BL O/0619/25

TRADE MARKS ACT 1994

ON APPEAL TO THE APPOINTED PERSON

IN THE MATTER of UK Trade Mark Application No. UK00003651109 for Cambridge Molecular in Class 09 & 42, in the name of Cambridge Molecular Ltd (the "Applicants")

AND IN THE MATTER OF Opposition No. OP000428078 thereto by The Chancellor, Masters and Scholars of the University of Cambridge

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DECISION

INTRODUCTION

1. This is an appeal from the decision of June Ralph, the Hearing Officer, dated 31st July 2023.

2. The Appellant applied on 4th June 2021 to register **CAMBRIDGE MOLECULAR** for various goods and services in Class 9 and 42 ("**the Application"**). The goods and services are for software and services in the field of applied sciences including software in the field of molecular biology, molecular screening, data science services in the field of molecular screening.

3. The Respondent opposed the Application under s.5(2), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("**TMA**"). It relied upon various registered marks but identified two

of these for **CAMBRIDGE** (solus) as being its strongest case. For these marks, the goods and services that it relied upon are set out in Annex 1 of the Decision.

4. The Respondent's grounds of s.5(2), s.5(3) and s.5(4)(a) all succeeded. The Appellant appeals the Decision in respect of all these grounds. The Respondent also served Respondent's Notice in relation to the section 5(3) ground.

STANDARD OF APPEAL

5. The approach I should adopt on this appeal was summarized by Mr. Daniel Alexander KC sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd* [2017] RPC (17) 655 (AP), at [14]-[56] and subsequently approved and applied by Joanna Smith J in *Axogen v Aviv* [2022] EWHC 95 (Ch) as follows:

> "24. Although I was referred to numerous cases on the subject …, the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:
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> i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);
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> ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS* O/039/21 at [14]);
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> iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [81]);
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> iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.
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> v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], REEF at [28] and Fine & Country at [50]-[51]).
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> vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).
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> vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], Actavis Group at

> [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (Shanks at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).
> viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], Fage at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).
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> ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)]).

6. This appeal includes considerations of criticisms of the Hearing Officer's evaluative decisions. I therefore also bear in mind the guidance given by the Supreme Court in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 (albeit I understand this guidance to be consistent with the decision in *Axogen*), where Lords Briggs and Kitchin explained at [49]-[50]:

> "… on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion.
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> On the other hand, it is equally clear that, for the decision to be "wrong" under CPR 52.21(3), it is not enough to show, without more, that the appellate court might have arrived at a different evaluation."

7. Finally, I note that disagreements about the precise "weight" to be given to a factor has been consistently rejected as a proper ground of appeal (see Ian Purvis KC, sitting as the Appointed Person in BL-0-106-20 *GREYBOX).*

GROUNDS OF APPEAL

8. As set out in the Appellant's skeleton there were ten discrete grounds of appeal (the same appear in the Grounds of Appeal but are not numbered as such). Mr.

Wood who appeared for the Appellant focused his oral submissions on Grounds 3, 4 and 7.

Principle Grounds in relation to Section 5(2)(b)

Ground 3 *"Error as to Distinctive Character of the Element Molecular"*

9. Ground 3 attacks the following finding at paragraph 50 of the Decision:

> 50 The applicant's mark is a word mark comprising two words namely **CAMBRIDGE MOLECULAR** with no other aspect to it so again the overall impression is derived solely from the words themselves. However, the applicant's goods and services relate to science so the **MOLECULAR** element of the mark has very weak distinctive character.

10. This finding necessarily underpins the Hearing Officer's decisions under both sections 5(2) and 5(3) TMA.

11. The Appellant criticized the Hearing Officer for lumping all the goods and services together when considering the question of distinctiveness. It submitted that the level of distinctiveness necessarily varies between the different goods and services. And, most importantly, it submits that the distinctiveness was necessary greater than "very weak" in relation to at least some of the goods and services.

