

O/0635/24

TRADE MARKS ACT 1994

TRADE MARK APPLICATION 3874104

BY AMY JONES

AND

OPPOSITION 440894

BY LEARNING RESOURCES, INC.

AND

APPLICATIONS 505895/6 BY AMY JONES

FOR THE REVOCATION AND INVALIDATION

OF TRADE MARK 1569902

IN THE NAME OF LEARNING RESOURCES, INC.

BACKGROUND AND PLEADINGS

1. These proceedings started with an opposition from Learning Resources, Inc. (“LRI”) to an application filed by Amy Jones (“AJ”) on 3rd February 2023 to register the trade mark shown below in relation to a range of educational material and related services in classes 9, 16 and 41.¹



2. LRI is the proprietor of trade marks 1569902 and 903082741. The ‘902 mark consists of the words **LEARNING RESOURCES**. The mark was applied for on 31st October 1994 and registered on 3rd July 1997 in relation to goods in classes 9, 16 and 28.²

3. The ‘741 mark looks like this:



It is based on an application for an EU trade mark filed on 4th March 2003 and registered as such on 15th November 2004 in relation to goods in the same classes as the ‘902 mark.³ The ‘741 mark was created as a ‘comparable’ mark when the UK left the EU in accordance with withdrawal legislation. It is treated as though it has been registered in the UK throughout.

¹ The full specification is at Annex A

² The full specification is at Annex B

³ The full specification is at Annex C

4. According to LRI, AJ's mark is similar to the earlier marks, the respective goods are identical or highly similar, and there is a likelihood of confusion on the part of the public. Consequently, registration of the marks would be contrary to section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), which states:

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

(a) –

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

5. Further, LRI claims that the earlier marks have a reputation and use of AJ's mark, without due cause, would take unfair advantage of, and/or be detrimental to, the distinctive character and reputation of the earlier marks. Therefore, registration of AJ's mark would also be contrary to section 5(3) of the Act, which states:

"(3) A trade mark which—

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom 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."

6. Additionally, LRI claims:

- to have used the earlier marks throughout the UK since 2003 or 2004 and to have acquired goodwill under the marks;
- that use of AJ's mark would constitute a misrepresentation that the user is connected to LRI;
- that such a misrepresentation would damage LRI's goodwill.

7. Therefore, LRI claims that AJ's use of the opposed mark would amount to passing off. Consequently, registration of the mark would also be contrary to section 5(4)(a) of the Act, which states:

“5(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,

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.

(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.”

8. AJ filed a counterstatement denying the grounds of opposition. I note, in particular, that AJ:

- Denied that the opposed mark is similar to the earlier marks;
- Required proof of use of the earlier marks;
- Denied that earlier marks have a reputation and that LRI has established goodwill under the marks.

9. Prior to this, on 10th March 2023, AJ filed two applications to invalidate and/or revoke the registration of the '902 mark (i.e. LEARNING RESOURCES as words). Application 505895 was made under section 47(1) of the Act on the grounds that registration of the mark was contrary to sections 3(1)(b),(c) and (d) of the Act, which are as follows:

“47(1) The registration of a trade mark may be declared invalid on the ground that the trademark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trademark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

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“3(1) The following shall not be registered—

(a) signs which do not satisfy the requirements of section 1(1),

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

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

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

10. According to AJ, the words LEARNING RESOURCES:

“... consists exclusively of a sign or indication which serves in trade to designate the kind and/or intended purpose of goods covered by the registration, namely learning resources used for the purposes of educating children/people.”

And

“By virtue of the longstanding use of the word "LEARNING RESOURCES" as an English term for learning materials used to educate children/people, the

trade mark has become known as a term customary in the education trade to designate the goods covered by the registration.”

11. Application 505896 was made under section 46(1)(c) of the Act, which is as follows:

“(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) -

(b) -

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered

(d)- ”

12. According to AJ:

“The Sign comprises nothing more than a phrase which refers to learning materials and resources used for educating children/people. Furthermore, there are several third parties in the United Kingdom who have used, and are continuing to use, the Sign in a generic sense to refer to learning materials as resources. The extent of this generic use of the Sign is such that knowledge can reasonably be imputed to the Proprietor. As such, it is submitted that the Proprietor's inactivity in failing to deal with this generic, third party use of the Sign, has resulted in the Sign becoming the common name in the trade for the goods in issue.”

13. LRI filed counterstatements denying the grounds for invalidation/revocation. As regards the application for invalidation, LRI claimed that, even if the mark was *prima facie* excluded from registration in 1997, “...as a consequence of use made of the mark *LEARNING RESOURCES* in relation to the marketing sale and distribution of goods in class 9,16 and 28 both before and after the date of registration the mark *LEARNING RESOURCES* has acquired distinctiveness through use for the goods for which it is registered.”

14. As regards the application for revocation, LRI claimed that the mark remained distinctive and it had taken reasonable steps to prevent the mark becoming the common name for the goods for which it is registered.

15. The opposition and cancellation proceedings were consolidated.

REPRESENTATION

16. AJ is represented by Trade Mark Wizards Ltd. LRI is represented by TLT Solicitors. A hearing took place (via video link) on 10th May 2024 at which Ms Kendal Watkinson appeared as counsel for AJ, and Mr Daniel Selmi appeared as counsel for LRI.

THE EVIDENCE

17. AJ filed three witness statements with two exhibits, the first of which comprises some 270 pages. The purpose of AJ's evidence is to show that LEARNING RESOURCES is descriptive and/or generic for educational goods/services.

18. LRI's evidence comprises witness statements by Richard Woldenberg (2), Chris Mahady, Simon Hill, Debbie Faulkner and Caroline Wright. Mr Woldenberg is the CEO of LRI. He is also a director of the business through which LRI trades in the UK and Europe (Learning Resources Ltd). The main purpose of his evidence is to show that the '902 and '741 marks have been used and acquired a substantial reputation and goodwill in the UK, and that LRI has taken steps to protect the marks.

19. Mr Mahady, Mr Hill and Ms Faulkner work for companies providing educational products. LRI supplies, or has in the past supplied, them with products. Each of the witnesses attests to the fact that LEARNING RESOURCES is well-known in the educational supplies sector. Caroline Wright is Director General of the British Educational Suppliers Association ("BESA") which represents almost 400 educational suppliers, including LRI. Her evidence is that BESA members actively purchase and resell goods from LRI. According to Ms Wright, LRI is as an established supplier of teaching aids, including games and products that meet the curriculum requirements, and is very well-known for supplying products for special needs and early years children. All of these witnesses say they have not come across any other business called Learning Resources, and nor are they aware of any other businesses operating

in the education supplies sector that uses the term ‘learning resources’ as part of their name.

STATUS OF EU CASE LAW

20. 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.

HAS LEARNING RESOURCES BECOME THE COMMON NAME IN THE TRADE FOR THE GOODS COVERED BY THE ‘902 MARK?’

21. It is convenient to start by examining the application to revoke the ‘902 mark. The mark is registered in relation to:

Class 9: Teaching apparatus and instruments; protractors, calculating apparatus, computer apparatus, all for use as aids to teaching; all for use in schools and the like educational establishments.

Class 16: Instructional and teaching materials; games and playthings for teaching and instructional purposes; all for use in schools and the like establishments.

Class 28: Games and playthings, all for use as aids to teaching and all for use in schools and the like establishments.

22. AJ’s first statement purports to show “*a substantial number of books and articles which were published before 1997 and which contain the words LEARNING RESOURCES in their titles*” and that “*these books and articles were published for educational/teaching purposes.*” The witness cites as examples:

(1) “*Yellow Pages of Learning Resources*” by Richard Saul Wurman and George Borowsky (1972) at page 6.

