

O/0990/25

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO. 3587255

**IN THE NAME OF FUTURE (AWARDS AND QUALIFICATIONS) LIMITED
IN RESPECT OF THE TRADE MARK**

CERAD

IN CLASS 41

AND

**THE OPPOSITION THERETO UNDER NO. 425171
BY QUALSAFE LIMITED**

Background and pleadings

1. Future (Awards and Qualifications) Limited (“the applicant”) applied to register the trade mark no. 3587255 for the mark CERAD in the UK on 29 January 2021. It was accepted and published in the Trade Marks Journal on 26 March 2021 in respect of the following goods and services:

Class 9: Electronic publications downloadable from the Internet, computer software, computer programs, instructional videos, CD ROMs and DVDs, all relating to the training of paramedic and ambulance personnel.

Class 16: Printed matter, printed publications, books, instructional and teaching material, workbooks, booklets, training aids, manuals, stationery, instructional and reference material, all relating to the training of paramedic and ambulance personnel.

Class 41: Education; training; publication of books, texts, journals and periodicals; arranging and conducting conferences and seminars; provision of correspondence courses; education, instruction and training provided on-line from a computer database or from the Internet; provision of lectures and seminars; all relating to the training of paramedic and ambulance personnel; information, advisory and consultancy services relating to the aforesaid services.

2. On 25 June 2021, Quallsafe Limited (“the opponent”) opposed the trade mark on the basis of sections 3(1)(b), (c) and (d) of the Trade Marks Act 1994 (“the Act”). In respect of section 3(1)(c), the opponent argued that the mark serves in trade to designate the kind, the intended purpose, and other characteristics of the goods and services outlined above. Under section 3(1)(b), it argued that the mark constitutes the recognised acronym for “Certificate in Emergency Response Ambulance Driving” and is therefore not capable of distinguishing one undertaking from another. Under section 3(1)(d), the opponent argued the mark has become customary in the current language and established practices of the trade, being that it is an acronym adopted by trade bodies in the training of ambulance drivers and healthcare staff.

3. The applicant filed a counterstatement denying the claims made. It claimed CERAD is a made-up word and was unknown prior to the applicant devising the same. It also argued it was unknown in the sector prior to this time. Further, it claimed the mark has not been adopted by trade bodies other than those authorised by or associated with the applicant. It therefore argued that CERAD is seen by the trade as denoting the goods and services of the applicant, and it fulfils its function as a trade mark. For the reasons set out, the applicant denied that the application should be rejected under sections 3(1)(b), 3(1)(c) and 3(1)(d) of the Act, and put the opponent to proof of its claims.

4. Both sides filed evidence in the proceedings.

5. A hearing took place on this matter, following which on 30 June 2022, a decision was issued under reference BL O/561/22 (“the first decision”). In that decision, Mr Arran Cooper, acting on behalf of the Registrar, found that the opposition failed in relation to the section 3(1)(d) ground, but succeeded on the section 3(1)(b) and (c) grounds. As a result, the application was refused for all of the goods and services claimed in classes 9, 16 and 41.

6. Following an appeal to the Appointed Person, Mr Phillip Johnson considered and rejected the first decision due to the sequential approach to the assessment of acquired distinctiveness not being deemed appropriate following the hearing officer’s previous assessment and conclusions made based on the evidence filed. As a consequence, in his decision issued on 6 November 2022 under reference BL O/969/22, Mr Johnson allowed the appeal and remitted the case back to the Registrar for reassessment. Given that the original hearing officer had previously rejected the section 3(1)(d) grounds, the Appointed Person made it clear in his decision that remittal back to the Registrar was solely for the purpose of making a fresh determination on the section 3(1)(b) and (c) grounds (and for the evidence submitted to be reconsidered in that context).

7. During the course of the appeal, the applicant had sought to limit its specification to a narrower set of terms in class 41 (whilst remaining within the scope of the original specification), and withdrew the original claim to goods in classes 09 and 16 in its

entirety. The matter was formalised via a supplementary order made by the Appointed Person and issued on 06 November 2022. The order specifies that the application be limited to the following services:

Class 41: Development of qualifications, standards, approval of training providers, quality assurance of training providers, awarding of certificates, assessment and certification services, all relating to the training of paramedics and ambulance personnel.

