

BLO/0599/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3785341

BY

SHARON WILLIAMS

TO REGISTER THE TRADE MARK

The Good School

IN CLASS 16

AND

THE OPPOSITION THERETO UNDER NO 436855

BY

RALPH MATTHEW PALMER BARON LUCAS OF CRUDWELL

BACKGROUND AND PLEADINGS

1. On 7 May 2022, Sharon Williams (“the applicant”) applied to register the above trade mark in class 16,¹ for the following goods:²

Educational equipment; Educational books.

2. The application was published on 15 July 2022, following which Ralph Matthew Palmer Baron Lucas of Crudwell (“the opponent”) filed a notice of opposition against the application. I will return to the matter of which goods are opposed as a preliminary issue.

3. The opponent bases its case on sections 3(1)(b), 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).

4. Section 3(1)(b) is an absolute ground which does not require the opponent to rely on another mark. The opponent’s claim is that the application, The Good School, is not distinctive of the goods for educational equipment and educational books.

5. Under section 3(1)(b) the opponent submits:

“Unadorned marks which are purely informational, or generic, or promote the benefits of a product or service category in a general sense are unlikely to be capable of distinguishing one particular product or service from another...”

6. Section 5(2)(b) requires the applicant’s mark, The Good School, to be similar to an earlier trade mark and to seek registration for goods or services identical with or similar to those for which the earlier trade mark is protected – resulting in a likelihood of confusion.

¹ The application was made in classes 16 and 41. Class 41 was refused following an ex-parte hearing on 30 June 2022.

² International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

7. Section 5(3) requires the applicant's mark, The Good School, to damage the opponent's earlier mark which has a reputation (which must be shown in evidence), as a result of the link made between the two marks in the mind of the relevant public.

8. The mark relied on by the opponent for the claims under sections 5(2)(b) and 5(3) is as follows:³

Mark details:	Goods relied on:
<p>UKTM: 2165317</p> <p>THE GOOD SCHOOLS GUIDE</p> <p>Filed: 30 April 1998</p> <p>Registered: 9 July 1999</p>	<p>Class 16</p> <p>Printed matter, books newspapers, magazine articles all providing advice and information relating to education and schools.</p> <p>Class 41 (5(3) ground only)</p> <p>Advice and information relating to schools and education.</p>

9. With regard to the claim under section 5(2)(b), the opponent outlines the history of its own brand and concludes:

“...The Applicant intends to brand unspecified ‘educational books’ and other unspecified educational materials with ‘The Good School’ in any script or format which copies the first two and reproduces the third word in the singular of the four words constituting the Opponent's mark. The virtually identical composition of the first three words risks leading to both aural and visual confusion as to origin in both physical media and in electronic media promoting the product of the Applicant...Moreover, those three words can be amplified with the addition of ‘s’ and additional wording, such as - eg

³ The mark was considered inherently non-distinctive but proceeded to registration following consideration of evidence showing acquired distinctiveness.

‘report ... on ..’ or ‘experience ... of ...’ which will increase the risk of confusion by suggesting a titular association with the long established business authorised by the Opponent.”

10. Under Section 5(3) the opponent relies on classes 16 and 41 of its earlier mark and submits:

“The mark applied for is for the words "The Good School" simpliciter in any style or format. There is no prefatory auditory distinction or visual distinction between the Applicant's mark and the Opponent's registered mark to reduce the risk of confusion by the public or to dissociate the Applicant's mark from the Opponent's registered trade mark and the Applicant's mark simply squats on the first three component words of Opponent's registered mark - which itself has acquired distinctiveness in its entirety arising from its massive reputation and goodwill within the UK...”

11. The applicant filed a counterstatement in which she denied all the grounds of opposition. I also note that proof of use of the opponent’s earlier mark was not requested.

12. The opponent filed evidence and a skeleton argument. The applicant filed submissions during her evidence rounds and further submissions in advance of the hearing. At that hearing the opponent was represented by John Rubenstein of Inforight Limited. The applicant represented herself.

