

O-198-18

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO 3238121
BY ENGLISH LANGUAGE ITUTORING LIMITED TO REGISTER:

 **Class View**

AND

THE OPPOSITION THERETO UNDER NO 600000697
BY AVANTIS SYSTEMS LIMITED

BACKGROUND

1. On 19 June 2017, English Language Itutoring Limited (the applicant) applied to register the above trade mark in the following classes:¹

Class 9

Artificial intelligence programme; computer software for online provision of language teaching; computer software for online provision of language assessment; computer software used for language education.

Class 41

Development of education materials; Distance learning services provided online; Education services relating to languages; Education services relating to the teaching of foreign languages; Language teaching services; Providing computer delivered education testing and assessments; Second language educational services; Research in field of language education; Research in the field of language learning.

2. The application was published on 30 June 2017, following which Avantis Systems Limited (the opponent) filed a notice of opposition against all of the goods and services in the application.

3. The opponent bases its case on section 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (the Act). It relies upon UK trade mark 2646462, for the following series of two marks:

Mark details and relevant dates	Services relied upon
ClassView and Class View	Class 9 Software; downloadable software Class 42 Design, maintenance, development, installation, repair and updating of computer software; rental of computer software; hire of computer software; providing computer software that may be downloaded from a global computer network; leasing of computer software; providing temporary use of non-downloadable computer

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

<p>Filed: 21 December 2012 Registered: 12 April 2013</p>	<p>software; providing temporary use of non-downloadable computer software for use in relation to teaching, training and education; support services for computer software; providing temporary use of non-downloadable computer software namely a web based application; advisory, consultancy and information relating to the above.</p>
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4. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an ‘earlier trade mark’ means -

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

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

5. The opponent's series of marks constitute earlier trade marks which are not subject to proof of use. This is because, at the date of publication of the application, they had not been registered for five years.² Consequently, the opponent is entitled to rely on its full specification for the marks relied on.

6. The opponent submits that the parties' marks are identical or highly similar and that the goods in class 9 are identical, the applicant's specification being included within the opponent's goods. With regard to the applicant's services in class 41, the opponent concludes that software is commonly used in teaching, educational and research services which results in a 'clear link or association' between the opponent's goods and services and the applicants services in class 41.

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

7. The applicant filed a counterstatement in which it denied the grounds raised by the opponent.

8. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

9. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

10. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

11. A hearing was neither requested nor considered necessary. The opponent filed written submissions which I will refer to as necessary, below.

Preliminary issues

12. A number of the points raised in the applicant’s counterstatement are arguments which are often put before this Tribunal. However, they have no bearing on the outcome of this decision. Before I continue with the merits of the opposition it is necessary to explain why this is so.

13. At section 7 of its counter statement the applicant answered “YES” when asked if it required the opponent to provide proof of use and provided the following explanation:

“Class 9: Software and downloadable software as these terms are so broad the opponent is asked to provide evidence of how it uses its mark so a proper analysis can be made as to the similarity of the goods and any likelihood of confusion.”

14. Up until the point at which a trade mark has been registered for five years (when the proof of use requirements set out in s.6A of the Act take effect), it is entitled to protection in relation to all the goods/services for which it is registered. Consequently, the opponent’s earlier UK mark must be considered in relation to all the goods and services for which it is registered in classes 9 and 42, without the opponent needing to prove any use of its mark in relation to those goods and services. The opponent’s earlier mark is therefore entitled to protection against a likelihood of confusion with the applicant’s mark based on the ‘notional’ use of the earlier mark for all the goods and services for which it is registered. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd*³ as follows:

"22. ...It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

15. At paragraph 2.4 of its counterstatement, the applicant submits:

³ [2004] RPC 41

“2.4 the Applicant's goods and services (the provision of online language learning for individual students) are very different to those of the Opponent (the provision of hardware and/or software designed specifically for use within a school), and in particular will be promoted in different markets, sold in different distribution channels, made available under different purchase models and used by different consumers (in the case of the Applicant predominantly individual language learners, in the case of the Opponent schools and institutions).”

16. So far as the applicant's proposed use of its mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*,⁴ the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.

