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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91201895
Party	Defendant Oxford IPC Worldwide Limited
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Submission	Motion to Suspend for Settlement Discussions
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Date	12/20/2013
Attachments	12-20-13 Motion to Suspend -w-consent.pdf.pdf(112471 bytes) Notification of a Decision - OHIM.PDF(768857 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

In the matter of U.S. Application Serial No. 85155064

Mark: 

THE CHANCELLOR, MASTERS AND SCHOLARS OF THE UNIVERSITY OF OXFORD, Opposer, v. OXFORD IPC WORLDWIDE LTD. Applicant	)	Opposition No.: 91-201895

MOTION FOR SUSPENSION FOR SETTLEMENT WITH CONSENT

WHEREAS, both Applicant and Opposer would like to suspend the Opposition pursuant to section 510.02(a) of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") and section 37 CFR § 2.117(c) in order to await the final disposition in a parallel

litigation which is currently pending before the European Community Trademark Office ("CTM Opposition"). The CTM Opposition is between the same parties and concerns the same trademark and issues as the instant case, albeit with a different jurisdictional scope.

The parties in this case have business interests world-wide. As such, the jurisdiction addressed by the CTM Opposition is relevant to the parties' overall dispute and plays into the worldwide settlement discussions. While both the CTM Opposition and the instant opposition have been pending, the parties have been engaged in attempting to settle their dispute world-wide. Following the parties' preliminary conference settlement discussion, Opposer sent a settlement proposal to Applicant on June 12, 2013. Applicant reviewed and considered the proposal and found it unacceptable. Given this brief impasse, the Parties determined that a decision from OHIM in the CTM Opposition would aid in negotiating a settlement. Each party thus briefed its respective case. Following the briefing, the parties nonetheless continued oral settlement discussions in November.

The instant U.S. matter was part of the negotiations and the parties agreed that it would be more fruitful to continue discussions while awaiting the OHIM decision than to engage in discovery in the U.S. which might be rendered moot by the outcome of the CTM Opposition.

On November 20, 2013, the Community Trademark Office issued its decision. A copy of the CTM Opposition No. 008660284 decision is attached at Exhibit A. The time for an appeal to the CTM Opposition decision is not exhausted.

The parties are currently continuing their negotiations in light of the CTM decision and in light of the potential for an appeal of the CTM decision. The CTM decision is not a final disposition at this time. To this end, Opposer has proposed several possible dates for meetings

following January 1, 2014. The aim of the proposed meeting is for the parties to better understand each other's concerns and understand whether a commercial agreement is possible.

In light of the ongoing negotiations and possible appeal of the CTM Opposition in the event of an unsuccessful meeting between the parties, the parties jointly request a six (6) month suspension of the instant opposition, subject to the right of either party to resume the proceedings. In order to allow continued settlement discussions and for reasons of judicial efficiency in light of the parallel proceeding, the parties respectfully request the Board Grant this motion for suspension.

Applicant has secured the express consent of all other parties to this proceeding for the suspension requested herein. Applicant has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Dated: December 20, 2013

Respectfully submitted,
LOWE HAUPTMAN HAM & BERNER, LLP
/jhg/

Jeffrey H. Greger
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SEEN AND AGREED

Mark Lerner
Satterlee Stephens Burke & Burke LLP
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/marklerner/

Certificate of Service

I hereby certify that a copy of the foregoing Motion for Suspension shall be forwarded to Opposer's currently listed correspondence address and contact information according to the current records as contained in the U.S. Patent and Trademark Office records as appears below, by email pursuant to agreement of counsel on this 20th day of December 2013, to

Mark Lerner
Satterlee Stephens Burke & Burke LLP
230 Park Avenue
New York, NY 10169
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212-404-8714 –Office
212-818-9606-Fax

/jhg/
_____
Jeffrey H. Greger

Exhibit A

OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

OPERATIONS DEPARTMENT

B206b

Notification to the applicant/holder of a decision

Alicante, 20/11/2013

WARD HADAWAY SOLICITORS
Sandgate House 102 Quayside
Newcastle Upon Tyne NE1 3DX
REINO UNIDO

Your reference:	**(C)AS.MXC.OXF001.3**
Opposition number:	**B 001722159**
Contested trade mark number:	**008660284**
Name of the applicant/holder:	**Oxford Leadership Academy Limited**

Please see the attached decision which ends the abovementioned opposition proceedings. It was taken on **20/11/2013.**

Andrea NEWMAN

Enclosures (excluding the cover letter): 13 pages.

