recreational events; arranging of cultural events; publishing of printed matter; publication of printed matter in electronic form; publishing of web magazines; organisation of continuing educational seminars; providing information relating to continuing education via the Internet; providing audio and visual content, namely, podcasts, webinars, movies, ongoing television programs, short form video content, user generated content in the fields of entertainment and education; dissemination of educational material in the fields of personal development, career development, relationship building, recruiting, business consulting, business development, and networking; advice, consultancy and information services relating to the aforesaid.

2. Registration of the mark is opposed by Bournemouth University Higher Education Corporation (“the opponent”). Its grounds of opposition are based on sections 5(2)(b),

5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In relation to the first two grounds, the opponent relies on two earlier marks, both of which were filed on 11 December 2014 and registered on 25 May 2015, and both of which cover goods and services in classes 9, 16, 21, 25, 35, 36, 38, 41, 42, 43, 44 & 45, which I will set out later to the extent necessary. The marks themselves are:

EU registration 13554811 (“the black and white mark”):



EU registration 13554721 (“the colour mark”):



3. Under section 5(2)(b), the opponent claims that there is identity/high similarity with the applied for services, that the marks are highly similar, that the words BUSINESS OF SCIENCE CONFERENCE are descriptive and attract no trade mark protection, and, consequently, that there is a likelihood of confusion. Under section 5(3), unfair advantage, detriment and dilution is claimed.

4. Under section 5(4)(a), the applicant relies on the use of signs corresponding to the above marks in the UK (and the EU) since circa 1992.

5. Both of the opponent’s marks were filed before the applicant’s mark, so meaning that they qualify as earlier marks in accordance with section 6 of the Act. Both were registered within the period of 5 years ending on the date the applicant’s mark was published for opposition purposes, so meaning that the use conditions set out in section 6A do not apply.

6. The applicant filed a counterstatement denying the various grounds of opposition.

7. Both sides filed evidence and written submissions. Neither side requested a hearing, but both filed written submissions in lieu. The applicant has been represented by James Love Legal, the opponent by D Young & Co LLP.

### **The evidence**

8. Rather than provide a standalone evidence summary, I will, instead, refer to the pertinent parts of the evidence when it is necessary to do so. However, for the record, those who have given evidence (and about what) are as follows.

For the opponent - a witness statement from Ms Ann Fernandez, the opponent's director of marketing and communication. Her evidence is about the background to the opponent, its use of the acronym BU (which stands for Bournemouth University) and the use that has been made of its earlier mark(s).

For the applicant – a witness statement from Mr Stephen Bennett, the applicant's managing director. His evidence starts with a critique of the opponent's evidence (including highlighting that the earlier mark is always used with the words BOURNEMOUTH UNIVERSITY). He also gives evidence about the use made of the applicant's mark. He also comments that there has been no confusion between the marks and, he states, that on account of the applicant's use of its mark, it would be associated with it and it alone.

For the opponent, in reply – a further witness statement from Ms Fernandez, containing further examples of use of the earlier mark.

9. I begin this decision with the grounds of opposition under section 5(2)(b) of the Act.

### **Section 5(2)(b)**

10. Section 5(2)(b) of the Act states that:

“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.”

11. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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 the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods/services**

12. All relevant factors relating to the goods/services should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“the CJEU”), Case C-39/97, 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.”

13. Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

14. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“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..”

15. In addition to other goods and services in other classes, the opponent’s mark is registered for a variety of services in class 41, as follows:

Education; providing of training; entertainment; sporting and cultural activities; university education services; academic and vocational education and teaching services; medical training and teaching; advice relating to medical training; publishing services; publication of books, texts, journals and periodicals; library services; provision of lectures and seminars all relating to academic or vocational subjects; arranging and conducting conferences and seminars; provision of correspondence courses; education, instruction and training provided on-line from a computer database or from the Internet; provision of recreation and sporting facilities; providing training via computer games; education and training provided on-line or on CD-ROM or memory stick; education and training provided via remote learning tools, namely, virtual seminars, conferences, exhibitions and learning sessions, computer games, training materials and software; arranging and conducting of conferences; arranging and conducting of workshops [training]; publication of books; coaching; training; editing (videotape); dubbing; educational examination; organization of exhibitions for cultural or educational purposes; film production, other than advertising films; computer game services provided on-line from a computer network; layout services, other than for advertising purposes; providing museum facilities; news reporters services; journalism services; photographic reporting; production of radio and television programmes; production of videotape film; providing sports facilities; publication of electronic books and journals on-line; publication of texts, other than publicity texts; production of radio and television programmes; provision of information, namely sporting, cultural and news information through the media of publication, television and the internet; recording studio services; sport camp services; provision of movie studios; subtitling; production of radio and television programmes; videotape editing; videotape film production; hospitality



services (entertainment); information, advisory and consultancy services relating to all the aforesaid services.