17. Furthermore, in *Devinlec Développement Innovation Leclerc SA v OHIM*,⁵ CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

18. In other words, the way in which the applicant is actually using its trade mark at this point is not a factor which is relevant to the decision. Rather I must consider all normal and fair uses of the applicant's mark. The same applies to the opponent's earlier mark.

19. The opponent's registration consists of a series of two marks which differ only in the space between the words 'Class' and 'View'. Throughout the rest of this decision I will refer to the opponent's mark as 'Class View', by which I mean to refer to both versions of the

⁴ Case C-533/06

⁵ Case C-171/06P

mark, the differences between them have no material impact on the determinations I am required to make.

DECISION

Opposition under sections 5(1) and 5(2)(a)

20. Section 5(1) of the Act read as follows:

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

21. Section 5(2)(a) of the Act reads as follows:

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

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

22. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*,⁶ the Court of Justice of the European Union (CJEU) held that:

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

23. Both parties' marks contain the words 'Class View'. The words in the applicant's mark are preceded by a pink cross and are underlined with a pink line which runs the length of the two words. These additional elements are not present in the opponent's mark but are not fatal to the opponent's claim under this section of the Act, providing the additional

⁶ *Case C-291/00*

elements (which account for the difference between the respective marks) are so insignificant that they may go unnoticed by the average consumer.

24. Whilst the pink cross and the pink line under the words 'Class View' are not highly distinctive elements of the application, I do not find that they are so insignificant as to go unnoticed by the average consumer. The pink cross appears at the beginning of the mark, before the words and is unlikely to be ignored in the mark as a whole.

25. The opposition under sections 5(1) and 5(2)(a) fails.

The opposition under section 5(2)(b)

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

“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,

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

Section 5(2)(b) case law

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

(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 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing act

28. In accordance with the above cited case law, I must determine who the average consumer is for the goods and services at issue and also identify the manner in which those goods and services will be selected in the course of trade.

29. 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*⁷, 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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

30. As I have outlined above, I must consider the full range of goods and services contained within the parties’ respective specifications. I must then consider who the average consumer for those goods and services will be.

⁷ [2014] EWHC 439 (Ch)

31. The parties' specifications include a range of goods and services for which the average consumer may be a member of the public or a business/professional user. The selection process is likely to be primarily visual, being made from a store, website or brochure, though I do not discount the fact that there may be an aural element, particularly given that some of these goods and services may be purchased as a result of recommendations.

32. With regard to the level of attention that will be paid to the purchase, a piece of software bought by a member of the general public will be less expensive, more frequent and require a lower level of attention to be paid than the commissioning of software design and development for a business, which will be infrequent, more expensive and is likely to involve a far longer purchasing process.

33. That said, the level of attention paid during the selection of all of the respective goods and services will be at least 'average' as the average consumer, whether an individual or a commercial undertaking, will need to take note of, inter alia, the type of product or service, the cost, its capabilities, and so on.

Comparison of goods and services

34. The parties' goods and services to be compared are as follows:

Opponent's goods and services	Applicant's goods and services
<p>Class 9 Software; downloadable software.</p>	<p>Class 9 Artificial intelligence programme; computer software for online provision of language teaching; computer software for online provision of language assessment; computer software used for language education.</p>
	<p>Class 41 Development of education materials; Distance learning services provided online ;Education services relating to languages; Education</p>

	<p>services relating to the teaching of foreign languages; Language teaching services; Providing computer delivered education testing and assessments; Second language educational services; Research in field of language education; Research in the field of language learning.</p>
<p>Class 42 Design, maintenance, development, installation, repair and updating of computer software; rental of computer software; hire of computer software; providing computer software that may be downloaded from a global computer network; leasing of computer software; providing temporary use of non-downloadable computer software; providing temporary use of non-downloadable computer software for use in relation to teaching, training and education; support services for computer software; providing temporary use of non-downloadable computer software namely a web based application; advisory, consultancy and information relating to the above.</p>	

35. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the 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”.

36. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case,⁸ for assessing similarity were:

- (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.

