

**O/632/21**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION No. 3415075**

**BY GEORGE COOK AND GEORGE SPOONER, THE PARTNERS IN  
OXBRIDGEIQ**

**AND**

**OPPOSITION No. 418255**

**BY OXBRIDGE LIMITED**

**AND**

**APPLICATION No. 503253**

**BY GEORGE COOK AND GEORGE SPOONER, THE PARTNERS IN  
OXBRIDGEIQ**

**FOR A DECLARATION THAT TRADE MARK No. 3357627 IS INVALID**

## Background and pleadings

1. Oxbridge Limited (“OL”) relies on two existing registered trade marks consisting of, or including, the word ‘OXBRIDGE’ to oppose a trade mark application filed on 18<sup>th</sup> July 2019 by George Cook and George Spooner, the partners in OxbridgeIQ (“IQ”). They applied to register the following mark in relation to “*Tutoring*” services in class 41.



2. OL claims that ‘Oxbridge’ is distinctive of the educational goods and services for which the earlier marks are registered, and that use of the contested mark will create a likelihood of confusion with its earlier marks. This is an unusual case because OL accepts that OXBRIDGE is a portmanteau word that has been used for many years to collectively describe two other high very profile providers of educational services; namely, Cambridge and Oxford Universities. Indeed, OL relies on OXBRIDGE indicating the trade origin of services provided by these universities to resist a counter application brought by IQ to invalidate OL’s word-only OXBRIDGE mark on the basis that it is was descriptive, non-distinctive, or in customary use, when it was registered in 2018.

3. The main details of OL’s case for opposing IQ’s application are as follows:

(a) Trade mark 3163319 was applied for on 6<sup>th</sup> May 2016 and registered on 11<sup>th</sup> November 2016;

(b) The mark covers, inter alia, “education” in class 41;

(c) The mark looks like this The logo for OXBRIDGE HOME LEARNING consists of a stylized 'X' formed by two overlapping shapes (one orange, one blue) to the left of the text 'OXBRIDGE' in orange and 'HOME LEARNING;' in blue.

(d) The respective services are identical;

(e) The word OXBRIDGE is the dominant and distinctive element of both the contested mark and the earlier mark, the device of a teaching board and the letters 'IQ' in the contested mark being descriptive, and the other elements of the earlier mark being secondary in impact and importance to OXBRIDGE;

(f) Trade mark 3357627 was applied for on 30<sup>th</sup> November 2018 and registered on 10<sup>th</sup> April 2020;

(g) The mark covers, inter alia, "*Distance learning services*" and "*education services provided remotely*;"

(h) The mark consists of the word **OXBRIDGE**;

(i) The respective services are identical or highly similar;

(j) The word OXBRIDGE is the dominant and distinctive element of the contested mark and the only element in the earlier mark;

(k) The word OXBRIDGE used in the respective marks has "*essentially the same or a very similar meaning*" (OL's pleading in the opposition proceedings is silent about what this meaning is);

(l) The relevant public will believe that the contested mark is a sub-brand used by the user of the earlier marks.

(m) There is a likelihood of confusion on the part of the public, including the likelihood of association;

(n) Registration of IQ's mark would therefore be contrary to s.5(2)(b) of the Trade Marks Act 1994 ("the Act").

4. IQ filed a counterstatement denying the grounds of opposition. I note that IQ:

(a) Admitted that the respective services are identical or highly similar;

(b) Denied that OXBRIDGE, rather than the stylised OX logo, is the dominant and distinctive element of earlier trade mark 3163319;

(c) Denied that 'IQ' is of less significance than OXBRIDGE in the contested mark;

(d) Relied on the device of a figure in front of a whiteboard in the contested mark as an element which further visually distinguished the contested mark from the earlier marks;

(e) Claimed that OXBRIDGE is "*a commonly used and well known descriptive, generic and/or non-distinctive word*" which the relevant consumer would not see as indicating the goods/services of any one undertaking.

5. On 29<sup>th</sup> July 2020, IQ applied for a declaration under s.47(1) of the Act that trade mark 3357627 (i.e. the word OXBRIDGE) is invalid in relation to all the goods/services for which it is registered, namely:

Class 9: Computers; computer software; computer programs, computer programs for educational purposes, computer games for educational purposes; USB flash drives; downloadable computer programs; downloadable computer program applications; downloadable computer programs for mobile devices; sound recordings and audio-visual recordings; digital and pre-recorded compact discs, DVDs and electronic media; teaching, instructional and educational apparatus and instruments; electronic publications; downloadable electronic publications; electronic books.

Class 16: Printed matter; printed publications; books; text books; materials for education, instruction and teaching; journals; work books; stationery; pens, pencils and erasers; pencil cases; calendars; cards, postcards, posters for education, instruction and teaching.

Class 38: Telecommunications; electronic transmission of publications and books; video-on-demand transmission; video conferencing services; electronic mail services; communication by voice over internet protocol; communication by electronic mail systems; data transmission to mobile devices; data transmission by electronic mail; providing access to and leasing access time to

computer databases; information, advisory and consultancy services relating to the aforesaid.

Class 41: Distance learning services; education at a distance; education services provided remotely; vocational education provided remotely or at a distance, examination services; educational publishing; publication of books, texts, journals and periodicals; provision of online library services; education, instruction and training provided on-line from a remote computer database; provision of electronic publications and electronic books; provision of virtual learning environments.

