

O/405/20

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3374758 BY
SARAH KLAES
TO REGISTER:**



AS A TRADE MARK IN CLASS 41

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 416235 BY
WILD LEARNING AND DEVELOPMENT LTD**

BACKGROUND AND PLEADINGS

1. Ms Sarah Klaes (“the applicant”) applied to register the trade mark on the front cover of this decision in the United Kingdom on 12 February 2019. The application was accepted and published on 1 March 2019 in respect of the following services:

Class 41

Training; Training (Practical -) [demonstration]; Training and education services; training and further training consultancy; Training and instruction; Training consultancy; Training courses; Training courses (Provision of -).

2. On 24 April 2019, the application was opposed by Wild Learning and Development Ltd (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent stated that the opposition concerns some of the services in the application, but, when asked to specify which services were being opposed, listed them all.

3. The opponent is relying upon UKTM 3015854: **Wild Learning**. The mark was applied for on 29 July 2013 and registered on 17 January 2014 for the following services:

Class 41

Adventure training for children; Educational services provided for children; Educational services provided for teachers of children; Entertainment services for children; Entertainment services provided for children; Provision of entertainment services for children; Education; Adult education services; Adult education services relating to environmental issues.

The opponent is relying upon all these services except for *Adventure training for children*.

4. As the registration process for the earlier mark was completed 5 years or more before the application date of the contested mark, the opponent is required to make a statement of use. It is claiming use for the following services:

Class 41

*Educational services provided for children; Educational services provided for teachers of children; Education; Adult education services; Adult education services relating to environmental issues.*¹

5. The opponent claims that the applicant's mark is very similar to the earlier mark and that the services are very similar, leading to a likelihood of confusion on the part of the public. The opponent also claims that there have been instances of actual confusion. Therefore, registration of the contested mark should be refused under section 5(2)(b) of the Act.

6. The applicant filed a defence and counterstatement denying the particular claims made, but admitting that there had been confusion. She claims to be able to prove that she owns an earlier unregistered right in the name **Wild Learning** and also notes that she has registered the company name at Companies House and the domain name. She put the opponent to proof of use for all the services on which it is relying.

7. Both parties filed evidence. I shall summarise this to the extent that I consider it necessary. Both parties made submissions alongside their evidence.

8. A hearing took place before me via video link on 30 June 2020. The opponent was represented by Michael Downing of Downing IP Limited. The applicant represented herself.

PRELIMINARY ISSUES

9. The applicant seeks to defend herself against the opposition by claiming that she is the owner of the intellectual property in the name **Wild Learning**, on the basis of an earlier unregistered right. Section 4.5 of the Trade Marks Manual states that:

¹ Mr Downing explained at the hearing that at the time of completing the notice of opposition, the opponent was unrepresented. He clarified that the Tribunal could ignore the services not listed in this paragraph.

“The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton & Anor*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

Parties are reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.”

10. The applicant’s claim to a prior right therefore are not relevant in these proceedings. Neither are the registrations of a company or domain name. Even if it is the case that the applicant started its business before the opponent, I must confine my attention to the trade mark issues.

EVIDENCE

The opponent’s evidence

11. The opponent’s evidence comes from Julie Holland, a director of Wild Learning and Development Limited. It is dated 8 January 2020.

12. Ms Holland states that the opponent was set up in 2012 to provide outdoor learning programmes for children and adults. Turnover was £79,501 in 2012-13, £110,747 in 2013-14, £188,108 in 2014-15, £221,061 in 2015-16, £247,388 in 2016-17 and £240,229 in 2017-18. At the time of the witness statement the 2018-19 figures had not been confirmed, but Ms Holland estimated it would be approximately £205,000.