Please note that the decisions of the Opposition Division will not be signed by the responsible officials, but will only indicate their full name and carry a printed seal of the Office in accordance with Rule 55(1) CTMIR.

OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Opposition Division

OPPOSITION No B 1 722 159

The Chancellor Masters and Scholars of the University of Oxford, University Offices, Wellington Square, Oxford, Oxfordshire OX1 2JD, United Kingdom (opponent), represented by **Sipara Limited**, Black Horse House, Ground floor, Wallbrook Court, Oxford, OX2 0QS, United Kingdom (professional representative)

a g a i n s t

Oxford Leadership Academy Limited, Oxford Centre for Innovation, Mill Street, Oxford OX2 0JX, United Kingdom (applicant), represented by **Ward Hadaway Solicitors**, Sandgate House 102 Quayside, Newcastle Upon Tyne NE1 3DX, United Kingdom (professional representative).

On 20/11/2013, the Opposition Division takes the following

DECISION:

1. Opposition No B 1 722 159 is rejected in its entirety.

2. The opponent bears the costs, fixed at EUR 300.

REASONS:

The opponent filed an opposition against all the services of Community trade mark application No 8 660 284. The opposition is based on United Kingdom trade mark registrations No 2 224 116 and No 2 055 566, and four non-registered trade marks 'OXFORD', 'OXFORD UNIVERSITY', 'UNIVERSITY OF OXFORD' and 'OXFORD LEADERSHIP PRIZE' used in the course of trade in the UK. The opponent invoked Article 8(1)(b), Article 8(5) and Article 8(4) CTMR.

LIKELIHOOD OF CONFUSION – ARTICLE 8(1)(b) CTMR

A likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically-linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs and the relevant public.

a) The services

The services on which the opposition is based are the following:

UK No 2 224 116

Class 41: *Academic services provided by universities, university services; conferral of degrees; arranging and conducting seminars, symposiums, conferences and congresses; conducting correspondence courses; teaching, lecturing and tutorial services; educational and training services; providing information concerning education; educational examinations; organisation of exhibitions for educational purposes; lending libraries and library services; provision of sporting, cultural and entertainment activities; museum services; rental of educational apparatus and instruments; information and advisory services all relating to the aforesaid; all provided by a university.*

UK No 2 055 066

Class 41: *University services; academic services; conferral of degrees; arranging and conducting seminars, symposiums, conferences and congresses; conducting correspondence courses; teaching, lecturing and tutorial services; educational and training services; providing information concerning education; educational examinations; organisation of exhibitions for educational purposes; lending libraries and library services; provision of sporting, cultural and entertainment activities; museum services; rental of educational apparatus and instruments; information and advisory services all relating to the aforesaid; all provided by a university.*

The contested services are the following:

Class 35: *Business management and business consulting and advisory services; business process management and consulting; advising clients about business strategy, organisation performance and business related policy areas; business research services.*

Class 36: *Financial management, assistance, advice, consultancy, information and research services, financial consulting and advisory services; financial analysis and consultation in the nature of assisting clients with financial and strategic initiatives.*

The relevant factors relating to the comparison of the goods or services include, inter alia, the nature and purpose of the goods or services, the distribution channels, the sales outlets, the producers, the method of use and whether they are in competition with each other or complementary to each other.

Contested services in Class 35:

The contested services in Class 35 are services usually rendered by companies specialised in this specific field such as business consultants and are essentially aimed at improving the performances of organisations. These companies gather information and provide tools and expertise to enable their customers to carry out their business or provide businesses with the necessary support t acquire, develop and expand market share. The services involve activities such as business research, organisation consultancy as well as any ‘consultancy’, advisory and assistance activity that may be useful in the management of a business, such as how to efficiently allocate human resources, how to improve productivity, how to increase market share etc. Hence, the services in dispute are different in nature and purpose, as those for which protection is required as essentially aimed at supporting business management while the services of the earlier right have educational and cultural purposes. They are not complementary, neither in competition with each other.

