

O-735-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3322388
BY THE LAUGHTER COMPANY (TLC) LTD TO REGISTER THE TRADE MARK**

TLC Training

IN CLASS 41

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 413786 BY
LEARN SOLUTIONS LIMITED**

BACKGROUND AND PLEADINGS

1) The Laughter Company (TLC) Ltd (hereafter “the applicant”) applied on the 4 July 2018 to register the mark “TLC Training”. It was published for opposition purposes on 20 July 2018 and on 16 January 2019 it filed a Form TM21B to restrict the scope its specification of services. It is the application with its scope as defined by this restricted specification that remains in issue in these proceedings. It reads as follows:

Class 41: *Arranging and conducting competitions; Arranging and conducting of competitions [education or entertainment]; Arranging and conducting of in-person educational forums; Arranging and conducting of workshops and seminars in self-awareness; Arranging of competitions for educational purposes; Arranging of competitions for training purposes; Arranging of educational events; Arranging of festivals for educational purposes; Arranging of festivals for training purposes; Coaching [training]; Conducting of educational events; Conducting workshops and seminars in personal awareness; Conducting workshops and seminars in self awareness; Development of educational materials; Education services relating to health; Education services relating to meditation; Health and wellness training; Organisation of competitions [education and/or entertainment]; Organisation of educational events; Organisation of educational shows; Personnel training; Provision of courses of instruction in self awareness; Provision of training courses in personal development; Residential training courses; Self-awareness courses [instruction]; Team building (education); Written training courses; none of the aforesaid shall apply to education, training, entertainment, sporting or cultural activities for dogs and dog owners; all of the aforesaid services relating to personal development, yoga and laughter based skills but not including any of the aforesaid services provided by schools or relating to hospitality or food or beverages.*

2) Learn Solutions Limited (hereafter “the opponent”) opposes the application. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following mark when challenging the application:

UK Trade Mark No. 3019297



and



(Series of 2 marks)

Filing date: 22 August 2013

Registration date: 22 November 2013

The list of goods:

Class 16: *Paper; stationery; printed publications; instructional and teaching materials (other than apparatus); examination and/or assessment materials; manuals; text books; advertising material*

Class 41: *Academic educational services; instruction and training courses; provision of tuition; academic educational services; instruction and training courses; provision of tuition provided on-line from a computer database or from a global computer network; providing electronic publications on-line from a computer database or from a global computer network; examination services; educational services; design of educational courses, examinations and qualifications; provision of instructional, training, teaching, testing and/or assessment services; provision of correspondence and distance learning courses; arranging, organising and conducting colloquiums, conferences and seminars; publication in both electronic and paper format of instructional, training, teaching, testing, examination and/or assessment materials, including examination papers and syllabuses and materials for the testing of candidates; production and distribution of films, videos and DVDs for educational purposes; information, advisory and consultancy services relating to all the aforesaid services*

3) The opponent's mark is an earlier mark within the meaning of section 6(1) of the Act because it has an earlier filing date than the contested application. It completed

its registration procedures less than five years before the publication date of the contested application and, as a result, it is not subject to the proof of use provisions contained in section 6A of the Act. The consequence of this is that the opponent may rely upon the full list of goods and services contained in its earlier mark.

4) The opponent asserts that registration of the contested application would be contrary to section 5(2)(b) of the Act because the respective marks are similar and in respect of identical goods and services “relating to education”. It contends that, as a result, there is a likelihood of confusion.

5) The applicant filed a counterstatement denying the claims made. Specifically, it denies that the respective goods are similar or identical, or that there is any resemblance between the respective marks. It contends that its mark is used in respect of training involving laughter-based and mindfulness/meditation activities for adults and does not compete with the opponent’s mark.

6) The opponent is represented, in these proceedings, by Keebles LLP. The applicant is not represented.

7) The opponent filed evidence and the applicant filed written submissions. I will refer to these to the extent that I consider it necessary. No hearing was requested. I take this decision after careful consideration of the papers.

Opponent’s Evidence

8) This takes the form of a witness statement by Simon James Barnes, director, shareholder and Chief Executive Officer of the opponent. This evidence identifies the opponent’s activities as being “a tutoring and training business”¹. Mr Barnes refers to the opponent’s website that explains that TLC Live provides “online tutoring, English tutoring, Maths tutoring, Science tutoring and help with preparation for SATs, GCSEs and other important exams”².

¹ Mr Barnes’ witness statement, para 5

² Ditto, para 6

9) Mr Barnes also makes a number of submissions that I will not detail here, but I will keep them in mind.

DECISION

10) 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”.

Comparison of goods and services

11) The parties have both made submissions based upon a comparison of the services they provide under the current business models. However, for the purposes of considering grounds based upon section 5(2), the level of similarity between the parties’ respective goods and services must be based upon the notional and fair use of all the goods and services listed in the respective specifications of goods and services and not just a subset that reflects the current business model. As Kitchen L.J. noted in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220:

“80. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

12) It is for this reason, that I reject the submissions made and I will undertake an analysis of the similarity of the respective goods and services based on all the goods and services included in the opponent’s registration and the contested application.

13) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

14) 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.

15) In addition, I also keep in mind the guidance of the General Court (“the GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, when it 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”

16) When applying the guidance in *Meric*, it is self-evident that the following of the applicant’s services are a subset of, and therefore identical to, the opponent’s broad terms *educational services* and *instruction and training courses*:

...; Arranging and conducting of competitions [education ...]; Arranging and conducting of in-person educational forums; Arranging and conducting of workshops and seminars in self-awareness; Arranging of competitions for educational purposes; Arranging of competitions for training purposes; Arranging of educational events; Arranging of festivals for educational purposes; Arranging of festivals for training purposes; Coaching [training]; Conducting of educational events; Conducting workshops and seminars in personal awareness; Conducting workshops and seminars in self awareness; Development of educational materials; Education services relating to health; Education services relating to meditation; Health and wellness training; Organisation of competitions [education ...]; Organisation of educational events; Organisation of educational shows; Personnel training; Provision of courses of instruction in self awareness; Provision of training courses in personal development; Residential training courses; Self-awareness courses [instruction]; Team building (education); Written training courses; none of the aforesaid shall apply to education, training, entertainment, sporting or cultural activities for dogs and dog owners; all of the aforesaid services relating to personal development, yoga and laughter based skills but not including any of the aforesaid services provided by schools or relating to hospitality or food or beverages.

17) In respect of the applicant’s *arranging and conducting competitions*, this term includes *arranging and conducting of competitions [education ...]* that I have already found to be covered by the opponent’s broad term *educational services*. It follows that this term is also covered and, therefore, the respective services are identical.

18) In respect of the final two terms, namely *arranging and conducting of competitions [... entertainment]* and *organisation of competitions [... entertainment]* these are both restricted to be an entertainment service and therefore, not identical to any of the opponent's various education and training services. In terms of the level of similarity between the respective services, one is for educational purposes, the other for entertainment and, as a result, their purpose is different. However, the opponent's *educational services* includes competitions for educational purposes and, therefore, the respective nature, method of use and even trade channels may overlap. However, because of their different purposes, they are not likely to be in competition and it is not obvious to me that they are complementary "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"³. Taking all of this into account, I conclude that these two terms share a medium level of similarity to the opponent's *educational services*.

19) The opponent also relies upon its Class 16 goods but has not provided any submissions or evidence in support of this claim, and it is not obvious to me how reliance upon such goods can place the opponent any a stronger position than its reliance upon its Class 41 services.

Comparison of marks

20) It is clear from *Sabel BV v. Puma AG*, Case C-251/95 (particularly paragraph 23), Case C-251/95, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its 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

³ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

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.”

21) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take account of 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.

22) The respective marks are:

Opponent's marks	Applicant's mark
	<p data-bbox="1027 1133 1214 1167">TLC Training</p>

23) The opponent's registration consists of a series of two marks that differ only in that one mark is presented in black and white and the other in colour. This difference will not materially affect my considerations because a mark registered in colour is normally considered on the basis that it could be used in any colour⁴ (including the colour of the second mark in the series). Therefore, for convenience, I will restrict my comparison to the opponent's black and white mark.

⁴ see *Specsavers* [2014] EWCA Civ 1294, at para 5 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47

24) In its counterstatement, the applicant asserts that the respective marks are not similar or identical. I note this, but as my comparison below makes clear, the fact that both parties' marks include a "TLC" element, they share similarity. I, therefore, reject the applicant's assertion.

25) The opponent's mark consists of the letters "TLC" and the word "LIVE" conjoined (as emphasised by the difference in the thickness of the font of each) together with a logo of the end of a pencil presented within a round border. All three elements share an approximately equal prominence in the mark, but in terms of distinctiveness the logo and the letters "TLC" will dominate because the word "LIVE" will be perceived as describing or alluding to the way the opponent's services are provided. The applicant's mark consists of the letters "TLC" and the word "Training" presented in ordinary typeface. The "TLC" element is the dominant and distinctive element by virtue of appearing as the first part of the mark and because of the descriptive nature of the word "Training". In respect of the services covered by the contested application, this second element will merely be seen as describing the nature of the services and will, therefore have very little, if any, distinctive character.

26) Visually, both marks share the identical "TLC" element, but they differ in that the opponent's mark also contains a logo. In addition, both marks contain second but different words. Taking these similarities and differences into account, I conclude that the respective marks share a medium level of visual similarity.

27) In its written submissions, the applicant states that its "training will not be referred to as 'TLC' seeing that it is the complete term 'TLC Training' that represents our services". I note this, however, I consider that it is also possible that its mark may be referred to as just "TLC" because the second word "Training" has a descriptive meaning that adds little to identifying the provider of training-type services. Such descriptive words are often not referred to by the average consumer. I also accept that the average consumer may refer to the mark as "TLC Training". As this defence offers the applicant a slightly stronger case, I will consider aural similarity from this perspective.

