

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO. 2241893
BY NICHOLS PLC
TO REGISTER A TRADE MARK IN CLASSES 9, 29, 30, 32 AND 42

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DECISION AND GROUNDS OF DECISION

On 8 August 2000, Nichols Plc of Laurel House, 3 Woodlands Park, Ashton Road, Newton-Le-Willows, WA12 OHH applied under the Trade Marks Act 1994 to register the trade mark NICHOLS in classes 9, 29, 30, 32 and 42 for the following goods and services:

Class 9

Vending machines; electrically-controlled automatic dispensers and token operated dispensers for food and drinks; parts and fittings for all the aforesaid goods.

Class 29

Milk and milk powders; preparations made with milk, ad-mixtures of milks, fats, starches and sugars for use in making beverages; dairy toppings; yoghurt and yoghurt drinks; desserts; flavoured extracts from juices made from fruit and vegetables.

Class 30

Coffee, tea, cocoa, drinking chocolate; coffee essence, coffee extracts, mixtures of coffee and chicory; all for use as substitutes for coffee; sugar, confectionery, edible ice, cakes and frozen foods; dessert toppings, and preparations for making desserts, drinks.

Class 32

Non-alcoholic drinks and preparations for making such drinks; soups and concentrates for making non-alcoholic drinks; fruit flavoured beverages; ice beverages.

Class 42

Restaurant, cafeteria and catering services.

Objection was taken to the application under Section 3(1)(b) of the Act because the mark is a common surname. Objection was also taken under Section 5(2) of the Act because of the existence of earlier registration no. 2215907, raised against all classes in this application, and registration no. 2111542 raised against class 42 only.

At the hearing at which the applicants were represented by Mr J Groom of Trade Mark Owners Association Limited, their trade mark agents, the fundamental argument submitted in

respect of the Section 3(1)(b) objection was that if the Parliamentary draftsmen had intended for surnames to be excluded from prima facie acceptance, then specific mention would have been made of them in legislation under Section 3(1) of the Act. The Registrar is therefore acting ultra vires in objecting to surnames depending on the number of times they appear in telephone directories. The Section 3(1)(b) objection was however maintained at the hearing. The Section 5 objections were addressed in that the agent is to file for a change of name of registration no. 2215907 from J N Nichols (Vimto) Plc to this applicant Nichols Plc. Class 42 of this application was deleted in full at the hearing in order to dispense with citation no. 2111542.

Following refusal of this application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

The relevant part of Section 3(1)(b) of the Act is set out below:

"The following shall not be registered -

(b) trade marks which are devoid of any distinctive character.

The surname NICHOLS and its phonetic equivalent, NICHOLLS, also its singular form NICHOL, appears in the London Telephone Directory, in total, a number of 483 times. The Registrar's practice on surnames alone is set out in Practice Amendment Circular (PAC) no. 6/00. A copy of this circular is attached at Annex A.

The Appointed Person, Mr G Hobbs Q.C. has since stated that he is in agreement with the general tenor of the Registrar's guidelines - see *J & J Crombie Ltd v A & F Trade Mark Inc* [Case No 0-0151-01] dated 21 March 2001.

Taking account of the guidance set out above it is clear that this mark (the surname NICHOLS along with its singular form and phonetic equivalent NICHOLLS,) in respect of most of the goods and services applied for will only be seen as a surname, as the word has no other meaning.

In my view, anyone seeing the mark NICHOLS used in relation to most of the goods for which registration is sought i.e. classes 29, 30 and 32, will see the word as a surname indicating a source but not a unique source of trade origin. This is because the word is such a common surname in the UK that it does not, in itself, have the capacity to communicate the fact that the goods in relation to which it is used recurrently by the applicant are those of one and the same undertaking. Also, taking account of the nature of the business involved and the potential size of the market for food and drink products, the word NICHOLS could be used by other manufacturers and providers. The public are therefore unlikely to consider that there is only one party trading in food and drink products under the name of NICHOLS. I therefore consider the mark to be devoid of distinctive character for the goods claimed in classes 29, 30

and 32. I however am prepared to acknowledge that the market in respect of the class 9 products sought is far more specialised with fewer people trading in it. Consequently the mark is acceptable in class 9, but in respect of the other remaining classes sought, it follows that the mark is debarred from prima facie acceptance for registration by Section 3 (1)(b).

However this is not the end of the matter as, at the hearing, Mr Groom went on to submit that I should accept the application based on the earlier registration of the words NICHOLS OF HAYDOCK which will undergo a name change to the applicant company. This is registration no. 2215907, registered in respect of classes 9, 29, 30, 32 and 42 for the exact same products originally sought as in this application, which proceeded to publication as an unused mark. His argument was that the public are already familiar with the earlier registration and will associate simply the word NICHOLS as being from the same source as NICHOLS OF HAYDOCK. He urged me to accept the application based on the existing rights of registration no. 2111542.

The proviso to Section 3(1) is in the following terms:

"Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

It is clear from Registry practice that for a prior registration to assist, the mark applied for must contain only a minor variant to the earlier mark. This is not the case here as the earlier mark was clearly acceptable in the prima facie because it contains additional matter to simply the common surname i.e. it is the three words NICHOLS OF HAYDOCK rather than simply NICHOLS, without any qualification. Thus the earlier mark - unlike the later mark - faces up to the objection that NICHOLS per se is not, as an unused mark, capable of distinguishing the goods of a single undertaking (in respect of classes 29, 30 and 32).

It is my conclusion that the mark applied for is devoid of any distinctive character in classes 29, 30 and 32. Furthermore there is no evidence that the mark has acquired a distinctive character as a result of the use made of it. I therefore conclude that the application is not acceptable for registration under Section 3(1)(b) of the Act.

In this decision I have considered all the documents filed by the applicant and all the submissions made to me in relation to this application and for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 3(1)(b) of the Act.

Dated this 11 day of May 2001

JANET FOLWELL (Ms)
For the Registrar
The Comptroller General

ANNEX A
www.patent.gov.uk/tm/reference/pac/pac0600.htm

