

O-290-03

**TRADE MARKS ACT 1938 (AS AMENDED)  
AND TRADE MARKS ACT (1994)**

**IN THE MATTER OF APPLICATION NO. 1586606  
BY CURTIS FINE PAPERS LIMITED TO REGISTER A TRADE MARK IN  
CLASS 16**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 48553 BY ZANDERS FEINPAPIERE AG**

**Trade Marks Act 1938 (as amended)  
and Trade Marks Act (1994)**

**In the matter of Application No. 1586606  
in the name of Curtis Fine Papers Limited**

**And**

**In the matter of Opposition thereto  
under No. 48553 by Zanders Feinpapiere AG**

**Background**

1. On 29 September 1994, Curtis Fine Papers Limited applied to register the trade mark CLASSIC for the following goods in Class 16.

“Paper, board, stationery and envelopes”.

2. The application was examined and subsequently advertised before acceptance under the provisions of Section 18(1) of the Act in Part B of the Register and on the basis of Honest Concurrent Use for the following goods:

“Papers, board and envelopes; all for use as writing paper or as stationery for graphics and printing; all included in Class 16.”

3. On 15 May 1998, Zanders Feinpapiere AG filed notice of opposition. The grounds of opposition are in summary that:

a) the word CLASSIC is not an invented word and therefore does not qualify for registration under the provision of Section 9(1) (c) of the Act and thus should be refused registration under this section;

b) the word CLASSIC is one having a direct reference to the character of quality of the applicants’ goods and therefore does not qualify for registration under Section 9(1) (d) of the Act and thus should be refused registration under this section;

c) the word CLASSIC is one which is required by traders as a descriptive word in the sale and advertisement for sale of their goods and therefore is not a distinctive mark within the meaning of Section 9(1) (e) of the Act and thus should be refused registration under this section;

d) the opponent has been using the word CLASSIC in the United Kingdom since 1982 in relation to “paper” as an indication of the quality of their paper. The opponent might well be disadvantaged if a monopoly were to be granted to one trader to use that word as a trade mark in relation to the applicant’s goods, particularly in relation to paper. The

registration of the mark would not afford an indication of trade origin without trespassing on the legitimate freedom of other traders to use the word in relation to describing the character or quality of their goods. Consequently, the mark is not inherently capable of distinguishing the applicants' goods within the meaning of Section 10 of the Act and thus should be refused registration under Section 10(1) of the Act.

4. The applicants filed a counterstatement in which the grounds of opposition are denied.

5. Both parties filed evidence and both ask for an award of costs in their favour.

6. The matter came to be heard on 18 February 2003. At the hearing the opponents were represented by Mr Michael Edenborough of Counsel instructed by Mewburn Ellis; the applicants were represented by Ms Emma Himsworth of Counsel instructed by JY & GW Johnson.

7. By the time this matter came up for a decision, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having begun under the provisions of the 1938 Act must continue to be dealt with under that Act, in accordance with the transitional provisions set out in Paragraph 17 of Schedule 3 of the 1994 Act. Accordingly, all reference in this decision are references to the 1938 Act and the Trade Marks and Service Marks Rules 1986.

### **Opponents' evidence**

8. This consists of a declaration, together with 5 exhibits, dated 7 January 1999, by Richard Bertram Salzer. Mr Salzer is the Deputy Sales Director of the opponents and has been employed by them for the last 28 years and is familiar with the paper trade. The following relevant points emerge from his declaration:

- the opponents manufacture paper of various grades and in respect of each type of paper the opponent uses a trade mark and a description or grade indicator. Since 1982 the opponents have sold in the United Kingdom a grade of paper referred to as CLASSIC under the trade mark ZANDERS. In recent years paper graded as "CLASSIC" has been sold in quantities, the annual sales values of which have been approximately:

<b>Year</b>	<b>£</b>
1989	1270
1990	12770
1991	8650
1992	7470
1993	10020
1994	7700
1995	8000

