

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

**IN THE MATTER OF Trade Mark**

**Registration Nos. 1166210 and 1339716**

5 **in the name of News Limited**

**AND IN THE MATTER OF**

**APPLICATIONS 8103 & 8104 FOR RECTIFICATION**

10 **of the register by the removal therefrom of the  
above named registrations**

**BACKGROUND**

15 On 6 June 1994, Henri Fetter Fashion B.V. applied under Section 32 of the Trade Marks Act  
1938 for the rectification of the register by the removal therefrom of registration No 1339716.  
The trade mark concerned consists of the word NEWS. It is registered for:-

20 “Articles for clothing for men and for boys; parts of fittings for all the aforesaid goods;  
all included in Class 25”.

The date of registration is 26 March 1988. The registration currently stands in the name of  
News Limited.

25 The grounds for rectification are as follows:-

1. The applicant for rectification has filed various applications for the registration  
of marks consisting of or containing the word NEWS and registration No  
1339716 represents a fatal barrier to these applications under Section 12(1) of  
30 the Trade Marks Act 1938. The applicant therefore qualifies as a “person  
aggrieved”.

2. The applicant has used the trade mark NEWS on a substantial scale since 1985 and, at the time that application No 1339716 was filed on 7 March 1988, the applicant for registration (Clubclass Limited) was not therefore entitled to claim to be the proprietor of the trade mark. The registration of the mark was therefore contrary to Sections 17(1) and 68 of the Trade Marks Act 1938.

3. Use of the mark registered under No 1339716 by the proprietor thereof was liable to cause deception and the registration was therefore contrary to Section 11 of the Trade Marks Act 1938.

4. The applicant is the registered proprietor of trade mark registration No 1256552 - NEWS FLASH plus device - which is registered in Class 25 with effect from 16 December 1985. The registration of the mark NEWS under No 1339716 was therefore contrary to Section 12(1) of the Trade Marks Act 1938.

On 6 June 1994 the same applicant applied under Sections 26 and 32 of the Trade marks Act 1938 for the rectification of the register by the removal therefrom of registration No 1166210, which is also registered in the name of News Limited. The mark is a device which is reproduced below.



Hereinafter I will refer to this mark as the “newsreel” mark. The date of registration is 9 December 1981. The specification of goods is “articles of clothing” in Class 25.

The grounds for the removal of this mark are that:-

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1. For the same reasons as set out above in relation to the application to remove registered trade mark No 1339716, the applicant is a “person aggrieved.”

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2. The “newsreel” mark has not been used by the proprietor or on his behalf for a continuous period of five years ending one month before the date of the application for rectification.

The registered proprietor denies all of the grounds for rectification and initially contested that the applicant was a “person aggrieved”.

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These matters came to be heard on 11 November 1998, when the applicant was represented by Mr H Carr QC, instructed by D. Young & Co, and the registered proprietor was represented by Ms D MacFarland of Counsel, instructed by Carpmaels and Ransford.

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By the time these matters came to be heard the Trade Marks Act 1938 had been repealed. However under the transitional provisions set out in Schedule 3 of the Trade Marks Act 1994 I must continue to apply the provisions of the old law to these proceedings. Accordingly, all further references in this decision to sections of the Act are references to the provisions of the old law.

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Although the proceedings have not been consolidated the registered proprietor’s evidence is common to both proceedings and it is common ground that the result of the attack on registration No 1339716 has a bearing on the outcome of the application to remove registration No 1166210.

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My decision will therefore cover both of these applications. I will deal with each application

in sequence. The first point I must decide is whether the applicant qualifies as a “person aggrieved” for the purposes of Sections 26 and 32 of the Act. Section 32 is as follows:

5 32.-(1) Any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the Court or, at the option of the applicant and subject to the provisions of Section 54 of his Act, to the Registrar, and the tribunal may make such order for making, expunging or varying  
10 the entry as the tribunal may think fit.

Section 26 contains a similar requirement that the applicant be a “person aggrieved”.

Ms MacFarland did not pursue this matter at the hearing. I think she was right not to do so.