13. I make this decision having taken full account of all the papers before me and the submissions made at the hearing.

14. 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.

Preliminary issue

The opposed application

15. The applicant's mark which is the subject of this opposition and the mark I must consider is an application for the plain words 'The Good School' (shown on the cover page of this decision) and not a mark with additional figurative elements, such as hearts. Ms Williams refers to the figurative elements of her mark in her skeleton argument and made the same representations to me at the hearing. It is clear that the applicant has another trade mark which does include those features, but that is not the mark opposed in this case. I clarified this with Ms Williams at the hearing.

The opponent's pleadings under 5(2)(b)

16. In its notice of opposition, the opponent was asked which of the goods in the application it considers to be identical or similar to its earlier mark.⁴ It ticked 'Some goods and services' and specified 'Educational books' in the free text box below. This would indicate that the full extent of the opposition is educational books only and does not extend to the term 'educational equipment' which is also contained in class 16 of the application.

17. However, in the following section the opponent is asked to supply further information about '*why you consider there is a likelihood of confusion and for example why you consider the respective marks or goods and/or services to be similar.*' In that section the opponent wrote (my underlining added):

"The Applicant intends to brand unspecified 'educational books' and other unspecified educational materials with 'The Good School' in any script or format which copies the first two and reproduces the third word in the singular of the four words constituting the Opponent's mark. The virtually identical composition of the first three words risks leading to both aural and visual confusion as to origin in both physical media and in electronic media promoting the product of the Applicant."

⁴ See question 4 of the 5(2)(b) section of the amended form TM7 filed 12 October 2022.

18. This indicates that the opponent intended to oppose both ‘educational books’ and ‘educational equipment’ in the contested application.

19. I will begin by considering the opponent’s case under the 3(1)(b) ground and will then consider its case under the 5(3) ground, in which the opponent relies on its reputation. I will return to the 5(2)(b) ground, and the necessary clarification of the scope of the opposition under that ground, if it proves necessary to do so.

DECISION

The opposition under section 3(1)(b)

20. Section 3(1) of the Act is as follows:

“3. - (1) The following shall not be registered –

(a) ...

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

(c) ...

(d) ...

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

21. The principles to be applied under article 7(1)(b) of the Community Trade Mark Regulation (now article 7(1)(b) of the EUTM Regulation, which is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the Court of Justice of the European Union (CJEU) in *Office for*

Harmonisation in the Internal Market (OHIM) v BORCO-Marken-Import Matthiesen GmbH & Co KG (C-265/09 P) as follows:

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

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

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

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

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the

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

22. The opponent's pleading under this ground does not go beyond a general statement that generic marks are not capable of being distinctive trade marks. The case is elaborated on in the skeleton argument filed in advance of the hearing. This was somewhat late in the day to flesh out the details of the case relied upon by the opponent. However, 3(1)(b) is freestanding and was raised at the outset, so the applicant was aware of the matter at issue. I will consider it briefly.

23. The goods for which the mark is applied are educational equipment and educational books in class 16. The relevant public from whose perspective the opposition under this ground must be assessed is, in this case, a member of the general public engaged in education and, in addition, educators and those responsible for home schooling. The mark 'The Good School' is allusive, it is not clear if it applies to a specific place or organisation. Furthermore, the mark is applied for in respect of educational resources, rather than an institution itself or the services it would provide. The definite article at the beginning of the mark helps to drive consumer perception that the mark indicates a single origin for the goods. In my view, these factors are sufficient to result in a mark that is distinctive enough to pass the threshold test for registration.

24. The opposition under section 3(1)(b) fails against the application 'The Good School'.

The opposition under section 5(3)

25. Ms Williams states in her skeleton argument that:

“...for the benefit of all parties, I think this matter has already been addressed. A review of Class 16 was given and allowed.”

