

O/792/21

TRADE MARKS ACT 1994

**CONSOLIDATED PROCEEDINGS**

IN THE MATTER OF APPLICATION NOS. UK00003090962 AND UK00003086412

IN THE NAME OF WEST LONDON TAMIL SCHOOL

IN CLASSES 16, 35 AND 41

AND OPPOSITIONS THERETO UNDER NOS. 404157 AND 404147

BY ORIENTAL FINE ARTS ACADEMY OF LONDON

AND

IN THE MATTER OF APPLICATION NO. UK00003100347

IN THE NAME OF ORIENTAL FINE ARTS ACADEMY OF LONDON

IN CLASSES 9, 16 AND 41

AND OPPOSITION THERETO UNDER NO. 404839

BY WEST LONDON TAMIL SCHOOL

## BACKGROUND AND PLEADINGS

### THE OFAAL OPPOSITIONS

1. On 17 December 2014, West London Tamil School (“WLTS”) applied to register the trade mark **OFAAL** (no. 3086412) (“the First Application”) in the UK. The First Application was published for opposition purposes on 16 January 2015.

2. On 25 January 2015, WLTS applied to register the following trade mark in the UK (no. 3090962):



(“the Second Application”)

3. The Second Application was published for opposition purposes on 13 February 2015. For both the First and Second Application, registration is sought for the following goods and services:

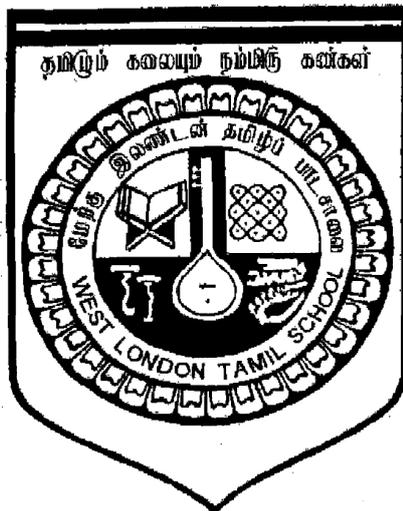
Class 16 Printed matter; syllabus books; theory books.

Class 35 Promotion services relating to musical concerts and orchestras; supply of music teachers.

Class 41 Conducting Oriental and South Asian fine arts and music practical and theory examinations; conducting conferences and training in music; education and training services; cultural activities; entertainment.

4. On 16 April 2015, Oriental Fine Arts Academy of London (“OFAAL”) opposed the First and Second Applications based upon sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”).

5. Under section 5(4)(a), OFAAL relies upon the following signs which it claims to have used throughout the UK since 1 April 1995 and 1 April 2011, respectively, in relation to “printed matter; educational services; examination board services”:



(“the First Earlier Sign”)



(“the Second Earlier Sign”)

6. Under section 3(6), OFAAL states:

“16. It is clear that by filing UK Trade Mark Application No. 3086412 and UK Trade Mark Application No. 3090962 the Applicant is attempting to obtain trade mark protection and trade on the repute and notoriety the Opponent has built up in relation to the OFAAL marks. The activities of the Applicant and the Applicant’s Organisation make clear that the Applicant must have been aware of the Opponent’s rights and that use by the Applicant and the Applicant’s Organisation would be liable to mislead the public as to the origin of the goods and services offered under the marks. The Applicant goes beyond what would

be considered “acceptable commercial behaviour” in a particular area. This must have been clear to the Applicant.”

7. WLTS filed counterstatements denying the claims made.

### **THE WLTS OPPOSITION**

8. On 20 March 2015, OFAAL applied to register the following trade mark (no. 3100347) in the UK:



(“the Third Application”)

9. The Third Application was published for opposition purposes on 8 May 2015. Registration is sought in relation to the following goods and services:

Class 9      Software; educational software; teaching apparatus and instruments; electronic teaching devices; electronic publications.

Class 16      Printed matter, syllabus books, theory books; books, instructional and teaching materials; posters; charts; printed sheet music.

Class 41 Conducting Oriental and South Asian fine arts and music practical and theory examinations; conducting conferences and training in music; education and training services; cultural activities; entertainment; publication services; publishing of electronic publications; provision of information relating to teaching, instruction, and education; teaching, instructional and educational services relating to Oriental and South Asian fine arts and music; publishing services provided by means of the internet and world wide web; conferral of education awards; arranging and conducting workshops, seminars, symposiums, conferences and congresses; teaching, lecturing and tutorial services; educational examinations; organisation of exhibitions and performances for education purposes; music concerts; orchestral performances and recitals; publication in both paper and electronic format of educational, instructional, training, teaching, testing, examination and assessment materials; courses relating to examination preparation; provision of educational examination facilities; design of educational courses, examinations, qualifications and tests; organisation of examinations to grade the level of achievement; curriculum development relating to the development and specification of standards, practise, syllabuses and accreditation systems to enable national and international assessment of candidates; assessment services.

10. On 7 August 2015, WLTS opposed the Third Application based upon sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Act. Under sections 5(2)(b) and 5(3), WLTS relies upon UK trade mark no. 3087988 for the following trade mark:



(“the 988 Mark”)

11. The 988 Mark was filed on 5 January 2015 and registered on 24 April 2015. WLTS relies upon all goods and services for which the 988 Mark is registered, namely:

Class 16 Books; theory books; printed matter; instructional and teaching material; artists' materials; all the aforesaid goods relating to Fine Arts, music, Tamil Language, Tamil culture.

Class 41 Education; provision of training; entertainment and cultural activities; arranging and conducting of conferences; all the aforesaid services relating to Tamil Language and Tamil culture.

12. Under section 5(2)(b), WLTS claims that the parties' respective marks and the goods and services are similar or identical, resulting in a likelihood of confusion.

13. Under section 5(3), WLTS claims that use of the 988 Mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the earlier marks.

14. Under section 5(4)(a), WLTS relies upon unregistered rights in the sign shown at paragraph **10** above, which it claims to have used throughout the UK (and Germany, France, Norway, Denmark and Holland) since 1 January 1995 in relation to:

“Class 16 – Books, theory books, printed matter, instructional and teaching material, artists' materials; all the aforesaid goods relating to fine arts, music, Tamil language or Tamil culture.

Class 41 – Education; provision of training; entertainment and cultural activities; arranging and conducting of conferences; all the aforesaid services relating to Tamil language or Tamil culture.”

15. Under section 3(6), WLTS states:

“[OFAAL] have demonstrated clear intentions of bad faith by competing to register the earlier right logo UK00003087988, due to the allegations brought against them by the members of West London Tamil School and OFAAL.

The Applicant further clearly intends to cause detrimental harm to both charities and its members by way of misleading the general public through false claims and actions.