13. Exhibit JH1 contains a set of invoices, as detailed in the table below:

Date	Services	Value
26/04/13	Birthday party, Wimbledon Common	£300.00
12/02/14	DBS check	£61.09
13/01/15	Birthday party, Wimbledon Common	£570.00
14/04/16	Wild Learning Session, Wimbledon Windmill (School to provide at least 2 other teachers)	£384.00
10/01/17	School day	£1680.00
16/03/18	Nursery sessions	£8976.00
23/01/19	Wild Learning Sessions	£2646.00
11/12/19	Wild Learning Sessions (35 children)	£864.00
19/09/15	Inset training session (training for 24 nursery staff)	£360.00

14. Exhibit JH2 contains a sample of advertising and marketing material from 2012 onwards. These include:

- A leaflet from an event held at Winkworth Arboretum, a National Trust property, on 16 September 2012. The opponent is described as a “forest school for children”;
- An advert for Wild Learning Holiday Clubs, placed in 2012 in *Primary Times*, a magazine for parents, pupils and teachers in the primary sector;
- An undated advertorial published in *ABC Magazine*, a local parenting magazine in Surrey;
- A sample from a direct mailing campaign to teachers in 2012 promoting resources the opponent provides for schools;
- Adverts and listings from the Surrey West edition of *Families* magazine dating from 2014-2018. An example is reproduced below;
- A listing from Forestry England for events in Alice Holt Forest;
- An undated advert placed in the *Forestry England* magazine

The house that Jack built...
 (with Will and Alyssa and Sam.)

Wild Play holiday clubs

"Yes! Good clean (or not!) fun. Kids shattered, messy, but bubbling with renewed enthusiasm for outdoor activities."

Easter and Summer holidays, all day
 Ages 5 and over, £38 per day

Reigate, Polesden Lacey and Guildford

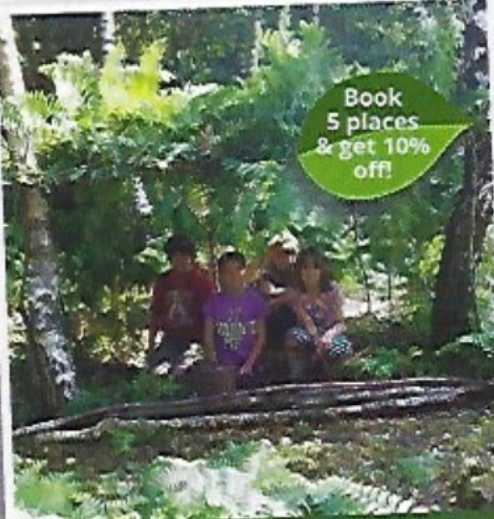
Activities may include:
 • Den building • Tracking and trailing • Survival skills
 • Story telling • Wild art • Killer frisbee • Craft skills

For more details or to book a place visit
wild-learning.net

wild learning
 tired, dirty, happy children

Book 5 places & get 10% off!

"The first words out of my daughter's mouth were 'Best day ever, can I go again tomorrow?' Brilliant."



15. As well as advertising in publications, according to Ms Holland "typically" 180,000-240,000 leaflets have been issued per year, including to children via schools. She says that the company is increasingly using online advertising. Exhibits JH5 and JH6 contain printouts from the opponent's website showing the mark in use. The first dates from 2012 and was obtained via the Wayback Machine and the second is undated but Ms Holland states that it is the current version. The mark appears in the following forms:



16. A further undated printout is supplied in Exhibit JH7 to show information on the services the opponent offers. Examples of promotional and information emails all showing the mark in the forms depicted above are to be found in Exhibits JH8 to JH10. These date from 2014, 2016 and 2019 respectively and concern holiday and classroom activities for children.

17. Ms Holland states that her company has also been using Google and Facebook to advertise since 2013. Examples of Facebook advertising and a printout of the homepage are shown in Exhibits JH15 and JH16 respectively. The mark is shown as the name of the account, and consequently in plain word form, and the services advertised are holiday clubs. Both exhibits are undated. Ms Holland says that the opponent now has around 1700 Facebook followers and 1100 Twitter followers.