37. In *Gérard Meric v Office for Harmonisation in the Internal Market*,⁹ the General Court ('GC') stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

⁸ [1996] R.P.C. 281

⁹ Case T- 133/05

38. I also remind myself of the guidance given by the courts on the correct approach to the interpretation of specifications. In *YouView TV Ltd v Total Ltd*,¹⁰ Floyd J. (as he then was) stated that:

“[...] 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) (IP TRANSLATOR)* [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 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”.

39. In *Avnet Incorporated v Isoact Limited*,¹¹ Jacob J. (as he then was) warned against construing specifications for services too widely, stating that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase”.

40. With regard to the complementary nature of the goods and services, in *Kurt Hesse v OHIM*,¹² the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods and services. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*,¹³ the GC stated that “complementary” means:

¹⁰ [2012] EWHC 3158 (Ch)

¹¹ [1998] F.S.R. 16

¹² Case C-50/15 P

¹³ Case T-325/06

“...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”.

41. In *Sanco SA v OHIM*,¹⁴ the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, e.g. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*:¹⁵

“18. [...] It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

42. Whilst on the other hand:

“19. [...] 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”.

43. In the same case, Mr Alexander also warned against applying too rigid a test when considering complementarity:

“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

¹⁴ *Case T-249/11*

¹⁵ *BL O/255/13*

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*".

44. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons.¹⁶

The applicant's goods in class 9

45. Software is, in essence, the programs and operating information used by computers and related devices. Therefore, the programs and software included in class 9 of the applicant's specification are included within the broader term, 'software' in class 9 of the opponent's specification. I find these goods to be identical in accordance with *Meric*.

The applicant's services in class 41

46. In its written submissions dated 19 September 2018, the opponent submits:

"5...As far as the [Applicant's] class 41 services are concerned it is important to note that notional use must be taken into consideration. Software and downloadable software is used in relation to education services. In fact that is exactly what the opponent uses its software for. Furthermore the Opponent's class 42 specification clearly covers 'providing temporary use of non-downloadable software for use in relation to teaching training and education'.

In light of the above, there is a clear similarity between the Opponent's class 9 and class 42 goods and services and the class 41 services of the Applicant."

¹⁶ See *Separode Trade Mark BL O/399/10 and BVBA Management, Training en Consultancy v. Benelux-Merkenbureau [2007] ETMR 35 at paragraphs [30] to [38]*.

The applicant's services in class 41 compared to the opponent's goods in class 9

47. In making this comparison, I bear in mind the decision in *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*¹⁷ which concerned a comparison between computer software and software services in classes 9 and 42, respectively, and a range of information, travel and reservation services in classes 39 and 42. The GC upheld the finding of no similarity, including no complementarity, between the goods and services. It stated in its judgment:

“54. The mere fact that the information, booking and reservation services covered by the trade mark at issue are exclusively provided via the internet and therefore require software support such as that provided by the goods and services covered by the earlier trade mark does not suffice to remove the essential differences between the goods and services concerned in terms of their nature, their intended purpose and their method of use.

55. Computer goods and computer services are used in nearly all sectors. Often, the same goods or services – for example, a certain type of software or operating system – may be used for very different purposes, and that does not mean that they become different or distinct goods or services. Conversely, travel agency services do not become something else – in terms of their nature, intended purpose or method of use – solely because they are provided via the internet, particularly since, nowadays, use of computer applications for the provision of such services is almost essential, even where those services are not provided by an internet shop.

[...]

60 [...] The commercial origin of the software and the computer services which enable the intervener's website to function is not generally of the slightest interest to the public for which the services covered by the mark at issue, which are supplied via that website, are intended. For that public, the intervener's website

¹⁷ Case T-316/07

is a mere tool for the online reservation of travel and accommodation. What is of importance is that it functions well and not who provided the software and computer services which enable it to function.

61. If, however, some of the intervener's customers wonder about the commercial origin of the software and the software development and design services which are necessary for the functioning of the intervener's website, they are capable, as was correctly pointed out by the Board of Appeal, of making a distinction between the specialised undertaking which supplies those goods and services and the intervener which supplies services relating to the tourism and travel sector over the internet. Since the services covered by the mark at issue are, by definition, supplied exclusively over the internet, it must be assumed that the intervener's customers have at least some basic knowledge of computing. They are thus aware that an online reservation system cannot be set up by merely any computer user and that it requires software and software development and design services which are provided by a specialised undertaking.

