

TRADE MARKS ACT 1994

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

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of Registration No 1021689 standing
in the name of Nottingham Group Limited**

DECISION

The trade mark ARNOLD is registered in the name of Nottingham Group Limited for a specification of goods in Class 9 which reads:

"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."

It is numbered 1021689 and has a filing date of 4 December 1973.

On 9 December 1997 Viacom International Inc. applied for this registration to be revoked under the provisions of Section 46(1)(a) or (b) of the Act. The wording of the non-use claims closely follows the wording of the Act. The only supplementary points I need to record are that the claim under sub-paragraph (b) is firstly expressed in general terms (without reference to the dates of the five year period concerned). Alternatively it is said to be the five year period prior to the date of the application. Finally it is said:

"The Applicant contends that, by virtue of the letter written by its representative (R.G.C. Jenkins & Co.) to the representative of the proprietor of UK Trade Mark Registration No. 1021689 (Eversheds (Nottingham)) dated 10 September 1997, any commencement or resumption of use of the trade mark within the three month period before the making of this application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made."

The registered proprietors filed a counterstatement denying the above grounds and the relevance of the points made by reference to the letter of 10 September 1997 from RGC Jenkins.

Both sides filed evidence. The matter came to be heard on 3 January 2001 when the registered proprietors were represented by Mr A Roughton of Counsel instructed by Garretts and the applicants by Dr S R James of RGC Jenkins & Co.

Section 46 reads as follows:

"46.-(1) The registration of a trade mark may be revoked on any of the following grounds-

- 5 (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- 10 (c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;
- 15 (d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

20 (2) 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, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

25 (3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

30 Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

35 (4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that-

- 40 (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

45 (5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

- (a) the date of the application for revocation, or
- (b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date."

Section 100 is also relevant. It reads:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

The registered proprietors' evidence in support of their registration comes from Richard Piggott, the Company Secretary of Novara PLC, the holding company of Nottingham Group Ltd. The substance of the registered proprietors' case is that:

"3. The registered Trade Mark number 1021689 was originally registered in 1973 by E.J. Arnold & Son Limited. The business of E.J. Arnold & Son Limited had been promoting goods for which the mark is registered under and by reference to the mark "Arnold" for over 125 years for the promotion of educational supplies. There is now produced and shown to me marked "PG 1" a true copy of the front, side, back and selected pages from brochures distributed nationally by E.J. Arnold & Son Limited in 1982 and 1990 from which it can be seen that the mark "Arnold" was used in 1982 and 1990 to promote a variety of goods for which the Mark is registered. Similar brochures were distributed annually in the period between 1982 and 1990.

4. In April 1990 the business of E.J. Arnold & Son Limited was acquired by Nottingham Educational Supplies and thereafter the Mark has been used genuinely continuously and consistently to promote a range of goods for use by educationalists. 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 word "Arnold". The mark has also been used extensively without the initials NES Arnold.

5. 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 1998 main catalogue were distributed in 1998 throughout the UK and similar brochures have been despatched by us in similar numbers since 1990.

There is now produced and shown to me marked "PG 2" copies of the front, back, side and selected pages from our catalogues for the years 1992, 1993, 1994, 1995 and 1998 by way of selective examples."

5 Mr Piggott goes on to identify, by reference to the 1995 catalogue, the following goods which have been sold under or by reference to the mark:

10 Rulers, Theodolites, Trundle Wheels, Calipers, Clinometers, Tape Measures, Measuring Cylinders, Balancers, Measuring Kits, Timers, Drawing Instruments, Science Kits, Specimen Tubes, Petri Dishes and Pond Dippers, Magnifiers, Microscopes, Electronic Thermometer, Flow Meters and Blood Pressure Meters, Investigating Forces Kits, Bulbs, Electric Motors, Battery Chargers, Battery Holders and Magnets, Video Cameras and Photography (sic)

15 Also exhibited (PG 3) are copies of the cover pages and indexes to the NES Arnold Scientific brochures for the years 1993 to 1996.

20 The applicants filed a statutory declaration by Stephen Richard James, their professional representative in the UK. He comments on Mr Piggott's evidence. The main points to emerge are:

S the claimed use of ARNOLD up to 1990 is not relevant to the revocation action save in relation to the Section 46(1)(a) position

25 S the catalogues exhibited by Mr Piggott mainly evidence the supply by Nottingham Group of other traders' branded goods

S of the own brand goods the vast majority are identified by the mark NES ARNOLD. Only one product (not in Class 9) is identified by ARNOLD alone

30 S the 1998 catalogue should be ignored as it post-dates the action

S Mr Piggott's claim that the initials NES are considered a non-distinctive element is denied. Reference is made to a number of registrations of NES

35 S Mr Piggott's declaration makes no mention of one of the exhibits (RP4) showing use of ARNOLD'S. There is in any case no evidence that the word is used as a trade mark for the goods of the registration at issue

40 S submissions are made as to the distinctiveness of the word ARNOLD

S it is said that use of the mark NES ARNOLD should not be viewed as use of ARNOLD as a separate word.