12. In broad terms the goods/services for which the Appellant's mark is registered can be divided into four categories: (a) those that are expressly "molecular" related goods/services (e.g. *Computer software in the field of molecular biology*); (b) those which do not directly refer to molecular – but nonetheless have a scientific nexus with molecular (*e.g. Computer software in the field of pharmaceuticals*); (c) those which relate to general computer science (*e.g. Non-downloadable software; Non-downloadable software in the field of data science*).

13. In relation to the first two categories I can find no reason to criticize the Hearing Officer's decision. Nor was this point pushed by the Appellant orally.

14. There is more force in the criticism of the Hearing Officer's finding in relation to the third category. Of these the least associated with science, and most distant from the concept "molecular" (and therefore arguably most distinctive), is "non-

downloadable software".

15. With some hesitation my view is that the Hearing Officer was entitled to make the finding of very weak distinctiveness in relation to this last category of goods/services. Whilst I might have come to a different decision in relation to the single category of "non-downloadable software" simpliciter, it seems to me that her finding nonetheless lay within the reasonable bounds of findings she was entitled to make.

Ground 4 *"Error of Law as to Likelihood of Confusion"*

16. The Appellant asserted that the Hearing Officer had misapplied the law relating to indirect confusion and, in particular, had misapplied the following statement from the decision of Mr. Iain Purvis QC, Sitting as the Appointed Person in *L.A Sugar Ltd v By Back Beat Inc*. Case BL O/375/10: at [16] and [17]:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.
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> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
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> (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).

17. The Hearing Officer cited paragraph 16 (but not 17) of L. A. Sugar and then found as follows:

> 62 The heart of this case is whether consumers seeing the applicant's mark would understand it as being a business undertaking molecular science in Cambridge (the English City) or being a business undertaking molecular science at or in conjunction with Cambridge (the University). The applicant, in the evidence of Guy Lewy, states it is the former and that "it is not unusual for businesses to wish to express their locality through their business and trading names". Mr Lewy also exhibits a list of 3260 active company registrations using the word Cambridge within their legal names. However this is not determinative to the trade mark decision I must make.
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> 63 The opponent for its part has sufficiently demonstrated that it has used the word CAMBRIDGE solus in relation to both educational services and to scientific research including molecular science and that it has enhanced the distinctiveness of these marks with that use. I therefore find there is a likelihood of confusion. I do not find this it is a likelihood of direct confusion as there are sufficient differences between the marks for a consumer not to directly confuse the respective marks but I find there is likelihood of indirect confusion as the addition of the word MOLECULAR could be seen as a natural brand extension for goods and services in that specialist field.

18. In reaching this finding, the Appellant submitted the Hearing Officer erred in broadly four ways. Namely, by failing to:

(a) take proper account of paragraph 17 of L. A. Sugar;

(b) address her mind to the need for an express finding of brand extension. It being asserted that merely finding an enhanced reputation was insufficient on its own;

(c) take proper account of the considerable number of third parties using Cambridge as part of the names of their businesses;

(d) take proper account of her finding that the Appellant's mark did not have a clear conceptual meaning.

19. I reject the submission that the failure of the Hearing Officer to set out paragraph 17 of *L. A. Sugar* is a material error. Paragraph 17 merely exemplifies the principles set out in paragraph 16. Indeed, it does not in any event amount to an exhaustive list of situations in which there might be indirect confusion (e.g. see Arnold LJ in *Liverpool Gin Distillery v Sazera Brands* [2021] EWCA Civ 1207, [10]). The real question it seems to me is whether the Hearing Officer reached a decision which was inconsistent with the principles set out in paragraph 16 or the exemplification in paragraph 17. For the reasons set out below, it is clear that the Hearing Officer did reach a finding that was wholly consistent with paragraph 17 of L.A. Sugar.

20. The Appellant's second criticism focuses on the proposition that the Hearing Officer's finding at paragraph 63:

> CAMBRIDGE solus ….. has enhanced the distinctiveness of these marks with that use. I therefore find there is a likelihood of confusion

is (a) improperly reasoned and (b) does not support the conclusion at the end of paragraph 63 that:

> I find there is likelihood of indirect confusion as the addition of the word MOLECULAR could be seen as a natural brand extension for goods and services in that specialist field

21. The first point to note, as I have dealt with above, is that the Hearing Officer found MOLECULAR to be a very weakly distinctive of the goods and services in question. This puts the matter into a category very similar to that discussed in paragraph 17(b) of L. A. Sugar (see above).