15 In the light of the Powell trade mark case (1894) 11 RPC 4 and the Zonophone case (1903) 20 RPC 450, there can be no doubt that the circumstances justify the applicant’s claim to be a “person aggrieved”. I next consider the application for the removal from the register of registration No 1339716, the word NEWS solus.

## 20 **APPLICANT’S EVIDENCE**

The applicant filed a declaration dated 19 June 1996 by Peter H. van der Meché, who is the Financial Director of Henri Fetter Fashions B.V. The following extracts from Mr Meché’s declaration appear to me to be the most relevant:-

25 “The trade marks register confirms that the original proprietors of registration No 1339716, subject of this rectification action, were Clubclass Ltd and that the registration was subsequently assigned to News Limited, the current proprietors in circa 1990. At the time of filing application No 1339716 on 26 March 1988, Clubclass  
30 Ltd could not claim to be the true proprietors of the mark in view of my company’s own use of the mark NEWS in the United Kingdom since February 1985. Details of my company’s use of NEWS since 1985 are given below.

35 My company first sold goods under the trade mark NEWS in the United Kingdom in February 1985 although the first promotions of such goods took place in late 1994.

In support of my company’s claim to first use of the trade mark NEWS in the United Kingdom in February 1985 there is now produced and shown to me “PHvdM 1”

copies of invoices all dating from 1985. These invoices refer to BALL/NEWS. These references may be explained as follows. My company originally acted as manufacturer for BALL clothing for a third party company in the early 1980s. My company then created its own label NEWS for its clothing but continued to manufacture and distribute BALL Clothing also. I confirm that the two marks BALL and NEWS were used separately as garments (*this is obviously intended to say "as trade marks for garments"*).

The approximate annual turnover figures for goods sold under the trade mark NEWS in the United Kingdom for the years 1985/1988 are as follows:-

Year	£
1985	145,440
1986	446,357
1987	506,647
1988	180,557

During the years 1985/1988 and subsequently, my company and its distributors have promoted the goods sold in the United Kingdom under the trade mark NEWS by the publication and distribution of catalogues and there is now produced shown to me marked "PHvdM 2" copies of such catalogues dating from 1987 and 1988.

There is now produced and shown to me marked "PHvdM 3" clothing labels and five copies of photographs of garments, a copy of a photograph of a model wearing a NEWS garment which I confirm relate to garments sold in the United Kingdom in 1985.

My company's distributors in the United Kingdom have regularly promoted the goods sold under the NEWS mark by participating in national exhibitions including the Premier Menswear and Exhibition at the NEC in Birmingham, the N.A.B. (mens and boys) Exhibition (which no longer takes place) and the Imbex Exhibition. There is now produced and shown to me marked "PHvdM 4" extracts from the Imbex 1988 catalogue relating to the exhibition held in London during 21/24 February 1988. At that time, my company's distributors were Newsflash UK and at that time, Newsflash UK distributed my company's clothing in the United Kingdom under both the NEWS and NEWSFLASH trade marks. I confirm that both trade marks were promoted at the Imbex '88 Exhibition."

I find that Exhibits PHvdM 1, 2 and 4 to Mr Meché's declaration provide little independent support for the claims made in his evidence. However, Exhibit PHvdM 2 does contain a catalogue which provides support to the applicant's claim to have used the mark NEWS as a trade mark for mens casual clothing, at least from 1987.

The applicant also filed a statutory declaration dated 17 June 1996 from Denton Charles Guest, who is the Managing Director of Holywell Trading Co. Limited. Mr Guest states that his company has been the sole distributor of Henri Fetter's NEWS range of clothing since 1991. The most relevant parts of his evidence are reproduced below:-

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"I have held my present position since 1987 and formally I was a sole trader acting as Sales Agent for the brands NEWSFLASH and NEWS CLOTHING both said by Henri Fetter Fashion B.V. (herein after called Henri Fetter) from late 1984.

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I have been personally aware of the NEWS trade mark of Henri Fetter since late 1984 when I was appointed as Sub-Agent to Henri Fetter's main United Kingdom distribution agent Bugatti Agency and later re-named Academy Distribution Limited. The first customer orders for NEWS CLOTHING were placed in late 1984 in preparation for delivery and sales in 1985. The first time NEWS CLOTHING was exhibited at a trade show in the United Kingdom was at the NEC in Birmingham

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19/21 February 1985 and I was personally involved in promoting clothing under the NEWS trade mark at that exhibition on Henri Fetter's behalf.

