

O/561/22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003587255
IN THE NAME OF FUTURE (AWARDS AND
QUALIFICATIONS) LIMITED FOR THE
FOLLOWING TRADE MARK:**

CERAD

IN CLASSES 9, 16 & 41

AND

**IN THE OPPOSITION THERETO
UNDER NO. 425171 BY
QUALSAFE LIMITED**

BACKGROUND AND PLEADINGS

1. On 29 January 2021, Future (Awards and Qualifications) Limited (“the applicant”) applied to register the trade mark shown on the front page of this decision (“the contested mark”) for the following goods and services:

Class 9: Electronic publications downloadable from the Internet, computer software, computer programs, instructional videos, CD ROMs and DVDs, all relating to the training of paramedic and ambulance personnel.

Class 16: Printed matter, printed publications, books, instructional and teaching material, workbooks, booklets, training aids, manuals, stationery, instructional and reference material, all relating to the training of paramedic and ambulance personnel.

Class 41: Education; training; publication of books, texts, journals and periodicals; arranging and conducting conferences and seminars; provision of correspondence courses; education, instruction and training provided on-line from a computer database or from the Internet; provision of lectures and seminars; all relating to the training of paramedic and ambulance personnel; information, advisory and consultancy services relating to the aforesaid services.

2. The contested mark was published for opposition purposes on 26 March 2021, and, on 25 June 2021, it was opposed by Quallsafe Limited (“the opponent”) under sections 3(1)(b), 3(1)(c) and 3(1)(d) of the Trade Marks Act 1994 (“the Act”).

3. In respect of its section 3(1)(b) ground, the opponent pleaded:

“The mark is devoid of distinctive character as it constitutes the recognised acronym for ‘Certificate in Emergency Response Ambulance Driving’ and is not capable of distinguishing the services of one undertaking from another.”

4. Under its section 3(1)(c) ground, the opponent pleaded:

“The mark applied for serves in trade to designate the kind of goods and services, the intended purpose of the goods and services and other characteristics of the goods and services.”

5. Finally, under its section 3(1)(d) ground, the opponent pleaded:

“The mark applied for has become customary in the language and established practice of the trade, being an acronym adopted by trade bodies in the training of ambulance drivers and healthcare staff.”

6. The applicant filed a counterstatement denying the claims made.

7. Both parties filed evidence in chief with the opponent also filing evidence in reply. A hearing took place before me on 26 April 2022 by video conference. The opponent was represented by Mr Matt Sammon of Sonder IP Limited, being the firm that has represented the opponent throughout these proceedings. The applicant was represented by Mr Tim Blower of IP-Active.com Limited, being the firm that has represented the applicant throughout these proceedings. Both parties filed skeleton arguments prior to the hearing.

8. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

9. As set out above, both parties have filed evidence during these proceedings. The opponent's evidence was in the form of the first and second witness statements of

Mr Nigel Barraclough dated 25 October 2021 and 7 March 2021 respectively, with the latter statement being the one filed in reply. Mr Barraclough is the CEO of the opponent, a position he has held since forming the company in May 2000. Mr Barraclough's first statement is accompanied by 10 exhibits and his second is accompanied by a further five.

10. The applicant's evidence came in the form of the witness statement of Mr Christopher Young dated 29 December 2021. Mr Young is the director of the applicant, a position he has held since 2005 when he founded the company. Mr Young's statement is accompanied by eight exhibits.

11. I do not propose to reproduce the parties' evidence in full but will refer to it below where necessary.

DECISION

Section 3(1) legislation and case law

12. Section 3(1) of the Act provides as follows:

"3(1) The following shall not be registered –

(a) [...]

(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.”

13. The relevant date for determining whether the contested mark is objectionable under sections 3(1)(b), 3(1)(c) or 3(1)(d) is its filing date, being 29 January 2021.

14. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b): *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P at [25].