1996	12535
1997	20930
1998 (part)	2810

- the opponents have advertised the grade of paper known as CLASSIC together with other types of paper in the range, but separate budgets have not been established, but in 1996 the opponents spent approximately £65,000 advertising CLASSIC paper;
- the CLASSIC grade of paper has been advertised in the opponents' own newsletter as well as the trade press including *Graphic Design*, *The Quick Printer*, *Design Week*, *Creative Review*, *Stationery Update*, *The Drum*, *Paper Europe*, *Paper Focus*, *One Stop* and *Graphic International*. Exhibit RBS1 shows copies of such advertisements;
- the opponents export their goods from Germany to the United Kingdom where they are primarily distributed through the opponents' main distributor. The particular grade of paper referred to as CLASSIC is described as such in invoices examples of which are shown at exhibit RBS2;
- the word CLASSIC is widely used in a descriptive sense in a number of fields, but more particularly in the field of paper and stationery. Exhibit RBS3 shows copies of applications and registrations in Class 16 for trade marks containing the word CLASSIC in the names of eight different proprietors;
- the state of the Register in respect of Class 16 is reflected in the market place and Exhibit RBS4 consists of a selection of brochures showing use of the word CLASSIC by some of the proprietors of registrations in Class 16;
- the applicant approached the opponents and their distributors on the basis of the present application, stating that they were confident of obtaining registration which would then give the applicants the right to seek an injunction in respect of infringement of the registration and to seek damages from any infringer. This illustrates the disadvantage that would be suffered by anyone continuing the general custom of referring to a particular grade of paper as CLASSIC. Exhibit RBS5 consists of a copy of a letter dated 1 November 1996 sent to the opponents' UK distributor by the applicants' Trade Mark Agents;
- the applicants, being one of many traders in paper goods, is attempting to obtain a monopoly in a word which is common to the trade. Although the applicant may well have used the word to describe a grade of paper for a number of years, any evidence of such use would have to be partial evidence of use of CLASSIC since it ignores that which is made by other traders in the field, and more specifically use of CLASSIC by competitors of the applicants.

## **Applicants' evidence**

9. This consists of three statutory declarations, each with two exhibits attached. The first statutory declaration, dated 13 October 1999, is from Bryan Corbett Bateman Director of Special Projects at the Paper Federation of Great Britain the principal trade body for paper manufacturers within the United Kingdom. In common with most other paper manufacturers, the applicants in these proceedings are members of the Federation, but Mr Bateman confirms that he has no personal connection with the applicants. Mr Bateman explains that he has been employed by the Federation since March 1989 and until September 1999 was a Director of Business and Environment for the Federation. During this time, Mr Bateman had broad responsibility for the Federation's activities in relation to commercial affairs, statistics, the environment, energy, health and safety and research and development. Mr Bateman is a member of numerous paper trade organisations, and serves as an expert advisor to the Commission of the European Union on certain matters relating to the paper industry. Mr Bateman confirms that the statements made in this declaration are made from his personal knowledge as a result of twelve year's experience in the paper industry.

10. Mr Bateman states that to his certain knowledge, Curtis Fine Papers Limited and its predecessors in business have used CLASSIC as a trade mark for many years and definitely before 1989 (when Mr Bateman's involvement in the paper industry began). To the best of Mr Bateman's knowledge, the use of CLASSIC as a trade mark dates back well over twenty years. The CLASSIC brand has been used in relation to a range of products including, in particular, business letter paper and envelopes, as well as papers for graphical and printing use. Exhibit BCB1 consists of a copy of the Federation's publication "Who Makes What", which he says illustrates this. On this basis, Mr Bateman considers it fair and true to say that CLASSIC is associated with Curtis Fine Papers alone. Mr Bateman explains that he has consulted the Phillips International Paper Directory (generally regarded as the leading trade directory in the paper industry) and found that the only entry in the trade name index under the mark CLASSIC is Curtis Fine Papers Limited. Mr Bateman also consulted the Mill Branded Products in Europe trade name index section of Paper Europe (August 1999 edition) and this too lists only Curtis Fine Papers Limited under the entry for the trade mark CLASSIC. Finally, Mr Bateman consulted the product index entries for Curtis Fine Papers Limited and Zanders Feinpapiere AG from the 1997 International Pulp & Paper Directory and found that, while the Curtis Fine Papers entry lists CLASSIC as one of the company's three main brands, the Zanders Feinpapiere entry makes no mention at all of CLASSIC or ZANDERS CLASSIC. Exhibit BCB2 consists of copies of the relevant index pages. Mr Bateman concludes that he has not found any trade name indexes which list any company other than Curtis Fine Papers Limited under the CLASSIC mark. In contrast, the directories indicate that the principal mark of Zanders Feinpapiere AG appears to be CHROMOLUX. Mr Bateman accepts that the word CLASSIC can be used in a descriptive sense, but states that in his experience the word is not used in the paper industry to indicate any particular kind or grade of paper and therefore does not feel that the possible descriptive meaning of CLASSIC in any way diminishes the fact that, in

respect of business stationery CLASSIC exclusively identifies goods from Curtis Fine Papers Limited.

