

O-941-22

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**IN THE MATTER OF
TRADE MARK APPLICATION NOS 3524855 & 3566004, BOTH FOR THE
FOLLOWING MARK:**

IELTS MEDICAL

IN THE NAME OF IELTS MEDICAL LTD

AND OPPOSITION THERETO (UNDER NOS 422571, 422572, 424763 & 424764)

BY

**THE CHANCELLOR, MASTERS AND SCHOLARS OF THE UNIVERSITY OF
CAMBRIDGE, THE BRITISH COUNCIL & IELTS AUSTRALIA PTY LIMITED**

BACKGROUND

1) This dispute concerns four consolidated oppositions against two trade mark applications. Both trade mark applications are for the mark IELTS MEDICAL. The parties to the dispute are IELTS Medical Ltd ('the applicant') and The Chancellor, Masters and Scholars of the University of Cambridge, The British Council and IELTS Australia Pty Limited ('the opponents').

2) On 20 August 2020, the applicant applied to register the trade mark IELTS MEDICAL, application number 3524855 ('855'), in respect of the following goods and services:

Class 09: Educational, teaching, instruction, research, training, testing, examination or assessment apparatus and instruments; electronic apparatus for medical teaching, training, testing, examination and assessment purposes; publications in electronic format in the field of medical education; on-line electronic publications in the field of medical education; downloadable electronic publications; downloadable electronic books, magazines, newsletters, newspapers, journals, and periodicals, all in relation to medical education; downloadable instructional, teaching, training and educational materials, all in relation to medical study; downloadable educational examination and test materials; downloadable medical study guides; downloadable instructional manuals for teaching; electronic book readers; apparatus for recording, transmission or reproduction of sound, data, text or images; computer software applications for educational, teaching, research, training, testing, examination and assessment purposes; computer software and computer software platforms for educational, teaching, research, training, testing, examination and assessment purposes; software for the arrangement of rental accommodation; software for the booking of student rental accommodation; computer software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text and electronic publications; educational computer games software; optical data media; magnetic data media; data storage and data memory apparatus; media bearing electronic publications or educational,

teaching, research, training, testing, examination and assessment software; compact discs, DVDs and other digital recording media for teaching, training or assessment purposes; mobile applications; educational mobile applications.

Class 35: Advertising, marketing and promotional services; office function; business administration; business advice; online and offline wholesale, retail, import and export services for the sale of educational, teaching, instruction, research, training, testing, examination or assessment apparatus and instruments, electronic apparatus for medical teaching, training, testing, examination and assessment purposes, publications in electronic format in the field of medical education, on-line electronic publications in the field of medical education, downloadable electronic publications, downloadable electronic books, magazines, newsletters, newspapers, journals, and periodicals, all in relation to medical education, downloadable instructional, teaching, training and educational materials, all in relation to medical study, downloadable educational examination and test materials, downloadable medical study guides, downloadable instructional manuals for teaching, electronic book readers, apparatus for recording, transmission or reproduction of sound, data, text or images, computer software applications for educational, teaching, research, training, testing, examination and assessment purposes, computer software and computer software platforms for educational, teaching, research, training, testing, examination and assessment purposes, software for the arrangement of rental accommodation, software for the booking of student rental accommodation, computer software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text and electronic publications, educational computer games software, optical data media, magnetic data media, data storage and data memory apparatus, media bearing electronic publications or educational, teaching, research, training, testing, examination and assessment software, compact discs, DVDs and other digital recording media for teaching, training or assessment purposes, mobile applications, educational mobile applications.

Class 38: Telecommunication; telecommunication services; audio video broadcasting via the internet; communication between computers; communication by computers; communication by online blogs; access to content, websites and portals; provision of access to content, websites and portals; providing user access to portals on the internet; on-line chat room services; on-line chat rooms enabling communication between students and teachers.

Class 41: Educational services; educational services in the nature of medical schools, graduate schools, and nursing schools; establishing tests and examinations for medical students, potential medical students, doctors and nurses; operating tests and examinations for medical students, potential medical students, doctors and nurses ; publication of texts of test papers, examination papers, sample test papers, sample examination papers; publication of documents relating to tests and examinations particularly relating to aptitude and admission tests for higher education courses such as degree courses in university medical schools; establishment of aptitude and admission tests for higher education courses; operation of aptitude and admissions tests for higher education courses; establishment and operation of aptitude and admissions tests for higher education courses, particularly degree courses in university medical schools; arranging of tests and examinations for educational purposes, particularly admissions; educational examination; information services relating to educational tests and examinations; organisation of educational competitions; administering of professional competency examinations for testing students and graduates of medical schools to ascertain their competence to be licensed to practice medicine; provision of distance learning programs; all the aforesaid services being provided in paper-based (hard copy), electronic or on-line format.

3) On 09 December 2020, the applicant filed a second application to register the trade mark IELTS MEDICAL, application number 3566004 ('004), in respect of the following goods and services:

Class 16: Printed matter; books; textbooks; workbooks; magazines; newsletters; instructional and teaching material; books, textbooks, workbooks, magazines, newsletters, instructional and teaching material in relation to medical education and medical study; educational, teaching, instruction, research, training, testing, examination or assessment material; educational, teaching, instruction, research, training, testing, examination or assessment material in relation to medical education and medical study; publications in the field of medical education; journals, and periodicals in relation to medical education and medical study; newspapers; leaflets; medical study guides; medical study booklets; stationery; notebooks; calendars; posters; office requisites.

Class 42: Computer services; providing information via an Internet website; design services; design and development of software; design and development of educational software; software as a service; website design services; industrial analysis and research services; scientific research; scientific risk assessment; scientific research, development and analysis.

Class 44: Medical services; healthcare services; healthcare establishments; organisation of healthcare and medical tests; medical and hospital consultations; organisation of health care, analyses and medical tests, in particular by doctors and in hospitals; information and advice for health; health advice and information services; providing health information.

4) The first application was published in the Trade Marks Journal on 02 October 2020; the second application was published on 02 April 2021. Both applications were subsequently opposed by the opponents. The opponents claim that the applications offend under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ('the Act').

Grounds against application '855

5) In support of its grounds under sections 5(2)(b) against application '855, the opponents rely upon the following two trade mark registrations and the following goods/services covered by those registrations, as shown below:

- **UKTM 2360300 ('300)**

IELTS

Filing date: 05 April 2004

Date of entry in register: 25 March 2005

Class 41: Educational services; provision of instructional, training, teaching, testing, examination and/or assessment services, including all the aforesaid services provided by computer assisted or computer based means or via distance learning programmes; publication in both electronic and paper format of instructional, training, teaching, testing, examination and/or assessment materials, including examination papers and syllabuses and materials for the testing of English language skills; testing of English language skills; information, advisory and consultancy services relating to all the aforesaid services, including such services provided on-line from computer databases and/or intranets and/or extranets and/or the Internet.

- **UKTM 3517510 ('510)**

IELTS

Filing date: 30 July 2020

Date of entry in register: 25 December 2020

Class 09: Instructional and teaching apparatus and instruments; downloadable educational course materials; computers; computer software; educational computer software; computer software, recorded; computer programs, downloadable; computer operating programs; application software; downloadable computer software applications; downloadable mobile applications; computer games software; electronic publications; downloadable electronic publications; downloadable electronic award certificates; electronic

examination papers; electronic databases recorded on computer media; data processing equipment; pre-recorded compact discs; pre-recorded DVDs; pre-recorded audio cassettes; pre-recorded videos; sound recordings; audio-visual teaching apparatus; portable media players; recorded media.

6) The claim under section 5(2)(b), based upon the '300 mark, is directed against the following: i) all goods in class 09 with the exception of 'electronic book readers; apparatus for recording, transmission or reproduction of sound, data, text or images; ... software for the arrangement of rental accommodation; software for the booking of student rental accommodation; computer software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text and electronic publications; educational computer games software; ... mobile applications...' ii) all services in class 35 with the exception of 'Advertising, marketing and promotional services; office function; business administration; business advice' and 'online and offline wholesale, retail, import and export services for the sale of... electronic book readers, apparatus for recording, transmission or reproduction of sound, data, text or images, ...software for the arrangement of rental accommodation, software for the booking of student rental accommodation, computer software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text and electronic publications, ...mobile applications' and iii) all services in class 41 of application '855.

7) The claim under section 5(2)(b), based upon the '510 mark, is directed against all goods in class 09 of application '855.

8) In support of its ground under section 5(3) of the Act, the opponents rely upon the '300 mark only. That ground is directed against all of the goods and services covered by application '855.

Grounds against application '004

9) In support of its grounds under sections 5(2)(b) against application '004, the opponents rely upon the following trade mark registration and certain of the goods covered by that registration, as shown below:

- **UKTM '510**

IELTS

Filing date: 30 July 2020

Date of entry in register: 25 December 2020

Class 09: computers; computer software; educational computer software; computer software, recorded; computer programs, downloadable; computer operating programs; application software; downloadable computer software applications; downloadable mobile applications; computer games software; electronic databases recorded on computer media; data processing equipment.

Class 16: printed matter; printed publications; printed instructional, educational, and teaching materials; manuals; study guides; books; booklets; pamphlets; brochures; prospectuses; printed award certificates; printed examination papers; stationery; notebooks; calendars; posters; office requisites, except furniture.

10) The claim under section 5(2)(b), based upon the '510 mark, is directed against all of the goods in class 16 and some of the services in class 42 of application '004, namely: 'Computer services; providing information via an Internet website; design services; design and development of software; design and development of educational software; software as a service; website design services'.