15. The position under the above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect.¹ At the hearing, the applicant made submissions in respect of the relevant public for the goods and services at issue and set out that it is the parties that would sell the courses to the training providers, who would then offer the courses to the end consumer, being the trainees. In this scenario, it is the training provider, being a business user, that would be the average consumer. While I accept that this may be how the applicant operates its business, I must make a notional assessment regarding the goods and services, meaning that I must consider all of the ways in which the terms may be used. While I accept the applicant’s submissions that training providers do form part of the relevant public, I am of the view that the relevant public will also include a specialist sub-set of the general public at large, particularly people looking to receive training or achieve an education in the fields of paramedics or ambulance personnel. I make this finding

¹ *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

on the basis that there is nothing in the specification at issue that precludes them being provided to or sought by the end consumer, being the trainee, directly.

16. Turning to consider the level of attention paid by the consumer, I am of the view that this will vary. While the goods and services, when being selected by trainees directly, are sought to potentially further the users' careers, I do not consider that the level attention will extend any higher than medium. This is on the basis that this consumer will consider the price of the goods/services and whether they meet the criteria required and, once satisfied that it does, I do not consider any greater degree of attention will be paid. Therefore, I consider that the degree of attention paid by these users is medium. Moving to consider the selection process of training providers, I am of the view that they are likely to pay a higher degree of attention (but not the highest) on the basis that the provision of the goods and services are likely to have an impact on their business and they would, therefore, want to ensure that the goods/services meet their requirements and those of their potential customers.

Section 3(1)(d)

17. I will first consider the opposition under section 3(1)(d) of the Act. It is the opponent's claim that 'CERAD' has become customary in the language and established practice of the trade on the basis that it is an acronym adopted by trade bodies in the training of ambulance drivers and healthcare staff.

18. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case law of the CJEU under the equivalent of s.3(1)(d) of the Act, as follows:

"49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and

Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (BSS, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (BSS, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and BSS, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and BSS, paragraph 40)."

19. In light of the case law above, the relevant question is whether, on the relevant date (29 January 2021), the mark 'CERAD' had become customary in the current language or in the bona fide and established practices of the trade to designate the goods and services for which the mark is registered. That question must be based on the perception of the average consumer of the goods in the UK, who I have identified at paragraph 15 above.

20. The opponent's evidence shows a number of documents that refer to qualifications referred to as the 'Level 3 Certificate Emergency Response Driving'² and the 'Level 3 Certificate in Emergency Response Ambulance Driving'.³ While these print-outs are undated, I note that they either contain a copyright date of 2018 or 2020, or advertise job start dates from prior to the relevant date. While I acknowledge this evidence, it does not point towards 'CERAD' becoming customary in the trade and only refers to the full title of the qualification itself. On this point however, I note that there is evidence from the opponent in support of its position in that:

"it is common practice for course providers to adopt an acronym to describe the course being offered. It is also common practice for such acronyms to be widely used by all provided."⁴

21. A number of print-outs have been attached to the opponent's evidence showing the first aid courses 'First aid at work' and 'Emergency first aid at work' being referred to by the acronyms 'FAW' and 'EFAW', respectively.⁵ I note that both of these courses are accredited by both parties to these proceedings.⁶ In addition, there is reference to a course called 'Certificate in Assessing Vocational Achievement' which the opponent claims is commonly referred to as 'CAVA'.⁷ While the evidence on this point is noted, it shows three examples of courses that are abbreviated and does not, in my view, point to such a practice being established in the trade.