8. Following the remittal of this decision, a further hearing took place on this matter before a second hearing officer, following which on 28 September 2023, a further decision was issued under BL O/0922/23 (“the second decision”). In that decision, Mr Nathan Abraham, acting on behalf of the Registrar, found that after his fresh consideration of the evidence (and with consideration to the now limited specification above only), the opposition based on section 3(1)(c) and 3(1)(b) failed. As a result, the application was allowed to proceed for all of the services remaining.

9. Following a further appeal to the Appointed Person, Mr Phillip Harris considered and rejected the second decision. In his decision of 7 April 2025 under reference BL O/0328/25, Mr Harris concluded it was not obvious that applicant’s evidence had been considered by the hearing officer when reaching his conclusion, and that the full scope of evidence filed by both the applicant and the opponent must be considered when determining the case.

10. This case has now been remitted for a second time for fresh consideration of the section 3(1)(b) and 3(1)(c) grounds only, and in respect of the limited specification set out above covering services in class 41. Although a further hearing was initially requested by the parties, this request was subsequently retracted in favour of the parties filing written submissions. I therefore make this decision following careful consideration of the papers before me.

11. Both parties are professionally represented in these proceedings. The applicant is represented by IP-Active.com Limited. The opponent is represented by Sonder & Clay.

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

Evidence

13. Due to the nature of this decision, I find it appropriate to summarise the evidence filed by both parties in relative detail below, although I intend to focus on the most relevant information and not outline in detail every single exhibit provided. However, I note for completeness at this stage, that I have reviewed and considered all of the evidence provided. To give context to some statements made in my summary below, I note at this stage that the relevant date in these proceedings is the date the application was filed, that being 29 January 2021.

The opponent's evidence in chief

14. The opponent filed its evidence in the form of a witness statement of Mr Nigel Barraclough, CEO of the opponent. The statement is dated 18 October 2021, and introduces ten exhibits, namely Exhibit NB1 to Exhibit NB10. The statement explains that the opponent has been a "leading" training organisation in the field of pre-hospital care for 20 years. He states that it accredits training courses for a range of healthcare professions, including the qualification of Associate Ambulance Practitioner (AAP). He states that this qualification was created as part of the Governments Apprenticeship reform program, and part of the requirement for this is to complete a "Level 3 Certificate in emergency Response Driving". A page from the website of the Institute for Apprenticeships & Technical Education is provided at Exhibit NB1. This provides an overview of the APP apprenticeship and sets out the requirement for the aforementioned certificate to be achieved as part of the same. The print out itself is dated 13 October 2021, and no specific reference to CERAD is made. Exhibit NB2 provides further details of the AAP qualification, and references a number of NHS Trusts involved in creating the standard.

15. An assessment plan for the AAP qualification is provided at Exhibit NB3. The document provides a copyright date of 2018 at the end of the same. Page 3 of the document provides a table outlining the Phase/Qualification and duration of the same, and one line of this references “Level 3 Emergency Response Driving & Level 2 Award in Ambulance Driving”. On the following page, a pie chart is provided, detailing the duration in percentage terms of each part of the qualification. I note in the key provided below the chart itself, “L3 CERAD” is referenced when referring to a section making up 7% of the same. This corresponds with the total percentage in the table on the previous page made up by the Level 3 Emergency Response Driving & Level 2 Award in Ambulance Driving previously referenced.

16. At page 5 of the document above, it is noted that the Level 4 Associate Ambulance Practitioner apprentice is required to complete the “Level 3 Certificate Emergency Response Driving” as a mandatory qualification, and the range of assessment methods used in respect of the same are also outlined. It is also mentioned at page 9 of the document, that successful apprentices will be awarded the regulated qualification Level 3 Certificate Emergency Response Driving at the end of the course. No further mention of the acronym CERAD appears to have been made.

17. Exhibit NB6 also provides details of the Ambulance Support Worker (Emergency, Urgent and Non-Urgent) “standard”. This document makes reference to “level 3 Certificate in Emergency Response Ambulance Driving”. No use of CERAD is made in the document. The document was approved for delivery on 26 June 2018 and no additional revisions are logged since that date. Exhibit NB7 provides the assessment plan relating to this qualification, again referring to this certificate but not to CERAD itself. This names the certificate as one of the options of mandatory qualifications to choose from to progress and has a copyright date of 2020.

18. Exhibit NB8 provides the Paramedic (Degree) standard, which also references the Level 3 Certificate in Emergency Response Ambulance Driving course as a mandatory qualification, again with no additional reference to CERAD. A log date of the latest change to the “End-point assessment plan” is given as 19 February 2021. Again, an assessment plan for this degree is also provided at Exhibit NB9, and this references

the Level 3 Certificate in Emergency Response Ambulance Driving Course, without reference to CERAD. The document has a copyright date of 2021.

