

O/648/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3371030: **HEADSTREAM**  
BY LEARNING POOL LIMITED FOR GOODS AND SERVICES IN CLASSES 09, 41  
AND 42

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO 600001137 BY  
CORPORATE LEARNING ALLIANCE LTD

## Background and pleadings

1. Learning Pool Ltd (the applicant) applied to register the trade mark No 3 371 030 HEADSTREAM in the UK on 29<sup>th</sup> January 2019. It was accepted and published in the Trade Marks Journal on 5<sup>th</sup> April 2019 in respect of the following goods and services:

Class 09:

*Computer software for education; computer software namely, learning management and learning experience systems; computer software that provides access to online courses or education; computer software that provides access to courses or education through information networks; computer software that provides access to online teaching, training, learning and assessment resources; downloadable elearning catalogues; electronic publications and publications in electronic form; downloadable electronic publications; downloadable digital media and multimedia; downloadable video and audio recordings; webcasts; podcasts; vodcasts; podscrolls; downloadable digital media and recordings containing teaching apparatus and instruments; downloadable computer applications (apps) for use in education, learning, assessment, teaching and training; computer software for designing, creating and editing online learning content; computer software providing user interaction services including search capability and chatbot paradigms; computer software for the storage and management of software user records relating to learning and education.*

Class 41:

*Education services; e-learning; providing education, teaching, training, and assessment via learning management and learning experience systems; providing teaching, training and assessment; providing online teaching, training and assessments; publishing teaching, training, learning and assessment material; production of digital documents, video, audio and*

*multimedia entertainment training and education; non-downloadable electronic publications; non-downloadable elearning catalogues; information advice and consultancy relating to all the aforesaid.*

Class 42:

*Software as a service for education; software as a service, namely, learning management and learning experience systems; non-downloadable digital media and multimedia; non-downloadable video and audio recordings; non-downloadable digital media and recordings containing teaching apparatus and instruments; programming of educational, teaching, learning, training and assessment software; design and development of educational, teaching, learning, training and assessment software; non-downloadable software for providing access to online courses, education; information advice and consultancy relating to all the aforesaid.*

2. Corporate Learning Alliance Ltd (the opponent) opposes the trade mark using the Fast Track procedure on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK Trade Mark No 3 332 883 HEADSPRING. The following goods and services are relied upon in this opposition:

Class 09:

*Software applications delivered online through a web-browser; software applications delivered as a downloadable application; software applications delivered to any computing device including desktop, laptop, wearable computer peripheral, tablet computer and/or mobile device; computer software for teaching, instructional and educational purposes; teaching apparatus and/or instruments; instructional apparatus and/or instruments; downloadable MP3 files; recorded content; digital media; electronic publications; downloadable electronic publications; downloadable electronic publications in the nature of newspapers, magazines, periodicals, leaflets, catalogues, newsletters, directories and books; articles, columns or*

*written/published articles contained and/or supplied in or by electronic media; published material in digital format; e-books; downloadable ebooks; publications in electronic form, supplied on-line from databases or from facilities provided on the Internet; electronic publications delivered online as a downloadable application or application delivered to any computing device including desktop, laptop, wearable computer peripheral, tablet computer and/or mobile device; optical, electronic and magnetic data storage devices bearing recorded information; DVDs; CDs; hard disks; pre-recorded audio and/or video cassettes; compact discs; floppy discs; podcasts; vodcasts; blogs; electronic databases; information stored in electronic, digital and/or magnetic form; educational apparatus and/or instruments; electronic devices for providing access to the Internet or viewing information on global computer networks; speech recognition equipment for use in education; computer software for the collection and the distribution of visual images, data, video, audio material, audio visual material and information; computer software for processing images, graphics, audio, video, and/or text; computer software for transmission and display of digital content, audio works, visual works, audiovisual works, electronic publications, books, movies, and music; computer software for browsing and accessing digital content, audio works, visual works, audiovisual works, electronic publications, books, movies and/or music; computer software for collecting, editing, modifying, organizing, synchronizing, integrating, monitoring, transmitting, storage and sharing of data and/or information; computer software; computer software for cloud computing; computer software for use in cloud infrastructure management; computer software for running cloud computing based applications; computer software development tools; interfaces for digital content management of wired and wireless electronic devices for accessing, storing, transmitting, and/or sharing of data, information, text, images, audio, video, and/or multimedia content.*

Class 16:

*Printed matter; printed publications; books; newspapers, periodicals, journals, textbooks, catalogues, magazines, leaflets, newsletters, posters, charts,*

*directories and calendars; articles, columns and written/published articles contained and/or supplied in or by print media; instructional and teaching materials; paper and cardboard; educational course certificates; educational or training award certificates; diplomas; course notes; study guides; pamphlets; journals; newsletters; prospectuses; catalogues; handbooks; stationery; pictures; note books; note pads; forms; calendars; writing instruments; pens; pencils; pencil cases; pencil sharpeners; erasers; rulers; writing materials; book marks; pennants; badges made of paper and cardboard; maps; address books; prints; posters; wall charts; postcards; labels; adhesive stickers; greeting cards, diaries; photographs; graphic prints.*