Additionally, they are unlikely to be provided by the same undertakings. Hence they are dissimilar.

Contested services in Class 36:

The applicant's services in Class 36 are all in the field of finance. They cover a variety of advisory and information giving services (relating to finance). These services are provided by financial institutions and have nothing in common with the services provided by the opponent's earlier rights in Class 41. The services for which protection is sought are essentially financial, whereas the services of the earlier right have educational purposes. The services under dispute are different in nature. It is doubtful that the compared services would be provided by the same undertakings. Therefore they are dissimilar.

b) Conclusion

According to Article 8(1)(b) CTMR, the similarity of the goods or services is a condition for a finding of likelihood of confusion. Since the services are clearly dissimilar, one of the necessary conditions of Article 8(1)(b) CTMR is not fulfilled, and the opposition must be rejected as far as it is based on this ground.

This finding would still be valid even if the earlier trade mark were to be considered as enjoying a high degree of distinctiveness. Given that the dissimilarity of the services cannot be overcome by the highly distinctive character of the earlier trade mark the evidence submitted by the opponent in this respect does not alter the outcome reached above.

REPUTATION – ARTICLE 8(5) CTMR

According to Article 8(5) CTMR, upon opposition by the proprietor of an earlier trade mark within the meaning of Article 8(2) CTMR, the contested trade mark shall not be registered where it is identical with, or similar to, the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier Community trade mark, the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Therefore, the grounds of refusal of Article 8(5) CTMR are only applicable when the following conditions are met.

- The signs must be either identical or similar.
- The opponent's trade mark must have a reputation. The reputation must also be prior to the filing of the contested trade mark; it must exist in the territory concerned and for the goods and/or services on which the opposition is based.
- Encroachment upon reputation: the use of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition under Article 8(5) CTMR (judgment of 16/12/2010, joined cases T-345/08 and T-357/08, 'BOTOCYL', paragraph 41). However, the fulfilment of all the abovementioned conditions may not be sufficient. The opposition may still fail if the applicant establishes due cause for the use of the contested trade mark.

In the present case, the applicant did not claim to have due cause for using the contested mark. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists.

a) The signs

1) OXFORD UNIVERSITY 2) UNIVERSITY OF OXFORD	**Oxford Leadership Academy**
Earlier trade mark	Contested sign

The relevant territory is the United Kingdom.

Visually, the signs are similar to the extent that they coincide in 'OXFORD'. On the other hand, they differ in the words 'UNIVERSITY' and 'UNIVERSITY OF' of the earlier marks and in the words 'Leadership Academy' of the contested sign.

Aurally, the pronunciation of the signs coincides in the sound of the word 'OXFORD' present identically in both signs, and to that extent the signs are aurally similar. The pronunciation differs in the sound of the words 'UNIVERSITY' and 'UNIVERSITY OF' of the earlier signs and the sound of the words 'Leadership Academy' of the contested sign which have no counterparts in the other mark.

Conceptually, the word 'OXFORD' which appears in all of the signs is the name of a city and university town in southern England. The word 'UNIVERSITY' that appears in both of the earlier marks will be understood by the relevant public as *an institution of higher education offering tuition in mainly non-vocational subjects and typically having the power to confer degrees. Also: the members, colleges, buildings, etc., of such an institution collectively.* Therefore, both earlier signs, will be perceived by the public in the relevant territory as institutions offering higher education and the power to confer degrees that are situated in the city of Oxford.

The term 'Leadership' of the contested sign means *The dignity, office, or position of a leader, esp. of a political party; ability to lead; the position of a group of people leading or influencing others within a given context; the group itself; the action or influence necessary for the direction or organization of effort in a group undertaking. Also attrib., as leadership behaviour, leadership school, leadership skill*. (Oxford English Dictionary on line). The word 'Academy' of the contested sign means *an independent publicly run school (esp. a secondary school) funded by both the government and voluntary or private sponsors* or *A place of general education in the arts and sciences; an institution for the study of higher learning; formerly spec. an educational institution claiming to hold a rank between a university or college and a school*. (Oxford English Dictionary online).

Therefore, the contested sign will be perceived as a whole by the relevant public as a place of general education situated in Oxford.