Page 6 of exhibit AJ consists of an undated page from an unspecified website about a book entitled Yellow Pages of Learning Resources, which appears to have been available to purchase on Amazon. It is not entirely clear what the book was about, but it does not appear to be aimed at educational establishments or their students.

(2) *“Learning Resources in Schools” by Margaret Kinnell Evans (1992) at page 7.*

Page 7 of exhibit AJ consists of a webpage from Google Books about a book entitled Learning Resources in Schools, which appears to have been first published by the Library Association in 1992. It is not clear where it was published. The subject is described as ‘Instructional materials centers -- Great Britain.’

(3) *“Learning Resources Centers” by Len S Powell (1974) at page 17.*

Page 17 of exhibit AJ consists of an undated webpage from ResearchGate about an article published in 1974 about Learning Resource Centers. The article itself is not in evidence. It is not clear where it was published or what it was about. I note the US spelling of ‘Centers’ in the title.

(4) *“Clifford Library and Learning Resources Self-Study Report” by P. Grady Morein (1982) at page 23.*

Page 23 of exhibit AJ consists of an undated webpage from ResearchGate about an article published in 1982 about a report. The article itself is not in evidence. It is not clear where it was published or what the report was about.

(5) *“From Libraries to Learning Resources” by D. Joleen Bock (1985) at page 24.*

Page 24 of exhibit AJ consists of an undated webpage from ResearchGate about an article published in 1985. The article itself is not in evidence. It is not clear where it was published.

(6) *“Exploiting learning resources: A team approach” by Gloria Terwilliger (1975) at page 80.*

Page 4 of exhibit AJ consists of an undated webpage from ResearchGate about an article published in 1975. The article itself is not in evidence. It is not clear where it was published.

23. AJ further provides details of *“a substantial number of books, articles and learning resource materials, such as worksheets, which have been published or made available since 1997 and which contain the words LEARNING RESOURCES in their titles.”* She says, *“All of these books, articles and learning resource materials were published for educational/teaching purposes.”* She cites these examples from exhibit AJ to her statement:

(1) *“The Creative Teaching & Learning Resource Book (Creativity for Learning)” by Brin Best (2008) at page 96.*

This book is available on Amazon in pounds sterling. It was published in 2008. According to the description it ‘..presents over 200 tips, tools and practical strategies for more effective teaching and learning that can be used in your classroom tomorrow.’

(2) *“Libraries and Learning Resource Centres” by Brian Edwards (2009) at page 101.*

This book appears to be available to purchase in the UK in pounds sterling, although it is not clear where from. It was published in 2009. It seems to be aimed at librarians.

(3) *“Year 2 Home Learning Resource Pack” by twinkl at page 105.*

This consists of an undated webpage from an unidentified website about a Home Learning Resource Pack.

(4) *“Implications of Free Primary Education on Learning Resources” by Wabwoba Caroylne N S (2013) at page 108.*

This consists of an undated webpage from an unidentified website about an academic paperback publication available for purchase for £56.

(5) *“Jonathan Meres Learning Resources” by Jonathan Meres (2014) at page 127.*

This consists of an undated webpage from the website of the UK education website TES advertising an educational worksheet with the description ‘Get creative in the classroom with these brilliant teaching resources to accompany a couple of Jonathan Meres's excellent books.’ Although undated, I note the webpage was last updated in 2014.

(6) *“Lucy Hawking Learning Resources” by Lucy Hawking (2014) at page 128.*
This is from the same website and advertises the same sort of material.

24. I note that similar worksheets described as ‘learning resources’ are shown at pages 107, 112, 113, 123, 124, 125, 126, 128, 135 – 139, 151 - 215 and 249/250 of exhibit AJ. All are shown as having been last updated prior to the date of AJ’s trade mark application in February 2023.

25. I further note that pages 131 – 134 of exhibit AJ consists of four similar worksheets described as ‘teaching and learning’ resources’. Again, all four are shown as having been last updated prior to February 2023.

26. Page 103 of exhibit AJ consists of a page dated October 2020 from the website Books2all. This appears to be the website of a party that accepts and distributes books without payment/charge. This page advertises the availability of ‘The best digital learning resources for teachers’. I note that donations were encouraged in pounds sterling, indicating this is a UK website.

27. There are further undated pages from the website of Bookshop.org showing the availability of educational books published between 2013 and 2019 which include the words Learning Resources in their titles. The prices are shown in pounds sterling, indicating this is also a UK website.

28. Pages 226, 230 - 232 of exhibit AJ are undated webpages from Waterstones showing the availability of educational books published between 2007 and 2013 including the words Learning Resources in their titles. The prices are shown in pounds sterling, indicating this is also a UK website.

29. Pages 110, 251 – 270 of exhibit AJ are undated webpages from various, mostly UK websites showing Learning Resources used in an educational context in relation to publications and education related services, such as libraries and museums.

30. At the hearing, the applicant's counsel also drew my attention to page 109 of exhibit AJ. This consists of an undated webpage from the website of Argos advertising a Learning Resources activity set for sale priced in pounds sterling. AJ cites this as another example of generic use of 'learning resources'. However, Mr Woldenberg gives evidence for LRI that this is in fact an instance of licensed use of its trade mark. This is borne out by the fact that both the '902 word mark and the '741 logo mark appear on the packaging of the product. I accept Mr Woldenberg's evidence on this point.

31. AJ also gives evidence about a number of UK companies that are registered and operate under names including Learning Resources. These are:

(1) E Learning Resources – incorporated in 2005. The evidence of its current website shows it is active in the education sector.⁴

(2) Tailored Learning Resources Ltd – incorporated in 2006. The evidence shows that it operates in the education sector.⁵

(3) Education Learning Resources Ltd - incorporated in 2021. The evidence shows that it is active.⁶

⁴ See page 89 of exhibit AJ

⁵ See page 90 of exhibit AJ

⁶ See page 92 of exhibit AJ

(4) Ultimate Learning Resources Ltd - incorporated in 2012. The evidence shows that it is active.⁷

32. Ms Watkinson relies on *Björnekulla Fruktindustrier AB v Procordia Food AB*⁸ for the proposition that:

(1) Section 46(1)(c) addresses the situation where a trade mark is no longer capable of fulfilling its essential function;

(2) The focus is on the relevant market for the goods in question and the role of the trade mark in that market; and

(3) Generally, the views of consumers and/or end users in the product market will play a decisive role since the function of the trade mark as an indication of origin is of primary importance to them. However, depending on the feature of the market concerned, the influence of intermediaries on decisions to purchase, and thus their perception of the trade mark, must also be taken into consideration.

33. According to Ms Watkinson, AJ has provided clear evidence that LEARNING RESOURCES has become generic, and that was the situation at the time the '902 mark was registered and subsequently.

34. For his part, Mr Selmi drew my attention to the judgment of Richard Arnold QC (as he then was) as deputy judge in *Hormel Foods*⁹ and submitted that:

(1) The requirement is that the mark has become the or a common name in the trade. Some descriptive use of the mark does not make it so.

(2) In respect of the proprietor's "*acts or inactivity*", all circumstances must be considered, including the steps that the proprietor has taken, or has failed to

⁷ See page 94 of exhibit AJ

⁸ Case C-371/02, CJEU

⁹ [2005] EWHC 13 (Ch)

take, to seek to prevent generic use of the mark e.g., by using the mark widely, publicising its registration, warning infringers etc.

35. According to Mr Selmi, none of the uses shown in AJ's evidence show generic use of Learning Resources in relation to goods within the scope of the '902 word mark. For example, use of those words in company names, or by a museum in relation to its services, or in academic articles, is not use in relation to goods.