1. As per the Charity Commission Stage One Review, para 16, it clearly states that the Applicant are not properly appointed trustees of OFAAL.
2. The Applicant have made illegal and fraudulent amendments to the charity’s Constitution documents without prior knowledge or approval of members. Charity Commission have also been misled and are still continuing to be misled by the Applicant.
3. The Applicant, as per the charity’s Constitution, do not qualify and thus are not eligible to be members or trustees of our charity OFAAL.
4. Due to the maladministration of the charity the Applicant have been dismissed as trustees by the membership at an OFAAL EGM held on 11 October 2014.”

16. OFAAL filed a counterstatement denying the claims made.

## **THE HEARING**

17. A hearing took place before me on **9 September 2021**, by video conference. OFAAL was represented by Mr Gwilym Harbottle of Counsel, instructed by Kilburn & Strode LLP. WLTS was self-represented. Both parties filed skeleton arguments in advance of the hearing.

## **EVIDENCE AND CROSS-EXAMINATION**

18. OFAAL filed the following evidence in chief:

- a. Two witness statements from Pathanchaly Navendren dated 1 September 2015 and 19 November 2020. Mr Navendren describes himself as a trustee of OFAAL.

- b. The witness statement of Mano Thiyagarajah dated 28 August 2015. Mr Thiyagarajah is the web administrator for OFAAL.
- c. The witness statement of Kandiah Rasanayagam dated 14 November 2020. Mr Rasanayagam has been a member of WLTS and OFAAL since 2004.

19. WLTS filed the following evidence in chief:

- a. The witness statement of Amirthalingam Nagarajah dated 4 January 2016. Mr Nagarajah has been a member of WLTS and OFAAL since 2005.
- b. The witness statement of Marshel Amutharasan dated 4 January 2016. Mr Amutharasan has been a member of WLTS and OFAAL since 1997.
- c. The witness statement of Mr Rasanayagam dated 3 January 2016. This is the same Mr Rasanayagam who later gave evidence on behalf of OFAAL, as above.

20. WLTS filed evidence in reply in the form of the witness statements of Mr Subramaniam Kugasenan Chettiar and Mr Nagarajah dated 12 January 2021 and 20 January 2021, respectively. Mr Chettiar has been a member of WLTS and OFAAL since 2004.

21. OFAAL elected not to file evidence in reply during the evidence rounds.

22. After the evidence rounds had concluded, OFAAL made an application to submit further evidence in the form of the third witness statement of Mr Navendren dated 14 May 2021. This statement was accompanied by 6 exhibits. This statement was relevant to the allegations of bad faith made by WLTS. I granted OFAAL's request to admit this further evidence and gave WLTS a period in which to file any evidence in reply to that statement.

23. WLTS filed evidence in reply in the form of the witness statement of Mr Nagarajah dated 1 July 2021. This was accompanied by 4 exhibits.

24. I have taken all of the evidence filed into account in reaching my decision. I do not propose to summarise it here, but will refer to it below where it is necessary to do so.

25. At the hearing, Mr Chettiar, Mr Nagarajah and Mr Amutharasan were cross-examined by Mr Harbottle. I found all of the witnesses to be honest, albeit they were all reluctant to give direct answers to any questions that they thought might harm their case. I will return to the evidence given under cross-examination where it is necessary to do so below.

## **PRELIMINARY ISSUE**

26. It was raised at the hearing, that one of the witnesses for OFAAL had approached a witness for WLTS, inviting them to withdraw their evidence. The witness in question, Mr Amutharasan, had refused to do so.

27. I explained to WLTS at the hearing that if they wished to report a criminal offence then they should refer the matter to the police. Otherwise, as Mr Amutharasan had not withdrawn his evidence and had confirmed that he wishes to continue as a witness in this case (and, indeed, proceeded to give evidence under cross-examination), I need comment upon this no further.

## **DECISION**

### **FINDINGS OF FACT**

28. It is convenient, at this stage, to outline some preliminary findings of fact that impact upon multiple aspects of this decision.

### **Is OFAAL a separate legal entity?**

29. Both parties agree that WLTS had been operating for many years as a Tamil School prior to OFAAL's creation. WLTS offered examinations for its pupils in the field of fine arts. In around 1994, both parties agree that WLTS started offering examinations to other Tamil schools under the name Oriental Fine Arts Academy of London.

30. A document from the Charity Commission entitled "Stage One Review" confirms that from 2000 onwards OFAAL began operating as a separate entity to WLTS.<sup>1</sup> This eventually led to OFAAL being granted independent charitable status in 2004, as confirmed by Mr Chettiar for WLTS and Mr Navendren for OFAAL. I find, therefore, that at least from 2004, OFAAL was operating as a separate legal entity from WLTS.

### **Does WLTS benefit from some form of ownership over OFAAL/its intellectual property rights?**

31. There can be no doubt that WLTS created the examination board called Oriental Fine Arts Academy of London. There has clearly been a long-standing belief held on the part of WLTS that it had retained some ownership of OFAAL. For example, a letter dated April 2008 from WLTS to parents of those attending the school stated: "OFAAL is a registered charity, though the ultimate owner of OFAAL is West London Tamil School". However, once OFAAL was established as an independent charity in 2004, there does not on the face of it appear to me to be any reason as to why WLTS would have retained any control or ownership over OFAAL and its assets.

32. There seem to be two key lines of argument on WLTS's part as to why it might retain some form of ownership over OFAAL/its intellectual property rights: 1) WLTS claims that OFAAL's constitution confers rights on WLTS and 2) WLTS claims that an agreement in 2003 confirmed WLTS's ownership of OFAAL. I will deal with each of these in turn.

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<sup>1</sup> Exhibit KR4

## OFAAL's constitution

33. There is no dispute that WLTS was originally responsible for creating OFAAL, as discussed above. However, at least by 2004, OFAAL had been established as an independent legal entity, by virtue of it being registered with the Charity Commission.

34. I do not think that there can be any doubt that prior to OFAAL's independence, any rights in the name OFAAL (or its associated trade marks) would have accrued to WLTS. At that point, OFAAL was nothing more than an alternative sign being used by WLTS under which to conduct its examination activities. I have no assignment before me to confirm that these rights were transferred to OFAAL upon its establishment as a separate legal entity. However, I am prepared to infer that such an assignment did take place; such an assignment would have been necessary to establish OFAAL's independence and to enable the charity to carry on its activities freely and independently under the name in which WLTS had previously accrued rights.