The signs are conceptually similar since they both contain the concept of the city of Oxford. There are also slight conceptual similarities in their other parts, namely that they both refer to an institution related to education, however there are also some differences as the earlier signs refer to universities where is it possible to obtain a degree, whereas the contested sign refers to an institution ranked lower than a university and where it is not possible to obtain a degree.

Taking into account the abovementioned visual, aural and conceptual coincidences, it is considered that the signs under comparison are similar.

b) Reputation of the earlier trade mark

According to the opponent, the earlier trade marks have a reputation in the United Kingdom.

Reputation implies a knowledge threshold which is reached only when the earlier mark is known by a significant part of the relevant public for the goods or services it covers. The relevant public is, depending on the goods or services marketed, either the public at large or a more specialised public.

In the present case the contested trade mark was filed on 03/11/2009. Therefore, the opponent was required to prove that the trade marks on which the opposition is based had acquired a reputation in the United Kingdom prior to that date. The evidence must also show that the reputation was acquired for the services for which the opponent has claimed reputation, namely

UK No 2 224 116

Class 41: *Academic services provided by universities, university services; conferral of degrees; arranging and conducting seminars, symposiums, conferences and congresses; conducting correspondence courses; teaching, lecturing and tutorial services; educational and training services; providing information concerning education; educational examinations; organisation of exhibitions for educational purposes; lending libraries and library services; provision of sporting, cultural and entertainment activities; museum services; rental of educational apparatus and instruments; information and advisory services all relating to the aforesaid; all provided by a university*

UK No 2 055 066

Class 41: *University services; academic services; conferral of degrees; arranging and conducting seminars, symposiums, conferences and congresses; conducting correspondence courses; teaching, lecturing and tutorial services; educational and training services; providing information concerning education; educational examinations; organisation of exhibitions for educational purposes; lending libraries and library services; provision of sporting, cultural and entertainment activities; museum services; rental of educational apparatus and instruments; information and advisory services all relating to the aforesaid; all provided by a university*

In order to determine the mark's level of reputation, all the relevant facts of the case must be taken into consideration, including, in particular, the market share held by

the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

On 01/02/2013 the opponent filed, in particular, the following evidence:

- Statute of incorporation: this shows that the opponent is a body which was first incorporated by Royal Charter under English law in 1357.

- Internet prints: Taken from the opponent's website, they give a history of the university plus other information such as statistics on the students, some results from a satisfaction survey completed by its students, as well as information on admissions and access, they showthat the university has a student population of over 21,000. The university is named "University of Oxford" on the heading of the webpage.

- League tables: Here some information is provided as to the ranking of the university compared to others around the world, for e.g. *Quacquarelli Symonds Topuniversities*: the university of Oxford is ranked number 5 in the world in 2012 and number 2 in the world 2012-2013 by the Times Higher Education World University Rankings

- Commercial partnerships: Through its activities the opponent has strong links with industry. It undertakes extensive research and consulting projects with large commercial entities around the world. The opponent has provided some details on the strategic consulting projects undertaken by the school in recent years. The school also partners with industry to create and develop substantive institutions in their own right. The school has a sponsorship arrangement with Pricewaterhouse Coopers for scholarshops for the "oxford Diploma in Financial Strategy" and sponsors a number of high profile events. Details of which are submitted.

- There are many publications associated with the opponent. A list of these publications has been provided and includes various books on various subjects including marketing, management science, finance, operations management and organisational behaviour. The books are published through "Said Business School" which according to the information from the opponent, is an integral part of the University of Oxford. There is no other information on the books such as the number of copies sold.

- The opponent offers courses in leadership since 1966 through a division then – named "The Oxford Centre for Management Studies" and renamed "Templeton College".

- The opponent has held an annual competition called the "Oxford Leadership Prize". Examples of press coverage of the competition as well as a list of judges are provided. Press coverage, includes "The Sun", "The Daily Telegraph", "The Daily Messenger"

- Turnover & sales figures: Although no official figures have been supplied, the opponent states in its observations, that "the school has an annual turnover of around £45 million".

- Advertisements: Some figures are listed in the opponent's observations. From 2008 to July 2012 advertising figures range from £410,000 to £760,000. Some examples are provided from various publications.

