O/0090/26

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO. 3739581
IN THE NAME OF CAMBRIDGE ROWING LTD
IN RESPECT OF THE TRADE MARK

IN CLASSES 25, 35 & 41

AND

THE OPPOSITION THERETO UNDER NO. 433477
BY THE CHANCELLOR, MASTERS AND SCHOLARS OF THE UNIVERSITY OF CAMBRIDGE

Background and pleadings

1. Cambridge Rowing Ltd ("the applicant") applied to register the trade mark no. 3739581 shown on the cover page of this decision in the UK on 5 January 2022. It was accepted and published in the Trade Marks Journal on 11 February 2022 in respect of the following goods and services:

> **Class 25:** *Sports clothing; Sports wear; Sports jackets; Clothes for sport.*
>
> **Class 35:** *Merchandising; Inventorying merchandise; Product merchandising; Business merchandising display services; Display services for merchandise; Product merchandising for others; Preparing promotional and merchandising material for others.*
>
> **Class 41:** *Corporate hospitality (entertainment); Hospitality services (entertainment); Sports activities; Sport camps; Sporting services; Sporting activities; Instruction in sports; Sports entertainment services; Training in sports; Sports coaching services; Sports and fitness; Organising of sporting events, competitions and sporting tournaments; Operation of sports facilities.*

2. On 12 May 2022, The Chancellor, Masters and Scholars of the University of Cambridge ("the opponent") opposed the trade mark on the basis of sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). The oppositions under section 5(2)(b) and 5(3) are based on its earlier UK and UK comparable trade marks below:[1]

[1] Within the skeleton arguments filed and during submissions made at the hearing, the representative for the opponent confirmed that no case of genuine use had been put forward for some of the marks and some of the goods originally relied upon. I have therefore only listed those that are still relevant at this stage in the proceedings here.

Opposition under section 5(2)(b) only

UK comparable trade mark[2] no. 901771997

Filing date: 24 July 2000

Registration date: 03 September 2001

Relying on goods in class 25, including:

Class 25: ***Clothing, headgear.***

UK comparable trade mark no. 909896705

Filing date: 14 April 2011

Registration date: 19 September 2011

Relying on goods in classes 18 & 25, including:

Class 25: ***Clothing, headgear.***

UNIVERSITY OF CAMBRIDGE

UK trade mark no. 3554488

Filing date: 11 November 2020

Registration date: 9 July 2021

[2] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent's EUTM being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

Relying on services in class 41, those being:

Class 41: *Sporting activities; sport camp services; organisation of competitions [education or entertainment]; physical education; providing of training; instruction services.*

Opposition under section 5(2)(b) & 5(3)

CAMBRIDGE

UK trade mark no. 3015609

Filing date: 26 July 2013

Registration date: 4 September 2015

Relying on goods in class 41, those being:

Class 41: *Education; providing of training; entertainment;* ***sporting and cultural activities****; academies [education]; arranging and conducting of colloquiums; arranging and conducting of workshops [training]; arranging and conducting of congresses; arranging and conducting of conferences; arranging and conducting of seminars; arranging and conducting of symposiums; boarding schools; schools; club services [entertainment or education]; coaching [training]; correspondence courses; distance learning courses; education information; educational examination; electronic desktop publishing; game services provided on-line from a computer network; holiday camp services [entertainment]; holiday camp services [education]; publishing consultancy services; advisory services relating to publishing; publishing services; electronic publishing services; providing electronic publications; publication of printed matter and printed publications; language interpreter services; lending libraries; mobile library services; providing museum facilities; nursery schools; organisation of competitions [education or entertainment]; organisation of exhibitions for cultural or educational purposes; physical education; practical training; production of radio and television programmes; providing online electronic publications, not downloadable; publication of texts, other than publicity texts; publication of books; publication of reference books; publication of*

directories; publication of manuals; publication of reports; publication of magazines; publication of journals; publication of periodicals; publication of dictionaries; publication of exam papers; publication of lecture notes; publication of worksheets; publication of quizzes; publication of puzzles; publication of examination marking criteria; publication of pamphlets; publication of booklets; publication of flashcards; publication of vocabulary lists; publication of educational material; publication of electronic books online; publication of electronic journals online; publication of electronic reference books online; publication of directories online; publication of manuals online; publication of reports online; publication of magazines online; publication of periodicals online; publication of dictionaries online; publication of exam papers online; publication of lecture notes online; publication of educational worksheets online; publication of quizzes online; publication of puzzles online; publication of examination marking criteria online; publication of pamphlets online; publication of booklets online; publication of flashcards online; publication of vocabulary lists online; publication of educational material online; publishing; services of schools [education]; ***sport camp services****; teaching services; educational services; instruction services; tuition; translation; vocational guidance [education or training advice]; vocational retraining; writing of texts, other than publicity texts; academic examination services; adult education services; analysing educational test scores and data for others; arrangement of training courses; arranging of festivals for educational purposes; bibliographic information; business educational services; business training; certification of education and training awards; computer assisted education services; computer assisted examination services; design of educational courses, examinations and qualifications; development of educational material; educational assessment services; educational examination services; educational research; provision of educational examination facilities; setting of educational standards; university education services; university services; provision of training, teaching, examination and assessment services including such services being provided via computer assisted and computer mediated means and via on-line means; provision of distance learning*

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

UNIVERSITY OF CAMBRIDGE

UK comparable trade mark no. 900896449
Filing date: 4 August 1998
Registration date: 7 March 2000
Relying on goods in classes 25 & 41, those being:
Class 25: *Clothing, footwear, headgear.*
Class 41: *University education services, academic and vocational educational services; provision of courses of instruction, lectures and seminars all relating to academic or vocational subjects; arranging and conducting conferences and seminars; library services; publication of books, texts and journals; provision of correspondence courses;* ***provision of recreational and sporting facilities;*** *publication services.*

3. By virtue of their earlier filing dates, the above marks all constitute earlier marks in accordance with section 6 of the Act. All but one of the above marks had been registered for a period of five years or more at the time the contested application was filed and are therefore subject to proof of use in accordance with section 6A of the Act. The underlined goods and services represent the extent to which the applicant has requested the opponent provide proof of use of the marks in these proceedings.

4. In respect of the opposition based on section 5(2)(b) of the Act, the opponent argues that the respective goods and services are identical or similar and that the marks are similar, and that as such there exists a likelihood of confusion including a likelihood of association between the marks.

5. In respect of the opposition based on section 5(3) of the Act, the opponent pleads that it holds a “massive reputation” for its services and that the use of the contested mark would cause the consumer to make a link between the same. The opponent argues that as a result of this link (whether there be confusion or otherwise), the use

of the contested mark would, without due cause, take unfair advantage of and cause detriment to the reputation and distinctive character of its earlier marks.

6. In respect of the opposition under section 5(4)(a), the opponent relies on the sign CAMBRIDGE which it submits has been in use in the UK since the 13th Century. The opponent claims that it holds goodwill in its business as distinguished by the sign in the UK in respect of the following goods and services:

> *Education; provision of courses of instruction; lectures and seminars; provision of recreational and sporting facilities; sporting activities; sports training; organising of sporting events; sports clothing.*

7. The opponent pleads that use of the contested mark would result in a misrepresentation and damage to its goodwill.

8. The applicant filed a counterstatement denying the claims made, and requesting the opponent provide proof of use for some of its goods and services, as identified previously by paragraphs 2 and 3 of this decision.

9. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.

10. A Hearing took place on 2 July 2025. The opponent is represented in these proceedings by Keltie LLP and was represented at the hearing by Guy Tritton of Hogarth Chambers. The applicant is represented by Basck Limited and was represented at the hearing by Richard Bickford-Smith of the same.

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence

12. The opponent filed its evidence in the form of two witness statements. The first was in the name of Andrea Ward, Head of Brand and Trademark at the University of Cambridge. The statement introduces 22 exhibits, namely Exhibit AW-1 to Exhibit AW-22, and is dated 19 March 2024. It goes to the history of the opponent and the use, reputation and goodwill of the marks relied upon.

13. The second witness statement filed is in the name of Benjamin Britter, a Chartered Trade Mark Attorney and Partner at the opponent's representative firm. The statement is made for the purpose of introducing two exhibits, those being Exhibit BNB1 and Exhibit BNB2. These provide extracts from the applicant's website from 7 December 2021 and 14 March 2024.

14. Having considered the multiple marks, grounds and issues present in this matter, it will in my view be helpful to set out an initial summary (to the extent I consider it relevant and/or useful) of the evidence of Ms Ward in particular at this stage. This is provided below. Before I do so, I note that the filing date of the contested application of 5 January 2022 will serve either as the relevant date or the date on which the relevant period for consideration will end throughout this decision.

15. In her witness statement, Ms Ward explains that the University of Cambridge traces its origins back to 1209, and as a common law corporation to 1571. Exhibit AW1 provides a printout of the university's website, confirming it was founded in 1209, and stating it is the fourth oldest university in the world. The page provides the 2020-2021 student figures as 24,270, and states that as of May 2022, a few months after the contested application was filed, it has 315,000 living alumni. The pages also confirm that among the university's alumni are 121 Nobel Prize Laureates, 47 Heads of State and 210 Olympic medallists. References to both University of Cambridge and Cambridge solus are made on these pages when referring to the university. I note the pages provided are themselves undated, and they appear to postdate the relevant date by at least a small amount considering the alumni figures given are from May 2022.

16. Ms Ward explains that the university is consistently ranked as one of the best in the world, and provides various tables at Exhibit AW-2 to support this. The tables show its position between 1st and 7th university in the world between 2011 – 2021 across three different ranking systems, and between 1st and 2nd in the UK for the same period. Also provided are three UK press articles discussing the rankings. These include a BBC article dating from 25 April 2018 entitled "Cambridge beats Oxford to top university guide's table". This discusses Cambridge beating Oxford in the annual league table of universities for the eighth year in a row, based on measures including research, student satisfaction and graduate prospects. Further articles from the Guardian and the Independent are provided, dating from 2019 and 2017 respectively, both of which use University of Cambridge and Cambridge only to describe the opponent and its successes.

17. Exhibit AW-3 provides what Ms Ward describes as "…the University's Annual Report for sports". This appears to be an internal document, but it discusses the sports clubs offered, the successes of the athletes and the income and revenue generated from the "Sports service income streams". This discusses revenue from both "membership" as well as "Sports centre revenue" generally. Membership figures for the year 2019/2020 show at roughly between £40,000-£45,000 monthly until they drop sharply at the beginning of the coronavirus pandemic. Sports Centre revenue is given as £342,251 for the same period, which is said to be a 29.8% decrease on the previous year. The total revenue from "the Sports Service" is given as £2,147,535, which is said to be a 20% decrease on the previous year. The majority of this comes from the category "Trading". On the front of the document, the mark UNIVERSITY OF CAMBRIDGE is used, and 'Cambridge' only is used frequently within the text in the document. The mark below is also shown when the Cambridge University Boat Club is discussed:

CAMBRIDGE
UNIVERSITY BOAT CLUB

18. As mentioned, the document discusses successes of athletes training at the university, and it provides a feature on an athlete who won gold medals at the BUCS[3] Indoor championships and the Irish National Indoor Senior Championships. The athlete provides a comment on the successful coaching she has received and the club she has been a part of at “Cambridge”.

19. A 2021-2022 “Sports Guide” is provided in the evidence at Exhibit AW-4. This document appears to be aimed at students or potential students of the university, and shows UNIVERSITY OF CAMBRIDGE on the front of the document and again uses ‘Cambridge’ in the text. This document confirms that ‘Cambridge’ has over 75 sports clubs for everyone from beginners to elite athletes. Further, it goes on to explain that the “University of Cambridge Athlete Performance Programme” offers high performance athletes professional and coordinated sports services in order to improve their performance, including lifestyle management, physiotherapy, strength and conditioning, nutritional advice, sports psychology support and gym membership. There is also a section on rowing which reads:

> “Rowing
>
> The first Boat Race in 1829 launched Cambridge’s rivalry with Oxford on the water. Men’s and women’s crews, guided by a hunger for victory and outstanding staff, develop their technical skill and strength and conditioning, with the help of medical, sports psychology and nutritional support. Rowers are encouraged to pursue their sport at International level with every Olympic Games featuring CUBC athletes. Many students have not rowed before they come to Cambridge, and learn to row at their college before trialling with the university. We also run a development squad to help improving rowers accelerate their progress.

[3] It is confirmed elsewhere in the evidence including at Exhibit AW-4 that this stands for British Universities & Colleges Sport.

> Whilst preparing for the Boat Races, all crews will also race at the British Rowing Championships, the Fuller's Head of the River Fours, the Women's Eights Head of the River Race and the British Universities & Colleges' Sport (BUCS) Regatta."