6. OL claims that registration of OXBRIDGE was contrary to sections 3(1)(b),(c),(d) and/or 3(3)(b) of the Act. The pleaded case for invalidation based on section 3(1)(c) of the Act was put like this:

*“The Mark should be declared invalid under Section 3(1)(c) on the basis that it indicates the quality, intended purposes and/or other characteristics of goods or services. The Mark directly conveys that the goods and services in classes 9, 16, 38 and 41 originate from and/or are endorsed by the highly prestigious Oxford and/or Cambridge Universities.”*

7. The pleaded case for invalidation under sections 3(1)(b) and/or (d) of the Act on the grounds that the mark is devoid of any distinctive character and/or a sign that has become customary in the current language or in the bona fide and established practices of the trade, closely followed the reasons set out under section 3(1)(c). The pleaded case under section 3(3)(b) of the Act was that OXBRIDGE:

*“...is deceptive as to nature of the goods and services as coming from the Oxford or Cambridge Universities when they do not. This will deceive the public into incorrectly thinking that the goods and services relate to or emanate or originate from Oxford or Cambridge University.”*

8. OL filed a counterstatement denying the grounds of invalidation. Whilst admitting that OXBRIDGE is a portmanteau word used to refer collectively to Oxford and Cambridge Universities, OL denied that this rendered the mark devoid of any

distinctive character, descriptive of any characteristic of the registered goods/services, or customary in the current language or in the bona fide and established practices of the trade. OL further denied that use of OXBRIDGE would be deceptive, as alleged by IQ.

9. OL also pleaded that:

*“If, contrary to the foregoing, the Mark is found to have been registered contrary to sections 3(1)(b), (c), and/or (d) of the Act, then the Proprietor will rely pursuant to section 47(1) of the Act upon its use of the sign OXBRIDGE (and/or signs incorporating the word OXBRIDGE) as establishing that the Mark had, at least by the date of application for invalidity, acquired a distinctive character in relation to the goods/services for which it is registered (or some of them).”*

10. In this respect, OL indicated that it would, if necessary, make amendments to its registered list of goods/services so as to retain as many of them as possible.

11. Both sides seek an award of costs.

12. The opposition and invalidation proceedings are consolidated.

### **Representation**

13. OL is represented by Burley Law Limited. IQ is represented by Gill, Jennings & Every LLP. A hearing took place on 15<sup>th</sup> June 2021 at which Mr Mitchell Beebe appeared by video link as counsel for OL. IQ was not represented. I have, however, had the benefit of written submissions in lieu of IQ’s participation in the hearing.

### **The evidence**

14. OL’s evidence takes the form of two witness statements by Mr Matthew Jones, who is the Managing Director of OL. The purpose of Mr Jones’ evidence is to show that OL has been trading under OXBRIDGE since August 2015 and, he claims, acquired a reputation under that mark.

15. IQ’s evidence consists of a witness statement by Ms Natalie John, who is a Trade Mark Attorney at Gill, Jennings & Every. Ms John provides a dictionary reference for

Oxbridge, as well as newspaper articles including that word. Her evidence also includes the results of a search of the companies register and online searches for 'Oxbridge' showing numerous companies registered and/or trading under, or using, that name in the education sector. The purpose of Ms John's evidence is to show that Oxbridge is commonly used to refer to Oxford and Cambridge Universities or their prestigious qualities and characteristics in the education sector.

### **IQ's application to invalidate trade mark 3357627 (i.e. the word OXBRIDGE)**

16. It is convenient to start by examining IQ's application to invalidate trade mark 3357627 on the grounds that registration of OXBRIDGE was contrary to sections 3(1) and/or 3(3)(b) of the Act. The relevant statutory provisions are set out below.

*"47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration). Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.*

*[...]*

*(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.*

*[...]*

*(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.*

*Provided that this shall not affect transactions past and closed."*

*“3.— Absolute grounds for refusal of registration*

*(1) The following shall not be registered—*

*(a) signs which do not satisfy the requirements of section 1(1).*

*(b) trade marks which are devoid of any distinctive character.*

*(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,*

*(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:*

*Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.*

*[...]*

*(3) A trade mark shall not be registered if it is—*

*(a) contrary to public policy or to accepted principles of morality, or*

*(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”*

17. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

18. The case law under article 7(1)(c) of the EU Trade Mark Regulation (which corresponds with section 3(1)(c) of the Act) was set out by Arnold J. in *Starbucks*



*(HK) Ltd v British Sky Broadcasting Group Plc*<sup>1</sup> (with most case notes omitted) as follows:

*“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in Agencja Wydawnicza Technopol sp. z o.o. v OHIM (C-51/10 P) [2011] E.T.M.R. 34 as follows:*

*“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services.... .*

*36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it.*

*37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services.*

*38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes.*

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<sup>1</sup> [2012] EWHC 3074 (Ch)

39. *By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question. It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration.*

*And*

46. *As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive.*

47. *There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation, Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.*

48. *In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.*

49. *The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article*

*7(1)(c) of Regulation No 40/94 , the terms ‘the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’, the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.*

*50. The fact that the legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics.”*

*92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned.”*

19. OL submits that IQ’s case under section 3(1) of the Act is misconceived because, as the pleading under section 3(1)(c) indicates, it is based on the proposition that Oxbridge identifies goods/services that “*originate from and/or are endorsed by the highly prestigious Oxford and/or Cambridge Universities.*” According to OL, this amounts to a claim that Oxbridge identifies the trade origin of the goods/services, which is not relevant to the absolute grounds for refusal/invalidation of trade marks. Rather, it is a matter that can only be raised under the relative grounds for refusal/invalidation set out in section 5 of the Act.