22. As for any evidence relating to 'CERAD' itself, there is very little reference to it in the opponent's evidence. The first reference is from a print-out of an Assessment Plan issued by the Association of Ambulance Chief Executives and NEMAS, the National Education Network for Ambulance Services.⁸ This comes in the form of an image of a pie chart graph which I have reproduced as follows:

² Page 6 of NB1, pages 4 and 5 of NB3 of the Second Witness Statement of Mr Nigel Barraclough

³ Page 3 of NB6, Page 3 of NB7, Page 9 of NB8, pages 3 and 4 of NB9, page 2 of NB11 and page 2 of NB12 of *ibid*

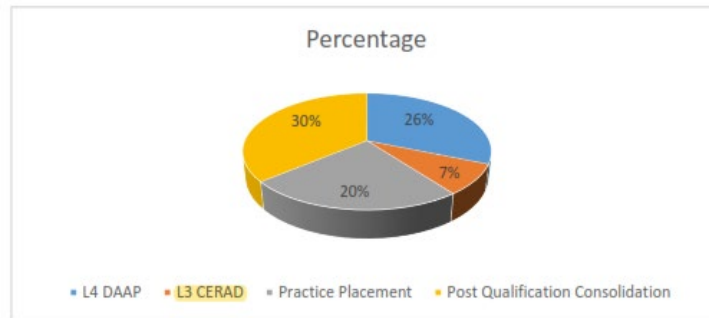
⁴ Paragraph 7 of *ibid*

⁵ Exhibit NB13 of *ibid*

⁶ Exhibit NB14 of *ibid*

⁷ Exhibit NB15 of *ibid*

⁸ Page 4 of Exhibit NB3 of *ibid*



23. In addition to the above, the further references to ‘CERAD’ in the opponent’s evidence comes in the form of undated print-outs that show seven separate training providers offering a ‘CERAD’ training course.⁹ I note that three of these refer specifically to the applicant as the developer or the ‘approval centre’ for these courses.¹⁰ Additionally, one of them confirms that its course is accredited by both the applicant and the opponent.¹¹ While these print-outs are noted, they are undated and it is not clear whether these services were offered prior to the relevant date. They are, therefore, of no assistance to the opponent in respect of its 3(1)(d) claim.

24. The opponent’s evidence of the term ‘CERAD’ being used on goods and services in the UK is far from sufficient to warrant a finding that it has become customary in the current language of the trade. This is particularly the case given that the evidence regarding ‘CERAD’ is very limited with only one reference to it prior to the relevant date and the remaining evidence being undated and, therefore, of no assistance. Taking all of this into account, I am not prepared to accept that the opponent’s evidence points to ‘CERAD’ being customary in the current language or in the bona fide and established practices of the trade. As a result, the opposition based on section 3(1)(d) fails in its entirety.

Section 3(1)(c)

25. I will now move on to the opposition based on section 3(1)(c). Section 3(1)(c) prevents the registration of marks which are descriptive of the goods and services,

⁹ Exhibit NB10 of *ibid*

¹⁰ Pages 2, 4 and 5 of Exhibit NB10 of *ibid*

¹¹ Pages 8 of Exhibit NB10 of *ibid*

or a characteristic of them. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the Court of Justice of the European Union (“CJEU”) in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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 (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

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 (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

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 (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

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 (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM (C-80/09 P)*, paragraph 37).

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 (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). 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 (*Koninklijke KPN Nederland*, paragraph 57).

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 (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

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 (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), 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 (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

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: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

26. The opponent has claimed that the contested mark serves in trade to designate the kind of, intended purpose and other characteristics of the goods and services for which it is applied. I have no submissions or evidence that confirms what ‘other characteristics’ the opponent is referring to so will only consider the position in respect of kind and intended purpose.

27. While success under section 3(1)(c) grounds is not solely dependent upon evidence, I note my comments above when considering the section 3(1)(d) ground that the evidence regarding the alleged propensity of providers to use acronyms in the provision of training courses is limited to three examples. Further, the evidence regarding the use of the acronym ‘CERAD’ is also limited. The same issues apply to the remaining grounds in these proceedings; however, this does not mean that those grounds are bound to fail on that basis.