36. I agree that much of AJ's evidence is irrelevant to the issue of whether Learning Resources had become a common name for the goods covered by the '902 mark at the date of AJ's application for revocation in March 2023. This is because:

(1) It is dated after the date of AJ's application, or is undated and, therefore, could be from after this date.

(2) It does not show use of the words in the UK or places where UK consumers would be likely to encounter it.

(3) It does not show use of the words in relation to the goods covered by the application.

37. However, there is some relevant use of the words shown in relation to worksheets for teachers, which are covered by *Instructional and teaching materials; all for use in schools and the like establishments*. There is also some relevant use of the words shown in relation to educational publications, which I consider are also covered by the term *Instructional and teaching materials*.

38. I accept the evidence shows descriptive use of Learning Resources to designate the intended purpose of *Instructional and teaching materials*. It also shows such use occurred after the '902 mark was registered. Does this show that the words had become a common name for such goods by March 2023? In my view, it does not. There are two reasons for this. Firstly, there is a difference between words being used descriptively and words being used as a common name for a product. Section 46(1)(c) covers only words or signs that are used as a name for the goods/services for which

they are registered.¹⁰ In my view, AJ's evidence does not show use of the words Learning Resources as a 'name' for *Instructional and teaching materials*. That is so even if 'name' is given a wide meaning within the range of possible natural uses of that word, e.g. as a name for a whole category of goods.

39. The second reason the use shown does not establish the conditions for revocation is that the scale of the descriptive use shown is not sufficient, in my judgement, to show the words are a common name for the registered goods, even if they are a name.

40. The application for revocation under section 46(1)(c) of the Act therefore fails.

THE VALIDITY OF THE '902 MARK

Burden of proof

41. The '902 mark appears to have been registered after LRI filed evidence of acquired distinctiveness to overcome the examiner's objections that registration of the mark was *prima facie* contrary to section 3(1)(b) and (c) of the Act. LRI's current evidence includes the evidence put before the examiner twenty years ago. According to Mr Selmi's skeleton argument "*It would be rationally unsupportable for the UK IPO to assess the same evidence differently and any such finding would be appealable without more.*"

42. It is fair to acknowledge that when I pressed him about this at the hearing, Mr Selmi accepted that I am not bound by the examiner's decision. However, he maintained that "*if you are assessing the evidence then the finding logically needs to be the same. There is no principled reason or basis to have a different finding.*"

43. I find this submission surprising for a number of reasons. Firstly, if there is "*no principled reason or basis to have a different finding*" on acquired distinctiveness, then the same must apply to the examiner's finding that the '902 mark was *prima facie* excluded from registration under section 3(1). Nevertheless, LRI invites me to find that the examiner was wrong about this. Secondly, these are *inter partes* proceedings in which the parties are entitled to an independent and unbiased assessment of their

¹⁰ See paragraph 34 of the judgment of the Court of Appeal in *Bach Flower Remedies Ltd v Healing Herbs Ltd* [2000] RPC 512

respective cases. That is hardly consistent with suggesting that it would be wrong for the Hearing Officer to take a different view to the one taken by the examiner in earlier *ex parte* proceedings. Cloaking the suggestion with the language used by the appellate bodies to describe the kind of error that justifies intervention on appeal by review – “*rationally unsupportable*” – is wrong and inapt: this is not an appeal against the examiner’s decision. Thirdly, as I pointed out at the hearing, the proviso to section 47(1) requires me to assess whether the ‘902 mark had acquired a distinctive character through use prior to the date of the application for invalidation in March 2023. LRI’s evidence of acquired distinctiveness by 2023 (to which I shall come shortly) is plainly much stronger than the case based on the evidence of use up to 1994. Consequently, there would be little point in considering that matter at the earlier date. Fourthly, it is well established in the assimilated case law of the CJEU that (at least) the (evidential) burden of establishing acquired distinctiveness in these circumstances rests on the proprietor of the mark.¹¹

44. Section 72 of the Act states that:

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

45. The net result is that the onus is on AJ to satisfy me that registration of the ‘902 mark was *prima facie* contrary to section 3(1) of the Act. If, or to the extent that, she succeeds in doing so, the burden shifts to LRI to provide sufficient evidence to show that the mark had acquired a distinctive character through use prior to (at the latest) 10th March 2023.

The *prima facie* objections

46. At the hearing, Ms Watkinson accepted that the ground for invalidation based on section 3(1)(b) of the Act added nothing to the grounds based on sections 3(1)(c) and

¹¹ *Oberbank AG & Banco Santander SA and Another v Deutscher Sparkassen- und Giroverband eV* (Joined cases C-217/13 and 218/13) at paragraphs 66 - 71

(d). I will therefore start by considering the section 3(1)(c)-based ground. The case law under section 3(1)(c) of the Act was summarised by Arnold J (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc.*¹² These are the most relevant points:

- (a) The general interest underlying section 3(1)(c) is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services.
- (b) With a view to ensuring that that objective of free use is fully met, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes.
- (c) The application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question. It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration.
- (d) The situations specifically covered by section 3(1)(c) of the Act are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of

¹² [2012] EWHC 3074 (Ch)

goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

(e) The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in section 3(1)(c) of the Act are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. A sign can be refused registration on the basis of section 3(1)(c) only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics.

(f) In addition, a sign is caught by the exclusion from registration in section 3(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned.

47. During the discussion at the hearing, LRI took the position that the relevant average consumer of the goods covered by the '902 mark is comprised of teachers or parents *"who are using those goods for education or teaching purposes."*¹³ Additionally, LRI says it includes those who trade in educational materials, such as the independent witnesses who have given evidence on its behalf. According to LRI, the end users of the goods are children/students.

48. I accept LRI's submissions on this matter.

49. The Oxford Learner's Dictionary defines 'learning' as *"the process of learning something"*, and 'resources' as, inter alia, *"something that can be used to help achieve an aim, especially a book, equipment, etc. that provides information for teachers and students."* The Cambridge Dictionary describes 'learning' as *"the activity of gaining knowledge"* and 'resources' as *"something that can be used to help you."*

50. On the face of it, LEARNING RESOURCES therefore appears to describe something that can be used in the process of learning. There is nothing to suggest that the inherent meaning of these words is any different today than it was in 1994

¹³ See page 38 of the transcript of the hearing.

when the application was made to register the mark. Indeed, the examiner's objection to registering the mark without evidence of acquired distinctiveness points to the words having had the same meaning when tendered for registration.

51. Mr Selmi submitted that LEARNING RESOURCES is a coined term. He said that learning is done by students using various means so 'learning resources' cannot be deemed to refer to any one thing. Consequently, and in contrast to 'teaching resources', which he accepted refers to tools used by teachers to teach, there is no sufficiently direct and specific relationship between the '902 mark and the Class 9, 16 and 28 goods for which LEARNING RESOURCES is registered so as to engage section 3(1)(c).

52. In support of this submission, Mr Selmi relied on the judgment of the CJEU in *OHIM v Celltech R&D Ltd*¹⁴ in which the court upheld the Court of First Instance's judgment which stated that even if CELLTECH was understood to refer to "cell technology" it was not descriptive within the meaning of the EU Trade Mark Regulation. This was because for a sign to be descriptive it must be such that:

"the relevant public would immediately and without further reflection make a definite and direct association with the ... goods and services claimed and the meaning of [the mark]"

- and that this association:

"... is such as to be immediately and unambiguously perceived..."

53. Each case turns on its own facts. I consider that relevant average consumers/end users would immediately and unambiguously understand LEARNING RESOURCES as designating something that can be used in the process of learning. In other words, as designating the intended purpose of the goods. It is true that the words do not identify by name the kind(s) of goods that can be used for this purpose. The same could be said about 'teaching resources', or 'teaching tools' for that matter. However, this is not necessary. It is sufficient for the purposes of section 3(1)(c) that the mark

¹⁴ Case C-273/05 P

designates at least one of the characteristics of the goods. Whether that is so must be assessed by considering each of the goods covered by the registration and deciding whether average consumers/end users would consider the words 'learning resources' apt to describe (at least one of) their intended purposes.