45 I go on to consider the grounds for revocation. At the hearing Dr James indicated that he would not be pursuing the ground based on Section 46(1)(a). So far as Section 46(1)(b) is concerned the only specified period is the five years prior to the date of application. On that

basis the relevant five years runs from 9 December 1992 to 8 December 1997. For the record no claim is made that there are proper reasons for non-use. The matter, therefore, turns on whether the proprietors have shown genuine use of the mark in relation to the goods during that period. I will say at the outset that I do not think there can be any doubt that the use shown is genuine. A subsidiary issue arises as to whether the mark or marks used have been "in relation to the goods". I will briefly touch on this point later in the decision. The main issue before me and which will effectively determine the outcome of the action turns on the mark(s) that have been used.

The mark as registered is the word ARNOLD. So far as use of that mark is concerned the proprietors rely on a limited number of references in the evidence (for convenience submissions at the hearing were largely directed to the 1995 catalogue at RP2).

Dr James' own evidence challenged the extent to which ARNOLD alone is used. His detailed scrutiny of the evidence led him to identify one item only, a weather vane, offered for sale under that mark. As such items are normally proper to Classes 6 or 19 this item appears to be irrelevant to the defence of a Class 9 registration.

At the hearing Mr Roughton drew my attention to the word ARNOLD'S on one of the opening pages of the 1995 catalogue. The context in which this appears is important. The supporting text reads "And this year we've included our Textile Schedule and 'value for money' Stationery and Office Sundries range, 'Arnolds', inside the catalogue - great products, great prices!" The clear implication is that ARNOLD'S is used on a discrete range of products which are unlikely to fall within the specification of the registration under attack. There is further evidence that this is the case in Exhibit RP4 to Mr Piggott's declaration (though curiously the Exhibit is not actually referred to in the body of the declaration). This is a four page document headed "Arnold's Stationery and Office Supplies '96". It is not the complete document as is evident from the copy of the contents' page. However the latter is sufficient to confirm that the contents are a range of items (paper, pens, staplers, office accessories etc) that do not fall within the specification at issue. I infer from this that the name ARNOLD'S continues to be used in relation to the stationery and office supplies side of the business. It would also seem that for 1996 at least this part of the business had its own separate catalogue thus emphasising the self contained and separate nature of this part of the business.

In short the proprietors have not shown use of the mark ARNOLD in relation to the goods at issue. Their defence fails in so far as they rely on this point.

However the registered proprietors' main line of defence is not the limited use of ARNOLD on its own but rather the use of NES Arnold. In fact the use occurs in two forms. The catalogue evidence shows use of NES Arnold with the device of a bird:



The bird device does not, of course, appear in the narrative text in the catalogue. As might be expected NES Arnold is used in those circumstances. The letters NES are invariably presented in upper case but only the initial letter of the word Arnold is in upper case.

5 Mr Roughton acknowledged, 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. He, therefore, relied on the provisions of Section 46(2) namely that this was "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".

10 Both Dr James and Mr Roughton made submissions in relation to the relative distinctiveness or non-distinctiveness of the elements making up the mark and the effect that this should have on my view of the totality.

Dr James put it as follows in his skeleton argument:

15 "ARNOLD is prima facie a non-distinctive trade mark having both a surnominal and a geographical significance. It was only registered in 1973 on the basis of evidence of acquired distinctiveness. In order to remain such a validly registered mark, genuine use of the mark should consist of use that would be adequate to show acquired
20 distinctiveness in the first place. Thus, if the use of the trade mark BRITISH SUGAR TREAT is not adequate to obtain registration of the trade mark TREAT, then use of the trade mark BRITISH SUGAR TREAT should not constitute genuine use of a registered trade mark TREAT. Similarly, it is submitted that use of the trade mark NES ARNOLD would not, unless adequate survey evidence in relation to ARNOLD
25 were provided, lead to the registration of the trade mark ARNOLD. It follows, in our view, that use of ARNOLD either in combination with the distinctive mark NES or in further combination with a distinctive bird device for the period 1990-1997 should not constitute genuine use of the trade mark ARNOLD."