19. Exhibit NB10 provides extracts from various third-party websites offering or referring to CERAD. On three of the six pages provided, CERAD is used next to the full phrase “Certificate in Emergency Response Ambulance Driving”. However, I note the extracts are either undated or provide a date after the filing date of the application.

The applicant’s evidence

20. The applicant filed its evidence in the form of a witness statement in the name of Christopher Young, Director of the applicant. The statement is dated 24 December 2021, and introduces 8 exhibits, those being Exhibit CY1 to Exhibit CY8.

21. Mr Young explains the applicant is recognised by the four UK qualification regulators to deliver regulated qualifications. Exhibit CY1 provides an extract from the government website for Ofqual which sets out the role of awarding organisations such as the applicant. This explains these organisations design, develop and deliver awards and qualifications.

22. Mr Young explains the applicant was approached by the Driver Training Advisory Group (“DTAG”) in 2013 and asked to develop a regulated qualification for ambulance drivers in emergency response situations. This is evidenced at Exhibit CY2, which provides a letter to this effect, and references “Level 3 Award in Emergency Ambulance Driving”. The letter is headed South Western Ambulance Service NHS, and Mr Young explains it was from the head of Driver Training and Development at the same, and a member of DTAG at the time. This is followed at the same exhibit by a page from the Ofqual register referencing this qualification as FAQ Level 3 Certificate in Emergency Ambulance Driving, which Mr Young shortens in his statement to the “CEAD” qualification, although it does not appear to be shortened to such on the document itself.

23. Mr Young goes on to explain that in 2015, the applicant went on to develop a new qualification to replace CEAD, which they named the Level 3 Certificate in Emergency

Response Ambulance Driving. Mr Young shortens this in his statement to the CERAD qualification and explains CERAD has been used to refer to the same internally since its development, and that as the qualification became more widely known, CERAD was also being used by its customers within the field of ambulance driver training. Mr Young explains this new qualification was approved by Ofqual in 2015, and details of it showing on the Ofqual register are provided at Exhibit CY4. I note the use of CERAD itself does not feature on the Ofqual register.

24. Mr Young explains that training for the CERAD qualification is carried out by organisations approved by the applicant only. Exhibit CY5 firstly provides pages from the applicant's website, referring to the "Certificate in Emergency Response Ambulance Driving (CERAD™)". The page explains that this has been developed to meet the requirements of NHS Ambulance Trusts, and notes it is a qualification that meets the requirements for ambulance drivers to claim exemptions under the road traffic act¹. Later down the page, it is states that "CERAD™ is a trademark of Future (Awards and Qualifications) Ltd". This page is undated.

25. Following the above also at Exhibit CY5 are pages not unlike those provided at the opponent's Exhibit NB10. These pages show third parties offering the Level 3 Certificate in Emergency Response Ambulance Driving, which is referred to on a number of those pages as CERAD or L3 CERAD. On several of the pages provided, CERAD is used either next to, in close proximity to, or on the same page as the full phrase Certificate in Emergency Response Ambulance Driving. I also note most (but not all) of the pages provided make reference to the applicant, either referring to it as the awarding/accrediting body for the qualification, the party responsible for developing the same, or by reference to the "FutureQuals Emergency Response Ambulance Driving CERAD" or similar. One page from the CMS Central Medical Services website refers to "Level 3 Certificate in Emergency Response Ambulance Driving CERAD". Underneath this header, the page reads:

"The FAQ Level 3 Certificate in Emergency Response Ambulance Driving has been developed to meet the core requirements of NHS Ambulance Trusts for

¹ The full name of the Act is not given.

learners working or intending to work as emergency ambulance clinical practitioners and emergency care support staff. This qualification meets the requirement for ambulance service drivers to claim exemptions under the road traffic act and to operate to the specification of the high speed driver training regulations of the Department for Transport.”

26. The page referenced above has a copyright date of 2020, however, I note most of the pages provided at this exhibit are undated, although one site provides a testimonial referring to the completion of the L3 CERAD in Feb/March 2021, not long after the relevant date. One page from the St John Ambulance website, seemingly from just after the relevant date in May 2021, uses CERAD in a number of paragraph headings, such as “What is the CERAD course?”, “Am I eligible for this CERAD course?” and “How much does the CERAD course cost?”, following its use at the top of the page alongside the full phrase.