54. As to the suggested distinction between the descriptive words 'teaching resources' and the supposedly distinctive words 'learning resources', I consider it is much exaggerated. 'Teaching resources' describes the purpose of the goods from the perspective of the teacher, whereas 'learning resources' describes the purpose of the goods from the perspective of the student. However, given that the student is the end user of the goods, and teaching and learning are two sides of the same coin, the distinction is not sufficient, in my view, to disguise the descriptive meaning of 'learning resources' to average consumers/end users of goods.

55. I find LEARNING RESOURCES describes the intended purpose of *teaching apparatus and instruments and computer apparatus, all for use as aids to teaching in class 9 (which would include, for example, audio and computer tools for language learning) instructional and teaching materials and games and playthings for teaching and instructional purposes in class 16, and games and playthings for teaching and instructional purposes in class 28.*

56. This leaves:

Class 9: protractors, calculating apparatus, all for use in schools and the like educational establishments.

57. Mr Selmi placed particular emphasis on the inapplicability of the objection to the mark in relation to *protractors*. I agree that it is stretch to say that average consumers/end users would regard a measuring tool as simple as a protractor as a 'learning resource'. I do not accept that the same applies to *calculating apparatus*. This covers sophisticated electronic goods with the potential for use for the purposes of learning, e.g. checking the accuracy of the student's own maths.

58. I therefore find that the '902 mark may serve, in trade, to designate the intended purpose of all the goods covered by the registration in classes 9, 16 and 28, except

for *protractors* in class 9. Trade marks that are caught by any one of the subsections of section 3(1) of the Act are excluded from *prima facie* registration. Consequently, there is no point in considering whether the goods caught by the section 3(1)(c) objection are also caught by the pleaded section 3(1)(d) ground. This leaves the section 3(1)(d) ground in relation to the registration of the '902 mark in relation to *protractors* in class 9. I can deal with this shortly. There is no evidence of anyone using 'learning resources' in relation to *protractors* prior to the date of the application to register the '902 mark in 1994. Consequently, the mark cannot have come by then to "consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade [in *protractors*]." I therefore reject the grounds put forward under sections 47(1) and 3(1) for invalidating the registration of the '902 mark in relation to *protractors* in class 9.

Acquired distinctiveness?

59. As explained above, the next step is to consider whether LRI's evidence shows that the '902 mark had acquired a distinctive character through use in relation to the goods for which it was *prima facie* excluded from registration, prior to the date of the application for invalidation in 2023.

60. The CJEU provided guidance in *Windsurfing Chiemsee*¹⁵ about the correct approach to assessing the acquisition of distinctive character through use. The guidance is as follows:

"51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

¹⁵ Joined cases C-108 & C-109/97

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

61. Mr Woldenberg gives evidence that:

- (1) Learning Resources Ltd was set up in 1994 to conduct LRI's trade in the UK.
- (2) Prior to that LRI already had already been selling into the educational supplies sector and had several well established UK customers in that field.
- (3) LRI uses three brands: LEARNING RESOURCES, EDUCATIONAL INSIGHTS and HAND2MIND.
- (4) In October 2023, LRI Ltd supplied over 1000 different educational products (including variations within a single product line) into the UK market. Of those over 700 product types carried the LEARNING RESOURCES brand.
- (5) The UK sales cover *“goods in Classes 9 (including calculators and counting apparatus), 16 (including card games, books and cardboard play sets) and 28 (toys and games).”* The sales are of *“instructional and teaching materials mainly of paper, educational toys and games, and teaching apparatus and instruments.”*
- (6) Catalogues showing the *“wide range of teaching materials and educational toys and that were distributed in the UK”* between 2000 and 2022 are exhibit RW5.¹⁶
- (7) Examples showing how the LEARNING RESOURCES brand appears on the goods.¹⁷
- (8) LRI markets its goods through UK trade fairs, including the London Toy Fair under the LEARNING RESOURCES brand.¹⁸

¹⁶ These show mainly educational toys and games.

¹⁷ These show the logo version of the mark, i.e. the '741 mark.

¹⁸ Pictures of stands at exhibitions are at exhibit RW8.

(9) LRI markets its products through three channels in the UK: (i) to UK businesses that focus on supplying teachers, schools and educational establishments: (ii) to third party retailers such as Smyths Toys, Hamleys, WH Smith, Ryman, Very, John Lewis & Partners and Amazon who stock and resell its products to consumers: (iii) through sales direct to customers via the UK website www.learningresources.co.uk, which was set up in 1997.

(10) The home page of the current website bears the (logo version of) the LEARNING RESOURCES mark (i.e. the '741 mark').¹⁹ The current text on the home pages of the website starts with the line; "*We're Learning Resources® and we've been helping teachers and parents build generations of amazing kids for 35 years.*" The website looked the same prior to the date of the application for invalidation.

(11) Over the period 1 January 2021 to 31 December 2022 the analytics available for the UK website showed 2.85 million page views during 2021, and 2.23 million page views during 2022.

(12) There is a LEARNING RESOURCES branded store for the UK on Amazon. Over the period 1 January 2021 to 31 December 2022 the analytics available for the LEARNING RESOURCES store indicated 270,064 visitors in 2021 and 195,693 visitors in 2022.

(13) Search results for 'learning resources' on Amazon UK lists, under the heading "*Best Sellers from Learning Resources*", a selection of LRI's best-selling products sold under LEARNING RESOURCES.²⁰ On the following page it shows the words LEARNING RESOURCES (alone) under the list of brands on the left-hand navigation pane of the page.²¹

(14) A search for 'learning resources' on the website of John Lewis reveals ten of LRI's products, each listed as 'Learning Resources'.²² 'Learning Resources' also appears in a list of brands on the 'shop by brand' page.

(15) LRI Ltd.'s UK turnover in 1997 was about £630k. This rose gradually to nearly £6.3m in 2019, rose again to over £10m in 2021, before dropping back to £7.8m in 2022.

¹⁹ The website says LRI markets "*Educational Toys, Games and Learning Activities.*"

²⁰ See page 108 of exhibit RW6. This shows the logo version of the mark (i.e. the 741 mark). The goods shown are educational toys and games.

²¹ See page 109 of RW6

²² See pages 9 and 10 of exhibit RW2. The goods shown appear to be educational toys and games.

(16) Learning Resources Group makes available a wide range of free online educational activity sheets from the LEARNING RESOURCES website in the UK under the LEARNING RESOURCES brand. This activity was substantially scaled up following the start of the Covid Pandemic in March 2020. Parents, teachers and carers have free unlimited online access to downloadable and printable worksheets for maths, literacy, STEM, coding, early years activities, educational games, social-emotional learning (SEL), outdoor learning, and more. These worksheets were downloaded 750k times between 2020 and October 2023.

(17) This activity drew media attention during the COVID pandemic. The Daily Mail published an article in November 2020 which stated *"UK website Learning Resources is full of fun, easy activities to occupy children of all ages."* Another article in Toy World in March 2020 was headed *"Learning Resources to offer free at home learning activities."*

(18) Learning Resources Ltd in the UK has over 120,000 followers across the various social media sites.²³

(19) LRI UK spent significant sums on marketing activity.²⁴

(20) LRI's products have won awards in the UK. These include: Toy Talk Awards 2014: Winner for *best educational toy* – 'Learning Resources Buy Right Shopping Game'; and Practical Pre School-Awards 2015 and 2017: Gold Awards in the 'toys and games' category for 'Primary Science Lab Set' and 'Mathlink Cubes Activity Set'.²⁵ The latter product review includes the accolade *"when we saw this product was made by Learning Resources ® we knew it would be a great resource and we were not disappointed."*

62. Mr Woldenberg also gives evidence about the way the media refer to LRI's business.

²³ See exhibit RW7. This shows the sites are registered under 'learning resources' or learning resources uk', and there is consistent use of the Learning Resources logo (i.e. the '741 mark) on the pages.