Class 35:

*Business advisory services; business assistance; business appraisals; business information; marketing and promotional services; business development services; arranging and conducting business conferences and events, commercial exhibitions and trade show exhibitions; business introductory and meetings services and business networking services; provision and dissemination of information relating to business introductory services and business networking services; consultancy, advisory and information services for all the above services.*

Class 41:

*Education services; training services; examination services; design and provision of educational and training programmes; design and provision of courses and examinations; providing education accreditation; certification of education training and awards; education services relating to business and/or business services; planning, arranging and conducting educational events; provision of training; conducting correspondence courses; providing training and/or education events; providing exhibitions, conferences, seminars, workshops and networking events; teaching, research, instruction and education by means of a computer database; providing access to video and audio materials for education; providing feedback for teachers on pupils'*

*progress; training of teachers; computer assisted teaching services; online education for the assessment and improvement of student learning or teacher training; provision of distance learning for adult education; publishing services; publishing of electronic publications; electronic publishing services; provision of online-electronic publications; publishing services provided by means of the Internet and world-wide web; provision of teaching materials online; distribution of printed or electronic materials relating to education; development and dissemination of teaching material; provision of digital handbooks, instructional handbooks, and educational materials in the field of education; organization of competitions, awards, quizzes, games and recreational activities; organizing and arranging of cultural and entertainment events; production, presentation, provision and distribution of films, blogs, webinars, podcasts, vodcasts and news feeds; consultancy, advisory and information services relating to the above services.*

Class 42:

*Application hosting services for digital networks; platform as a service (PAAS); software as a service (SAAS); software as a service for use in providing education services; providing non-downloadable software applications; provision of temporary use of non-downloadable computer software for use in the creation and publication of online education materials; providing temporary use of on-line non-downloadable software for publishing and sharing digital media and information via global computer and communication networks online; hosting of digital content on the internet; application service provider featuring application programming interface (API) software for accessing and searching for content and data in electronic publications and on online databases; application hosting; software development in the field of mobile applications; application service provider, namely, hosting, managing, developing, and maintaining applications, software, and web sites; cloud computing services; leasing, hire and rental of computer hardware, computer software and computer programmes; electronic data storage; creating, managing, developing, designing, maintaining and/or hosting of websites; installation, maintenance, upgrading and repair of*

*computer software; designing, managing and monitoring online forums for discussion; online services, namely, providing secure online data storage; providing temporary use of on-line non-downloadable cloud computing software for use in electronic storage of data; cloud hosting of electronic databases; advisory, information, management, consultancy and technical support relating to all the above services.*

3. The opponent argues that the respective goods and services are identical or similar and that the marks are similar.
4. The applicant filed a counterstatement denying the claims made.
5. Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

## **DECISION**

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

6. Section 5(2)(b) of the Act is as follows:

“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”.

## Comparison of goods and services

7. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut 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. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

9. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, 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.

10. In its written submissions, the applicant accepts that the majority of its applied-for specification is identical or similar to those goods and services contained within the earlier trade mark. As such, I do not consider it necessary to conduct a comparison of the goods and services to which this admission applies. The goods and services to which this admission does not apply (and so which need to be assessed) are as follows:

Class 09:

*Webcasts; computer software providing user interaction services including search capability and chatbot paradigms.*

Class 42:

*Programming of educational, teaching, learning, training and assessment software; design and development of educational, teaching, learning, training and assessment software; information advice and consultancy relating to all the aforesaid.*

#### Comparison of goods in Class 09:

11. The earlier specification includes computer software at large: *software applications delivered to any computing device including desktop, laptop, wearable computer peripheral, tablet computer and/or mobile device*. Nothing turns on the method of delivery. The later term *computer software providing user interaction services including search capability and chatbot paradigms* is a particular type of software for a particular purpose. However, I cannot see how this is precluded from inclusion within the earlier term which is software applications at large and clearly broader. According to the terms set out in *Meric*, the goods are considered to be identical.
  
12. The applicant claims that webcasts are different from the earlier term podcasts. I understand that webcasts refer to a particular event (perhaps even a one-off event), broadcast live over the internet, whereas podcasts are episodic in nature and are available to download. However, programmes which are normally episodic in nature can also, on occasion, be delivered via special one-off live events, for example, soap operas and nature programmes. Further the goods can clearly coincide in purpose, which is allowing people to view particular content (for entertainment or for educational purposes), whether live or at a time of one's own choosing. I see no reason (dependent upon particular subject matter) why they would also not coincide in respect of the end user (the public at large). Further, as already touched on above, I see no reason why the same provider could not produce content both live and also episodic nature. These goods are similar, to a medium to a high degree.