- The opponent has listed some previous decisions of various national offices which found in favour of the opponent against trade marks applied for incorporating the word 'OXFORD' seeking protection in services in Class 41.

On the basis of the above the Opposition Division concludes that the earlier trade mark has a reputation in the United Kingdom for all the services for which the opponent has claimed reputation.

The abovementioned evidence indicates that the earlier trade mark has been used for a substantial period of time. The university rankings show that the opponent has a consolidated position in the market and the press articles relating to the annual competition has given the university worldwide coverage and by the way of consequence, also the earlier marks "UNIVERSITY OF OXFORD" and "OXFORD UNIVERSITY". Under these circumstances, the Opposition Division finds that, taken as a whole, the evidence indicates that the earlier trade marks enjoy a certain degree of recognition among the relevant public, which leads to the conclusion that the earlier trade marks enjoy some degree of reputation. Whether the degree of recognition is sufficient for Article 8(5) CTMR to be applicable depends on other factors relevant under Article 8(5) CTMR such as, for example, the degree of similarity between the signs, the inherent characteristics of the earlier trade mark, the type of goods and services in question, the relevant consumers, etc.

c) The 'link' between the signs

As seen above, the earlier marks are reputed to a certain extent and the signs are similar. In order to establish that a later trade mark will encroach upon the reputation of an earlier mark, it is necessary to demonstrate that, given all the relevant factors, the relevant public will establish a link (or association) between the signs. The necessity of such a 'link' between the conflicting marks in consumers' minds is not explicitly mentioned in Article 8(5) CTMR but has been confirmed in the judgment of 23/10/2003, C-408/01, 'Adidas', paragraphs 29 and 31 and the judgment of 27/11/2008, C-252/07, 'Intel Corporation', paragraph 66. It is not an additional requirement but merely reflects the need to determine, after all the factors relevant to the particular case have been assessed, whether the association that the public might establish between the signs is such that either detriment or unfair advantage is likely to occur.

Possible relevant factors for the examination of a 'link' include (judgment of 27/11/2008, C-252/07, 'Intel Corporation', paragraph 42):

- the degree of similarity between the signs;

- the nature of the goods and services, including the degree of similarity or dissimilarity between those goods or services, and the relevant public;

- the strength of the earlier mark's reputation;

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

- the existence of likelihood of confusion on the part of the public.

This list is not exhaustive and other criteria may be relevant depending on the particular circumstances. Moreover, the existence of a 'link' may be established on the basis of only some of these criteria.

The establishment of such a link, while triggered by similarity (or identity) between the signs, requires that the relevant sections of the public for each of the goods and services covered by the trade marks in dispute are the same or overlap to some extent.

According to the Court of Justice of the European Union,

> It is therefore conceivable that the relevant section of the public as regards the goods or services for which the earlier mark was registered is completely distinct from the relevant section of the public as regards the goods or services for which the later mark was registered and that the earlier mark, although it has a reputation, is not known to the public targeted by the later mark. In such a case, the public targeted by each of the two marks may never be confronted with the other mark, so that it will not establish any link between those marks.

(Judgment of 27/11/2008, C-252/07, 'Intel Corporation', paragraph 48.)

The Court of Justice has also noted,

> … that certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services for which those marks were registered. In such a case, it is possible that the relevant section of the public as regards the goods or services for which the later mark is registered will make a connection between the conflicting marks, even though that public is wholly distinct from the relevant section of the public as regards goods or services for which the earlier mark was registered.

(Judgment of 27/11/2008, C-252/07 'Intel Corporation', paragraphs 51 and 52.)

In the present case, there is no overlap between the relevant sections of the public for the trade marks in dispute. Each trade mark targets a different type of public. While the contested services are aimed at business managers and the financial sector, the earlier trade mark was found to have a reputation only among universities. Given that the public for the contested trade mark is completely distinct from the relevant section of the public among which the earlier trade mark enjoys a reputation, no association will be made between the signs.