35. WLTS point to the terms of OFAAL's constitution, which they note lists WLTS as beneficiary upon OFAAL's dissolution. The parties dispute which constitution is the correct and valid one, however, I do not consider that this will materially affect my findings in this regard. The clauses in question state:

“13.1 The Oriental Fine Arts Academy of London may at any time be dissolved by a resolution by Ninety percentage majority of the total membership voting at a meeting of the school of which at least 21 days' notice shall have been sent to all the members of the school.

13.2 Any assets remaining on dissolution of Oriental Fine Arts Academy of London after satisfying any outstanding debts and liabilities shall be given only to WLTS. WLTS is the sole beneficial of the OFAAL.”<sup>2</sup>

And:

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<sup>2</sup> Exhibit KR8

“13.1 The Oriental Fine Arts Academy of London may at any time be dissolved by a resolution by Ninety percentage majority of the total membership voting at a meeting of the school of which at least 21 days’ notice shall have been sent to all the members of the school.

13.2 Any assets remaining on dissolution of Oriental Fine Arts Academy of London after satisfying any outstanding debts and liabilities shall be given only to WLTS.”<sup>3</sup>

36. The effect of both of this clause in both constitutions is the same i.e. to confirm that upon dissolution of OFAAL, any assets shall be transferred to WLTS. Clearly, if OFAAL were to be dissolved, then the benefit of any intellectual property rights would be transferred to WLTS. However, I do not consider that that gives WLTS any ownership of OFAAL (or its intellectual property rights) whilst OFAAL is still in existence.

37. WLTS also point to certain other clauses within the constitution. The first of these is the membership clause, which states:

### “3.0 MEMBERSHIP

3.1 Every Parent or Guardian of Pupils (under 18 years) attending the West London Tamil school hereinafter call (WLTS or school).

3.2 All permanent teaching staff of the school.

3.3 Any other person who accepts the school’s aims and objectives may be admitted as an associate or life member by the Trustees of OFAAL.

3.4 Such a member may be proposed and seconded by existing members.”<sup>4</sup>

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<sup>3</sup> Exhibit PN3

<sup>4</sup> Exhibit KR8

And:

### “3.0 MEMBERSHIP

3.1 Every Parent or Guardian of Pupils (under 18 years) attending the school for more than two terms continuously and their child/children must enroll and attend to one of the fine arts classes. Individual seeking to become a member must demonstrate to the Board of Governors that they are not anyway connected to the Oriental Examination Board of London or Oriental Examination Board London Ltd or any other institution connected or associated with these two institutions. It is the Trustees who make the final decision to admit the applicant as a full member of the Academy.

3.2 All permanent teaching staff of the school. Individual seeking to become a member must demonstrate to the Board of Governors that they are not anyway connected to the Oriental Examination Board of London or Oriental Examination Board London Ltd or any other institution connected or associated with these two institutions. It is the Trustees who makes the final decision to admit the applicant as a full member of the Academy.

3.3 Any other person who accepts the Academy’s aims and objectives may be admitted as an associate or life member by the Trustees of OFAAL. Individual seeking to become a member must demonstrate to the Board of Governors that they are not anyway connected to the Oriental Examination Board of London or Oriental Examination Board London Ltd or any other institution connected or associated with these two institutions. It is the Trustees who makes the final decision to admit the applicant as a full member of the Academy.

3.4 Such a member shall be proposed and seconded by existing members.”<sup>5</sup>

38. Clearly, the different constitutions put forward by the parties contain different wording as to membership. However, again, for the purposes of this decision, the

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<sup>5</sup> Exhibit PN3

difference has no material impact. The wording of both documents is clear; there is overlap between the members of WLTS and OFAAL. However, I do not consider that this confers any ownership on WLTS in relation to OFAAL or its intellectual property rights; these clauses do nothing more and nothing less than setting out the terms upon which one can become a member of OFAAL.

39. During the course of cross-examination, Mr Amutharasan pointed to the fact that the defined term “school” also appears in other parts of the 2003 constitution, such as in the provisions regarding the Annual General Meeting. However, again, I see nothing in the use (or absence of use) of this defined term throughout the constitutions which confers any proprietary rights on WLTS. Further, Mr Amutharasan pointed to clause 8 of the 2003 constitution which states:

“The Board of Governors shall be the Trustees of the school”.

Clearly, the effect of this clause is to ensure that the Board of Governors for OFAAL consists of trustees of WLTS. However, intellectual property rights would not be owned by trustees. WLTS and OFAAL are registered charities and independent legal entities. The fact that there may be overlap in trustees/Board of Governors does not confer any proprietary rights on WLTS.

40. Similarly, Mr Chettiar referred to clause 10 of the 2003 constitution. In particular, he notes the following clause:

“10.4 The funds of OFAAL shall be only used for the purpose of the school [...]”

The Charity Commission has expressed its concerns over the closeness of the tie between the two entities in circumstances in which they are independent.<sup>6</sup> However, that is not a matter for this Tribunal; suffice to say that whilst this may indicate how funds raised by OFAAL should be used, it does not indicate how any intellectual property should be owned.

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<sup>6</sup> Exhibit KR4

## The Written Agreement

41. The document in question can be found at Exhibit MA1. The exhibit contains a letter from Rosenblatt Solicitors to an individual called Ms Briffa dated 27 August 2003 and two pages of an agreement (pages 3 and 4). It is not clear what relationship Ms Briffa has with the parties in these proceedings, if any, and it is not immediately clear who Rosenblatt Solicitors were acting for. Under cross-examination, the witnesses all agreed that this document had been obtained after this dispute had arisen from an individual who had had previous involvement in WLTS. Mr Amutharasan confirmed during cross-examination that these pages were given together as one document, although they were not actually joined together (by a staple or any other means).

42. The letter states as follows:

“We are instructed as follows (adopting the numbering in the Settlement Agreement): -

3.1.3 Mrs [X], Mr [Y] and/or the directors of the Oriental Fine Arts Academy of London Limited and Oriental Fine Arts Academy Limited have failed to transfer the ownership of the companies to West London Tamil School whether by 25 March 2003 or at all;

3.1.10 +

3.1.11 No documentation belonging to our client, whether copies of the WLTS database or the OFAAL database and/or confidential information, or documentation (in whatever media) incorporating the names Oriental Fine Arts Academy of London Limited, Oriental Fine Arts Academy Limited and/or Oriental Fine Arts Examination Board London or incorporating the acronym “OFAAL” have been delivered up whether by 21 April 2003 or at all;

[...]

We are instructed that unless your clients comply with their obligations pursuant to the Settlement Agreement, and remedy the breaches identified above by

effecting the appropriate transfer, delivering up relevant documentation that our client will issue proceedings.”