#### Comparison of services in Class 42:

13. The contested services are in respect of the programming, design and development of software, specifically in respect of education. The earlier goods are: *computer software for teaching, instructional and educational purposes*. These goods and services are likely to coincide in terms of

producer and end user. Further, software is an end product which is the result of the programming, design and development process. There is clearly therefore a complementary relationship here<sup>1</sup>. They are considered similar, to a medium degree.

## Comparison of marks

14. 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 Court of Justice of the European Union 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.”

15. It would be wrong, therefore, to dissect the trade marks artificially, 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.

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<sup>1</sup> See: *Kurt Hesse v OHIM*, Case C-50/15 P; *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06.

16. The respective trade marks are shown below:

HEADSPRING	HEADSTREAM
Earlier trade mark	Contested trade mark

17. Each of the trade marks are word only with no stand out dominant and/or distinctive features. It is noted that the applicant claims that “head” in the respective trade marks will be understood as referring to the brain and learning and education and as such is relatively less distinctive. I am not persuaded that the mark will be carved up in this manner, particularly as “head” is not the usual way in which to refer to a brain. Even if it has an allusive quality in this regard, it is loosely so. Rather, I consider it more likely that each mark will be appreciated as a whole and so the comparison will be carried out on this basis.

18. Visually, they coincide in the first five letters. A further coincidental letter is the letter R which appears in the same position (the seventh letter in each of the marks respectively). They differ in two ways: first, as regards their particular endings – ING as opposed to EAM and second in relation to letter number six in the strings: P and T. They are also similar in overall construction as they are identical in length. Having considered all of the aforesaid, it is considered that they are visually similar to a medium degree.

19. Aurally, again, the construction is similar in that each mark is comprised of two syllables, the first of which coincides entirely. It is true that there are

differences: in the sixth letter and in the respective endings. However, aural similarity remains. This is also pitched as being medium.

20. Conceptually, neither of the combinations in the marks has a clear, unequivocal meaning. However, it is considered that the word head in both will be understood as referring to the anatomical body part. The applicant argues that head will have a meaning in respect of the brain and its learning function. For the reasons given above, I am not persuaded that this meaning immediately comes to mind. Even if I am wrong on this, in respect of the anatomical meaning, the marks have a conceptual point in common. Stream can have several meanings including notably, that of a narrow river. Spring can also be understood as making a reference to water, namely a place where the liquid comes up through the ground. Looking at each of the trade marks as combinations, the effect in each is evocative of a similar idea whereby the anatomical body part is linked with water. They are considered to be conceptually similar, to a low to medium degree.

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

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

22. 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.”

23. The relevant consumer for these goods and services is likely to include both the public at large, educational providers and other professional users, such as businesses. The purchase may be visual and/or following a period of research. Word of mouth recommendations may also play a part and so visual and aural considerations will be important. The decision-making process is expected to be carefully considered as aspects such as the correct subject matter and particular medium used will be important. It may also represent a relatively expensive outlay, dependent upon the needs of the particular consumer. It is concluded therefore that at least a medium to high degree of attention would be displayed during the purchasing process.

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

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).”

25. There is no claim from the opponent that its earlier trade mark enjoys an enhanced degree of distinctiveness as a result of the use made of it. As such, I must consider the prima facie position. Headspring as a combination has no clear meaning and as such, no obvious relationship to the goods and services for which it is registered. It could possibly be argued that the word head has an allusive quality, but this is loosely so. It is considered, as a combination, to be distinctive to at least an average degree.

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

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

*The principles*

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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.

27. The goods have been found to be identical and/or similar to a medium degree. The earlier trade mark is distinctive to at least an average degree. The marks are similar visually and aurally to a medium degree and their overall construction in terms of length and syllables is similar. They differ in respect of SPRING and STREAM. However, there is no clear conceptual gap as a result of this difference. Indeed, they evoke a similar idea around a water source. It is true that medium to high degree of attention is expected to be displayed during the purchasing process. That said, I also bear in mind the fact that customers rarely have the opportunity to view marks side by side and so rely on an imperfect picture of them. Bearing in mind all of the aforesaid, it is considered likely that a customer will mistake one mark for the other. There is therefore a likelihood of direct confusion.

28. I also do not discount the fact that a customer paying a medium degree of attention may notice the differences between the marks. In assessing the impact of this, I take into account the guidance in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on

the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark".

29. Bearing this in mind, it is considered that the similar idea evoked by the respective endings and identical first syllables, together with the overall construction of each mark, is likely to lead customers to conclude that the later trade mark is another brand of the earlier trade mark relied upon or signifies a new version of a particular educational tool or service. There is therefore also a likelihood of indirect confusion.

30. The opposition therefore succeeds in its entirety.

## **COSTS**

31. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £400 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Notice of opposition (and accompanying statement) plus official fee - £400

32. I therefore order Learning Pool Ltd to pay Corporate Learning Alliance Ltd the sum of £400. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 25<sup>th</sup> day of October 2019**

**Louise White**

**For the Registrar**