

## TRADE MARKS ACT 1994

### IN THE MATTER OF APPLICATION No. 9913 BY VIACOM INTERNATIONAL INC. FOR REVOCATION OF REGISTRATION No. 1021689 IN THE NAME OF NOTTINGHAM GROUP LIMITED

---

#### DECISION

---

#### **The Registration**

1. Registration No. 1021689 (“the registration”) is for the word only trade mark ARNOLD standing in the name of Nottingham Group Limited.
2. The registration has a filing date of 4 December 1973 and covers the following specification of goods in Class 9:

Scientific, electrical and control apparatus and instruments, all included in Class 9; photographic, optical, measuring and signalling apparatus and instruments; all being goods for use in education.

3. **The Application for Revocation**

On 9 December 1997 Viacom International Inc. filed an application to revoke the registration on non-use grounds under section 46(1)(a) and (b) of the Trade Marks Act 1994 (“TMA”).

4. In the event, the applicants did not pursue their complaint under section 46(1)(a) of the TMA.
5. The relevant five-year period of alleged non-use of ARNOLD under section 46(1)(b) of the TMA was from 9 December 1992 to 8 December 1997.
6. There was no claim:
  - (a) on the part of the applicants, that any use shown by the registered proprietors was other than genuine;
  - (b) on the part of the registered proprietors, that there existed proper reasons for non-use.

### **The Issues**

7. The issues between the parties were briefly whether use by the registered proprietors of NES Arnold or –



- (i) constituted use of the trade mark ARNOLD as registered;
- (ii) amounted to “use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered” for the purposes of section 46(2) of the TMA.
8. If either of the above was decided in favour of the registered proprietors a further issue that emerged was whether partial revocation should be ordered in respect of some only of the goods in the specification because of the registered proprietors’ catalogue use of the trade mark to sell other manufacturers’ branded goods. The registered proprietors objected that the applicants had not raised that issue in their statement of grounds and the registered proprietors had no opportunity to address it either through their counterstatement or in their evidence.

### **The Registered Proprietors’ Evidence**

9. The registered proprietors’ evidence consisted of a statutory declaration of Mr Richard Piggott dated 20 March 1998. Mr Piggott is the Company Secretary of Novara plc the holding company of the registered proprietors.
10. Mr Piggott states that Registration No. 1021689 was originally owned by E.J. Arnold & Son Limited (“the original proprietors”). Mr Piggott exhibits at what he refers to as “PG1” but which is in fact labelled “RP1” copy extracts from catalogues produced by the original proprietors for the years 1982/1983 and 1990. He correctly states that these extracts show use of “Arnold” to promote a variety of the goods in Registration No. 1021689. He says that similar brochures were distributed annually between 1982 and 1990.
11. The evidence at “RP1” does not assist the registered proprietors as it predates the period 9 December 1992 to 8 December 1997 in suit.
12. In April 1990, Nottingham Educational Supplies acquired the business of the original proprietor. Mr Piggott describes the manner of use thereafter of Registration No. 1021689 as follows:

In most cases the Mark has been used with the initials “NES”, standing for Nottingham Educational Supplies. This abbreviation is considered a non-distinctive element, the distinguishing element being the mark

“Arnold”. The mark has also been used extensively without the initials NES Arnold.

Novara Plc are the UK’s leading educational supplier. The name “NES Arnold” and the Mark have been promoted extensively throughout the United Kingdom and we are commonly known by various educationalists throughout the United Kingdom as “Arnolds”. The main method by which we promote the Mark is in catalogues distributed annually to substantially all primary and secondary schools in the UK. We also stage exhibitions throughout the UK using the Mark to promote the educational supplies we market. Each year we produce a “main catalogue”. Approximately 37,000 copies of the main catalogue were distributed in 1998 throughout the UK and similar brochures have been despatched by us in similar numbers since 1990.