²⁴ Pages 146 – 161 of exhibit RW8 consists of invoices for marketing work, e.g. trade fairs, ranging from several hundred pounds to (in one case) over £13k. The overall amount spent on marketing is not clear.

²⁵ Exhibit RW11 pages 183/185

(1) An article published in the regional magazine KLMagazine on August 2018 stated that *"Learning Resources is the top manufacturer of educational toys in the UK."*

(2) An article published on The Good Web Guide website on July 2018 stated that *"Parents and teachers need to know about Learning Resources, purveyor of high-quality educational tools for your home and school."*

(3) METRO, a high circulation freesheet tabloid newspaper, published a 'Toy Fair Special' in 2019 which Mr Woldenberg says referenced two of LRI's products: the Magnetic Food Fun Multicultural Set and the Artie 3000 Coding Robot.²⁶

(4) Toyworld reported that 'Learning Resources teams up with Butlins for science Lab workshops'.²⁷

(5) The Mail Online's *"Best educational board games for kids"* (published in November 2022) included a Learning Resources product, and the same site's *"must have toys for Christmas 2022"* included another Learning Resources product.²⁸

63. Mr Mahady works for Findel Education Ltd, which is a supplier of educational products to schools etc. He has known of LRI for the 19 years he has worked for Findel. LRI supplies Findel with specialist teaching products. In 2022, these products were worth around £450k. LRI also provides marketing support to Findel. In 2022, this amounted to around £11.5k. Mr Mahady describes LRI's goods as *"curriculum teaching products."* He exhibits at CW1 four examples of LRI's goods on Findel's UK website. They are all educational toys/playthings. They are listed on the website under the mark LEARNING RESOURCES. This is also the way LRI is referenced in the list of brands on Findel's website.²⁹ Mr Mahady's gives evidence that *"if somebody said*

²⁶ See pages 165/166 of exhibit RW10. The Artie 3000 Coding Robot is shown in the evidence as having been available from LRI's UK website, although it is branded (only) as ARTIE 3000. I cannot see the other product mentioned in the accompanying exhibit RW10.

²⁷ RW10 pages 163 to 164

²⁸ RW10 page 171

²⁹ See exhibit CW2

to me learning resources, I would immediately think of our supplier, Learning Resources.”

64. Mr Hill is the Managing Director of Yorkshire Purchasing Organisation (“YPO”) , which procures educational materials for schools in 13 local authority areas. He came across LRI whilst working for YPO. In 2022, YPO placed orders with LRI worth around £270k. He describes LRI as having *a reputation as a long-established supplier of teaching aids, particularly toys and games that have an educational purpose and that help kids to learn maths, English and spatial skills.* He says their focus is *“as a supplier of educational materials that stimulate learning and development through the medium of play.”*

65. Mr Hill provides examples of LRI’s products on YPO’s UK website. They are educational toys/games. The products shown in packaging bear the Learning Resources logo mark, i.e. the ‘741 mark. One of the products shown without packaging is listed as a Learning Resources product. Others are not so branded. This is consistent with his evidence that *“Some products sold by Learning Resources were individually branded as Learning Resources products on the packaging. Other products had their own brand names or description but were supplied to us by Learning Resources.”*

66. Mr Hill gives evidence that *“If I was to come across any educational product with the brand Learning Resources on the packaging or labelling, I would assume that the product was produced or supplied by the Learning Resources business.”*

67. Ms Faulkner works for Atelier Education Ltd and has been in the education sector since 2002. She gives evidence that:

“Within the industry Learning Resources has always been known as a provider of high quality innovative classroom teaching materials to schools. As time's gone on, they've also developed a presence in the retail market. They have also developed their own a well-established retail brand LEARNING RESOURCES and they continue to innovate and bring in new ranges collaborating with third parties. They've done fantastic things recently under

licence with Numberblocks, which is a collaboration with Cbeebies. So they continue to innovate and bring new products into the market.”

And:

“They also have a depth of range which means they have toys and books that focus on literacy numeracy computing and special needs.”

And:

“If I was to come across any educational product with the name ‘learning resources’ on the packaging, I would assume that the product was produced or supplied by Learning Resources Limited as they have strong branding on their packaging which is quite recognisable and well established.”

68. Ms Wright of the trade association BESA has known of LRI’s business for 10 years. She gives evidence that:

“Learning Resources Limited is so well known in our sector that if someone in our industry referred to a learning resources product, I would assume that they were referring to products supplied by Learning Resources Limited including products sold or packaged under the LEARNING RESOURCES brand.”

69. It is clear that LRI has been using LEARNING RESOURCES on a substantial scale in the UK market for 20 years or more. The business is plainly well known within the educational supplies sector. The majority of the use relied on to show the ‘902 trade mark has become factually distinctive in relation to educational goods is as part of the logo registered under the ‘741 mark, and/or as the trading name of the business that supplies the goods. It is well established that use of a non-distinctive mark as part of a distinctive mark can, as a matter of law, permit the non-distinctive mark to acquire the distinctive character it originally lacked.³⁰ However, where use of the non-distinctive mark is always, or nearly always, used as part of a more distinctive sign, it

³⁰ See *Société des Produits Nestlé SA v Mars UK Ltd*, CJEU, Case C-353/03

may be more difficult to show that the non-distinctive sign has become distinctive by itself.³¹

70. I have, therefore, carefully considered whether LRI has established that LEARNING RESOURCES (alone) had acquired a distinctive character through such use as there is of those words alone, and as part of the '741 mark. In my view, the evidence is sufficient to establish that the mark had acquired a distinctive character by the date of the application for invalidation in March 2023 to, at least, a significant proportion of relevant average consumers, end users, and trade intermediaries. In this connection, I note that:

- (1) There is evidence of the '902 mark being used, by itself, to distinguish LRI's goods, particularly on the websites of Amazon, John Lewis and Findel's;
- (2) There is evidence of a significant level of media coverage in which LRI and its products are referred to by reference to the words Learning Resources;
- (3) The trade witnesses give evidence that LRI and its products are known to them by the name Learning Resources and similarly known within the educational supplies sector.

71. The more difficult matter is identifying, with the necessary precision, the goods for which the '902 mark has acquired a distinctive character. According to LRI's annual report for 2022, "*The Company's principal activity continues to be the sale of educational toys.*" This accords with most of the goods shown on the invoices exhibited at RW3 and much of the evidence set out above. I find that the '902 mark has acquired a distinctive character in relation to:

Class 16: Games, playthings, cards, counters, puzzles, and activity sets for teaching and instructional purposes; all for use in schools and the like establishments.

Class 28: Games and playthings, all for use as aids to teaching and all for use in schools and the like establishments.

³¹ See, for example, *Audi AG, Volkswagen AG v OHIM*, Case T-318/09, the General Court

72. Mr Woldenberg claims the mark has also been used in relation to *books* which are covered by *instructional and teaching materials* in class 16. Ms Faulkner gives similar evidence. However, neither witness gives any indication of the proportion of LRI's business that is made up of book sales, or provides any further particularisation of these claims. The closest Mr Woldenberg comes to this is his estimate that:

".. goods in scope of the class 16 specification of the '741 mark make up approximately 20% of our total sales volume (not counting free downloads which are in addition)."