28. I note that some of the evidence filed by the applicant refers to courses that are not for the ‘Level 3 Certificate in Emergency Response Ambulance Driving’ and do not,

therefore, require the acronym 'CERAD' to be used.¹² While noted, these courses are not particularly relevant to the assessment I must make here. I appreciate that there are likely to be a variety of other courses available in relation to emergency driving, and at different levels, that would not be shortened to 'CERAD'. However, this does not mean that 'CERAD' is not capable of being descriptive of the kind of or purpose of the goods and services at issue.

29. The applicant's evidence sets out that it originally coined the term 'Level 3 Certificate in Emergency Response Ambulance Driving', which it internally referred to as 'CERAD'. While this may be the case, the assessment I must make is based on whether the relevant public would perceive 'CERAD' as referring to the kind of or intended purpose of the goods and services. On this point, I note that a newly coined term, or neologism, for a new product or service may still be seen as descriptive. In *Wirex Ltd v Cryptocarbon Global Ltd & Ors* [2021] EWHC 617 (IPEC), Judge Hacon explained that a neologism used in relation to a new product may be taken by the relevant public to be a new word for that type of product. He referred to *Linoleum Manufacturing Company v Nairn* [1878] 7 Ch. D. 834, in which Fry J said (at 837):

"In my opinion, it would be extremely difficult for a person who has been by right of some monopoly the sole manufacturer of a new article, and has given a new name to the new article, meaning that new article and nothing more, to claim that the name is to be attributed to his manufacture alone after his competitors are at liberty to make the same article."

30. Although 'CERAD' is not a word itself, it is apt as an acronym to describe the certification required for trainees to qualify as emergency response ambulance drivers. Any potential objection is also not avoided because the applicant coined the term and, for a time, nobody else was using it. Further, the objection is not avoided because the course may also be known by other names or terms such as its full name, being 'Level 3 Certificate in Emergency Response Ambulance Driving'.

¹² Exhibits CY6 and CY7 of the Witness Statement of Christopher Young

31. I wish to also address the reference in the applicant's evidence to the disparity between the applicant's course and the equivalent course offered by the opponent. This issue was picked up at the hearing. The applicant essentially alleges that the opponent's course has a lower standard of qualification. This point was disputed by the opponent. The assessment I must make relates to whether the mark is objectionable under section 3(1)(c) of the Act or not and the alleged quality of the courses provided by the parties is not relevant to that assessment. I will say no more on this point.

32. Moving now to consider the substantive position under the 3(1)(c) ground, I note that the applicant's evidence sets out that it developed training courses for 'Level 3 Certificate in Emergency Ambulance Driving' between 2014 and 2015 and then developed a new course to replace the pre-existing one. This new course was called 'Level 3 Certificate in Emergency Response Ambulance Driving'. The applicant states that, internally, this was referred to as 'CERAD' from the earliest days of its development. While the evidence of internal use is noted on this point, this is not relevant to the assessment I must make, which is based on how the average consumer would perceive the mark. I have identified the average consumer at paragraph 15 above. On this point, the applicant goes on to state that the term also began being used by its customers as the course became more popular.¹³ In my view, this is external use which could likely spread amongst the relevant public including, eventually, non-customers of the applicant.

33. Registration of learners for the applicant's CERAD course began in 2016. The applicant sets out that it does not provide the training itself but sells the courses to training providers who then provide the training to end users with each award being authorised by the applicant as the 'awarding authority'.¹⁴ A total value of registration charges has been provided which shows the number of registrations provided between 2016 and 2021. While I intend to address the registration figures in further detail should it be necessary to consider the claim for acquired distinctiveness, at this stage I simply note that the figures increased steadily each year. Given that the UK registration figures increased from 1,197 in 2016 to 2,701

¹³ Paragraph 9 of *ibid*

¹⁴ Paragraph 12 of *ibid*

in 2017, thereby indicating an increase in popularity for the course, I am content to conclude that this is around the time the applicant's customers began using the term 'CERAD'. This is in line with the applicant's evidence that I have discussed at paragraph 32 above. Given that the applicant's customers would have no doubt formed part of the relevant public for the goods and services, I am satisfied that they would have been aware of what the term 'CERAD' meant.