20. I accept that the case pleaded under section 3(1)(c) is misconceived. Although the words “..characteristics of goods or services” have been given a broad meaning in the case law, it is limited to signs which are capable of designating “..a property, easily recognisable by the relevant class of persons, of the goods or the services.” The trade origin of the goods or services is not a property of those goods/services. Rather, designations of trade origin indicate that the goods/services marketed under a specific mark originate from a particular undertaking (or particular undertakings). Such an indication is not a ‘characteristic’ of the goods/services. On the contrary, signs which identify the trade source of the goods/services are usually regarded as suitable for registration and use as a trade marks.

21. IQ’s case under sections 3(1)(b) and (d) of the Act is pleaded as follows:

*“The Mark entirely consists of the word OXBRIDGE which is widely and commonly used as a portmanteau word of two highly prestigious and extremely well known universities in England, Oxford and Cambridge, allowing reference to the two educational establishments collectively.*

*On this basis, The Mark as it covers various educational goods and services and/or goods and services that could be used for educational purposes in classes 9, 16, 38 and 41 is devoid of any distinctive character; it would not be seen as nor is it capable of functioning as a trade mark.”*

And

*“The Mark should be declared invalid under Section 3(1)(d) on the basis that The Mark is customary in the bona fide and established practices of the trade and has been extensively and significantly used in the UK to collectively refer to the Oxford and Cambridge Universities.”*

22. IQ’s case under these sections appears to me suffer from the same defect as the case put under section 3(1)(c), i.e. that Oxbridge will not be taken as designating OL’s goods/services because it will be taken as designating those of Oxford and

Cambridge Universities. That is a relative grounds issue, not a question of whether Oxbridge is capable of identifying any particular trade source for the goods/services.

23. This conclusion is consistent with the judgment of Floyd J. (as he then was) in *Nude Brands Ltd v Stella McCartney Ltd*,<sup>2</sup> where he dealt with a counter claim for invalidation of an EU mark under the corresponding provisions of the EU Trade Mark Regulation. The judge held that:

*“29. Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly does not go as far as establishing ground 7(1)(d) - customary indication in trade. Ground 7(1)(b) is concerned with the inherent character of the mark, not with what other traders have done with it. The traders in question are plainly using the mark as a brand name: so I do not see how this use can help to establish that the mark consists exclusively of signs or indications which may serve to indicate the kind or quality or other characteristics of the goods, and thus support an attack under 7(1)(c).”*

24. I note that in its written submissions in lieu of a hearing, IQ suggested that some of the material it filed as evidence showed that Oxbridge had a somewhat wider meaning than collectively referring to the Oxford and Cambridge Universities: it was said to show that the word could also be used:

*“...as an adjective to describe a certain type of individual i.e. a graduate, student or applicant of Oxford or Cambridge University.”*

*“.. more generally to infer high standards of education and assessment, for example through use in combination with other descriptor words as follows: “OXBRIDGE EDUCATION”, “OXBRIDGE ESSAYS” and “OXBRIDGE ENTRANCE TESTS.”*

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<sup>2</sup> [2009] EWHC 2154 Ch

25. This represents a broadening of IQ's case for invalidation under section 3(1) of the Act. It is not covered by IQ's existing pleadings and no application has been made to amend its pleadings. Consequently, it is not appropriate for me to assess IQ's case for invalidation on the broader basis described (almost in passing) in its written submissions in lieu of participation in the hearing.

26. The pleaded case under section 3(1) is misconceived, as OL contended at the hearing. Therefore, I reject it. This means that there is no need for me to consider OL's fallback position that Oxbridge had acquired a distinctive character through prior to the date of the application for registration and/or the date of IQ's application for invalidation.

27. I turn next to IQ's case for invalidation based on section 3(3)(b) of the Act, which is essentially that Oxbridge:

*"...is deceptive as to nature of the goods and services as coming from the Oxford or Cambridge Universities when they do not."*

28. At the hearing, Mr Beebe for OL reminded me of my own conclusions in *Khadi and Village Industries Commission v BNP Best Natural Products GmbH*<sup>3</sup> in which I held that:

*"If the alleged deception depends on who is using the mark, rather than on the inherent deceptiveness of the mark itself, that is a matter that can only be addressed under the so-called relative grounds for refusal."*

29. This conclusion is consistent with the findings of Mr David Stone, sitting as a Deputy High Court Judge in *Cormeton Fire Protection Ltd v Cormeton Electronics Ltd & Anor.*<sup>4</sup> The Deputy Judge said that:

*"85. First, in relation to the law, as I have already noted, section 3(3)(b) is in the part of the TMA which deals with absolute grounds of refusal. Absolute grounds are those that pertain to the mark itself – for example, marks devoid of distinctive character, marks which denote kind or quality, certain types of shape marks, and*