73. This does not shed much light on the matter of book sales because class 16 of the '741 mark covers much more than just books. And having gone through the exhibits to Mr Woldenberg's statements, I have struggled to find concrete examples of the use of LEARNING RESOURCES as (or as part of) a trade mark for books.³² Ms Faulkner provides no such examples. The question, of course, is whether the '902 word mark has acquired a distinctive character for such goods to a significant proportion of the relevant public, not just whether LRI has ever sold books under the mark. Showing a few sales of books under the mark would not be enough to support such a finding. This is particularly so in circumstances where the apparent descriptiveness of the mark is at its most striking in relation to educational publications. This is because 'learning' is the whole purpose of such goods and 'resources' is a very apt way to describe an accessible collection of such goods. I find the evidence about the claimed use of the '902 mark in relation to books to be mere assertion. In any event, without further particularisation or adequate documentary support, I do not find the evidence sufficient to show that the '902 mark has acquired a distinctive character for books or similar educational publications.

74. The use of the mark in relation to educational activity sheets also potentially falls within *instructional and teaching materials* in class 16. There is almost no such use shown in the evidence, apart from the free online worksheets that were made

³² I note that exhibit RW13 includes what appears to be a LRI brochure from pre-1994 which includes references to activity books (as opposed to text books). However, it is not clear whether, or the extent to which, this document was circulated in the UK and there are no pictures of the books themselves. I also note that page 76 of exhibit RW5, which is contents page for LRI's 2004 brochure includes a reference to pages (82/83) relating to 'Professional books and games'. However, those pages are not included in the exhibit.

downloadable from LRI's UK website between 2020 and October 2023. The worksheets were downloaded 750k times in this period. The later date is after the relevant date in March 2023. However, even assuming that most of the downloads were made prior to that date, I do not accept that the evidence establishes that LEARNING RESOURCES had acquired a distinctive character for such goods to a significant proportion of the relevant UK public. This is because:

(1) Although 750k downloads sounds a lot, this is over a three year period and the evidence does not identify how many different users downloaded the material: the likelihood is that a smaller number of users downloaded the material on multiple occasions during this period. The real number of users could constitute only a small proportion of the relevant public, which is likely to amount to many millions.

(2) Although the free downloads attracted some media interest in 2020, the scale of this publicity appears to have been modest.

(3) Consistent with providing activity sheets without charge, there is no evidence that LRI spent much, if anything, promoting these goods.

(4) They appear to have been give-aways intended to promote the educational toys and playthings which make up LRI's core business.

(5) Similar to books, the apparent descriptiveness of the mark is particularly striking in relation to educational activity sheets. It cannot therefore be assumed that all, or even most, of the users of the worksheets understood Learning Resources to be a trade mark.

75. I conclude that the '902 mark has not been shown to have acquired a distinctive character in relation to *instructional and teaching materials* (at large) in class 16.

76. This leaves:

Class 9: Teaching apparatus and instruments; calculating apparatus, computer apparatus, all for use as aids to teaching; all for use in schools and the like educational establishments.

77. Mr Woldenberg offers no estimate as to the proportion of LRI's goods that fall in class 9.

78. Looking at the evidence, I cannot see any use, or any significant use, of the '902 mark in relation to teaching aids being calculators or computer apparatus.³³ There is some use of the mark shown in relation to junior binoculars, microscopes, science sets, thermometers, and barometers, all of which are proper to class 9.³⁴ I consider that, at least when for use in schools etc., an average consumer would consider microscopes and science sets to be types of *teaching apparatus and instruments*. However, *binoculars, thermometers and barometers* would not be perceived as such. Further, *teaching apparatus and instruments* covers many other goods, e.g. language learning apparatus, for which the '902 mark has not been shown to have acquired distinctiveness through use. I note that page 76 of exhibit RW5, which consists of the contents page for LRI's 2004 brochure, includes a reference to pages (74 - 77) relating to 'Teacher Resources'. However, those pages are not included in the exhibit. It is impossible to say whether, let alone to what extent, the '902 mark has been used in relation to goods of this kind. Considering the evidence as a whole, I find that the '902 mark has only been shown to have acquired a distinctive character in relation to the following goods in class 9:

Teaching apparatus and instruments, namely microscopes and science sets; all for use in schools and the like educational establishments.

79. The overall effect of the above findings is that the '902 mark will remain registered in relation to:

Class 9: Protractors; teaching apparatus and instruments, namely microscopes, science sets; all for use in schools and the like educational establishments.

³³ I have noticed use in relation to toy cash registers, but these are toys in class 28 not calculating apparatus in class 9.

³⁴ See, for example, exhibit RW5

Class 16: Games, playthings, cards, counters, puzzles, and activity sets for teaching and instructional purposes; all for use in schools and the like establishments.

Class 28: Games and playthings, all for use as aids to teaching and all for use in schools and the like establishments.

80. The '902 mark is invalid in relation to the remaining goods for which it is registered in classes 9 and 16.

LRI's OPPOSITION TO AJ'S APPLICATION 3874104

Proof of use of LRI's '902 and '741 marks

81. As it was entitled to under section 6A of the Act, AJ put LRI to proof of use of the earlier marks. However, Ms Watkinson's skeleton did not address that matter and, at the hearing, she clarified that AJ does not say there is no evidence of genuine use of the marks.³⁵ Rather, Ms Watkinson chose instead to focus on the effect of such use, which she submitted was not such as to endow the words 'learning resources' alone with distinctive character.

82. In the light of the positions taken at the hearing, I do not consider it necessary to determine whether the use shown of the earlier marks satisfies the proof of use requirements. Instead, I will proceed on the footing that this matter is no longer in dispute.

The Section 5(2)(b) grounds

83. 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.

³⁵ See page 18 of the transcript of the hearing.

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/services

84. AJ accepts that the goods/services applied for are identical or similar to the goods for which the earlier '741 and '902 marks are registered.

Average consumer and the selection process

85. I earlier accepted LRI's submission that average consumers of the goods covered by the earlier marks are teachers, parents, intermediaries who trade in educational materials, and the end users of the goods are children/students.

86. Ms Watkinson submitted that the relevant public for AJ's goods/services is comprised of anyone who is in the market for learning products, such as teachers, home schoolers, but also the general public. Consequently, there does not seem to be any real dispute as to the identity of the relevant public.

87. The evidence indicates that the goods at issue are selected from websites, catalogues, retail stores etc., i.e. by visual means. For this reason, Mr Selmi accepted³⁶ that the visual comparison of the marks appears to be the most important.

³⁶ See page 40 of the transcript of the hearing

However, given the potential for word-of-mouth recommendations, the way the marks sound must also be considered.

88. Most average consumers/end users of the goods/services at issue are liable to pay an average or medium degree of attention during the selection process and/or when using the goods. Intermediaries who trade in educational products are likely to pay a higher degree of attention because selecting the right products is highly important to the success of their businesses.

Distinctive character of the earlier marks

89. I have found that the '902 mark has acquired a distinctive character for the goods set out in paragraphs 71 and 78 above. However, distinctiveness is a matter of degree. In *Lloyd Schuhfabrik Meyer* the CJEU provided the following guidance about the assessment of distinctive character (with references to earlier cases removed):

“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.

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.”

90. LRI submits that the '902 mark is highly distinctive through use in relation to the goods for which it is registered.

91. AJ disputes this.

92. I have already found that LEARNING RESOURCES is, with one minor exception, *prima facie* descriptive of the intended purpose of the goods for which it was, and remains, registered. The mark has acquired factual distinctiveness through the longstanding use described above, particularly in relation to *games and playthings, all for use as aids to teaching*. In my view, the mark has acquired a fairly high (but not the highest) degree of distinctive character for such goods, and at least a medium degree of distinctive character in relation to all the goods for which it remains registered.