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The product NEWS was promoted between 1985 and 1991 by all our UK retail customers by the use of in-store promotional material such as posters and catalogues."

The applicant's evidence also includes statutory declarations from three clothing retailers, Brian William Smith, Graham Dibb and Jeffrey Bookman, who say that their companies have purchased and stocked mens clothing under the mark NEWS from Henri Fetter Fashion B.V. since 1985. They also say that they associate the mark NEWS with the applicant.

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### **REGISTERED PROPRIETOR'S EVIDENCE**

The registered proprietor's evidence consists of a statutory declaration dated 29 April 1997 by Richard Carnill, who is a Director of News Limited. The most relevant parts of Mr Carnill's evidence are as follows:-

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"The registration was assigned to my company by Clubclass Ltd in 1991. The mark of trade mark registration No 1339716 was in use when my company purchased the registration.

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Empire Stores Ltd are registered as registered users of the registration under No RU83241.

5 The registration was first used in the United Kingdom by my company's predecessors  
in title or under license before March 1990. The registration of my company has been  
in use in the United Kingdom since the date of first use either by my company, their  
predecessors in title or under license. My company sees an annual return on clothing  
10 sold in the United Kingdom under the trade mark NEWS of a minimum of £50,000.  
There is now produced and shown to me marked Exhibit RC1 copies of pages from the  
Empire Stores catalogues, Empire Stores being the registered users with regard to the  
registration. The Empire Stores catalogue is distributed throughout the United  
Kingdom. The registration is used in relation to all types of clothing in catalogues  
15 dating from 1992”

The registered proprietor also filed a statutory declaration dated 22 October 1998 by John  
Edward Grundy. Mr Grundy is a Director of Clubclass Ltd, the original proprietor of  
registration No 339716. This evidence was filed after the end of the usual evidence rounds  
15 and only a few weeks before the hearing. The applicant objected to the admission of this  
evidence. Before me Mr Carr contended that no satisfactory explanation for the delay in filing  
the evidence had been put forward, and that the evidence did not add significantly to the  
proprietor's existed evidence on matters that were in dispute. He urged me to reject me as  
irrelevant.

20 Ms MacFarland pointed to the explanation for the delay which had been put forward in  
another statutory declaration dated 23 October 1998 by Nicholas Howick of Carpmaels and  
Ransford. Ms MacFarland urged me to accept the late evidence on the basis of this  
explanation. Ms MacFarland pointed out that the tribunal should have as much information as  
25 possible before it about the use of the registered trade mark under attack.

It did not seem to me that the explanation put forward by the registered proprietor was very  
persuasive. On the other hand the admittance of the new evidence was not, as Mr Carr  
acknowledged, likely to prejudice the applicant in any way. I decided, on balance, to admit  
30 the additional evidence.

The relevant parts of Mr Grundy's evidence are as follows:-

35 “I am a Director of the company Clubclass Ltd of 8 Bunting Road, Moreton Hall  
Industrial Estate, Bury St Edmunds, IP32 7BX. Clubclass Ltd was a wholly owned

subsidiary of Stuncroft Ltd. In 1993 the trade of Clubclass Ltd was transferred to the parent company. I have been a Director of Clubclass Ltd since the date of incorporation, 1979. Clubclass Ltd is now dormant.

5 On 26 March 1988 Clubclass Ltd filed application No 1339716 for registration of the mark NEWS in Class 25 for “articles of clothing for men and boys; parts and fittings for the aforesaid goods”. On 4 December 1989 Clubclass Ltd took assignment, with goodwill, of UK registration No 1166210 NEWS and device from Societ  Nationale D’Exploitation Industrielle des Tabacs et Allumettes. Registration Nos 1166210 and 10 1339716 were assigned with goodwill by Clubclass Ltd to NEWS Limited of 26 Queens Street, St Helier, Jersey, Channel Islands, and this assignment was recorded on 27 September 1991.