20. Ms Ward also explains that the university has been home to "some of the world's most renowned athletes including James Cracknell, Michael Atherton and Emma Pooley" as well as having produced champions at 24 of the 28 modern Olympiads since and including 1900. She goes on to explain that the Cambridge University Boat Club has supplied around 150 Olympians and has had representatives at all but one of the modern Olympiads.

21. Ms Ward explains that the opponent opened the University of Cambridge Sports Centre in 2013, comprising various facilities including a sports hall with spectator area, fitness, strength and conditioning suite, a multipurpose room and squash courts and team training areas. She explains that this is both for sport at the university and is open to the public at large via membership named Cambridge Sport. AW-5 provides details of this, and whilst I note the webpages provided at this exhibit appear to postdate the relevant date, they reinforce what Ms Ward confirms regarding the opening date, facilities and public membership. Images provided in the evidence show UNIVERSITY OF CAMBRIDGE externally on the sports centre.

22. Exhibit AW-6 provides screenshots from the opponent's social media pages between 2018 – 2021 showing various athletes wearing sportswear showing Cambridge, Cambridge University or the University of Cambridge. I note the engagement with the posts is limited, with few likes and comments shown.

23. Ms Ward explains that rowing has arguably been the most preeminent sport at the university and confirms the Cambridge University Boat Club (CUBC) was founded in 1828. She confirms it has been located at the Goldie Boathouse on the River Cam since 1882, and that it offers "a world-class rowing programme provided by leading coaches in state-of-the-art training facilities". Ms Ward explains the CUWBC – the Women's Boat Club opened in 1941, and the CULRC – the Men's Lightweight Rowing

Club was formed in 1977, before all three clubs merged into one under the Cambridge University Boat Club name in August 2020.

24. Exhibit AW-08 provides printouts from the web archiving site the Wayback Machine, from the Cambridge University Boat Club webpage at www.cubc.org.uk. These date between July 2017 and June 2021. These discuss the history and facilities offered at Cambridge University Boat Club.

25. Ms Ward explains that the university's Ely Boathouse has been available for event hire and rowing camps since it was opened in 2016. Pages detailing the availability of the venue for event hire are provided again via the web archiving site the Wayback Machine at Exhibit AW-09. The pages provided date between 2018 and 2021. A table of reservations made is also provided for the period between 2018 and 2019, with 22 reservations listed in total. Details of rowing camp bookings are also provided, with 32 occurring between 2018 and 2021. An image showing the boathouse provided from an Instagram page on 23 August 2021 shows UNIVERSITY OF CAMBRIDGE on the external window in the building. A CAMBRIDGE UNIVERSITY BOATHOUSE mark is shown on the page, and the page itself refers to "Event hire at the heart of Cambridge Rowing" and offers "[…] the newest and most authentic Cambridge experience for your event". It reads:

> **"What we offer**
>
> Our building is now being used to it's full potential not only by training world class rowers but giving the opportunity for everyone to share in its use for business meetings, birthday parties, celebration, workshops and seminars […]"

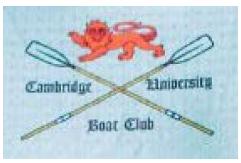
26. Exhibit AW-12 provides an article from what appears to be the opponent's website at www.cambridge.org. Although this is dated from 2023, after the filing date of the contested mark in these proceedings, it discusses the history of the boat race between Cambridge and Oxford, describing this as world-famous and iconic. It confirms that double gold medal winning Olympian James Cracknell raced for Cambridge in 2019, and that when the article was issued (a little over a year after the relevant date), over a quarter of a million people watch the boatrace on the Thames, and more than 100

million watch it worldwide. Ms Ward also provides television viewing figures for the UK for the years prior to the filing date of the contested mark as follows:

2015 – 4.1 million
2016 – 3 million
2017 – 3.5 million
2018 – 3.7 million
2019 – 2.9 million
2021 – 2.1 million

27. Various third-party UK press articles are also provided about the Cambridge/Oxford Boatrace at Exhibit AW-13. These include those from the BBC website providing information about the history of the race, as well as an article dating from 29 October 2021, which explains the BBC has televised the race since 1938 and that it will continue to do so until 2025. It refers to “Cambridge” continuing to dominate the race in the previous April. A 2021 article from the Guardian is provided entitled “Cambridge don the medals after double boat race triumph over Oxford”, and 2018 and 2019 articles from the Guardian are also provided again referring to “Cambridge” beating Oxford. An article from Sky News is provided from 2019 reporting on James Cracknell’s feature in the “Cambridge crew”, a Sky Sports article from 2017 reports on the Oxford win over Cambridge, and an article from the Independent reports on a Cambridge win in 2021. Exhibit AW-15 provides pages from social media between 2017 – 2021 showing rowers wearing clothing displaying the following wording or logos:

CAMBRIDGE



28. The remaining exhibits provided with Ms Ward's statement focus on the sale of clothing bearing a range of CAMBRIDGE UNIVERSITY and UNIVERSITY OF CAMBRIDGE marks, as does the rest of Ms Ward's statement itself. Screenshots are provided again from web archiving site the Wayback Machine, showing clothing for sale in GBP. An "Official Merchandise" catalogue dating from 2019 is provided, along with cover pages also shown from the 2017 and 2018 versions, all of which reference University of Cambridge. A licensee royalty report is provided from "2018 Q2" detailing sales made by licensee Advance Apparel Ltd, and Ms Ward provides sales figures from the same as follows:

Year	**Net Sales**
2018	£242,551
2019	£1,024,439
2020	£238,173
2021	£139,848
2022 (Q1)	£69,501

29. Ms Ward goes on to explain that licensing deals were also made with Dreamsport Ltd, Ryder & Amies, Pepe Jeans Europe BV and Promo Qc Ltd t/a GWCC prior to the relevant date, but exact sales figures and payments are not provided. Further, I note Mr Bickford-Smith highlighted at the hearing that the wording on the invoices provided from Pepe-Jeans suggested that these may refer simply to the minimum royalty fee being paid, rather than evidencing a particular level of clothing sales.

Proof of use

30. I remind myself at this stage that, of the marks still relied upon by the opponent as set out at paragraph 2 of this decision, the applicant has requested proof of use of the following goods and services only:

CAMBRIDGE (no. 3015609)

Class 41: *Sporting and cultural activities; sport camp services.*

UNIVERSITY OF CAMBRIDGE (no. 900896449)

Class 41: *Provision of recreational and sporting facilities.*

(no. 901771997)

Class 25: *Clothing, headgear.*

(no. 909896705)

Class 25: *Clothing, headgear.*

31. To the extent requested, the marks outlined above are subject to proof of use in accordance with section 6A of the Act. This is set out below:

Section 6A:

"(1) This section applies where

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

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

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

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

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

(5)-(5A) [Repealed]

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

32. Two of the earlier marks are comparable marks, which means that as per schedule 2A of the Act, up until the end of the transition period on 31 December 2020, evidence of use in the EU will also be relevant. However, I note that in this case the evidence

provided is heavily UK focused (with some reference to global success). Genuine use in the UK will suffice to show genuine use in a significant portion of the territory up until the end of the transition period, and as such, my assessment will focus on whether the opponent has evidenced genuine use in the UK.

33. Section 100 of the Act states that:

> "100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

34. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 Ansul BV v Ajax Brandbeveiliging BV [2003] ECR I-2439, Case C-259/02 La Mer Technology Inc v Laboratories Goemar SA [2004] ECR I-1159, Case C-416/04 P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [2006] ECR I-4237, Case C-442/07 Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'[2008] ECR I-9223, Case C-495/07 Silberquelle GmbH v Maselli-Strickmode GmbH [2009] ECR I-2759, Case C-149/11 Leno Merken BV v Hagelkruis Beheer BV [EU:C:2012:816], Case C-609/11 Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], Case C-141/13 P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [EU:C:2014:2089], Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 Ferrari SpA v DU [EU:C:2020:854].
>
> 106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: Ansul at[36]; Sunrider at [70]; Verein at [13]; Centrotherm at [71]; Leno at [29]; Ferrari at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: Ansul at [36]; Sunrider at [70]; Verein at [13]; Silberquelle at [17]; Centrotherm at [71]; Leno at [29]; Gözze at [37], [40]; Ferrari at [32].

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic

sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: Ansul at [38] and [39]; La Mer at [22]-[23]; Sunrider at [70]-[71], [76]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34]; Leno at [29]-[30], [56]; Ferrari at [33].

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

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: Reber at [32].”

35. The relevant period within which the opponent must prove use of its marks in these proceedings is the five years directly preceding and ending with the date the application was filed, that being 6 January 2017 - 5 January 2022. The opponent must show that genuine use has been made in respect of the marks relied upon during the relevant period, within the relevant territory, and in respect of the goods and services relied upon.

36. I note firstly that there is no evidence of use of the opponent’s two crossed rowing blade trade marks as registered and relied upon being used in respect of clothing or headgear. At the hearing, Mr Tritton argued that I should consider use of the wording CAMBRIDE and CAMBRIDGE UNIVERSITY as use of an acceptable variant of these

marks. However, I also note his submissions in his skeleton arguments at paragraph 50 in relation to the comparison of the marks that:

> "For the "crossed rowing blades" marks, it is submitted that the dominant and distinctive element are "CAMBRIDGE" combined with the "crossed rowing blade" and there is enhanced distinctive character."

37. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test for use in a variant form under section 46(2). He said:

> "13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).
>
> 14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.
>
> 15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.
>
> 16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason

to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word "MEDIA" would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still."

38. Mr Tritton also referred me to the comments made by the General Court in *Mignot & De Block BV GmBH* (T-800-19), which sets out that a registered mark can sometimes be used with additional elements and sometimes without, and this can be one factor from which it may be inferred that there has been no alteration to the distinctive character of a mark.

39. However, it is my view in this instance, and in the context of the relevant goods, that the inclusion of the crossed rowing blade element in both of the aforementioned marks contribute to the distinctive character of the marks overall. I therefore do not consider the removal of this element and the use of the wording alone to equate to the omission of a non-distinctive element of the registered marks. Whilst I note that changes to figurative elements are less likely to alter the distinctive character than changes to words, in this instance, I consider the complete removal of the figurative elements, which in both cases are placed in a prominent position within the marks, will alter the inherent distinctive character of the same. I therefore do not consider the use of the wording CAMBRIDGE or CAMBRIDGE UNIVERSITY alone to constitute an acceptable variant of the opponent's two crossed rowing blade marks.

40. Whilst I note there are also some examples of marks featuring crossed rowing blades on clothing in the evidence,[4] I note that these also differ from those relied upon in various ways which, in my view, alter the distinctive character of the marks. For example, I consider what I find to be the most similar of these below:

41. This mark uses different word elements to the registered cross rowing blade marks, and as the case law sets out, changes to word elements are more likely to alter the distinctive character of the earlier marks themselves. Further, there are also additional changes. For example, I note that the word CAMBRIDGE is placed in the middle of, and is overlapped by, the rowing blades in one of the registered marks, and is heavily stylised. In the other, the words CAMBRIDGE UNIVERSITY are curved, giving the impression of a circle with the rowing blades in the middle. These changes are relatively small compared with the alteration of the word elements themselves, but cumulatively all of the changes contribute towards altering the overall impression, and as such the distinctive character of the marks themselves. I therefore do not consider the mark shown above, or any of the alternative crossed rowing blade marks shown in use in respect of the goods in the evidence, to constitute acceptable variants of the registered marks in this instance.

42. Further, I note that even if the crossed rowing blade mark outlined above was considered use of an acceptable variant of the earlier marks,[5] I would not consider the limited examples of its use shown in the evidence sufficient to establish genuine use of the mark in relation to these goods.

[4] I refer to clothing shown for sale in the evidence. I do not consider that images of athletes wearing an item of clothing whilst participating in a sport is evidence of the opponent attempting to create or maintain a market for the goods in the UK, and as such it does not in my view, contribute towards a picture of genuine use for these goods.
[5] For example, that shown on page 255 under Exhibit AW-20 of the evidence.

43. For the reasons set out above, I do not consider the opponent to have established genuine use of its two crossed rowing blade marks (no. 901771997 and no. 909896705) in respect of the goods relied upon.

44. I consider next the services *provision of recreational and sporting facilities* under the opponent's earlier UNIVERSITY OF CAMBRIDGE mark no. 900896449. It is clear from the evidence provided by Ms Ward that the opponent has operated a sports centre under this mark since 2013. The sports centre has been available both to members of the university and its alumni, in addition to members of the general public during the relevant period. I note Ms Ward's statement that its plans to expand the sports centre were unveiled in 2019. Whilst I acknowledge I have not been provided with figures relating to the number of members, I note Sports Centre revenue is given as £342,251 between 2019/2020. In my view, the provision of these services both to members of the general public and to members of the university including students will count towards genuine use of the mark in respect of the same.