43. As noted above, only two pages of the agreement are provided. It is not, in my view, necessary to look in any detail at the content of the document. There are clearly issues with it that mean it cannot be of assistance to WLTS for the purposes of proving some ownership of OFAAL or OFAAL’s intellectual property rights as at the relevant dates for the purposes of these proceedings. The issues are:

- a. No information is visible within the pages provided as to who the parties were to the agreement. Clearly, it seems that WLTS were involved. However, as noted in the above letter, the only other entities mentioned are limited companies. I note that this agreement was signed the year before OFAAL was registered with the Charity Commission;
- b. No signature page is provided and so it is not possible to determine whether the agreement was actually executed; and
- c. The agreement cannot possibly shed light upon the ownership of intellectual property rights in the name Oriental Fine Arts Academy of London or the acronym OFAAL as at the relevant dates. It is dated prior to OFAAL’s registration and the position may very well have (and, in my view, is likely to have) changed after OFAAL’s registration as an independent charity.

44. Consequently, I do not consider this document confers any rights on WLTS with regard to the ownership of OFAAL or its intellectual property.

## **THE OFAAL OPPOSITIONS**

### **Section 5(4)(a)**

45. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

46. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

### **Relevant date**

47. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-

410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

48. The prima facie relevant date is the date of application for the contested marks i.e. 17 December 2014 for the First Application and 25 January 2015 for the Second Application. However, as noted above, WLTS claims to have been using the marks prior to the application dates and also claims to be able to benefit from any use made of those marks by OFAAL.

49. There is very limited evidence of WLTS’s use of the First Application and the Second Application prior to the application dates. Although WLTS clearly used the words Oriental Fine Arts Academy of London from as early as 1994, it is not clear to me to what extent it used the acronym prior to the registration of OFAAL as an independent charity. Further, there is no evidence of use of the logo mark prior to 2011. In any event, as noted above, there must have been some implied assignment of any rights accrued by WLTS under the name Oriental Fine Arts Academy of London up until 2004 when OFAAL was established as an independent charity. After that time, there is nothing to suggest that any rights in the name Oriental Fine Arts Academy of London, OFAAL or its associated logo would have accrued to WLTS rather than OFAAL itself. In these circumstances, I do not consider that WLTS’s use of these signs prior to 2004 would have prevented OFAAL from asserting a passing off right, if WLTS had resumed use of the signs on its own account at the dates of application.

## Goodwill

50. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

51. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

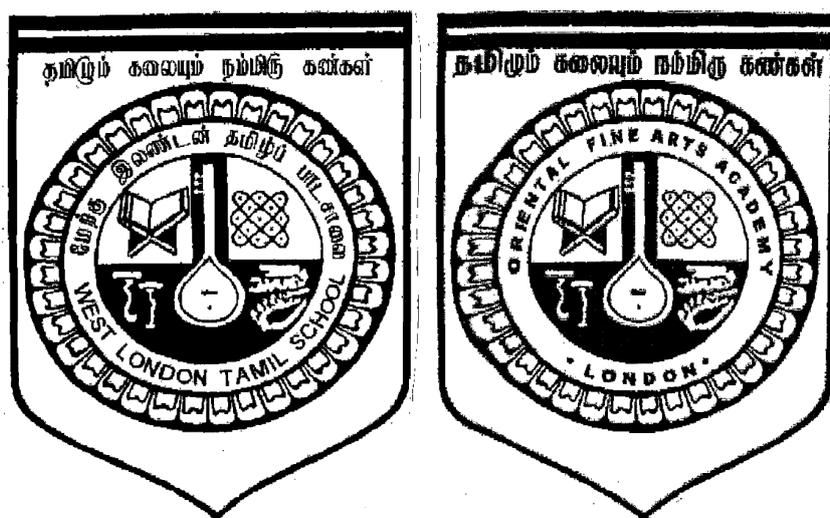
“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

52. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent’s reputation extends to the goods comprised in the application in the applicant’s specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

53. I remind myself that under this ground, OFAAL relies upon the following signs:



(“the First Earlier Sign”)

(“the Second Earlier Sign”)

54. OFAAL has provided a list of the number of students to whom OFAAL has issued results between the years 2000 and 2010 in the UK being 857 in 2000, 716 in 2001, 1254 in 2002, 1172 in 2003, 1312 in 2004, 1537 in 2005, 1905 in 2006, 2500 in 2007, 3074 in 2008, 2478 in 2009 and 3478 in 2010.<sup>7</sup> I also note that “admissions” figures (presumably the number of pupils admitted to the OFAAL examination programme)

<sup>7</sup> Exhibit PN2

have also been provided for the subsequent years being 3559 in 2011, 4697 in 2012, 4987 in 2013 and 4625 in 2014.

55. Examination certificates from 1995 to 2008 display both the words ORIENTAL FINE ARTS ACADEMY LONDON and the following sign:



56. Mr Navendren notes that the certificates up to 1998 display the words “Oriental Fine Arts Academy London is part of West London Tamil School”. However, from 1999 onwards, this was removed in line with attempts to make OFAAL more independent.

57. Various examination papers have also been provided.<sup>8</sup> One paper dated 1999 displays the words ORIENTAL FINE ARTS ACADEMY LONDON and WEST LONDON TAMIL SCHOOL, along with the device mark shown above. The same is also true of a selection of papers dated between 2000 and 2014. The examination papers for 2014 also display the word OFAAL. A number of papers from 2000 and 2005 refer to ORIENTAL FINE ARTS ACADEMY only.

58. OFAAL operates a number of websites with the word OFAAL contained within the domain name.

59. Mr Navendren gives evidence that the following mark was first adopted by OFAAL in April 2011:

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<sup>8</sup> Exhibit PN7 and PN22



60. However, evidence of this sign in use is limited. I note that it was used on two examination certificates dated 2013 and 2014.<sup>9</sup>

61. It is clear to me from the number of pupils engaging with the examinations offered by OFAAL over a lengthy period of time that it had a reasonable degree of goodwill as a charity and in the provision of educational examinations at the prima facie relevant dates. The name Oriental Fine Arts Academy of London has clearly been used on examination papers and certificates for a number of years.

62. With regard to the First Earlier Sign, I do not consider that OFAAL have established that that sign was distinctive of its goodwill. The First Earlier Sign contains the words West London Tamil School and I see no reason as to why a sign bearing the name of a different entity would have been distinctive of OFAAL. The sign may have been used on examination papers and certificates in conjunction with OFAAL's name or logo, but that does nothing more than demonstrate collaboration between the two entities and, to my mind, gives OFAAL no rights to that sign. The use of that sign by WLTS clearly pre-dates OFAAL's creation as a separate legal entity and any use that OFAAL has made of that sign is likely to have been made with WLTS's consent (particularly given their ongoing connection).