11) In support of its ground under section 5(3) of the Act, the opponents rely only upon the '300 mark. That ground is directed against all of the goods and services covered by application '004.

12) Under Section 5(2)(b) of the Act, it is claimed that the relevant goods and services (as set out above) of the contested marks are identical, or similar, to certain of those covered by the earlier marks and the marks are highly similar such that there exists a likelihood of confusion on the part of the average consumer of those goods and services.

13) Under Section 5(3) of the Act, it is claimed that the earlier '300 mark enjoys a reputation in the UK in respect of all the class 41 services covered by that registration and that use of the contested marks will take unfair advantage of, or be detrimental to, the distinctive character of the earlier mark. (There is no claim of detriment to the reputation of the earlier mark.)

14) The marks relied upon by the opponent are both earlier marks, in accordance with section 6 of the Act. As the '300 mark completed its registration procedure more than five years prior to the application date of the contested marks, it is, in principle, subject to the proof of use conditions, as per section 6A of the Act. However, the applicant helpfully conceded at the hearing that genuine use had been made. In this connection, I note that the applicant's own evidence in these proceedings shows that the nature of its business is such that it is, at least in part, dependent upon the class 41 services provided by the opponent under the IELTS mark and therefore the applicant's concession appears to me to be a sensible one.

15) Counterstatements were filed by the applicant in defence of its trade mark applications in each of the four opposition cases, denying the grounds of opposition. The four oppositions were subsequently consolidated.

16) The applicant was initially represented in these proceedings by a firm of Trade Mark Attorneys. That representation was removed after the conclusion of the evidence rounds and before the appointment of the main hearing; the opponent has, at all times, been represented by Mills & Reeve LLP. The opponent's evidence in

chief consists of thirteen witness statement from eleven different individuals, two of whom have provided two witness statements (the second of their statements corrects errors made in their first statements). The applicant's evidence consists of a witness statement from Nonny Nze and thirty-eight exhibits thereto. A hearing took place before me, by video conference, at which the applicant was represented by Chris Pearson, of Counsel, instructed directly by the applicant herself; the opponent was represented by Michael Hicks, of Counsel, instructed by Mills & Reeve LLP.

Section 5(2)(b)

17) The relevant section of the Act states:

“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.

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

Case law

18) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas*

Benelux BV, Case C-425/98, Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

The principles

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

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

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

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

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

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

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

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

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

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

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

19) 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.

Comparison of goods and services

20) All relevant factors relating to the goods and services should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended

purpose and their method of use and whether they are in competition with each other or are complementary.”

21) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

- (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.

22) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking..”

In *Sanco SA v OHIM* Case T-249/11, the General Court ('GC') found that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services was very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* (BL-0-255-13):

"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand:

".....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

23) Finally, I note the decision in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05), where the GC held 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03

Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

Application ‘855

24) At the hearing, it was conceded by the applicant that the class 41 services covered by application ‘855 are identical or similar to the class 41 services covered by the earlier ‘300 mark. It was also conceded that the goods in class 09 of application ‘855 are identical, or similar, to class 09 goods covered by the earlier ‘510 mark.

25) In the light of the above concessions, that leaves only the claimed similarity between the applicant’s contested services in class 35 in application ‘855 and the services covered by earlier mark ‘300 in class 41 to be decided for the purposes of the claim under section 5(2)(b) (for which no concession has been made). The applicant has conceded that some of its services in class 35 are similar to the earlier mark’s class 41 services but has not specified which particular services are encapsulated by that concession. The relevant services to be compared are:

<u>The earlier ‘300 mark</u>	<u>Contested application ‘855</u>
<p>Class 41: Educational services; provision of instructional, training, teaching, testing, examination and/or assessment services, including all the aforesaid services provided by computer assisted or computer based means or via distance learning programmes; publication in both electronic and paper format of instructional, training, teaching, testing, examination and/or assessment materials, including examination papers</p>	<p>Class 35: Online and offline wholesale, retail, import and export services for the sale of educational, teaching, instruction, research, training, testing, examination or assessment apparatus and instruments, electronic apparatus for medical teaching, training, testing, examination and assessment purposes, publications in electronic format in the field of medical education, on-line electronic publications in the field of medical education, downloadable</p>

and syllabuses and materials for the testing of English language skills; testing of English language skills; information, advisory and consultancy services relating to all the aforesaid services, including such services provided on-line from computer databases and/or intranets and/or extranets and/or the Internet.

electronic publications, downloadable electronic books, magazines, newsletters, newspapers, journals, and periodicals, all in relation to medical education, downloadable instructional, teaching, training and educational materials, all in relation to medical study, downloadable educational examination and test materials, downloadable medical study guides, downloadable instructional manuals for teaching,...computer software applications for educational, teaching, research, training, testing, examination and assessment purposes, computer software and computer software platforms for educational, teaching, research, training, testing, examination and assessment purposes,..., educational computer games software, optical data media, magnetic data media, data storage and data memory apparatus, media bearing electronic publications or educational, teaching, research, training, testing, examination and assessment software, compact discs, DVDs and other digital recording media for teaching, training or assessment purposes,... educational mobile applications.

Online and offline wholesale, retail, import and export services for the sale of ... publications in electronic format in the field of medical education, on-line electronic publications in the field of medical education, downloadable electronic publications, downloadable electronic books, magazines, newsletters, newspapers, journals, and periodicals, all in relation to medical education, downloadable instructional, teaching, training and educational materials, all in relation to medical study, downloadable educational examination and test materials, downloadable medical study guides, downloadable instructional manuals for teaching... media bearing electronic publications... compact discs, DVDs and other digital recording media for teaching, training or assessment purposes.

26) It seems to me that there is some degree of similarity between the applicant's services which are underlined directly above and the opponents' 'publication in both electronic and paper format of instructional, training, teaching, testing, examination and/or assessment materials, including examination papers and syllabuses and materials for the testing of English language skills;'. The user of the respective services may be the same, the purpose of the services is similar i.e., to provide educational publications to the consumer (online, on electronic media or in paper form). The trade channels may be the same or at least overlap. I find a medium degree of similarity between the applicant's services listed directly above and the aforementioned services of the opponent.

27) It is not obvious to me, and the opponent has not explained why or provided any evidence to show that, the remainder of the applicant's services are similar to any of the opponents' services in class 41. Although the users may be the same, the respective nature and purpose appears of the respective services appears to be different and none appear to be obviously in competition or complementary. I find that the rest of the applicant's services are not similar to any of the opponent's services. The ground under section 5(2)(b) must therefore fail against those services of the applicant because there can be no likelihood of confusion without some degree of similarity between the respective services.

Application '004

28) At the hearing, it was conceded by the applicant that the class 16 goods covered by application '004 are identical, or similar, to the class 16 goods covered by the earlier '510 mark. However, it was submitted that the services in class 42 of application '004 are not similar to the class goods relied upon, covered by the earlier '510 mark.

29) Taking into account the applicant's concession regarding its class 16 goods, the only comparison left for me to make for the purposes of the claim under section 5(2)(b) is, therefore, between the following goods and services:

The earlier '510 mark	Contested application '004
<p>Class 09: computers; computer software; educational computer software; computer software, recorded; computer programs, downloadable; computer operating programs; application software; downloadable computer software applications; downloadable mobile applications; computer games software; electronic databases recorded on computer media; data processing equipment.</p> <p>Class 16: printed matter; printed publications; printed instructional, educational, and teaching materials; manuals; study guides; books; booklets; pamphlets; brochures; prospectuses; printed award certificates; printed examination papers; stationery; notebooks; calendars; posters; office requisites, except furniture.</p>	<p>Class 42: Computer services; providing information via an Internet website; design services; design and development of software; design and development of educational software; software as a service; website design services.</p>

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Computer services

30) The applicant's 'computer services' is a broad term covering a number of specific services relating to computers, such as consultation in relation to computers, testing of computers and rental of computers. There is an obvious complementary relationship with the opponent's 'computers' and the users and trade channels will be the same. I find a high degree of similarity between the opponent's 'computers' and the applicant's 'computer services'.

Design services; design and development of software; design and development of educational software.

31) All the above services of the applicant include the design and/or development of software ('Design services' is broad enough to cover such services). There is clearly a complementary relationship, in the sense described in the case law, between the applicant's services and the opponent's 'computer software'. The users will be the same, the trade channels will be the same or overlap. There may be a degree of competition between the respective goods and services with a consumer choosing between purchasing ready-made software or paying for the service of having software designed and developed specifically for it. I find a high degree of similarity between the opponent's 'computer software' and the applicant's 'Design services; design and development of software; design and development of educational software'.

software as a service

32) The applicant's 'software as a service' involves the provision of software online which can be accessed, and used, by purchasing a subscription. The opponent's 'computer software' is software that can be purchased and installed upon a consumer's computer. The users of the respective goods and services will be the same, the trade channels are likely to be the same or overlap, the intended purpose and method of use is the same or at least highly similar. There is also a competitive

relationship in play given that a consumer may choose between purchasing a subscription to access software to use online or purchasing software to install and keep on their own computer. I find a high degree of similarity between the opponent's 'computer software' and the applicant's 'software as a service'.

providing information via an Internet website

33) The applicant's 'providing information via an Internet website' covers all kinds of information relating to services which fall within class 42. It therefore covers information about computers and computer software. I find a high degree of similarity between these services and the opponent's 'computers' and 'computer software' given the obvious overlap in users, trade channels and that providing information about computers and software will no doubt go hand-in-hand with the sale of the same.

website design services

34) The opponent's 'computer software' covers such software for the purposes of creating and maintaining websites. There is overlap in purpose between those goods and the applicant's 'website design services' and the opponent's goods may be complementary, in the sense described in the case law, to the applicant's services. I find a medium degree of similarity between the applicant's 'website design services' and the opponent's 'computer software'.