45. On top of the evidence relating to the provision of the sports centre, I note there is reference to the opponent offering its students state of the art rowing facilities at its boathouses, in addition to the evidence relating to the rental of the Ely Boathouse and its facilities to the general public. Whilst I have considered that the facilities at Ely Boathouse are offered are more often presented under the CAMBRIDGE UNIVERSITY BOATHOUSE mark, I note again the image showing the Ely Boathouse provided from an Instagram page on 23 August 2021 (within the relevant period) which shows UNIVERSITY OF CAMBRIDGE on the external window in the building.

46. I accept that the evidence relating to the *provision of recreational and sporting facilities* under the mark UNIVERSITY OF CAMBRIDGE is not particularly extensive. However, it is my view that it is sufficient to show that the opponent has made a genuine effort to create and maintain a market for these services in the UK within the relevant period, and with consideration to the sum of the evidence as a whole, I am satisfied that it has demonstrated genuine use of this mark in respect of the same.

Further, with consideration to the case law,[6] I am satisfied that this is a fair description of the services offered in accordance with the perception of the average consumer.

47. Next, I consider the applicant's request for the opponent to provide proof of use of its mark CAMBRIDGE (no. 3015609) for the following services:

> Class 41: *Sporting and cultural activities; sport camp services.*

48. I note this is as far as the applicant's request for proof of use extends in relation to this mark. Having considered the specification relied upon by the opponent carefully, I note this also covers the following services in class 41, which are not subject to proof of use (for example):

> Class 41: *Providing of training*; *entertainment; club services [entertainment or education]; coaching [training]; holiday camp services [entertainment]; instruction services.*

49. It is my view that the above services will include *sports training services, sports entertainment services, sports club services, sports coaching and instruction services*. Further, I consider that *holiday camp services* will include *holiday sports camp services*. With this in mind, it is in my view unlikely that the opponent's ability to rely on the challenged services will alter the outcome of this decision. I therefore do not intend to consider this point further at this stage. However, if it becomes necessary to do so, i.e. if it becomes apparent it may alter the outcome of these proceedings, I will revert to this position and conduct a full assessment of use in respect of the challenged services at that stage.

Decision

Section 5(2)(b)

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

[6] See *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10

"5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

51. Section 5A of the Act is as follows:

"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."

The Principles

52. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of goods and services

53. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

> "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".

54. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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.

55. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

> "… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

56. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM),* Case T-325/06, the General Court ("GC") stated that there is complementarity where:

> "...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".

57. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the GC stated that:

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

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

58. With this in mind, the goods for comparison are as follows:

Earlier goods[7]	**Contested goods**
UK trade mark no. 900896449 Class 25: *Clothing, footwear, headgear.*	Class 25: *Sports clothing; Sports wear; Sports jackets; Clothes for sport.*
	Class 35: *Merchandising; Inventorying merchandise; Product merchandising; Business merchandising display services; Display services for merchandise; Product merchandising for others; Preparing promotional and merchandising material for others.*
UK trade mark no. 3015609 Class 41:[8] *Providing of training*; *entertainment; club services [entertainment or education]; coaching [training]; holiday camp services [entertainment]; organisation of competitions [education or entertainment]; instruction services.* UK trade mark no. 900896449 Class 41: *University education services, academic and vocational educational services; provision of courses of instruction, lectures and seminars all*	Class 41: *Corporate hospitality (entertainment); Hospitality services (entertainment); Sports activities; Sport camps; Sporting services; Sporting activities; Instruction in sports; Sports entertainment services; Training in sports; Sports coaching services; Sports and fitness; Organising of sporting events, competitions and sporting tournaments; Operation of sports facilities.*

[7] These are listed in accordance with my findings and my approach in my initial proof of use section of this decision.
[8] See full list of services relied upon under this mark at paragraph 2 of this decision.

relating to academic or vocational subjects; arranging and conducting conferences and seminars; library services; publication of books, texts and journals; provision of correspondence courses; publication services; ***provision of recreational and sporting facilities.*** UK trade mark no. 3554488 Class 41: *Sporting activities; sport camp services; organisation of competitions [education or entertainment]; physical education; providing of training; instruction services.*	

Comparison with the earlier 900896449 and 3554488 marks (both marks being UNIVERSITY OF CAMBRIDGE)

59. The opponent's earlier 900896449 mark covers the goods *clothing* in class 25. The applicant's class 25 goods are all included within the more general category of *clothing*. These are therefore identical in accordance with the principles set out in *Meric*.

60. The opponent's earlier 3554488 mark covers *sporting activities; sport camp services; organisation of competitions [education or entertainment].* These are identical, either self-evidently or in accordance with the principles set out in *Meric*, to the applicant's services below:

> *Sports activities; Sport camps; Sporting services; Sporting activities; Sports entertainment services; Sports and fitness; Organising of sporting events, competitions and sporting tournaments.*

61. I note the opponent's 900896449 mark also covers the services *provision of recreational and sporting facilities.* The applicant's services include *operation of sports facilities*. Whilst the provision of recreational and sporting facilities is in my view, not identical to the operation of sports facilities, I consider these to be highly similar. It is likely that the provision and operation of sporting facilities will be conducted by the same entities and targeted towards the same consumers. They will both be provided in pursuit of the same purpose (to provide the consumer with operational sports facilities) and the nature of the services is at least highly similar. I note they will not be in competition, however, there may be an element of complementarity in respect of the same, with one being at least important to the other to the extent that the consumer will likely believe they derive from the same entity.

62. The opponent's earlier 3554488 mark also covers *providing of training; instruction services.* This includes the provision of training and instruction in sports. These are therefore identical to the applicant's contested services below, in accordance with the principles set out in *Meric*:

Instruction in sports; Training in sports; Sports coaching services.

63. The applicant's contested mark includes the following services:

Corporate hospitality (entertainment); Hospitality services (entertainment).

64. In my view, the most similar services covered by the opponent's earlier marks outlined above are *arranging and conducting conferences and seminars.* I consider that the arranging of conferences in particular will likely often be targeted at the same consumers as corporate hospitality services (which are also included in the more general category of hospitality services above). Both will be aimed at business professionals for example. The nature of the services is somewhat similar, with both being services for arranging different types of corporate events. However, the purpose will differ, with the applicant's services being primarily for entertainment, and the opponent's being primarily for providing learning and networking opportunities. Without evidence on the point, it seems unlikely to me that trade channels will be

shared, and I do not find any complementarity or competition between the services. Overall, I consider them to be similar to a low degree.

65. The application also covers the following services in class 35:

> *Merchandising; Inventorying merchandise; Product merchandising; Business merchandising display services; Display services for merchandise; Product merchandising for others; Preparing promotional and merchandising material for others.*

66. I note at this stage that these are concerned with the provision of the outlined services to others, and not simply, for example, with selling a party's own merchandise to consumers. I also note that whilst I have considered Mr Tritton's submission at the hearing that these services are "effectively the selling of goods", I do not consider these services to be retail services to which the case law pertaining to the similarity of goods vs retail services really applies. It is instead my view that these services are concerned with the provision of merchandising or promotional services to other entities, for example to those running a business who wish to engage a party to advise on merchandising or produce merchandise, promotional material or displays on their behalf. Having considered the full list of goods and services covered by the opponent's earlier marks, I see no reason to find these similar to the applicant's services in class 35. I therefore consider these to be dissimilar.

Comparison of goods and services with the opponent's earlier trade mark no. 3015609

67. The opponent's earlier mark covers *providing of training*; *coaching [training]* in class 41. These terms include services for the provision of sports coaching and training. These are identical to the applicant's following services in accordance with the principles set out in *Meric*:

> *Sports activities; Sporting services; Sporting activities; Instruction in sports; Training in sports; Sports coaching services; Sports and fitness.*

68. The opponent's earlier services include *entertainment* in class 41. This will cover the applicant's *sports entertainment services* in the same class, and I therefore find these identical in accordance with the principles set out in *Meric*.

69. The opponent's earlier services include *holiday camp services [entertainment]* in class 41. In my view, these will include holiday sports camp services. I therefore find these identical to the applicant's contested *sport camps* in class 41. However, I note for completeness that if I am wrong on this point, I consider that *holiday camp services [entertainment]* to share a very similar nature and purpose with *sport camps.* Both may be provided to children in school holidays for example, for the purpose of both entertaining them and providing childcare simultaneously. The nature will be similar, with a form of structure, entertainment and possibly accommodation offered with each. Consumers/users will be shared, particularly where parents of children engaging the services are concerned. Trade channels appear likely to be shared. Overall, if these services are not identical, I consider them similar to a high degree.

70. In respect of the applicant's services *operation of sports facilities* in class 41, I find these similar to the opponent's services covering sports training and sports coaching. I consider that whilst the core purpose differs, there is some level of overlap with both services providing the consumer with the means to partake in sports and activities. Further, it is my view that the provision of sports coaching and sports training will often be provided by the same entities as those operating the sports facilities themselves, and users will likely be shared. This may be by way of the general public, or it may, for example, be by way of entities such as sports clubs who engage services for operating their own sports facilities, and also engage coaches to provide training. However, the services to not appear to be complementary or in competition as such. The method of use differs, as does the nature. Overall, I find these services similar to a medium degree.

71. The opponent's earlier class 41 services cover *organisation of competitions [education or entertainment].* It is my view that this will cover the organising of sporting competitions for entertainment purposes. This would render these services identical to the applicant's services *organising of sporting […] competitions […].* It would also on this basis be at least highly similar (if not identical) to the applicant's *organising of*

sporting events […] and sporting tournaments as, if not considered identical, I find the nature, purpose, trade channels and users would all largely overlap, and there may be an element of competition between the services themselves.

72. The opponent's earlier mark covers *entertainment*. This will include the applicant's services *corporate hospitality (entertainment)* and *hospitality services (entertainment).* I therefore find these services identical in accordance with the principles set out in *Meric*.

73. The applicant's mark covers various sports clothing goods in class 25. Whilst I note the opponent covers sports related services, such as training and coaching, I do not consider these to be similar to applicant's goods in class 25. It is my view the nature, purpose and method of use of the goods are different. Further, I am not aware that it is particularly common for trade channels to be shared, and I have no evidence to consider on this point. I consider that users will be shared at a fairly general level, but I do not find there to be complementarity or competition between the goods and services. Overall, I consider these dissimilar.

74. I note for completeness, that whilst I have considered the submissions from Mr Tritton on why I should find these goods and services similar, particularly that it is "…common to merchandise the reputation of a mark for a sporting club or event on [sports] clothing", I note firstly I have no evidence on this point, and in any case, whilst this may be so, this argument appears to be based on the anticipated behaviour of an entity which holds a reputation. I do not believe this argument is sufficient for a finding of similarity between these goods in the context of section 5(2)(b) of the Act.

75. Finally, I consider again the applicant's services in class 35. I have compared these with the opponent's earlier services, including the full list of class 41 services relied upon. I do not find any overlap in nature, purpose or method of use between the applicant's class 35 services and any of the opponent's services, nor do I consider them complementary or in competition. I do not consider it likely that trade channels will be shared and I have no evidence to the contrary, nor do I consider users to overlap at more than a very general level. I therefore find the applicant's services in class 35 to be dissimilar to the opponent's earlier services relied upon.

76. Where there is no similarity between goods and services, the opposition based on section 5(2)(b) of the Act must fail. This ground therefore continues in respect of the following goods and services under the two marks[9] only:

Opposition under 5(2)(b) of the Act relying on the earlier mark UNIVERSITY OF CAMBRIDGE

> Class 25: *Sports clothing; Sports wear; Sports jackets; Clothes for sport.*
>
> Class 41: *Corporate hospitality (entertainment); Hospitality services (entertainment); Sports activities; Sport camps; Sporting services; Sporting activities; Instruction in sports; Sports entertainment services; Training in sports; Sports coaching services; Sports and fitness; Organising of sporting events, competitions and sporting tournaments; Operation of sports facilities.*

Opposition under 5(2)(b) based on the earlier mark CAMBRIDGE

> Class 41: *Corporate hospitality (entertainment); Hospitality services (entertainment); Sports activities; Sport camps; Sporting services; Sporting activities; Instruction in sports; Sports entertainment services; Training in sports; Sports coaching services; Sports and fitness; Organising of sporting events, competitions and sporting tournaments; Operation of sports facilities.*

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

[9] Whilst there are three registrations to consider at this stage, two feature identical marks.

Court of Justice of the European Union 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."