13. Mr Piggott exhibits at “PG2” [sic – “RP2”] copy extracts from their 1992 – 1995 annual catalogues and from the 1998 catalogue. The latter of course post-dates the period 9 December 1992 to 8 December 1997 in suit. Mr Piggott identifies by reference to the 1995 catalogue a variety of goods falling within the specification in relation to which he asserts Registration No. 1021689 has been used. At “PG3” [sic – “RP3”] Mr Piggott exhibits copies of the cover pages and indexes to the NES Arnold Scientific brochures from 1993 – 1996. There is one further exhibit – “RP4” – which is not referred to in Mr Piggott’s declaration but shows use of “Arnold’s” in an office and stationery sundries catalogue of 1996. This states at the “Welcome” page:

Arnold’s offer you a range of Office and Stationery Sundries, so well priced .... And don’t forget we have also included the Arnold’s range in our main catalogues, so that everyone in your school can benefit.

#### **The Applicants’ Evidence**

14. The applicants’ evidence consisted of a statutory declaration of Dr Stephen Richard James dated 30 March 1999. Dr James is a partner of R.G.C. Jenkins & Co. and is the UK trade mark representative of the applicants.
15. Dr James’ evidence is essentially limited to commenting on the registered proprietors’ evidence and to putting forward arguments as to non-use of Registration No. 1021689.
16. Dr James does allude at paragraph 4 of his statutory declaration to the supply by the registered proprietor of other traders branded and own brand goods.

#### **The Hearing Officer’s Decision**

17. The application for revocation proceeded to a hearing before Mr M. Reynolds acting on behalf of the registrar of Trade Marks on 3 January 2001. In a written decision dated 2 February 2001, Mr Reynolds held that the application for revocation under section 46(1)(b) of the TMA had been successful and that Registration No. 1021689 should be revoked with effect from 9 December 1997.

18. In summary, the hearing officer's reasons for arriving at that decision were as follows;

- (i) during the period 9 December 1992 to 8 December 1997 the registered proprietors had failed to show use of the word ARNOLD alone except in relation to weather vanes and stationery and office supplies. Since these goods were not within the subject specification in Class 9, the registered proprietors had failed to show use in relation to the goods in Registration No. 1021689;
- (ii) Mr Reynolds understood Mr Ashley Roughton of Counsel on behalf of the registered proprietors to acknowledge "as he was bound to, that use of NES Arnold (ignoring for present purposes the bird device) was not use of the mark as registered". In any event it was clear from the evidence that NES Arnold was being used as a single composite mark;
- (iii) use of NES Arnold was not use of the mark ARNOLD in a form differing in elements that do not alter the distinctive character of the mark in the form in which it was registered. The registered proprietors could not avail themselves of section 46(2) of the TMA. More particularly:

The mark as registered is a single word. The distinctive character of the mark can only, therefore, be the word itself. It may be possible to add elements (the name of the goods say or a simple border) which would have no material impact on the distinctive character of the mark in the form registered. However as a matter of impression (and without seeking to apportion relative degrees of distinctive character to the elements of the mark) I am in no doubt that use of NES Arnold does make a material difference to the character of the mark. The presentation of NES as the first element in the mark and in upper case letters gives it a degree of prominence and importance within the totality of the mark which cannot fail to make an impression on the viewer.

- (iv) the claim by the registered proprietors that they were known to educationalists as "Arnold's" was unrelated to any specific goods and unsubstantiated in the evidence;
- (v) although in view of his main finding it was unnecessary to decide the point, an application for partial revocation would be unlikely to succeed. The evidence would probably reveal use of the NES Arnold marks sufficient to support the specification on own brand and non-branded goods.

**The Appeal**

19. On 2 April 2001 the registered proprietors gave notice to appeal to an Appointed Person under section 76 of the TMA (having been granted an extension of time within which to appeal until that date). In their grounds of

appeal they seek orders that the hearing officer's decisions be reversed, that Registration No. 1021689 be restored to the register, and an award of costs.

20. There is no appeal against the finding of Mr Reynolds that the registered proprietors failed to show use of ARNOLD alone in relation to goods within the specification in the period 9 December 1992 to 8 December 1997.
21. Instead, Mr Roughton on behalf of the registered proprietors contends that the hearing officer erred in his findings that use of NES Arnold and/or



did not constitute use of the mark as registered.