62. The applicant's claim that the intervener's customers cannot distinguish information which comes from the intervener itself from that which derives from software and computer services of the kind covered by the earlier mark is likewise incorrect. The information likely to be of interest to the intervener's customers is that relating to travel arrangements, the availability of hotel accommodation and their prices. The provision of that information is precisely what constitutes the services covered by the mark at issue. The goods and services covered by the earlier mark serve only to convey that information and do not themselves transmit other separate information to the persons concerned".

48. In this case, the opponent has offered a false correlation based on the premise that its software in class 9 is ubiquitous in nearly all sectors of the market. Its software cannot be held to be similar to education services simply because both involve software at some level. I note that the opponent claims that its own software is actually for education which results in a finding of similarity. This submission is flawed. The opponent has highlighted the fact that this assessment must be made on the basis of notional use. That is the correct approach with regard to both parties' trade marks, meaning that I must consider the opponent's

specification as registered for software at large and not for the narrower term software for education. In the absence of any submissions from the opponent on this point, and having considered the nature of the goods and services, their intended purpose, their method of use and whether they are in competition with each other or are complementary, I can find no meaningful areas in which any of the opponent's goods in class 9 coincide with the applicant's services in class 41. The core meaning of these goods and services is different and I find these goods and services to be dissimilar.

The applicant's class 41 services compared to the opponent's class 42 services

49. In considering the applicant's class 41 services and the opponent's class 42 services I must, in accordance with the guidance in *Avnet*, look at the core meaning of the parties' services.

50. The applicant's services divide into three main areas, namely development of education materials, provision of teaching and education (particularly in the field of language education), including computer delivered education testing and assessments; and research services in respect of language learning and education.

51. The opponent's services are primarily for the design, maintenance, development, installation, repair, updating and provision of computer software. Within its broad specification the opponent's specification includes, 'providing temporary use of non-downloadable computer software for use in relation to teaching, training and education'. The users of these services are likely to be teachers, trainers and educators as well as students and trainees. The purpose of the software is to teach, train and educate and its nature is non-downloadable software.

52. The applicant's 'distance learning services provided online' and 'providing computer delivered education testing and assessments' have the same users and uses and are delivered online, requiring software in order to operate. In my view, it is not uncommon for online training providers to use their own proprietary software and I find there is likely to be some overlap in the trade channels. These services are complementary to the opponent's in the sense that educational software of the type provided by the opponent is essential for the applicant to offer its online education and examination and it is possible that the software

is provided by the provider of the training/teaching. I find these services to have a moderate degree of similarity.

53. The applicant's specification also includes a number of broader educational services. These are, 'education services relating to languages', 'education services relating to the teaching of foreign languages', 'language teaching services' and 'second language educational services'. The users and uses of these services are students and trainees of language. The nature of the services, though not limited to online provision may include it. For example, streamed lectures, web-chat seminars and tutorials, online module delivery and electronic submission but these services may also include correspondence courses or face to face teaching. The users and uses are similar, the nature of the services may be identical or entirely different and there may be a degree of overlap in the trade channels for these services. There is also a degree of complementarity to the extent that some of the educational services provided by the applicant will require the kind of educational software provided by the opponent. Taking all of these factors into account I find these services to be similar to a low degree to the opponent's, 'providing temporary use of non-downloadable computer software for use in relation to teaching, training and education'.

54. The application also includes, 'development of education materials'. To the extent that this term includes the development of the type of educational software provided by the opponent, there is a degree of similarity with the opponent's service, 'providing temporary use of non-downloadable computer software for use in relation to teaching, training and education', but I would put this at a very low level.

55. The applicant's services for 'research in field of language education' and 'research in the field of language learning', are first and foremost, research services. The users, uses and trade channels for these services are different from any terms in the opponent's specification. They are not complementary nor in competition. Taking all of these factors into account I find the services to be dissimilar.