34. Further to the above, the applicant's own evidence consists of a number of references to 'CERAD' being short for 'Certificate in Emergency Response Ambulance Driving'. One of these examples is shown on the applicant's own website.¹⁵ However, I note that there are other references to this on websites from Elite Advanced Driver Training,¹⁶ ERDT,¹⁷ Basegreen Academy,¹⁸ Rapid Response Medical Services,¹⁹ CMS²⁰ and St John's Ambulance.²¹ While these are all undated or dated after the relevant date, they show references to 'CERAD' being the course required to obtain a certificate in emergency response ambulance driving. Each of the examples provided refer to the provider of the course itself and to FutureQuals, being the applicant's apparent trading name (a point that I note was not contested at the hearing by the opponent), in that it is identified as the developer of the course. In all of these examples, 'CERAD' will be seen as a descriptor of the kind of training that will be provided/received under the acronym in that it will be emergency response ambulance driving. Further, it will also be viewed as an indicator of the purpose in that it will be perceived by the relevant public as an indicator of what they will be able to go on to do after completing the course, i.e. become an ambulance driver. In this context, 'CERAD' will not be seen as an indicator of origin. Instead, it is either the applicant itself or the provider that will be seen as the undertaking responsible for the training course and any associated materials. While this evidence is undated or dated after the relevant date, it is consistent with the narrative evidence that I have discussed at paragraphs 32 and 33 above. Taking into account how the applicant operates its

¹⁵ Page 1 of Exhibit CY5 of *ibid*

¹⁶ Page 2 of Exhibit CY5 of *ibid*

¹⁷ Page 4 of Exhibit CY5 of *ibid*

¹⁸ Page 5 of Exhibit CY5 of *ibid*

¹⁹ Pages 7 to 13 of Exhibit CY5 of *ibid*

²⁰ Pages 14 and 15 of Exhibit CY5 of *ibid*

²¹ Pages 16 to 22 of Exhibit CY5 of *ibid*

business, I am content to conclude that the evidence discussed in this paragraph is indicative as to how the courses would have been marketed or promoted prior to the relevant date. In this scenario, I am satisfied that anyone looking to provide or seek training to obtain a certificate in emergency response ambulance driving would understand what 'CERAD' stood for. In this scenario, the contested mark would be descriptive of the kind and purpose of the course offered.

35. Even upon considering the inherent position without reference to the evidence filed, I do not consider it realistic to suggest that the training course would be provided without reference to the awarding body (be that FutureQuals or another undertaking) or the training provider itself also. When confronted by 'CERAD' in circumstances where it is promoted together with 'Certificate for Emergency Response Ambulance Driving', the average consumer would clearly understand its meaning as an acronym or initialism for that phrase. Even if not presented together, the relevant public would be aware what 'CERAD' stood for. This is on the basis that the considerations of the average consumers (that I have discussed at paragraph 16 above) would have resulted in an awareness of precisely what certificate was required and, in seeking this out, trainees would have been aware of what course the provider was providing or, where the average consumer is the training provider itself, what course it was providing. I do not consider that a consumer would enrol themselves on a course without understanding what it was for. Further, 'CERAD' would not, in my opinion, be perceived as a trade mark indicating the origin of the goods and services on offer, but would be seen purely as a descriptor of the type of course being provided and the associated or ancillary goods used to support the training course. It is the branding of the course provider itself that would be identified as the undertaking being responsible for the provision of the course with any additional branding being potentially viewed as the undertaking responsible for the accrediting of the course itself. Regardless of the circumstances in which the average consumer is confronted by the contested mark, I do not consider that they would see it as anything other than a descriptor of the kind of course offered, being one that trains the user in how to drive an ambulance in emergency response situations. Further, it will also be seen as a descriptor of the intended purpose, being to learn something and receive an award to prove it in order to eventually seek employment in the field of ambulance driving.