30 Mr Roughton invited me to approach the matter by considering whether the word ARNOLD is descriptive of anything in the class of goods concerned or more generally. If the answer to that was in the affirmative he suggested that the addition of the letters NES would be likely to change the character of the mark. However his view was that there was nothing to suggest that ARNOLD was descriptive or weakly distinctive. On the contrary he said it did not
35 describe anything and was perfectly distinctive. Further, he referred me to the following passage from British Sugar PLC v James Robertson & Sons Ltd (the TREAT case), 1996 RPC 281 at page 299

40 "I turn to consider how the word "Treat" is used here. I have no evidence from the public in relation to this question. I have some evidence of internal thinking at Robertson's, but the most important thing of all must be my own impression from the label and all the surrounding circumstances. Looking at the label I think the average customer would not see "Treat" used as a trade mark. It is true that it is written as part of a phrase "Toffee Treat" but this is done in a context where the maker's name is
45 plain. It is of course the case that you can have two trade marks used together ("Ford Prefect"), but whether the secondary word is used as a trade mark is a question of fact. If it is a fancy word, then obviously it is a trade mark because it could not be taken as

5 anything else. But where it is highly descriptive I see no reason why a member of the public should take the mark as a badge of origin. And that is particularly so where the product is a new sort of product, as here. The public are apt to take the name of a novel product as a description rather than a trade mark, particularly where the name is not fancy but is descriptive or laudatory. I do not think Robertson's use is as a trade mark." (emphasis added).

10 On the basis of the underlined passage Mr Roughton suggested that only in cases where the mark is 'highly descriptive' that an objection may arise on the grounds that the character of the second word is altered by the additional matter (in this case NES).

15 It must be borne in mind that the issue Jacob J was considering in the above passage from TREAT was whether the defendant had a defence against the infringement action under Section 11(2) of the Act on the basis that Toffee Treat was not being used as a trade mark but rather as non-infringing descriptive use. I do not find any assistance in the TREAT case as to how I should approach the interpretation of Section 46(2). In any case, leaving aside for a moment the parties' respective views of the merits of the word ARNOLD, that mark 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 that kind.

20 In ELLE Trade Marks, 1997 FSR 529, Lloyd J had to consider whether registrations of the mark elle (in lower case) in the middle of a circle with a cross off the circle bottom right (the symbol for the female gender) could be defended on the basis of the use of ELLE in upper case letters. He concluded that

25 "..... one comes back to the question whether, by omitting the device and by 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 judgment it has. It seems to me that the device is at least as much what makes the mark distinctive as the word. The use of the word alone and in capitals does alter the distinctive character of the mark, in my judgment, in a significant and substantial way. Therefore, although I do not proceed by analogy with Section 41, I agree with the decision of Mr Knight on this point and without having to consider the position as regards disclaimer."

30 The ELLE case does not, I accept, provide a direct analogy. The mark in use in that case was part of and, therefore less than the mark registered. The circumstances before me are that the registered mark is contained within the mark used (it is clear from the evidence that NES Arnold is being used as a single composite mark - this is not a case where independent marks happen on occasions to be used together).

35 I note that Kerly's Law of Trade Marks and Trade Names, Thirteenth Edition (not available at the date of the hearing) indicates that

45 "..... if the proprietor relies on use of a variant of the registered mark, the variant must be compared with the registered mark to see whether the differences are such as

to alter the distinctive character of the mark. The process of comparison is a matter of impression. The distinctive elements of the mark in the form in which it was registered should be identified. Likewise with the variant. Are the differences significant enough to alter the distinctive character of the mark? If the variant passes the test, then the use of the variant must be taken into account."

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.

The applicants have pointed to the fact that there are a number of third party registrations of NES. Geoffrey Hobbs QC, sitting as the Appointed Person in FSS Trade Mark¹, considered the correct approach to the registrability of 3 letter marks and endorsed the Registry's current practice which is to accept such marks unless there is a specific reason to believe that the particular letters will not be taken by the average consumer as a trade mark. I can see no reason why, in the circumstances of this particular case, NES should be regarded as attracting less attention on the basis that it is in some way descriptive or non-distinctive. Quite the contrary it makes a significant contribution to the overall character of the mark.

The above view of the matter should not, in my view, come as any particular surprise to the proprietors. The element NES is not there by accident and is not in my view intended to be a negligible or even subordinate part of the mark. Mr Piggott says:

"4. In April 1990 the business of E J Arnold & Son Limited was acquired by Nottingham Educational Supplies and thereafter the Mark has been used genuinely continuously and consistently to promote a range of goods for use by educationalists. 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 word "Arnold"."