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<sup>3</sup> BL O/556/20

<sup>4</sup> [2021] EWHC 11 (IPEC)

*marks contrary to public policy. That is already a clear guide to the interpretation of section 3(3)(b) – it is clearly not aimed at preventing registration of marks in which a third party may own rights.*

*86. Next, the section itself lists, albeit non-exclusively, examples of types of mark which may deceive the public – "for instance as to the nature, quality or geographical origin of the goods or services". Counsel for the Defendants submitted that this list is not closed, and I accept that submission. But the examples given are all absolute grounds examples, concerned with deception about the nature of the goods or services on offer. None of the examples given relates to the message that may be conveyed about the business origins of the goods or services provided under the mark.*

*87. Third, this position is entirely consistent with the limited case law on section 3(3)(b) and its equivalents in the EU instruments I have referred to above [...]."*

30. After summarising the findings in *Elizabeth Florence Emanuel v Continental Shelf 128 Ltd*,<sup>5</sup> *Melly's Trade Mark Application*,<sup>6</sup> *Sworders Trade Mark*,<sup>7</sup> and *WF Gözze Frottierweberei v Verein Bremer Baumwollbörse*,<sup>8</sup> the Deputy Judge held that:

*"87. [...] These four decisions speak with one voice – section 3(3)(b) of the TMA refers to per se or absolute grounds.*

*88. Fourth, if the Defendants are right, their interpretation would drive a coach and horses through the relative grounds provisions in section 5 of the TMA. All an earlier right owner would need to do would be to allege public deception, without first having to comply with the requirements for identical or similar marks, identical or similar goods/services, or ownership of a mark with reputation. This cannot be what the legislature intended.*

*89. Therefore, in my judgment, section 3(3)(b) of the TMA is not engaged where the only "deception" is as to who is using the mark to provide goods or services.*

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<sup>5</sup> Case C-259/04

<sup>6</sup> [2008] ETMR 41

<sup>7</sup> BL O/212/06

<sup>8</sup> Case C-689/15

*That sort of deception is remediable under the relative grounds for refusal of registration to be found in section 5 of the TMA. The Defendants' application for invalidity under section 3(3)(b) fails.”*

31. I find that IQ's case for invalidation based on section 3(3)(b) of the Act is also misconceived and must, therefore, also be rejected.

32. This means that OL is entitled to rely on that trade mark 3357627 (i.e. the word OXBRIDGE) for the purpose of its opposition to IQ's application for registration.

### **OL's opposition to IQ's trade mark application 3415075 under section 5(2)(b) of the Act**

33. Sections 5(2)(b) and 5A of the Act are 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”.*

*“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”*

34. 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.

#### Comparison of goods/services

35. Neither of the earlier trade marks relied on by OL is subject to proof of use under section 6A of the Act. Therefore, OL can rely on these marks in relation to all the goods/services for which they are registered.

36. The respective goods/services are shown below.

Trade mark application 3415075  <i>“Tutoring”</i> services in class 41	Earlier trade mark 3357627  <i>“Distance learning services”</i> and <i>“education services provided remotely”</i> in class 41  Earlier trade mark 3163319  <i>“education”</i> in class 41
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37. Services can be considered identical where those designated in the trade mark application are included in a more general category covered by the earlier mark.<sup>9</sup>

<sup>9</sup> *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05

38. “*Tutoring*” is clearly a sub-set of education services. These services are therefore identical. Tutoring services can be provided either in person or remotely, e.g. online. Therefore “*tutoring*” is also identical to “*education services provided remotely.*”

#### The average consumer and the selection process

39. 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.<sup>10</sup>

40. OL accepts that the average consumer of education services in class 41 could be a member of the public or a business user. According to OL, a member of the general public will pay “*a higher than average degree of attention, but not pay a high degree of attention*” when selecting such services. OL accepts that the level of attention paid may vary depending on the nature of the class 41 services being provided, which it says could vary between simple low cost courses (e.g. 1 hour courses for CPD points for a lawyer) through to more substantive qualifications. OL accepts that users of the latter type of service will pay a higher degree of attention, as will business users.

41. I agree that average consumers of all education services will pay an above average degree of attention when selecting such services. Decisions about education generally, and educational qualifications in particular, are usually highly important to the user. Therefore, he or she will normally pay a higher than normal degree of attention when selecting a service provider in this field. I accept that the level of attention may vary depending on the importance to the user of the education and/or qualification sought. Those seeking important qualifications that may affect their career path are likely to pay a particularly high degree of attention when selecting an educational service provider. In this connection, I note that in its final written submissions IQ indicated that it would be prepared to amend its specification, if necessary, to *Tutoring for Oxford and Cambridge applicants*.

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<sup>10</sup> *Lloyd Schuhfabrik Meyer, Case C-342/97*

42. OL submits that the services at issue are likely to be selected with equal importance attached to the visual and aural impressions created by the trade marks. I note that the opponent's own evidence indicates that the majority of its own advertising is online through its website or through social media. These channels usually place emphasis on the visual aspects of trade marks. However, those seeking entrance to a bricks and mortar university or college are likely to have to face-to-face discussions in the course of selecting a service provider. Oral recommendations may also play an important part in the selection process. I therefore accept OL's submission that the services at issue are likely to be selected with equal importance attached to the visual and aural impressions created by the trade marks.