15 From the date of purchase of registration No 1166210 from Societ  Nationale D’Exploitation Industrielle des Tabacs et Allumettes until the date at which registration Nos 1166210 and 1339716 were assigned in full to NEWS Limited, Clubclass Ltd used the mark NEWS, and the mark NEWS underlined in red, in relation to men’s suits; jackets and trousers. Clubclass Limited’s clothing bearing the NEWS labels, was sold on a commission basis in outlets of the Burton Clothing Group. Between 1989 and 20 1991, at least 100 Burton Clothing Group outlets carried concessions of Clubclass Limited’s Clothing bearing the NEWS label.

25 During that the time that I was a Director of Clubclass Limited, I was unaware of any use of the mark NEWS or marks similar thereto in the UK in the clothing field by any company other than Clubclass Limited.”

### **DECISION RE 1339716**

30 Section 46 of the Act states that registration shall be prima facie evidence of validity. The onus is therefore on the applicant to show that registration no. 1339716 is not valid. I first consider the claim that the registered proprietor cannot claim to be the lawful proprietor of the trademark in the light of the earlier use of the mark NEWS claimed by the applicant.

35 Mr Carr referred me to the Al-Bassam case before the Court of Appeal (1995 RPC page 511). Morritt L.J. indicated that the ownership of unregistered trade marks should be determined in accordance with the principals of common law. Mr Carr contended that, on the evidence in this case, the applicant was the first to use the mark NEWS in the UK and, accordingly, neither the registered proprietor nor his predecessor in title could claim to be the lawful 40 proprietor of the trade mark. The view expressed by Morris L.J. was also adopted by Ward



L.J. , although Stewart-Smith L.J. reserved his opinion on the point.

The Al-Bassam case was concerned with competing claims to ownership of goodwill and the trade mark which characterised that goodwill in the UK. The comments of Morritt L.J. appear to have wider application but I do not think that they should be regarded as settling that, as a matter of law, only the first user of a trade mark can make a lawful claim to be the proprietor of that mark. There have been a number of cases where the same trade mark has been registered in the name of different proprietors, most recently in the case of Budweiser trade marks (1998 RPC page 669). It appears to me to be clear from the wording of Sections 7 and 12(2) of the Act that, in appropriate circumstances, the same trade mark can be registered in the name of two proprietors for identical goods. That would not be possible if first use of a trade mark in the United Kingdom inevitably had the result of disentitling any other party from making a lawful claim to be the proprietor of an identical trade mark. In contrast to the Al-Bassam case, the parties before me are not disputing entitlement to the same goodwill. Nor is there any suggestion that the registered proprietor's predecessor adopted the mark NEWS dishonestly or with any knowledge of the applicant's use of the same mark. In these circumstances it appears to me that principal issue in this case is the likelihood of confusion and deception.

Mr Carr conceded that his case under Section 17(1) stood or fell together with his case under Section 11. In these circumstances I propose to determine the matter by reference to the provisions of Section 11 of the Act. Section 11 is as follows:

11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

It is clear from the GE case (1973 RPC 297 at 334) that if use of the mark NEWS was likely to cause confusion at the time that it was registered it may be expunged from the register as "an entry made in the register without sufficient cause", unless the proprietor of the mark at that time would have been entitled to have registered the mark by reason of his honest concurrent use thereof before the date of the registration.

The applicant claims to have used the mark NEWS in relation to mens casual clothing since early in 1985. This about 3 years prior to the filing of application (now registration) 1339716. The use claimed is modest but not de minimis. Clear examples of such use are few. This is not entirely surprising given the passage of time. However, taking the applicant's evidence  
5 together with the evidence of Messrs Guest, Smith, Dibb and Bookman, I am prepared to accept that the applicant used the mark NEWS from 1985, in the UK, in relation to mens clothing.

It is clear from Mr Grundy's evidence that there was no use of the registered trade mark  
10 NEWS by its original proprietor before the date of the application for the registration of that mark on 26 March 1988.

It is common ground that the appropriate test to be applied under Section 11 is that set out in Smith Hayden's Application (1946 63 RPC 97 at 101) as adapted by Lord Upjohn in the  
15 BALI trade mark case 1969 RPC 472 at 496. Adapted to the matter at hand the test maybe expressed as follows:-

20 "Having regard to the use of the name NEWS by the applicant, is the tribunal satisfied that, at 26 March 1988, use of the trade mark NEWS by the registered proprietor's predecessor in title was not reasonably likely to cause confusion and deception amongst a substantial number of persons?"