36. I have found above that 'CERAD' is descriptive of the kind and intended purpose of the course offered. However, I must now consider what goods and services in the contested mark's specification this applies to. Given the nature of the limitation provided in the applicant's specification, in that all of its goods and services all relate to the training of paramedics and ambulance personnel, I am of the view that the above finding applies in respect of all of the applicant's goods and services. In respect of the services at issue, these all relate to training and educational services where 'CERAD' will be understood by the relevant public as being the purpose of the training/education, namely that its purpose is to assist in obtaining training in emergency response ambulance driving that may eventually lead to employment in as such. Further, it will be understood as a reference to the kind of training on offer, being emergency response ambulance driving.

37. I turn now to consider the goods at issue. As above, all of the goods at issue are specifically limited so that they are used in conjunction with training of paramedics and ambulance personnel. In this context, I consider that the term 'CERAD' on goods such as CD ROMs and instructional videos will be considered as descriptive of the kind or intended purpose of the goods at issue. For example, when used on an instructional video, 'CERAD' will be understood as a reference to the kind of instruction being given in that it will indicate what type of training is provided (ambulance driving training). Further, 'CERAD' will also be descriptive of the purpose of the video in that it will instruct the user how to drive an ambulance in emergency response situations. In my view, this finding applies to all of the goods at issue in that they are all aids or ancillary goods used in the course of the training.

38. For completeness, I have also given consideration to the claim that the course is widely known. Whether this is the case or not is irrelevant as if 'CERAD' is understood as a term which may describe the goods or services, it must be freely available for other traders, as the CJEU stated in *Postkantoor*:

"58 Similarly, whether the number of competitors who may have an interest in using the signs or indications of which the mark consists is large or small is not decisive. Any operator at present offering, as well as any operator who

might in the future offer, goods or services which compete with those in respect of which registration is sought must be able freely to use the signs or indications which may serve to describe characteristics of its goods or services.”

39. Given that other undertakings may wish to offer their own versions of duly accredited courses that offer certificates for emergency response ambulance driving, it is appropriate that the term CERAD, as it has become known within the relevant community as a descriptor of such services, be freely available for other traders as set out by the case law above.

40. Taking all of the above into account, I consider that all of the goods and services at issue are objectionable under section 3(1)(c) of the Act.

Section 3(1)(b)

41. Section 3(1)(b) prevents registration of marks which are devoid of distinctive character. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product

in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

42. The opponent has pleaded that the contested mark is devoid of distinctive character as it constitutes the recognised acronym for 'Certificate in Emergency Response Ambulance Driving' and is, therefore, not capable of distinguishing the goods or services of one undertaking from another. I have found under my assessment of the 3(1)(c) ground that 'CERAD' will be considered descriptive of the kind and intended purpose of the goods and services. I have also found that 'CERAD' would not be seen as an indicator of origin for the goods and services

and would, instead, be understood as an acronym for the name of the certificate provided upon successful completion of the course. As I have found that the contested mark is descriptive, it follows that it is devoid of distinctive character and, therefore, not capable of distinguishing the goods and services of one undertaking from one another.

43. I have also given further consideration to the position under the 3(1)(b) ground in the event that I was wrong to conclude that the goods were objectionable under 3(1)(c). Even if the contested mark was not considered descriptive of the kind or purpose of the goods at issue, I am of the view that it would still be devoid of distinctive character. This is on the basis that the goods will all be used in the context of training of paramedics and ambulance personnel by virtue of the limitation in both the class 9 and 16 list of goods. The average consumer for these goods will not be members of the general public at large and the goods would not be sold in high street retailers. Instead, the average consumer, as I have set out at paragraph 15 above, is a specialist subset of the general public or training providers who would be well aware of what 'CERAD' stood for. Further, these goods will be used in conjunction with the training services provided. In these circumstances, the average consumer will fully understand what 'CERAD' means and, as a result, would not consider it as an indicator of origin of the goods.

