

**O/1186/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER 4033904**

**IN THE NAME OF PERFORMANCE LABS PTE. LTD.**

**TO REGISTER THE FOLLOWING TRADE MARK:**

**UNICITY**

**IN CLASSES 30, 32 & 41**

**AND**

**THE OPPOSITION THERETO UNDER NUMBER 449657**

**BY EDEX – EDUCATIONAL EXCELLENCE CORPORATION LIMITED**

## Background and pleadings

1. On 2 April 2024, Performance Labs Pte. Ltd. (“the applicant”) applied to register the trade mark “UNICITY” in the UK. It claims priority from an earlier EU trade mark, filing number 018935049, which was filed on 9 October 2023. The following goods are opposed in these proceedings:

*Class 41: Arranging and conducting training courses; arranging and conducting of workshops; educational and training services; health and wellness training; arranging and conducting of conferences and seminars; publishing, reporting and writing of texts; electronic publishing services; providing online electronic publications; entertainment, arranging and conducting of webinars.*

2. On 16 September 2024, EDEX – Educational Excellence Corporation Limited (“the opponent”) opposed the trade mark based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier UK comparable trade mark and its international registration designating the UK:<sup>1</sup>

### 1. UNIC

UK registration number: UK00916468068

Filing date: 14 March 2017

Registration date: 4 July 2017

*(“the opponent’s earlier ‘068 registration”)*

The following goods are relied on for this opposition:

*Class 41 - publishing and reporting; translation and interpretation; education, entertainment and sport services; education, entertainment and sports.*

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

## 2. UNIC

International Registration designating the UK under no.: 1385116

International registration date: 6 October 2017

Date designated for protection in the UK: 6 October 2017

Date protection granted in the UK: 21 June 2018

*("the opponent's earlier '116 registration")*

The following goods are relied on for this opposition:

*Class 41 - University services; providing of education; training provision; teaching services; distance learning services; correspondence courses; e-learning; publishing services; training services; education information services; entertainment; sporting and cultural activities; arranging of seminars.*

3. By virtue of their earlier filing dates, the opponent's above registrations constitute earlier marks in accordance with section 6 of the Act. As the opponent's earlier '068 and '116 registrations had been registered for more than five years before the filing date of the applicant's mark, they are, in principle, subject to the use provisions set out in section 6A of the Act. In its submissions in lieu, the opponent submits that it has used the marks for "a range of relevant services in class 41".

4. Under section 5(2)(b), the opponent claims that the respective goods and services are identical and that the marks are similar. As such, the opponent submits there will be a likelihood of confusion between the marks.

5. The applicant filed a counterstatement in which they concede that the marks have a low visual similarity and the goods and services are similar but deny that there is any prospect of confusion. The applicant requested the opponent to file proof of use for the opponent's earlier registrations relied upon.

6. The opponent filed evidence but the applicant did not. Both parties filed submissions in lieu. No hearing was requested and so this decision is taken following a careful perusal of the papers.

7. The opponent is represented by Purdy Smith. The applicant is represented by J A Kemp LLP.

8. 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**

9. The opponent's evidence was filed in the form of four witness statements, all dated 11 February 2025. These were filed by Kyriakoulla Michaelidou, Lecturer at the University of Nicosia; Nicolas Ioannides, Director of Academic Affairs of the University of Nicosia; Hazal Aripinar, Business Development and Enrolment Manager of Institute for the Future of the University of Nicosia; and Demetrios Panayiotou, Digital Marketing Manager at the University of Nicosia. In Ms Michaelidou's witness statement, it is stated that EDEX – Educational Excellence Corporation Limited, the opponent, owns the University of Nicosia (UNIC).

10. The witness statements introduce thirty five exhibits labelled KM1 to KM23, NI1 to NI2, HA1 to HA2 and DP1 to DP8. The purpose of the evidence is to address the applicant's request for the opponent to show proof of use for the opponent's earlier '068 and '116 registrations.