I bear in mind that in the BALI case referred to above, Lord Upjohn cautioned that the requirement for confusion and deception amongst a "substantial number of persons" was a  
25 matter of judicial gloss to be applied properly and sensibly. I also note that Lord Upjohn expressed his approval of the comments of Romer J. in JELLINEK's application (1946 63 RPC 59, which are as follows:-

30 "It is not necessary in order to find that a mark offends against Section 11 to prove that there is an actual probability of deception leading to a passing off or (I add) an infringement action. It is sufficient if the result of the registration of the mark will be that a number of persons will be caused to wonder whether it might not be the case the two products come from the same source. It is enough that the ordinary person entertains a reasonable doubt, but the Court has to be satisfied not merely that there is  
35 a possibility of confusion; it must be satisfied that there is a real tangible danger of

confusion if the mark which it is sought to register is put on the register.”

Ms MacFarland contended that the applicant’s use was tainted because they had simultaneously used other marks such as NEWSFLASH and BALL/NEWS during the period prior to 1988, and further that such use of the mark NEWS that had occurred was through various third parties without sufficient acknowledgement that the goods at issue were those of the applicant. In Ms MacFarland’s submission this is likely to have led to the result that at the relevant date, the public did not associate the word NEWS with goods from any single source.

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Mr Carr argued that, evidentially, this argument did not get off the ground. I think he is right. It is not unusual for the same trader to use a number of different trade marks. Nor is it necessary for the public to know who is the proprietor of the mark. It is sufficient for the public to associate goods under a mark with a single source of trade origin. The only independent evidence on this point comes from Messrs Smith, Dibb and Bookman, and they seem quite clear that the goods they have stopped since 1985 under the trade mark NEWS originate from a single source, namely the applicant.

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In my view, the applicant’s evidence is sufficient to establish significant earlier use of the trade mark NEWS in relation to mens casual clothing. I think it is also sufficient to establish that, at the relevant date, use of the mark NEWS by the registered proprietor’s predecessor in title in relation to mens and boys clothing was likely to cause a number of persons (and probably a substantial number of persons) to have had cause to wonder whether the registered proprietor’s goods were connected with the applicant.

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I acknowledge that there is no evidence of actual confusion. That does not mean that there has not been any. Origin confusion generally comes to light when customers are either dissatisfied and try to return goods to the wrong trader - which is less likely in the clothing trade because most goods are sold through retailers - or are highly satisfied and try to place subsequent orders with the wrong trader - which is always possible but less likely when (as in this case) the respective use of the marks is modest. Given that the marks are identical, I believe that the potential for confusion is obvious. I conclude that the original registration of the mark NEWS

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under No. 1339716 in relation to all the goods for which it is registered was contrary to the provisions of Section 11 of the Act.

5 I record here that, at the Hearing, Mr Carr indicated that the applicant was not pursuing the ground of rectification based upon Section 12 of the Act. In the light of this and my finding under Section 11, I need therefore say no more about that.

10 Section 32 of the Act gives the Registrar a discretion not to remove a registration that was originally made contrary to Section 11 of the Act. The only relevant matters that have been drawn to my attention are:-

1. The use that has taken place of the trade mark NEWS by the registered proprietor and its predecessor in business since 1989;
- 15 2. The acquisition on 4 December 1989 by Clubclass Limited of the “Newsreel” mark, which has been registered for articles of clothing since 9 December 1981.