16. The applicant seeks registration in relation to the following class 41 services:

**Education and training services; arranging and conducting conferences, symposia, conventions, seminars, training workshops, courses;** hosting and arranging of award ceremonies; **coaching;** consultancy and information services relating to arranging, conducting and organisation of conferences, symposia, conventions, seminars, training workshops, courses; **entertainment; sporting and cultural activities;** organisation of meetings and conferences, exhibitions and competitions; organisation of galas; organisation of recreational events; **arranging of cultural events;** publishing of printed matter; publication of printed matter in electronic form; publishing of web magazines; **organisation of continuing educational seminars;** providing information relating to continuing education via the Internet; providing audio and visual content, namely, podcasts, webinars, movies, ongoing television programs, short form video content, user generated content in the fields of entertainment and education; dissemination of educational material in the fields of personal development, career development, relationship building, recruiting, business consulting, business development, and networking; advice, consultancy and information services relating to the aforesaid.

17. The opponent's marks covers, in general terms: education, providing of training, entertainment, sporting and cultural activities. I consider it clear that the terms I have emboldened in the applicant's specification above fall within the ambit of one, or other, of the opponent's terms I have referred to and, as such, are considered identical on an inclusion basis<sup>1</sup>. I will now go through the remaining applied for services in more detail.

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<sup>1</sup> See, for example, Case T- 133/05, of the General Court

### Hosting and arranging of award ceremonies

18. None of the earlier services specifically cover the hosting and arranging of award ceremonies. However, whilst this is not an educational service per se, it seems to me that there is a close complementary relationship between the provision of education and the provision of an award ceremony relating thereto, with an award ceremony often following the successful completion of a course of study. That link is one where the consumer would well expect the same provider to provide both. I consider there to be a medium degree of similarity on that basis.

### Consultancy and information services relating to arranging, conducting and organisation of conferences, symposia, conventions, seminars, training workshops, courses

19. The earlier mark covers services for arranging and conducting conferences and seminars, and, also, workshops. The earlier mark also covers information and consultancy in relation to the aforesaid. As such, I consider the above term, in so far as it relates to conferences, seminars and training workshops, to be identical to terms covered by the earlier mark, or else there must be a very high degree of similarity.

20. In relation to the above services relating to symposia and conventions, these, in reality, are no different to a conference or seminar, so the same finding applies. If there is a difference then it is a small one and there would be a high level of similarity on account of nature, purpose and channels of trade. In relation to information/consultancy in relation to arranging (etc) courses, then as courses fall within the earlier mark's education, and the earlier specification includes information/consultancy thereof, the services are, again, identical.

### Organisation of meetings and conferences, exhibitions and competitions

21. The services of the earlier mark include arranging of conference and exhibitions. Therefore, there is identity with some of the above. In terms of the organisation of meetings, they are highly similar to the opponent's services for arranging seminars and conferences, which are aimed at the same type of public, may be offered by the

same businesses and have a similar purpose. The services are highly similar. The organisation of competitions could be a sporting, entertainment or educational competition and, as such, fall within the equivalent term in the earlier mark and, so, are identical, or, if not, highly similar.

Organisation of galas; organisation of recreational events

22. The above could be forms of entertainment, sporting or cultural events/activities. I consider they fall within one or other of the opponent's entertainment, sporting or cultural activities. The services are identical.

Publishing of printed matter; publication of printed matter in electronic form; publishing of web magazines

23. The opponent's specification covers publishing services. I consider the applied for terms to fall within the ambit of the opponent's term and, as such, they are considered identical. If they are not identical, they must be similar to the very highest degree.