27. In his witness statement, Mr Young provides a table showing how many CERAD registrations have been given out each year between 2016 and the end of September 2021. The number is shown to steadily increase each year, with 3803 qualifications given out in 2020 for example, and just under 15,000 given out between 2016 and up until the end of 2020. At paragraph 13 of his witness statement, Mr Young explains:

“Over the period 2016 to 2021 the CERAD qualification offered by FutureQuals was unique in the marketplace and has become very well known, highly regarded and much sought after [...] customers include training organisations who offer the training courses, Ambulance Services who employ the trainees, and trained and trainee personnel.”

28. Exhibit CY6 provides a list from the Ofqual website showing a number of ambulance and emergency driving related qualifications. Exhibit CY7 appears to provide the same information as Exhibit NB2 provided by the opponent.² Exhibit CY8 provides what Mr Young explains are details from the Ofqual website of a competing

² I note in its final written submissions, the applicant highlights these documents are not identical, but it seems there is little material difference between them for the purpose of my assessment.

“Level 3 Certificate in Emergency Response Ambulance Driving” offered by the opponent.

The opponent’s evidence in reply

29. The opponent filed evidence in reply in the form of a further witness statement from Mr Barraclough. This statement introduces a further four exhibits, those being Exhibit NB11 to Exhibit NB15. Exhibits NB11 – NB12 respond to points made by the applicant regarding the competing course offered by the opponent.

30. In his second witness statement, Mr Barraclough states that it is “common practice” for course providers to adopt acronyms to describe a course being offered, and for these to be widely used by providers. Exhibit NB13 provides an example of this relating to a First aid at work (“FAW”) course and an Emergency first aid at work (“EFAW”) course. At Exhibit NB14, Mr Barraclough then provides examples of EFAW courses on offer, and confirms one is accredited by each of the parties. Exhibit NB15 provides similar documents relating to two courses for the Certificate in Assessing Vocational Achievement (“CAVA”), stating again that one course is accredited by the opponent and one by the applicant.

Legislation

Section 3(1)

31. The relevant parts of section 3(1) read:

“3.— Absolute grounds for refusal of registration

(1) The following shall not be registered—

(a) [...]

(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) [...]

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.”.

Relevant public

32. The Court of Justice of the European Union (“CJEU”) has examined the question of the relevant public for the purposes of trade mark law. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04. The court found that:

“In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for.”

33. The court had earlier addressed the significance of the trade’s perception of trade marks in more detail in *Björnekulla Fruktindustrier AB v Procordia Food AB*, Case C-371/02, where the court found that:

“24. In general, the perception of consumers or end users will play a decisive role. The whole aim of the commercialisation process is the purchase of the product by those persons and the role of the intermediary consists as much in detecting and anticipating the demand for that product as in increasing or directing it.

25. Accordingly, the relevant circles comprise principally consumers and end users. However, depending on the features of the product market concerned,

the influence of intermediaries on decisions to purchase, and thus their perception of the trade mark, must also be taken into consideration.”

34. In this instance, both parties appear to be in agreement that the relevant public will include both training providers and a subset of the general public looking to receive training/education or certificates, particularly in the field of paramedics or ambulance personnel. The opponent submits the level of attention will vary from average (for the general public) to higher than average for training providers. On the other hand, the applicant submits that the cost of the courses is relatively high as shown in the evidence as between £2435 - £2995, and as a result, the consumer will attend a training course and achieve a significant qualification. They therefore submit that the level of attention will be higher than average.

35. I accept the parties’ interpretation of the relevant public in this instance and agree the services will be used by both groups outlined. It is in my view, likely the level of attention paid to the services will be above average for both groups, but I note at this stage that the level of attention paid is not particularly relevant to my assessment of whether the mark is descriptive or non-distinctive.

Section 3(1)(c)

36. I will begin with the examination of the trade mark under section 3(1)(c) of the Act.

37. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 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 (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , 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 (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that 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 (*Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779*, paragraph 35, and *Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-1619*, paragraph 38). 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 (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 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, in Article 7(1)(c) of Regulation No 40/94 , 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 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.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 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. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 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 (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods

or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

38. In its submissions, the opponent has set out two parts to its argument. The first is that the contested mark CERAD will be recognised as an acronym for Certificate in Emergency Response Ambulance Driving. The second is that the term Certificate in Emergency Response Ambulance Driving itself is “plainly a reference to a “qualification”, “standard”, and “certificate” relating to the training of paramedics and ambulance personnel” and therefore designates the kind and/or intended purpose of the services.