Average consumer and the purchasing process

35) It is necessary to determine who the average consumer is for the respective goods and services and the manner in which they are likely to be selected. 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.”

36) The average consumer for the majority of the goods and services at issue, that have been found, or are conceded, to be identical or similar is likely to consist mainly of students or professionals wishing to pass certain examinations for work, study and/or immigration purposes and teachers requiring training and/or teaching materials. The average consumer also includes members of the UK general public who wish to obtain proof of their general English language proficiency for the purposes of emigrating to another English language speaking country (such as Australia or Canada). Insofar as the ‘computers’ and ‘computer software’ covered by earlier mark ‘510 are concerned and the class 42 services covered by application ‘004, the average consumer of these goods and services is the general public and businesses/professionals. The cost of the various goods and services is likely to vary. The nature of all the goods and services, despite their exact cost, is such that the average consumer is likely to take some care and consideration over the purchase to ensure that the goods or services are appropriate to meet their educational, professional, emigration/immigration or other needs. On the whole, I find that the degree of attention is likely to be above normal for all of the goods and services at issue and I would expect them all to be sought out visually on websites or perhaps, sometimes, by signage on physical premises. However, I do not discount the potential for aural use of the marks through verbal recommendations and/or discussions with sales representatives, for example.

Distinctive character of the earlier mark

37) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

38) At the hearing, Mr Pearson referred me to a Notification of Final Decision following a Refusal of the Norwegian Patent Office from 2006, in relation to an application filed by the opponents for the mark IELTS. This refusal was made on the basis that the opponent’s mark stood for International English Language Testing System and was therefore non-distinctive. I note this refusal. However, it is in no way binding upon me. Furthermore, Section 72 of the Act states:

“In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

In the instant case, the opponent's earlier marks are both registered. It is therefore not open to me, by virtue of section 72 of the Act, to conclude that they are non-distinctive. They must be attributed with some degree of distinctiveness.

39) The earlier mark is IELTS. It is a plain combination of five letters. In my view, although it is likely that the mark will be perceived as an initialism or acronym of some sort, the meaning of that initialism/acronym is not immediately apparent from those letters, of themselves. I find that, *prima facie*, the inherent distinctiveness of the mark is of a normal level in relation to all the earlier goods and services.

40) I now need to consider i) the applicant's evidence purporting to show that the earlier mark is, in fact, descriptive and lacking in distinctiveness and ii) the opponent's evidence purporting to show that the earlier mark is factually highly distinctive consequent upon the use that has been made of it in the UK.

41) Ms Nze's evidence claims to show that the earlier mark is descriptive of language tests because it stands for 'International English Language Testing System' and that the average consumer will be aware of that descriptive meaning. She provides examples of, what she states is, the acronym IELTS referring descriptively to the 'International English Language Testing System'¹. The relevant exhibit consists of over 100 pages showing prints from various educational institutions, online articles and portals referring to IELTS alongside an explanation that those letters stand for 'International English Language Testing System'. A large number of these web pages make clear that the IELTS exam is run/managed and/or owned by one or more of the opponents in the instant case. The pages also make clear that the IELTS exam is taken for a range of reasons including to improve a person's job/study prospects in an English-speaking country or for immigration purposes to settle in a country where English is the first language. A number of the web pages refer to the popularity and renown of the IELTS exam, for example, as "the world's most popular English Language Test"² and "the most popular high-stakes English Language certificate in the world"³. In my view, the evidence merely

¹ NN7

² NN7, page 6

³ NN7, page 5

shows that IELTS, which happens to stand for International English Language Testing System, is an acronym/initialism which is used by the opponent as a trade mark to distinguish its English Language Tests from those of other undertakings and is used by other undertakings when referring to the tests provided by the opponent. The evidence does not show that IELTS is used descriptively to refer to English Language tests generally or that the average consumer is likely to perceive IELTS in such a way. All of the use shown points to the opponent.

42) Ms Nze also provides evidence which, she states, shows IELTS being used in signs by a number of third parties⁴ who provide educational services. The relevant exhibits show prints from a number of websites offering assistance/educational services in relation to preparing for the IELTS exam, prints from YouTube showing various videos of individuals providing tips/guidance on how to pass the IELTS exam and prints showing various Apps for educational purposes. Examples of some of the titles/signs used on these sites are ‘My IELTS classroom’, ‘IELTS Liz’, ‘IELTS with Fiona’, ‘IELTS Tutor London’, ‘IELTS Mentor’, ‘IELTS reading strategies’, ‘Excel in IELTS’, ‘Free IELTS sessions’, ‘IELTS Exam preparation courses’, ‘IELTS Advantage’. I note that some of those sites make clear that they have no connection with IELTS (the opponent’s mark and tests provided under that mark) and/or make clear that IELTS is managed/owned by one or more of the opponents. For example, ‘IELTS Liz’ states “Please note, I am not affiliated with or endorsed by IELTS in any way” (page 20 of NN10). ‘IELTS Mentor’ states that the ‘IELTS is jointly managed by ‘University of Cambridge...” (page 39 of NN13). ‘IELTS Advantage’ states that “The information on this site is for information purposes only. IELTS is a registered trademark of [the opponents]. This site and its owners are not affiliated, approved or endorsed by [the opponents]” (pages 8-9 of NN21). I also note that there are at least two sites which claim to provide IELTS certificates for a fee, without the need to actually sit, or pass, the IELTS exam (NN32 and NN34). Such claims raise some concerns, in my mind, as to the authenticity of those sites. I find that most of the third party use of IELTS appears to be in the nature of informative use only about the opponent’s IELTS mark and the test of English Language proficiency provided under that mark. While the evidence does show that IELTS is often used alongside the

⁴ NN8-NN38

words it stands for i.e. 'International English Language Testing System' and those words are, inherently, not particularly distinctive, all such use refers to a single exam provided by a single undertaking i.e. the opponents. I do not therefore consider that the applicant's evidence disturbs my finding above that the earlier mark has a normal level of inherent distinctiveness.

43) I now turn to consider the opponents' evidence of use claiming to show enhanced distinctiveness through use.

Ms Hirtzel's evidence

44) Ms Hirtzel is Assistant General Counsel of Cambridge University Press & Assessment, a non-teaching department of The Chancellor, Masters and Scholars of the University of Cambridge.

45) Ms Hirtzel states that The International English Language Testing System is known as IELTS and is an international standardised test of English Language proficiency for non-native language speakers and is one of the leading English language proficiency tests in the world for higher education and immigration. The following IELTS tests are provided in the UK: IELTS Academic (taken by people wishing to study in an English-speaking country at undergraduate and postgraduate levels and by individuals seeking professional registration e.g. as doctors and nurses), IELTS General Training (taken for immigration purposes or to study at below degree level), IELTS for UKVI, IELTS Life Skills.

46) Ms Hirtzel explains that the University has been responsible for the production and technical support of the IELTS tests, including the development and production of instructional, training, teaching, testing, examination and/or assessment materials used for the IELTS tests. The British Council is responsible for the administration of the IELTS tests and the supervision of the centres at which IELTS tests are carried out. IDP Education Limited (the holding company of IELTS Australia) has an equivalent responsibility in Australia, New Zealand and China.

47) Ms Hirtzel lists a number of publications which she states have been published under the IELTS mark since 1996 containing instructional, training, teaching, testing, examination and/or assessment materials. Six such examples are provided spanning the period of 2016 – 2019. All bear the mark IELTS on the cover. The books contain various educational materials relating to the opponent's IELTS tests, including practice test papers.

48) Ms Hirtzel states that Cambridge University Press & Assessment has, since 2016, provided in the UK, the MINDSET FOR IELTS course to prepare students for the IELTS test.

49) The opponent's website was launched in 2017 and has had 50, 792 new visitors from the UK before 20 August 2020. The IELTS mark is promoted on that website in relation to the opponent's class 41 services.

50) Over 700 regulatory bodies, government bodies, education institutions and other organisations throughout the UK, who require proof of English Language proficiency for immigration, employment, study or regulatory purposes, accepted IELTS tests at the filing date of the contested marks.

51) Between 1996 and August 2020, 1,742,033 people took IELTS tests at official test centres across the UK, of which 486,105 took IELTS tests between August 2015 and August 2020. Exhibit MH1 provides numerous pages from the opponent's publications referred to above showing use of IELTS in relation to English language proficiency tests and supporting educational materials.

Mr Barreto's evidence

52) Mr Barretto is Global Head of IELTS Marketing at the British Council. He states that the British Council has, at least since 1996, provided the following services in the UK under the IELTS mark: Testing, examination and assessment services, publication of testing, examination and assessment materials (including examination papers and materials); all relating to the testing, examination and assessment of English language proficiency and skills and Educational services, provision of

instructional and training services and the publication of instructional, training and teaching materials; all relating to the testing, examination and assessment of English language proficiency and skills. He confirms that the British Council provides and authorises the provision of various IELTS tests, as described in Ms Hirtzel's statement.

