

O-235-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3012808
BY THAVARAJASINGAM UTHAYANAN
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 41 & 42:**



AND

**OPPOSITION THERETO (NO. 401045) BY
JEHAN RAJENDRA**

Background and pleadings

1. Thavarajasingam Uthayanan (“the applicant”) filed the above trade mark on 5 July 2013. It was published for opposition purposes on 16 August 2013 for the following services:

Class 41: Education – providing of training, entertainment, sporting and cultural activities.

Class 42: Scientific and technological services and research and design.

2. Registration is opposed by Jehan Rajendra (“the opponent”) under sections 5(1), 5(2)(b), 5(3), 5(4)(a) & 3(6) of the Trade Marks Act 1994 (“the Act”). In summary, the pleadings are as follows:

- i) Section 5(1) of the Act based on earlier registration 3011790 which consists of the series of four trade marks: CWN Mathematics Challenge, CWN: Mathematics Challenge, CWN Maths Challenge & CWN Maths Challenge. The application to register these marks was filed on 27 June 2013 and the registration process completed on 4 October 2013. The mark is registered for the following services:

Class 41: Competitions (organising of education-);Education examination;Educational examination;Educational testing;Examination services (educational -);Organising competitions;Provision of educational examinations;Provision of educational examinations and tests;Publication of material which can be accessed from databases or from the internet;Publication of printed matter;Publication of printed matter and printed publications;Publication of printed matter relating to education;Remedial tuition;Tuition

Reference is made in the pleading to the applicant having helped the opponent with some manual labour. It is claimed that the applicant has “confiscated” some exam papers from an exam that the opponent ran and some funds from a participating school, it is stated that the applicant has registered companies with similar names and has applied for his trade mark in order to “cheat parents into believing that the collected funds will be used for our charitable activities”.

- ii) Section 5(2)(b) of the Act based on earlier registration 3010204 which consists of the series of two trade marks: Chithambara College Well-wishers Network & Chithambara College Well-wishers' Network. The application to register these marks was filed on 16 June 2013 and the registration process completed on 20 September 2013. The marks are registered for the following services:

Class 41: Arranging for students to participate in educational activities;Arranging for students to participate in educational courses;Arranging of award ceremonies;Arranging of award ceremonies to recognise achievement;Arranging of competitions for education or

entertainment;Arranging of competitions for educational purposes;Certification of education and training awards;Charitable services, namely education and training;Competitions (organisation of-) [education or entertainment];Competitions (organising of education-);Educational examination;Educational examination services;Educational examination services (information relating to -);Educational testing;Examination services (educational -);Hosting [organising] awards;Information relating to education, provided on-line from a computer database or the internet;Organisation of competitions;Organisation of competitions (education or entertainment);Organisation of competitions for education or entertainment;Organisation of examinations [educational];Organisation of examinations to grade level of achievement;Organising competitions;Organising of competitions for education;Organising of conferences for educational purposes;Organising of education competitions;Organization of competitions;Organization of competitions [education or entertainment];Organization of education competitions;Providing tutorial sessions in the field of mathematics;Remedial tuition;Services for the organisation of competitions;Teaching;Tuition.

- iii) Section 5(3) of the Act based on the two registrations above. It is claimed that the earlier marks have a reputation for all their services and that the applicant is trying to manipulate the public into thinking that any collected funds will be used by the opponent's charitable service.
- iv) Section 5(4)(a) of the Act based on the use since 24 February 2012 of the signs CWN: Maths Challenge and of the sign Chithambara College Well-Wishers Network, both in respect of a maths examination, award ceremony and tuition.
- v) Section 3(6) of the Act, the claim being that:

"The infringing trademark has been raised to solely imitate our Mathematics Challenge service by a former volunteer [the applicant] who is collecting children's identities and public donations using our name and past achievements. This individual has been well aware that Chithambara College Well-wishers Network is my father's trading name, been [sic] keeping a close eye on our achievements through our emails and websites (previously: www.chithambaracollege.com, now: www.cwnetwork.co.uk). He volunteered to help invigilate our Croydon examination center in June. On the examination day, without our permission, he distributed an identical application form for next year's Mathematics Challenge replacing our charity's name and contacts with his own. He then registered a company (08584889 - "CWN MATHS CHALLENGE LTD") with the same name as our Mathematics Challenge service, confiscated all of our answer papers with the help of one of our examination coordinators, manipulating parents into thinking that our charity's service belongs to him, and now shockingly demanding (through aggressive letters) that we hand over our achievements and public donations to his friends. We have reported these atrocities and a lot more to the Police Ref: 18th June CAD6795, 25th June

CA02057, 1st July CHS5741, 14th July CHS7374, 3rd Aug CA03465. His actions have hurt us very deeply, angered parents and tarnished our charity's good reputation.”

The two earlier trade mark registrations relied upon are owned jointly by the opponent and his father, Swaminathamuthaly Rajendra.

3. The applicant filed a counterstatement stating:

“We have been running our Chithamabra Well Wisher Mathematics Challenge service in United Kingdom from June 2012.

We have conducted award ceremony 2012 and 2013, who have been selected for an award to encourage children and parents.

Every year June second week we held mathematics challenge for kids from year 1- year 6.

We are non-profitable organisation.

I e have register our Charitable company name at Company house in June 2013 as Chithamabra well wisher Network and CWN: mathematics Challenge under UK Law.

We do carry out mathematics work shop for Kids and parents at Saturday school.

In 2013 between September and December we have carried out 3 maths workshopa for parents and students

This is entirely free of charge. Those maths work shop was carried out our University students, who are voluntarily working with Chithamabra well wisher Network.

Mr.Jehan Rajendra, who was working with us and given opportunity to print exam papers 2013.

Himself and his father held all the money collected from parents £11000 last year Chithambara well wisher maths Challenge. And also those individual sending money to their relatives, those live in Sri Lanka illegal way.”

and

“1) Mr. Jehan Rajendra never conducts Children well wisher maths challenge in 2012 or 2013.

2) He worked with us form May 2013 as volunteer for Chithamabra well wisher maths challenge. Then he started Children well wisher maths challenge from 2014 to confuse parents and children's.

3) He started same as our Mathematics exam in January 2014. And also he send conflicting text messages to parents.

4) His action hurt us and all the parents deeply.

5) Our non profitable organisation run by volunteer, who selected by public meeting in every year.

6) Please see the attached copy of company house registration details for CWN: Mathematics Challenge.”

4. The applicant put the opponent to proof of use in respect of its earlier marks, however, this is not pertinent because neither earlier mark had been registered for more than five years at the date on which the applicant's mark was published.

Consequently, in accordance with section 6A of the Act, the opponent does not have to show that the marks have been used in order to rely on them.

5. Both sides represented themselves throughout the proceedings. Both sides filed evidence. Neither side requested a hearing.

The evidence

6. The evidence of both sides focuses on what is, effectively, a charitable organisation whose main aim (although according to the opponent not the exclusive aim) is to provide funds for an educational establishment in Sri Lanka called Chithambra/Chithambara College. Both the applicant and opponent have been involved with the charity. The roots of the charity appear to stem from a visit the opponent and his father made to Sri Lanka in 2012 and their desire to help the college due to the poor state of the facilities encountered there. This is why the charity was set up and why members of the Sri Lankan community in the UK, including the applicant, assisted. To raise funds, the charity operates a maths competition.

7. The opponent and the applicant both give evidence from their perspectives. The opponent's father, Swaminathamuthaly Rajendra, also gives evidence on behalf of the opponent. As well as the applicant giving evidence, evidence on his behalf is also given by Mr Sooriyalingam Ramesh, another person who has been involved with the charity and, indeed, the person who claims to have come up with the idea of running a maths challenge. From reading the detail of the evidence, there is clearly a dispute as to who controls the charity. For reasons that will become apparent, I do not consider it necessary to summarise the evidence any further.