20 I have carefully considered these matters but have come to the conclusion that there are no grounds for exercising the Registrar’s discretion adversely to the applicant. I have reached this conclusion for the following reasons:-

1. The registered proprietor is unable to demonstrate any use by it or its predecessor in title of the mark NEWS prior to the date of registration;
- 25 2. The applicant’s mark is identical to the opponent’s mark (and the evidence suggests they have been used on identical goods) and this is not therefore a case where both marks can be registered and used concurrently without a significant likelihood of confusion;
- 30 3. The registered proprietor’s use of the mark after the date of registration does not appear to be substantial. The only sales figures provided are by Mr Carnill, who says

that sales of clothing under the NEWS mark amount to a “minimum of £50,000” per annum;

4. This appears to be substantially less than the applicant’s trade under the mark NEWS up to 1988;

5. The assignment of the “Newsreel” mark to the registered proprietor’s predecessor in title on 3 December 1989 was made some twenty one months after the date of registration of the NEWS mark and cannot, therefore, have any bearing on whether the NEWS mark was entered in the register without sufficient cause;

6. Although Mr Grundy says that the “Newsreel” mark was assigned to Clubclass Limited in December 1989 with goodwill (and subsequently assigned to the proprietor on the same basis) there is no evidence of any use of this mark, either prior to the date of registration or at all.

The result of my findings is that registration No.1339716 will be removed from the register as an entry made therein without sufficient cause. In these circumstances Counsel for both parties agreed that the registration should, as a matter of law, be deemed never to have existed.

I next consider the application for the rectification of the register by the removal therefrom of registration No. 1166210 for reasons of non-use.

#### **DECISION RE 1166210**

Section 26 of the Act, insofar as it is relevant, is as follows:-

26(1).....a registered trade mark may be taken off the register in respect of any of the goods in respect of which it is registered on application by any “person aggrieved” to the Court or, at the option of the applicant and subject to the provisions of Section

54 of this Act, to the Registrar, on the ground either -

5 (b) that up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time being;

10 provided that the tribunal may refuse an application made under paragraph (b) of this sub section in relation to any goods, if it is shown that there has been before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by the proprietor thereof at the time being in relation to -

15 (i) goods of the same description, or

(ii) services associated with those goods or goods of that description.

I have already found that the applicant has the necessary standing as a “person aggrieved”.

20 The period in which it is claimed there was no use of the mark is the period 6 May 1989 to 6 May 1994. It is well established that (under the old law) the onus is on the applicant to make out a prima facie case of non use. If that is done the onus shifts to the proprietor to demonstrate bona fide use of the mark during the relevant period.

25 The applicant filed evidence from a number of retailers (Messrs Smith, Dibb & Bookman) with long experience in the clothing trade, who say that have never seen the trade mark registered under no. 1166210 in use. The applicant also filed evidence from David William Lake and Jacqueline Margaret Lake, who are Directors of a company called Farncombe International Limited which undertakes commercial investigations. Their declarations describe various enquiries undertaken on behalf of the applicant, including covert approaches made, inter alia, 30 to the Buying Department of Empire Stores (the registered user of the registered proprietor’s trade mark) and Stuncroft Limited (the holding company of Clubclass Limited, the previous proprietor of registration no. 1166210). The Lake’s claim that they were advised that Empire Stores did not stock any goods under the “Newsreel” trade mark, and that Clubclass Limited had not used this mark either.

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There is no need for me to analyse this evidence in detail. Ms MacFarland, on behalf of the registered proprietor, accepted that there was no evidence of any use of the “Newsreel” trade

mark as such. Ms MacFarland instead contended that the registration should continue because of use by the registered proprietor and its predecessor of the mark NEWS.

Section 30(1) of the Act is as follows:-

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30(1) Where under the provisions of the Act use of a registered trade mark is required to be proved for any purpose, the tribunal may, if and so far as the tribunal thinks right, accept use of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proven.

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Ms MacFarland claimed that registration 1166210 was associated with registration 1339716 under Section 23 of the Act. She also drew my attention to the evidence of use of the mark NEWS within the relevant period by the registered proprietor and its predecessor in title, Clubclass Limited.

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Mr Carr contended that a decision in his favour on the application to remove registration No. 1339716 would mean that the registered proprietor could no longer rely on that registration as an ‘associated’ trade mark because a rectification in the circumstances pertaining would have the effect of deeming registration No. 1339716 never to have existed. Ms MacFarland was constrained to accept that this would indeed be the consequence of such a decision.

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However, Ms MacFarland submitted that such a decision would not be fatal to her case because the evidence of use of the word NEWS by the proprietor and its predecessor in title amounted to evidence of use of a mark “with alterations not substantially affecting its identity”. In that event the use of the mark NEWS should qualify as use of the mark registered under number 1166210 for the purposes of Section 26 of the Act.