63. With regard to the Second Earlier Sign, I recognise that the evidence of use before me is limited. However, it is overwhelmingly clear from the evidence that the words Oriental Fine Arts Academy London have been used by OFAAL to distinguish its

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<sup>9</sup> PN23

goods/services since 2004. These words are plainly visible within the Second Earlier Sign. Consequently, I consider the Second Earlier Sign was distinctive of OFAAL's goodwill at the relevant dates in 2014/15 because it includes OFAAL's name.

### **Misrepresentation and damage**

64. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

65. *Halsbury's Laws of England* Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309, it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

66. I will begin by assessing the position in relation to the Second Application i.e. WLTS’s application for the logo mark. Clearly, this sign is identical to the Second Earlier Sign which I have found to be distinctive of OFAAL’s goodwill. I have found OFAAL had a reasonable degree of goodwill at the relevant dates in 2014/15.

67. The provision of educational examinations is clearly within the same field of activity as “conducting Oriental and South Asian fine arts and music practical and theory examinations”, “conducting conferences and training in music” and “education and training services” in class 41 of the applied-for specification. I also consider that there will be significant overlap in fields of activity with “printed matter; syllabus books; theory books” in class 16 and “supply of music teachers” in class 35 of the applied-for specification.

68. That leaves “promotion services relating to musical concerns and orchestras” in class 35 and “cultural activities” and “entertainment” in class 41 of the applied-for specification. “Cultural activities” is a very broad term that could cover any number of things. I consider that there is likely to be reasonable overlap in fields of activity covered by this term and OFAAL’s activities which are within the field of fine arts and music. With regard to “promotion services relating to musical concerts and orchestras” and “entertainment” services, I also consider that there is some overlap in fields of activity; OFAAL’s educational activities within the field of fine arts and music enable entertainers to show that they are competent to perform to a certain level.

69. In my view, given that it is identical to the sign I have found to be distinctive of OFAAL’s goodwill, there is a likelihood that a substantial number of members of the

relevant public would be deceived by the use of the Second Application in relation to goods and services which share some overlap in fields of activity with OFAAL's activities. Given the overlap in fields of activity, damage through diversion of customers is clearly foreseeable. Additionally, or in the alternative, there would be a misrepresentation which would be liable to damage OFAAL's goodwill through loss of control of its reputation in relation to all of the applied-for services, which is an established head of damage under passing off law. As Warrington LJ stated in *Ewing v Buttercup Margarine Company, Limited*:

"To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me."<sup>10</sup>

For example, entertainers or promoters using OFAAL's name in relation to musical concerts are likely to be understood to be claiming that the performers have passed the OFAAL exams. If untrue, this misrepresentation would be damaging to OFAAL's goodwill.

70. The opposition against the Second Application based upon section 5(4)(a) is successful in its entirety.

71. With regard to the First Application, the same factors apply with the exception of the similarity between the applied-for mark and the sign relied upon. The First Application is for the letters OFAAL only. The only overlap between the First Application and the Second Earlier Sign is that the first letter of each word in the Second Earlier Sign appears in the First Application i.e. OFAAL. The words themselves are absent, as is the logo device. Consequently, I consider the mark and the sign relied on to be dissimilar or, at best, similar to a very low degree. Given the distance between the signs, I consider that this will be sufficient to avoid misrepresentation occurring, even when used in identical fields of activity. For the

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<sup>10</sup> [1917] 2 Ch. 1 (COA)

avoidance of doubt, my finding would have been the same as above had OFAAL relied upon the acronym 'OFAAL' as a sign distinctive of its goodwill under this ground.

72. The opposition against the First Application based upon section 5(4)(a) is, therefore, unsuccessful in its entirety.

### **Section 3(6)**

73. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

74. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. It summarised the law as follows:

“68. The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].

2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined

by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]".

75. The correct approach to the assessment of bad faith claims is as follows. According to *Alexander Trade Mark*, the key questions for determination in such a case are:

(a) What, in concrete terms, was the objective that the trade mark applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

76. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

77. In this case, the relevant dates are the dates of application for the contested marks i.e. 17 December 2014 for the First Application and 25 January 2015 for the Second Application.

78. OFAAL claims that WLTS had prior knowledge that the applied-for marks were associated with OFAAL and that its action in applying to register the marks was intended to take advantage of the reputation built up over the years by OFAAL.

79. The First and Second Applications were applied-for by Abdul Samad. They were assigned to WLTS on 14 March 2015. In its skeleton argument, WLTS states:

“3. (a) As both member of WLTS/OFAAL, Mr Samad was entrusted to deal with not only the trade mark applications for OFAAL but also for WLTS which were later transferred to WLTS on his youngest child leaving WLTS [...]”.

80. OFAAL disputes that Mr Samad had any authority to act on its behalf in making applications for trade marks. This claim was made in WLTS’s skeleton argument and was not accompanied by a statement of truth. There is no evidence before me to suggest that Mr Samad had authority to act on OFAAL’s behalf in making these applications. However, the above wording makes it clear that WLTS clearly does not dispute that Mr Samad was acting with the authority of WLTS in making the applications in question. This is confirmed in WLTS’s counterstatement, which states as follows:

“10. In December 2014, the West London Tamil School governing board decided to re-register the expired marks UK00002320078 and

UK00002320309, after having attempted to reinstate it, and since both had expired as of January 2013.

11. Upon making the enquiry with the IPO office in December 2014, IPO advisors had confirmed to Mr Abdul Samad that neither of the marks, UK00002320309 and UK00002320078 can be further reinstated, as they had been dead and removed from the register. The advisor then further confirmed to Mr Abdul Samad that anyone was eligible to apply for the registration of the two marks. The figurative mark UK00003090962 was also applied to be registered. To this end, Mr Abdul Samad was appointed as representative to deal with all aspects of trademark registrations on behalf of the charity.”

81. WLTS plainly had knowledge of OFAAL’s activities as an examination board. WLTS does not dispute that OFAAL was established as an independent charity in 2004. WLTS made the decision to establish OFAAL as an independent body and were clearly instrumental in ensuring that that independence was achieved. It seems to me that it plainly gives rise to a prima facie case of bad faith for an agent, acting on behalf of WLTS, to have applied for trade marks which it knows belong to another charity with which it has a long-standing relationship.