39. The applicant submits that I must first determine whether CERAD is inherently descriptive. The applicant’s position is that it is not. It then submits that CERAD was not recognised as an acronym prior to its origination with the applicant. It submits there is no evidence of it being used in relation to the relevant services by other traders prior to the filing date of the application, and there is no evidence provided of CERAD appearing in any dictionaries or technical reference books. The applicant concludes that the evidence provided simply shows use of CERAD as a trade mark, and that the opponent has failed to show this would have been recognised by the average consumer as an acronym at the filing date.

40. I note at this stage that there is some dispute between the parties in the final written submissions about the relevance of various case law referring to neologisms.³ I find this to be relevant to the extent that I accept the principle that the coining of a term by a party does not mean it cannot be considered descriptive will also apply to this case, and on this basis I will say no more about the applicant’s argument that CERAD was not used prior to its origination with the applicant, or that it does not appear in technical reference books or dictionaries.

³ Cases including *Wirex Ltd v Cryptocarbon Global Ltd* [2021] and *Leonard & Ellis’s Trade Mark* ((1884) 26 Ch D 288 ‘Vaseline’ are discussed by the parties.

41. In my view it is apparent the word CERAD in and of itself, and without consideration to the evidence provided, is not inherently descriptive of the relevant services. Without evidence on the point, it would in my view be considered an entirely made up word, which in turn would hold the requisite level of distinctiveness to achieve registration. In order to fall foul of section 3(1)(c), the evidence must therefore show that the relevant public had come to consider CERAD as an acronym denoting a descriptive expression at the relevant date.⁴

42. Next, I move on to consider the phrase which CERAD is claimed by the opponent to denote. That is, by all accounts, “Certificate in Emergency Response Ambulance Driving”. I consider the direct meaning of this phrase to be of a physical or digital certificate representing the completion by an individual of a level of training or the achievement of a particular standard of emergency response ambulance driving. More generally, it describes a qualification or standard awarded to an individual in the field of emergency response ambulance driving. I remind myself at this stage that the services in question are as follows:

Class 41: Development of qualifications, standards, approval of training providers, quality assurance of training providers, awarding of certificates, assessment and certification services, all relating to the training of paramedics and ambulance personnel.

43. Whilst I note that none of the services above are physical or digital certificates per se, the phrase is clearly indicative of the kind and/or purpose of the services above, that being for the development and awarding of these particular certificates and the certification services for such, as well as the approval and quality assurance of training providers offering the relevant courses or assessments required to achieve the certificate described. Further, even if I am wrong about the phrase being directly descriptive for all of the services, it is my view that any outlying services are so closely allied with those for which the phrase is directly descriptive, that it would be unrealistic to treat it as descriptive for some of these services and not the others.⁵

⁴ See T-16/02 *Audi v OHIM* [2003] ECR II5167

⁵ See *Fourneaux De France Trade Mark*, Case BL-O/240/02

44. Further, I note at this stage that the applicant does not appear to put forward any particular argument relating to why this should not be considered a descriptive phrase for the services, focusing instead on its position that CERAD would not be considered or known as an acronym for the same. Whilst I note the point made in Mr Young's statement and the evidence relating to his position that other phrases can also be used to indicate training courses and qualifications related to ambulance driving, this does persuade me that Certificate in Emergency Response Ambulance Driving is itself not descriptive in the context of the services. It is well established that the fact an alternative may be used does not imbue a phrase or expression with distinctive character. As there is nothing material to sway me from my conclusion on this point, I find the aforementioned phrase to be descriptive in respect of all of the services applied for.

45. I now move on to what I consider to be the key issue in this decision, and that is whether the evidence shows that the relevant public had been educated to view CERAD as an acronym for the descriptive phrase Certificate in Emergency Response Ambulance Driving, or alternatively, whether this appears to be 1) an arbitrary string of letters with no particular meaning and/or 2) distinctive of services stemming from the applicant only. I remind myself that it is the filing date of the application, that being 29 January 2021, that is relevant, whilst keeping in mind that section 3(1)(c) is forward looking.⁶ It is at this point that further consideration of the evidence is required. Whilst the opponent has provided evidence in support of its own case, and the applicant has provided evidence in support of its own case, I must conduct an assessment based on the evidence provided as a whole. Should one party's evidence of fact support the opposing side's case, this must nonetheless be considered in reaching my conclusion.

