

O-366-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION  
No. 2546141  
BY EMMANUEL DARE ANTHONY  
TO REGISTER A SERIES OF TWO TRADE MARKS**



**IN CLASSES 9, 35 & 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 100741 BY  
AMBITIOUS ABOUT AUTISM**

## BACKGROUND

1) On 23 April 2010 Mr Emmanuel Dare Anthony (hereinafter the applicant), applied to register the following series of two marks:



2) In respect of:

In Class 9: Pre-recorded CDs and DVDs; coaching, life coaching, mentoring, educational, teaching and training materials in the form of CDs and DVDs; downloadable electronic publications or printed matter in electronic format (downloadable); downloadable audio, visual and audiovisual material; downloadable educational, teaching and training materials; video recordings; sound recordings; podcasts; none of the above relating to autism or for use in relation to the education, therapy or treatment of people with autism.



In Class 35: Business management; business administration; office functions; business consultancy; business assistance; provision of business information; advice, assistance, consultancy and information relating to commercial enterprises in the management, administration, operation, organisation and conduct of their business; business networking services; marketing and promotional services; advertising; advisory, consultancy and information services relating to the above; none of the above being a charitable service or relating to charities.

In Class 41: Education, teaching and training; education, teaching and training in the fields of business, commerce and/or personal development; coaching and mentoring services; life coaching and mentoring; business coaching; arranging and conducting conferences, seminars and workshops in relation to the aforementioned services; organising and conducting online educational and training events including virtual meetings and seminars; provision of online electronic publications (not downloadable); publication of books, texts, leaflets, reports, educational and training materials and manuals; publishing; production of DVDs and audio and/or audio visual material; advisory, consultancy and information services relating to the above; none of the above relating to autism or for use in relation to the education, therapy or treatment of people with autism.

3) The application was examined and accepted, and subsequently published for opposition purposes on 21 May 2010 in Trade Marks Journal No.6836.

4) On 19 July 2010, Ambitious About Autism, formerly The Treehouse Trust, (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade marks:

Number	Mark	Filing and Registration Date	Class	Specification
2180119B	 <p>The applicant claims the colours green, brown and black as an element of the mark. By Consent No. 2161800 (6233,7555)</p>	08.10.98 / 13.08.99	16	Educational materials and/or information in printed form.
			41	Provision of education for children with autism and related disorders; training in the delivery of Applied Behaviour Analysis educational methods.
2455593	 <p>The colours shown in the mark are orange Pantone 173u, green Pantone 361u and fade orange Pantone 173u.</p>	15.05.07 / 16.11.07	9	Educational materials and/or information in the form of computer programs, films and video.
			16	Educational materials and/or information in printed form.
			35	Consultancy on the management of educational or charitable issues.
			36	Charitable fund raising and collections.
			41	Provision of education for children with autism and related disorders; training in the delivery of applied behaviour analysis educational methods.

- b) The opponent states that the marks are similar and that both parties' goods and services are identical or similar. The opponent states that the application offends against Section 5(2)(b).
- 5) On 8 October 2010, the applicant filed a counterstatement which basically denied the opponent's claims. The applicant puts the opponent to strict proof of use.
- 6) Only the opponent filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 17 October 2011. At the hearing, the opponent was represented by Mr Stobbs of Messrs Impulse (IP) Limited; the applicant was not represented but supplied written submissions which I shall take into account as and when required in my decision.

### **OPPONENT'S EVIDENCE**

7) The opponent filed a witness statement, dated 11 February 2011, by Jolanta Lasota the Chief Executive of the opponent company. She states:

"7. My company was established in 1997 in response to the significantly unaddressed national need for specialist education and specialist schools for children with autism. We exist to educate children and young people with autism and related disorders, produce and promote autism education research, support parents and the families of children and young people with autism, train professionals working with children and young people with autism, influence local and national decision makers affecting autism policy, and produce educational materials and other information in relation to each of these services. My company has continued to provide and further develop these goods and services since its conception, always using the Trade Mark in conjunction with the same."

8) Ms Lasota also provides the following exhibits:

- Exhibit 3: A screen shot of the home page of the opponent's website on 15 August 2000. This shows use of trade mark number 2180119B.
- Exhibit 4: A screen shot of the home page of the opponent's website on 1 February 2010. This shows use of trade mark number 2455593.
- Exhibit 5: A copy of a leaflet entitled "About TreeHouse" which provides details of the activities of the opponent. It is said that over 100,000 of these leaflets have been distributed. This shows use of trade mark number 2455593.
- Exhibit 6: A copy of a booklet entitled "10 years of TreeHouse History 1997-2007". It is claimed that 10,000 of these booklets were distributed. This booklet shows use of the mark in fundraising, in relation to the school operated by the opponent and on various leaflets and publications providing advice on a range of

issues surrounding autism. This shows use of trade mark number 2180119B from 1997 – 2003, and of trade mark number 2455593 from 2004-2007.