26. This is a reference to an earlier ex-parte hearing held in respect of ‘The Good School’ application which is the contested mark in this opposition. That hearing dealt only with whether the trade mark was registerable under section 3 of the Act. The ex-parte hearing officer allowed the mark to proceed to registration for class 16 goods. A section 3 ground has been raised in this case by the opponent and I have agreed with the ex-parte examiner that the application is, under the provisions of section 3(1)(b) of the Act, distinctive for the goods in class 16.

27. I now move to consider the ground raised under section 5(3), which I have outlined above, and which has not been dealt with previously. An opposition under section 5 is made on the basis of someone else’s earlier mark. In this case the opponent’s mark, ‘The Good Schools Guide’.

28. Section 5(3) of the Act reads:

“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”.

29. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

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

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

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

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

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

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

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

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

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

30. In *General Motors*,⁵ the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the

⁵ Case C-375/97

market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

31. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.

The opponent's evidence of reputation

32. The opponent's evidence is provided by the opponent himself, namely Ralph Matthew Palmer, Baron Lucas of Crudwell. His witness statement is dated 22 March 2023. He says of The Good Schools Guide:

"2. The Good Schools Guide was founded in 1986 by my late wife, Amanda Atha and the book was initially published by Ebury Press, then by Macmillans, and since 1998 by LPL [Lucas Publications Limited]. The Guide was novel as it depended to a very great extent on the input of parents who had experienced schools' interactions with their children, and the gathering of those parents' information by a team of empathetic reviewers who themselves would take on a number of schools to review and to visit, in order to sound them out and to research their actual performances as against what the schools would themselves say in their own promotional literature and publicity."

33. Lucas Publications Limited (LPL) has been the registered licensee of The Good Schools Guide, since 27 June 2002.⁶ Titles published by LPL since 1998 (the 5th edition of The Good Schools Guide) are as follows:⁷

⁶ Baron Palmer has been the majority shareholder in LPL since 2000 and is the publisher of The Good Schools Guide.

⁷ See exhibit RMP2, page 69.

Title:	Publication date range:	Total copies sold:
11+ English – A parents’ toolkit Countertop 11+ English	Apr 2002	7,925
Boarding Schools 1st-4 th Editions	Mar 2016 – May 2022	6,089
Good Schools Guide Bookmark	Mar 2018	211
Good Schools Guide 5 th -22 nd Editions	Apr 1998 – May 2019	83,583
Good Schools Guide London North 1 st – 7 th Editions	Nov 2014-Apr 2021	5,853
Good Schools Guide London South 1 st – 7 th Editions	Nov 2014 – Apr 2021	5,135
Of Neighing Coursers and of Trumpets Shrill: A Life of	Jun 2013	103
A Parent’s Guide to Primary School	Oct 2005	1936
SEN/GSG 2 nd Edition	Feb 2007	2506
Good Schools Guide: Special Educational Needs	Apr 2006 – Jan 2008	11,205
Uni in the USA 2 nd – 7 th Editions	Jan 2012 – Sep 2019	3,417
Uni in the USA: UK guide to US universities	Jan 2005	4,142

34. The opponent draws my attention to the following:

- No school can buy editorial in The Good Schools Guide. A school not featured in the guide cannot advertise in it.
- Many schools want to be featured in the guide but, ‘have not made the cut’. If standards drop, a school will be removed from The Good Schools Guide.
- The guide reviews and features independent and state schools and caters for parents whose children have special educational needs.