22. Second, whilst the conclusion in paragraph 63 is expressed in very short form, it sits in the context of a much more detailed discussion of the enhanced distinctiveness of the Respondent's Mark and in particular the Respondent's very extensive reputation in relation to the commercialization of scientific and hi-tech research services (see paragraphs 11 – 24 and paragraph 29 of the Decision).

23. In the light of these two factual findings, I can see no error of principle in the Hearing Officer's approach in paragraphs 62 and 63. In my view, the Hearing Officer's finding of indirect confusion was one she was entitled to make (and indeed corresponds with the example given in paragraph 17(b) of *L A Sugar*).

24. The final two criticisms attack the Hearing Officer's evaluative decisions on the evidence.

25. As to the third criticism. The Hearing Officer expressly considered the question of third-party businesses with Cambridge in their name in paragraph 62. Her finding in paragraph 62 is not that the evidence was irrelevant, but that it was not determinative. That is clearly correct. Furthermore, the issue is primarily one of detailed evidence The question is not just whether Cambridge is used in a particular company's name, but also in what context, and in particular in respect of what goods and services that use was made. How much weight to give this strand of evidence was a matter for the Hearing Officer's discretion when weighing the evidence on indirect confusion as a whole. The Appellant's criticism is a bare one. It identifies no specific error in the Hearing Officer's assessment of the evidence. Properly understood it is no more an invitation for me to re-weigh the evidence, a course which the cases make clear I should not take.

26. As to the fourth criticism. The Hearing Officer's finding in relation to conceptual similarity is set out at paragraph 53 of the Decision. This states as follows:

> With regard to the conceptual comparison, the opponent for its part, in its skeleton argument, states that the shared word can mean both the English city and the university, but "to a significant group of people it will mean the university". Whereas the applicant states in its skeleton argument that the shared element **CAMBRIDGE** will be taken as a reference to the city. Clearly the applicant's additional word **MOLECULAR** will be understood by its usual dictionary definition as an adjective relating to molecules. Therefore, the whole mark is slight odd in a purely grammatical sense but is likely to be understood as something to do with molecules and Cambridge, which brings about a somewhat different concept to the earlier marks, albeit that the respective marks share the word **CAMBRIDGE**. Overall, I find there is a medium degree of conceptual similarity.

27. The Appellant's assertion that the Hearing Officer should have taken into greater account that this paragraph is a finding that its mark has no clear conceptual meaning is flawed in two ways. First, it is not in my view a fair summary of the Hearing Officer's finding (as set out above). Second, the Appellant has identified no specific error in regard to either (a) the finding of a medium degree of conceptual similarity or (b) the manner in which the Hearing Officer took that finding into account.

28. For these reasons I reject this ground of appeal.

Remaining Grounds relevant to section 5(2)(b)

29. The Appellant ran two other grounds which were asserted to be (and are) relevant to the section 5(2)(b) opposition. They did not form any material part of its oral submissions, but they were set out, albeit briefly, in its skeleton.

Ground 1: *Comparison of Goods and Services*

30. This argument was limited in scope as it was common ground that there was identicality between all of the class 9, and many of the class 42, goods and services.

31. The Appellant criticized paragraph 42 of the Decision which states as follows:

> Turning to the applicant's remaining services in class 42, I take first the non-downloadable software terms namely *Non-downloadable software; Non-downloadable software in the field of medicinal chemistry; Non downloadable software in the field of molecular biology; Non-downloadable software in the field of pharmaceuticals; Non-downloadable software in the field of molecular screening; Non-downloadable software in the field of machine learning; Non-downloadable software in the field of data science; Non-downloadable software in the field of machine learning for molecular screening or analysis; Non-downloadable software in the field of machine learning for pharmaceuticals.* I find these services to be highly similar to the opponent's *computer software* in class 9 of the '733 mark. The nature of the software is only slightly different in that one is either in physical or downloaded form on a device whereas the other is not able to be downloaded to a device but can be used via another method. The purpose of the software will be the same and there will be

a crossover of users and trading channels.