46. With reference to my evidence summary, I note the applicant's position is that it created the Certificate in Emergency Response Ambulance Driving in 2015. It is clear from the evidence that the qualification provided is a regulated one, created at the request of Driver Training Advisory Group, supported by various NHS trusts, regulated

⁶ This means even if a mark is not in use descriptively at the relevant date, I may consider in the context of this ground whether it is capable of being used descriptively in future.

by various regulators including Ofqual and offered by a number of approved third party training providers. It is also clear that the achievement of a certain standard, either through the completion of the certificate or a similar one, is required as part of broader qualifications or apprenticeships, in the field of ambulance driving and paramedics, and it meets the requirement for ambulance service drivers to claim exemptions under the road traffic act.

47. It is also established in the applicant's evidence that CERAD has always been used internally by the applicant to describe the certificate,⁷ and that as it became well known, it was also used by its customers (those being members of the relevant public). I also note Mr Young's statement that between 2016 – 2021, the CERAD qualification became very well-known, highly regarded and much sought after, again indicating it was known to the relevant public either seeking to offer or seeking to achieve this qualification at the relevant date. Further, I note that CERAD is used consistently by third parties offering this certificate (those third parties being training providers and therefore members of the relevant public), and it is frequently used by those parties alongside the full expression it is said to represent, meaning it will also be viewed in this way by the subset of the general public also included within the relevant public. I consider that much of, but not all the evidence showing third parties using CERAD is either undated or dated after the relevant date, however, I also note this evidence has been provided by Mr Young for the applicant as "...examples of how the CERAD qualification is marketed by ourselves and private training organisations". Further, I note the applicant's statement provided within its final written submissions as follows:

"While these printouts may be regarded strictly as of no or limited value in terms of showing how the mark CERAD was perceived by the Average Consumer at the Filing Date, we suggest that they do indicate how the mark CERAD was being used shortly after the Filing Date and thus may cast light on use on or before the Filing Date."

48. Later, the applicant goes on to submit:

⁷ I note internal use will not influence the perception of the relevant public.

“Although the samples are undated or were taken after the Filing Date, they were taken relatively close to the Filing Date, with one having a date of Feb/Mar 2021 [CY/Tab 21/p9]. Since all but one have been taken from the websites of third parties showing use by the party concerned, we submit that it would have been difficult for all of these examples to have been changed or influenced in the light of the present case.”

49. The applicant then goes on to assess what these documents show alongside submissions in support of its own position. The opponent shares the applicant’s sentiment above, stating in its own submissions that the undated documents or documents showing dates after the relevant date cast light on the perceptions of the relevant public prior to the relevant date. I therefore find that, considering the circumstances of the case and the parties’ position on this point, I can consider the undated and later dated evidence as indicative of the likely position at the relevant date. I do also consider the use dated prior to the relevant date, such as on the CMS website with the copyright date of 2020 as below:



The screenshot shows the top navigation bar of the CMS website. The logo for 'CENTRAL MEDICAL SERVICES' is on the left. The navigation menu includes: Home, Emergency & Critical Care, Patient Transport Service, Event Medical, CMS Training, Recruitment, General, and Staff Page. There are also links for 'Log In' and a phone number '0115 857 0999 (24 hours)'. The main heading of the page is 'Level 3 Certificate in Emergency Response Ambulance Driving CERAD'. Below the heading is a paragraph of text: 'The FAQ Level 3 Certificate in Emergency Response Ambulance Driving has been developed to meet the core requirements of NHS Ambulance Trusts for learners working or intending to work as emergency ambulance clinical practitioners and emergency care support staff. This qualification meets the requirement for ambulance service drivers to claim exemptions under the road traffic act and to operate to the specification of the high speed driver training regulations of the Department for Transport.' Below this is another paragraph: 'At CMS we offer the four week course with days including Monday to Thursday, with 10 hour days with fully qualified DERADI instructors to get you to the highest standard required to drive safely and responsibly allowing you to attend emergency callouts on our frontline NHS contracts.' At the bottom of the screenshot is a note: 'Please contact training@centralmedicalservices.co.uk to secure your place!