- Exhibit 7: Copies of newsletters issued by the opponent to elected representatives, local officials, community groups, supporters and the public. The copies are of very poor quality and many of the photographs can barely be made out. It is clear that until 2005 only trade mark number 2180119B was used. After this date both marks appear to be used.
- Exhibit 8: Copies of various printed articles regarding the charity in its work campaigning on behalf of those with autism, fundraising and its operation of a school and national centre, involved in training parents and teachers on how to educate those who are autistic. It shows use of both trade marks and in many articles written in newspapers etc the opponent is referred to simply as "Treehouse".

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

## **DECISION**

10) The only ground of opposition is under Section 5(2)(b) of the Act which reads:

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

(a)....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

11) An "earlier trade mark" is defined in section 6, the relevant part of which states:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks."

12) The opponent is relying upon its trade marks listed in paragraph 4 which are clearly earlier trade marks. They were registered on 13 August 1999 (2180119B), and 16 November 2007 (2455593). Only the first mark (2180119B) is subject to The Trade Marks (Proof of Use, etc) Regulations 2004, paragraph six of which states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark 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)....
- (b)....

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

13) In the instant case the publication date of the application was 21 May 2010. Therefore, the relevant period for proof of use is 22 May 2005 - 21 May 2010. I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the mark has been made. The guiding principles to be applied in determining whether there has been genuine use of a mark are *Ansul BV v Ajax Brandbeveiliging*

*BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following main points:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be 'on the market' and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

14) I must also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

"29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment

is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in Decon suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

15) The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant.

"20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable



example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

16) The only use of trade mark 2180119B during the relevant period is on newsletters. In strict terms this shows only use on "information in printed form" in Class 16. I do not regard these newsletters as "educational materials". However, the content of the newsletters must also be taken into account. A great many of these are so poorly photocopied that they are very difficult to read. I cannot find any references to "educational materials" being offered for sale within these newsletters and the opponent was unable to refer me to any such items at the hearing. However, it was possible to glean from what was readable that the opponent provided a school for children with autism. I am therefore willing to accept that this service in Class 41 was also being offered by the opponent. For the purposes of the comparison test the opponent's specification will be amended as follows:

Specification of 2180119B as registered	Specification to be used in comparison test following proof of use test
Class 16: Educational materials and/or information in printed form.	Information in printed form.
Class 41: Provision of education for children with autism and related disorders; training in the delivery of Applied Behaviour Analysis educational methods.	Provision of education for children with autism and related disorders;

17) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *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 and *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). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10) Mr Hobbs QC

acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

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

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) 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;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

18) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods and services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. Furthermore, I must compare the applicant's mark and the marks relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods and services in their specifications.

19) In the instant case the opponent has provided evidence regarding use of its mark. However, the opponent has not provided turnover or marketing figures nor has it filed evidence from the trade or independent witnesses. It cannot therefore benefit from an enhanced reputation. However, to my mind, the opponent's mark has a high degree of inherent distinctiveness.

20) As the case law in paragraph 17 above indicates I must determine the average consumer for the goods and services of the parties. I must then determine the manner in which these goods and services are likely to be selected by the said average consumer. Educational products and services will be purchased by members of the public, either for themselves or for members of their family, they will also be purchased by those in the education industry including teachers and local and central government, and also by businesses. Such goods and services will not be purchased or selected without considerable care.

24) At the hearing, following a discussion on the outcome of the proof of use exercise, Mr Stobbs accepted that the opponent's strongest case was under its 2455593 trade mark. I shall therefore consider the case only with regard to that mark and its specification. I shall now consider the goods and services of the two parties. For ease of reference, I set out only the relevant goods and services of both parties below:

Opponent's specification	Applicants' specification
Class 9: Educational materials and/or information in the form of computer programs, films	In Class 9: Pre-recorded CDs and DVDs; coaching, life coaching, mentoring, educational, teaching and training materials in the form of CDs and DVDs; downloadable electronic publications or printed matter in electronic format (downloadable); downloadable audio, visual and audiovisual material; downloadable educational, teaching and training materials; video recordings; sound recordings; podcasts; none of the above relating to autism or for