11. The second statutory declaration, dated 12 October 1999, is from Stefan George Kay. Mr Kay is the Managing Director of Inveresk Plc, a British Company of Kilbagie Mills, which manufactures and sells speciality papers and boards, a position he has held since February 1989. Prior to that, between 1981 and 1988, Mr Kay was the Managing Director of the Silverton Mill of St.Regis Paper Company Limited, a company which also manufactures and sells papers and boards. Mr Kay confirms that Curtis Fine Papers Limited is one of his company's main competitors. The following relevant points emerge from his declaration:

- in response to the question what the term CLASSIC means to him within the confines of the paper industry, Mr Kay explains that since 1981, he has known CLASSIC to refer to a brand of papers manufactured by the company, which is now known as Curtis Fine Papers Limited. In particular, the CLASSIC brand refers to a high quality range of water-marked papers and boards for use as business and personal stationery and for printing and graphical use. Although the CLASSIC range has been updated over the years, the essential "concept" of a high quality range of water-marked papers and boards has remained unaltered;
- Mr Kay confirms that he has read a copy of the statutory declaration of Richard Bertram Salzer made in these proceedings on 7 January 1999. In relation to this, Mr Kay comments that the sales figures quoted at paragraph 3 are very small. From the sterling figures given, Mr Kay estimates that the maximum yearly sales (£20,930 in 1997) would have amounted to only around 20 tonnes, which is an entirely trivial amount compared to the size of the UK market. Exhibit SGK1 consists of an extract from the July 1999 edition of "Pulp and Paper International" magazine, which reviews total UK production, export/import and consumption figures for various paper and board products for 1997 and 1998;
- Mr Kay confirms that it is his firm belief that CLASSIC is well established throughout the paper industry and paper merchant trade in the United Kingdom as indicating a brand of papers supplied by Curtis Fine Papers Limited. This view appears to be shared by Duncan McLean, who is the Managing Director of the Fine Papers Division of Inveresk PLC, whose statutory declaration dated 24 March 1997 is provided as Exhibit SGK2.

12. The third statutory declaration, dated 12 October 1999, is from William Whyte. Mr Whyte states that he is the same William Whyte who made a statutory declaration on 29 November 1995 in respect of the ex-parte prosecution of the application in suit. A copy of this earlier declaration is attached at Exhibit WW6. Mr Whyte is the Financial Director of the applicant company, a position he has held since 1989. He confirms that he has read a copy of the declaration made by Richard Bertram Salzer on 7 January 1999 and comments as follows:

- Mr Whyte is aware that the opponents' have been sporadically selling papers in the UK branded as ZANDERS CLASSIC and the applicants have objected to such misuse of CLASSIC as referred to by Herr Salzer in paragraph 11 of his declaration. Mr Whyte comments that he finds the advertising figures mentioned in paragraph 4 as surprising considering that the figure of £65,000 per annum exceeds the yearly sales by a substantial margin;
- in relation to Exhibit RBS1, which consists of copies of advertisements in various publications, Mr Whyte notes that that majority of these advertisements date from late 1996 and early 1997 and further comments that all of the exhibited advertisements date from after the date of the application in suit, thus making them irrelevant for the purposes of the present opposition;
- in relation to Exhibit RBS2, Mr Whyte notes that over half of the invoices (36 out of 55) are dated well after the date of the application in suit. Of the remaining 19, these appear to point towards a small volume of sales to a small group of customers before September 1994. Six out of the 19 invoices of relevant date are made out to Robert Horne Paper Company Limited, which is a company which assisted the applicants in these proceedings, in obtaining allowance of the application at ex-parte stage. Exhibit WW7 consists of a copy of a letter dated 1 August 1996 from the Marketing Director of Robert Horne Paper Company Limited, in which the writer states that "In my opinion the "CLASSIC" brand of stationery, text and cover papers within the UK is firmly a product from the Curtis Fine Papers stable";
- exhibit WW6, being Mr Whyte's previous statutory declaration mentioned above, states that CLASSIC was first used as a trade mark by the applicants in 1972, and has been in continuous use ever since. Sales figures for the years 1986 to 1994 in the UK are as follows:

Year	Quantity (tonnes)	Quantity (in reams)	Turnover (£)
1986	3170	1020740	4,382,436
1987	3387	1090614	4,697,999
1988	4006	1289932	5,893,411
1989	3805	1225210	6,272,899
1990	3424	1102528	6,047,772
1991	2875	919954	5,036,994
1992	2380	766360	4,241,467
1993	2151	692622	3,907,198
1994	2074	667828	3,852,515

- the applicants spend a substantial amount on advertising, for example, it produces swatch booklets of the type exhibited at Exhibit WW1. Expenditure on advertising for CLASSIC is currently approximately £250,000 per annum;

- as well as appearing on all literature relating to CLASSIC products, the name CLASSIC is also predominantly displayed upon all boxes of CLASSIC paper sold by the applicant. Exhibit WW3 shows a photocopy of a typical box lid.
- the name CLASSIC also appears as a prominent watermark on the vast majority of paper produced in the CLASSIC range (Exhibit WW4).
- CLASSIC goods are sold throughout the United Kingdom through a number of individual distributors. Exhibit WW5 consists of a list of such distributors.