11. I do not intend to summarise the evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

## **Decision**

### **Relevant period**

12. The opponent's earlier '126 mark was registered on 4 July 2017 and its earlier '116 mark on 6 October 2017. The priority date of the contested mark is 9 October 2023. As previously set out, as the earlier marks had been registered for more than five years on the priority date of the contested application, Section 6A of the Act applies. It states:

“(1) This Section applies where—

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

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

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

13. As one of the earlier marks is a comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the “five-year period”) has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

14. The relevant period for proof of use of the opponent’s marks is from 10 October 2018 to 9 October 2023. I note that the relevant territory will be considered the EU (including the UK) from 10 October 2018 to 31 December 2020, and the UK only from 1 January 2021 to 9 October 2023.

## **PROOF OF USE**

### **Relevant case law**

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

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

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services;

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

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

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

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

‘19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. [...]

22. [...] it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal [...] comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

16. Proven use of a mark which fails to establish that “the commercial exploitation of the marks is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

### **Genuine use**

17. In the opponent’s first witness statement, Ms Michaelidou states that UNIC is the largest university that teaches primarily in English in Southern Europe. Exhibit KM1 includes a “mini UNIC prospectus” for the academic year 2021/22, showing the variety of programmes offered at the university, including professional training courses. Exhibit KM2 includes a screenshot of the Times Higher Education website stating that the majority of UNIC students come from outside Cyprus. Ms Michaelidou states that the UK was the fourth most popular country of origin for UNIC students, as shown in the UNIC prospectuses in Exhibits KM3 and KM4. These prospectuses also have a

freephone UK telephone number for enquiries, which Ms Michaelidou states shows the importance of the UK as a source of students. Exhibit KM5 is a screenshot of a webpage showing that the UK was the most popular destination for UNIC medical school graduates between 2015 and 2021. I note that this shows that consumers of services under the mark subsequently travelled to the UK for work; it does not show whether those consumers were UK consumers at the time of purchasing the services. Ms Michaelidou states that UNIC's website is only available in English and Greek, as shown in Exhibit KM16, and that its social media accounts have posts made primarily in English and available to a UK audience, examples of which are shown in Exhibit KM17. Exhibits KM6 to KM8 include quotes from students about their studies at UNIC. Exhibits KM9 to KM11 include information about UK-based organisations that UNIC has links with and Exhibits KM12 to KM15 detail UNIC's involvement in research. UNIC website is Exhibit KM18 contains targeted search engine advertisements that Ms Michaelidou states were targeted at a UK audience. Ms Michaelidou further states that the main campus of the University of Nicosia is commonly referred to as "UNIC CITY" or "UNIC City". A range of exhibits demonstrate this use, both in written text and in photographs of signage. Exhibits KM19 and KM20 include printouts from UNIC's website and KM21 includes a guide to "UNIC CITY", the university campus. A social media post about "UNIC CITY" is also provided in Exhibit KM22. Exhibit KM23 includes a printout from 'Intercollege' website, a third-party that is stated to be affiliated with the University of Nicosia. This printout includes success stories from previous students of UNIC, information about various programmes of study offered and news from UNIC.

18. In the opponent's second witness statement, Mr Ioannides states that from 2018 to 2023, a total of 531 students from the UK were registered in academic programmes of study across all eight schools at the University of Nicosia. Exhibit NI1 is a screenshot of a webpage showing the eight schools. Mr Ioannides further states that this number of students is "very significant in the context of private universities" and that the UK is one of the University of Nicosia's most important international markets. He states that, in the Fall Semester of 2022, the University of Nicosia had a total of 12,619 students registered in academic programmes. Exhibit NI2 is a screenshot of a webpage showing that 3760 students were enrolled at the University of Buckingham in the academic year of 2022/23. Mr Ioannides states that the University of Buckingham is

the oldest private university in the UK and that this data shows that the University of Nicosia is large for a private university.

19. In the opponent's third witness statement, Ms Aripinar states that UNIC offers massive open online courses ("MOOCs") as well as academic programs. Exhibit HA1 includes a screenshot of UNIC's website showing a "Free MOOC" about blockchain and digital currency. Exhibit HA2 includes a screenshot of the enrolment page for said course. Ms Aripinar states that, in the five years prior to 8<sup>th</sup> August 2023, 1,952 people from the UK enrolled onto the course.