50. I note at this stage that the examples provided by the applicant all reference the course as being provided by or in association with the applicant (or at least, it is assumed this is what FAQ stands for in the example above). On this point, I note the applicant has submitted that there is a very strong link in the mind of its customers between the course and the applicant. However, it is my view that the evidence simply shows that the particular Certificate in Emergency Response Ambulance Driving, or CERAD course being offered in the examples is either developed or certified by the

applicant. It does not make the phrase itself less descriptive, or the connection between the phrase and the acronym CERAD less apparent. Further, it does not show that members of the relevant public would consider that they may only achieve the Certificate in Emergency Response Ambulance Driving, or CERAD, through the applicant and not through any other provider, or make the phrase or acronym capable of acting as an indication of origin. I also consider again at this stage the opponent's evidence in reply, referencing other qualifications offered firstly under acronyms, and secondly by both the opponent and the applicant. Although I note these examples are limited, I do agree with the point being made that there is no reason for a member of the relevant public to think that Certificate in Emergency Response Ambulance Driving or CERAD may only be offered via one entity. If anything, the reference to the applicant in the evidence shown may simply be considered necessary to indicate which provider is responsible for developing or certifying the certificate in that *particular* case, with the reference being necessary to distinguish the origin of a service indicated by an entirely descriptive phrase.

51. Further, I note the applicant's assessment of the exhibits, and its reference to CERAD sometimes being used alone in the documents. On this point, it is my view that the occasional use of CERAD alone does not detract from the evidence showing use of CERAD alongside the descriptive phrase. Whilst examples of the use of CERAD solus cannot make the opponent's case, it does not show that the relevant public will not understand this in a descriptive sense. It is entirely possible that third party providers may use CERAD solus where they (as members of the relevant public) were already aware of it as an acronym for the full phrase, and/or where they are of the belief that the relevant public at large would have a good awareness of what this stood for. Further, use of CERAD further down on pages where it has been used alongside the descriptive phrase further up the page is even less convincing, as by that point in the document, the consumer has already been made aware of what the acronym used stands for.

52. I also consider in more detail at this stage the document provided by both the opponent and the applicant in these proceedings, comprising the Level 4 Associate Ambulance Practitioner Assessment Plan. Mr Young for the applicant highlights in his evidence that this makes reference to "Level 3 Emergency Response Driving", rather

than using the full phrase, Certificate in Emergency Response Ambulance Driving. However, below this in the document, as is pointed out by Mr Barraclough, L3 CERAD is used to signify this on the pie chart provided. The document is dated 2018. With reference to this document, the applicant argues:

“We submit that a reader of these documents, who would potentially be an Average Consumer, might realise that the term L3 CERAD relates in some way to a qualification, since that is the context of the document. However, from this document, if the reader compared the pie chart to the table, he/she would realise that CERAD is not an acronym of “Emergency Response Driving”. He/she might wonder if CERAD is an acronym, but is given no information in this respect in these documents. Or, equally, he/she might wonder if CERAD is a made-up word which is being used as a user-friendly and memorable name (ie a distinctive trade mark) to denote the L3 Emergency Response Driving qualification or something similar to it.”

53. The applicant then goes on to submit:

“28. What these documents do show is that:

- a. The mark CERAD was in use in 2018;
- b. The mark CERAD was being used in 2018 independently and on its own without explanation;
- c. The mark CERAD was sufficiently well known in 2018 as to be included in an industry standard published by a third party, The Association of Ambulance Chief Executives.

29. We submit that, far from showing that the mark CERAD was known as an acronym for the wording “Certificate in Emergency Response Ambulance Driving” (“the Wording”) the documents at [NB3/Tab 5] and [CY7/Tab 27] instead would lead an Average Consumer to think of the mark CERAD as a distinctive and original trade mark.”

54. I do agree that the Level 4 Associate Ambulance Practitioner Assessment Plan references CERAD when referring to emergency response driving without using the full phrase Certificate in Emergency Response Ambulance Driving, and therefore does not assist in educating training providers or other members of the relevant public about what the acronym means. However, whilst I again therefore do not consider this evidence particularly supports the opponent's case, I also do not find it undermines it when considered in the context of the evidence as a whole. The fact CERAD is not linked to the full phrase in the document, does not show the relevant public had not been educated via other means to understand CERAD as a reference to the full phrase by the relevant date, although I remind myself that it is of course the opponent's case that must be proved in the evidence, and not the applicant's case.