53) Since 2006 the British Council and persons authorised thereby have provided testing, examination and assessment services in the form of the IELTS tests. The tests are provided at test centres throughout the UK. A table showing the locations of those test centres is provided⁵. There are 77 in total in places such as Aberdeen, Edinburgh, Northern Ireland, Birmingham, Bournemouth, Brighton, Bristol, Cardiff, Chester, Cork, Coventry, Exeter, Ipswich, Leeds, Leicester, London, Newcastle and Torquay.

54) Mr Barretto states that the British Council has, since 1 January 2014, provided an online preparation course called "Road to IELTS" which includes individual IELTS practice tests with answer keys and videos to help candidates prepare for the speaking element of the IELTS tests. 96,259 people in the UK have participated in that course before 20 August 2020 (which is an average of around 15,000 people per year from 2014 - 2019).

55) The British Council also provides training to individuals who wish to become IELTS examiners. That training is also conducted at the test centres referred to above. This training began in 2006 and 15, 531 people have been trained worldwide.

56) Mr Barretto states that the relevant public for the opponents' services consists of i) individuals wishing to prove their English language proficiency in order to migrate, or obtain work or a study visa, in the UK and Australia, New Zealand or Canada and those wishing to obtain British citizenship, study in higher education or obtain employment in the UK such as doctors and nurses, ii) organisations such the General Medical Council and the Nursing and Midwifery Council, schools, colleges

⁵ SB1, pages 2 and 3

and government bodies such as the UK Visas and Immigration and iii) teachers and examiners of English proficiency in the UK.

57) As of August 2020, the competitors of the IELTS test in the UK were: i) Test of English as a Foreign Language (TOEFL), ii) Pearson Test of English (PTE), iii) Occupational English Test (OET), iv) Trinity English Exams and v) LanguageCert English exams.

58) Based on country visa data for key English-speaking destination markets, namely Australia, Canada, New Zealand and the UK, adjusted for factors such as repeat test takers, the IELTS Tests had an approximate 60% share of the UK market in 2019.

59) The IELTS mark and services offered under it have been promoted on the IELTS Partners website and the British Council IELTS website. The former had 6,402,232 new visitors from the UK between 2005 and August 2020 and the latter had 1,954,401 new visitors from the UK between August 2015 and August 2020.

60) Between 2016 and 2021⁶ Google Adwords campaigns were run to promote the IELTS tests in the UK to drive internet search traffic to the British Council IELTS website and to secure test take bookings/raise awareness of the IELTS test in the UK. A table is provided listing each of those Adword campaigns along with the number of impressions (each time the advert was shown on a search result page), interactions (each time someone interacts with the advert e.g. clicking on it) and conversions (when a user performs some specified action after clicking on an advert such as signing up for an email list). There are 11 such campaigns in the table. A number of them indicate the area in the UK to which they targeted e.g. London, Edinburgh, Warwickshire and Belfast. Seven of those campaigns are shown below:

⁶ See Mr Barretto's second witness statement in which he corrects the date given his first witness statement

Campaign	Impressions	Interactions	Conversions
UK Life Skills - Targeted to prospective takers of the Life Skills Test	5,173,034	200,988	2,599.00
UK London - Geotargeted to London, targeting potential IELTS for UKVI test takers	805,438	129,604	8,397.00
UK TFL - Geotargeted to London, targeting potential IELTS for Transport for London test takers	255,703	17,976	518
UK Edinburgh - Geotargeted to Edinburgh, targeting potential IELTS for UKVI test takers	82,958	5,566	247
UK Cambridge- Geotargeted to Cambridge, targeting potential IELTS for UKVI test takers	85,428	10,941	1,110
UK UKVI - Targeted to prospective IELTS for UKVI test takers	248,918	31,076	609
Health Sector - Awareness campaign targeting healthcare workers in the UK	924,141	6,519	0

61) The IELTS services have been promoted in the UK on social media pages on Facebook, twitter, Instagram and LinkedIn.

62) In 2019, the British Council hosted the International Education Conference 2019 at the Edinburgh International Conference Centre, where attendees learnt about how best to promote UK education overseas, find out about international market conditions, discover best practice for supporting international students and network

with other international education strategists. A copy of the sponsorship webpage is provided for the said conference⁷ listing a number of sponsors, including IELTS which is described as the International English Language Testing System which is “the world’s most popular English Language test for higher education and global migration”.

63) Mr Barretto states that the IELTS exam is recognised by the General Medical Council, The Nursing and Midwifery Council and UK Visas and Immigration. All of these bodies accept IELTS test certificates as sufficient to prove an individual’s level of English language proficiency in order to either work or settle in the UK.

Ms McDowall’s evidence

64) Ms McDowall is a solicitor at Mills & Reeve LLP (the opponents’ legal representative in these proceedings). She provides prints of articles published in various UK newspapers including The Guardian, Daily Mail and The Independent⁸ detailing the IELTS tests provided by the opponents. Many of these articles speak of the renown of the IELTS test in the UK and/or that it is one of the leading providers of English language proficiency tests.

65) Ms McDowall also provides a selection of prints from the Wayback Machine⁹ for the period 2016 -2020 from websites used by the opponents. All give information about the various kinds of IELTS tests that are available (there are different tests depending on whether it is for Academic or work purposes or for the purpose of emigrating to another UK-speaking country such as Australia or Canada, for example). Some provide guidance to help prepare for the tests, sample test papers and training materials for teachers which all bear the IELTS mark. Some of the pages provide an option to book your IELTS test. IELTS is always used alongside what it stands for i.e. International English Language Testing System.

⁷ SB1, pages 6 and 7

⁸ JM1

⁹ JM3

Opponents' other evidence

66) There are eight other witness statements provided by the opponent.

67) Ms Bruzaite is Senior IELTS Administrator of Kings Oxford College. She delivers tests, including IELTS tests, at Kings Oxford College which is an IELTS Test Centre. She states she has been aware of the IELTS trade mark since 2014 and has always associated it with the opponents, who are the official owners of the test and with the provision of the services in class 41 covered by the opponent's earlier mark.

68) Mr Elwen has managed Examinations at the Centre of English Studies since 2003. He runs the CES Exams Centres in Leeds and Harrogate which have been running IELTS tests for more than 20 years as IELTS Test centres accredited by the British Council. He has been aware of the IELTS trade mark and its connection with exams and testing services in the UK since 2003. He has always associated the IELTS with the opponents. He states that, in his view, in August 2020 the main competitors of the opponent were Pearson, Occupational English Testing (OET) and Trinity College London. He believes that IELTS was the major provider of testing services in the Leeds and West Yorkshire areas at that time based upon the number of IELTS tests run by at this test centres and by research into his local competitors.

69) Ms Goel is Acting Head of Exams at International House London which has, since 2004, been an IELTS test centre accredited by the opponents to provide IELTS exams and preparation courses relating to the same. She has been aware of the IELTS mark since 2011 and has always associated it with the opponents in relation to the provision of its class 41 services. In her view, the UK market for the services provided under the IELTS mark consists of international students for education and immigration purposes, native English speakers for emigration and for registration with professional bodies.

70) Mr Hillman is Vice Principal of Southwark College which is another official IELTS test centre. The college also provides a range of intensive IELTS courses. He has been aware of the opponents' IELTS mark since 2016. He states that it is an internationally recognised brand, kite mark and standard for English language testing

skills. In his view, despite having some competitors such as the TOEFL (Test of English as a Foreign Language) the IELTS is one the market leaders in the UK for English qualifications. He makes this assessment based upon 25 years of curriculum experience and knowledge of awarding bodies.

71) Mr Madeley is the IELTS Test Centre Administrator at Chaucer College Canterbury, a position he has held since 2001. He has also worked as a teacher of IELTS Test preparation courses for Chaucer College students preparing to go on and study at the University of Kent. Mr Madeley states that since 1998 he has been aware of the IELTS mark as a recognised test of English language competence, well-known throughout the English language teaching and testing industry in the UK and he always associated IELTS with the opponents. Mr Madeley states that for the purposes of migration to Australia, Canada and New Zealand and for the purposes of obtaining a visa to remain in the UK, the IELTS test is the only English language test recognised by all the relevant national governments. He states that this is an indication of the established position of IELTS in the English language testing market in the UK and elsewhere.

72) Ms Pattinson is Head of Registration Operations at the General Medical Council. She is involved in the GMC application process. She explains that doctors often take the IELTS test to demonstrate their English language proficiency as part of the application process with the GMC to join the UK medical register and obtain a license to practice here.

73) Ms Pearson is the Exams Officer at LSI Portsmouth. Prior to that, for three years, she had been secretary and senior administrator to the director of the department running “English as a second language” (“ESL”) courses and IELTS exams for international students undertaking pre-sessional courses at the University of Portsmouth, for whom gaining an appropriate level in the IELTS exams is a requirement for University admission. For a further six years, she was a course administrator and senior administrator in the University’s Faculty of Technology, during which time she was aware that students’ IELTS levels were commonly referred to for undergraduate and postgraduate degree entry requirements. She has been aware of the IELTS mark since 1999 and has always associated it with the

opponents. She states that she associates the IELTS mark as a world-wide recognised provider of exams which tests candidates' English levels to a constant and rigorously reviewed standard. The IELTS test results are used by, for example, academic admissions departments including university, college and other educational institutions, employers and immigration services. In her view, in August 2020 IELTS was the main provider in the UK of an internationally recognised English Language testing system to provide an overall score which candidates can use when applying to academic institutions, workplaces or for immigration purposes. She makes this assessment based upon her awareness of the ESL marketplace, her observations of the IELTS administration/booking of exams process, along with dealing with student and candidate enquiries.