### **Opponents' further evidence**

13. This consists of a statutory declaration, dated 26 July 2000, from Katherine Patricia Ann Sainsbury. Ms Sainsbury explains that she has been employed by Farncombe International Limited for two and a half years as an Intellectual Property Investigator. Her company were instructed by the opponents' Trade Mark agents to conduct an investigation into the use made of the name CLASSIC in respect of stationery paper. Exhibit KPAS consists of the original copy of this report dated 18 May 2000. The relevant points to emerge from which are as follows:

- in perusing the Viking Office Products Catalogue, they noted use of the word classic as a descriptive term for Viking Direct Bond paper (p.46):
 

“Elegant finish: Strong 100gsm paper with a classic laid or wove finish that adds class to your correspondence.”;
- having examined the South Coast Office Equipment Catalogue, they found use of the word classic as a descriptive term for Parchment Paper and envelopes (p 573):
 

“Creating a lasting impression with this traditional classic paper with matching envelopes”;
- on examination of three different paper trade publications, they found other companies using the word CLASSIC, either alone or in conjunction with other elements;
- on 10 May 2000, Farncombe made an approach to The Paper Federation of Great Britain, who informed them that two manufacturers were listed as making Classic papers, the applicants and a company called Howard Smith Paper Ltd (whom it subsequently transpired were distributors for the applicants). The Federation also provided a list of companies using the word classic in their name, of which there were four;
- on contacting the journal Paper Focus, the investigator spoke to the News and Environment Editor, who advised that the name Classic in relation to paper had been used by a few people; he went on to mention the applicants as being a manufacturer of a range of papers called Classic;



- the investigation also found a variety of websites which referred to the word Classic in relation to paper products.
- The report did not offer any conclusions.

### **Applicants' further evidence**

14. This consists of two witness statements. The first, dated 27 May 2002, is from Ross Timothy Manaton. Mr Manaton explains that he is a Registered Trade Mark Agent and a partner in the firm of JY & GW Johnson, the applicants' professional representatives in these proceedings. Mr Manaton confirms that he has read the statutory declaration of Katherine Sainsbury and the report prepared by Farncombe International Limited. He notes that the report makes reference on pages 11 and 13-15 to various internet web-sites alleged to contain material in which CLASSIC is used in respect of paper. Mr Manaton has consulted a "whois" database and copies of the printouts of the details of the registrations of the websites listed in the Farncombe report are provided as Exhibit RTM1. Mr Manaton comments that, apart from [www.scprok.sk](http://www.scprok.sk), all the websites appear to have been created after the date of the application in suit and cannot therefore assist the opponents in establishing the significance of the word CLASSIC at the filing date of the application in suit. In respect of [www.scprok.sk](http://www.scprok.sk), Mr Manaton has been unable to establish a date of creation, but has discovered that the site is registered in the Slovak Republic in the name of a Slovakian Company. Its contents do not, therefore, appear to have relevance to the meaning of the word CLASSIC in the United Kingdom.

15. The second witness statement, dated 23 May 2002, is from the same William Whyte mentioned above. Mr Whyte confirms that he has read a copy of the declaration made by Katherine Sainsbury and the report exhibited to it. He comments on the report as follows:

- although the report lists company entries in various trade directories, it does not establish what if any use, within the United Kingdom, the companies have made of the goods cited in the relevant entries. Neither does the report make clear whether the cited companies are manufacturers, retailers etc of papers nor whether they use any other marks in relation to the papers;
- Mr Whyte notes at paragraph 2.2.3 of the report the use of the word Classic as a descriptive term for Viking Direct Bond paper, but does not consider this is a usual or typical way to describe paper of this type. Most of the references to "Classic" in the report are, he says, to its use in a trade mark sense rather than in a descriptive sense;
- Mr Whyte comments that he was aware that the company called Hartmann & Cie GmbH did at one time commence using CLASSIC in a trade mark sense in respect of paper. However as a result of objections by the applicants, Hartmann agreed not to use CLASSIC in relation to paper, envelopes or card. Exhibit WW9 consists of a copy of this agreement;

- the only other companies mentioned in the Phillips Directories are Fedrigoni & C SpA Cartiere, Shree Vindhya Paper Mills Ltd and MD Papier GmbH. These are all foreign companies and Mr Whyte states that he is not aware that any of them sell any goods bearing the trade mark CLASSIC in the United Kingdom. Mr Whyte is also of the view that reference to these companies in an international trade directory is not evidence of sales of goods bearing the mark CLASSIC in the United Kingdom;
- in relation to the companies listed at paragraph 2.8 of the report, which are all said to use marks including the word Classic, Mr Whyte considers that in each case Classic is used in a trade mark sense. Apart from Zanders Classic, Mr Whyte is not aware that any of the marks are used in the United Kingdom;
- Mr Whyte explains that he is aware of the existence of the company called Classic Papers mentioned in paragraphs 2.16 to 2.18 of the reports, but understands that they sell a completely different type of paper from that of the applicants;
- by way of conclusion, Mr Whyte states that there is nothing in Ms Sainsbury's declaration that changes his opinion that in the United Kingdom, and in respect of the goods covered by the application in suit, the mark CLASSIC is recognised as indicating goods emanating from the applicants. In his opinion, the overall weight of Ms Sainsbury's declaration supports this view. The remainder of Mr Whyte's witness statement consists of opinion evidence, which I do not propose to recite here.