- The guide is published and is also available online at www.goodschoolsguide.co.uk

35. Turnover figures for LPL publication of The Good Schools Guide ‘in all media’ are as follows:⁸

Year	Turnover (GBP)⁹
2012	364,453
2013	531,176
2014	617,325
2015	794,515
2016	962,166
2017	1,090,315
2018	1,188,278
2019	1,244,836
2020	1,424,965
2021	1,285,696
2022	1,608,219
2023	1,687,394

36. Subscription sales data has been provided for 7 May 2021 – 6 May 2022. Subscriptions range from one month to a full year and total 8039 at a value of £179,924.40.¹⁰

37. The opponent provides a list of press cuttings that mention The Good Schools Guide.¹¹ The cuttings have not been provided, but the list runs to 12 pages and refers to articles dated between 23 December 2015 and 17 December 2022. The articles feature in national newspapers including, inter alia, The Daily Mail, The Daily Telegraph, The Financial Times, The Guardian, The Independent, The Mail on Sunday, The Sunday Times and The Times.

⁸ See exhibit RMP2, page 2.

⁹ I confirmed with Mr Rubenstein at the hearing that the figures are in GBP, as the exhibit is silent on that point.

¹⁰ See exhibit RMP2, page 68.

¹¹ See exhibit RMP2, pages 3-15.

38. Articles also appear in magazines, including Country Life Harpers Bazaar, Spectator, and The Australian as well as on BBC News, Good Morning Britain, This Morning and the Today programme and Woman's Hour on Radio 4. Some of the articles include the Good Schools Guide in the title, for example:

- 6/02/2016 – BBC News Online, “Good Schools Guide editor: Better state schools put private sector at risk”.
- 18/02/2016 – Harpers Bazaar, “Good Schools Guide 30th Anniversary”.
- 22/02/2016 – Country Life, “Good Schools Guide 30th Anniversary”.
- 24/08/2017 – Telegraph, “Prince George’s new school ‘busy, slightly chaotic’, according to Good Schools Guide”.
- 20/09/2017 – Telegraph, “Goods Schools Guide to examine how ‘transgender friendly’ schools are”.
- 22/03/2018 – FE News, “The Good Schools Guide set to co-host launch of 2018 Apprenticeships Anthology.”
- 17/10/2018 – Daily Mail, “...applications set to soar by 24,000 for 2019, Good Schools Guide warns”.
- 1/09/2019 – Angels & Urchins, “Expert advice...from the Good Schools Guide”
- 01/04/2021 – The Times, “Private schools must take responsibility for boys behaviour outside, says Good Schools Guide head.”

39. Sample press cuttings are provided for 1998 and include:¹²

- Harpers & Queen (October 1998) - “Twelve of the best – In an extract from the new edition of The Good Schools Guide by Amanda Atha, we choose some of the most impressive senior schools in this country.”
- The Express (8 October 1998) – “The Good Schools Guide, what the prospectus doesn’t tell you, eight page special pullout.”
- The Express (9 October 1998) – “How to choose the best school for your child – today more exclusive extracts from The Good Schools Guide.”

¹² See exhibit RMP2, pages 16-19.

- The Times Educational Supplement – “The good, the bad and the ghastly - The sixth edition of The Good Schools Guide is out. Bidy Passmore looks at the irreverent guide for parents by parents.”¹³

40. The opponent provides a list of schools taking subscriptions of The Good Schools Guide, between May 2021 and April 2022. There are 425 schools listed, including private and state schools.¹⁴ He also provides evidence of twenty-five references to The Good Schools Guide in Hansard (the edited verbatim record of both houses of parliament).¹⁵ These references are for the most part, Baron Lucas declaring his interest in the publication prior to contributing to debates on a range of educational bills.

41. The following table shows the number of licences granted for The Good Schools Guide, from 2010 to 2022:¹⁶

Year:	Number of licences:
2010	11
2011	59
2012	87
2013	143
2014	179
2015	215
2016	245
2017	281
2018	317
2019	337
2020	362
2021	363
2022	419

¹³ Date of publication not visible.

¹⁴ See exhibit RMP2, pages 30-59.

¹⁵ See exhibit RMP2, pages 19-29.

¹⁶ See exhibit RMP2, page 61.