32. The Appellant submitted that there was no basis for a finding that the services were highly similar. I disagree. In my view the Hearing Officer was, absent of evidence to the contrary, entitled to find that the purpose of the goods is the same whichever method of delivery is used, and that there will be a crossover of users and trading channels.

33. I therefore reject this ground of appeal.

Ground 2: *Error Relating to Complementarity*

34. The Appellant criticized the Hearing Officer's finding of complementarity in paragraph 43 of the Decision which states as follows:

> This leaves the applicant's terms *Providing, hosting, managing, developing and maintaining applications, software, websites and databases in the field of molecular screening or analysis.* In its skeleton argument and at the hearing, the opponent accepted these services were more directly comparable to services within its registrations for **CAMBRIDGE ASSESSMENT** and **CAMBRIDGE MATHEMATICS** rather than its **CAMBRIDGE** solus marks. However the '733 mark has *computer software* and the '445 mark has the term *design and development of computer software,* both are terms which I find overlap to some extent with the applicant's terms. Software itself can be purchased from an undertaking who also provide related services such as updates, patches and fixes. There would be an overlap in user and trade channels. As such I find there is some complementarity leading me to find similarity to a low degree.

35. There was no dispute between the parties that for the purposes of this appeal I, like the Hearing Officer, could consider the complementarity to be as stated by the General Court in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)***,** Case T-325/06, namely that it exists 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".

36. The Appellant criticized the Hearing Officer's finding on the basis that it did not address the test set out in *Boston Scientific* head on (instead merely reciting that there would be an overlap in user and trade channels).

37. There is some force in this criticism, at least so far as it relates to the manner in which the Hearing Officer expressed her finding rather than the substance of that finding.

38. However, the Respondent also submitted, in my view correctly, that even if the Hearing Officer had failed to apply the test of complementarity properly, there was more than sufficient basis more generally for her to find that the goods and services in question were similar to a low degree (and indeed that was what the Hearing Officer had done albeit under the rubric of complementarity). I agree.

39. For these reasons I dismiss this ground.

Conclusion: section 5(2)b

40. Given I have rejected the appeal finding under section 5(2)(b) it is unnecessary to consider the other substantive grounds of appeal.

Ground 10: Costs

41. The Appellant skeleton submitted that the Hearing Officer erred in principle by failing to take into account that the Respondent re-used in part evidence prepared for earlier UKIPO hearings. It suggested that because of this the Respondent would gain a windfall in a costs regime where costs were intended only to be a contribution. This point was not expanded in oral argument.

42. The sums awarded by the Hearing Officer were determined by reference to Annex A of the Tribunal Practice Notice (TPN) 2/2016 (which applied when this action was start). They were as follows:

£200	Official fee
£600	Preparing a statement and considering the counterstatement
£1500	Preparing evidence and considering the applicant's evidence

£1000	Preparing for and attending the hearing
£3300	**Total**

43. The Ground of Appeal criticizes only one aspect of these costs – the £1500 spent on preparing evidence and considering the applicant's evidence. It does so on the basis that the evidence is said to be a rehash of evidence prepared for other cases, namely Cambridge Spark (OP409694) and Cambridge Quantum Computing (OP41098 and 416143).

44. The figure of £1500 lies within a range of sums that the Hearing Officer could have awarded: £500-£2200. It is a matter for the Hearing Officer's discretion where in the range the appropriate award is. Based on the very limited material before me I have no basis on which to find that an award of £1500 was unreasonable. Furthermore, there is no basis for concluding that an award of this sum provided the Respondent with a windfall (i.e. a profit) in relation to its costs of preparing and considering evidence.

45. I therefore reject this ground of appeal.

CONCLUSION

46. For all these reasons I dismiss this Appeal. The Respondent is entitled to a contribution to its costs of this appeal, which I will award in the sum of £1500. In addition, it is entitled now to payment of the costs awarded by the Hearing Office (e.g. £3300). The total sum, i.e. £4800, shall be paid within 28 days of the date of this decision.

GEOFFREY PRITCHARD KC

THE APPOINTED PERSON

30 June 2025