and video.	use in relation to the education, therapy or treatment of people with autism.
Class 35: Consultancy on the management of educational or charitable issues.	In Class 35: Business management; business administration; office functions; business consultancy; business assistance; provision of business information; advice, assistance, consultancy and information relating to commercial enterprises in the management, administration, operation, organisation and conduct of their business; business networking services; marketing and promotional services; advertising; advisory, consultancy and information services relating to the above; none of the above being a charitable service or relating to charities.
Class 41: Provision of education for children with autism and related disorders; training in the delivery of applied behaviour analysis educational methods.	In Class 41: Education, teaching and training; education, teaching and training in the fields of business, commerce and/or personal development; coaching and mentoring services; life coaching and mentoring; business coaching; arranging and conducting conferences, seminars and workshops in relation to the aforementioned services; organising and conducting online educational and training events including virtual meetings and seminars; provision of online electronic publications (not downloadable); publication of books, texts, leaflets, reports, educational and training materials and manuals; publishing; production of DVDs and audio and/or audio visual material; advisory, consultancy and information services relating to the above; none of the above relating to autism or for use in relation to the education, therapy or treatment of people with autism.

25) The applicant in its written submissions merely states that “there is no similarity” between the goods and services of the two parties, but does not provide any reasoning to corroborate this assertion. To my mind the two parties goods in Class 9 are clearly identical as the opponent has no restriction upon its specification and so their range of educational materials in various formats would include those for people who are not autistic. The goods of the opponent encompass those of the applicant.

26) Moving onto the Class 35 services, here the opponent’s services are restricted to educational and charitable issues. The applicant’s services specifically restrict their services to non charitable services. However, they do not exclude educational issues and so the restriction plays no part in this comparison. Educational services are quite capable of being commercial and to my mind there is clear identity between the two sets of services.

27) Moving onto the applicant’s services in Class 41, I note that the applicant’s specification has a restriction so that the services do not relate autism. However, the opponent’s Class 41 specification also includes “training in the delivery of applied behaviour analysis educational methods”. Neither side has provided evidence as to the exact nature of such services. In considering the specification applied for by the

applicant I see no reason why such services should not include applied behaviour analysis educational methods, and I therefore conclude that the services are identical.

28) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicants' Trade Mark	Opponent's Trade Mark
	 <p data-bbox="917 1192 1414 1285">The colours shown in the mark are orange Pantone 173u, green Pantone 361u and fade orange Pantone 173u.</p>

29) The applicant's mark is a series of two, one of which is in colour the other black and white. No colour claim has been made and so there is no restriction upon the applicant's mark. The device element in the applicant's mark would be seen as a human figure forming a tree with leaves sprouting from the figures arms. This would emphasise the first part of the first word "Tree" in "TreeHouse". The hyphenated word "In" does not make sense or alter the meaning of the word "TreeHouse". The mark is completed by the strapline "Branch out and be successful" which would be seen as being an exhortation or motto for the goods and services. To my mind, whilst the dominant element of the whole mark is the device element simply because of its size, the word "TreeHouse" retains an independent distinctive role within the composite mark. The same could be said of the opponent's mark. Here the device element is a childish

drawing of a treehouse which is quite large. However, it simply serves to enhance the first word in the mark “TreeHouse” which undoubtedly retains an independent distinctive role within the composite mark. There is also a strapline “Ambitious about Autism” which will be seen as the opponent’s creed. Visually, I believe that whilst there are very obvious differences between the marks they share a common distinctive element, the word “TreeHouse”.

30) Aurally the marks have a number of differences sharing only the initial word “TreeHouse”. However, it is the initial word that they share and the other aural elements would, in my view be seen as straplines.

31) Conceptually both marks share the same image namely a treehouse. The other words and the device elements do not detract from this conceptual image, the applicant’s device being an image of a tree and the opponent’s a treehouse.

32) Taken overall although there are a number of differences between the marks I believe that the single common element is so distinctive that it outweighs the differences.

37) When determining whether there is a likelihood of confusion I have to take a number of factors into consideration. There is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must consider the distinctive nature of the opponent’s trade mark, the average consumer for the goods and services, the nature of the purchasing process and the issue of imperfect recollection. I must also take into account that these goods and services will not be chosen without considerable care. In the instant case the opponent’s mark is inherently very distinctive and the goods and services are identical. To my mind, although the competing trade marks have a number of differences, these are outweighed by the common aspect of the mark to the extent that there is a likelihood of confusion on the part of the public, or a likelihood of association with the earlier trade mark. The ground of opposition under Section 5(2)(b) succeeds.

**COSTS**

38) The opponent has been successful and it is therefore entitled to a contribution towards its costs.

Preparing a statement and considering the other side’s statement	£300
Preparing evidence	£900
Preparing for and attending a hearing	£900
Expenses	£200
<b>TOTAL</b>	<b>£2300</b>

39) I order the applicant to pay the opponent the sum of £2300. This sum 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 26<sup>th</sup> day of October 2011**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**