18. In 2018 the opponent reached semi-finals of the “Muddy Stiletto” awards for Surrey, run by a website that aims to provide a “witty but indispensable guide to the very best restaurants, walks, boutiques, day trips, hotels, interiors and events in the local counties”.²

19. Towards the end of her witness statement, Ms Holland says:

“We have also over the years had a number of calls and emails from people that obviously don’t want us due to the location that they are seeking – for example if they are in the Midlands (where the Applicant is based). We have also had teachers ring us asking us for information regarding the sessions that they have booked with us, but who turned out to have booked with the Applicant.”³

The applicant’s evidence

20. The applicant’s evidence comes from Sarah Klaes, the Director of Wild Learning. Her witness statement is dated 12 March 2020.

² Paragraph 22.

³ Paragraph 32.

21. The applicant's company was incorporated in 2011 and the domain name was purchased on 6 June of that year.⁴ It was set up to provide forest school and outdoor leadership training for adults working in a professional capacity with children, young people or other adults, consultancy and training advice to schools and other educational establishments on forest school and outdoor learning, and Continuous Professional Development for education professionals working in the field. Exhibit SK1 contains screenshots from the applicant's website showing the services available. These were printed on 13 February 2020 but are otherwise undated.

22. Ms Klaes provides screenshots of the contents of computer folders relating to the development of the business, including the first training event in September 2011 and the creation of the logo.⁵ These are intended to prove the applicant's claim to have an earlier unregistered right in the mark. However, as I have already noted, this is not a valid defence to an opposition under section 5(2) of the Act.

23. Having agreed in the counterstatement that there have been instances of confusion, Ms Klaes states that her company has received "numerous" phone calls from the opponent's customers "over the years", the majority of those being enquiries from parents seeking information about events they had booked with the opponent.

DECISION

Proof of Use

24. Section 6A of the Act states that:

"(1) This section applies where

(a) an application for registration of a trade mark has been published,

⁴ Exhibit SK2.

⁵ Exhibits SK2-SK4 and SK6.

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier mark was completed before the start of the relevant period.

(1A) In this section ‘the relevant period’ means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the ‘variant form’) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

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

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

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

25. Section 100 of the Act is as follows:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

26. The period for which the opponent is required to show genuine use is the five years ending with the date of application for the contested registration: 13 February 2014 to 12 February 2019.

27. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

“114. *The law with respect to genuine use.* The CJEU has considered what amounts to ‘genuine use’ of a trade mark in a series of cases: Case C-40/01

Ansul BV v Ajax Brandbeveiliging BV [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816] [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single

undertaking under the control of which the goods are manufactured and which is responsible for their quality control: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [132].”

28. The opponent has shown evidence of leaflets and other advertising in connection with holiday clubs for children. I have listed these in paragraph 15 of this decision, and some fall within the relevant period. Advertised activities include fire lighting, nature walks, tracking and bushcraft, which can all be described as educational. It seems likely to me that the sessions covered by the invoices dated 10 January 2017 and 16 March 2018 were also aimed at children. These are described as “School day” and “Nursery sessions”. The opponent also claims to provide services for adults. There are, indeed, some references to corporate team-building sessions on the website extracts in Exhibit JH6, but these are undated and there is no evidence that any sales of these services have been made. It is not clear whether any of the invoiced sessions were delivered to adults, apart from the Inset session on 19 September 2015, provided for 24 nursery staff.⁶

29. In paragraphs 15 and 16 above, I noted that different forms in which the earlier mark appears in the evidence. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (CJEU) found that:

⁶ Exhibit JH1, page 18.

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the

product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)."

30. The earlier mark (**Wild Learning**) is a word mark. Registration of a word mark protects that word written in any normal font and irrespective of capitalisation: see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16. Bearing this in mind, together with the CJEU's statement in *Colloseum*, I find that the use shown in paragraphs 15 and 16 above indicates the origin of the services provided and so qualifies as use of the registered mark.

31. At the hearing, Mr Downing for the opponent admitted that its turnover was not huge, but stressed that large sales figures were not necessary to show genuine use. Equally, I recall that the courts have said that not every commercial use of the mark constitutes genuine use: see *P Reber Holdings & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-141/13, summarised by Professor Ruth Annand, sitting as the Appointed Person, in *STRADA Trade Mark*, BL O/528/15.