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

79. The respective trade marks are shown below:

Earlier trade marks	**Contested trade mark**
CAMBRIDGE ("the first earlier mark") UNIVERSITY OF CAMBRIDGE[10] ("the second earlier mark")	

80. The first earlier mark comprises the single word CAMBRIDGE. It is in this word alone that the overall impression of the earlier mark resides.

81. The second earlier mark comprises the wording UNIVERSITY OF CAMBRIDGE. Considering that the word UNIVERSITY indicates the type of services/institution offered under the mark, and OF CAMBRIDGE suggests that the institution is 'of' that location, I consider that the words hang together and the overall impression of the mark is in the combination of these elements and the mark as a whole.

[10] To avoid repetition, I will discuss the two identical marks together.

82. The contested mark comprises a number of elements, including the words CAMBRIDGE and ROWING, the device of a person rowing on water, a border in the shape of a shield or crest, and two partially obscured but seemingly crossed rowing blades. I note at the hearing that Mr Bickford-Smith submitted that the image of the man rowing is the most distinctive element of the mark.

83. I consider that the eye tends to be initially drawn to word elements in marks, which often also make a greater impact on the consumer than devices. I do note however, that this may not aways be the case, particularly where the wording itself is only distinctive to a relatively low degree.[11] That said, I do not agree with Mr Bickford-Smith that the image of the rower is the most distinctive element of the contested mark. I consider that, particularly in the context of sports services and sports attire, the simple image of a person rowing only serves to reinforce the same conceptual message as the word ROWING itself, which is in my view descriptive or at the very least highly allusive in respect of goods and services in classes 25 and 41 in particular. As such, neither element is especially distinctive in this context. I consider that the use of CAMBRIDGE may also serve to identify or suggest the location that the services in particular may take place, however, it is arguably less directly descriptive in the context of sports goods and services than ROWING itself. I note it is also placed roughly in the centre of the mark and is in a slightly larger font than ROWING, increasing the impact of the same. It is my view that particularly in the context of sports related goods and services, the word CAMBRIDGE plays the greatest role in the overall impression of the mark, followed by the word ROWING and the device of the person rowing in combination. However, if I am wrong in this finding, and in respect of instances where the services are not directly sports related, it is my view that the wording and the device of the person rowing play an equal role. The crossed rowing blades and shield border fall into the background of the mark, and whilst not negligible, play a lesser role in the overall impression of the same.

Visual comparison

[11] See *Metamorfoza d.o.o. v EUIPO*, Case T-70/20, EU:T:2021:253

84. Visually, the first earlier mark coincides with the contested mark through the use of the word CAMBRIDGE. This is the whole of the earlier mark and at least one of the most dominant elements of the contested mark. However, there are also a number of visual features present in the contested mark that are not in the first earlier mark. Overall, I consider the marks visually similar to a medium degree.

85. The second earlier mark also coincides with the contested mark by way of the word CAMBRIDGE only. Again, there are a number of visual features present in the contested mark that are not in the second earlier mark. In addition, the second earlier mark also includes the wording UNIVERSITY OF which does not feature in the contested mark. Overall, the marks are visually similar to a low degree.

Aural comparison

86. Aurally, the first earlier mark comprises the two-syllable word CAMBRIDGE only, which will be pronounced in the known way. The contested mark includes the two, two syllable words CAMBRIDGE ROWING, which again will be pronounced in the known way. By virtue of the overlap in the word CAMBRIDGE, and with consideration to this being the only word in the earlier mark and the first word in the contested mark where it will have more impact aurally on the consumer,[12] I find the marks aurally similar to just above a medium degree.

87. The second earlier mark also overlaps with the contested mark by way of the word CAMBRIDGE. However, this word is in different positions in each of the marks, and the second earlier mark also includes the two words and six syllables UNIVERSITY OF at the beginning. Further, I remind myself the contested mark includes the additional two-syllable word ROWING. Overall, by virtue of the coinciding word CAMBRIDGE, I consider the marks aurally similar to a low degree.

Conceptual comparison

[12] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

88. Conceptually, the first earlier mark conveys the concept of the UK city of Cambridge. This is the only concept present in the mark.

89. The second earlier mark conveys the concept of a university, that being a place offering higher education at degree level and above as well as engaging in academic research, located in or belonging to, the city of Cambridge.

90. The contested mark conveys the concept of the city of Cambridge, in addition to the sport of rowing. All of the marks overlap by way of their reference to the city of Cambridge. They are all conceptually similar to a roughly medium degree.

Average consumer and the purchasing act

91. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

92. 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."

93. The average consumers of the relevant goods, those being clothing in class 25, primarily comprise members of the general public. Consumers will consider factors such as comfort, practicality and aesthetics, as well as size and fit when making a

purchase. However, the purchases themselves will likely be relatively frequent, and these goods clearly do not warrant the highest degree of attention. Overall, I consider the general public will pay a medium degree of attention to the same. I note there may also be a group of professionals such as retailers or athletes purchasing the goods, and due to the impact that purchasing decisions may have on their business or performance, these consumers are likely to pay an above medium degree of attention when making a purchase.

94. In respect of the sports related services in class 41, I consider these may be aimed primarily at members of the general public as well as professional athletes. As far as members of the general public are concerned, they will likely consider the type and frequency of the training or scope of facilities or activities offered and the suitability of the same for their level of skill, along with factors such as cost and convenience. I consider the general public would likely pay a medium level of attention to the same. However, where competitive or professional athletes are concerned, factors such as reputation, previous successes, qualifications and types of training programmes offered are more likely to be considered, and to receive a greater level of scrutiny. These consumers are likely to pay a high level of attention when choosing these services.

95. I do note that in the case of the applicant's *operation of sporting facilities* these are services that may be offered either to the general public, who may engage directly with the operator of sporting facilities, such as a gym for example, to seek membership and other services, or that may be engaged by the owner of those sporting facilities who require an entity to operate those facilities on their behalf. In the case of the general public, these services will be given a medium degree of attention for the same reason I have outlined above. In the case of the professionals seeking these services, they will likely pay a greater degree of attention to the reputation, scope of services and costs, and as such will pay a relatively high degree of attention in respect of the same.

96. I consider that the hospitality services generally may be engaged both by members of the general public as well as business users, whereas corporate hospitality services will only be engaged by the latter. However, both sets of users will engage these services for the purpose of arranging important events, and will likely consider factors

such as cost, services offered and reputation. In both cases, I consider that the consumer will likely pay a slightly above medium level of attention to the same.

97. All of the goods and services will likely primarily be purchased visually, either in physical or online retail stores, or through websites offering services. There may also be in-person promotional events where visual branding is present, and brochures and pamphlets may be handed out or sent via post. However, I note that word of mouth recommendations may also play a part in the process for all of the goods and services. In respect of clothing goods, verbal assistance from retail staff may also be provided, and in terms of the services, these may be engaged over the phone. I therefore cannot completely disregard the aural considerations.

Distinctive character of the earlier trade marks

98. 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 WindsurfingChiemsee 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)."

99. The first earlier mark is the word CAMBRIDGE. I note this (at the very least) alludes to a location from which services under the mark derive or are based, and it is therefore not particularly distinctive inherently. I note that registered marks must be afforded a level of distinctive character[13] however, in this instance, I consider this mark was accepted for registration on the basis of acquired distinctive character only. I therefore consider this earlier mark inherently non-distinctive, but I accept that at the time of registration it had been evidenced that it held at least a low degree of distinctive character by virtue of its use.

100. The second earlier mark describes an institution for higher education and research based in or associated with the city of Cambridge. This is inherently somewhat descriptive of a number of the services covered by the mark, particularly those relating to education and research. In respect of the various sports related services the mark still alludes to those services being offered by an institution for education and research based in or associated with the city of Cambridge. I therefore consider this mark inherently distinctive to a relatively low degree in respect of the same. In respect of the clothing goods registered under the mark, the mark is not particularly descriptive/allusive, and it is my view that the mark UNIVERSITY OF CAMBRIDGE is inherently distinctive for the clothing goods in class 25 to a medium degree.

101. The opponent has filed evidence of use in these proceedings, and I therefore must consider whether the distinctive character of the earlier marks has been enhanced by virtue of this use. When considering whether the distinctive character of a mark has been enhanced, it is the perception of the UK consumer at the relevant date, that being the date the contested application was filed, that is key. I remind myself that in this instance, that date is 5 January 2022.

[13] See *Formula One Licensing BV v OHIM,* Case C-196/11P

102. Before I consider the evidence, I note that at the hearing, Mr Tritton highlighted that the following "admissions" had been made by the applicant within its TM8:[14]

> "20. […] It is undeniable that the mark UNIVERSITY OF CAMBRIDGE () is a reputed mark for educational services, but this does not mean that the other Opponent's marks, not consisting of the part associating them clearly with University, have a reputation as well.
>
> 21. The Applicant would also like further reiterate that the Opponent's CAMBRIDGE ROWING and CAMBRIDGE mark are associated with the University of Cambridge's Rowing team and related sporting events, and as such have a reputation in relation to being a University sports team, rather than a commercial rowing experience aimed at the general public."

103. At the hearing, I note Mr Bickford-Smith made the following statements when commenting on the reputation and goodwill of the opponent:

> "We do admit they have reputation but for educational and academic related services. We make no admission that they have any such reputation when it comes to sporting activities or rowing."

104. Later, Mr Bickford-Smith stated:

> "It seems to be really that they believe they have huge reputation in commercial activities relating to rowing and that specific commercial activity is open to the public, you know. So I think we disagree on that point very heavily and while we admit that, yes, the University of Cambridge is well known for educational services, when it comes to rowing it is very specific.

[14] There was initially considerable confusion at the hearing relating to the correct version of the TM8. I had been provided with the incorrect version of the TM8 within my paper file, which set off some discussion between myself and the parties relating to the version that was currently in play in the proceedings. There was some discussion about allowing the parties time after the hearing to provide further submissions once the correct version was identified, however, upon reviewing the paper file in detail, I was able to clarify the correct version following the opponent's initial submissions, meaning there was no need to take any further action on this point following the hearing.

[…]

I do not believe that any member of the public believes that they can buy their way into The Boat Race and The Boat Race itself is well known not just because of Cambridge but because of Oxford too. I think it is very interesting that the Opponent has neglected to mention that back whatsoever. They are entirely focused on The Boat Race being about the University of Cambridge but again, Oxford versus Cambridge, you know, might be used as a headline in a newspaper but again it is referring to the cities, not just the universities. It is a competition between two cities which both have universities which both have strong rowing teams.

[…]

Their reputation is a university with a strong rowing team, not a university where you can go paying money and go for a nice little row. It is interesting that again they really only have one example of any kind of commercial usage that is remotely close to our clients and that is their boathouse in Ely, which is called the Ely Boathouse.

[…]

Looking at 5(4)(a), the Opponent essentially argues that they have huge goodwill and reputation attached to goods and services and they use their sporting events et cetera to try and argue that they have huge reputation in rowing, but that is specifically in the remit of sports teams at universities. They do not have huge reputation and goodwill when it comes to commercial rowing activities, they simply do not."

105. There is no *explicit* admission that the opponent holds an enhanced degree of distinctive character for its marks. However, I consider that between the TM8 and the comments of Mr Bickford-Smith at the hearing, the applicant appears to accept the following:

- The mark UNIVERSITY OF CAMBRIDGE has a *reputation* for educational services;
- The mark CAMBRIDGE is *associated* with the University of Cambridge's Rowing team and related sporting events;
- That the opponent has a huge *reputation* for rowing specifically in the remit of (rowing) sports teams at universities;
- That the Boat Race is well known.

106. On the other hand, it is clearly denied that the opponent holds a reputation for its marks in respect of a commercial rowing experience aimed at the general public, and none of the comments go to enhanced distinctive character specifically. I do consider the applicant's comments regarding the opponent's reputation under its marks point towards an agreement that the earlier mark UNIVERSITY OF CAMBRIDGE likely also holds an enhanced degree of distinctive character in respect of educational services, and that the mark CAMBRIDGE is associated with the opponent's rowing team and that the distinctive character of this mark has likely therefore been enhanced in respect of services related to the same. However, as I have no explicit admission of an enhanced degree of distinctive character for the marks in relation to particular services, whilst I keep these comments in mind, I will still go on to consider the evidence filed, to determine the extent to which I consider the opponent to have shown the distinctiveness of its earlier marks to have been enhanced in this instance.