56. Where there is no similarity between the parties' goods and services, there can be no likelihood of confusion¹⁸. In *eSure Insurance v Direct Line Insurance*,¹⁹ Lady Justice Arden stated that:

“49...I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

57. Consequently, there can be no likelihood of confusion in respect of 'research in field of language education' and 'research in the field of language learning' in class 41 of the application and the opposition fails in respect of these services.

Comparison of marks

58. The marks to be compared are as follows:

Opponent	Applicant
<p style="text-align: center;">Class View and ClassView</p>	<p style="text-align: center;">+ <u>Class View</u></p>

59. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by

¹⁸ *Waterford Wedgwood plc v OHIM – C-398/07 P (CJEU)*

¹⁹ [2008] ETMR 77 CA

them, bearing in mind their distinctive and dominant components²⁰, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

60. The opponent submits that the words in both parties' marks are identical, the only differences between them being the red line underneath and the red cross next to the words 'Class View' in the application.

61. The applicant submits:

"2. Whilst the respective marks and goods and services may be similar the Applicant denies that there is any likelihood of confusion on the following grounds:

2.1 the marks contain significant visual and conceptual differences such that the overall similarity of the marks is low and not sufficient to cause confusion amongst consumers;

2.2 the Applicant's mark contains dominant stylised components that serve to make its mark distinctive and reduces the overall visual similarity with the Opponent's mark. This is also important in the context of how the Applicant uses its mark to distinguish its services which are provided from an online platform (where visual distinctiveness, not aural use, is the most important element of its mark)."

62. The opponent's mark comprises the words, 'Class' and 'View'. In the first mark of the series the two words are separated by a space and in the second they are joined. The space, or lack of it, between the two words makes no material difference to the overall impression of the marks. The capitalised initial letters of each word and the fact that both words are common English words which will be well known to the average consumer means that both will be seen as 'Class View'. The overall impression of both marks in the series rest in the marks as wholes.

²⁰ *Sabel v Puma AG*, para.23

63. The applicant's mark comprises the words 'Class' and 'View', presented in standard black text with the first letter of each word capitalised. Below the word is a pink line which extends the length of the two words. Before the words is a pink cross, which is very simple in design, being no different to a standard keyboard character. Neither the cross before the words nor the line below them will be ignored by the average consumer but these are not highly distinctive and dominant elements either, within the mark as a whole. The words, 'Class View' play the greater role in the overall impression of the mark.

Visual similarity

64. Visual similarity rests in the fact that both parties' marks contain the words 'Class View'. Neither contains any additional words.

65. The only differences are the pink cross at the beginning of the application and the pink line underneath the words, 'Class View'.

66. I note that the applicant has referred to 'significant visual differences' and 'dominant stylised components' in its mark which reduce the visual similarity. I disagree. I accept that the cross and the line will be noticed within the totality of the mark, but these elements fall a long way short of amounting to significant visual differences. I find these marks in their totalities to be visually similar to a high degree.

Aural similarity

67. Both parties' marks consist of the words, 'Class View'. These are common English words which the average consumer will know how to pronounce. The pink cross before the words and the line underneath 'Class View' in the application will not be articulated. The parties' marks are aurally identical.

Conceptual similarity

68. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.²¹ The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.²²

69. The applicant suggests that the words 'Class View' (in the opponent's marks) will be seen as '*software that presents teachers with a view of what their class are working on (ClassView) or to share with the class a view (ClassView) of what any individual student may be working on*'. I disagree. The majority of the opponent's specification does not relate to education. Its class 9 specification is for 'software' and 'downloadable software' at large and only one term in its class 42 specification relates specifically to education.

70. 'Class' may well be seen as relating to a class of students, but may also be seen as meaning 'excellent' or 'first-rate' or an indicator of economic status. In combination with the word, 'View', the marks overall are somewhat nebulous. They could be seen to mean, 'excellent view' or the view of a particular class of person, or the views held by a class of students or pupils, or, as the applicant suggests, a physical view of a classroom. However, whatever the conceptual impression conveyed by the parties' marks it will be the same in both cases. The line underneath the words and the pink cross before the words, 'Class View', in the application do not give any conceptual message to the average consumer and, to the extent that they are noticed, will be seen as decorative elements. Taking these factors into account, I find the competing marks to be conceptually identical.