Providing information relating to continuing education via the Internet

24. The opponent's mark covers "information...services relating to the aforesaid services", the aforesaid including education. I consider the applied for term to fall within the ambit of the opponent's term and, as such, they are considered identical. If they are not identical, they must be similar to the very highest degree.

Providing audio and visual content, namely, podcasts, webinars, movies, ongoing television programs, short form video content, user generated content in the fields of entertainment and education

25. Whether for education or entertainment, the above would fall within the opponent's entertainment and/or education services. The services are identical, or if not they must be similar to the very highest degree.

Dissemination of educational material in the fields of personal development, career development, relationship building, recruiting, business consulting, business development, and networking

26. Whilst it is unlikely that the above would be regarded as an educational service per se, the services are still, in my view, complementary to the educational services as covered by the earlier mark (educational services, which given the breadth of the term would include education in the fields specified above). They have a very clear link and the link is of such a nature that the educational service provider would also likely to be seen as responsible for the dissemination of education material. The services have a medium degree of similarity.

Advice, consultancy and information services relating to the aforesaid

27. I consider the above advice, consultancy and advisory services to rest and fall with the similarity of the “aforesaid”. They are similar to the same degree.

### **Average consumer and the purchasing act**

28. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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.”

29. The average consumer of the contested services could be a member of the general public, looking, for example, for services in the field of entertainment or education, or could be a business, looking for the same services (especially entertainment), and also conferences etc, in the particular field of interest. The breadth of the services is large with a correspondingly large potential for there to be a range of cost, frequency of selection etc. In general terms, entertainment, sporting and cultural event services will have no more than a medium level of care and consideration. Slightly more care might be paid to the selection of education and training providers, or conference providers etc, but whilst this might be a little higher than the norm, it is unlikely to be of the very highest level of consideration.

30. The services are likely to be seen on brochures, advertising material on the web etc, all of which suggests that the visual impact of the marks will play an important role in the selection process and will likely take on most significance. However, I do not discount the potential for the verbal use of the marks through recommendations, booking places at conferences over the phone etc. Aural similarity must not, therefore, be excluded from the assessment.

### **Comparison of marks**

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

32. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. I will focus on the opponent's black and white mark. The marks to be compared are:



33. One of the key submissions made by the applicant as to why there will be no confusion is based on the fact that the opponent's mark is almost always used in conjunction with the name BOURNEMOUTH UNIVERSITY. However, this is not the correct test. The opponent's mark as registered does not include those words. It is the notional use of the mark as registered that must be compared to the applicant's mark.

34. In terms of overall impression, the earlier mark clearly comprises the letters BU. The stylisation does, though, play a reasonable part in its overall impression. In terms of the applied for mark, there are a number of components. The letters Bu appear within a tile or square, alongside which are the words Business of Science Conference (with Business and Science emboldened). These two elements make a roughly equal contribution to the mark's overall impression. Within the tile, at the bottom, are the words/letters BusOfSci. However, they are in very small lettering and are barely discernible. They are either negligible, or otherwise play only a very limited role in the overall impression of the mark.

#### *Visual similarity*

35. Both marks clearly contain the letters BU/Bu. However, the visual similarity this creates is reduced by the stylisation of the letters in the earlier mark, the presentation of the letters in the applied for mark on a tile/square background, and the addition of the words Business of Science Conference. The fact that the applied for mark contains the colour blue under the (colour contrasted) letters Bu, does little to create a difference. This is because the applied for mark is not registered with regard to colour

and could notionally be used in a similar colour scheme. Overall, I consider the degree of visual similarity to be between low and medium.

#### *Aural similarity*

36. The earlier mark comprises just the (stylised) letters BU. Whilst I do not rule out the possibility that the letters may be pronounced as a word (BOO or BUH), I consider it far more likely that the letters will be pronounced as letters, i.e. BE-YOU.

37. In terms of the applied for mark, the letters, despite them being presented in upper and lower case, are likely to be articulated in the same way. The words Business of Science Conference will be articulated in a conventional manner, so there are two distinct verbal components.

38. The likely identical articulations of BU/Bu creates a degree of aural similarity, although given the much longer articulation of the applied for mark, such aural similarity is at the lower end of the spectrum.