107. I note the evidence shows the mark UNIVERSITY OF CAMBRIDGE has been in use for a UK based institution for higher education for hundreds of years prior to the relevant date. It is also clear that both the opponent itself, and the external press, use UNIVERSITY OF CAMBRIDGE and CAMBRIDGE interchangeably to refer to the opponent and the services offered by the same. I also note the league tables provided, showing that the university has been in first or second spot in the UK every year between at least 2011 – 2021, and that this success has been publicised by major UK press outlets including the BBC, the Guardian and the Independent prior to the relevant date. It is, in my view, clear from the evidence that the distinctiveness of both CAMBRIDGE and UNIVERSITY OF CAMBRIDGE will have been enhanced through use to a very high degree in respect of services offered by a university, which will include education and educational services or university education services in the

terms these are covered under each of the earlier marks. In any case, I note even if the evidence was not considered sufficient for this purpose, I would be in this instance willing to take judicial notice of the same.[15] I note however, for the purpose of section 5(2)(b), an enhanced degree of distinctive character for educational services is not relevant to the decision I must make.

108. In respect of the various sports services offered, which do remain relevant under this ground, I consider that it is typical for universities to offer various sports clubs and sports training to its students whilst they're conducting their studies, and indeed these services may well draw students to a particular university known for a sport they are interested in. However, this does not in my view mean that the evidence capable of showing the marks hold an enhanced degree of distinctive character for the core services offered by a university such as education will necessarily suffice to show an enhanced level of distinctive character in respect of sports clubs and sports training services, or indeed for the provision of sports facilities. It is for the opponent to provide evidence showing an enhanced degree of distinctive character in respect of these services in particular.

109. That said, I note the opponent has provided further evidence for consideration relating to its sports training programmes and club offerings to its students, as well as relating to the provision of sports facilities. I consider that the evidence confirms the university offers, amongst a wide variety of sports clubs and training, a "world class rowing programme".[16] It is clear that one of the major sources of exposure to the UK public of the opponent's rowing programme is the culmination of its efforts in the Boat Race between Oxford and Cambridge, and I note viewing figures for the race fell between approximately 2-4 million each year between 2015 and 2021. Alongside the viewing figures, there are also press articles from major publications including the BBC discussing the results of the same. I also note the success of the training programmes including the rowing programme is marked by the large number of Olympians produced by these, as Ms Ward discusses. In addition, I note the reference to double

[15] See *Chorkee Ltd v Cherokee Inc.,* Case BL O/048/08, in which Ms Anna Carboni as the Appointed Person states that the hearing officer may take judicial notice may be taken of facts that are too notorious to be the subject of serious dispute.
[16] I keep in mind these are the words used by Ms Ward herself rather than those from an external source.

gold medal winning Olympian James Cracknell racing for the Cambridge team in the Boat Race in 2019, and I consider that this was reported on including by Sky News UK at the time.

110. Although I have considered Mr Bickford-Smith's submission that the Boat Race is simply a race between two cities both with strong university rowing teams, it is my view that this is not the story that is told by the evidence provided. Whilst I note that, particularly in relation to the press surrounding the Boat Race, the mark CAMBRIDGE only is often used, the association of the race and the CAMBRIDGE team with the opponent is in my view nonetheless clear. There are a number of references to the universities in the press surrounding the boat race, with one BBC article dating from 2021 stating (for example):

> "The BBC will continue to broadcast the annual Boat Race between Oxford and Cambridge universities for a further four years"

111. It is, in my view, evidence of significant publicity associated with the opponent's rowing team and as such its training programme under the marks. I consider that, at the very least, the opponent's earlier mark CAMBRIDGE has been enhanced for services including *providing of sports training in the field of rowing* and *sports coaching [training] in the field of rowing* in class 41, to a high degree. It is my view that the distinctiveness of mark UNIVERSITY OF CAMBRIDGE has also been enhanced in respect of *providing of sports training in the field of rowing*, but in case in case I am wrong on this point, I will also consider the position if this second mark is not considered to benefit from an enhanced distinctiveness in respect of these services.

112. Whilst I note the evidence of use of the mark in relation to the provision of sporting facilities, it is in my view, not as obvious that this has been publicised or will be particularly known by the UK consumer, and as such I do not consider the distinctiveness of the marks to have been shown in evidence as enhanced in respect of the same. I have considered alongside the evidence of the sports centre etc, the references to the "Cambridge University Boat Club" in the evidence and in the press, but I do not consider these to contribute to an enhanced degree of distinctive character in the marks for the provision of sporting facilities themselves. Further, in respect of

clothing items, whilst I do not have any evidence on the size of the market in the UK, it is my view this will no doubt be very large. I consider the relatively low sales figures for clothing items provided in evidence, as well as the lack of additional supporting evidence relating to the promotion and advertising of the goods, and with this in mind it is my view that the distinctiveness of the mark relying on these goods, that being UNIVERSITY OF CAMBRIDGE, has not been enhanced in respect of the same.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

113. Prior to reaching a decision under Section 5(2), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 52 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the distinctiveness of the common elements is key.[17] I must keep in mind that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that how the goods are obtained will have a bearing on how likely the consumer is to be confused.

114. In respect of section 5(2)(b) of the Act, there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between

[17] See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.[18]

115. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

Likelihood of confusion under section 5(2)(b) relying on earlier mark CAMBRIDGE

116. I note, firstly, that the opposition based on the earlier mark CAMBRIDGE only has failed under this ground where the goods and services are deemed dissimilar. This is the case for the following contested goods and services:

> Class 25: *Sports clothing; Sports wear; Sports jackets; Clothes for sport.*
> Class 35: *Merchandising; Inventorying merchandise; Product merchandising; Business merchandising display services; Display services for merchandise; Product merchandising for others; Preparing promotional and merchandising material for others.*

117. In respect of the remaining services, I found these to range from similar to a medium degree to identical. I found the average consumer would pay a medium or above level of attention depending on the services, and that these would primarily be purchased visually, although aural considerations are still relevant. I found the marks to share the dominant (or at least codominant) element CAMBRIDGE, and overall that there is a medium level of visual and conceptual similarity, as well as just above a medium level of aural similarity between the marks. I found that the earlier mark itself to technically be non-distinctive inherently but to have acquired at least a low level of distinctive character at the time of registration, and that this has been enhanced through use in respect of some of the services, those being sports training and coaching services in the field of rowing, to a high degree.

[18] *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

118. Having considered all of the relevant factors, it is my view that the differences between the marks are, in this instance, too significant to simply be misremembered or go unnoticed, even keeping in mind the identity of some of the services and the enhanced distinctive character relied upon. I therefore find no likelihood of direct confusion between the marks.

119. I therefore move on to consider the likelihood of indirect confusion. In *L.A. Sugar* (cited above) Mr Iain Purvis Q.C. (as he then was), as the Appointed Person set out three examples of when indirect confusion may occur. These are set out below:

> *"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)."*

120. I note that the examples above were intended to be illustrative and are not exhaustive. I also keep in mind *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, in which Arnold LJ referred to the comments of James Mellor Q.C. (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.

121. Further, I also consider *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), in which Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo,* Case C-591/12P, on the court's earlier judgment in *Medion v Thomson.* The judge said:

> "18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.
>
> 19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.
>
> 20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

> 21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

122. I consider at this stage the applicant's position that the word CAMBRIDGE would simply serve to indicate the location of the services themselves within the marks. Further, I note Mr Bickford-Smith's multiple requests for me to consider the "policy position" when reaching my conclusion. Particularly, Mr Bickford-Smith argued that as geographic locations are generally "exempted from registration as trade marks […] it is wise to think about the extent to which the university can use [its] acquired distinctiveness given that it is a pretty intense exception". When asked to elaborate on how he wishes me to consider this in the context of 5(2)(b), Mr Bickford-Smith went on to state:

> "Cambridge Rowing is in the city of Cambridge. It ideally wants to show that, you know, it is a rowing experience that exists in the city of Cambridge. You know, again like I have said, if it is a geographic reference we need to understand how the word "Cambridge" would be understood in that case and if only understood as a reference to a place then that affects both 5(2)(b) and 5(3). Consumers would understand CAMBRIDGE in that context to be a place not a university."

123. Mr Tritton for the opponent also provided his position on Mr Bickford-Smith's comments above. He highlighted at the hearing that this matter is not concerned with infringement, and it is not therefore, for me to decide whether the applicant is free to use the word CAMBRIDGE descriptively in respect of services offered in the city of Cambridge, or whether it has a valid defence to an infringement action on that basis. Mr Tritton highlighted that the issue here is that the applicant has sought to protect its own monopoly right for its mark, which will apply throughout the United Kingdom. He submitted that I must consider the likelihood of confusion between the marks wherever they are used in the UK.

124. I have considered both sets of submissions carefully. It is of course true that geographical place names are often considered to have a lower (if any) level of distinctive character inherently. I note also, that I should be careful not to afford too great a level of protection to marks which hold only a low level of distinctive character when reaching a decision under this ground. However, my primary concern and consideration in the context of section 5(2)(b) is whether consumers will be able to rely on a contested mark, if registered, to accurately identify the economic origin or the goods and/or services, without there being a likelihood of confusion with the goods or services offered by another trader under an alternative registered mark. This is for the purpose of establishing whether, on a primarily notional basis, two marks can coexist in a way that enables consumers to be able to identify the entity from whom the goods and services they engage arise, and either repurchase goods and services if they are satisfied, or choose to avoid repeat purchases in future if they are not, protecting the rights both of consumers and of registration holders. I am not required, and indeed it is not within the scope of the Tribunal to decide, as a matter of "policy" or otherwise, to what extent the opponent may prevent the applicant or other parties from using the word CAMBRIDGE descriptively outside of the context of registration. Further, I agree with the submissions of Mr Tritton that I must consider that if granted registration, the applicant will be afforded protection for a mark that may be used throughout the United Kingdom, and not simply one that may be used in Cambridge alone.

125. Keeping the above in mind, I also note in the context of this particular case, not only that as a registered mark CAMBRIDGE solus must be afforded a level of distinctive character, but also that this level has been enhanced by the opponent through its use for some similar and identical services. Further, I note this is the only element of the earlier mark and it is at least co-dominant in both marks. I consider that in the context of the sports services offered, there are no particularly distinctive elements included in the contested mark which may assist the consumer in reaching a conclusion that different entities are responsible for the marks. I also remind myself again of the visual, aural and conceptual similarity between the marks, as well as the level of attention paid and the purchasing process of the average consumer, which will be primarily visual.

126. Whilst this case is not entirely in line with the examples given in *L.A. Sugar*, I do consider that this is similar to the scenario set out in category B, with the contested mark including only additional elements which are of limited or no distinctiveness in the context of the majority of the services, those being all of the sports related services in class 41. Further, and in any case, with consideration to all of the factors previously set out, it is my view that it would be perfectly logical and indeed likely, that consumers who have previously encountered sports (including rowing) services under the opponent's earlier mark, would upon seeing the contested mark, believe this to be a more decorative or elaborate version of the earlier mark deriving from the same entity, with CAMBRIDGE indicative of the origin of the sports related services in each. I therefore find a likelihood of indirect confusion between these marks in respect of all of the similar and identical sporting services in class 41.

127. That leaves the contested services *corporate hospitality (entertainment); hospitality services (entertainment).* I whilst I note that many of the same factors as above apply in respect of these services, there are some differences I must factor into my assessment. Firstly, I have not found the mark CAMBRIDGE to hold an enhanced degree of distinctive character in respect of the services which I find to be identical to these services, those being *entertainment* at large. Further, I do not find significant similarity based on the *Treat* factors between the services for which the distinctive character of the mark has been enhanced and these services. However, I consider that the applicant's hospitality and corporate hospitality services will include those covering commercial rowing experiences. As such, whilst I note the opponent's mark CAMBRIDGE holds only a low degree of distinctive character (on the basis that it is a registered mark) for entertainment at large, it will nonetheless be in use in both marks as a key indicator of origin in respect of identical services. Therefore, with consideration to these factors, I find it would still be perfectly logical and again likely that a consumer who has previously come across rowing related hospitality (entertainment) or corporate hospitality (entertainment) services under the mark CAMBRIDGE,[19] would assume that any rowing related hospitality or corporate hospitality services offered under the contested mark would likely derive from the same origin. I therefore also find a likelihood of confusion in respect of these services.

[19] As included within the broader category of *entertainment* at large.

128. For completeness, I note at this stage that I do not consider that the opponent's reliance on its class 41 services *sporting and cultural activities; sport camp services* would take it any further, and as such I do not intend to go back and consider whether it has shown genuine use in respect of the same at this stage.

Likelihood of confusion under section 5(2)(b) relying on earlier mark UNIVERSITY OF CAMBRIDGE

129. I can deal with the likelihood of direct confusion relying on this mark relatively swiftly. The factors for consideration in respect of this earlier mark are less favourable for a finding of direct confusion than those outlined under the previous mark relied upon. In particular, I consider that the differences between this earlier mark and the contested mark are aurally and visually more significant. Whilst I note there is identity between a broader and different range of goods and services under this mark including those such as clothing, considering all of the relevant factors, I still consider that the differences between these marks are too significant for the consumer to entirely forget or fail to notice the same. I therefore find no likelihood of direct confusion between the marks.