Untenable grounds of opposition

8. Having considered the pleaded case, together with the evidence, it is clear to me that two grounds of opposition are untenable, as follows:

- Section 5(1) of the Act. For a ground under this part of the Act to succeed, it is a prerequisite that the marks be identical. The respective marks are:



CWN: Maths Challenge¹ v

Although the whole of the earlier mark is contained in the applied for mark, this does not make the marks identical. The additional device and words in the applied for mark are not things that would go unnoticed. The ground of opposition must, therefore, fail.

¹ Plus three similar marks forming its series.

- Section 5(3) of the Act. For a ground under this part of the Act to succeed, it is a prerequisite that the earlier marks relied upon have a reputation, in the sense that they are known by a significant part of the public² concerned with the claimed reputed services. Whilst the evidence provides details about the setting up of the charity and what it does, the evidence falls a long way short of demonstrating that the earlier marks are known to a significant part of the public, a public which must be taken to include members of the public from across the UK.

9. In terms of the remaining grounds of opposition, I begin with 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;

² In *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572 the Court of Justice of the European Union (“CJEU”) stated:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

(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 great 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.

The (lack of) relevance of the evidence

12. For the sake of the parties to these proceedings, who are both without legal representation, I will explain why the evidence they have filed features little in the assessments I make below under section 5(2)(b) of the Act. I firstly observe that the dispute as to who controls the charity is not relevant under section 5(2)(b). The assessment that is required is a comparison between the two trade marks at issue and the services they cover. Based on this, I must then decide, after taking into account the factors in the preceding paragraph, whether there is a likelihood of confusion. This is notional assessment based on the notional and fair use of the marks across the full range (not just limited to the exact things set out in the evidence) of the respective services. The applicant may feel that the opponent should not succeed because the opponent does not control the charity, however, the fact remains that the opponent has an earlier trade mark upon which he is entitled to rely. The applicant could have sought to invalidate the opponent's mark, but he has not done so.

13. All that being said, evidence can, on occasion, assist the decision maker in deciding whether there is a likelihood of confusion. For example, evidence could be provided showing that the earlier mark has an enhanced level of distinctiveness because of the use made of it (a factor which may increase the likelihood of confusion) or evidence could be filed to demonstrate whether services are similar or not. However, as stated earlier, the evidence does not even get close to demonstrating a reputation, so the position on enhanced distinctiveness is no better, furthermore, there is no evidence directed at the similarity of services. This does not mean that the opposition fails. The filing of evidence is not a prerequisite and many oppositions based on section 5(2)(b) are decided without it. I must make a decision based on whether I consider there to be a likelihood of confusion on the part of the average consumer.

Comparison of services

14. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

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

- “(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.”

16. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs)* (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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

17. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

18. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”³ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning⁴. I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of “dessert

³ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

⁴ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

19. Even if the terms are not worded identically, they can still be considered identical if one term falls within the ambit of another (or vice versa), as per the judgment of the General Court in *Gérard Meric v OHIM*, Case T-133/05.

20. The earlier mark covers various services in class 41. As stated earlier, the determination is not limited to the activities described in the evidence; the opponent is able to rely on all of the services for which his mark is registered, namely:

Arranging for students to participate in educational activities;Arranging for students to participate in educational courses;Arranging of award ceremonies;Arranging of award ceremonies to recognise achievement;Arranging of competitions for education or entertainment;Arranging of competitions for educational purposes;Certification of education and training awards;Charitable services, namely education and training;Competitions (organisation of-) [education or entertainment];Competitions (organising of education-);Educational examination;Educational examination services;Educational examination services (information relating to -);Educational testing;Examination services (educational -);Hosting [organising] awards;Information relating to education, provided on-line from a computer database or the internet;Organisation of competitions;Organisation of competitions (education or entertainment);Organisation of competitions for education or entertainment;Organisation of examinations [educational];Organisation of examinations to grade level of achievement;Organising competitions;Organising of competitions for education;Organising of conferences for educational purposes;Organising of education competitions;Organization of competitions;Organization of competitions [education or entertainment];Organization of education competitions;Providing tutorial sessions in the field of mathematics;Remedial tuition;Services for the organisation of competitions;Teaching;Tuition.