16. That concludes my review of the evidence filed in these proceedings, in so far as I consider it necessary.

### **Decision**

17. Although the opponents' statement of grounds makes reference to Sections 9(1)(c), (d) and (e) of the Act, I note that this application was advertised before acceptance in Part B of the Register. I need only consider, therefore, the matter in relation to the provisions of Section 10 of the Act. **The objections based on Section 9 of the Act are dismissed.** Section 10 reads as follows:

“10 (1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to the limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid

the tribunal may have regard to the extent to which -

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and
  - (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.
- (3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.”

18. Prior to the hearing, I had advised both Counsel that my starting point in these proceedings would be the decision of Mr Justice Whitford dated 4 May 1982 in relation to an application dated 30 January 1979 by *W.G.Allen (Birmingham) Limited* for the trade mark CLASSIC in Part A of the register in respect of the following goods in Class 21:

“Hardware and hollow ware, all being small domestic utensils, none of precious metals or coated therewith, glassware, porcelain and earthenware, all included in Class 21.”

In that decision, which was an appeal to the Court from an ex parte decision of the Registrar, Whitford J concluded that notwithstanding the Hearing Officer’s conclusion that the trade mark had become factually distinctive of the applicants’ goods (a finding which Registrar’s Counsel felt was on the evidence generous in the extreme), the word CLASSIC was a word that in relation to the goods for which registration was sought other traders might without any improper motive wish to use and the appeal was dismissed.

19. Having accepted that the onus was on the applicants to establish that the trade mark in suit was both inherently capable of distinguishing and capable of distinguishing in fact, Ms Himsworth sought to distinguish the decision of Whitford J from the instant proceedings. Before doing so however, Ms Himsworth noted that the Judge in the earlier proceedings not only reviewed the evidence filed by the applicants in support of the application for registration, an approach which if, as a matter of law, the word CLASSIC in relation to the goods for which registration was sought was unregistrable would have been unnecessary, but also noted that the word CLASSIC was the subject of a number of trade mark registrations (both at the time of the earlier decision and since). In her view these facts clearly indicated that as a matter of law the word CLASSIC was capable of registration.

20. Returning to the earlier decision, Ms Himsworth drew to my attention the decision (also of Whitford J) in *CHUNKY* trade mark [1978] FSR 322. In particular, Ms Himsworth pointed out, that the test for registration in Part B of the Register constitutes a “lesser test” to that of registration in Part A; that whilst in the *W.G.Allen* proceedings mentioned above the Judge referred to the evidence that was before him, commenting that there was not a lot of it, in the instant proceedings there was not only substantial

evidence of use of the trade mark, but also supporting evidence from the trade and competitors; that whilst the Judge found in the earlier proceedings that other traders may want to use the trade mark without improper motive, that was not the case in these proceedings given the trade evidence mentioned above, and that the word CLASSIC was not in use in the trade as an indication of a grade of paper.

21. For his part Mr Edenborough argued that a trade mark which was not capable of achieving registration in Part A of the Register i.e. of becoming adapted to distinguish should not be registered in Part B of the Register (as per paragraphs 8-74 to 8-75 of the 12<sup>th</sup> edition of Kerly's Law of Trade Marks & Trade Names). I will return to this point later in my decision. As a consequence, Mr Edenborough argued that even if I found the trade mark to be 100% factually distinctive of the applicants' goods, it would still be unregistrable.

22. The word CLASSIC has been registered on a number of occasions. The instances of such registration were helpfully attached to Ms Himsworth's skeleton argument. Those registered prior to the introduction of the 1994 Trade Marks Act are as follow:

272718 (1905) – “boots, shoes etc”:	accepted prima facie;
288792 (1906) – “blackings, polishes etc”:	accepted prima facie;
352505 (1913) – “typewriter ribbons”:	accepted prima facie;
485610 (1927) – “gas fires”:	based on use;
483423 (1927) – “radiators for heating”:	based on use;
651718 (1946) – “lampshades”:	based on use;
1344575 (1988) – “financial services etc”:	based on use.

(I note that all of the above trade marks were registered in Part A of the Register).