44. As a result, I consider that the contested mark is objectionable under section 3(1)(b) of the Act for all of the contested goods and services.

45. I note that the applicant has pleaded that the contested mark has acquired distinctiveness through use, which I will now consider. In the event that this claim is proven, the contested mark cannot be deemed objectionable under 3(1)(b) or 3(1)(c) of the Act (see paragraph 12 above).

Acquired Distinctiveness

46. I will now proceed to consider the applicant's claim that its mark has acquired distinctiveness through use. The CJEU provided guidance in *Windsurfing Chiemsee*, Joined cases C-108 & C-109/97, about the correct approach with

regard to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: 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 class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37).”

47. As I have summarised throughout this decision, the applicant’s evidence sets out that the applicant created a course to train ambulance drivers so that they can obtain a certificate in emergency response ambulance driving. The applicant does not provide the course directly to the trainee but, instead, sells it to training providers who then provide the training themselves. The applicant is then considered the awarding authority. While the evidence on this point is noted, my

issue at this stage is that the applicant's use appears to be aimed at the provision of accreditation services and it does not purport to be the provider of the training service itself. Given that the goods and services at issue are directed at the provision of education and training services, the evidence must also be directed towards use in respect of those and not the accrediting service for the award. While it created the course, the applicant does not, by its own admission, provide the training, education or the ancillary goods associated with it. Therefore, the evidence is, in my view, irrelevant to the applicant's claim for acquired distinctiveness in the goods and services at issue. However, if I am wrong on this point and the evidence is capable of pointing towards use of the goods and services at issue, it is not sufficient to show a level of acquired distinctiveness in the contested mark. My reasons follow.

48. Firstly, the applicant has not provided any evidence in respect of the market share that it holds by virtue of the use of its mark, how geographically widespread the use of the mark has been, the amount the applicant has invested in promoting the mark, the proportion of the relevant class of persons who, because of the mark, identify the goods/services as originating from the applicant or any statements from the industry or other trade and professional associations. It has, however, provided evidence as to turnover generated since 2016 in respect of registration fees that are charged to trainees.

49. The evidence of use sets out that since 2016, being when the training began, the applicant charged a registration fee for each learner of £59.50. This fee is how the applicant generates its income. For the avoidance of doubt, this is not the amount that the end user ultimately pays for the training course but is the fee that the applicant charges with the remaining costs of the course being determined by and paid to the provider itself. The applicant has provided evidence of the total income generated between the years of 2016 and 2021 (to the end of September). These are as follows:

Table 1: CERAD registrations			
Year	No of Ofqual Registrations (England)	Total No of UK Registrations for all four UK Qualifications Regulators	Total Value of UK Registration Charges
2016	880	1197	£71,238
2017	1985	2701	£160,690
2018	2455	3340	£198,738
2019	2700	3673	£218,571
2020	2795	3803	£226,262
2021 to end September	2820	3837	£228,285
Totals	13,635	18,551	£1,103,785

50. I note that the above figures for 2021 are, for the most part, after the relevant date, being 29 January 2021. While the figures for 1 to 29 January 2021 are to be considered, I have no way to accurately calculate what the turnover would have been for that time period. I will bear this in mind when considering the figures.

51. The evidence goes on to state that the ‘CERAD’ qualification “was unique in the marketplace and [became] very well known, highly regarded and much sought after.”²² The applicant claims that if ‘CERAD’ was ever referred to, it was only available from FutureQuals and, therefore, created a very strong link in the minds of customers. My issue with the argument presented by the applicant is that the evidence sets out that the ‘CERAD’ course is provided by third party providers and that it is a ‘FutureQuals accredited’ course. On this point, I refer to the case of Case C-215/14, *Société des Produits Nestlé SA v Cadbury UK Ltd*, wherein the CJEU considered a preliminary reference from the High Court of England and Wales which sought guidance about the legal test for showing that a trade mark had acquired a distinctive character. The CJEU understood the question as follows:

“By its first question the referring court asks, in essence, whether an applicant to register a trade mark which has acquired a distinctive character following the use which has been made of it within the meaning of Article 3(3) of Directive

²² Paragraph 13 of *ibid*

2008/95 must prove that the relevant class of persons perceive the goods or services designated exclusively by that mark, as opposed to any other mark which might also be present, as originating from a particular company, or whether it is sufficient for that applicant to prove that a significant proportion of the relevant class of persons recognise that mark and associate it with the applicant's goods."