42. The following figures are taken from Google Analytics, for The Good Schools Guide website:¹⁷

Year:	New users:	Page views:
2017	1,600,454	5,058,107
2018	1,604,354	6,051,462
2019	2,649,057	7,683,687
2020	3,675,586	8,912,103
2021	3,150,906	8,329,595
2022 (to 6 May)	1,051,234	2,733,866

43. The number of writers working on each edition of The Good Schools Guide ranges from 26 in 2017 to 45 in 2022.¹⁸

44. The Good Schools Guide has an advisory service that had 400–600 clients per year between 2017 and 2022. At the time of writing his witness statement, Baron Lucas submits that the service had been running for 15 years.¹⁹

45. A list of advertisers for the 2021 edition include 82 schools and four non-schools, namely, Harper Collins (Letts), Learn & Co., What Career Live and Westminster Tutors.²⁰

46. Before drawing my conclusion in respect of the opponent’s reputation, I must address a point raised frequently by the applicant, Ms Williams.

47. Understandably, for one not familiar with trade mark law, Ms Williams’ submissions indicate that her understanding of the reputation in the earlier mark means the ethical or moral nature of the opponent’s business. Throughout her submissions to me, the

¹⁷ See exhibit RMP2, page 62.

¹⁸ Senior writers for those years are given as 5 and 8, respectively, though it is not clear if these are included within the larger number, or in addition to that number.

¹⁹ See exhibit RMP2, page 64.

²⁰ See exhibit RMP2, page 67.

applicant has made reference to the opponent's personal reputation and the fact that, in her view, his charity is not one that 'does good'.

48. Reputation for the purposes of this section of the Act is an assessment, which I must make (based on the evidence provided), of the level of knowledge of the earlier The Good Schools Guide trade mark among a significant part of the relevant public.

49. The conditions of section 5(3) are cumulative. Firstly, the application must be similar to the earlier mark. Secondly, the opponent must satisfy me that its earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must establish that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark(s) being brought to mind by the later mark. Fourthly, assuming that the first, second and third conditions have been met, section 5(3) requires that one or more of three types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods or services be similar although the relative distance between them is one of the factors that must be assessed in deciding whether the public will make a link between the marks.

50. Ms Williams does appear to accept the opponent's reputation in the field of providing a guide which rates schools. For example, she submits in her skeleton argument:

"TGSG reputation is well known, ie that it "rates" some "schools", but is not known for inclusion/representation. So, not our/a "good" in community."

51. The opponent is clearly well-established as a provider of a guide for schools and offers help and advice to parents selecting a school for their child. It has had considerable coverage in the press and magazines, including its own eight-page supplement in a national newspaper and is a well-known measure of school excellence in the education sector. So much so that when schools are selected for the children of royals, The Good Schools Guide findings are reported on and debated in

the national press.²¹ It also provides comment in the national press about educational issues, for example, the behaviour of pupils outside school premises. The Good Schools Guide has a turnover in the UK in excess of £1 million from 2017 until the relevant date and is available online and in hard copy, being published annually. The applicant has not challenged the opponent's reputation in its claimed field of business, rather, she seeks to highlight the different business models that the parties embody.

52. I find that the earlier mark has a strong reputation in the UK, which rests in its guides to educational establishments (being a sub-set of the class 16 goods relied upon) and its provision of advice and information relating to schools and education. This was the case at the relevant date and has not been disputed by the applicant.

Link

53. In addition to the earlier mark having a reputation, a link must be made between the mark applied for and the earlier mark. In *Intel Corporation Inc v CPM (UK) Ltd*²² ("*Intel*") the CJEU provided guidance on the factors to consider when assessing whether a link has been established. It stated:

"41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case..."

54. Those factors include:

The degree of similarity between the conflicting marks

55. In *Intra-Press SAS v OHIM*,²³ the CJEU stated that:

"72...The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the

²¹ See RMP2, page 6.

²² C-252-07.