20. In the opponent's fourth witness statement, Mr Panayiotou states that the digital marketing expenditure in the UK through Google Ads and social media for the period 1 January 2019 to 31 July 2024 amounted to a total of €377,840.20. I note that this period starts after and ends earlier than the relevant period, which is 10 October 2018 to 9 October 2023. Mr Panayiotou provides seven exhibits, DP2 to DP8, which include spreadsheets detailing the total expenditure per year for advertising campaigns through Twitter/X. I note that the yearly expenditure for the year 2024 is not significantly higher than for the other years, so it would be reasonable to conclude that a significant proportion of the given total was spent within the relevant period.

21. An assessment of genuine use is a global assessment, which includes looking at the evidence as a whole.<sup>2</sup> The evidence presented demonstrates that, even where not undertaken in the UK, university courses bearing the opponent's mark were targeted at UK consumers during the relevant period, and were undertaken by a significant number of consumers in the UK. I consider this use to be shown in the UK, despite the fact that the services themselves are provided outside of the UK.<sup>3</sup> The evidence further demonstrates that a free online course has been undertaken by a large number of people in the UK throughout the relevant period.<sup>4</sup> Taking all of the evidence into account, I am satisfied that the opponent has shown genuine use of its mark on university services, including in-person and online courses and training courses.

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<sup>2</sup> *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T-415/09

<sup>3</sup> *Standard International Management LLC v EUIPO*, T-768/20, EU:T:2022:458

<sup>4</sup> *Lifestyle Equities CV and another (Respondents) v Amazon UK Services Ltd and others* [2024] UKSC 8, at [24] to [31] provides a list of principles concerning whether the accessibility of intellectual property on websites counts as the use of said intellectual property in the UK, which I have taken into account.

## **Fair specification**

22. Having reached the above conclusion, I must determine a fair specification upon which the opponent is entitled to rely, bearing in mind the use that has been demonstrated.

23. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

24. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

25. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

26. Having reviewed the evidence, I am satisfied that the use of the marks has been established for university services, including in-person and online courses and training courses. I am therefore satisfied that genuine use has been shown for the opponent’s ‘university services; providing of education; training provision; teaching services; distance learning services; correspondence courses; e-learning; training services; education information services’.

27. The opponent’s specification includes ‘education, entertainment and sport services’ and ‘education, entertainment and sport’. Although I am satisfied that use has been shown for education services and education, I have not been shown any

evidence relating to entertainment and sport services. As such, I am satisfied that genuine use has been shown for 'education services' and 'education'.

28. I do not consider the opponent to have shown genuine use in relation to the following services:

For the opponent's earlier '068 registration:

*Class 41: Publishing and reporting; translation and interpretation; entertainment and sport services; entertainment and sport.*

For the opponent's earlier '116 registration:

*Class 41: Publishing services; entertainment, sporting and cultural activities; arranging of seminars.*

29. As such, fair specifications for the earlier marks are as follows:

1. UNIC

*(the opponent's earlier '068 registration)*

Class 41: Education services; education.

2. **UNIC**

*("the opponent's earlier '116 registration")*

Class 41: University services; providing of education; training provision; teaching services; distance learning services; correspondence courses; e-learning; training services; education information services.

### **Section 5(2)(b)**

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

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

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

## **Section 5A**

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

## **The principles**

32. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 C120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### The principles

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of services**

33. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

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

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

- a. The respective uses of the respective goods or services;
- b. The respective users of the respective goods or services;
- c. The physical nature of the goods or acts of service;
- d. The respective trade channels through which the goods or services reach the market;
- e. In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- f. The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

35. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

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

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

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

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

37. Further, in *Kurt Hesse v OHIM*,<sup>5</sup> the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*,<sup>6</sup> the GC stated that “complementary” means:

“...there is close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

38. With this in mind, the services for comparison are as follows:

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<sup>5</sup> Case C-50/15 P

<sup>6</sup> Case T-325/06

<b>Opponent's services:</b>	<b>Applicant's contested services:</b>
<p>For the opponent's earlier '068 registration:</p> <p><i>Class 41: education services; education.</i></p> <p>For the opponent's earlier '116 registration:</p> <p><i>Class 41: university services; providing of education; training provision; teaching services; distance learning services; correspondence courses; e-learning; training services; education information services.</i></p>	<p><i>Class 41: arranging and conducting training courses; arranging and conducting of workshops; educational and training services; health and wellness training; arranging and conducting of conferences and seminars; publishing, reporting and writing of texts; electronic publishing services; providing online electronic publications; entertainment; arranging and conducting of webinars.</i></p>

*Arranging and conducting of workshops; arranging and conducting of conferences and seminars; arranging and conducting of webinars; providing online electronic publications*

39. The above services fall within the scope of the opponent's 'education services'. These services are therefore considered identical according to the principles set out in *Meric*.<sup>7</sup>

*Educational [...] services*

40. The above services are identical to the opponent's 'education services'.

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<sup>7</sup> Case T-133/05

*Arranging and conducting training courses; [...] training services; health and wellness training*

41. The above services fall within the scope of the opponent's 'training services'. These services are therefore considered identical according to the principles set out in *Meric*.<sup>8</sup>

*Publishing, reporting and writing of texts; electronic publishing services*

42. The above services are most similar to the opponent's 'education services'. The purpose of the services broadly overlap as both the above services and the opponent's 'education services' have the purpose of educating the user. Users differ as consumers wanting to publish texts are likely to be offering educational services themselves, not seeking them. The nature of the services differs. I consider that trade channels may overlap as it is not unusual for providers of educational services, such as universities, to also be engaged in publication services, such as the publication of academic tests. There is no competition or complementarity between the services. Overall, I find a low level of similarity between the above services and the opponent's 'education services'.

*Entertainment*

43. I do not consider that the ordinary and natural meaning of *entertainment* would include education or vice versa. However, in its pleadings, the applicant admits that there is a degree of similarity between its services and those of the opponent. The purpose and users differ, as does the nature of the services. However, I acknowledge that some educational services may be entertaining, and some entertainment, particularly children's entertainment, may involve a degree of education. Overall, I consider the above services to have a low similarity to the opponent's 'education'.

### **Comparison of marks**

44. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its

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<sup>8</sup> Case T-133/05

various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

45. 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.

46. The respective trade marks are shown below:

The opponent’s earlier marks	The applicant’s contested mark
<p>1. UNIC</p> <p><i>“The opponent’s earlier ‘068 registration”</i></p> <p><b>UNIC</b></p> <p>2.</p> <p><i>“The opponent’s earlier ‘116 registration”</i></p>	<p>UNICITY</p>

47. In its submissions in lieu, the opponent submits that the marks are highly visually similar, have a medium aural similarity and are distinct conceptually.

48. In its counterstatement, the applicant states that the marks are visually similar to a very low degree, and aurally and conceptually distinct.

### *Overall impression*

49. The opponent's earlier '068 registration is a word-only mark consisting of the four letters "UNIC". There are no other elements in the mark, therefore the word plays a dominant role.

50. The opponent's earlier '116 registration is a figurative mark consisting of the four letters "UNIC" in black uppercase lettering. The font appears relatively standard and does not have an impact on the impression of the mark. The word element of this mark is dominant.

51. The contested mark is a word-only mark consisting of the seven letters "UNICITY". There are no other elements in the mark, therefore the word plays a dominant role.

### *Visual comparison*

52. The visual similarity between the marks resides in the first five letters "UNIC" in all the marks. The contested mark contains an additional three letters, "ITY" at the end of the mark.

53. Since the similarities between the marks are at the beginning, they have a larger visual impact than if they were at the end.<sup>9</sup> However, the difference in the ending of the contested mark still acts as a point of visual difference. Overall, I consider that the marks are visually similar to just above a medium degree.

### *Aural comparison*

54. The opponent's earlier marks both consist of the letters "UNIC". Given that this is not a dictionary word, I consider that the average consumer will either read the mark as a word or acronym and therefore will pronounce the marks as "you-nick", although it is possible that some consumers may pronounce the mark as the letters U-N-I-C.