#### Distinctive character of the earlier marks

43. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,<sup>11</sup> 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*

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<sup>11</sup> Case C-342/97

*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).”*

44. *Kurt Geiger v A-List Corporate Limited*,<sup>12</sup> Mr Iain Purvis Q.C., as the Appointed Person, pointed out that the degree of distinctive character of the earlier mark is only likely to increase the likelihood of confusion if it resides in the element of the mark that is identical or similar to the opposed trade mark. In examining the level of distinctive character of the earlier marks it is therefore appropriate to pay particular attention to the distinctiveness of Oxbridge in relation to the services at issue.

45. The relevant date for assessing the matter is the date of IQ’s application, i.e. 18<sup>th</sup> July 2019.

46. IQ submits that Oxbridge is lacking in distinctive character for educational services. In this respect, it relies on the evidence of Ms John. Her evidence includes dictionary entries for Oxbridge.<sup>13</sup> I note that the dictionary reference from Collins Dictionary refers to Oxford and Cambridge Universities combined, and also lists the word as a modifier which may be used to refer to graduates of those establishments. I consider that this is, in any event, a notorious fact about which I can take judicial notice.

47. Ms John says that research she commissioned by Findtech Limited found a total of 872 newspaper articles published between 2012 and 2018. She provides the text from a selection of these articles.<sup>14</sup> They support the proposition that Oxbridge is used to designate Oxford and Cambridge Universities together, and their applicants, students, graduates and entrance tests.<sup>15</sup>

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<sup>12</sup> BL O-075-13

<sup>13</sup> See exhibit NSJ1

<sup>14</sup> See exhibit NSJ3

<sup>15</sup> See page 16 of exhibit NSJ3

48. Ms John conducted a search of the register of companies in December 2020 for companies including the name Oxbridge and found 228 hits. She provides a list of hits and a selection of pages from the websites of some of the companies concerned, as well as those of other businesses she found trading under names including Oxbridge.<sup>16</sup> I note that these include:

- (i) The homepage for Oxbridge Academy London Ltd at [oxbridgeacademylondon.net](http://oxbridgeacademylondon.net), which appears to offer educational courses to a global student base. The website carries a copyright claim of 2018.
- (ii) The homepage for Oxbridge Applications Ltd at [oxbridgeapplications.com](http://oxbridgeapplications.com), which claims that it was established in 1999 and is the global leader in Oxbridge admissions consultancy supporting students wishing to get into Oxford and Cambridge Universities and other top schools.
- (iii) The homepage for Oxbridge Research Group Ltd at [oxbridgeessays.com](http://oxbridgeessays.com), which offers support from expert academic mentors to help students get the grades they want. I note that it was reported in the Guardian in 2017 that the Advertising Standards Authority found an advertisement by Oxbridge essays published in 2013 to be in breach of its code.

49. Mr Jones's evidence on behalf of OL is that:

- (i) OL first traded under OXBRIDGE in August 2015 and has used this name as its primary brand since that date;
- (ii) The main activity of the company is the sale of educational products;
- (iii) The number of students enrolled on its courses increased from 140 in 2016 to 5125 in 2019;
- (iv) The total number of staff, including administrative, teaching and management roles, increased from 3 to 25 over the same period;

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<sup>16</sup> See exhibits NSJ4 and NSJ5

- (v) The company's turnover between 2016 and 2019 increased from around £60k in 2016, to over £500k in 2017, to over £1.25m in 2018, to approaching £2m in 2019;
- (vi) The number of students enrolled on OL's courses increased from 140 in 2016 to over 5000 in 2019;
- (vii) The number of courses offered increased from 12 in 2016 to 175 in 2019;
- (viii) The courses range from introductory education, through GCSEs, A levels, foundation degrees and degree level qualifications, and cover a wide range of subjects;
- (ix) OL's students come from locations across the UK;
- (x) OL's largest advertising expenditure is aimed at keeping the company at the top of the Google search rankings for 'Oxbridge';
- (xi) During 2019 and 2020, OL spent around £30 - £60k per month on this activity;
- (xii) Over the same period, OL has also spent £10k - £15k per month on PR and marketing agencies to improve the visibility of the brand;
- (xiii) Additionally, OL spends £100k per annum on affiliate advertising, that is incentivising third party social media sites to direct traffic to OL's website at [oxbridgehomelearning.co.uk](http://oxbridgehomelearning.co.uk);
- (xiv) As at December 2020, OL had 5847 'likes' on its Facebook page, 131 followers on Twitter, and 773 followers on Instagram;
- (xv) In late 2019 (it is not clear exactly when), OL was the winner of a gold award for use of blended learning at the Learning Technologies Awards.

50. Mr Jones provides 23 exhibits to support the claims made in his statement. I note the following:

- (i) The 2018-19 prospectus included in exhibit MCJ3 carries the composite mark registered under 3163319.