The signs are similar to some extent. This does not mean that the relevant public is likely to establish a link between them. When consideration is given to the services in question, it is clear that the similarities between the signs in dispute relate to elements which are descriptive. This is because the comment element 'OXFORD' is a well known university city in Southern England and as used in the trade marks under comparison, merely indicates to the consumers that the services, in the case of the opponent, educational services, are available from the city of Oxford. Therefore, in view of the feeble distinctive character of the elements in question, the similarities between the contested trade mark and the earlier trade mark are unlikely

to bring the earlier trade mark to the mind of the average consumer. Intrinsically the earlier marks are weak because they combine two elements that are descriptive of the services at hand, in a way that follows the normal rules of grammar.

Therefore, taking into account and weighing up all the relevant factors of the case at hand, the Opposition Division concludes that it is unlikely that the relevant public will make a mental connection between the signs in dispute, that is to say, establish a 'link' between them. Therefore, the opposition is not well founded under Article 8(5) CTMR and must be rejected.

NON-REGISTERED MARK OR ANOTHER SIGN USED IN THE COURSE OF TRADE – ARTICLE 8(4) CTMR

The opponent has based its opposition on the grounds of Article 8(4) in relation to the following non-registered trade marks:

- "**OXFORD**" for *educational and training services; business consultancy and advisory services; leadership coaching and training services.*

- "**OXFORD UNIVERSITY**" for *educational and training services; business consultancy and advisory services; leadership coaching and training services.*

- "**UNIVERSITY OF OXFORD**" for *educational and training services, business consultancy and leadership training.*

- "**OXFORD LEADERSHIP PRIZE**" for *educational and training services, business consultancy and leadership training*.

According to Article 8(4) CTMR, upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Community legislation or the law of the Member State governing that sign:

(a) rights to that sign were acquired prior to the date of application for registration of the Community trade mark, or the date of the priority claimed for the application for registration of the Community trade mark;

(b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

Therefore, the grounds of refusal of Article 8(4) CTMR are subject to the following requirements:

- the earlier sign must have been used in the course of trade of more than local significance prior to the filing of the contested trade mark;

- pursuant to the law governing it, prior to the filing of the contested trade mark, the opponent acquired rights to the sign on which the opposition is based, including the right to prohibit the use of a subsequent trade mark;

- the conditions under which the use of a subsequent trade mark may be prohibited are fulfilled in respect of the contested trade mark.

These conditions are cumulative. Therefore, where a sign does not satisfy one of those conditions, the opposition based on a non-registered trade mark or other signs used in the course of trade within the meaning of Article 8(4) CTMR cannot succeed.

a) Prior use in the course of trade of more than mere local significance

The condition requiring use in the course of trade is a fundamental requirement, without which the sign in question cannot enjoy any protection against the registration of a Community trade mark, irrespective of the requirements to be met under national law in order to acquire exclusive rights. Furthermore, such use must indicate that the sign in question is of more than mere local significance.

It must be recalled that the object of the condition laid down in Article 8(4) CTMR relating to use in the course of trade of a sign of more than mere local significance is to limit conflicts between signs by preventing an earlier right which is not sufficiently definite – that is to say, important and significant in the course of trade – from preventing registration of a new Community trade mark. A right of opposition of that kind must be reserved to signs with a real and actual presence on their relevant market. To be capable of preventing registration of a new sign, the sign relied on in opposition must actually be used in a sufficiently significant manner in the course of trade and its geographical extent must not be merely local, which implies, where the territory in which that sign is protected may be regarded as other than local, that the sign must be used in a substantial part of that territory. In order to ascertain whether that is the case, account must be taken of the duration and intensity of the use of the sign as a distinctive element for its addressees, namely purchasers and consumers as well as suppliers and competitors. In that regard, the use made of the sign in advertising and commercial correspondence is of particular relevance. In addition, the condition relating to use in the course of trade must be assessed separately for each of the territories in which the right relied on in support of the opposition is protected. Finally, use of the sign in the course of trade must be shown to have occurred before the date of the application for registration of the Community trade mark (judgment of 29/03/2011, C-96/09 P, 'Bud', paragraphs 157, 159, 160, 163 and 166).