Distinctive character of the earlier marks

71. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and

²¹ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

²² See the comments of Anna Carboni, sitting as the Appointed Person in *Chorkee*, BL O/048/08, paragraphs 36 and 37.

services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.²³

72. The applicant submits that:

“...the Opponent's mark is devoid of distinctive character, describing hardware and/or software that presents teachers with a *view* of what their *class* are working on (ClassView) or to share with the *class* a *view* (ClassView) of what any individual student may be working on”.

73. No claim has been made with regard to enhanced distinctive character so I have only the inherent distinctiveness of the earlier marks to consider. The words, ‘Class’ and ‘View’ have clear meanings but put together, they do not create a clear and obvious meaning which describes any of the opponent’s goods and services. The earlier mark is also not allusive for the vast majority of the opponent’s specification which does not relate to education. It is possible that the words ‘Class’ and ‘View’ combine to form a term which may allude to a physical view of a classroom and to that extent, for the term ‘providing temporary use of non-downloadable computer software for use in relation to teaching, training and education’ the inherent distinctive character of the opponent’s earlier mark is a little lower than average.

74. I find that the opponent’s marks are normal trade marks possessed of a medium degree of inherent distinctive character for all of the goods and services, other than ‘providing temporary use of non-downloadable computer software for use in relation to teaching, training and education’, for which its inherent distinctiveness is a little lower than average.

Likelihood of confusion

75. The factors assessed so far have a degree of interdependency²⁴ and a global assessment of them must be made when determining whether a likelihood of confusion exists.²⁵ 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.

²³ *Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.*

²⁴ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc., C-39/97, paragraph 17*

²⁵ *Sabel BV v. Puma AG, C-251/95, paragraph 22*

76. I have made the following findings:

- The average consumer is a member of the general public, business or professional user.
- The level of attention paid to the purchase will vary. That said, the goods and services will require at least an average degree of attention to be paid.
- The purchase will be primarily a visual one, though I do not discount an aural element.
- The respective marks possess a high degree of visual similarity, are aurally and conceptually identical.
- The earlier mark 'Class View' has a medium degree of inherent distinctive character, other than for 'providing temporary use of non-downloadable computer software for use in relation to teaching, training and education', for which it is slightly lower than average.

77. In respect of the remaining goods and services where there is any degree of similarity, taking all of these factors into account, the similarity of the marks is such that in the context of identical or similar goods and services (even those similar to a very low degree) there will, in my view, be direct confusion (where one mark is mistaken for the other). In reaching this conclusion I have taken account of the fact that the opponent's mark is a little lower than averagely distinctive for those services which I have found to be similar to those of the applicant in class 41. However, the similarity between the respective marks is such that when considering all of the relevant factors, this is not sufficient to alter my finding that there is a likelihood of direct confusion.

78. Even if I am wrong in this, the similarity between the parties' marks is such that there will be indirect confusion (where the average consumer believes the respective goods originate from the same or a linked undertaking). This is because the additional line and cross in the application do not provide any message which alters the average consumer's

perception of the mark. Whichever mark they encounter first, the other will simply be seen as a minor variation of it, emanating from the same undertaking.

CONCLUSION

79. The opposition succeeds under section 5(2)(b) of the Act for all of the goods and services in the application except 'research in field of language education' and 'research in the field of language learning' in class 41, as these services are not similar to any goods and services contained in the opponent's specification. Subject to any successful appeal, the application will be refused for those goods and services and may proceed to registration for the following:

Class 41

Research in field of language education; research in the field of language learning.

COSTS

80. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice (TPN) 2 of 2015. Using that TPN as I guide, I award costs to the opponent on the following basis, reduced to reflect the services for which it was unsuccessful:

Preparing a statement and considering the other side's statement:	£200
Preparing and filing submissions:	£100
Official fee	£100
Total	£400

81. I order English Language Itutoring Limited to pay Avantis Systems Limited the sum of £400. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 28th day of March 2018

Ms Al Skilton
For the Registrar,
The Comptroller-General