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Mr Carr accepted that there was evidence of use of the trade mark NEWS within the relevant period by the registered proprietor and its predecessor in business. However, in Mr Carr’s submission the differences between the respective marks substantially affected their identities. Ms MacFarland contended that the distinctive character of the “Newsreel” mark was the word NEWS. In her submission the device element was a mere background which served simply to reinforce the message of the word element.

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There is some attraction in that submission, but I do not think it is right. It is undoubtedly the case that the word NEWS forms a distinctive feature of the “Newsreel” mark. But that is not the test. The test is whether the presence of the device element in the “Newsreel” mark gives it an identity which is substantially altered from the word NEWS solus. In my view it does, because the identity of the “Newsreel” mark is dictated as much by the film shots that appear below the word NEWS as by the word itself. I do not accept that the device element in the “Newsreel” mark can be regarded as a mere border or trivial setting for the word NEWS.

I am fortified in this view by the judgement of Mr Justice Lloyd in the ELLE trade mark case (1997 FSR page 529). This case was considered under the provisions of the Trade Marks Act 1994, Section 46(2) of which contains a provision which is similar to Section 30 of the old law. The question arose as to whether the use of the word ELLE could be taken as equivalent to use of the registered mark, which is reproduced below:-



The most relevant parts of Mr Justice Lloyd’s judgement are re-produced below:-

“Mr Birss on behalf of the proprietor says that the word is what is distinctive about the mark, that the use of lower or upper case letters does not matter and that the use of the female gender symbol is not the memorable or distinctive part of the mark. His case is that it conveys to the person who looks at it only an impression which is entirely congruous with the impression conveyed by the word; they are in a sense verbal and graphic ways of saying the same concept of “she”; the device is really almost immaterial, and it is certainly not so integral to the mark, or it is not such a strongly characteristic feature of the mark, that its omission alters the distinctive character of the mark.”

“..... one comes back to the question whether, by omitting the device and by



5 converting the four letters of the word from lower to upper case, something has been done which alters the distinctive character of the mark from the registered form. In my judgement it has. It seems to me the device is at least as much what makes the mark as distinctive as the word. The use of the word alone and in capitals does alter the distinctive character of the mark, in my judgement, in a significant and substantial way.”

10 For the sake of completeness I record here that there was a disclaimer of rights to the word ELLE, although Mr Justice Lloyd makes it clear (at page 532, last line) that he did not find it necessary to consider that aspect of the matter, which he described as a “red herring”.

15 In my judgement there is a greater degree of difference between the “Newsreel” mark and the word NEWS solus than there was between the registered mark and the word ELLE. In my view, use of the word NEWS does not qualify as equivalent use to that of the “Newsreel” trade mark for the purposes of Section 26(1)(b) of the Act.

20 The Registrar has a discretion under Section 26 of the Act not to remove a registered trade mark in circumstances where the conditions for removal set out in the Act are satisfied. I see no ground to exercising this discretion in the registered proprietors favour. The “Newsreel” mark has not been used by the proprietor and there is no evidence that it has been used by the previous proprietor. I have already found that the mark which has been used (the word NEWS solus) was adopted, registered and used after the applicant for rectification had already made significant use of the same mark for around 3 years. The potential for confusion is obvious. Such confusion, if and when it does occur, is likely to be damaging to the distinctiveness of the applicant’s mark and the goodwill that it characterises. In these circumstances, I would not have used the Registrar’s discretion under Section 30 of the Act in the registered proprietor’s favour, even if I had come to the view that the use of the mark NEWS qualified as equivalent to use of the “Newsreel” mark under that Section. It follows that I see no case for exercising the Registrar’s general discretion under Section 26(1) of the Act in the registered proprietor’s favour.

The result is that the register will be rectified by the removal therefrom of registration No. 1166210.

## **COSTS**

The applications for rectification having being successful, the applicant is entitled to a contribution towards its costs. I order the registered proprietor to pay the applicant the sum  
5 of £1,400.

**Dated this 1 Day of December 1998**

10 **Allan James**  
**For the Registrar**  
**The Comptroller General**