55. The contested mark consists of the letters "UNICITY". In its submissions in lieu, the opponent submits that the contested mark will be pronounced as "YUNIKITY" or "YUNISITY". I consider that the average consumer may view this mark in one of two

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<sup>9</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

ways: firstly, as a single word “unicity” or as the combination of two words “uni”, and “city”. In both scenarios, the mark will be pronounced as “you-nee-sit-ee”. I do not consider that it is likely that the average consumer would pronounce the contested mark with a hard “K” sound as suggested by the opponent as it is not common to pronounce a letter C with a hard k sound when it is placed before the letter I. Although UNICITY is a word that the consumer may not recognise, it is likely that consumers would mirror the pronunciation from common words when deciding how to pronounce the mark.

56. The pronunciation of the marks overlaps in the first syllable, “you” or “U”, but differs where the earlier marks consist of the second syllable “nick”, and the contested mark consists of the second, third and fourth syllables “nee-sit-ee”.

57. Although the first syllables of the marks are identical, and the beginnings of marks tend to have more aural impact, there are significant aural differences between the marks.<sup>10</sup> I consider that the marks are similar to a low degree.

#### *Conceptual comparison*

58. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgements of the GC and the CJEU including *Ruiz Picasso v OHIM*.<sup>11</sup> The assessment must be made from the point of view of the average consumer.

59. The earlier ‘068 and ‘116 marks consist of the letters “UNIC”, which is not an English dictionary word. Due to the mark being short, I do not consider that a significant portion of consumers would divide the mark into sections. As noted above, I consider that most consumers will view these marks as an acronym or word with no apparent meaning. As a result, consumers are likely to attribute no meaning to the earlier marks.

60. The contested mark consists of the letters “UNICITY”. In their submissions in lieu, both parties submit that “unicity” is a dictionary word meaning “the state or quality of being one single or united entity”. However, the opponent submits that this meaning will not be known to the average consumer. I consider that some consumers may

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<sup>10</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

<sup>11</sup> [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

understand this meaning but that most consumers would view the contested mark as an invented word. In either situation, consumers will recognise the prefix “uni” and the word “city”. The prefix “uni” may be recognised by the consumer as meaning one or single. In the context of the relevant services, I also consider that a significant proportion of consumers will attribute this prefix to the word “university”. I note the applicant’s submissions that the suffix “icity” will be understood to form a noun describing the state of being described by the adjective it follows; however, I also consider that a significant portion of consumers would see the word “city” in the mark, and attribute the mark to a place, particularly one associated with a university.

61. Overall, I find no conceptual similarity between the marks.

### **Average consumer and the purchasing act**

62. As the case law above indicates, it is necessary to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

63. The services at issue will be purchased by both the general public and professionals seeking training and education. These will typically be high-cost services, although I appreciate that some education services are available to the general public for free. The services will be infrequently bought, and consideration will be taken of factors such as price and suitability. I consider this group of consumers will pay a slightly higher than average level of attention during the purchasing act.

64. The services at issue will primarily be purchased online where they will be shown on websites, although I do not discount that some services may be purchased in-person from the training provider. I consider that aural considerations will play a role in the purchasing process, as it is likely that consumers will visit the university to find out information about courses and training, during which information will be given both aurally and visually. Guidance may be sought aurally from other students and academic advisors. I also consider that consumers would use brochures and websites to inform their decision. Overall, I consider aural and visual considerations to play a role in the purchasing process.

### **Distinctive character of the earlier trade mark**

65. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

66. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

67. In its submissions in lieu, the opponent submits that the earlier marks have a high level of inherent distinctiveness, which has been enhanced through their use.

68. The earlier marks consist of the letters “UNIC”. As noted above, I consider that this will be viewed by the average consumer as an acronym. The word will have no evident meaning to the average consumer and therefore does not allude to or describe the services at issue. Although the earlier ‘116 registration is a figurative mark, the font used is standard and I do not consider it to have an effect on the distinctiveness of the mark. I am of the view that both earlier marks are inherently distinctive to a high degree.