74) Mr Vicente is Head of Operations at Mobile Testing Solutions Ltd, a position which he has held for eleven years. MTS has been an official IELTS test centre, accredited by the British Council since 2017. In his view, the market for IELTS services are students, doctors, nurses and people who wish to emigrate to other countries. In December 2020 IELTS held, in his view, the strongest position in this market due to its reputation, recognition, validity and security.

75) Taking a collective view of the evidence before me, I find that the opponent's earlier mark is factually highly distinctive in the UK in relation to the following services covered in class 41: Educational services relating to the testing of English language skills; provision of instructional, training, teaching, testing, examination and/or assessment services in English language skills, including all the aforesaid services provided by computer assisted or computer based means or via distance learning programmes; publication in both electronic and paper format of instructional, training, teaching, testing, examination and/or assessment materials, including examination papers and syllabuses and materials, all for the testing of English language skills; testing of English language skills.

76) I reach this view despite the fact that the mark may be understood as standing for "International English Language Testing System". The evidence, taken in the round, shows that the opponents' services provided under the IELTS mark are highly regarded and recognised as one of the leading service providers in its field both

around the world and, in my view within the UK. Indeed, this is indicated not only by the opponents' evidence but also throughout the evidence submitted by the applicant.

Comparison of marks

77) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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.”

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

78) Both of the contested applications are for the mark IELTS MEDICAL and both of the earlier marks are for the mark IELTS. For ease of expression, I will therefore refer to each of the party's marks in the singular as 'the mark'. The respective marks to be compared are:

Earlier mark	Applicant's mark
IELTS	IELTS MEDICAL

Overall impression of each mark

79) The opponents' mark is made up of the five letters, IELTS. The mark does not lend itself to deconstruction into separate elements. The overall impression and distinctiveness of that mark lies in the whole. Turning to the applicant's mark, this consists of two elements, IELTS and the word MEDICAL. The latter word is likely to be perceived as descriptive of the nature/intended purpose/subject matter or target market (medical professionals) of the applicant's goods/services. Although MEDICAL is not negligible, it is the IELTS element which strongly dominates the overall impression of the mark.

Similarity

80) Visually, the opponents' mark is entirely contained at the beginning of the applicant's mark, followed by the word MEDICAL. It is a general rule of thumb that the beginnings of marks will tend to have the greatest impact upon the consumer's perception. I find that to be the case here. I find a medium degree of visual similarity between the marks.

81) Aurally, I consider it likely that the IELTS element is likely to pronounced as an initialism i.e. as the five separate letters, I-E-L-T-S. Even if I am wrong on that, and the average consumer attempts to pronounce it as an acronym (as a single word) i.e. as EYE-ELTS, for example, any such pronunciation is equally likely for both marks. IELTS is therefore a point of identity between the marks. The applicant's mark contains the additional word, MEDICAL, the pronunciation of which requires no explanation given that it is a common English word. Again, I bear in mind that it is likely to be the IELTS part of the contested mark that will have the greatest impact

upon the average consumer given its position at the beginning of the mark. I find a medium degree of aural similarity between the marks.

82) Conceptually, the applicant submits that IELTS stands for 'International English Language Testing System' and that is the meaning that will be perceived from those letters. I do not consider that such a meaning is immediately apparent from the letters IELTS, of themselves, without more in the mark to lead the consumer to such a perception. IELTS, of itself, is meaningless. Even if I am wrong on that, and the consumer does immediately perceive IELTS as meaning 'International English Language Testing System', such a perception is equally likely for both marks. It follows that, insofar as IELTS evokes any concept at all beyond a mere string of letters, it will be the same for both marks. Although the applicant's mark contains the additional MEDICAL concept which is not present in the earlier mark, I keep in mind that that is not a distinctive conceptual difference.

Likelihood of confusion

83) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

84) I will first consider the likelihood of direct confusion. The applicant's contested goods and services in classes 09 and 41 covered by application '855 are conceded to be identical or similar to the opponent's goods and services. I have also found that some of the applicant's services in class 35 covered by the same mark are similar to the opponent's class 41 services. As regards application '004, the applicant's goods in class 16 are conceded to be identical or similar to the opponent's goods and I

have found that the contested services in class 42 covered by mark '004 are similar to a high or medium degree to the opponent's class 09 goods. The earlier mark is factually highly distinctive in relation to the following services in class 41: Educational services relating to the testing of English language skills; provision of instructional, training, teaching, testing, examination and/or assessment services in English language skills, including all the aforesaid services provided by computer assisted or computer based means or via distance learning programmes; publication in both electronic and paper format of instructional, training, teaching, testing, examination and/or assessment materials, including examination papers and syllabuses and materials, all for the testing of English language skills; testing of English language skills. For all other goods and services relied upon, it has a normal degree of distinctiveness. There is a medium degree of visual and aural similarity between the respective marks. Conceptually, insofar as IETLS evokes any concept at all beyond a meaningless string of letters, it will be the same meaning in both parties' marks. Further, although MEDICAL creates a point of conceptual difference, it is not a distinctive one. Weighing all these factors, I find that the average consumer, paying an above normal degree of attention during a mainly visual purchase is unlikely to mistake one mark for the other in relation to all of the goods and services at issue. There is no likelihood of direct confusion.

85) I now turn to consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example)”.

86) In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

87) Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

88) The common element between the earlier mark and the applicant’s mark is ‘IELTS’. The point of difference between the marks lies in the descriptive word, MEDICAL. Further, IELTS is factually highly distinctive for some of the earlier services

and at least normally distinctive for the others. Weighing all relevant factors, and bearing in mind the comments of Mr Purvis set out above, I am of the firm view that the circumstances of the instant case fall squarely within the type of indirect confusion described by Mr Purvis in his category (b). The applicant's mark simply adds the non-distinctive element, MEDICAL, to the earlier mark. I find that the average consumer paying an above normal degree of attention during the mainly visual purchase is likely to perceive the applicant's mark as a sub-brand or brand extension of the earlier mark. There is a likelihood of indirect confusion in respect of all the goods and services which are identical or share some degree of similarity.

89) I add here that, if I am wrong to have found that the earlier mark is factually highly distinctive or normally inherently distinctive, I would still have found a likelihood of indirect confusion even if I had found the earlier mark's distinctive to be low. In this connection, Mr Pearson referred me, at the hearing, to *Office Cleaning Services Limited v Westminster Window and General Cleaners Limited* [1946] 63 RPC 39, which in his submission supports the applicant's contention that the addition of the word MEDICAL is sufficient to avert confusion because of, he submitted, the descriptive or low degree of distinctiveness of IETLS. I note that case. However, I disagree that the addition of the entirely non-distinctive element MEDICAL to the lowly distinctive IELTS element (supposing that my primary finding of normal inherent distinctiveness and high factual distinctiveness is wrong) is sufficient to avert confusion in the instant case, bearing in mind the identity of the common element and the identity/similarity between the respective goods and services.

Parallel trading

90) Having concluded that there is a prima facie likelihood of indirect confusion, I must now deal with the applicant's evidence purporting to show that there has, in fact, been no confusion between the respective marks, despite the applicant being operational since 2017, such that there was, in fact, no likelihood of confusion at the relevant date. In this connection, Mr Pearson referred me, at the hearing to the case of *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch) where Arnold J (as he then was) said at [167]: "As I have said in a number of judgments, absence of actual confusion is not necessarily fatal to a claim under art.9(1)(b) [involving the same principles relating to the likelihood of confusion]. The longer the use complained of has gone on in parallel

with the use of the trade mark without such evidence emerging, however, the more significant it is. In the present case over 6 years have elapsed without any such evidence emerging. In my judgment this is an important factor in the present case.”

91) Ms Nze states that she incorporated IELTS Medical Ltd on 5 September 2016. The domain name ieltsmedical.co.uk was registered on 24 July 2018. She provides pages from her company’s website with testimonials from clients and which, she states, shows use of IELTS MEDICAL dating back to 2017. The relevant exhibit¹⁰ shows:

- A print from the home page of the applicant’s website showing ‘IELTS MEDICAL’ preceded by the stylised device of a heart in a circle, above the strap-line ‘TRAINING TOMORROW’S UK MEDICS’.
- A handful of reviews from clients. The nature of the goods/services being reviewed is not clear in some of the reviews. I note that most of the others appear to give reviews in relation to Mental Health OSCE Training provided by the applicant in preparation for the Mental Health OSCE Exam or training for the OET exam.
- The rest of the exhibit shows a number of articles from 2017 from the applicant’s website. The articles appear to give information about the IELTS Medical exam (i.e. the exams provided by the opponent), advice on how to prepare for that exam and adverts for workshops which will be provided by the applicant to assist with preparation for the exam.

92) Ms Nze states that she has spent more than £60,000 on advertising since the inception of her company.

93) Ms Nze explains that her company provides training to healthcare professionals, including both English language courses and medical courses, with the aim of helping international medical professionals to achieve UK registration with medical regulators.

94) Ms Nze states that her company promotes the IELTS MEDICAL mark on social media, namely on Facebook. Her company’s Facebook page was created on 23 July

¹⁰ NN1

2016 and has 4.086 followers and over 350 people who have tagged themselves as having visited her company in person. The relevant exhibit¹¹ shows:

- A print from the applicant's Facebook page. The mark IELTS MEDICAL is present in small font on the top of the first page (together with the same strap-line and stylised heart device as described above). IELTS MEDICAL is not visible anywhere else on the Facebook page or any of the posts on that page.
- There is a large and prominent stylised device of a heart in a circle on the top left-hand-side of the page, above the words: 'IELTS, OET, OSCE, PLAB for Medical Professionals Preparation Centre Daily'. A number of courses are advertised on the page such as 'IELTS Training and Review in Person Course' and OET and OSCE Training courses.