32. No figures have been given for the size of the UK market for the opponent's services, but it seems to me that it would be reasonably large for *Educational services provided for children, Education and Adult education services*, while smaller for *Educational services provided for teachers of children and Adult education services relating to environmental issues*. The opponent delivers its services in the south-east of England (London, Surrey, West Sussex, Hampshire) and its evidence shows promotional activities through social media, direct mailings, publications and leaflets. Taking these factors together, I find that the use shown is sufficient for the purpose of creating or preserving market share for the opponent's services. I must now move on to consider a fair specification for the earlier mark in the light of the use shown.

Framing a fair specification

33. In *Euro Gida Sanayi ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”⁷

34. In *Property Renaissance t/a Titanic Spa v Stanley Dock Hotel Ltd t/a Titanic Hotel Liverpool & Ors* [2016] EWHC 3103 (Ch), Carr J summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot

⁷ Pages 10-11.

reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

35. I also bear in mind what Mr Daniel Alexander QC, sitting as the Appointed Person, had to say on the subject of broad claims in *PLYMOUTH LIFE CENTRE*, BL O/236/13:

“... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as ‘tuition services’, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to ‘tuition services’ even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”⁸

⁸ Paragraph 28.

36. The opponent submits that it has shown use for all of the services relied upon. If I turn to Ms Holland's witness statement, I note that she describes her company's services in the following terms:

"Forest School/Wild Play based holiday clubs for children, taking children to forest locations where they will learn to use resources to build structures, play games, track and trail.

Forest-based sessions for schools, charities and businesses (in the form of corporate days) of a generally similar nature but aimed at providing a more structured learning incorporating a degree of instruction in new skills with scenario-based challenges.

Forest School/Wild Play ad hoc activities & sessions (e.g. birthday parties, and activities at festivals, shows, etc.)"⁹

37. However, it seems to me that the evidence shows the provision of outdoor learning opportunities for children and arguably also for adults who work with children. In my view, the average consumer would understand forest schools and similar outside learning activities to be a distinct subcategory in the broader category of *Education*. In my view the opponent can rely on *Outdoor educational services provided for children*; *Outdoor educational services provided for teachers of children*.

Section 5(2)(b)

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

"A trade mark shall not be registered if because –

...

⁹ Paragraph 5.

(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.”

39. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the CJEU 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 BV* (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;

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

d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa;

h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

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

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

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

Comparison of services

40. When comparing the services, all relevant factors should be taken into account, per *Canon*:

“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 complementary.”¹⁰

41. Guidance has also been given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281. At [296], he identified the following relevant factors:

“(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.”

42. The services to be compared are shown in the table below:

¹⁰ Paragraph 23.

Earlier services	Contested services
<p><u>Class 41</u> <i>Outdoor educational services provided for children; Outdoor educational services provided for teachers of children.</i></p>	<p><u>Class 41</u> <i>Training; Training (Practical -) [demonstration]; Training and education services; training and further training consultancy; Training and instruction; Training consultancy; Training courses; Training courses (Provision of -).</i></p>

43. In *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), Arnold LJ summarised the principles of interpretation of terms as follows:

“(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”¹¹

44. I also keep in mind what the General Court (GC) said in *Gérard Meric v OHIM*, Case T-133/05:

“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,

¹¹ Paragraph 56.

paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”¹²

45. The opponent submitted definitions of *training* and *education* from the online Cambridge Dictionary.¹³ They are as follows:

Training

The process of learning the skills you need to do a particular job or activity.

Education

The process of teaching or learning, especially in a school or college, or the knowledge that you get from this.

46. The opponent’s services are encompassed by the applicant’s *Training and education services* and so are identical under the *Meric* principle.

47. The applicant’s *Training, Training (Practical -) [demonstration], Training and instruction, Training courses* and *Training courses (Provision of -)* are all services in which participants are taught skills. This is also one of the intended purposes of the opponent’s services. Their method of delivery is highly similar. If they are not identical, they are at least highly similar.

