

O-114-14

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION 2317870
IN THE NAME OF NATIONAL OPEN COLLEGE NETWORK:**

OCN

AND

**AN APPLICATION FOR REVOCATION THEREOF (NO. 84709)
BY OPEN COLLEGE NETWORK, LONDON REGION**

THE BACKGROUND AND THE PLEADINGS

1) National Open College Network (“NOCN” referred to hereafter as “the Registered Proprietor”) is the proprietor of UK trade mark registration 2317870 for the trade mark shown below:

OCN

The application for registration was filed on 06 December 2002 and completed its registration procedure on 27 June 2003. It is registered in respect of:

Class 9: *Sound and/or video recordings; parts and fittings for the aforesaid goods.*

Class 16: *Printed matter; printed publications; books, magazines, journals and newspapers; instructional and teaching materials; stationery.*

Class 41: *Education and training services; provision of advice and information relating to the aforesaid services; publication of printed matter; publications in electronic form (not downloadable).*

Class 42: *Accreditation services; certification services.*

2) In its application Open College Network, London Region (“the Applicant”) seeks revocation of the registration in respect of all of the goods and services for which it is registered. It bases this application on non-use under section 46(1)(a) of the Trade Marks Act 1994 (“the Act”). The time period when the Applicant claims non-use under section 46(1)(a) is: 28 June 2003 to 27 June 2008. I shall refer to this below as “the period relevant under section 46(1)(a)”. The Applicant seeks revocation under section 46(1)(a) with effect from 28 June 2008.

3) The Registered Proprietor concedes that the mark has not been used for:

Class 9: *Parts and fittings for sound and/or video recordings*

Class 16: *Magazines, journals and newspapers; instructional and teaching materials.*

It filed a counterstatement, opposing the application for revocation in respect of the following goods and services:

Class 9: *Sound and/or video recordings.*

Class 16: *Printed matter; printed publications; books; stationery.*

Class 41: *Education and training services; provision of advice and information relating to the aforesaid services; publication of printed matter; publications in electronic form (not downloadable).*

Class 42: Accreditation services; certification services.

The Registered Proprietor claims that it has used the mark for the above services continuously from at least 2001 up to and including 2012, and that either there are no grounds to revoke the mark under section 46(1)(a) or that, if such grounds are made out, the Registered Proprietor commenced or resumed such use after the expiry of the five year period ending 7 June 2008 and more than three months before the application for revocation was made.

4) The registered Proprietor filed evidence of use and written submissions. The Applicant filed no evidence or submissions. Neither side requested a hearing. I therefore give this decision after a careful review of all the papers before me.

THE EVIDENCE

5) The evidence consists of a witness statement by Mr Graham Hasting-Evans, who says that he is the managing director of the Registered Proprietor, and states as follows:

- The Registered Proprietor is a learning-credit-based awarding organisation which creates and develops qualifications for various organisations which offer education and training. It provides education and training itself and also accredits education and training courses which are provided by third parties, so the learner can obtain a recognised qualification. It contracts with a network of regional organisations, known as Open College Networks, or OCNs, to provide the development, delivery and award of qualifications. These organisations, which have been set up on a regional basis, are currently called Open College Networks, or OCNs.
- In March 2000 the Registered Proprietor became the recognised awarding body for the regional Open College Networks. In 2000 the regulator at that time, the QCA, would not allow these OCNs to become awarding bodies to deliver, award and certificate recognised qualifications in their own right. They could only do so as agents for the Registered Proprietor under the Registered Proprietor's trade marks NOCN and OCN.
- The Registered Proprietor issues qualification certificates to learners on completion of a learning programme or course. These UK-regulated qualification certificates, which are kept for many years by the learners, have the same status as other UK-regulated qualification certificates such as a GCSE or A-Level certificate. They are widely recognised documents that a learner will need, for example, to gain employment or access to further training and education. The certificates are printed and sent to the Registered Proprietor's recognised training centres to issue to the individual successful learner. Certificates are signed by the Chair of the Board of the Registered Proprietors. During the period 2003 to 2011 on average around 400,000 of these certificates were issued by NOCN each year across the UK and around 40,000 per year in London. Examples of the form of the certificates issued over the years are annexed to the witness statement.

- In 2002 with the agreement of all the Open Colleges/Access consortia, the Registered Proprietor registered the mark in suit for the goods and services shown above. Since 2009, as a result of changes in the regulatory framework, some of the Open College Networks decided they wanted to become awarding organisations in their own right. The Applicant was one of them.