21. I will go through the applicant's specification term(s) by term(s) when making the comparison.

Class 41

Education – providing of training

22. The earlier mark covers various educational and training services, including: "charitable services, namely education and training", "teaching" and "tuition". The services are identical, the difference residing simply in terminology.

Entertainment

23. The earlier mark covers various forms of entertainment, including “Arranging of competitions for ... entertainment”. Such a term would fall within the ambit of the applied for term and, as such, identical services are in play. No revised specification has been provided by the applicant, however, even if one were to attempt to exclude competition based entertainment services from the specification then I consider the services still to be reasonably similar as the purpose of the services would still be similar (the end product being to entertain an audience), the method of use would still be similar (going to a venue to see the end product of watching it on TV) and the users would still be the same. It would also be likely that the same service provider would provide entertainment services both of a competitive and non-competitive form.

Sporting [activities]

24. Although the services of the earlier mark do not specifically mention sporting activities, the services cover arranging competitions in general which, notionally speaking, would cover arranging of competitions in the field of sporting activity. There is, therefore, an overlap as above with partial identity. Furthermore, as with the above term, even if the services applied for were not competition based, there would still be a reasonable degree of similarity.

Cultural activities

25. I consider there to be a fine line between certain cultural activities and entertainment. To illustrate the point, if the entertainment competition being run was to find a new singer (which could be in the field of opera) then there must be some similarity to the provision of cultural activities such as opera. The same would apply to other types of cultural activity. I consider there to be at least an average level of similarity.

Class 42

Scientific and technological services and research and design

26. I consider there to be a clear and obvious link between educational services and the applied for terms. The services go hand in hand, with the applied for services often being undertaken by educational establishments. Educational establishments will have research/development and scientific/technological wings. Research etc is important to the use of an educational establishment because it effectively forms part of the learning process, or at least builds upon that learning. The nature of the relationship is one where the consumer would believe that the responsibility for the services is the same. There are, though, some inherent differences which reduce the degree of similarity. I consider the degree of similarity to be low.

The average consumer

27. 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 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.”

28. The average consumer is a member of the general public, at least in terms of the class 41 services. The class 42 services will have a somewhat more specialised consumer. For educational services and the services in class 42, the degree of care used in the selection process will be somewhat higher than the norm given the nature of the choice involved. For the other services, the degree of care will be no higher or lower than the norm.

29. The marks will be encountered through a range of mediums such as websites, brochures, leaflets, prospectus etc which suggests that visual similarity takes on more significance. However, the marks will also be encountered aurally through word of mouth recommendations, contact by telephone etc, so aural similarity should not be ignored completely from the assessment.

Comparison of marks

30. 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.”

31. 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. The marks to be compared are:



Applicant's mark:

Opponent's mark: **Chithambara College Well-wishers Network**

32. The applicant's mark breaks down into three distinct components: i) the central logo, ii) the words at the top of the mark "CHITHAMBRA WELL WISHERS NETWORK LTD" and, iii) the words at the bottom "CWN: MATHS CHALLENGE". The central logo is more visually dominant, but the two verbal elements still make an impact to the visual impression of the mark. They are far from negligible. The verbal elements, for obvious reasons, make the only aural impact because the logo will not be articulated. Overall, I consider that whilst the logo has greater relative weight in the overall impression than the two verbal elements, the two verbal elements nevertheless play an important role in the mark. The opponent's mark has a number of words, but they are words which combine to create a single phrase. The phrase forms its overall impression.

33. Visually, the marks coincide to a degree on account of the presence of the words Chithambra Well Wishers Network at the top of the applied for mark, words (although Chithambra is spelt differently) which also appear in the opponent's mark. There are, though, some differences in the wording at the top of the mark (in comparison to the opponent's mark) due to the addition of the word LTD, the absence of the word College, the absence of a hyphen between the words WELL and WISHERS and the different spelling of Chithambra/Chithambara. However, whilst these differences do exist, there are other differences between the marks as a whole which are starker, particularly the addition of the central logo, but also the addition of the wording at the bottom of the applied for mark. I consider that the marks are visually similar to only a low degree.