82. Mr Chettiar submitted at the hearing that all WLTS was trying to achieve by applying for the trade marks in question was to regularise its ownership of trade marks held prior to the creation of OFAAL as an independent charity. In this regard, I note that WLTS points to a previous trade mark for the sign OFAAL which was filed and registered in 2003 (UKTM no. 2320078). WLTS states that WLTS applied for this trade mark and this demonstrates an intention to retain control over OFAAL’s property rights. However, the trade mark in question was, in fact, registered in the name of OFAAL, not WLTS. Further, WLTS claims that it was entitled to apply for the trade marks because it had retained ownership over OFAAL/its intellectual property rights. I have found that not to be the case for the reasons set out above. Indeed, I find this explanation to be contradictory with WLTS’s own actions in seeking to ensure OFAAL’s independence. In my view, this explanation does not rebut the prima facie case of bad faith established by OFAAL.

83. For these reasons, the oppositions against the First and Second Applications based upon section 3(6) of the Act succeed in their entirety.

## **THE WLTS OPPOSITION**

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

84. Section 5(2)(b) of the Act reads as follows:

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

(a)...

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

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

85. By virtue of its earlier filing date, the 988 Mark qualifies as an earlier trade mark pursuant to section 6 of the Act. As the 988 Mark had not completed its registration process before the publication date of the mark in issue, it is not subject to proof of use pursuant to section 6A of the Act. WLTS can, therefore, rely upon all of the goods and services identified.

### **Section 5(2)(b) – case law**

86. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia*

*Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, is not sufficient;

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

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

### Comparison of goods and services

87. The competing goods and services are as follows:

<b>WLTS's goods and services (the opponent)</b>	<b>OFAAL's goods and services (the applicant)</b>
<u>Class 16</u> Books; theory books; printed matter; instructional and teaching material; artists' materials; all the aforesaid goods relating to Fine Arts, music, Tamil Language, Tamil culture.	<u>Class 9</u> Software; educational software; teaching apparatus and instruments; electronic teaching devices; electronic publications.
<u>Class 41</u> Education; provision of training; entertainment and cultural activities; arranging and conducting of conferences; all the aforesaid services	<u>Class 16</u> Printed matter, syllabus books, theory books; books, instructional and teaching materials; posters; charts; printed sheet music.
	<u>Class 41</u>

<p>relating to Tamil Language and Tamil culture.</p>	<p>Conducting Oriental and South Asian fine arts and music practical and theory examinations; conducting conferences and training in music; education and training services; cultural activities; entertainment; publication services; publishing of electronic publications; provision of information relating to teaching, instruction, and education; teaching, instructional and educational services relating to Oriental and South Asian fine arts and music; publishing services provided by means of the internet and world wide web; conferral of education awards; arranging and conducting workshops, seminars, symposiums, conferences and congresses; teaching, lecturing and tutorial services; educational examinations; organisation of exhibitions and performances for education purposes; music concerts; orchestral performances and recitals; publication in both paper and electronic format of educational, instructional, training, teaching, testing, examination and assessment materials; courses relating to examination preparation; provision of educational examination facilities; design of educational courses, examinations, qualifications and tests; organisation of examinations to grade the level of achievement; curriculum</p>
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	development relating to the development and specification of standards, practise, syllabuses and accreditation systems to enable national and international assessment of candidates; assessment services.
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88. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

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

89. In the *Treat* case, [1996] R.P.C. 281, Jacob J. (as he then was) identified the following factors for assessing similarity:

- (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.

90. In reaching my findings below, I have borne in mind that WLTS's specification is limited to those goods and services "relating to Fine Arts, music, Tamil Language, Tamil culture" and have factored this into my findings.

### Class 9

#### *Software; educational software*

91. These terms in OFAAL's specification could both include goods sold by educational institutions to support their educational services. Consequently, there is overlap in trade channels with "education" in WLTS's specification. There will also be overlap in user, as both may be purchased by members of the general public. The goods and services will differ in nature and method of use. There will be overlap in purpose, as both may be used for educational purposes. There may be a degree of competition, as users may choose to sign up to, for example, an online course or decide to purchase software which could deliver the equivalent training. Taking all of this into account, I consider the goods and services to be similar to between a low and medium degree.

92. I also consider the same overlap in trade channels, purpose and user will apply in relation to "instructional and teaching materials" in WLTS's specification. There will also be the same competition, as users may either purchase hard copy instructional and teaching materials such as books or information sheets, or they may purchase software which provides access to the same information on a computer or device. However, I recognise that the goods will still differ in nature and method of use. Taking all of this into account, I consider the goods to be similar to between a low and medium degree.

### *Teaching apparatus and instruments; electronic teaching devices*

93. These terms in class 9 of OFAAL's specification will differ from "instructional and teaching material" in WLTS's specification as the latter will be in the form of printed matter as opposed to technical apparatus by virtue of their inclusion in different classes. However, there will still be overlap in user, purpose and trade channels. I recognise that the method of use of the goods is likely to differ. However, there may be a degree of competition between different types of teaching materials and instruments. Taking all of this into account, I consider the goods to be similar to between a low and medium degree.

### *Electronic publications*

94. This term will overlap in purpose with "books" in WLTS's specification as one is simply the electronic form of the other. For that reason, there will also be overlap in user. There will be overlap in method of use to the extent that both will be read by the user, although I recognise that the way in which this is done may differ, with one being read in hard copy and the other being read through an electronic device. The nature of the goods will clearly differ. However, there is likely to be overlap in trade channels. There will also be significant competition between the goods. Taking all of this into account, I consider the goods to be similar to between a medium and high degree.

### Class 16

*Printed matter, syllabus books, theory books; books, instructional and teaching materials.*

95. I recognise that these terms in OFAAL's specifications will be broader than their equivalent terms in WLTS's specification by virtue of the limitation referred to above included in the latter. However, they will still be identical on the principle outlined in *Meric* to the terms "books; theory books; printed matter; instructional and teaching materials [...] all of the aforesaid goods relating to Fine Arts, music, Tamil language, Tamil culture" in WLTS's specification.

*Poster; charts; printed sheet music*

96. These terms in OFAAL's specification are all identical on the principle outlined in *Meric* to "printed matter" in WLTS's specification, notwithstanding the above mentioned limitation.

#### Class 41

*Conducting Oriental and South Asian fine arts and music practical and theory examinations; education and training services; provision of information relating to teaching, instruction, and education; teaching, instructional and educational services relating to Oriental and South Asian fine arts and music; conferral of education awards; teaching, lecturing and tutorial services; educational examinations; courses relating to examination preparation; provision of educational examination facilities; design of educational courses, examinations, qualifications and tests; organisation of examinations to grade the level of achievement; curriculum development relating to the development and specification of standards, practise, syllabuses and accreditation systems to enable national and international assessment of candidates; assessment services.*

97. These terms will all be self-evidently identical or identical on the principle outlined in *Meric* to "education" in WLTS's specification, notwithstanding the above-mentioned limitation. Even if I am wrong in that finding, there will be overlap in user, purpose, nature, method of use and trade channels and the services will be highly similar.