- (ii) Between 1<sup>st</sup> January 2017 and 14<sup>th</sup> December 2020 (i.e. 17 months after the relevant date), OL's website received around 1.6m visitors, about 75% of which are recorded as using GB domains.<sup>17</sup>
- (iii) The website had a 'bounce rate' of more than 50%, indicating that many such users immediately left the website (the average time per session for all users is recorded as 8 seconds).<sup>18</sup>
- (iv) The two pages from OL's website obtained from the web archive site WayBack showing the website as at September 2018 show no use of Oxbridge, or even Oxbridge Home Learning, other than in the domain name.<sup>19</sup>
- (v) Four invoices for education services issued by OL between 3<sup>rd</sup> January 2019 and the relevant date show prominent use of the Oxbridge logo shown below;<sup>20</sup>

**Oxbridge**

- (vi) Two educational certificates issued to students on 24<sup>th</sup> June 2019 (and others from after the relevant date) show use of the same Oxbridge logo and that the certificates were from 'Oxbridge Home Learning';<sup>21</sup>
- (vii) The pages from OL's website downloaded in 2021 (i.e. well after the relevant date) show prominent use of Oxbridge including, but not only, in the logo form shown above;
- (viii) The certificates granted to OL confirming its status as a qualified course provider all refer to OL as Oxbridge Home Learning.<sup>22</sup>
- (ix) Reviews of OL's services on the website findcourses.co.uk dated between 2015 and 2019 show that four students referred to OL as just Oxbridge (or Oxbridge College) and five referred to it as Oxbridge Home Learning.<sup>23</sup>

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<sup>17</sup> See exhibit MCJ6

<sup>18</sup> See exhibit MCJ6

<sup>19</sup> See the first two pages of exhibit MCJ16: the third page was not obtained from the web archive site, despite Mr Jones's evidence to the contrary

<sup>20</sup> See exhibit MCJ20

<sup>21</sup> See exhibit MCJ23

<sup>22</sup> See exhibit MCJ9

<sup>23</sup> See exhibit MCJ8



51. At the hearing, Mr Beebe took me to the contents of exhibit MCJ5 which he said showed OL and others referring to it as 'Oxbridge' prior to the relevant date. Mr Jones says that the exhibit consists of electronic press cuttings of events attended or sponsored by OL and awards won by OL or its staff. He does not say when. I find the exhibit hard to read and even harder to accurately date the contents. Some of the contents do not match the period(s) described in the headings within the exhibit. For example, the entry on page 30 showing that 'Oxbridge' was listed for an award in the Birmingham Chamber of Commerce awards for 2018, 2019 & 2020 is internally dated 2020: it does not show how OL was described in 2018 or 2019, i.e. prior to the relevant date. Therefore, I have not found the contents of exhibit MCJ5 to be of much assistance.

52. I will first consider the degree of inherent distinctiveness of the word Oxbridge. The word Oxbridge does not appear to be used by Oxford and Cambridge Universities themselves, i.e. it is not a trade mark as such. I do not consider its use by others as a portmanteau word describing Oxford and Cambridge Universities together, and their applicants, students, graduates etc., means that the word is inherently descriptive of the characteristics (as opposed to the trade source) of tutoring services. On the other hand, the fact that the name has been widely associated with Oxford and Cambridge Universities for over 150 years inevitably limits its capacity to be particularly distinctive of any single provider of education services. I therefore find that, at the relevant date, Oxbridge had, at most, an average degree of inherent distinctive character in relation to education and distance learning services.

53. IQ denies that OL has not shown that OXBRIDGE alone has become distinctive of its services through use. It points out that much of the use shown in the evidence is of the composite mark registered under 3163319, or the words Oxbridge Home Learning. It also disputes that use of the Oxbridge logo shown at paragraph 50(v) above amounts to use of the word Oxbridge as such. I accept that OL has shown only limited use of the word OXBRIDGE as such prior to the relevant date. However, as a matter of law, use of a mark as part of another trade mark may still result in the

mark acquiring an enhanced level of distinctiveness.<sup>24</sup> In this connection, I find that the difference between the Oxbridge logo and the word Oxbridge as such is slight, and the words 'Home Learning' are plainly descriptive of distance learning services. Consequently, the use of Oxbridge as part of the latter marks, and the use of the Oxbridge logo, could result in Oxbridge alone acquiring an enhanced level of distinctiveness through the use.

54. OL claims that the Oxbridge word mark had indeed acquired a high degree of distinctive character through use prior to the relevant date. The evidence shows that OL started providing distance learning services on a small scale in 2015. The turnover to 2016 shows that the business remained small with only 140 students. By 2019, OL's business had grown to the extent that it had over 5k students and a turnover of around £2m. OL points out that by 2020 it had more students (9811) than all bar four UK universities.<sup>25</sup> However, the relevant date is July 2019. In any event, OL is not a university. It provides distance learning education services at various levels below, up to, and including degree level. Comparing its student numbers to those of bricks and mortar universities is not a fair or relevant comparison.