28) The logo element of the opponent's mark plays no part and its mark is likely to be expressed as the four syllables "TEE-EL-SEE-LIVE". The applicant's mark will share the same first three syllables but will also have the fourth and fifth syllables "TRAIN-ING". Taking this into account, the aural similarity is slightly higher than medium.

29) Conceptually, the common element "TLC" is likely to be perceived as an acronym of unknown meaning. The second word element of both marks, namely, "LIVE" and "Training" respectively are likely to be perceived as descriptive or allusive as discussed in paragraph 24, above. The logo present in the opponent's mark may be perceived as a reference to writing, drawing or similar. Taking all of this into account, I conclude that the respective marks share a medium level of conceptual similarity.

Average consumer and the purchasing act

30) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

31) 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."

32) The relevant average consumer of the respective goods and services is likely to range from an ordinary member of the public (generally adults who may be purchasing services for themselves or for their children) to businesses or other organisations such as schools and colleges wishing to access training and educational services or competitions for entertainment purposes. In respect of the level of care and attention paid during the purchasing act, this is likely to range from average in respect of members of the public obtaining a specific service such as training related to a specific exam, or higher where broad educational services are being procured by an organisation to be delivered to a larger group. In all cases, visual impressions are likely to be important, but I do not ignore that aural considerations may play a part in the purchasing process where the consumer may aurally request the services.

Distinctive character of the earlier trade mark

33) 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).”

34) The opponent makes no claim to an enhanced level of distinctive character acquired through use (as of the relevant date in these proceedings, namely, the filing date of the contested application – 4 July 2018) and provides no evidence beyond general and uncorroborated claims to its mark becoming “its defining brand name” in 2014⁵ and having worked in primary and secondary schools⁶. There is no information provided regarding the scale of its business under the mark, its geographical scope or how or to what extent its services have been promoted. Therefore, I restrict my consideration to its mark’s inherent level of distinctive character. As noted earlier, the mark consists of three elements, a logo, the letters “TLC” and the word “LIVE”. The logo and “TLC” element are both distinctive and impart a medium to high level of inherent distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

35) The following principles are obtained from the decisions of the 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 C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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

⁵ Mr Barnes’ witness statement, para 7

⁶ Ditto, para 8

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.

36) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). These factors must be assessed from the viewpoint of the average consumer who rarely has the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods down to the responsible undertakings being the same or related).

37) I have found that:

- The majority of the respective services are identical;
- In respect of the non-identical services, namely, *arranging and conducting of competitions [... entertainment]* and *organisation of competitions [... entertainment]*, they share a medium level of similarity to the opponent's services;
- The applicant's mark consists of three elements but that its distinctive character resides primarily in the logo element and the "TLC" element. The opponent's mark consists of two elements, but it is the first element "TLC" that is the dominant and distinctive element;
- The respective marks share a medium level of visual and conceptual similarity and a slightly higher than medium level of aural similarity;
- The average consumer consists of both ordinary members of the public and businesses/organisations such as schools and colleges. The degree of care and attention paid during the purchasing act will be average in respect of ordinary members of the public, but higher in respect of businesses/organisations;

- The purchasing process is likely to be visual, but I recognised that aural considerations may play a part;
- The opponent's mark has a medium to high level of inherent distinctive character and that it has not been enhanced through use.

38) Taking account of all of the above, I conclude that the presence of the logo in the opponent's mark is not likely to go unnoticed by the average consumer and, therefore, there is no likelihood of direct confusion where one mark is mistaken for the other. However, I must also consider if there is a likelihood of indirect confusion. The difference between the two types of confusion was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10:

"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.

39) In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

40) Mr Mellor warns against a finding of indirect confusion merely because both marks share a common element. However, in the current case the "TLC" element,

common to both the marks is the dominant and distinctive element of the applicant's mark and is the dominant and distinctive verbal element of the opponent's mark. Whilst the logo element of the opponent's mark will not go unnoticed, neither is it likely to offset the impression created by the "TLC" element that such services are provided by the same or linked undertaking that provides services under the applicant's mark. The position is not impacted to any material extent by the presence of "LIVE" and "Training" respectively in the marks being compared because of their ability to convey a descriptive message. Therefore, taking all of this into account together with my other findings, including the identity of most of the services and the medium level of similarity between the remaining services, I conclude that, when considering the overall impression created by both marks, the average consumer will readily see the identical element "TLC" in both and is likely to perceive this as an indication that the services provided under the respective marks as being provided by the same or linked undertaking.

Summary

41) The opposition succeeds in respect of all of the services claimed and, subject to any successful appeal, the application will be refused in its entirety.

Costs

42) As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent costs as a contribution towards the costs of the proceedings, as follows:

Preparing a statement and considering the applicant's statement (including official fee of £100)	£350
Preparing evidence and considering applicant's submissions	£500
Total	£850

43) I therefore order The Laughter Company (TLC) Limited to pay Learn Solutions Limited the sum of £850. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 3rd day of December 2019

**Mark Bryant
For the Registrar
The Comptroller-General**