69. As the opponent has filed evidence of use of their marks, I will consider whether this evidence demonstrates enhanced distinctiveness of the marks. The numbers of students from the UK provided in Mr Ioannides's witness statement appear reasonable but not particularly high. The advertising figures are significant, however no turnover figures are provided. Ms Aripinar's witness statement discloses that a reasonable number of UK consumers have enrolled onto an online course, but I do not consider the numbers significant enough to affect the distinctiveness of the mark. Overall, although I consider that the evidence shows use of the earlier marks, I do not consider that the distinctiveness of the earlier marks has been enhanced to a higher degree than the inherent distinctiveness, which as mentioned is already high.

#### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion**

70. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e., a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods (or services) and vice versa (*Canon* at [17]).

It is necessary to keep in mind the distinctive character of the opponent's trade mark, the average consumer of the goods and the nature of the purchasing act. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind (*Lloyd Schuhfabrik* at [26]).

71. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related.

72. Earlier in this decision, I found that the services to range from having a very low similarity to being identical. I found the marks to have a just above medium visual similarity and a low aural similarity. I found the marks to have no conceptual similarity. I found the opponent's earlier registrations to possess a high level of inherent distinctive character for the relevant services. I identified the average consumer to be members of the general public and professionals, both paying a slightly higher than average degree of attention. I found that the goods would be selected by both aural and visual means.

73. As noted above, the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind (*Lloyd Schuhfabrik* at [26]).

74. Considering direct confusion, I note the similarities between the marks, being the initial four letters "UNIC". However, I consider that the additional three letters "ITY" in the contested mark would not go unnoticed by the average consumer paying an average degree of attention, particularly considering the conceptual differences and the significant aural differences between the marks. Taking all of the above factors into account, I am satisfied that the average consumer would not directly mistake the parties' marks for each other on the applied for goods and services. I therefore do not find there to be a likelihood of direct confusion between the parties' marks for the goods and services.

75. I will proceed to consider whether there is a likelihood of indirect confusion, whilst reminding myself that, as James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16], “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”.

76. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand

extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

77. I do not consider this case to fit neatly into one of the categories set out in *L.A. Sugar* above. However, I remind myself that these are not exhaustive. I also consider the relevance of *Medion vs Thomson*<sup>12</sup> and the subsequent case law. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

"18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the

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<sup>12</sup> Case C-120/04

composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

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

78. I note that I found that the earlier marks have a high degree of distinctive character and I also found that the earlier marks have no apparent meaning. However, I do not consider the four letters “UNIC” to play an independent role in the contested mark. I also do not consider that the consumer would find this string of letters so distinctive that they would conclude that no other entity would use these four letters as part of a longer word.

79. It is possible that a consumer who is aware of the opponent’s earlier mark may note the use of the letters “UNIC” in both marks. However, I do not see any logical reason for the consumer to conclude that the contested mark is another brand or brand extension of the owner of the earlier marks. If any consumers notice the use of the four letters U-N-I-C in both marks, they will simply conclude that this is a coincidence. There is no reason for the consumer to assume that the contested mark is the acronym of the earlier mark with three additional letters on the end.

80. I therefore do not consider there to be a likelihood of indirect confusion in relation to any of the services in question.

### **Final Remarks**

81. The opposition under section 5(2)(b) has been unsuccessful in respect of all of the contested services. Subject to any successful appeal, the application will proceed to be granted protection in the UK.

## **COSTS**

82. The applicant has achieved success in these proceedings and is therefore entitled to a contribution towards its costs. In the circumstances, I award the opponent the sum of £1200 as a contribution towards the cost of the proceedings, in accordance with Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Considering the TM7 and statement of grounds and preparing and filing the TM8 and counterstatement:	£250
Considering the other side's evidence:	£600
Filing submissions in lieu:	£350
<b>Total:</b>	<b>£1200</b>

83. I therefore order EDEX – Educational Excellence Corporation Limited to pay Performance Labs Pte. Ltd. the sum of £1200. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 18<sup>th</sup> day of December 2025**

**K HARBACH**

**For the Registrar**