55. I note the evidence, particularly that provided by the opponent, is fairly limited. I do not find any one single piece of evidence to be convincing in and of itself. However, I consider what the sum of the evidence from both parties shows. The fact CERAD was used to refer to the Level 3 Certificate in Emergency Response Ambulance Driving by the applicant since its creation in 2015 and that it was soon being used by its customers, those being members of the relevant public, is in my view, significant. I consider the figures showing that four training providers had offered the course to nearly (and at least) 15,000 individuals in the field by the relevant date. I also note that as shown in the evidence, third party providers were offering this certificate with reference to CERAD next to the full phrase prior to the relevant date. Considering the evidence as a whole, it seems to me on balance that it would be unrealistic to find that the relevant public would not, at the relevant date, have understood CERAD as an acronym for Certificate in Emergency Response Ambulance Driving, considering its use by the applicant and as such its customers including its training providers prior to that time. It seems fairly implausible, in view of the evidence provided, to state that the CERAD was very well known, highly regarded and sought after by the relevant public, but that the same public did not understand that it was an acronym that stood for the Certificate in Emergency Response Ambulance Driving rather than a distinctive trade mark, despite this being used in conjunction with the phrase by the members of the relevant public, offering the qualification course to other members of the relevant public.

56. With consideration to the underlying objective of section 3(1)(c) of the Act, that is to ensure descriptive terms remain free for use by all traders, it is my view that the opposition based on this ground must succeed. The application should remain free for use by other traders in respect of the services applied for.

Section 3(1)(b)

57. The objective of section 3(1)(b) is to prevent marks that are incapable of serving to identify goods or services derive from a single origin from being registered as trade marks.

58. Whilst I recognise that section 3(1)(b) and section 3(1)(c) are independent of each other and have different general interests, where a mark meets the criteria for a successful objection under section 3(1)(c), it follows it will also be devoid of distinctive character for the purposes of section 3(1)(b). Sitting as the Appointed Person in *Combi Steam*, BL O/363/09, Ms Anna Carboni set this out as follows:

“If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): Case C-363/99 *Koninklijke KPN Nederland BV v Benelux Merkenbureau (POSTKANTOOR)* [2004] ETMR 57 (ECJ) at [86].”

59. The opposition under section 3(1)(b) of the Act therefore succeeds.

Acquired Distinctiveness

60. The provisions of section 3(1) allow for circumstances in which a mark which is prima facie objectionable for being descriptive/non-distinctive may still be granted registration where it has acquired distinctiveness by the relevant date. As discussed above, the applicant has filed evidence of use in this case, in an attempt to show that the relevant public has come to associate the sign CERAD with the applicant (as opposed to third parties). However, for the reasons I have already given above, I consider the use by the applicant to be supportive of a finding that the sign CERAD is

descriptive/non-distinctive; as such that use cannot possibly demonstrate that the mark has acquired distinctiveness. As Mr Philip Johnson put it, sitting as the Appointed Person considering the first appeal in these opposition proceedings:

“In other words, once the Hearing Officer had considered each piece of evidence and concluded that on balance the evidence showed that the relevant public saw the sign CERAD as descriptive that should have been the end of it. The same evidence could not then show that in fact the relevant public came to associate CERAD with the Appellant and only the Appellant. Such a conclusion would be a nonsense as it would mean the relevant public would be seeing the same use as both descriptive *and* distinctive at the same time.”

CONCLUSION

61. The opposition has succeeded in its entirety. Subject to any successful appeal, the application will be refused in its entirety, in respect of all remaining services.

COSTS

62. This decision is the third first instance decision to be issued in this case. The case was most recently remitted to the Registry by Mr Philip Harris sitting as the Appointed Person. Mr Harris made the following statement on costs:

“36. The position on costs is becoming somewhat complex, given the “see-saw” in the parties’ respective fortunes at each stage of this process (this being the fourth such stage with, almost certainly, a fifth to follow at least). Even though the Opponent has been successful in this appeal it may still be unsuccessful going forward. I award the Opponent £3000 towards its costs but will leave it to the Hearing Officer who re-hears the matter to determine the final allocation of costs depending on which party is ultimately successful.”

63. The opponent has also been successful in this decision and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £3550 as a contribution towards the cost of the proceedings. This figure takes into

account the costs awarded to the opponent by the Appointed Person in respect of the proceedings so far, as well as costs for preparing and filing its final written submissions within this decision. The sum is calculated as follows:

Cost award granted by the Appointed Person in the most recent appeal: £3000

Preparing and filing final written submissions: £550

Total £3550

64. I therefore order Future (Awards and Qualifications) Limited to pay Qualsafe Limited the sum of £3550. The above sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of October 2025

**R. Le Breton
For the Registrar**