93. The same finding applies to the '741 mark. This mark is also inherently distinctive, to at least a medium degree, in relation to all the goods for which it is registered. This is because it includes the distinctive building block-like device as well as the words LEARNING RESOURCES. However, it is the distinctiveness of the words that are common to both parties' marks that matters most for present purposes.³⁷

Comparison of the earlier '902 mark with the contested mark


94. In its judgment in *Bimbo SA v OHIM* the CJEU held 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."

95. 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.

³⁷ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person

96. The marks are shown below.

Earlier trade marks	Contested trade mark
LEARNING RESOURCES	

97. This is the real battleground between the parties. It is submitted on behalf of LRI that the marks are visually, aurally and conceptually similar to a high degree. In this connection, LRI contends that the earlier mark is wholly contained in the contested mark.

98. AJ relies on the following features of the contested mark as differentiating and distinguishing it from the '902 mark:

- (1) The word "FUN" in AJ's Mark, which it says is at the start of the mark and is therefore the dominant and distinctive element;
- (2) The "unique stylisation" of the words 'FUN LEARNING RESOURCES', with the words 'FUN LEARNING' appearing in bolder and bigger letters than the word 'RESOURCES';
- (3) The font used for the words 'FUN LEARNING RESOURCES'; and
- (4) The circular logo next to the word element in the contested mark, which it says has the outline of a house in the centre filled with four squares, surrounded by tree branches with leaves coming off them.

99. AJ says that, to the extent that there is any aural or conceptual similarity between the respective marks, they are similar to no more than a low degree.

100. From a visual perspective, I find the bold font used for the words FUN LEARNING in the contested mark gives those words prominence in the impression created by the mark as a whole. The device element is likely to be recognised as containing a child-like representation of a house. I am less convinced that average consumers/end users will immediately recognise the surrounding design as trees with branches. Nevertheless, I consider that because of its relative size compared to the words in the mark, and the fact that it (rather than the word 'FUN') will strike consumers, who are used to reading from left to right, as the first element in the mark, the device is equally prominent to (and more distinctive than) the words FUN LEARNING.

101. Whilst undoubtedly making up the third word in the term 'FUN LEARNING RESOURCES', the smaller and lighter font used for 'RESOURCES' diminishes the relative impact of that word in the impression created by the mark as a whole. Therefore, although it is unlikely to be completely overlooked, average consumers/end users will perceive that word as only a minor visual component of the contested mark.

102. For these reasons, I find the respective marks to be visually similar to only a low to medium degree. The marks are more similar from an aural perspective. This is because the device element of the contested mark is unlikely to feature in oral orders/recommendations. Further, the visual emphasis given to the words 'FUN LEARNING' over the word 'RESOURCES' will not come out when the words '**FUN LEARNING** RESOURCES' are expressed verbally. Nevertheless, the marks will still sound different because the first word FUN/LEARNING is different.³⁸ Overall, I consider the marks to be aurally similar to a medium degree.



103. Conceptually, the earlier mark conveys the meaning of 'things that are used for learning'. Although those are my words rather than LRI's (it does not expressly define the conceptual meaning of the earlier marks), it does say that the contested mark conveys the same meaning as the earlier marks. I find the visual emphasis placed on the words 'FUN LEARNING' (the meaning of which is obvious) places more emphasis on that meaning than on the meaning of the common words - LEARNING

³⁸ It is well established that, in general, the beginnings of word marks tend to have more visual and aural impact than the ends. See, for example, the judgment of the General Court in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

RESOURCES. I therefore find that the apparent conceptual similarity of the respective marks is to a medium (not high) degree.

Comparison of the earlier '741 mark with the contested mark

104. The marks are shown below.

Earlier trade marks	Contested trade mark
	

105. The device on the left of the '741 mark is unlikely to feature when the mark is expressed verbally. It does not change the concept of the earlier mark either. Therefore, the same considerations expressed above in relation to the '902 mark also apply to the aural and conceptual comparison between these marks.

106. The visual comparison is different because:

(1) The device to the left of the '741 mark is quite prominent in that mark and entirely different to the device in the contested mark: this reduces the level of visual similarity between the marks.

(2) The words LEARNING RESOURCES are arranged one below the other in the '741 mark, as the words FUN LEARNING RESOURCES are arranged in the contested mark: this increases the level of visual similarity between the word elements a little, but not as much as the different devices reduces the overall level of similarity.

107. For these reasons I find that the contested mark is visually similar to the '741 mark to only a low degree.

Likelihood of confusion

108. Mr Selmi submitted that, once imperfect recollection is factored in, there is a likelihood of direct confusion between the contested mark and the earlier marks. I reject that submission. My reasons are:

(1) The various levels of similarity between the marks vary between 'low' and 'medium'.

(2) In the comparison most likely to affect the likelihood of confusion – the visual comparison - the level of similarity is low (in the case of the '741 mark) and low-to-medium (in the case of the '902 mark).

(3) The effect on the likelihood of confusion of the medium degree of conceptual similarity between the marks is reduced to a certain degree by the fact that the words 'LEARNING' (as part of 'FUN LEARNING') and 'RESOURCES' appear to convey descriptive meanings in the contested mark.

(4) Although all the respective goods/services are at least similar, the goods for which the earlier marks are most distinctive – educational toys and games in class 28 – are not covered by the contested mark.

(5) The level of attention paid by average consumers and end users is, at the least, medium.

109. I have also considered whether there is a likelihood of indirect confusion. As Mr Iain Purvis KC explained in *L.A. Sugar Limited v By Back Beat Inc.*:³⁹

"Indirect confusion.... 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

³⁹ Case BL O/375/10

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.’

110. In this case the “*something in common*” would be the words LEARNING RESOURCES. However, although both those words are present in the contested mark they are presented in a way that ‘LEARNING’ is much more strongly tied to the preceding word ‘FUN’ than to the following word ‘RESOURCES’. This points away from the contested mark being a brand extension of the LEARNING RESOURCES range of products. Further, the words LEARNING RESOURCES are not, as in one of the examples used by Mr Purvis in *L.A. Sugar*:

“...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.”

111. I therefore reject the likelihood that average consumers/end users who are aware of the differences between the marks would nevertheless believe that the common words LEARNING and RESOURCES indicate that the user of the contested mark is economically connected to the user of the earlier marks.

112. The grounds of opposition under section 5(2)(b) fail accordingly.

The Section 5(3) and Section 5(4)(a) grounds

113. The essential requirements of the law of passing off are well established and not in dispute. Essentially, LRI must satisfy me that:

(1) It had goodwill in the UK under the earlier marks by 3rd February 2023 in relation to the goods it claims;

(2) Use of AJ’s mark in relation to the goods/services set out in Annex A would constitute a misrepresentation to the public that the user of that mark is, or is connected to, LRI leading to deception or a likelihood of deception; and

(3) Substantial damage would be done to LRI's goodwill as a result of the misrepresentation.

114. I accept that LRI had the requisite goodwill under the earlier marks to bring an action for passing off at the relevant date in February 2023. However, for the reasons given in relation to the section 5(2) ground, I find that use of the contested mark would not amount to a misrepresentation to the public. Consequently, such use would not cause any damage to LRI's goodwill.

115. In reaching this finding, I have not overlooked the potential differences between the common law on misrepresentation and the test for a likelihood of confusion under section 5(2) of the Act. However, I find that on the facts of this case the result is the same.

116. The relevant case law under section 5(3) 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; *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) 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*).

Reputation

117. I accept that the earlier marks have acquired a qualifying reputation in relation to the goods specified in paragraphs 71 and 78 above.

Link

118. My assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

119. This is set out in paragraphs 93 - 107 above.

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

120. It is common ground that the parties' goods/services are identical or similar.

The strength of the earlier mark's reputation

121. Although there is limited evidence as to how much LRI had invested in establishing the earlier marks in the UK market, the marks appear to be long

established and well regarded, particularly in relation to educational toys, games and playthings.