#### *Conceptual similarity*

39. Conceptually, both marks contain the letters BU/Bu. In the earlier mark, I do not consider that the average consumer will pin any specific meaning to the letters, beyond them being letters. In terms of the applied for mark, the applicant's submission is that the letters Bu stand for the word Business (as per the word Business in Business of Science Conference) and that the upper and lower casing of the words is reminiscent of the way in which elements are represented in the periodic table (which is a nod towards the word Science). However, in my view, I do not consider that the average consumer will get to that view and they will, instead, just see the letters as letters. There is, thus, some conceptual similarity, on the basis that both marks will be recalled, or recalled in part, on the basis of the same letter combination. Even if I am wrong on that, and that some average consumers might interpret the applied for mark in the way suggested by the applicant, there would still in my view be a significant proportion of average consumers who would not see it that way, for whom there would be no conceptual distinction in the way in which the letters are perceived. The applied

for mark also contains the words BUSINESS OF SCIENCE CONFERENCE, which gives the applied for mark a further (and different) concept to the earlier mark.

### **Distinctive character of the earlier trade mark**

40. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

“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).

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).”<sup>2</sup>

41. From an inherent perspective, the earlier mark consists of the letters BU with a degree of stylisation. The stylisation adds some distinctiveness, but not a huge amount. Letters are not generally speaking the most distinctive of trade marks

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<sup>2</sup> C-342/97, paras. 22-23



(although it does not automatically follow that letters are weak in distinctiveness), because the consumer will often assume that they mean something. However, as presented here, there is nothing to suggest what they do mean. I consider that the earlier mark has a normal degree of inherent distinctiveness.

42. I now turn to the use made of the mark(s), as set out in the evidence of Ms Fernandez. The opponent runs Bournemouth University. Ms Fernandez explains that the university uses the letters BU as an acronym for the name Bournemouth University. She states that the earlier mark has been used since 2006. A large amount of material is provided in various exhibits which show the letters BU being used as plain text, and/or in the form depicted in the earlier marks. Invariably, such use is in conjunction with, and in close proximity to, the words BOURNEMOUTH UNIVERSITY. Sometimes (but not often) they are used in less close a proximity, but in all of the material, the reader will be left in no doubt that the materials have been issued by Bournemouth University and that the mark is a stylised acronym for that name.

43. The supporting material is broad, all relating, in one form or another, to the activities that the university undertakes. It also includes information on an enquiry service called “askBU”, the opponent’s sporting programme “SportBU”, and other initiatives such as LettingBU and CareersBU. After discussing other initiatives, including its work with the Erasmus programme, Ms Fernandez refers to various events that have been run. She states that approximately 100-130 academic conferences are run per year, around 10 of which would be large scale, with over 200 attendees. Exhibits AF12-19 provide details, and which show use of the earlier marks, whether this is in PowerPoint presentations, publicity materials, or because the events are placed on the opponent’s website, the banner page of which features the marks.

44. Evidence is also given about the opponent’s growing social media presence with likes/followers in the tens of thousands. It is estimated that around £3million per year is expended on promoting the university. Further evidence was filed in reply by Ms Fernandez, showing, essentially, further evidence of the use of the marks, notably in relation to academic conferences; again, BU is used in some way or another in association with Bournemouth University.

45. In terms of whether the evidence establishes that the inherent level of distinctiveness has been enhanced through use, there are some gaps in the evidence. There are no turnover figures broken down by the services covered by the earlier mark and, whilst there is some evidence of attendee numbers for the conferences that have been run, it is not as clear as it could have been for overall attendees per annum. Nevertheless, I am prepared to accept, on the basis of the evidence filed, that there may have been a modest uplift in distinctiveness of the earlier mark in relation to educational services. In relation to conferences and other such events, whilst the mark is clearly used, I do not consider that the evidence shows an uplift in the inherent distinctiveness of the mark.

### **Likelihood of confusion**

46. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted 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”.

47. In my view, I can easily rule out the likelihood of direct confusion. There are a number of differences between the marks, including the stylisation and the additional words, which mean, notwithstanding the concept of imperfect recollection and that some of the services are identical, that the average consumer will not mis-remember/mis-recall one mark for the other.