55. There is no evidence as to the size of the education market, but it must run into many £billions per annum. Similarly, I doubt that the 25 staff OL employed in 2019 represented more than a tiny fraction of those engaged in the education sector, even excluding State education. In my view, the evidence indicates that OL was a relatively new and small player in the market for education services at the relevant date. Others appear to have regarded OL in the same way. For example, OL was recognised in 2018 as 'Small Business of the Year' in Birmingham<sup>26</sup> and, in 2019, OL was the Midlands area finalist in the Federation of Small Business's 'Start-up Business of the Year' award category.<sup>27</sup> OL's marketing expenditure was also relatively modest and aimed mostly at attracting visitors and students to its website. The fact that the word Oxbridge is widely associated with two of the most prestigious universities in the world no doubt assisted in attracting a large number of visitors to

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<sup>24</sup> See, by analogy, *Société des Produits Nestlé SA v Mars UK Ltd*, Case C-353/03, CJEU, and *China Construction Bank Corp. v EUIPO*, General Court, Case T-665/17

<sup>25</sup> Exhibit MCJ13 shows the number of students at UK universities in 2020.

<sup>26</sup> See exhibit MCJ5, page 34

<sup>27</sup> See exhibit MCJ4, page 29



OL's website, but that does not mean that Oxbridge had become highly distinctive of OL's services by the relevant date. It seems far more likely that the public continued to associate Oxbridge primarily with Oxford and Cambridge Universities together, and their applicants, students and graduates. In assessing the level of enhanced distinctive character a trade mark has acquired through use (if any) it is, in my view, necessary to focus on the strength of the mark's capacity to distinguish goods/services marketed under the control of the trade mark proprietor. It follows that the fact that Oxbridge has been used by the public for over 150 years to designate other prominent service providers in the same sector does not assist OL's case that its limited use of Oxbridge between 2015 -2019 resulted in that word becoming highly distinctive of its education services.

56. I find that OL's use of Oxbridge, the words Oxbridge Home Learning and/or the Oxbridge logo prior to the relevant date did not result in that word becoming highly distinctive of OL's services. In my judgment, the use in question only increased the capacity of that word to distinguish OL's services from those of other education providers by a very modest degree. I therefore find that the level of distinctive character of the word Oxbridge as a sign which distinguished OL's services at the relevant date was average or medium. In reaching this conclusion I have attached no weight to IQ's evidence about the registration of companies and trade marks including the word Oxbridge by third parties. This is because entries in registers do not show how many such names or marks were in use in the market prior to the relevant date. I have taken note of the use of Oxbridge by third parties described at paragraph 48 above. However, as the extent of such use prior to the relevant date is not clear, I have attached little weight to this evidence.

57. My findings as regards trade mark 3357627 also apply to the word OXBRIDGE in composite trade mark 3163319. Considering the distinctive character of that mark as a whole, I find that the stylized OX device to the left of the words Oxbridge Home Learning is at least as distinctive as the word element of the mark. However, there is nothing about the inherent character of the mark, or the extent of its use, which establishes that this mark was more than averagely distinctive at the relevant date.

## Comparison of marks

58. For ease of reference, the respective marks are shown below.

Earlier trade marks	Contested trade mark
 <p>OXBRIDGE</p>	

59. OL's best case is clearly based on its registration of the word Oxbridge under trade mark 3357627. I will therefore assess this first. It is clear from *Sabel BV v. Puma AG* 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 expanded on this in *Bimbo SA v OHIM*<sup>28</sup> stating 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.”*

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

60. Trade mark 3357627 consists solely of the word OXBRIDGE. The contested mark is a composite mark including a figurative element and the words OxbridgeIQ.

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<sup>28</sup> See paragraph 34 of the judgment in Case C-591/12P

The device of the figure using a white board has some visual impact. This is partly because it is more than negligible in size relative to the word element of the mark, and also because the device appears to the left of the word element and will, therefore, naturally strike the eye first to UK consumers, who tend to read from left to right. However, the device of a person teaching is descriptive in relation to tutoring services. Therefore, whilst the visual impact of the device element is more than negligible, the dominant and distinctive element of the earlier mark is the word element 'OxbridgeIQ'. The earlier mark makes up the first eight of the ten letters of the OxbridgeIQ. This creates a fairly high degree of visual similarity between the marks. OxbridgeIQ is clearly composed of two elements - Oxbridge and IQ conjoined. Despite coming at the end of the mark, I find that the '-IQ' element, or suffix, contributes significantly to the overall visual impression created by the contested mark. Overall, I find that there is a medium-to-high degree of visual similarity between the contested mark and trade mark 3357627. This is based solely on the common use of the word 'Oxbridge'.

61. The word OXBRIDGE is pronounced OX-BRIDGE. The same word in the contested mark will be pronounced in the same way. This creates a certain degree of aural similarity between the marks. The figurative element of the contested mark is unlikely to be expressed verbally. In the context of educational services, the last two letters of the contested mark (IQ) are likely to be recognised as an abbreviation for 'Intelligence Quota'. Therefore, this element of the contested mark will be spoken as individual letters rather than as a two-letter suffix (-iq). It follows that the contested mark will be verbally expressed as in OX-BRIDGE-AYE-QUEUE. This is noticeably longer than OX-BRIDGE alone. I conclude that the respective marks are aurally similar, but only to a medium degree.