Mr Piggott's claim that the initials NES are considered a non-distinctive element is wholly unconvincing. The E J Arnold & Son Ltd business was a very old established business said to have a trading history going back over 125 years. It was acquired by Nottingham Educational Supplies in 1990. NES stands for Nottingham Educational Supplies. The NES Arnold mark, therefore, retains the ARNOLD name but associates it with the new owners. There is nothing wrong with that. It is a perfectly natural way to promote the combined business. But it is scarcely credible that the proprietors should consider the initial letters of their name to be a

¹ Decision dated 6 November 2000 under reference 0-473-00 (unreported at the time of writing).

non-distinctive element and that the NES element does not affect the identity of the mark ARNOLD. It must have been intended to convey a message about the new ownership arrangements and in my view does just that. Even if, contrary to my own view, Mr Piggott's claim (that the NES element is considered non-distinctive) is to be taken at face value it does not help the proprietors. It is the effect actually achieved by the presence of that element within the totality of the mark that is important not what they thought they were achieving.

I conclude that the use shown of NES Arnold is not "use of the mark ARNOLD in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered". The proprietors cannot bring themselves within Section 46(2) on the basis of such use.

There is, however, a further aspect of the proprietors' defence. It is said by Mr Piggott that:

"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"."

Mr Roughton put it to me that this is uncontroverted evidence and that Mr Piggott has not been called for cross-examination on that evidence.

It is clear from the evidence that the proprietors have a business which goes beyond the Class 9 goods at issue. That is scarcely surprising in an educational supplies company. The inference I have drawn above is that for part at least of that business (stationery and office supplies) the ARNOLD name has been retained as a stand alone mark. The evidence suggests that this is not true of the business as a whole. The first problem the proprietors face with this part of their argument is that Mr Piggott does not relate his general claim that the proprietors are known as Arnold's to any specific set of goods. What he says may be true of the stationery and office supplies' business but that is not to say it is also true of the Class 9 goods.

More fundamentally his claim is in any case little more than a bare assertion. The mere fact that the applicants may not have been in a position to challenge it does not relieve the opponents of the need to substantiate their claim. None of the educationalists referred to has given evidence.

There is a further potential problem in that Section 46(1) refers to use 'by the proprietor or with his consent'. It is not clear, therefore, whether or in what circumstances the way in which customers refer to a mark can be brought into the reckoning. Given my other findings I do not need to take a view on this point.

The action was launched and sustained on the basis that it was an attack on the whole of the registration. It emerged in Dr James' skeleton argument that if he was not successful in his primary submissions he wanted the matter considered on the basis that the registration should be limited to those Class 9 goods for which the trade mark NES Arnold has been used in the relevant period. He noted in particular that it is now possible to register trade marks in the UK for 'retail services' as he put it. He suggested that there was no longer justification for maintaining a UK trade mark registration for goods when the use has been predominantly in

relation to the branded goods of third parties. This was a reference to the fact that the proprietors offer goods from a catalogue. I should record that Mr Roughton objected to such an approach. He said that if the matter came down to partial revocation and hence a reduction in the scope of the registration then the point should have been pleaded and he should have an opportunity to consider the goods in respect of which the registration could be maintained bearing in mind that the catalogues contain many hundreds of pages and probably many thousands of products.

In view of my findings on the marks used I have not needed to consider a possible reduction in the scope of the registration. I would simply say that from my own reading of the evidence the catalogues show a mixture of

- (i) goods specifically identified in the catalogue text as being NES Arnold products. Even if not so marked on the goods themselves I take such use to be "in relation to the goods"
- (ii) items which bear no obvious indication of trade origin on the goods themselves or in the catalogue description thereof
- (iii) goods which clearly carry another manufacturers' mark whether or not that mark is also referred to in the catalogue narrative text
- (iv) hybrid products (such as the science packs or kits) which appear to be sold under the NES Arnold banner but contain some products (at least) with other manufacturers' marks on them within the packs.

I do not think that as a general principle there can be any doubt that items falling into (i) above clearly constitute a trade in goods. As there is no other obvious point of origin for goods in the second category it seems logical to suppose that the catalogue issuer would be regarded as the trade source for items in this category as well. Where third party brands are evident (category (iii)) it seems more likely that customers would regard the proprietors as offering the goods as part of their catalogue service but not as guaranteeing to the consumer that they are responsible for the quality of those particular goods. The fourth category would need to be considered on the particular facts in each case (not always evident from the material supplied).

Bearing in mind that the proprietors are an educational supplies company offering a wide range of items my impression is that the catalogue evidence would be likely to throw up sufficient products in the first two categories (with the possible exception of photographic apparatus which appear to be entirely third party brands) to justify the registered specification. However I did not hear detailed submissions in relation to what goods would survive if it was necessary to pursue this alternative avenue of attack. In the circumstance I do not propose, or need, to take a formal view of the matter.

The application for revocation has been successful. The registration will be revoked in its entirety with effect from 9 December 1997. The applicants are entitled to a contribution towards their costs. I order the registered proprietors to pay them the sum of £835. This sum is 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.

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Dated this 2 day of February 2001

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**M REYNOLDS
For the Registrar
the Comptroller-General**