23. A number of these earlier registrations were referred to by Whitford J in his decision mentioned above. In considering the earlier acceptances he said:

“Before me Mr Laddie adopted the same stance as we find in the decision the subject of appeal, namely, that these words may well have been wrongly admitted to registration. When one is considering an application under Part A or under Part B one is of course always considering the significance of the word and its possible descriptive or laudatory connotations in connection with particular categories of goods, and I suppose it is possible that, in the circumstances of these particular cases, there was evidence that was available which may have assisted the applicants for registration in establishing an inherent capacity to distinguish in relation to the particular goods for which registration was secured.”

24. Thus it appears to me that notwithstanding the decision of the Court Of Appeal in *W. N. Sharpe Ltd v Solomon Bros Ltd* [1915] RPC Vol.32 when they said of the word CLASSIC in relation to Christmas and other greeting cards:

“In our view, CLASSIC is, in the language which I clearly quoted from the judgement of the Master of the Rolls in the PERFECTION case, a word incapable of being treated as “adapted to distinguish” or as having a secondary meaning as indicating only the goods of the applicant. Mr Justice Warrington has held otherwise on the double ground that it is a word indeterminate in meaning and also rare and unusual as applied to the particular goods. With all due respect, we cannot find in the facts of this case any sufficient ground for attributing to the word CLASSIC either of the qualifications for registration as a trade mark”,

Whitford J held that if appropriate evidence was provided the word CLASSIC in relation to certain categories of goods may not be completely lacking in inherent distinctiveness and as such was potentially registrable. I see no reason to dissent from this view and approach the matter on this basis.

25. That being the case, and keeping in mind the dictionary definitions of CLASSIC as per Collins English Dictionary (5<sup>th</sup> Ed 2000) which defines the word in the same terms as it did when the application was filed, namely (inter alia): “of the highest class, esp. in art or literature; serving as a standard or model of its kind; definitive; of lasting interest or significance; continuously in fashion because of its simple and basic style”, I now go on to consider the evidence filed by the parties to support their various positions.

26. At the hearing both Counsel appeared to accept that a good deal of the evidence provided by both parties was either after the material date in these proceedings or contained hearsay. That said, both Counsel also appeared to accept that I should not completely disregard evidence falling into these categories, but to give it such weight as I felt appropriate. That is indeed how I intend to proceed.

27. The applicants evidence of use of their trade mark is contained in exhibit WW6 to the first statutory declaration of William Whyte (evidence which I note was filed in support of the application at the ex parte examination stage). In his earlier declaration dated 29 November 1995, Mr Whyte explains that the applicants first made use of the CLASSIC trade mark in 1972 adding that the mark has been in continuous use since that time. Exhibit WW1 is said to consist of a box containing various swatch booklets showing the range of products sold under the CLASSIC trade mark. In the evidence before me in these proceedings I have only a photocopy of what appears to be the lid of a box, which I note bears the word CLASSIC in lower case together with a device of a square inside of which are to be found somewhat stylised representations of what appears to be the lower case letters “jr”; also present are the words James River Fine Papers. Sales figures of goods sold in the United Kingdom and bearing the CLASSIC trade mark are provided between 1986 and 1994 and amount to some £44m. Advertising spend on goods bearing the CLASSIC trade mark is said to amount to £250k per annum. Exhibit WW2 is said to

consist of examples of swatch booklets from previous years. However once again I have only two photocopied pages to consider. I note that the first contains the word CLASSIC in a square border below the device of a crown. The document also appears to contain the words Guard Bridge (which I understand to be one of the applicants' previous company names) together with a distinctive device element. The second document contains the word CLASSIC below the device of a crown, but also includes the word CLASSIC in a repeated stylised script. This document also contains the words Cutler Guard Bridge and a device element. Exhibit WW3 consists of a photocopy of what Mr Whyte describes as a typical box lid. Once again I note that this document bears the word CLASSIC in lower case together with what (again) appears to be the letters "jr" presented in a square and the words James River Fine Papers. Mr Whyte adds that the word CLASSIC also appears as a watermark on the vast majority of paper produced in the CLASSIC range. Exhibit WW4 consists of a sheet of paper which, I note, bears the word Classic together with a device of a crown. Finally I note that the applicants' goods are sold throughout the United Kingdom by a number of distributors – exhibit WW5 refers.

28. In support of their case for registration the applicants have also provided evidence from both a trade body and a competitor within the paper industry. In his declaration Mr Bateman, who is Director of Special Projects at the Paper Federation of Great Britain comments:

“Naturally, I am aware that the word CLASSIC can be used in a descriptive sense, but in my experience the word is not used in the paper industry to indicate any particular kind or grade of paper. I therefore do not feel that the possible descriptive meaning of CLASSIC in any way diminishes the fact that, in respect of business stationery CLASSIC exclusively identifies goods from Curtis Fine Papers Ltd.”