95) Ms Nze states that the applicant has created IELTS MEDICAL software applications which can be downloaded from the Apple App and Google Play Store. At the date of Ms Nze's statement, she states that, these applications have been downloaded more than 71,427 times. The relevant exhibit¹² relating to these applications shows:

- A print from the applicant's website showing a number of available applications. They all bear the IELTS MEDICAL mark (with the strap-line and stylised heart device). There are a number of different kinds of applications including 'IELTS for healthcare professionals', 'OET for doctors', 'CBT for nurses', 'OSCE for children's nurses' and 'OSCE for midwives'.

96) Ms Nze states that IELTS MEDICAL is also promoted on YouTube. The relevant YouTube page was created on 11 September 2016 and over 3 million people have viewed the applicant's videos on that page. Extracts from those videos are provided¹³ showing a description about the applicant's services. It describes itself as the premier training service for international healthcare professionals providing courses relating to

¹¹ NN2

¹² NN3

¹³ NN4

IELTS, OET, CBT and OSCE exams. The mark IELTS MEDICAL is present (again used with the stylised heart device and the strap-line described above).

97) Ms Nze states that the applicant has published various books under the IELTS MEDICAL mark to help prospective nurses and doctors to prepare for their exams. Examples of these are provided¹⁴. The relevant exhibit shows around a dozen different textbooks listed on the applicant's website. Only one of these relates to the IELTS exam (entitled 'IELTS for Healthcare Professionals'). All the others relate to different qualifications/exams such as CBT, OSCE, OET. Ms Nze states that over 2,000 of these publications have been sold.

98) In *Roger Maier and Another v ASOS*¹⁵ Kitchin L.J. stated that:

"80.the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur."

The applicant has provided no financial turnover figures for the goods or services it has provided. Further, the amount spent on advertising (£60,000) is far from substantial for the three-year period prior to the relevant date (between 2017 and 2020 when the relevant applications were filed), and there is no explanation of precisely what that advertising consisted of aside from the reference to use on Facebook and YouTube. The number of followers on its Facebook page also appears to be low and

¹⁴ NN5

¹⁵ [2015] EWCA Civ 220

the number of reviews provided is small. The precise nature of the services it has provided is also not altogether clear from the evidence before me. Although I accept that there is likely to have been some use in relation to the provision of workshops for the purpose of preparation for professional examinations, the extent of that use is not clear. Further, the number of applications downloaded is not particularly high (71, 427) and the number of publications sold (2,000) is small. A further factor to bear in mind is that much of the use of the contested mark in the evidence before me is not of the mark as applied for but, rather, shows use with the stylised heart device. Such use may have made confusion less likely than would be the case if the mark had been used as the words IELTS MEDICAL alone. Bearing in mind all of the aforesaid, I find that the evidence before me is not sufficient to establish that the respective marks have been used 'side-by-side' on such a scale and/or for such a length of time in relation to the relevant goods and services at issue such that the average consumer has been shown to be able to distinguish between them or to satisfy me that there is no likelihood of confusion in the future, bearing in mind notional use of the respective marks in relation to all of the relevant goods and services at issue.

Acquiescence

99) In her witness statement, Ms Nze states:

“12. Party A [the opponents] was also fully aware of Party B's [the applicant's] existence since 2017. Attached at redacted **exhibit NN6** is dated email correspondence between myself and Mobile Testing Solutions Ltd, who used to deliver IELTS exams to our candidates on our premises between 2016 and 2017. Party A at that stage chose to take no action against Party B. This suggests that Party A was aware of the use of IELTS MEDICAL by Party B as far back as 2017, at the very latest, and have only decided to take action against Party B at this late juncture...”

This appears to be a claim that the opponents have acquiesced to the use of the contested mark. No such defence was pleaded in the counterstatements. In any event, the defence does not assist the applicant. Statutory acquiescence is provided for in section 48 of the Act and only applies to registered marks. The contested mark is not a registered mark. Statutory acquiescence therefore does not apply. Further, the issue

of whether common law defences can be applied under EU-derived trade mark law is covered in *Kerly's Law of Trade Marks and Trade Names* as follows:

“17-107 The issue was considered by the English High Court, sitting as an EU trade mark court, in *Marussia Communications Ireland Ltd v Manor Grand Prix Racing*, in which Males J relied on the decision of the CJEU in *Martin y Paz* in coming to the conclusion that defences of estoppel and acquiescence were not available to defendants under the EUTM. The defendant in that case did not argue that substantive national defences were not available to defeat infringement claims, but instead contended that estoppel and acquiescence were procedural matters which fell within art. 129(3) of the EUTM Regulation. That contention was rejected by the court. As the law stands in the UK therefore, national defences of estoppel and acquiescence are not available to defendants in trade mark matters.”

100) Accordingly, insofar as Ms Nze's witness statement appears to put forward a defence of acquiescence, that defence must be dismissed.

101) The opposition under section 5(2)(b) succeeds against all the contested goods and services in classes 09 and 41 and some of the contested services in class 35 covered by application '855 (those which have been found to be similar to the earlier class 41 services).

102) The opposition under section 5(2)(b) also succeeds against all of the contested goods and services in classes 16 and 42 covered by application '004.

Section 5(3)

103) Section 5(3) of the Act provides:

“(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 the repute of the earlier trade mark.”

104) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74* and *the court's answer to question 1 in L'Oreal v Bellure*).

Reputation

105) Bearing in mind my earlier comments when assessing the distinctiveness of the earlier mark, I find that the opponent's IELTS mark is likely to have been known by a significant part of the relevant public of the following services, in the UK, at the relevant date: 'Educational services relating to the testing of English language skills; provision of instructional, training, teaching, testing, examination and/or assessment services in English language skills, including all the aforesaid services provided by computer assisted or computer based means or via distance learning programmes; publication in both electronic and paper format of instructional, training, teaching, testing, examination and/or assessment materials, including examination papers and syllabuses and materials, all for the testing of English language skills; testing of English language skills'. The relevant public of those particular services consists mainly of students or professional individuals (particularly doctors and nurses) wishing to pass certain examinations for work, study and/or immigration purposes, but also teachers requiring training and/or teaching materials and members of the UK general public who wish to obtain proof of their general English language proficiency for the purposes of emigrating to another English language speaking country (such as Australia or Canada). I find that that reputation was a strong one. It was also a prestigious one given that the evidence before me clearly indicates that the opponent's services provided under its IELTS mark are held in high regard.

Link

106) Whether the relevant public will make the required mental 'link' between the opponents' mark and the contested marks must take account of all relevant factors. The relevant factors identified in Case C-252/07, *Intel* [2009] ETMR 13 are:

i) The degree of similarity between the conflicting marks

107) I have already assessed this under section 5(2)(b). There is a medium degree of visual and aural similarity between the respective marks. Conceptually, insofar as IELTS evokes any concept at all beyond a meaningless string of letters, it will be the same meaning in both parties' marks and although MEDICAL creates a point of conceptual difference, it is not a distinctive one.

ii) The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

108) I find that the following goods and services of application '855 are either plainly identical, or similar to some degree, to the services in which the opponent has a reputation:

Class 09: Educational, teaching, instruction, research, training, testing, examination or assessment apparatus and instruments; electronic apparatus for medical teaching, training, testing, examination and assessment purposes; publications in electronic format in the field of medical education; on-line electronic publications in the field of medical education; downloadable electronic publications; downloadable electronic books, magazines, newsletters, newspapers, journals, and periodicals, all in relation to medical education; downloadable instructional, teaching, training and educational materials, all in relation to medical study; downloadable educational examination and test materials; downloadable medical study guides; downloadable instructional manuals for teaching; computer software applications for educational, teaching, research, training, testing, examination and assessment purposes; computer software and computer software platforms for educational, teaching, research, training, testing, examination and assessment purposes; optical data media; magnetic data media; data storage and data memory apparatus; media bearing electronic publications or educational, teaching, research, training, testing, examination and assessment software; compact discs, DVDs and other digital recording media for teaching, training or assessment purposes; mobile applications; educational mobile applications.

Class 35: online and offline wholesale, retail, import and export services for the sale of publications in electronic format in the field of medical education, on-line electronic publications in the field of medical education, downloadable electronic publications, downloadable electronic books, magazines, newsletters, newspapers, journals, and periodicals, all in relation to medical

education, downloadable instructional, teaching, training and educational materials, all in relation to medical study, downloadable educational examination and test materials, downloadable medical study guides, downloadable instructional manuals for teaching, media bearing electronic publications, compact discs, DVDs and other digital recording media for teaching, training or assessment purposes.

Class 41: Educational services; educational services in the nature of medical schools, graduate schools, and nursing schools; establishing tests and examinations for medical students, potential medical students, doctors and nurses; operating tests and examinations for medical students, potential medical students, doctors and nurses ; publication of texts of test papers, examination papers, sample test papers, sample examination papers; publication of documents relating to tests and examinations particularly relating to aptitude and admission tests for higher education courses such as degree courses in university medical schools; establishment of aptitude and admission tests for higher education courses; operation of aptitude and admissions tests for higher education courses; establishment and operation of aptitude and admissions tests for higher education courses, particularly degree courses in university medical schools; arranging of tests and examinations for educational purposes, particularly admissions; educational examination; information services relating to educational tests and examinations; organisation of educational competitions; administering of professional competency examinations for testing students and graduates of medical schools to ascertain their competence to be licensed to practice medicine; provision of distance learning programs; all the aforesaid services being provided in paper-based (hard copy), electronic or on-line format.