48. That then leads to indirect confusion. One of the reasons put forward by the applicant as to why confusion will not arise is based upon the different things to which the letters BU/Bu refer in the respective marks, one tying to the name of a conference, the other to Bournemouth University. For the reasons already outlined (see paragraphs 33 and 39), this is not the appropriate test. In a witness statement provided by Mr Stephen Bennett, the applicant’s managing director, he provides evidence about the use made of the applied for mark. The point appears to be that the parties have used their respective marks without confusion. I do not need to detail Mr Bennett’s evidence in any greater detail than this because the absence of confusion is rarely significant in determining whether there is a likelihood of confusion<sup>3</sup>. This is particularly so in the case before me because, in use, and as the applicant points out, the words BOURNEMOUTH UNIVERSITY are always used in close proximity. Whilst this may create a point of distinction in the way in which the parties have actually used there marks, for the reasons already given, this is not something I can reflect in the notional comparison of the marks before me.

49. The opponent submits that the common presence in both marks of the dominant element BU/Bu is sufficient to inform the consumer that the services originate from the same undertaking. However, I bear in mind that my assessment of the overall impressions of the applied for mark found that the letters did not dominate the mark, but that they played a roughly equal role. That said, the letters perform an independent

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<sup>3</sup> See, for example, *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283

role within the mark given my findings in relation to their conceptual significance. I come to the view that notwithstanding the additional wording in the applied for mark, and the added stylisation in the earlier mark, there will be a likelihood of indirect confusion for all of the services. The letters BU/Bu indicate trade origin in and of themselves. The difference in the casing might be misremembered. The stylisation will simply be seen, if it is recalled, as a brand variant. The addition of the words in the applied for mark will be seen as some form of reference to the nature of the services provided, even though they may not be wholly descriptive. A good deal of the services are identical, but with all of the others there is some form of key relationship. The average consumer will put all this together and instinctively believe that the sharing of the letters BU/bu within the marks (which have at least a normal level of distinctiveness) signifies that the same or related economic undertaking is responsible for the services. The opposition succeeds in full on this ground.

50. I should add for sake of completeness that my finding would have been the same in respect of the opponent's colour mark. Even though the colour is a point of distinction, the contribution to the overall impression of the respective colours used is limited and it would have done little to avoid confusion.

### **Section 5(4)(a)**

51. Section 5(4)(a) of the Act reads:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

52. It is settled law that for a successful finding under the law of passing-off, three factors must be present: i) goodwill, ii) misrepresentation and iii) damage.

53. Given the opponent has already succeeded, I will deal with this ground more briefly. My view is that if I was wrong to have held that the opposition succeeded under section 5(2)(b), the opponent would be in no better position under section 5(4)(a). Indeed, I consider that the ground under section 5(4)(a) would more likely have failed. This is because even if I held that the opponent had a protectable goodwill associated with the signs relied upon (which, for the record, I would have held at least in relation to educational services), that goodwill is inextricably tied to the name of Bournemouth University. Claims under section 5(4)(a) are based less on a notional assessment of the sign relied upon, but more upon actual use. When the actual use is taken into account, there is less likelihood that there will be any form of deception with the applied for mark. I need say no more than this.

### **Section 5(3)**

54. Section 5(3) states:

“5(3) A trade mark which (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

55. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*.

56. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; General Motors, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; General Motors, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; Adidas Saloman, paragraph 29 and Intel, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; Intel, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; Intel, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; Intel, paragraphs 76 and 77.

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

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

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

57. Again, I deal with this ground briefly. I do not consider that this ground will improve the opponent's position. If there is no confusion, and if I am wrong on my finding under section 5(2)(b), the earlier mark may in fact not even be brought to mind. Even if it was, the simple bringing to mind in such circumstances would not necessarily lead to the heads of damage claimed by the opponent.

## **Conclusion**

58. The opposition succeeds. As such, and subject to appeal, the applied-for mark is refused registration.

## **Costs**

59. I have determined these proceedings in favour of the opponent. It is, therefore, entitled to an award of costs. I award the applicant the sum of £2000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee: £200

Considering the statement of case and filing a counterstatement: £300

Considering and filing evidence: £1000

Preparing written submissions: £500

60. I therefore order Business of Science Limited to pay Bournemouth University Higher Education Corporation the sum of £2000. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 18th day of June 2019**

**Oliver Morris**

**For the Registrar**

**the Comptroller-General**