22. At the appeal hearing, I asked Mr Roughton to clarify what was contained within that contention since in my view the statement of grounds of appeal was equivocal. Mr Roughton confirmed that the registered proprietors challenged not only Mr Reynolds' rejection of the section 46(2) defence but also his finding that the registered proprietor's use of NES Arnold was as a single composite mark rather than as independent marks together.
23. For the purposes of his arguments Mr Roughton identifies three elements in the device mark: NES which he characterises as "the acronym", the bird logo which he refers to as "the logo" and ARNOLD in lower/uppercase which he calls "the word". He says that "etiologically" these three elements are different. By this he means that the cause or root of each is different: initials, a graphical representation and a word respectively.
24. Mr Roughton's point is that because the cause or root of each element is different the consumer would perceive each element differently in use. The hearing officer failed to give due regard to the prominence and distinctiveness of the word ARNOLD and to appreciate that the consumer would view use of NES Arnold or NES Arnold & DEVICE as use of the mark as registered or alternatively as use of the mark in a form differing in elements which do not alter the distinctive character of the mark. In other words the consumer would disregard or treat as separate the logo and/or the acronym so that in the case of section 46(2) neither could have any effect on the distinctive character of ARNOLD as registered.
25. It became clear during the hearing of the appeal that Mr Roughton's use of "etiologically" strayed into what Mr Guy Tritton, appearing for the applicants, termed "semantic meaning". Thus, if two elements convey the same concept to a consumer, for example, femaleness as in *ELLE Trade Marks* [1997] FSR

529, the addition or removal of one alters the distinctive character of the other or of the whole because, says Mr Roughton, the consumer regards the two elements as being etiologically linked.

26. **Approach to this appeal**

Both parties agreed that since this is an inter partes appeal, I should adopt the approach set out by Pumfrey J. in *South Cone Inc. v. Bessant*, 25 July 2001 and Mr Simon Thorley QC sitting as the Appointed Person in *Eicher Limited – Royal Enfield Motor Units’ Application*, SRIS O/363/01. The appeal is limited to a review:

Findings of primary fact will not be disturbed unless the hearing officer made an error of principle or was plainly wrong on the evidence. His inferences from the primary facts may be reconsidered, but weight will be given to his experience. No question of the exercise of discretion arises. In this way, error will be corrected but a different appreciation will not be substituted for that of the hearing officer if he has arrived at his conclusion without error.

**Decision – section 46(1)(b)**

27. It is well established that the relevant consumer who is reasonably well informed and reasonably observant and circumspect normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v. Puma AG*, Case C-251/95 [1997] ECR I-6191, para. 23, *Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel BV*, Case C-342/97 [1999] ECR I-3830, paras. 25 and 26).

28. Nevertheless, in assessing the overall impression of a mark the tribunal must bear in mind its distinctive and dominant components (*Sabel*, supra., para. 23).

29. Section 72 of the TMA states that:

In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration ...

In *RALEIGH INTERNATIONAL Trade Mark* [2001] RPC 202 Mr Geoffrey Hobbs QC sitting as the Appointed Person said that he understood section 72 “to imply that the earlier trade mark should be taken, prima facie, to have possessed a distinctive character (so as to be free of objection under section 3(1) of the Act) when it was registered”. I can see no reason to differ from that understanding.

30. Mr Roughton criticised the hearing officer for giving too much weight to the applicants’ arguments as to the inherent distinctiveness or otherwise of the registered trade mark ARNOLD. I do not consider that criticism fairly levelled since the hearing officer made clear that he did not find the parties’ submissions on that issue helpful to his decision:

... that mark [ARNOLD] is not under attack in these proceedings under Section 47(1) on the basis that it was registered in breach of Section 3(1)(b)(c) or (d). The proprietors, therefore, had no reason to defend their registration against an attack of this kind.

31. There is nothing in Directive 89/104/EEC or the TMA to indicate that it is no longer possible to use two or more marks together in such a way that use accrues to each of the marks for the purposes of section 46(1)(a) and (b) of the TMA (*Levi Strauss & Co. v. Shah* [1985] RPC 371 said still to remain good law in *BP Amoco Plc v. John Kelly Limited*, 2 February 2001, NI CA; *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281).
32. Mr Tritton did not dispute the general principle but sought to illustrate with examples that this was not the case here.
33. I agree with Mr Tritton. It is clear from the evidence that in the period 9 December 1992 to 8 December 1997 the registered proprietors used NES Arnold and NES Arnold & DEVICE as composite marks and that is the overall impression that would have been conveyed to the relevant consumer. The hearing officer correctly concluded that use of the NES Arnold marks did not also constitute use of the word ARNOLD alone.