109) Where the respective services are not identical, the relevant public for the respective services is still likely to be the same or, at least, overlap significantly. The respective nature and intended purpose of the goods and services is also similar given that they are all for the purposes of education, albeit that the respective subject matter may not always be the same (e.g. English language skills v medical

education). There may also be a degree of competition and or complementarity between some of the respective goods and services.

110) The following goods and services of application '855 are not similar to the services in which the opponent has a reputation:

Class 09: electronic book readers; apparatus for recording, transmission or reproduction of sound, data, text or images; software for the arrangement of rental accommodation; software for the booking of student rental accommodation; computer software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text and electronic publications; educational computer games software.

Class 35: Advertising, marketing and promotional services; office function; business administration; business advice; online and offline wholesale, retail, import and export services for the sale of educational, teaching, instruction, research, training, testing, examination or assessment apparatus and instruments, electronic apparatus for medical teaching, training, testing, examination and assessment purposes, electronic book readers, apparatus for recording, transmission or reproduction of sound, data, text or images, computer software applications for educational, teaching, research, training, testing, examination and assessment purposes, computer software and computer software platforms for educational, teaching, research, training, testing, examination and assessment purposes, software for the arrangement of rental accommodation, software for the booking of student rental accommodation, computer software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text and electronic publications, educational computer games software, optical data media, magnetic data media, data storage and data memory apparatus, or educational, teaching, research, training, testing, examination and assessment software, mobile applications, educational mobile applications.

Class 38: Telecommunication; telecommunication services; audio video broadcasting via the internet; communication between computers; communication by computers; communication by online blogs; access to content, websites and portals; provision of access to content, websites and portals; providing user access to portals on the internet; on-line chat room services; on-line chat rooms enabling communication between students and teachers.

This is because the respective nature, purpose and methods of use of the services appears to be different and neither is there any obvious competitive or complementary relationship in play, in the sense described in the case law. The respective users are also unlikely to be the same in respect of some of the contested services, such as 'Advertising, marketing and promotional services; office function; business administration; business advice' where the relevant public is likely to consist mainly of businesses.

111) I find that the following goods and services of application '004 are similar to the services in which the opponent has a reputation:

Class 16: Printed matter; books; textbooks; workbooks; magazines; newsletters; instructional and teaching material; books, textbooks, workbooks, magazines, newsletters, instructional and teaching material in relation to medical education and medical study; educational, teaching, instruction, research, training, testing, examination or assessment material; educational, teaching, instruction, research, training, testing, examination or assessment material in relation to medical education and medical study; publications in the field of medical education; journals, and periodicals in relation to medical education and medical study; newspapers; leaflets; medical study guides; medical study booklets.

This is because the respective users are likely to be the same or overlap significantly. The respective purpose and nature is the same or at least similar in that they all may contain educational subject matter.

112) The following goods and services of application '004 are not similar to the services in which the opponent has a reputation:

Class 16: stationery; notebooks; calendars; posters; office requisites.

Class 42: Computer services; providing information via an Internet website; design services; design and development of software; design and development of educational software; software as a service; website design services; industrial analysis and research services; scientific research; scientific risk assessment; scientific research, development and analysis.

Class 44: Medical services; healthcare services; healthcare establishments; organisation of healthcare and medical tests; medical and hospital consultations; organisation of health care, analyses and medical tests, in particular by doctors and in hospitals; information and advice for health; health advice and information services; providing health information.

This is because the respective nature, purpose, methods of use and trade channels of the respective goods and services appears to be different and neither is there any obvious competitive or complementary relationship in play, in the sense described in the case law. The respective users are also unlikely to be the same in respect of most of the contested goods and services and even where there may be overlap in consumer with the earlier services, this is unlikely to be to a significant extent.

iii) The strength of the earlier mark's reputation

113) The earlier mark has a strong reputation in relation to 'Educational services relating to the testing of English language skills; provision of instructional, training, teaching, testing, examination and/or assessment services in English language skills, including all the aforesaid services provided by computer assisted or computer based means or via distance learning programmes; publication in both electronic and paper format of instructional, training, teaching, testing, examination and/or

assessment materials, including examination papers and syllabuses and materials, all for the testing of English language skills; testing of English language skills’.

iv) The degree of the earlier mark’s distinctive character, whether inherent or acquired through use

114) The earlier mark was factually highly distinctive at the relevant date consequent upon the use made of it in relation to ‘Educational services relating to the testing of English language skills; provision of instructional, training, teaching, testing, examination and/or assessment services in English language skills, including all the aforesaid services provided by computer assisted or computer based means or via distance learning programmes; publication in both electronic and paper format of instructional, training, teaching, testing, examination and/or assessment materials, including examination papers and syllabuses and materials, all for the testing of English language skills; testing of English language skills’.

v) Whether there is a likelihood of confusion

115) I find that there is a likelihood of indirect confusion between the opponent’s IELTS mark in relation to the services for which it has a reputation and the contested goods and services of the applications which have been found to be identical or similar to those services. In reaching this view, I have borne in mind the similarity between the respective marks and goods and services and that the earlier mark is factually highly distinctive for the earlier services. I have also borne in mind the above normal degree of attention that its likely to be paid during the mainly visual purchase (without disregarding the aural element of the purchase) and the degree of similarity between the marks. The average consumer is likely to believe that the contested mark is a variant or brand extension of the earlier mark.

116) There is no likelihood of confusion between the earlier mark, for the services for which it has a reputation, and the goods and services covered by the contested marks which have been found to be dissimilar to those services.

Findings on Link and damage in relation to the contested goods and services for which there is a likelihood of indirect confusion

117) Where I have found a likelihood of indirect confusion, it is implicit in this finding that a link would be made between the respective marks. Such a link also means that there is a non-hypothetical risk that the positive characteristics associated with the earlier mark, namely the mark's prestigious reputation, will directly transfer to the applicant's marks. This association with the opponents' reputed mark would make the applicant's mark more attractive to the relevant public and give the applicant more custom than it otherwise would have enjoyed and make its job of marketing its goods and services easier. As this would come without paying any compensation to the opponents, and without the applicant expending the money necessary to create a market for its own goods and services in the UK, I find that this constitutes unfair advantage. Having reached such a conclusion, I do not consider it necessary to also consider whether there would be detriment to the distinctive character of the earlier mark.

Findings on Link and damage for the following contested services in classes 35 and 38 (for which there is no likelihood of confusion):

Class 35: online and offline wholesale, retail, import and export services for the sale of educational, teaching, instruction, research, training, testing, examination or assessment apparatus and instruments, electronic apparatus for medical teaching, training, testing, examination and assessment purposes, electronic book readers, apparatus for recording, transmission or reproduction of sound, data, text or images, computer software applications for educational, teaching, research, training, testing, examination and assessment purposes, computer software and computer software platforms for educational, teaching, research, training, testing, examination and assessment purposes, computer software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text and electronic publications, educational computer games software, optical data media, magnetic data media, data storage and data memory apparatus, or educational, teaching, research, training, testing,

examination and assessment software, mobile applications, educational mobile applications.

Class 38: Telecommunication; telecommunication services; audio video broadcasting via the internet; communication between computers; communication by computers; communication by online blogs; access to content, websites and portals; provision of access to content, websites and portals; providing user access to portals on the internet; on-line chat room services; on-line chat rooms enabling communication between students and teachers.

118) I find that, despite the dissimilarity between the applicant's services listed directly above in classes 35 and 38 and the opponent's services in which the earlier mark has a reputation, the earlier mark is, nevertheless, likely to be brought to mind when the contested mark is encountered by the relevant public in relation to the applicant's services. In reaching this view, I have borne in mind that there is likely to be significant overlap in the relevant public of both parties' services (taking into account that all of the applicant's class 38 services cover the provision of chat rooms/portals or other means of communication between students and teachers), the degree of similarity between the marks and that the earlier mark is factually highly distinctive and has a strong reputation for the relevant earlier services.

119) I find that there is a non-hypothetical risk that the link that is made will result in the positive characteristics associated with the earlier mark, namely the mark's prestigious reputation, transferring to the applicant's mark. This association with the opponents' reputed mark would make the applicant's mark more attractive to the relevant public and give the applicant more custom than it otherwise would have enjoyed and make its job of marketing its goods and services easier. As this would come without paying any compensation to the opponents, and without the applicant expending the money necessary to create a market for its own goods and services in the UK, I find that this constitutes unfair advantage.

120) I do not, however, consider that the link that is made is likely to lead to detriment to the distinctive character of the earlier mark. It is difficult to see why that would occur in the absence of a likelihood of confusion.

Findings on Link and damage for the following contested services in classes 35, 42 and 44 (for which there is no likelihood of confusion):

Class 35: Advertising, marketing and promotional services; office function; business administration; business advice. online and offline wholesale, retail, import and export services for the sale of software for the arrangement of rental accommodation, software for the booking of student rental accommodation.

Class 42: industrial analysis and research services; scientific research; scientific risk assessment; scientific research, development and analysis.

Class 44: Medical services; healthcare services; healthcare establishments; organisation of healthcare and medical tests; medical and hospital consultations; organisation of health care, analyses and medical tests, in particular by doctors and in hospitals; information and advice for health; health advice and information services; providing health information.