²³ Joined cases C-581/13P & C-582/13P.

implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

56. In other words, the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion.

57. The similarity of marks under sections 5(2) and 5(3) of the Act is assessed in the same way.²⁴

58. The application is for the term ‘The Good School’. The opponent relies on an earlier mark, which is the plain words, ‘The Good Schools Guide’.

59. Submissions from the applicant regarding the similarity of the marks are either based on the incorrect trade mark, which contains figurative elements and is not the relevant mark in this case, or relate to the ethics and/or purpose of the parties respective charities. Neither of these is relevant to the matter to be decided. I must assess the application as it stands on the register, namely, the plain words, ‘The Good School’ for the goods for which registration has been sought. The opponent’s mark is

²⁴ See the principles established 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.

assessed as it stands on the register, in the context of the extent of that mark's reputation and the goods and services to which that reputation relates.

60. The opponent's submissions in terms of the similarity between the respective marks are as follows:

"1.5. ...the Opponent in any event asserts that the Sign as a whole at best can only embody a low level of distinctiveness. The Sign as a whole consists of three normal words in any script and is identical to the first three words of the Registered Mark bar the omission of the letter "s" at the end of the third word of the Registered Mark. It is submitted that the only word which has any significant independent meaning in relation to books as a whole can be "School", that the Sign only properly consists of two words – "good school" with the third word "the" not even meriting the use intended by the Applicant in the Sign being gleaned from her Counterstatement as being somehow subsidiary; eg:

'... The GOOD SCHOOL'... and '... Our GOOD SCHOOL is definitive and or itself ...'

61. The first two words in both marks are the same, namely, 'The Good'. The third mark in each differs only in the plural, being 'School' in the application and 'Schools' in the earlier mark. The primary difference is the inclusion of 'Guide' as the fourth word in the earlier mark. Visually, I find the marks similar to a fairly high degree.

62. Aurally the marks are three and four syllables in length respectively, THE-GOOD-SCHOOL and THE-GOOD-SCHOOLS-GUIDE, with the first two syllables being the same, the third being almost identical and a fourth in the earlier mark that is not present in the application. I find aural similarity to be at a fairly high level.

63. Conceptually both marks contain 'good school' elements. In the application the addition of the definite article indicates one institution, which is, 'The' good school. The earlier mark will be seen as either, a guide to goods schools, or a guide provided by 'the good school'. I have taken account of the fact that the second of these would

require an apostrophe in the word 'school's', but in my experience, it is not uncommon to find punctuation omitted from trade marks. The common 'good school/s' message leads me to find the marks conceptually similar to a medium degree.

The strength of the earlier mark's reputation

64. For the reasons I have already given, the opponent's mark had a strong reputation at the relevant date.

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

65. In determining the distinctive character of a trade mark it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been used as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.²⁵

66. The inherent distinctiveness of the earlier mark is low, being a description of the goods, which consist primarily of a guide to good schools. However, the earlier mark attained registration following proof of acquired distinctiveness, by the time it was registered on 9 July 1999.

67. Since then, it is clear that the opponent has continued to make extensive use of its mark and it is now the definitive guide to schools in the UK, being regularly cited in the educational press such as The Times Educational Supplement and more broadly in national newspapers and magazines. The opponent has enhanced the distinctiveness of its earlier mark to higher degree by the use made of its mark, such that the opponent's THE GOOD SCHOOLS GUIDE mark is distinctive of the opponent.

²⁵ Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

The nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

68. In the current case, I have found the opponent to have a strong reputation for printed matter that provides advice and information relating to education and schools and for the broader service of providing advice and information relating to schools and education. The applicant has applied for the following in class 16:

‘Educational equipment; Educational books’

69. With regard to the assessment of similarity between the respective goods and services, I bear in mind *Gérard Meric v OHIM*,²⁶ in which the General Court (GC) stated that:

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

70. Also the decision in *Canon*, where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

²⁶ Case T-133/05.