In the present case, the contested trade mark was filed on 03/11/2009. Therefore, the opponent was required to prove that the signs on which the opposition is based were used in the course of trade of more than local significance in the United Kingdom prior to that date. The evidence must also show that the opponent's signs have been used in the course of trade for *educational and training services; business consultancy and advisory services; leadership coaching and training services.*

On 01/02/2013 the opponent filed, in particular, the following evidence:

The evidence submitted by the opponent to prove the use of the non-registered marks is the same as that which was filed to prove the reputation of the earlier registered trade marks. As already noted by the Opposition Division, the evidence filed proved that the marks "OXFORD UNIVERSITY" and "UNIVERSITY OF OXFORD" were reputed in relation only to services relating to education in Class 41. In relation to these services the evidence was assessed in relation only to the marks "The University of Oxford" and "Oxford University". The evidence also includes information on the competition held by the university, namely "The Oxford Leadership Prize". This evidence shows that the opponent has been using this as a non-registered trade mark, but in relation to competitions. There is nothing within the

evidence to show that the opponent has been using any of its trademarks, in relation to *business consultancy and advisory services; leadership coaching and training services.*

Consequently, the Opposition Division concludes that the opponent's sign was used in the course of trade of more than local significance in the United Kingdom for *educational and training services* before the filing date of the contested trade mark.

However, the evidence does not succeed in establishing that the sign has been used in the course of trade of more than local significance for all the services on which the opposition is based. The evidence mainly relates to *educational and training services*, whereas there is no or little reference to the remaining services. This is clear, for example, from the press clips, where only the former are mentioned.

b) The right under the applicable law

The opposition is based on non-registered trade marks used in the United Kingdom. The opponent claims to have the right to prohibit the use of the contested trade mark under the tort of passing off.

A successful claim for passing off must satisfy three cumulative conditions. Failure to satisfy any one of them means that the claim cannot succeed. The conditions are:

Firstly, the opponent must prove that it enjoys goodwill or is known for specific services under its mark. The evidence must show that the opponent's mark is recognised by the public as distinctive for the opponent's services. For the purposes of opposition proceedings, goodwill must be proven to have existed before the filing date of the contested trade mark.

Secondly, the opponent must demonstrate that the applicant's mark would be likely to lead the public to believe that the applicant's services originate from the opponent. In other words, the public would be likely to believe that servics put on the market under the contested trade mark are actually those of the opponent.

Thirdly, the opponent must show that it is likely to suffer damage as a result of the applicant's use of the contested trade mark.

a) The opponent must demonstrate that the applicant's mark would be likely to lead the public to believe that goods and services from the applicant are goods and services coming from the opponent

The CTM applied for must be likely to lead the public to believe that goods or services to be offered by the applicant are goods or services of the opponent. Thus, it is necessary to examine whether, on a balance of probabilities, it is likely that a substantial number of members of the relevant public will be misled into purchasing the applicant's services in the belief that they are the opponent's.

The existence of a likelihood of confusion is therefore a condition common to Article 8(1)(b) CTMR and the action for passing off.

This mistaken belief is unlikely to exist where the goods and services covered by the application are dissimilar to those on which the opponent's goodwill has been built. Thus, the goods and services covered by the application must be compared with the

goods in connection with which the opponent has shown that he has acquired goodwill through use.

The goods and services

The services have already been compared above under the grounds of Article 8(1)(b) CTMR. Reference is made to those findings.

It follows from the above that the business and financial services covered by the CTM application are dissimilar to the educational services in relation to which the opponent has proved use. Under these circumstances the Opposition Division finds it unlikely that the opponent's customers will take the services of the applicant as being of the opponent, even if the signs present similarities.

Since all three conditions as listed above must be met for a passing-off claim to be successful, the opposition must be dismissed

The opposition is not well founded under Article 8(4) CTMR.

COSTS

According to Article 85(1) CTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the opponent is the losing party, it must bear the costs incurred by the applicant in the course of these proceedings.

According to Rule 94(3) and (7)(d)(ii) CTMIR, the costs to be paid to the applicant are the costs of representation which are to be fixed on the basis of the maximum rate set therein.

The Opposition Division

Martin EBERL Andrea NEWMAN Catherine MEDINA

According to Article 59 CTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 CTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. According to Rule 94(4) CTMIR, such a request must be filed within one month from the date of notification of this fixation

of costs and shall be deemed to be filed only when the review fee of EUR 100 (Article 2(30) CTMFR) has been paid.