34. Aurally, there is greater similarity due to the fact that the central logo in the applied for mark will not be articulated. Although the central logo contains some script, it is not clear what language this is (it may be Tamil, as this appears to be a language used by the protagonists) and whether the UK average consumer will know of it. If it is Tamil then the knowledge of such a language will be very low amongst the UK average consumer. In any event, the script in the central logo does not stand out and may not be articulated even if it was possible to decipher it. There are still some aural differences (due to the differences already identified in the preceding paragraph), however, I consider the marks to be aurally similar to a reasonable degree.

35. The concept of the earlier mark is based upon a network or group of well wishers who are supporting Chithambara College. In terms of the applied for mark, due to the multiple components of it, there could be multiple concepts. However, despite being the component that plays the greatest relative weight in the overall impression, the central logo has in my view the least clear conceptual message. Greater (and clearer) concepts come from the two verbal elements. One (CWN: Maths Challenge) is absent in the applied for mark so creates a conceptual difference. However, the other indicates a company in the form of a network or group of well wishers who are supporting Chithambra; the different spelling of Chithambra/Chithambara is not significant as it will be seen as a variant spelling. Although the concept of Chithambra/Chithambara being a college is absent, there is still in my view a very high degree of conceptual similarity between this component of the applied for mark and the earlier mark, with the consequence that there is a reasonable degree of conceptual similarity overall.

Distinctiveness character of the earlier marks

36. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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. The UK average consumer will see Chithambara as a very unusual word. Although the rest of the words in the mark are not as distinctive, I consider the mark as a whole to have a reasonably high level of inherent distinctive character. As discussed earlier, there is no enhancement of distinctive character through use.

Likelihood of confusion

38. 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.

39. For a likelihood of confusion to arise the marks do not need to be directly confused with one another. Confusion can be “indirect” in the sense that some similarity between them leads the average consumer to believe that the respective services are the responsibility of the same or economically linked undertaking. I accept that if a likelihood of confusion is to arise in this case then it will be on the basis of indirect as opposed to direct confusion. The central logo in the applied for marks (and the additional wording below) puts pay to the prospect of direct confusion. The question is, therefore, whether there is a likelihood of indirect confusion.

40. In relation to the identical educational services at issue, I have little hesitation in concluding that there is a likelihood of confusion. The average consumer will recall the shared concept (and the visual and aural similarity shared in this designation) of a network of well wishers relating to Chithambra/Chithambara College. That the college designation is missing does not matter as this is something that could be lost due to imperfect recollection (as would the variant spelling of Chithambra) or else the similarity still put down to a same stable provider. The earlier mark is reasonably high in distinctiveness so meaning that this similarity will be put down to a shared economic connection. The commonality between the marks will not be put down to coincidence. I extend this finding to the other services I held to be identical or reasonably similar.

41. In relation to the services in class 42 (which I found to be low in similarity to the earlier mark’s services) and the cultural services in class 41 (where I found an average level of similarity to the services of the earlier mark) I still consider a likelihood of confusion to arise. The distinctiveness of the common elements is such, that even for services which are more distant, the average consumer will believe the same or related undertaking is responsible for them.

42. The opposition succeeds under section 5(2)(b) in relation to all of the applied for services.

Other grounds

43. Given that the opponent has succeeded already, and for reasons of procedural economy, I do not consider it necessary to explore the other grounds of opposition. I should add, though, that should the parties become involved in further disputes concerning the control of the charity, I would strongly recommend the use of mediation as an attempt to resolve the conflict that has arisen. If some form of amicable resolution can be found then this will save the parties time and money, the

latter being particularly important given that both parties purport to be making their claims on behalf of a charity.

Costs

44. The opponent has succeeded and is entitled to a contribution towards his costs. I bear in mind, though, that he was not legally represented so did not incur any legal fees. My assessment is as follows:

Official Fee - £200

Preparing a statement and considering the other side's statement - £150

Filing and considering evidence - £300

45. I therefore order Thavarajasingam Uthayanan to pay Jehan Rahendra the sum of £650. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of May 2015

**Oliver Morris
For the Registrar,
The Comptroller-General**