6) Mr Hasting-Evans annexes to his witness statement two exhibits: **Exhibit GHE2** consists solely of a disc containing two short video clips; all the other evidence, consisting of a bundle of documentary evidence, is contained in **Exhibit GHE1**. Where it becomes necessary to refer to individual items of documentary evidence, it will therefore be convenient to do so by page number. The following documents, as described and commented on by Mr Hasting-Evans, were annexed to his statement to show use of the Registered Proprietor's mark between 28 June 2003 and 27 June 2008 (page numbers are given in brackets):

- An Update, dated November 2003, which was issued to external training providers delivering qualifications, and published on the Proprietor's website (1);
- a covering letter to a London training provider dated 1 December 2004 and a Certificate Receipt Form signed by a London training centre (5,6)
- an information sheet for certificate orders from the printers dated 4 May 2004 (7);
- a leaflet issued to students and potential students, which Mr Hasting-Evans dates to prior to 2006 (8). A virtually identical leaflet is also at page 118;
- a publication dated 2005 entitled "Standards and Criteria for the Licensing of Open College Networks", which was issued to all members of the Registered Proprietor's network (10);
- "Brand Identity Guidelines", dated 2006, with covering letter; these guidelines were issued to each of the regional OCN companies. The one exhibited is actually for the Applicant, but others were issued with specific references to the other regional companies concerned e.g. OCN East Midlands Region, OCN Northern, Ireland, OCN Wales etc (20,21);
- a publication dated 2007 to mark the 25th anniversary of the Open College Networks, describing the history and development of the Registered Proprietor and its OCN partners up to 2007 (58);
- a leaflet from between 2000 and 2005 (the Registered Proprietor's standard leaflet template throughout that time) issued to students and potential students, giving information and advice on the Registered Proprietor's training courses (97);

- examples from 2007 of leaflets giving information about some of the qualifications provided by the Proprietor, which were sent to external learning providers such as adult education centres, HM Prisons, Universities, employers and voluntary organisations (99);
- examples of certificates awarded by the Registered Proprietor to individual learners in 2004-2008 (134 *et seq*).
- an example from 2007 of a leaflet sent to employers giving information about the accreditation training provided by the Registered Proprietor (111);
- invitations and envelopes that were sent out to invitees to an event in 2007 and a photograph of pens and screen wipes that were issued widely to external training providers (113,117).

7) The following documents, as described and commented on by Mr Hasting-Evans, were annexed to his statement to show use of the Registered Proprietor's mark in the period following 27 June 2008, but more than three months before the application for revocation in the present proceedings was made :

- a cover of a DVD issued in 2010 which provided information on Step-Up Qualifications to learning (141);
- a prospectus dated 2010-2011 providing information for training providers on NOCN qualifications (143);
- an FAQ document "from at least 2009" providing information for training providers on NOCN functional skills qualifications (152);
- the cover of a book entitled "Measuring Improving Social, Environmental and Economic Productivity" with the imprint data "Published by the Institute of Productivity in association with the Open College Network and the World Confederation of Productivity Science" (155);
- a copy of an NOCN business card dating from 2011(157);
- photographs from 2012 of a presentation given by the Registered Proprietor at which advice and information relating to education and training services was provided (159);
- an example of a certificate awarded by the Registered Proprietor to an individual learner in July 2009 (163).

LEGISLATION AND CASE-LAW

8) The relevant parts of section 46 of the Act read:

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

(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;

(c)

(d)

(2) For the purpose 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.

(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: 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.

(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 –

(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 other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(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.”

9) Section 100 is also relevant; it reads:

“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.”

10) In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case law of the Court of Justice of the European Union (CJEU) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

"(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered

by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”

11) In deciding upon a fair specification of the services for which genuine use is found, the description must not be over-precise¹. It is necessary to consider how the relevant public would likely describe the services². The General Court (“GC”) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03 (“Aladdin”)* held:

“43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of

¹ See *Animal Trade Mark* [2004] FSR 19.

² See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32

genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

12) I also note the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

"However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

USE OF THE MARK AS REGISTERED

13) In 2006 the Registered Proprietor issued "Brand Identity Guidelines" to each of its regional OCN organisations, giving instructions on the use of the OCN mark on business stationery, certificates, press releases, websites, etc. OCN is presented in lower case, a regional reference appearing in substantially smaller lettering below it, and a simple figurative element in the form of a slightly distorted crescent sweeping round on the right of it, as follows:



The mark was used in this way, for example, on information leaflets issued to students and potential students (see page 97) and certificates issued to students on completion of accredited courses (see pages 134 *et seq.*). The question is whether use in this manner constitutes genuine use. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”. (The emphasis has been added).