52. The CJEU answered the question in these terms:

"In order to obtain registration of a trade mark which has acquired a distinctive character following the use which has been made of it within the meaning of Article 3(3) of Directive 2008/95, regardless of whether that use is as part of another registered trade mark or in conjunction with such a mark, the trade mark applicant must prove that the relevant class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company."

53. The Court of Appeal - [2017] EWCA Civ 358 - subsequently indicated that it understood the CJEU's answer to mean:

"A non-distinctive mark can only acquire distinctive character if, as a consequence of the way(s) that it has been used, a significant proportion of the relevant public would, at the relevant date, have taken the mark, by itself, to mean that the goods/services sold under it are those of a single undertaking, which is responsible for their quality.

In answering this question it is necessary to distinguish between, on the one hand, mere recognition of the mark in the abstract and, on the other hand, the likely use of that mark during the course of trade, by the relevant public, for the purposes of distinguishing the source of the goods/services.

It is not necessary to show that a significant proportion of the relevant public have in the past placed reliance on the mark for this purpose. This may be

particularly difficult where the mark has been used with, or as part of, other distinctive marks.

However, evidence of such reliance will mean that the mark has acquired a distinctive character.

It is necessary to consider all the evidence, particularly the way(s) in which the mark has been used and promoted, together with the duration and extent of the use.”

54. As set out in the case law cited above, it is necessary for me to consider the evidence in which the contested mark has been used and promoted. While I appreciate that there may be an association between the ‘CERAD’ course and the applicant’s FutureQuals branding, there may also be an association between ‘CERAD’ and the course provider itself. This is particularly the case given that the applicant has not provided any convincing evidence to suggest that the average consumer would perceive the goods and services designated exclusively by the contested mark. On this point, I consider that the evidence points to the contrary in that use is not exclusive to the contested mark but shared with both FutureQuals’s and the training providers’ brandings. Further, I do not consider that the relevant public would, in attending or providing the course, deem ‘CERAD’ to be the trade mark of the undertaking providing the goods or services. Instead, it would have simply been understood as an acronym for the certificate which was to be provided upon completion of the course. I am of the view that any association between ‘CERAD’ and the applicant would, based on the evidence provided, be a mere recognition and not sufficient to enhance the distinctive character of the contested mark.

55. To conclude, I am of the view that if there were any identification by the average consumer of the goods and services as originating from a particular undertaking, it is not as a result of the use of the contested mark but as a result of the branding of either the training provider or ‘FutureQuals’. Therefore, any distinctiveness that may have been acquired through use is not, in my view, attributable to the contested mark. I do not, therefore, consider that the evidence of use provided

indicates that the contested mark would have acquired any level of distinctiveness to the point that it would avoid being objectionable under sections 3(1)(b) or 3(1)(c) of the Act.

CONCLUSION

56. While the opposition failed on its 3(1)(d) ground, it succeeded on its 3(1)(b) and 3(1)(c) grounds. The application is, therefore, refused for all of the goods and services for which it was applied for.

COSTS

57. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,700** as a contribution towards its costs. The sum is calculated as follows:

Filing a notice of opposition and considering the counterstatement:	£200
Preparing evidence and considering the opponent's evidence:	£500
Preparation for and attendance at the hearing:	£800
Official fees:	£200
Total	£1,700

58. I therefore order Future (Awards and Qualifications) Limited to pay Qualsafe Limited the sum of £1,700. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of June 2022

A COOPER
For the Registrar