**Decision – section 46(2)**

34. Moving to section 46(2) of the TMA, Mr Roughton alleges that the hearing officer was wrong in law first, in not following “the general principle” set out in *British Sugar*, supra., and second, in applying *ELLE Trade Marks*, supra., to the facts of the present case.
35. Section 46(2) of the TMA states that:

For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered ...
36. Mr Roughton’s allegations hinge on the view that any alteration to a mark in use must affect its distinctiveness in order to be barred from constituting use of the mark under section 46(2). On the “authority” of *British Sugar* the addition of elements of like etiological significance (there, words) “drowns out” or alters the distinctive character of a mark but not otherwise. Similarly, the removal of the female symbol in *ELLE* altered the distinctive character of the mark because both the symbol and the word ELLE evoke femaleness.
37. In *British Sugar*, Jacob J. was considering whether Robertson’s use of “Treat” within the phrase “Toffee Treat” and preceded by “Robertson’s” on the label was as a description rather than as a trade mark for the purposes of a defence to infringement under section 11(2) of the TMA. I do not suppose he was laying down any general principle for the application of section 11(2) (the judge acknowledges that descriptive use is a question of fact in each case) let alone for the purposes of section 46(2). Indeed in the later case of *Euromarket Designs Inc. v. Peters and Crate & Barrel Ltd.* [2001] FSR 288, the same

judge notes that different definitions of use are given in the Directive and the TMA in connection with infringement on the one hand and revocation for non-use on the other hand:

It may well be that the concept of “use in relation to goods” is different for different purposes. Much may turn on the public conception of the use.

In my view, Mr Reynolds correctly held that *British Sugar* was inapplicable to the present case.

38. Mr Roughton’s criticism of the hearing officer’s treatment of the *ELLE* case is equally unjustified. Mr Reynolds accepted that the case did not provide a direct analogy but illustrated that in the end the basic question for section 46(2) is in the words of Lloyd J.: “whether ... something has been done which alters the distinctive character of the mark from the registered form”.
39. Lloyd J.’s words contain the key to the basic flaw in Mr Roughton’s reasoning. As Mr Tritton pointed out, section 46(2) requires the tribunal to have regard to the form in which the mark is used and to assess whether that form differs in distinctive character from the form in which the mark is registered.
40. Mr Reynolds noted the third party registrations for NES provided in evidence by the applicants. He also referred to the recent endorsement of registry practice in relation to the acceptance of three letter marks by Mr Geoffrey Hobbs QC sitting as the Appointed Person in *FSS Trade Mark*, SRIS O/473/00. Taking into account the likely overall impression on the consumer of the NES Arnold and NES Arnold & DEVICE marks, the hearing officer concluded that something had been done which altered the distinctive character of the mark from the registered form. I agree with that conclusion. The registered proprietors cannot bring themselves within section 46(2).

**Third party use of ARNOLD**

41. On a final note, Mr Roughton challenged the hearing officer’s dismissal of the registered proprietors’ claim to be known during the period of alleged non-use by educationalists as “Arnolds”. Quite apart from pointing out the difficulties of interpretation that argument raised with section 46(1) and (2), Mr Reynolds rightly rejected the claim as mere assertion and in any event unrelated to specific goods of the proprietor.

**Partial Revocation**

42. In view of my above findings on appeal it is unnecessary for me to consider Mr Roughton’s additional points relating to partial revocation.

**Conclusion**

43. In the result the appeal fails. The registration will be revoked in its entirety with effect from 9 December 1997. The parties were in agreement that the costs should follow the event. Mr Reynolds ordered that the registered proprietors should pay the applicants the sum of £835 in respect of the



application and I direct that a further sum of £835 be paid to the applicants as a contribution towards their costs of this appeal, to be paid on the same basis as indicated by Mr Reynolds.

Mr Ashley Roughton, instructed by Garretts, appeared on behalf of the registered proprietors

Mr Guy Tritton, instructed by R.G.C. Jenkins & Co., appeared on behalf of the applicants

Professor Ruth Annand, 17 October 2001