*Conducting conferences and training in music; arranging and conducting workshops, seminars, symposiums, conferences and congresses.*

98. These terms are self-evidently identical or identical on the principle outlined in *Meric* to "arranging and conducting of conferences" in WLTS's specification, notwithstanding the above-mentioned limitation. Even if I am wrong in that finding, there will be overlap in user, purpose, nature, method of use and trade channels and the services will be highly similar.

*Cultural activities;*

99. This term is identical on the principle outlined in *Meric* to the term “entertainment and cultural activities” in WLTS’s specification, notwithstanding the above-mentioned limitation.

*Entertainment; music concerts; orchestral performances and recitals;*

100. These terms are identical on the principle outlined in *Meric* to “entertainment and cultural activities” in WLTS’s specification, notwithstanding the above-mentioned limitation.

*Organisation of exhibitions and performances for education purposes;*

101. This term is identical on the principle outlined in *Meric* to the terms “education” and “arranging and conducting of conferences” in WLTS’s specification, notwithstanding the above limitation. If I am wrong in this finding, then there will be overlap in user, use, method of use, nature and trade channels and the services will be highly similar.

*Publication services; publishing of electronic publications; publishing services provided by means of the internet and world wide web; publication in both paper and electronic format of educational, instructional, training, teaching, testing, examination and assessment materials;*

102. These services will overlap in trade channels with “books” and “instructional and teaching material” in WLTS’s specification. The same businesses that provide publishing services will also be responsible for the goods provided through that service. The goods and services will clearly differ in nature, method of use and purpose. However, there will be overlap in user. There will also be complementarity as the goods and services are important or indispensable, such that the average consumer would consider that they originate from the same undertaking. Consequently, I consider the goods and services to be similar to a medium degree.

## **The average consumer and the nature of the purchasing act**

103. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

104. The average consumer for the goods and services is likely to be a member of the general public. I recognise that the level of attention is likely to vary. For example, in relation to posters, the average consumer is likely to pay less attention given the low cost nature of the goods than in relation to educational services which may be expensive and important to the user's career. However, I also recognise that even within the context of some of these terms, such as education, the level of attention may vary depending on the type of service purchased, from recreational educational courses to post-graduate degrees. Taking all of this into account, I consider that the level of attention paid is likely to vary from between low and medium to high.

105. The goods are likely to be self-selected from the shelves of a retail outlet or online equivalent. The services are likely to be purchased following perusal of advertisements, websites or physical premises. Consequently, I consider that visual considerations will dominate the purchasing process. However, I do not discount an aural component to the purchase given that word-of-mouth recommendations may be given or advice may be sought from retail assistants.

## Comparison of trade marks

106. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

107. 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.

108. The respective marks are shown below:

<b>WLTS's 988 Mark (the opponent)</b>	<b>OFAAL's trade mark (the applicant)</b>
 The logo for WLTS's 988 Mark is a shield-shaped emblem. At the top, it features the Tamil text 'தமிழ் கலை நம்மிரு கண்கள்'. Below this is a circular border containing the text 'Oriental Fine Arts Academy' and 'West London Tamil School'. The central part of the emblem contains a stylized figure holding a book and a pen, with a scale of justice and a hand holding a quill pen also visible.	 The logo for OFAAL's trade mark is a shield-shaped emblem. At the top, it features the Tamil text 'தமிழும் கலையும் நம்மிரு கண்கள்'. Below this is a circular border containing the text 'ORIENTAL FINE ARTS ACADEMY' and 'LONDON'. The central part of the emblem contains a stylized figure holding a book and a pen, with a scale of justice and a hand holding a quill pen also visible.

## Overall Impression

109. OFAAL's mark consists of a circular device on a banner shaped background. Inside the decorative outer ring of the circular device, is another circle containing the words "ORIENTAL FINE ARTS ACADEMY LONDON". Within that circle is a third circle containing various smaller devices, including a device described as a musical instrument. At the top of the banner device is a series of foreign language words. The overall impression of the mark lies in the combination of these elements.

110. WLTS's mark consists of the same device. However, inside the middle circle are a series of foreign language words and the English language words WEST LONDON TAMIL SCHOOL. At the top of the banner device is another series of foreign language words. The overall impression of the mark lies in the combination of these elements.

111. In reaching these findings, I have borne in mind Mr Harbottle's submissions that some of the decorative elements are non-distinctive. For example, Mr Harbottle submitted that the musical instrument device simply illustrates the field within which OFAAL's examinations are conducted. However, the combination of these device elements is quite striking and given their size in comparison with the wording, I consider that the overall impression of both marks lies in the combination of the text and device elements.

## Visual Comparison

112. Visually, Mr Harbottle accepted that the graphic elements of the marks are the same. The only point of difference between the marks is the words contained within them. In WLTS's mark, this circle contains a series of foreign language words and the words WEST LONDON TAMIL SCHOOL and in OFAAL's mark it contains the words ORIENTAL FINE ARTS ACADEMY LONDON. Clearly, these will act as a point of visual difference. The foreign language words at the top of the device also differ. I note that whilst the eye is naturally drawn to the elements of marks that can be read, the wording in these marks is relatively small when compared to the mark as a whole. Taking all of this into account, I consider the marks to be visually similar to between a medium and high degree.

### Aural Comparison

113. Aurally, the only element of OFAAL's mark that is likely to be pronounced is the words ORIENTAL FINE ARTS ACADEMY LONDON. The only element of WLTS's mark that is likely to be pronounced by the average consumer is the words WEST LONDON TAMIL SCHOOL. The only point of aural overlap is the pronunciation of the word LONDON, which will be identical in both marks. Taking all of this into account, I consider the marks to be aurally similar to a very low degree.

### Conceptual Comparison

114. Conceptually, I do not consider that any meaning will be derived from the devices in the marks. I consider that the words ORIENTAL FINE ARTS ACADEMY LONDON in OFAAL's mark is likely to convey the meaning of a school based in London specialising in oriental fine arts. I consider that the words WEST LONDON TAMIL SCHOOL in WLTS's mark will convey the meaning of a school for Tamil studies based in West London. To the extent that both refer to educational institutions based in London there will be conceptual overlap, but I consider this to be limited given they clearly refer to different institutions. Taking all of this into account, I consider the marks to be conceptually similar to between a low and medium degree.

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

115. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, 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).”

116. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

117. I will begin by assessing the inherent distinctiveness of the 988 Mark. I recognise that the words WEST LONDON TAMIL SCHOOL are not in themselves particularly distinctive. They convey a clear meaning of a school based in West London which specialises in Tamil studies. Certainly for educational services and goods, this not be particularly distinctive. However, the mark as a whole is a complex device mark, of which these words are only one element. Taking the mark as a whole into account, I consider the 988 Mark to be inherently distinctive to between a medium and high degree.

118. At the hearing, Mr Harbottle submitted that the evidence is insufficient to establish enhanced distinctiveness of the earlier mark. I agree that the evidence filed by WLTS in relation to its use of the 988 Mark is limited. There is a prospectus from 2005 which displays the mark, along with a number of certificates issued to those successful in

examinations between 2005 and 2010.<sup>11</sup> I also bear in mind that there are examples of the mark being used (as set out above) included in OFAAL's evidence. I recognise that, as a charity, WLTS is unlikely to be able to provide market share or turnover figures as might be expected of a trading business. However, I would still expect to see evidence about what steps WLTS has taken to promote its services under the sign and how many members/students the charity has year to year. Whilst some limited information has been provided in this regard, it is only provided for one year and of a small scale. It also appears that use of the mark has been relatively limited in terms of geographical spread, as there appears to be only one location each year from which the school is run. Taking all of this into account, I am not satisfied that WLTS has established that the distinctiveness of the earlier mark has been enhanced through use.

### **Likelihood of confusion**

119. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors have to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

120. I have found the marks to be visually similar to between a medium and high degree, aurally similar to a very low degree and conceptually similar to between a low

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<sup>11</sup> Exhibit KR2 and AN9

and medium degree. I have found the earlier mark to be inherently distinctive to between a medium and high degree. I have identified the average consumer to be a member of the general public who will purchase the goods and services primarily by visual means (although I do not discount an aural component). I have found that between a low and medium and a high degree of attention will be paid during the purchasing process. I have found the goods and services to vary from being similar to between a low and medium degree to identical.

121. I recognise that the word elements of the respective devices are different. However, I also recognise that the marks as a whole are visually similar to between a medium and high degree and that the purchasing process will be predominantly visual. In my view, the identity of the remaining elements of the marks will lead the average consumer to conclude that these are alternative marks being used by the same or economically linked undertakings. Consequently, I consider there to be a likelihood of indirect confusion.

122. In my view, these findings of direct and indirect confusion will apply even where there is only between a low and medium degree of similarity between the goods and services, due to the application of the interdependency principle.

123. In reaching this conclusion, I have borne in mind Mr Harbottle's submission at the hearing that the marks have coexisted in the marketplace for a long time without confusion arising. However, I do not consider that submission to be of assistance to OFAAL. Firstly, the logo mark which is the subject of this opposition was only introduced in 2011 (around 4 years prior to the relevant date, not 2004 when OFAAL became independent). Secondly, it is not uncommon for customers to be confused without realising it, thus their confusion is never reported to the parties concerned. Thirdly, the parties appear to have worked in collaboration for a number of years, so a perception that they were connected (in the sense of working together) would have been correct. However, as that no longer appears to be the case, going forward, there is no reason why it should be so.

124. The opposition against the Third Application based upon section 5(2)(b) succeeds in its entirety.

### **Section 5(3)**

125. Section 5(3) of the Act states:

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

126. I can deal with this ground relatively swiftly. The first requirement for a successful opposition based upon section 5(3) is that WLTS must establish that the 988 Mark had a reputation at the relevant date i.e. the date of the application in issue. However, as noted above, very little evidence has been filed by WLTS to demonstrate the extent to which they have used the mark. I have no consistent information regarding yearly member/student figures and no information about what steps WLTS has taken to promote its mark. In the absence of information of this nature, I am not satisfied that WLTS has proved the necessary reputation.

127. The opposition against the Third Application based upon section 5(3) is dismissed in its entirety.

### **Section 5(4)(a)**

128. I do not consider that WLTS's section 5(4)(a) ground adds anything over and above its section 5(2)(b) case, which I have found in its favour. Consequently, I decline to consider this ground any further.

### **Section 3(6)**

129. I have set out the law in relation to section 3(6) above. I do not propose to repeat it here, but have taken it into consideration in reaching my conclusions.

130. I have set out WLTS's claim under this ground, as pleaded, above. The main thrust of the claim is that those applying for the mark in issue were not properly appointed trustees of OFAAL and, consequently, were not able to make the application and/or did so with an intention to harm OFAAL and/or WLTS.

131. This ground of opposition has generated much debate throughout the course of these proceedings as to who the correct trustees are and whether the Charity Commission has been misled as to the identity of those trustees. Indeed, much of the evidence from WLTS seems to have focused upon this aspect of the case. At the hearing, WLTS accepted that, given the applications have been made in the name of OFAAL (not any individual trustees), the identity of the trustees is not relevant. In my view, that was a sensible concession to make. Clearly, this Tribunal is not the correct body to decide whether trustees have been properly appointed or, indeed, who those trustees should be and I consider this ground of opposition to be misguided. The Third Application has been made in the name of OFAAL. It is, therefore, the property of the charity, not any individuals. Whether the correct trustees were in place at the time of filing, or whether the identity of those trustees has since changed, is not relevant; the mark will remain the property of OFAAL. Consequently, I do not consider that WLTS has established a prima facie case of bad faith.

132. I note that in its skeleton argument and at the hearing, various comments were made by WLTS regarding ways in which OFAAL's conduct during the course of these proceedings might be taken to amount to bad faith. Any such conduct is outside of the scope of WLTS's pleaded case. In any event, for the purposes of determining whether the application was filed in bad faith the relevant date is the date of application, as set out above. OFAAL's conduct of these proceedings does not, in my view, cast light back upon the position at that date and is not, therefore, relevant.

133. The opposition against the Third Application based upon section 3(6) is dismissed in its entirety.

## **CONCLUSION**

134. OFAAL's opposition against application no. 3090962 succeeds in its entirety.

135. OFAAL's opposition against application no. 3086412 succeeds in its entirety.

136. WLTS's opposition against application no. 3100347 succeeds in its entirety.

## **COSTS**

137. At the hearing, Mr Harbottle requested off-scale costs in the event that his client was successful. WLTS have filed a proforma also seeking to recover their costs. I recognise that OFAAL has been successful in two oppositions and WLTS has been successful in only one. However, both oppositions brought by OFAAL were brought on the same grounds and so there was significant overlap in terms of the issues and the work undertaken. On balance, I consider that given the parties have enjoyed a roughly equal degree of success in their oppositions, it would not be appropriate to make an award of costs in this case.

138. Consequently, I direct that both parties bear their own costs.

**Dated this 21<sup>st</sup> day of October 2021**

**S WILSON**

**For the Registrar**