130. I therefore move on to consider the likelihood of indirect confusion between the marks. I consider again, the categories identified in *L.A. Sugar*, and whilst I remind myself that these are not exhaustive, I note these marks do not fit into the categories set out in the same. Considering firstly the contested class 25 goods, whilst I note these are identical to earlier goods, I also note the mark as a whole holds only a medium level of distinctive character in relation to the same. Considering these points, on a notional assessment of the marks and the goods, there is in my view little logical basis for a finding of indirect confusion between the marks for the goods in class 25. I see no real reason why an entity would take only the CAMBRIDGE element from the earlier mark and use this alongside the other elements in the contested mark as part of a brand extension or sub-brand in the context of this ground and these goods. The opposition based on this earlier mark against the class 25 goods therefore fails on the basis of section 5(2)(b) of the Act.

131. In the context of class 41 however, I consider again the elements of the contested mark that appear to indicate the services, and I consider that the earlier mark is in my view, highly distinctive for sports training services in the field of rowing. I consider that in the circumstances, there would be a logical basis for the consumer to consider that an entity, that being a university, using the highly distinctive mark UNIVERSITY OF CAMBRIDGE mark in respect of its class 41 services for sports training services in the field of rowing, to use the contested mark as an alternative form of branding in respect of the contested sports/rowing related services in this class, where those services are similar to at least a medium degree. I therefore find a likelihood of indirect confusion between these two marks in respect of sports services in class 41 in this instance, however, considering all of the relevant factors, this finding does not extend to the additional hospitality and corporate hospitality services in this class in the context of this ground. Further, I note for completeness that if I am wrong in my finding of enhanced distinctive character for rowing related services based on this earlier mark, I consider there will be no likelihood of indirect confusion in this instance. However, considering my findings on this ground based on the opponent's other earlier mark, this will be of no consequence to this decision.

132. The opposition based on section 5(2)(b) of the Act has succeeded against the following services:

> Class 41: *Sports activities; Sport camps; Sporting services; Sporting activities; Instruction in sports; Sports entertainment services; Training in sports; Sports coaching services; Sports and fitness; Organising of sporting events, competitions and sporting tournaments; Operation of sports facilities; Corporate hospitality (entertainment); Hospitality services (entertainment).*

133. However, it has failed in respect of the remaining goods and services, those being:

> Class 25: *Sports clothing; Sports wear; Sports jackets; Clothes for sport.*
> Class 35: *Merchandising; Inventorying merchandise; Product merchandising; Business merchandising display services; Display services for merchandise;*

Product merchandising for others; Preparing promotional and merchandising material for others.

134. I will now move on to consider the opposition based on section 5(3) of the Act.

Section 5(3)

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

"(3) A trade mark which-

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 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".

136. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case C-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 C-383/12P, *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; G*eneral 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) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) 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.

(h) 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.

(i) 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. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) 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).*

137. An opposition based on section 5(3) of the Act can only be successful via the establishment of several individual elements. To be successful on this ground, the opponent must prove it holds a reputation for the earlier mark relied upon amongst a significant portion of the public. It must also be established that the marks are similar. If it is found both that the marks are similar and that the earlier mark holds a qualifying reputation, it must then be shown that this reputation, combined with the similarity between the marks, will result in the relevant public establishing a link between the marks. A link may be found on the basis that the later mark brings the earlier mark to mind. Importantly, if all three of these elements have been established, it must then be shown that the link made by the public will result in, or will be likely to result in, one of the pleaded types of damage.

138. I remind myself at this stage that the opponent has relied upon two marks only under section 5(3) of the Act. These are UK trade mark no. 3015609 for the mark CAMBRIDGE and UK comparable trade mark no. 900896449 for the mark UNIVERSITY OF CAMBRIDGE. I note that the opponent's reliance on the single mark UNIVERSITY OF CAMBRIDGE offers protection for a narrower range of goods and services under this ground than under section 5(2)(b), where two identical

UNIVERSITY OF CAMBRIDGE marks were relied upon covering different specifications of goods and services. One notable difference is that as far as sports services go, the opponent's 900896449 relies only on *provision of recreational and sporting facilities* rather than the wider set of sports services including training in class 41.

Reputation

139. I consider again the evidence set out at the outset of these proceedings. I have mentioned the high points of the evidence under my assessment of enhanced distinctive character under section 5(2)(b). Whilst these are not identical assessments, the key points of the evidence are relevant to each. With respect to the education services relied upon, these include details of the opponent's history detailing that the UNIVERSITY OF CAMBRIDGE has been in existence for hundreds of years, its consistent ranking as one of the top two UK universities since 2011 and up until the relevant date, the reports of this success by major press outlets including the BBC, the Guardian prior to the relevant date. An article provided dating from 2017 from the Independent, listing the opponent as the UK's no. 1 university based on "QS world university rankings" states:

> "A university's ranking is based on the institution's reputation with academics and employers, and the number of research citations the school gets per paper published in a specific discipline – in this case, law".

140. A BBC article dating from 2018 discussing the opponent's success as top university for an eighth consecutive year in the Complete University Guide Rankings states:

> "The Complete University Guide 2019 rankings are based on 10 measures, including research, student satisfaction and graduate prospects."

141. As previously mentioned, both in material produced by the opponent itself and in the press articles, the marks CAMBRIDGE and UNIVERSITY OF CAMBRIDGE are used interchangeably. Whilst I note that the university rankings are based on a number

of factors and not purely the reputation of a university, I do note that the exposure received due to the top ranking in the UK, for example in the press articles above, will undoubtedly contribute towards the opponent's reputation for its services. Considering this, alongside the longstanding nature of the institution referred to under both earlier marks, I am satisfied that the opponent has shown it has a very strong reputation in the UK for education and educational services, and university education services as they are covered under the earlier marks. Further, and in any case, if I am wrong in my assessment of the evidence in respect of these services, I note that; 1) the applicant concedes that the opponent holds a qualifying reputation for educational services under at least UNIVERSITY OF CAMBRIDGE and 2) I am willing to take judicial notice of a very strong reputation for education and university education services as relied upon under the marks CAMBRIDGE and UNIVERSITY OF CAMBRIDGE in this instance.

142. When conducting my assessment of enhanced distinctive character in respect of the mark UNIVERSITY OF CAMBRIDGE, I highlighted why I did not consider the evidence sufficient to show this in respect of the goods and services *clothing, footwear, headgear* in class 25 or *provision of recreational and sporting facilities* in class 41. I reiterate that whilst I am aware these are not identical assessments, it is my view that the shortfalls found in the evidence for enhanced distinctive character, including the low sales figures for clothing and lack of evidence of promotion or particular public awareness of its provision of recreational or sporting facilities as such, also prevent the opponent from proving it holds a reputation for its UNIVERSITY OF CAMBRIDGE mark in respect of these additional goods and services.

143. With consideration to the earlier mark CAMBRIDGE, I note again the evidence provided relating to the sports services relied upon under this mark. I consider again the wide variety of sports clubs offered to their students, although I note this alone is not sufficient to show it holds a reputation for the same. I remind myself of the evidence provided relating to the rowing training programme outlined, significant public exposure to which is provided via the Boat Race between Cambridge and Oxford, which has been televised on the BBC since 1938 and received UK viewing figures of between 2-4 million between 2015 and 2021. I consider the number of Olympians produced by the opponent's rowing programme which will have undoubtedly added to

public awareness of the same. In addition, there is the UK press coverage from outlets such as the BBC and Sky News, including the reporting on the double Olympic champion James Cracknell racing for the team in 2019. I note the reporting on the event refers to the opponent's team as "Cambridge". Overall, considering the evidence provided, I am satisfied that the opponent has shown it holds a strong reputation for *providing of sports training in the field of rowing* and *sports coaching [training] in the field of rowing* under the mark CAMBRIDGE.

Link

144. I therefore move on to consider whether the average consumer would make a link between the marks in this instance. I consider this in accordance with the factors set out in Intel as below:

> The degree of similarity between the conflicting marks
>
> Earlier in this decision I found the opponent's UNIVERSITY OF CAMBRIDGE mark to be visually and aurally similar to the contested mark to a low degree, and conceptually similar to a medium degree.
>
> I found the opponent's mark CAMBRIDGE to be visually and conceptually similar to the earlier mark to a medium degree, and aurally similar to just above a medium degree.
>
> 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
>
> In respect of the services relied upon for which I have found a reputation for under the mark UNIVERSITY OF CAMBRIDGE, those being university education services, I do not consider these to be particularly similar to the goods and services covered by the contested mark. That said, as discussed previously in this decision, I do note that in my experience it is common for

sports services, such as those covered by the applicant in class 41, to be offered by the same institutions as those offering education services, particularly when it comes to universities. I consider the sports services and facilities offered may well be part of the attraction of a particular educational institution, and there is therefore also an overlap in the users of the services themselves. I therefore consider that these services, whilst only similar to a very low degree at best, do still share a degree of closeness and are not entirely disparate for the purposes of an assessment under section 5(3) of the Act.

In respect of the additional services in class 41, those being *corporate hospitality (entertainment)* and *hospitality services (entertainment)* I consider these to be dissimilar to the earlier *education* or *educational services*. Considering the relevant factors outlined in *Treat*, I see no significant points of similarity between the same. However, I do note that entities offering education and educational services may offer these services both to corporate entities in addition to the general public, and so there is an opportunity for an overlap in the user (albeit at a general level) of education and educational services and both corporate hospitality (entertainment) and hospitality services (entertainment).

I consider that the contested sports clothing goods covered by the applicant's class 25 are again somewhat removed from educational services, certainly being dissimilar overall when considered in accordance with the factors outlined in *Treat*. However, in my experience it is not uncommon for universities to sell clothing, at least to its students, under the university's name, and I note the opponent shows it also provides clothing in its evidence. Whilst these goods are not, in my view, materially similar to the services in accordance with the case law set out under section 5(2)(b), I consider again that these are not entirely disparate goods and services, compared to, for example, something such as educational services and cars for example, and there may be an overlap in users of the goods and services by way of the general public including university students themselves.

In respect of the class 35 services, whilst I note that it is likely institutions offering educational services offer various merchandise to potential students for example, it does not seem likely they offer the services for merchandising, or the other class 35 services listed, to others. I see no real points of similarity between these services, which I have already considered to be dissimilar in the context of 5(2)(b). Users will not be shared at more than a very general level.

In respect of the services for which I have found a reputation under the mark CAMBRIDGE, I note firstly my findings above based on education and educational services are mirrored here. Further, I consider the services *providing of (sports) training* and *(sports) coaching [training]* both *in the field of rowing* against the contested services. I have previously found these to be identical to many of the sports related services in class 41, and where there is no identity, I still consider these to be similar to the class 41 sports services to at least a medium degree.

In respect of the services *corporate hospitality (entertainment)* and *hospitality services (entertainment),* it is my view these are also dissimilar to services relating to sports training and sports coaching in the field of rowing. In accordance with the factors set out in *Treat*, I see no significant points of similarity. However, I consider that corporate hospitality and hospitality events may offer a rowing experience, and I can see from the evidence that this is offered to the public by the opponent. Whilst this does not render the services similar generally, again I do not consider them entirely disparate.

In respect of the class 25 goods, I have already found these to be dissimilar to the opponent's services. However, I consider that both the goods and services are in the field of sports, and there will be a general overlap in consumers on this basis, with both athletes and the general public likely to engage sports services and purchase sports clothing to wear whilst using those services.

Finally, I again consider the services in class 35 services against the opponent's services for which it holds a reputation. I see no points of similarity between

these services, and consider them dissimilar, albeit with a potential overlap in users only at a very general level.

The strength of the earlier mark's reputation

I found both earlier marks to have a very strong reputation for *education* and *educational services* or *university education services* as they are relied upon, and I found the opponent's earlier mark CAMBRIDGE to hold a strong reputation for *providing of (sports) training* and *(sports) coaching [training]* both *in the field of rowing.*

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

I have previously found UNIVERSITY OF CAMBRIDGE and CAMBRIDGE to hold a relatively low degree, or no degree of distinctive character inherently in respect of the services for which I have found the opponent to hold a reputation. However, I found that by virtue of the use made of the same, the distinctive character of the marks had been enhanced to a very high degree in respect of *education* and *educational services* or *university education services* as relied upon, and to a high degree in respect of *providing of (sports) training* and *(sports) coaching [training]* both in the field of rowing.

Whether there is a likelihood of confusion

I have previously found there to be a likelihood of confusion between the marks in the context of section 5(2)(b) of the Act, based on the earlier mark CAMBRIDGE and in respect of the contested sports related services in class 41. It is my view that this finding remains relevant under this ground based on the services for which a reputation has been found.