71. Guidance on this issue has also come from Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the Treat case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

72. 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 OHIM*, Case T-325/06, the General Court stated that “complementary” means:

“...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”.

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

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

Whilst on the other hand:

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

74. I bear in mind that the goods must be given their ordinary and natural meanings. In *YouView Ltd v Total Ltd*,²⁷ Floyd J stated:

“...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. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their

²⁷ [2012] EWHC 3158 (Ch) at [12].

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”.

75. The opponent submits that the applicant seeks to register the contested mark in relation to identical goods to its own ‘printed matter, books...all relating to education’ and relies on the decision in *Meric*. The opponent further submits:

“Educational equipment which are teaching and information dissemination aids and insofar as they do not consist of printed matter are utilised entirely alongside and ancillary to (and therefore are complementary to) the use of educational books and the process of educating and informing people and in consideration of the Applicant’s indicative specification, to operate in tandem with printed matter in the process of education.”

76. The opponent’s reputation relates to guides that provide advice and information relating to standards of education and schools; they are available in book form and in that sense they are, in themselves, educational books in their particular field. The applicant’s educational books may include books that relate to standards of education and to that extent, are identical in accordance with *Meric*.

77. The applicant’s educational equipment is not defined and was not expanded upon at the hearing. It must include goods that are proper to class 16, which will be printed and stationery goods. There is likely to be some cross-over with the opponent’s printed matter, which provides information relating to education and schools. For the remaining goods, the users are likely to be the same, namely those seeking education for themselves or others. The uses will be at least similar as all of the goods are printed goods in class 16. The natures are likewise similar. There is likely to be an overlap in trade channels and the goods may be displayed in close proximity and they are likely to have a complementary relationship. I find the goods similar to at least a medium degree.

78. Given the strength of the opponent's reputation and the enhanced distinctiveness of its mark, I find that the applicant's mark 'The Good School', for similar goods will result in a link being made between it and the opponent. I find additional support for this finding in the applicant's submissions concerning the nature of her business that indicate it is highly likely that her books and printed materials would fall into the category of advice and support for people who have not had good experiences with traditional education.

Damage

79. Section 5(3) of the Act identifies three types of injury or damage, namely, taking unfair advantage of the earlier mark (the so called 'riding on the coat tails' argument where the applicant benefits from the reputation in the other side's mark), causing detriment to the distinctive character of the earlier mark (in other words, diluting the earlier mark's ability to operate as a trade mark) or damaging the repute of the earlier trade mark (also known as tarnishing).

80. The opponent referred to unfair advantage in its statement of grounds:

"On the basis of the Applicant's submissions the Applicant's business is about offering educational support to the public as a business. The Applicant in her letter of 27th August 2022, without restricting the ambit of goods to be offered, or to qualify the mark applied for with a visual and aurally distinguishing aspect to remove or reduce the possibility of confusion by association in the minds of the public has stated that 'We seek to be able to help people, from any background, age culture or religion, who have in the past done something bad and now want to change/repay a debt, ie learning/relearning about good'.

The Applicant will most likely be advertising and promoting the Applicant's business and its proposed branded goods on the internet. The Applicant's service driver of the proposed production of the goods for which the Applicant applies to register the mark would overlap materially with the Opponent's electronic products, subscription services and consultancy

services being offered online with the authority of the Opponent in The Good Schools Guide Class 41 specified services, and in respect of which such social educational issues as special educational needs, delinquency, bullying and discipline are subjects of services which the Opponent's authorised business offers to the public.”

81. And in its skeleton argument, in which the opponent submits:

“2.12...The risk spelled out by the Opponent at Paras 20-21 of his first witness statement (uncontroverted) and the possibility that competitors will be keen to purchase a Sign which has registered status consisting of the words “the good school” as a prefix is both serious and significant, not only in diluting and reducing the ability of the Registered Mark to distinguish the Opponent’s goods and services in the future from those of other traders (including the Applicant hereafter) in Class 16 educational books and ancillary materials and printed matter, and Class 41 educational services and to enable competitors of whom there are several to ride on the coattails of the Opponent’s reputation in the Registered Mark.”