29. Declarations have also been supplied by Mr Kay and Mr McLean both of Inveresk PLC, who are a competitor of the applicants based in Scotland. The following quote from Mr Kay's declaration encapsulates both declarants view of the position. Mr Kay says (by reference to Mr McLean's declaration):

“I entirely support all of the statement made in that declaration. In particular, I agree with Mr McLean that I regard CLASSIC as being the exclusive mark and the sole property of Curtis Fine Papers Limited in relation to papers and boards for use as stationery and the like. I too know of no other company in the United Kingdom which uses CLASSIC in relation to any such goods, and in view of the reputation which Curtis Fine Papers Limited has acquired in the mark CLASSIC I cannot envisage that any other company could legitimately wish to use CLASSIC for its own goods, or could in fact do so without causing confusion with Curtis Fine Papers Limited.”

30. For their part, the opponents have provided evidence from Herr Salzer of their use of their trade mark together with evidence of an investigation conducted into the use of the word CLASSIC in relation to stationery paper by Ms Sainsbury of Farncombe

International Limited. In his declaration dated 7 January 1999, Herr Salzer explains that the opponents manufacture paper of various grades and in respect of each the opponents use a trade mark and a description or grade indicator. He says that the opponents have since 1982 sold in the United Kingdom a grade of paper referred to as CLASSIC under their ZANDERS trade mark. In this regard, I note that Mr Bateman of the Paper Federation of Great Britain has commented that in his experience the word CLASSIC is not used in the paper industry to indicate a particular kind or grade of paper; I shall return to this point later in my decision. Herr Salzer goes on to give the annual sales of paper graded as CLASSIC. I note that in the period 1989 to 1994 the figures are said to amount to some £48k. In this regard, I note that Mr Kay comments that these figures represent an entirely trivial amount when compared to the size of the United Kingdom market. Herr Salzer adds that the opponents advertised goods sold under the CLASSIC trade mark during this period, but separate budgets had not been established. Exhibits RBS1 consist of copies of the applicants' trade literature together with advertisements from the trade press, all of which I note post-date the material date in these proceedings (the majority of the documents dating from 1997). The opponents' goods have been distributed by both John Heyer Paper Limited and more recently Zanders Fine Papers of Kent. Exhibit RBS2 consists of a selection of invoices bearing the ZANDERS CLASSIC trade mark. Once again I note that many of these invoices post-date the application for registration. Exhibits RBS3 and RBS4 consist respectively of a range of trade mark applications in Class 16 which contain the word CLASSIC together with a selection of brochures showing use of the word CLASSIC by a number of the proprietors mentioned in exhibit RBS3. Whilst it is well established that the state-of-the-register is, in principle irrelevant (as per *Jacob J in British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281), I note that of the relevant registrations provided, the word CLASSIC is subject to a disclaimer in all five. Of the brochures provided in RBS4 they are either undated in the case of the Acco Eastlight brochure or after the material date in so far as the Tetra Pak brochures are concerned (dated 6/96).

31. In her report dated 18 May 2000, Ms Sainsbury explains that her firm was instructed to conduct an investigation into the use made of the word CLASSIC in the context of stationery paper. The instructions highlighted the need to establish use of the word CLASSIC prior to 1994 and in relation to stationery papers available in the United Kingdom. The results of Ms Sainsbury's investigations are summarised earlier in this decision. Whilst at the hearing Ms Himsworth accepted that the investigation involved a number of detailed enquiries, she urged me to consider the nature of what was on occasions either double or triple hearsay, that a number of the documents to which Ms Sainsbury refers were after the material date in these proceedings, whilst others referred to international paper trade directories which, in her view, were not necessarily indicative of the position in the United Kingdom (a view which Ms Himsworth felt was supported by the evidence from the trade and a competitor filed by the applicants and mentioned above). For his part Mr Edenborough accepted that while the evidence provided was not perfect, it did demonstrate that third parties not related to the applicants wished to use the word CLASSIC. In his witness statement dated 23 May 2002, Mr Whyte comments in detail on the results of the Farncombe investigations; a summary of his comments are reproduced above.

32. At the hearing Mr Edenborough took me to Mr Whyte's witness statement commenting that:

“Still with the third witness statement of Mr Whyte what is interesting is when he is trying to deal with the evidence that turned up in evidence in answer, the evidence that showed use by the various unrelated third parties of the mark CLASSIC by a series of slicing away, he tries to distinguish it from the present case.”

Having analysed a number of Mr Whyte's comments Mr Edenborough concluded:

“All of those types of use are upon items that are very close to what the applicants say they use their mark upon and yet they have attested that the mark would be distinctive of their goods and on each and every occasion they have tried to draw a distinction between the goods upon which the applicants' mark is being used. In my submission that is trying to draw a distinction which is far too fine and is actually impossible to draw in practice with respect to the specification.”