It is possible under section 5(3) for the reputation of an earlier mark to be such that the relevant consumer is likely to believe that the use of a contested mark in relation to similar or dissimilar goods or services will be use of the same or a

similar mark deriving from the same or a connected economic entity. A finding of this nature would result in a conclusion that there is a likelihood that the consumer will be confused as to the origin of the marks either directly or indirectly under this ground.

Considering all of the relevant factors, including the similarity of the marks and particularly the strong reputation for the sports training and sports coaching services in the field of rowing held by the opponent, it is my view that there would be a likelihood of confusion between the opponent's mark CAMBRIDGE and the contested mark in the context of the sports related clothing in class 25. The additional elements present in the applicant's mark do little to help differentiate it from the mark owned by the opponent, considering the services for which the opponent holds a reputation in this instance, and with the opponent's strong reputation in mind, it is my view that the consumer is likely to believe that sports clothing goods under the mark stem from or are authorised by the opponent in this instance.

Further, I consider this may also be the case in relation to the hospitality and corporate hospitality services in class 41, particularly where those services offer hospitality events featuring rowing. It is my view that in those instances, with regards to the reputation of the opponent for sports coaching and training in the field of rowing, the consumer is likely to believe that the mark represents a service offering from the opponent to corporate and non-corporate consumers.

I note the services in class 35 are somewhat further removed from those for which the opponent has a reputation. I consider that services do not need to be similar in order for there to be likelihood of confusion in the context of this ground. Considering all of the relevant factors, and keeping in mind the distance between the services, I am less convinced there will be a likelihood that a portion of consumer would believe services in class 35 offered under this mark would necessarily originate from the opponent, although I consider it would likely result in a pause to wonder if that may be the case, due to the opponent's strong reputation being held in the field of rowing, and the contested mark sharing the same distinctive element CAMBRIDGE as well as being themed

around the sport of rowing. However, as this is not as pronounced, I will nonetheless consider the possibility of link where there is no likelihood of confusion present for these services.

In respect of the earlier mark UNIVERSITY OF CAMBRIDGE, the position is, in my view, less clear cut. Whilst I note the very strong reputation held for university education services under the mark, the opponent does not rely on its sports coaching and training services under the same, and as such, a reputation for this mark in respect of those services has not been found. Within the confines of the pleaded case, I therefore do not find a likelihood of confusion between this mark and the contested mark in the context of section 5(3) in this instance.

Conclusions on link

145. Where there is a likelihood of confusion between the earlier mark CAMBRIDGE and the contested mark in the context of the 5(3) ground, it is inevitable that a link will be made between the marks. However, I note that even where there is no likelihood of confusion between the contested goods and services based on this earlier mark, considering all of the relevant factors, including the similarity of the marks, the fact that the contested mark is themed heavily towards rowing, which relates to services for which the opponent holds a strong reputation, and the shared identical element which holds an enhanced degree of distinctive character in respect of the services for which a reputation is held, it is my view that the use of the contested mark will at the very least bring the opponent and its earlier mark to mind and create a link in the mind of the consumer in respect of the same.

146. In respect of the opponent's earlier mark UNIVERSITY OF CAMBRIDGE, whilst I have found it holds a very strong reputation, I note I am to consider its reputation for *university education services* rather than sports services per se. Whilst I note it is clear from the evidence that the mark has a strong association with rowing and as Mr Bickford-Smith put it, "[t]heir reputation is a university with a strong rowing team", I must consider the position based on this earlier mark in the confines of the pleaded

case and the services for which it is registered.[20] The position under this mark is therefore less favourable to the opponent, and I find it unlikely a link will be made on this basis alone. As such, I intend to continue my assessment under this ground based on the opponent's earlier CAMBRIDGE mark only.

Damage

147. I now move on to consider damage. I will consider only the opponent's reliance on its earlier mark CAMBRIDGE at this stage, for the reasons set out above. The opponent has pleaded all three types of damage, those being unfair advantage, detriment to distinctive character and detriment to repute. I will begin by considering unfair advantage.

Unfair advantage

148. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. (as he then was) considered the earlier case law and concluded that:

> "80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill."

[20] See *Tulliallan Burlington Ltd v EUIPO,* Case T-123/16 and *Intel,* Case 252/07.

149. In this case, the opponent has pleaded that the use of the applicant's mark would result in the public believing that this was use by the opponent or by an economically connected or endorsed entity, and that this would result in the applicant free-riding on the opponent's reputation. Further, the opponent pleaded that even if the consumer were not actually confused, the link created between the marks would result in an unfair advantage for the applicant. I note the opponent has also filed evidence which it submits go to the intention of the applicant to benefit from the reputation held by the opponent.

150. At the hearing, Mr Tritton drew my attention in particular to pages from the applicant's own website filed at Exhibits BNB1 and BNB2 to the witness statement of Mr Britter. These pages discuss the applicant's offering of its "Cambridge Rowing Experience". The first of these pages is provided via the Wayback Machine dating from December 2021, and reads (my emphasis):

> "Whether you're a resident or just visiting for work or pleasure, we are delighted to offer a rare and exciting opportunity for you to experience Cambridge's most iconic sport – rowing!
>
> We run half-day sessions throughout the year, using high quality facilities and equipment. <u>You'll get the chance to row in a coxed eight boat, just like the crews in the word-famous Oxford-Cambridge Boat Race […]</u>
>
> So whether you want to learn a new skill, bond with your friends or your team, or make new friends – sign up for the Cambridge Rowing Experience today!"

151. Whilst the second page provided from the applicant's website dated from 2024, it offers a similar sentiment, stating:

> "WE WANT YOU TO EXPERIENCE ROWING
>
> Have you ever stood on the bank of the river and watched some of the large rowing boats and thought you'd like to give it a go? Well, now you can with

Cambridge Rowing Experience – a brand new attraction aimed at complete beginners!

You can now book a 3 hour experience with us and be rowing on the river Cam in little over an hours' time! You'll get the chance to row in a coxed 'eight' boat, just like the crews in the famous Cambridge-Oxford Boat Race and so will be joined with seven other complete beginners.

For tourists, delegates, event attendees etc. we can now give you the most 'Cambridge' experience by offering you an opportunity to try this iconic activity – and become a member of a town rowing club for the day.

[…]"

152. I also consider the use of the crossed rowing blades and the shield in the contested mark. In respect of the crossed rowing blades in particular, I note both parties' positions on the distinctiveness of the same appear to vary somewhat depending on the point they are trying to make. However, I note that nevertheless, Mr Tritton submitted at the hearing:

"They have truly chosen the activities which my client is well known for. As I say, that may be more of a distinctive and dominant element point but really CAMBRIDGE ROWING, with the cross rowing blades, the shield and all that, we really say that is a nudge and wink to the university and we say indeed it is intended to be so."

153. I do note that Mr Tritton also accepted at the hearing that crossed rowing blades are clearly associated with the sport of rowing and made his point more heavily in relation to the use of the shield in the applicant's mark, but he did not withdraw his original submissions on this. Mr Bickford-Smith also came back on this point at the hearing. I note at this stage that as I explained at the hearing, I will not be taking his submissions or those in the skeleton arguments that there are multiple other boat clubs using crossed rowing blades as evidence of fact, and I give this no weight. However, I do accept the general agreement between the parties that the distinctive character

of crossed rowing blades is at the most, low in relation to rowing. I also note Mr Bickford-Smith's submission that use of a shield alone is not particularly distinctive. That said, I consider the opponent's use of both crossed oars and a shield in the evidence, and Mr Bickford-Smith's own observations on this evidence, which included (at different stages in the hearing):

> "We cannot see the full figure but on every single item of clothing it usually has UNIVERSITY OF CAMBRIDGE, a crest and maybe the crossed oars. Again, the crossed oars alone I think do not have any distinctive character […]
>
> […]
>
> This Ely Boathouse costs over £1,000 for usage. It is generally not open to the public. It is in Ely. The branding again includes -- on the website includes the University of Cambridge, its shield, crossed oars and the Red Lion. Again, any member of the public using the Ely Boathouse will know that this belongs to the University of Cambridge."

154. I have considered carefully the points made by both parties, in addition to the tension both parties faced when arguing their case across the grounds, with both at points wishing to diminish the use of the crossed rowing blades and shield for the purpose of one ground and highlight this for the purpose of another. I accept the use of crossed rowing blades in a mark is not particularly distinctive in the context of most of the services filed and the applicant's activities, and so the applicant's choice to use this in its mark alone is not sufficient to point to an intention to benefit from the reputation of another entity. Further, whilst it is less obvious why a shield might be used in the applicant's mark, again this alone does not say too much. However, I consider the evidence and the facts of this case as a whole, including the opponent's strong reputation which is at the very least partially as a result of its role in the highly publicised Boat Race, its own use of a shield shown in the evidence and its use of crossed rowing blades including on the images of its crews participating in the Boat Race, in addition to the clear reference to the "world-famous" Boat Race on the applicant's website. It is my view that on balance the evidence does suggest that whilst the applicant's intention is not necessarily to represent itself as associated with the

opponent, its subjective intention appears to be to benefit from the reputation of the opponent for services relating to rowing.

155. With consideration to all of the factors of this case, it is my view that where there is a likelihood of confusion between the marks in the context of section 5(3) of the Act, there is no doubt that the applicant will benefit unfairly from the significant investment made by the opponent in its mark and the resulting reputation and image of prestige created by its widely publicised achievements, without any financial compensation being paid to the opponent.

156. Further, even if it is not the case that consumers believe all of the applicant's goods and services derive from or are economically linked to the opponent in some way, I consider the applicant's mark will nonetheless benefit from the instant familiarity and as such the sense of prestige in the eyes of the consumer due to the opponent's strong reputation for services relating to rowing, and the identical element of the applicant's mark alongside its rowing theme, thereby securing a commercial advantage as a direct benefit of the opponent's reputation. I therefore agree with the opponent that the applicant will gain an unfair advantage from the use of its mark in respect of all of the goods and services filed.

157. For completeness, I note here that whilst I have made these findings with the view that there appears to have likely been a subjective intention to benefit from the opponent's reputation, I note that even if I am wrong on that point, I would still find the objective effect of the registration and subsequent use of the applicant's mark would be to gain an unfair advantage in respect of all of the goods and services filed.

158. As I have found that the opponent will gain an unfair advantage for all of the goods and services filed, it is not necessary for me to consider the additional heads of damage in this instance.

Section 5(4)(a) of the Act

159. Section 5(4)(a) states:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
(aa) […]
(b) […]

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

160. Subsection (4A) of Section 5 states:

"(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

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

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

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them

are deceived (per Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21)."

162. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander QC (as he then was), as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

> "43. In SWORDERS TM O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:
>
> 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'"

163. In this case, the application was filed on 5 January 2022. The applicant has filed no evidence of use in these proceedings. Whilst I do note that the opponent has filed evidence of the applicant's webpage at Exhibits BNB1 and BNB2 to the witness statement of Mr Britter, I note the page dated in December 2021, prior to the relevant date in these proceedings, does not display the contested mark, instead using the mark CAMBRIDGE ROWING EXPERIENCE. I therefore only have the position at the relevant date of 5 January 2022 to consider in this instance.

164. The opposition based on section 5(4)(a) of the Act relies on the opponent's use of the sign CAMBRIDGE only, in respect of the following services:

> *Education; provision of courses of instruction; lectures and seminars; provision of recreational and sporting facilities; sporting activities; sports training; organising of sporting events; sports clothing.*

Goodwill

165. *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) defines goodwill as follows:

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

166. I have set out the key points of the evidence earlier in this decision. I have previously found that the opponent has provided evidence sufficient to show a reputation for education and educational services, as well as sports training in the field of rowing under a mark identical to the sign relied upon here. Where the evidence is sufficient to find a reputation for these services, it is clear it will also suffice to establish goodwill under the sign. I am therefore able to find a significant level of goodwill under the sign CAMBRIDGE in respect of at least the following services:

> *Education; lectures and seminars; sports training in the field of rowing.*

167. Further, it is my view that the opponent's reputation for educational services under the sign CAMBRIDGE clearly extends to the provision of lectures and seminars and the provision of courses of instruction, and as such I also consider it holds significant goodwill in respect of *lectures and seminars* and *provision of courses of instruction* as relied upon.