2.13 That would have a serious and unmerited commercial value to the Applicant who could in turn ride on the coattails of the distinctive character and repute vested in the Registered Mark.”

82. In *L’Oréal*,²⁸ the CJEU said:

“The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation 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

²⁸ *L’Oréal SA & Ors v Bellure & Ors* - Case C-487/07, paragraph 50.

marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image.”

83. It is clear from the decision of Arnold J. (as he then was) in *Jack Wills v House of Fraser (Stores) Limited*,²⁹ that the claim to unfair advantage does not require proof of subjective intention on the part of the applicant. Paragraph 80 of that decision reads:

“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.”

84. I agree with the opponent that the success of the earlier mark and its strong reputation for providing advice and information in the education sector will make it easier for the attraction of the earlier mark to be projected on to the applicant's mark. I find that there is a risk, which is not hypothetical, that use of the contested mark, The Good School, will make it easier for the applicant to offer its educational goods to a section of the relevant public due to the link made between it and the opponent's mark, The Good Schools Guide.

²⁹ [2014] EWHC 110 (Ch)

85. With regard to the remaining heads of damage the opponent's pleadings lack clarity. In its initial pleading the opponent did not complete the section of the statement of grounds concerned with detriment to the repute of the earlier mark but did deal with it in its skeleton argument. As I have already found for the opponent under the first head of damage, I do not consider it necessary to go on to consider the remaining heads of damage pleaded.

86. Having found the 5(3) ground to have succeeded, the only defence left for the applicant is to show that she has due cause to use the mark applied for. The applicant has not made a claim of due cause, but it has been raised by the opponent. I will discuss it briefly.

Due cause

87. In order to succeed in a claim to due cause it is necessary for the applicant to show the nature and extent of its current business under the 'The Good School' sign. It is then a matter for the competent authority to determine whether an act that would otherwise be deemed contrary to section 5(3), can be considered subject to the due cause defence. *Leidseplein Beheer BV v Red Bull*,³⁰ gives the test for such an assessment. However, the starting point must always be the applicant's own business. In this case, the applicant has not filed evidence of its current business and it is therefore not possible for me to determine how its business is known to its customers, nor to what extent, if at all, it has a reputation under the mark, The Good School, in the mind of the relevant public.

88. I would add that even if the applicant had established a business in educational goods under the sign 'The Good School', this does not seem to me to be sufficient to justify the use of it when that sign would, as I have already found, take unfair advantage of the opponent's sufficiently similar mark with a strong reputation.

89. The opponent succeeds under section 5(3) for all of the goods in the application.

³⁰ Case C-65/12

CONCLUSION

90. The opposition has failed under section 3(1)(b) and succeeded under section 5(3) for all of the goods in the application.

The remaining grounds

91. I have considered whether or not to deal with the opponent's claim under section 5(2)(b). The opponent has succeeded in full on the basis of its reputation under 'The Good Schools Guide' mark for goods in class 16 and services in class 41. There is nothing to be gained for the opponent by considering the other ground.

COSTS

92. Ralph Matthew Palmer, Baron Lucas of Crudwell has been successful under the section 5(3) ground and is entitled to a contribution towards costs. I bear in mind that the applicant did not file evidence. At the hearing, I explained the scale of costs applicable to this tribunal and I award costs on the following basis:

Official Fee -	£200
Preparing a statement and considering the other side's statement -	£400
Filing evidence and considering the other side's submissions-	£700
Preparing for and attending a hearing -	£800
Total	£2100

93. I order Sharon Williams to pay Ralph Matthew Palmer, Baron Lucas of Crudwell the sum of £2100. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of June 2024

Al Skilton

For the Registrar,

the Comptroller General