33. In response to a question from me regarding the supporting evidence the applicants had furnished from both the Paper Federation of Great Britain and Inveresk Plc Mr Edenborough said:

“You can adduce witnesses to say what you like. We do not know how many people there are. We do not know how many negative responses they received. Just because they have trooped in four people or so who have given an affirmative answer does not mean that that is actually a balanced view of the whole trade.”

34. In response to this comment Ms Himsworth said:

“What has been done is respectable trade bodies have been approached, as was very much the standard practice under the 1938 Act, which I believe is still acceptable practice under European law now, to ask for their position when their position has been freely given and put before you.....Again, I would say that criticism is not something, sir, you can take in mind and I would invite you to put great weight on the evidence that came from members of the trade and the trade organisations that we are talking about in the present case.”

35. What then do I make of this competing evidence? At the hearing I indicated that I was prepared to accept the evidence of Mr Bateman to the effect that the word CLASSIC was not used in the paper industry to indicate a particular kind or grade of paper. I am also prepared to accept (albeit somewhat reluctantly) that, as a matter of law, the word CLASSIC is, in relation to certain goods at least, capable of registration; these of course are both findings in the applicants' favour. However, I have grave concerns regarding the



manner in which the word CLASSIC has been used by the applicants. I have mentioned above the nature of the evidence filed by the applicants in support of the application at the ex parte examination stage. I have also mentioned that this evidence was not filed in the same format in these proceedings; I have therefore only the photocopied extracts at WW1, WW2 and WW3 (and not the originals) to go by.

36. In my view all of these exhibits show the use of the word CLASSIC in combination with one or more other elements i.e. the name JAMES RIVER FINE PAPERS, the stylised lower case letters JR presented in a square, a crown device, a device element distinctive in its own right and the words GUARD BRIDGE and CUTLER GUARD BRIDGE. Given the various (laudatory) meanings of the word CLASSIC referred to above, I am not convinced that on encountering the applicants' goods marked in this manner a potential customer for the goods concerned which, given the nature of the goods must be a member of the general public, may not simply see the word CLASSIC as indicating the premier range of goods from, for example, JAMES RIVER FINE PAPERS, or from GUARD BRIDGE or CUTLER GUARD BRIDGE. Whilst state-of-the-register evidence is rarely conclusive, I note that of the five relevant registrations revealed in Class 16, the word CLASSIC is in each case accompanied by a distinctive element and the word CLASSIC is disclaimed in them all. I also note that the opponents' use of the word CLASSIC is in much the same format i.e. ZANDERS CLASSIC.

37. Of course this is not an end to the matter as the applicants have also filed evidence from a trade association and one competitor in the paper industry. Mr Edenborough's views on how I should approach this evidence is reproduced above. Whilst I have no doubt that the individuals concerned gave their opinions in good faith, I think there is some force in Mr Edenborough's criticisms. For example, no information has been provided as to whether the views of other trade associations or competitors or members of the general public were sought. In light of the highly objectionable nature of the word CLASSIC in relation to a wide range of goods such an approach would not seem unreasonable; I must of course also keep in mind the results of Ms Sainsbury's investigation, subject of course to Counsel's submissions, on the weight to be attached to her findings. In my view the independent evidence provided does not establish that the general public would recognise the word CLASSIC as indicating "Papers, board and envelopes; all for use as writing paper or as stationery for graphics and printing" as originating exclusively from the applicants. One can well understand that experts in the trade concerned (for that is after all what Messrs. Bateman, Kay and McLean are) may take the view that they have. However, in my opinion, whilst helpful their view of the matter is far from determinative of the position.

38. Therefore, taking all of the relevant factors into account i.e. the highly laudatory nature of the word CLASSIC, the judicial approach that has been taken by the Courts to attempts to register the word over the years, the manner in which the applicants' have made use of the word i.e. with other distinctive elements together with the use which appears to have been made of the word CLASSIC in the paper industry generally, I have come to the conclusion that notwithstanding the independent evidence provided by The Paper Federation of Great Britain and Inveresk Plc, the applicants have not established

that the word CLASSIC is capable of distinguishing their paper goods in Class 16 from those of other traders in the same field. **As a consequence of that conclusion the opposition based on Section 10 of the Act succeeds** and it is not necessary for me to comment any further on Mr Edenborough's Part A, Part B point mentioned at paragraph (19) above.

### **Costs**

39. As the opponents have been successful in these proceedings they are entitled to a contribution towards their costs. I order the applicants to pay to the opponents the sum of £1200. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 24th day of September 2003**

**M KNIGHT  
For the Registrar  
The Comptroller-General**