62. In his skeleton argument on behalf of OL, Mr Beebe submitted that as the marks consist of, or contain, the word Oxbridge they are conceptually identical, or at least highly similar. The skeleton did not explain what this concept is. It can only be based on the dictionary meaning of Oxbridge, which refers to Oxford and Cambridge Universities together and/or their graduates. I accept that this meaning will be apparent to the public. However, in the contested mark the dictionary meaning of Oxbridge is qualified by the addition of the letters 'IQ'. I accept IQ's submission that

'OxbridgeIQ' clearly alludes to a person having the intelligence to gain entry to Oxford or Cambridge Universities, rather than to the universities themselves. Therefore, I find that the marks have different conceptual meanings and are only conceptually similar to a low degree, i.e. to the degree to which they bring to mind, in different contexts, Oxford and Cambridge Universities.

63. Turning to the comparison between the contested mark and composite trade mark 3163319, I find that this mark is less visually similar to the contested mark than trade mark 3357627. I find that it is no more similar from a conceptual perspective. My reasons are:

- (i) The earlier trade mark includes a highly stylised 'OX' device which is distinctive, catches the eye, and looks nothing like the device in the contested mark;
- (ii) The earlier trade mark includes the words 'Home Learning', which although descriptive are not negligible from a visual or aural perspective and have no counterpart in the contested mark;
- (iii) The words 'Home Learning' do not change the meaning of Oxbridge alone in a way that makes OXBRIDGE HOME LEARNING more similar in meaning to OxbridgeIQ.

64. In my view, trade mark 3357627 is visually and conceptually similar to the contested mark to only a low degree, and aurally similar to a medium degree.

#### Likelihood of confusion

65. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*<sup>29</sup> the CJEU stated that when assessing the likelihood of confusion under section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. This requires me to include in my assessment of the likelihood of confusion the effect of use of the contested mark in relation to the full range of *tutoring services*, from home learning services in relation to basic education

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<sup>29</sup> Case C-533/06, at paragraph 66 of the judgment

right up to *tutoring for Oxford and Cambridge applicants*. As I noted earlier, the level of attention paid by average consumers when selecting such educational services is likely to vary from ‘above average’ to ‘particularly high’, depending on their importance to the end user.

66. Bearing in mind the identity of the services in class 41, the medium to high degree of visual similarity between the contested mark and earlier trade mark 3357627, and the need to allow for a certain degree of imperfect recollection of the marks, I find that there is likely of direct confusion if the contested mark is used in relation to tutoring services for basic educational purposes. However, if the contested mark is used in relation to *Tutoring for Oxford and Cambridge University applicants*, I find that the high degree of attention likely to be paid by average consumers when selecting such services, and the greater role for aural use of the marks (where the -IQ element of the contested mark is less likely to be overlooked) in the selection process, will be sufficient to avoid any likelihood of direct confusion between the marks.

67. I recognise that an important part of OL’s case is that there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc.*,<sup>30</sup> 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*

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<sup>30</sup> Case BL O/375/10

*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.”*

*17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:*

*(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).*

*(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).*

*(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”*

68. OL’s case appears to be that the contested mark falls into scenarios (a) and/or (b) above. I reject this. My reasons are, firstly, that OXBRIDGE is not “*strikingly*”, or even highly, distinctive of OL’s educational services. The relevant public has no reason to believe that all trade marks including Oxbridge are likely to designate educational services provided by, or under the control of, OL. Secondly, I do not accept that ‘IQ’ is a non-distinctive addition to Oxbridge, like ‘worldwide’. Although it alludes to the nature of IQ’s tutoring services, these letters do not describe them. OxbridgeIQ does not give the impression of being a sub-brand of Oxbridge.

69. In *Duebros Limited v Heirler Cenovis GmbH*,<sup>31</sup> Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he

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<sup>31</sup> BL O/547/17



pointed out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion. This is the case here. I therefore reject OL's case based on indirect confusion with trade mark 3357627.

70. OL's section 5(2)(b) case based on earlier trade mark 3163319 is clearly weaker than its case based on trade mark 3357627. I reject it, with or without the specification amendment outlined in IQ's final written submissions.

### **Overall outcome**

71. I reject IQ's application to invalidate trade mark 3357627 under section 47(1) of the Act.

72. I reject OL's opposition to IQ's trade mark application under section 5(2)(b) based on earlier trade mark 3163319.

73. I uphold OL's opposition to IQ's trade mark application under section 5(2)(b) based on earlier trade mark 3357627 insofar as it is directed at the published specification.

74. In accordance with section 5A of the Act, I reject OL's opposition based on earlier trade mark 3357627 to the registration of the contested mark in relation to *Tutoring for Oxford and Cambridge University applicants*. IQ's mark will therefore be registered for (only) these services.

### **Costs**

75. OL has been more successful than IQ and is entitled to a contribution towards its costs, including the cost of defending IQ's application to invalidate trade mark 3357627. I will, however, take into account that OL's evidence of use of the earlier marks was also intended to show that the marks had acquired an enhanced level of distinctiveness through use (and failed to show it). I assess the costs due to OL as follows:

- i. £300 towards the cost of filing a counterstatement in the invalidation proceedings and preparing the notice of opposition;
- ii. £100 to cover the filing fee for the Form TM7;
- iii. £400 towards the cost of filing evidence and reviewing IQ's evidence;
- iv. £400 towards the cost of the hearing.

76. I therefore order George Cook and George Spooner, the partners in OxbridgeIQ to pay Oxbridge Limited the sum of £800 within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the final conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

**Dated 25<sup>th</sup> August 2021**

**Allan James**  
**For the Registrar**