168. I note that the threshold for establishing goodwill held in a business under a sign is lower than that required for establishing a reputation. I consider the evidence provided by the opponent relating to the provision of the large number of sports clubs and the sports facilities offered by the opponent, including the provision of a sports centre (and the turnover figures for the same) and its rowing facilities for example. I note the use of CAMBRIDGE by its athletes when referring to these clubs, as well as the significant use of the same on its own within the documents referencing the

provision of its sports clubs and sports facilities provided at Exhibit AW-3 dating from 2019-2020. Whilst the document itself appears to be internal, the Sports Guide 2021-2022 document that appears to go out to students and details the sports clubs and facilities provided also makes significant use of the sign CAMBRIDGE on its own, stating for example:

> "While renowned for its rowing and rugby, Cambridge offers you a diverse range of competitive and recreational sporting activities with over 75 Sports Clubs and Societies, from traditional to sports rising in popularity."

169. This use of the sign Cambridge only to refer to the opponent in addition to its sporting services appears to also be consistent with how the opponent is referred to in the press consistently prior to the relevant date. It is my view that the evidence provided shows the opponent has also established goodwill in its business as distinguished by the sign CAMBRIDGE in respect of the following services:

> *provision of recreational and sporting facilities; sporting activities; sports training;*[21] *organising of sporting events.*

170. Finally, I consider again the evidence relating to the opponent's use of the sign CAMBRIDGE in relation to the goods *sports clothing.* I note the opponent has provided turnover figures for each year between 2018 and the relevant date in 2022 relating to the sale of clothing. I consider that these figures exceeded a million in 2019, but that the figures for the remaining years are relatively low. Further, whilst there is a limited amount of evidence of sports clothing being sold, I also note evidence relating to the sale of general clothing and children's clothing, and so it is not clear what proportion of the figures relate to sports clothing as such. In addition, I note that there is only minimal evidence of clothing items being sold under or bearing the sign CAMBRIDGE only[22] with instead this mostly featuring references either to Cambridge University or the University of Cambridge. Overall, considering the evidence as a whole, it is my

[21] Including outside of the field of rowing.
[22] I have considered the references provided to the occasions this is used by Mr Tritton at the hearing.

view that this is not sufficient to show that the opponent holds goodwill in its business in respect of *sports clothing* as distinguished by the sign CAMBRIDGE only.

171. Before I go on to consider misrepresentation, I note there were brief submissions made with regards to the ownership of goodwill generated by the activities shown in the evidence. Mr Bickford-Smith made the following submission within his skeleton arguments:[23]

> "25. The Opponent states that rowing is a preeminent sport at the University. However, this is a mere association of a sport with the name of the city. It is submitted that an average consumer who comes across the term 'CAMBRIDGE UNIVERSITY' [SIC] does not immediately associate the mark with the University itself but that the sport is merely occurring in the city of Cambridge. Furthermore, within AW's witness, it is stated that the three listed Cambridge rowing clubs (CUBC, CUWBC and CULRC) were merged into one entity, which retained the Cambridge University Boat Club in August 2020. Even if we were to consider that the previous entities were to have acquired goodwill and reputation, they no longer exist, and the new entity was formed only 17 months prior to the filing of the Applicant's trade mark.
>
> Thereby, the Opponent has not acquired any goodwill attached to the mark "Cambridge" in relation to rowing activities and fails to function as a strong, distinctive indicator of source for the claimed goods and services."

172. At the hearing, Mr Tritton replied to this point as follows:

> "I just want to pick up AW 10, which deals with a point made by the Applicant's skeleton argument and ties in, by the way, with the evidence of Andrea Ward at paragraph 20. Just so you understand how this works, the various boat clubs

[23] It is my view that, in the interest of fairness, and in accordance with *TUI UK Ltd v Griffiths* [2023] UKSC 48, a challenge to the correct ownership of any goodwill should have raised as early as possible in the proceedings, and not for the first time during the skeleton arguments at which point the opponent had no opportunity to file evidence to respond on the same. This challenge, in my view, goes beyond a challenge to the sufficiency of the evidence as such. However, for reasons that will become clear, I do not find that refusing to consider these submissions will change the outcome of these proceedings, and as such I have opted to consider these below.

-- there has been a merger, as you can see at paragraph 5. They were all merged into a single club in August 2020. The Applicant tries and prays that in aid but they missed the point here because if you turn over to paragraph 7, "I confirm the use of the term CAMBRIDGE (unclear), as well as historic use, has always been with the consent of the university". So it is not the boat clubs which own goodwill or reputation, it is the Opponent so you do not need to suddenly think "oh well, the reputation, goodwill starts in 20". It does not because they are licensees and not licensors."

173. It is my view that the opponent will be the owner of the goodwill generated by the activities clearly undertaken by the University of Cambridge. As far as I am aware, they are one in the same and I have not been provided with any arguments or evidence to the contrary. Those activities include, from the evidence provided, the provision of a rowing training programme, for which the Boat Race provides additional publicity, as well as the provision of the sporting and recreational facilities and various sports clubs and training services outlined, all of which are set out across the opponent's annual sports report and sports guide provided at Exhibits AW3-AW4. I see no reason to consider that any goodwill generated by services, including the provision of rowing training and coaching would not (at least jointly) be attributed to and owned by the university/the opponent itself.

174. Whilst I note the existence of various university boat clubs over the years, including the existence of the Cambridge University Boat Club since 1829 as set out in Ms Ward's statement, it appears that, not only are these owned and/or authorised by the opponent, but their connection with the opponent by way of their reference to the university is made clear to the public. I note again at this stage, Mr Bickford-Smith's own submission that "[…] any member of the public using the Ely Boathouse will know that this belongs to the University of Cambridge" for example, with the Ely Boathouse being shown in the evidence as one of the Boathouses of Cambridge University Boat Club. Even if it is the case that the boat clubs themselves have generated a level of goodwill separate to that owned by the opponent, this does not negate my finding that there will be goodwill owned by the opponent in respect of its business under the sign CAMBRIDGE to the extent set out. I therefore move on to consider misrepresentation.

Misrepresentation

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

> "There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341* at page 407 the question on the issue of deception or confusion is
>
> > "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]"
> >
> > The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."
>
> And later in the same judgment:
>
> > ".... for my part, I think that references, in this context, to "more than *de minimis* " and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

176. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lord Justice Lloyd commented on the paragraph above as follows:

> "64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the "substantial number" of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small."

177. Accordingly, once it has been established that the party relying on the existence of an earlier right under section 5(4)(a) had sufficient goodwill at the relevant date to found a passing-off claim, the likelihood that only a relatively small number of persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

178. I therefore go on to consider whether there will be a misrepresentation in this instance. I note that, where all factors are equal, despite the grounds following different legal tests, a finding under section 5(4)(a) of the Act will often follow that under section 5(2)(b).[24] I keep in mind however, that firstly, the services for which goodwill has been found under this sign are in some ways narrower than those for which I have based my findings on a likelihood of confusion, but also that the requirement for similarity of goods and services in the strict sense applicable under section 5(2)(b) does not apply under this ground, although differences in the fields of activity remains a relevant factor. In *Harrods Limited* v *Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

> "There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression "common field of

[24] *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41

activity” was coined by Wynn-Parry J. in McCulloch v. May (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd. (1898) 15 R.P.C. 105 (cameras and bicycles); Walter v. Ashton [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the Advocaat case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the Lego case Falconer J. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

> ‘…whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the Lego case Falconer J. likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be

confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In Stringfellow v. McCain Foods (G.B.) Ltd. [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

> ‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.’

In the same case Stephenson L.J. said at page 547:

> ‘…in a case such as the present the burden of satisfying Lord Diplock's requirements in the Advocaat case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged “passer off” seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the Advocaat case, be substantial.’”

179. I consider also the case of *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] RPC 39 (HOL), in which Lord Simonds stated that:

> "Confusion innocently caused will yet be restrained. But, if the intention to deceive is found, it will be readily inferred that deception will result. Who knows better than the trader the mysteries of his trade."

180. I note at this stage that, whilst I have found earlier in this decision that the applicant appeared to have a subjective intention to gain an advantage from the reputation of the opponent, I do not consider the evidence sufficient to show that its intention was to actually deceive the public as to the origin of the services.

181. I consider the strength of the goodwill held under the opponent's sign, in particular for sports related services involving rowing, as well as the similarity of the sign and contested mark, in addition to the rowing related aspects of the contested mark itself. Keeping in mind the closeness in the fields of activity in respect of all of the sports related services, it is my view that there will be misrepresentation based on this earlier sign at least in respect of the following services:

> **Class 41:** *Sports activities; Sport camps; Sporting services; Sporting activities; Instruction in sports; Sports entertainment services; Training in sports; Sports coaching services; Sports and fitness; Organising of sporting events, competitions and sporting tournaments; Operation of sports facilities.*

182. Next, I consider the position in respect of the additional services covered by the application in class 41, those being *corporate hospitality (entertainment)* and *hospitality services (entertainment).* These are not on the surface in a highly similar field of activity to those services for which the opponent has shown goodwill under its mark. However, I consider that these types of services may offer a "rowing experience" amongst other things to the consumer, and it is clear from the evidence and the applicant's submissions that what it is offering is indeed a "commercial rowing experience". I consider that the applicant's mark itself under which these services will be offered is also heavily rowing themed. I also consider the fact that the evidence provided by the opponent shows it has a strong association with rowing, and the sign is used and holds a significant level of goodwill in respect of services in the field of rowing. I note further, the evidence provided establishes that the opponent's Ely

Boathouse has been available to the public for event hire and rowing camps since it was opened in 2016, and that pages detailing the availability of the venue for event hire between 2018 – 2021 are provided and reservations for events are provided between 2018 – 2019. It is my view that the provision of hospitality and corporate hospitality services in the field of rowing not only therefore appear to be a somewhat natural extension to the opponent's own business under the sign, but one that is already being undertaken by the same. With all this in mind, I find there would be a misrepresentation in respect of these services.

183. Next, I consider the position in respect of the applicant's class 25 goods, which are all essentially sports clothing. I note again that these services are not necessarily in the same field as those for which the opponent has shown goodwill under its sign, however, I do also note that both the opponent's sports services and the applicant's goods are both sports related. I consider the opponent holds a significant level of goodwill in respect of services related to rowing and is already offering a limited range of these goods. Whilst I note this differs slightly from the conclusion reached under section 5(2)(b) (which was reached on the basis that the goods were technically considered dissimilar in accordance with the factors set out in *Treat*), considering all of the relevant factors here, I find it likely there would be a misrepresentation amongst a substantial number of relevant consumers that sports clothing offered under the contested mark are associated with the opponent's business under its earlier sign.

184. Finally, I consider the applicant's class 35 services. I note that these comprise a number of services primarily related to promotion and merchandising, and I remind myself again at this stage that the protection offered by a registration for these services relates to the offering of the same to others. It does not, in my view, provide protection for offering merchandise under the mark, related to or for the promotion of one's own brand. I note these therefore are, in my view, much further removed from the opponent's field of business than both the sports clothing and the hospitality services covered by the applicant. I note the case law sets out it is not a requirement for the field of business to be shared, but that it remains a relevant factor. I consider again all of the elements of this case previously set out. I also note the slightly unusual set of circumstances here, in that there are elements of the applicant's mark that tie it to the services for which the opponent holds significant goodwill, those being services

relating to rowing. This will in my view, undoubtedly mean the opponent is brought to mind through the use of this mark even in relation to these services. However, given the disparity of the services in this instance, and the lack of an intention to actually deceive the public as such, I do not consider that the heavy burden to show that actual misrepresentation and/or subsequent damage in respect of these services will occur has been met. I therefore consider them no further under this ground.

Damage

185. In *Harrods Limited v Harrodian School Limited*, Millett L.J. described the requirements for damage in passing off cases like this:

> "In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the Lego case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.

186. In this case, it is my view that there exists a likelihood of damage by way of substitution in respect of the majority of the services in class 41, as well as an obvious risk of damage should the opponent's customers be dissatisfied with goods purchased from the proprietor, under the mistaken belief that they derive from the opponent in respect of all of the class 25 and class 41 goods and services.

187. The opponent has been successful under section 5(4)(a) of the Act in respect of all goods and services filed in class 25 and 41. This ground has failed in respect of the contested services in class 35.

Final Remarks

188. Whilst the opponent has only been partially successful based on section 5(2)(b) and 5(4)(a), it has succeeded entirely based on section 5(3) of the Act. Subject to any successful appeal, the application will therefore be refused registration in respect of all of the goods and services filed.

COSTS

189. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £2400 as a contribution towards the cost of the proceedings, in accordance with Tribunal Practice Notice 2/2016. The sum is calculated as follows:

Official fee:	£200
Preparing and filing the TM7 and consider the TM8:	£500
Preparing and filing the evidence:	£800
Preparing for and attending the hearing:	£900
Total:	£2400

190. I therefore order Cambridge Rowing Ltd to pay The Chancellor, Masters and Scholars of the University of Cambridge the sum of £2400. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 3rd day of February 2026

R. Le Breton

For the Registrar