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

122. This is set out in paragraphs 89 – 93 above.

Whether there is a likelihood of confusion

123. There is no likelihood of confusion between the earlier mark and the contested mark.

Conclusion on link

124. In my view, the relevant public will not make any link between the contested mark and the earlier marks.

125. If I am right about this the opposition under section 5(3) fails at this point. However, in case I am found to be wrong, I will briefly consider whether any such link would give rise to any of the conditions proscribed by section 5(3) of the Act.

Unfair advantage

126. According to LRI's pleaded case:

"The Application benefits from the attractiveness of the earlier mark, by affixing a highly visible, virtually identical sign, thus misappropriating the attractive powers and advertising value or exploiting the Opponent's reputation, image and prestige. This may lead to unacceptable situations of commercial parasitism, where the Applicant is allowed to take a free ride on the investment of the Opponent in promoting building up goodwill of its marks, as it may stimulate the sales of the Applicant's services to an extent that is disproportionately high in comparison with the size of its promotional investment."

127. In his skeleton argument, Mr Selmi sought to add to this by drawing attention to evidence filed by Mr Woldenberg consisting of the home page from AJ's website on which she states that she had previously worked in education in the UK.⁴⁰ He invited me to draw the inference that AJ must have known about LRI's marks and their reputation, and intended to take advantage of them. However, as I pointed out at the hearing, LRI's pleadings did not include such an accusation. Further, this point had not been put to AJ in any other way prior to the hearing. Mr Selmi accepted as much and consequently agreed that LRI's case should be limited to the claimed objective effect of AJ's use of the contested mark, and not include this alleged subjective intention.

128. In my view, even if the relevant public made a link between these marks, there would be no unfair advantage. This is primarily because I have found the marks are far from "*virtually identical*." In my view, any link the relevant public make between them would be fleeting and weak. This is the converse situation to the one described in the case law cited at paragraph 116(f) above, where it is noted that "*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.*"

129. The reason for using the words LEARNING and RESOURCES in the contested mark would also be self-evident to the relevant public, i.e. the words are used as, or as part of, descriptions (i.e. 'Fun Learning' and 'Resources') of characteristics of the goods.⁴¹ This mitigates against the mark obtaining a parasitic and unfair advantage.

Detriment to reputation

130. LRI submits the reputation of the earlier mark will suffer if AJ sells lower quality goods under the contested mark. This is purely speculative.⁴² In the absence of any

⁴⁰ See exhibit RW14, page 239, to Mr Woldenberg's first statement

⁴¹ In reaching this view, I have not placed any weight on the limitation in AJ's specification to the goods/services being 'learning resources'. The limitation on the register will obviously not be apparent to the relevant public in normal use of the mark.

⁴² See the decision of Ms Anna Carboni as the Appointed Person *Unite The Union v The Unite Group Plc*, Case BL O/219/13

likelihood of confusion, this does not constitute a serious likelihood of damage to the reputation of the earlier mark.

Detriment to distinctive character

131. LRI contends that the distinctiveness of the earlier mark will be eroded by use of the contested mark. According to LRI's pleading:

“Should [AJ’s] Application be allowed, without due cause, the Opponent’s earlier mark will lose its ability to attract the attention of the relevant consumer because there exists another virtually identical mark that reduces the attractive force of the earlier mark leading the relevant consumer to mistakenly believe they are purchasing services from the Applicant instead of the Opponent.”

132. I reject this submission too. A case under this heading requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark is registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future. In the absence of a likelihood of confusion, I see no reason why use of the contested mark would make the earlier marks any less distinctive.

133. For the reasons given above, the grounds of opposition under sections 5(3) and 5(4)(a) of the Act are also rejected.

OVERALL RESULT

134. AJ’s application to have the ‘902 mark revoked under section 46(1)(c) of the Act fails.

135. AJ’s application to invalidate the ‘902 mark under section 47(1) of the Act succeeds to a limited extent, but fails in respect of the majority of the goods for which it is registered. The mark will, therefore, remain registered in relation to the goods set out in paragraph 79 above.

136. LRI’s opposition to AJ’s trade mark application fails.

COSTS

137. Both sides have achieved a measure of success. I would ordinarily be minded to direct that each side should bear its own costs. However, LRI requested off-scale costs based on the volume and alleged poor quality of AJ's evidence, and the fact that it had unnecessarily been put to proof of use of the earlier marks. I therefore agreed to give the parties sight of this decision and an opportunity to make submissions on costs, prior to deciding this matter.

NEXT STEPS

138. This is a final decision on the substance of AJ's applications and LRI's opposition. The period for appeal will run from the date shown below.

139. LRI has 28 days to make written submissions, if it wishes, on the matter of costs. If LRI wishes to pursue its request for off-scale costs, it should also provide an estimate of the cost of the additional work it claims was caused by the issues complained about, and explain how this has been calculated.

140. If LRI makes such written submissions, AJ has 21 days to file written submissions in response.

141. I will issue a further decision on costs after reviewing any submissions received.

Dated this 5th day of July 2024

Allan James
For the Registrar

Annex A

Class 9: Digital books downloadable from the Internet; Downloadable e-books; Downloadable educational course materials; Downloadable electronic books; Downloadable publications; E-books; Training manuals in electronic format; All of the aforesaid to relate to learning resources.

Class 16: Activity books; Blank journal books; Blank writing journals; Books for children; Children's activity books; Coloring books; Diaries; Educational books; Exercise books; Handbooks [manuals]; Illustrated notepads; Non-fiction books; Notebooks; Printed curricula; Printed educational materials; Printed teaching activity guides; Printed teaching materials; Resource books; Storybooks; Workbooks containing exercises; All of the aforesaid to relate to learning resources.

Class 41: Development of educational materials; Providing information about education; Publication of educational books; Publication of educational teaching materials; Publishing of books, magazines; Publishing of electronic books and journals on-line; All of the aforesaid to relate to learning resources.

ANNEX B

Class 9: Teaching apparatus and instruments; protractors, calculating apparatus, computer apparatus, all for use as aids to teaching; all for use in schools and the like educational establishments.

Class 16: Instructional and teaching materials; games and playthings for teaching and instructional purposes; all for use in schools and the like establishments.

Class 28: Games and playthings, all for use as aids to teaching and all for use in schools and the like establishments.

ANNEX C

Class 9: Educational scientific apparatus, calculators, slide sets, activity kits relating to weather, geology, ecology, physics, measurement, chemistry, life sciences, anatomy, scientific research and discoveries, geography, optics, mechanics,

electricity, light, sound, biology, magnetism and other scientific subjects; parts and fittings for all the aforesaid goods.

Class 16: Instructional and teaching material; educational material, children's educational material, printed matter; books, magazines and publications, educational books and texts for children and/or teachers; cards, posters, calendars, charts, charts featuring educational themes, stickers, activity cards, children's educational material comprising coins, paper money, stamp sets, teaching clocks, manipulative wooden block sets, geometric fraction sets and block puzzles, language puzzles, vests and wooden dressing frames for teaching children the use of buttons, straps, laces and zippers, blocks, beads, pegs and grips for teaching maths fundamentals; parts and fittings for all the aforesaid goods.

Class 28: Toys, games and playthings; puppets, dolls, educational toys and games, beads, blocks, playsets, manipulative toys for teaching mathematics, science, language and early childhood concepts; board games and card games, flashcards, puzzles, beans bags, activity sets, play foods, animal figures, gear activity sets and tables, play money, play cash registers, learning clocks, and kits comprised in whole or part of the foregoing, parts and fittings for all the aforesaid goods.