48. The final services to be considered are *Training and further training consultancy*. These are services which the average consumer would expect to involve the provision of advice on training needs and different methods of meeting those needs. The purpose is to enable the consumer (most likely to be a business, educational institution or third sector organisation) to make the most effective choices of training opportunities for its employees, students or clients, so they are related. The opponent’s *Outdoor educational services provided for teachers of children* would, in my view, overlap with the applicant’s services. I find them to be similar to at least a medium degree.

¹² Paragraph 29.

¹³ Exhibit JH21.

Average Consumer

49. In *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“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.”

50. The average consumer of both the opponent’s and the applicant’s services is either an individual or an organisation. The individual may be a parent or guardian who is choosing training or education for a child, or an adult wanting to learn a new skill or subject. I have already mentioned above that the organisation may either be a business, educational institution or third sector body, purchasing the services for its employees, students or clients. When choosing services, the consumer will see adverts in publications, brochures or leaflets and may also search the internet. Therefore, the visual element of the mark will be important. However, I also consider that the aural element cannot be discounted, as word-of-mouth recommendation and other advice will also play a part. These services will be purchased relatively infrequently and can be costly. The consumer will consider the content of any training, the facilities offered and user feedback. In my view, they will pay at least a medium degree of attention during the selection process.

Comparison of marks

51. It is clear from *SABEL* (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 in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”¹⁴

52. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

53. The respective marks are shown below:

Earlier mark	Contested mark
Wild Learning	

54. The earlier mark consists of the words “Wild Learning” in title case and a standard font. The overall impression of the mark lies in the combination of the words. The contested mark consists of the same words in capitals, with WILD shown in black and LEARNING in green. Towards the left of the letters is a device comprising two ovals, each in two different shades of green and with a green line at the top. The average consumer is, in my view, likely to see these as leaves. They make a contribution to the overall impression of the mark, but not as great a contribution as that made by the words.

¹⁴ Paragraph 34.

55. The opponent submits that the marks are visually highly similar, given the identical verbal elements. The Court of Appeal has stated that registration of a trade mark in black and white covers use of the mark in colour: see *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290. However, normal and fair use of a mark would not include the application of complex colour arrangements. The verbal elements of the marks are not presented identically. In addition, the contested mark contains a device. The marks have, in my view, a medium degree of visual similarity.

56. The marks are aurally identical, as the words are the same and these are the only parts of the marks that will be articulated.

57. The opponent submits that:

“Both marks have the same conceptual content, that of learning in the wild. In the Applicant’s mark, this is reinforced by a motif of the leaves among which the learning might be conducted. Conceptually there is a high degree of similarity.”

58. I agree that the device in the contested mark will be seen as a representation of leaves and that this reinforces a forest or woodland setting for the learning. The earlier mark conveys the message of learning that takes place anywhere in the wild, not necessarily among trees, for example on a mountain. I agree with the opponent that there is a high degree of conceptual similarity.

Distinctive character of the earlier mark

59. In *Lloyd Schuhfabrik Meyer*, 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 Alternberger* [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).”

60. The opponent has made no claims to enhanced distinctiveness of its mark and therefore I have only the inherent position to consider. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of or allude to a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. A registered trade mark must be assumed to have at least some distinctive character: see *Formula One Licensing BV v OHIM*, Case C-196/11 P, paragraphs 41-44. The phrase “wild learning” alludes to the services that are offered. Consequently, I find that the earlier mark has a low degree of distinctive character.

Conclusions on likelihood of confusion

61. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred in paragraph 39 of this decision. Such a global assessment is not a mechanical exercise. I must keep in mind the average consumer of the goods and the nature of the purchasing process. I remind myself that it is generally accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture they have kept in their mind: see *Lloyd Schuhfabrik Meyer*, paragraph 27.

62. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

“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 recognised 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.’”¹⁵

63. I summarise the findings I have already made below:

- The opponent has shown use of the earlier mark in relation to *Outdoor educational services provided for children* and *Outdoor educational services provided for teachers of children*;
- The applicant’s services are identical or similar (to a high or at least a medium degree) to the opponent’s services;
- The average consumer will be paying at least a medium degree of attention and both visual and aural elements will be significant;
- The marks are visually similar to a medium degree, aurally identical and conceptually highly similar; and
- The earlier mark has a low degree of inherent distinctiveness.

¹⁵ Paragraph 16.

64. A low degree of distinctive character does not preclude a likelihood of confusion: see *L'Oréal SA v OHIM*, Case C-235/05 P. I note that the average consumer is likely to pay more attention to the words of the contested mark than the device. As they do not remember marks exactly, it is my view that they will mistake one mark for another and be directly confused. The marks are aurally identical, and aural considerations will play a part in the selection process. I also take account of the high degree of similarity in the conceptual hooks of the marks. It will be recalled that both parties stated that there had been instances of confusion in the past. I consider that this supports my finding of a likelihood of direct confusion.

65. In his skeleton argument, Mr Downing for the opponent says:

“The Applicant pleaded ‘an earlier unregistered right to the intellectual property of the name Wild Learning’ in her Counterstatement, paragraph 8. The nature of the unregistered right is not specified, but the Applicant is unrepresented so it behoves us to look into the evidence to identify what defences or prior rights could be relied on. Two options arise: a prior s5(4)(a)-type right relative to the Opponent’s registration, or honest concurrent use.”

66. I have already dismissed the possibility of a section 5(4)(a) defence, so will move on to honest concurrent use. Mr Downing drew my attention to *Victoria Plumb Ltd v Victorian Plumbing Ltd* [2016] EWHC 2911 (Ch), where Carr J considered the CJEU’s judgment in *Budějovický Budvar NP v Anheuser-Busch Inc. (BUDWEISER)*, Case C-482/09, and the Court of Appeal’s judgments in that case and in *IPC Media Ltd v Media 10 Ltd* [2014] EWCA Civ 1403, and stated that a defence of honest concurrence use could, in principle, defeat an otherwise justified claim of trade mark infringement where the two parties had been using the same or closely similar names honestly for a long time and the guarantee of origin of the claimant’s trade mark was not impaired by the defendant’s use.

67. The *BUDWEISER* case had shown that honest concurrent use may be relevant in cancellation proceedings, although the CJEU noted that the circumstances of that

particular case were exceptional. The court's answer to the third question put to it was as follows:

"In the light of the foregoing, the answer to the third question is that Article 4(1)(a) of Directive 89/104 must be interpreted as meaning that the proprietor of an earlier trade mark cannot obtain the cancellation of an identical later trade mark designating identical goods where there has been a long period of honest concurrent use of those two trade marks where, in circumstances such as those in the main proceedings, that use neither has nor is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods or services."

68. Whether the exceptional circumstances referred to by the CJEU in *BUDWEISER* apply in a particular case, is ultimately a question of fact. The evidence adduced by the applicant does not show that the businesses have co-existed for a long period and neither does the applicant provide any sales figures and the single example of a delivered event dates from 2011 and even then it is not clear how many people attended. While I accept that the applicant incorporated her company as "Wild Learning" in 2011, the evidence falls short of what would be required to mount a successful honest concurrent use defence, and the opposition succeeds.

Conclusion

69. The opposition has been successful and application no. 3374758 will be refused.

Costs

70. The opponent has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016. In the circumstances I award the opponent the sum of £1300 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

<i>Preparing a statement and considering the other side's statement:</i>	<i>£200</i>
<i>Preparing evidence and considering and commenting on the other side's evidence:</i>	<i>£700</i>
<i>Preparing for and attending a hearing:</i>	<i>£300</i>
<i>Official costs:</i>	<i>£100</i>
 TOTAL:	 £1300

71. I therefore order Ms Sarah Klaes to pay Wild Learning and Development the sum of £1300. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 25th day of August 2020

Clare Boucher
For the Registrar
Comptroller-General