121) The above services of the applicant are dissimilar to those in which the earlier mark has a reputation. The relevant public for the contested services in classes 35 and 42 is likely to consist mainly of businesses whereas the relevant public for the earlier services is likely to be different, as identified earlier. There is, therefore, likely to be little overlap in the relevant consumer of the contested services in classes 35 and 42 and the services in which the earlier mark enjoys a reputation. I therefore do not consider that there is a likelihood of a significant proportion of the relevant public for the applicant's services making the requisite link with the earlier mark.

122) Turning to the contested services in class 44, the relevant public for these services is the general public at large. While the relevant public for the earlier services includes, in part, members of the general public, this is limited to a specific

section of the general public who wish to emigrate to another English Language speaking country. Bearing this in mind, I am not persuaded that there is a likelihood that a significant proportion of the general public at large, when faced with the contested mark on the various medical services applied for, would make the requisite link with the earlier mark, bearing in mind, also, the overall dissimilarity of the services and notwithstanding the strong reputation and high factual distinctiveness of the earlier mark and the similarity between the marks.

123) The requisite link is not established for any of the contested services in classes 35, 42 and 44 listed above. Without a link, there can be no damage.

Link and damage for the following contested services in classes 09, 16 and 42:

Class 09: electronic book readers; apparatus for recording, transmission or reproduction of sound, data, text or images; software for the arrangement of rental accommodation; software for the booking of student rental accommodation; computer software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text and electronic publications; educational computer games software.

Class 16: stationery; notebooks; calendars; posters; office requisites.

Class 42: Computer services; providing information via an Internet website; design services; design and development of software; design and development of educational software; software as a service; website design services.

124) I have found no likelihood of confusion between these services of the contested mark, listed above, and the services in which the opponent's earlier mark has a reputation. However, I have already found a likelihood of confusion under section 5(2)(b) between these services and those in classes 09 and 16 covered by the opponent's '510 mark. In the circumstances, I do not consider it necessary to also

consider whether there would be a link and damage under section 5(3) in relation to the same.

Without due cause

125) Having concluded that there is a likelihood of the requisite link and damage occurring in relation to some of the contested goods and services covered by the applicant's marks, I now need to deal with the applicant's claim that it has due cause to use its marks. I note that such a defence was not raised in the counterstatements. Nevertheless, at the hearing, Mr Pearson relied upon the following statement, and supporting exhibit, given by Ms Nze in her evidence in support of the applicant's claim of due cause:

"12. Party A [the opponents] was also fully aware of Party B's [the applicant's] existence since 2017. Attached at redacted **exhibit NN6** is dated email correspondence between myself and Mobile Testing Solutions Ltd, who used to deliver IELTS exams to our candidates on our premises between 2016 and 2017. Party A at that stage chose to take no action against Party B. This suggests that Party A was aware of the use of IELTS MEDICAL by Party B as far back as 2017,..."

Mr Pearson submitted that, in the light of the above evidence, it is a reasonable inference that the supply of the opponent's exams to the applicant at that time was with the opponent's knowledge and consent which, in his submission, shows that the applicant has due cause to use its mark.

126) At the most, this indicates that the opponent's licensee tolerated the use of IELTS MEDICAL as a trading name/company name (not a trade mark) during a time when there was a collaboration between it and the applicant to deliver the opponent's exams on the applicant's premises to candidates put forward by the applicant. I do not consider that that justifies a finding that the opponent should now be expected to tolerate the use, by the applicant, of IELTS MEDICAL as a trade mark, in relation to any or all of the goods and services applied for, to designate its own goods and services. Further, and in any event, it is not entirely clear to me precisely which goods

and services covered by the applications were being supplied by the applicant during the time of the said collaboration which the opponent's licensee is said to have been aware of, aside from providing premises and possibly arranging/facilitating the provision of English Language Tests. The applicant has not satisfied me that it has due cause to use the contested mark in relation to any of the goods and services applied for.

OVERALL OUTCOME

127) The opposition succeeds against the following goods and services:

Application '855:

Class 09: Educational, teaching, instruction, research, training, testing, examination or assessment apparatus and instruments; electronic apparatus for medical teaching, training, testing, examination and assessment purposes; publications in electronic format in the field of medical education; on-line electronic publications in the field of medical education; downloadable electronic publications; downloadable electronic books, magazines, newsletters, newspapers, journals, and periodicals, all in relation to medical education; downloadable instructional, teaching, training and educational materials, all in relation to medical study; downloadable educational examination and test materials; downloadable medical study guides; downloadable instructional manuals for teaching; electronic book readers; apparatus for recording, transmission or reproduction of sound, data, text or images; computer software applications for educational, teaching, research, training, testing, examination and assessment purposes; computer software and computer software platforms for educational, teaching, research, training, testing, examination and assessment purposes; software for the arrangement of rental accommodation; software for the booking of student rental accommodation; computer software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text and electronic publications; educational computer games software; optical data media; magnetic data media; data storage and data

memory apparatus; media bearing electronic publications or educational, teaching, research, training, testing, examination and assessment software; compact discs, DVDs and other digital recording media for teaching, training or assessment purposes; mobile applications; educational mobile applications.

Class 35: online and offline wholesale, retail, import and export services for the sale of educational, teaching, instruction, research, training, testing, examination or assessment apparatus and instruments, electronic apparatus for medical teaching, training, testing, examination and assessment purposes, publications in electronic format in the field of medical education, on-line electronic publications in the field of medical education, downloadable electronic publications, downloadable electronic books, magazines, newsletters, newspapers, journals, and periodicals, all in relation to medical education, downloadable instructional, teaching, training and educational materials, all in relation to medical study, downloadable educational examination and test materials, downloadable medical study guides, downloadable instructional manuals for teaching, electronic book readers, apparatus for recording, transmission or reproduction of sound, data, text or images, computer software applications for educational, teaching, research, training, testing, examination and assessment purposes, computer software and computer software platforms for educational, teaching, research, training, testing, examination and assessment purposes, computer software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text and electronic publications, educational computer games software, optical data media, magnetic data media, data storage and data memory apparatus, media bearing electronic publications or educational, teaching, research, training, testing, examination and assessment software, compact discs, DVDs and other digital recording media for teaching, training or assessment purposes, mobile applications, educational mobile applications.

Class 38: Telecommunication; telecommunication services; audio video broadcasting via the internet; communication between computers;

communication by computers; communication by online blogs; access to content, websites and portals; provision of access to content, websites and portals; providing user access to portals on the internet; on-line chat room services; on-line chat rooms enabling communication between students and teachers.

Class 41: Educational services; educational services in the nature of medical schools, graduate schools, and nursing schools; establishing tests and examinations for medical students, potential medical students, doctors and nurses; operating tests and examinations for medical students, potential medical students, doctors and nurses ; publication of texts of test papers, examination papers, sample test papers, sample examination papers; publication of documents relating to tests and examinations particularly relating to aptitude and admission tests for higher education courses such as degree courses in university medical schools; establishment of aptitude and admission tests for higher education courses; operation of aptitude and admissions tests for higher education courses; establishment and operation of aptitude and admissions tests for higher education courses, particularly degree courses in university medical schools; arranging of tests and examinations for educational purposes, particularly admissions; educational examination; information services relating to educational tests and examinations; organisation of educational competitions; administering of professional competency examinations for testing students and graduates of medical schools to ascertain their competence to be licensed to practice medicine; provision of distance learning programs; all the aforesaid services being provided in paper-based (hard copy), electronic or on-line format.

Application '004:

Class 16: Printed matter; books; textbooks; workbooks; magazines; newsletters; instructional and teaching material; books, textbooks, workbooks, magazines, newsletters, instructional and teaching material in relation to medical education and medical study; educational, teaching, instruction, research, training, testing, examination or assessment material; educational,

teaching, instruction, research, training, testing, examination or assessment material in relation to medical education and medical study; publications in the field of medical education; journals, and periodicals in relation to medical education and medical study; newspapers; leaflets; medical study guides; medical study booklets; stationery; notebooks; calendars; posters; office requisites.

Class 42: Computer services; providing information via an Internet website; design services; design and development of software; design and development of educational software; software as a service; website design services.

128) The opposition **fails** against the following goods and services:

Application '855:

Class 35: Advertising, marketing and promotional services; office function; business administration; business advice; online and offline wholesale, retail, import and export services for the sale of software for the arrangement of rental accommodation, software for the booking of student rental accommodation.

Application '004:

Class 42: industrial analysis and research services; scientific research; scientific risk assessment; scientific research, development and analysis.

Class 44: Medical services; healthcare services; healthcare establishments; organisation of healthcare and medical tests; medical and hospital consultations; organisation of health care, analyses and medical tests, in particular by doctors and in hospitals; information and advice for health; health advice and information services; providing health information.

COSTS

129) The opponents have had a greater degree of success than the applicant. I estimate the ratio of the success to be roughly 80%:20% in the opponent's favour. Using the guidance in Tribunal Practice Notice 2/2016, but allowing for the applicant's degree of success, I award the opponents costs on the following basis:

Preparing statements and considering the other side's statements x 4	£800
Preparing and filing evidence and considering the applicant's evidence	£1200
Preparing for, and attending, the hearing	£600
Total:	£2600 x 0.8
Overall total:	£2,080

130) I order IELTS Medical Ltd to pay The Chancellor, Masters and Scholars of the University of Cambridge, The British Council and IELTS Australia Pty Limited the sum of **£2,080**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 28th day of October 2022

Beverley Hedley
For the Registrar,
the Comptroller-General