14) The average consumer of the Registered Proprietor’s services will consist of training providers, employers and (as end users of the accredited training and certified qualifications) trainees. There can be no doubt that these consumers would regard the mark OCN and the mark used as shown in paragraph 13 as designating the services of one and the same undertaking. Accordingly, use of the mark as shown in paragraph 13 is use of the Registered Proprietor’s mark.

HAS THERE BEEN GENUINE USE OF THE MARK?

Class 9: *Sound and/or video recordings.*

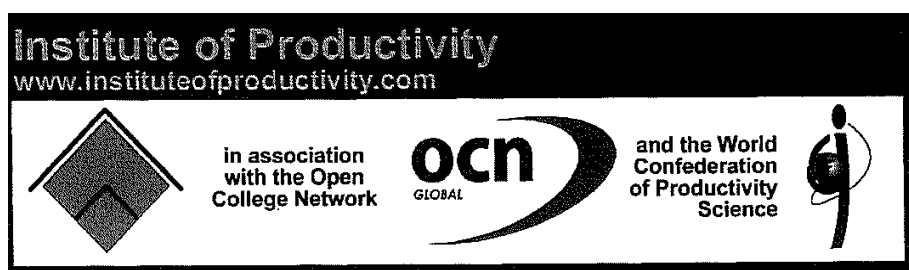
15) Exhibit GHE2 consists of a disc containing two short video clips, both apparently without sound, both lasting a few seconds, and both showing a large roomful of people apparently performing the Maori “Haka” popularised by the New Zealand All Blacks rugby team. On a board in the background a mark which may be the Registered Proprietor’s mark is barely visible. Mr Evans’ witness statement describes these as “2 videos which were taken at the staff conference in 2007 which was attended by some of the open colleges and their staff”. There is no evidence to suggest that these clips formed, or formed part of, sound and/or video recordings which were conveyed or distributed under the Registered Proprietor’s mark to anyone outside the Registered Proprietor’s organisation or its contracted partner OCN organisations, let alone that they were aimed at maintaining or creating an outlet, or a share in the market for, sound and/or video recordings. Any use of the mark would appear to have been internal, and thus cannot demonstrate genuine use. The cover of a DVD issued in 2010 is reproduced at pages 141-142. The cover shows the Registered Proprietor’s NOCN mark, rather than the mark in suit. The DVD provided information on “Step-Up Qualifications” to learning providers. The object of this DVD was thus apparently to promote the use and/or awareness among training providers of the Registered Proprietor’s OCN awards – in other words, to promote the Registered Proprietor’s services in class 41. This does not demonstrate real commercial exploitation of the mark on the market for *sound and/or video recordings* in class 9, and thus does not show genuine use.

Class 16: *Printed matter; printed publications; books; stationery.*

16) The Update issued to external training providers (1), leaflets issued to students and potential students (8, 97, 118), a publication describing the history of the Registered Proprietor and its OCN partners (58), leaflets sent to external training providers and employers (99 *et seq*, 152), invitations and envelopes sent to invitees to an event in 2007 to mark the 25th anniversary of the OCN organisations and a photograph of pens and screen wipes issued at that time to external training providers (113,116), , a prospectus on NOCN qualifications for training providers (143) all clearly relate to the promotion of the Registered Proprietor’s core services, and, where they use the mark in suit, demonstrate use of the mark on the market for those core services. There is no evidence whatever to support a conclusion that the use was by way of real commercial exploitation of the mark on the market for printed matter or stationery, i.e. exploitation aimed at maintaining or creating a share in that market. The same is true of the certificates issued to persons completing accredited courses (134, 163). Use of the mark on these certificates relates to the Registered Proprietor’s core service of certification of completed credits. The Registered Proprietor is not assuming responsibility in the trade mark sense for the printed certificates as products on the market for printed matter or stationery. This also finds some confirmation in an information sheet for certificate orders from the printers dated 4 May 2004 (7): “NOCN have approved the new NOCN certificate templates, therefore OCNs can now place orders for the new design from Rosehill Press”. No genuine use of OCN has been shown for *stationery*.

17) The “Standards and Criteria for the Licensing of Open College Networks” (10) and “Brand Identity Guidelines” issued to all members of the Registered Proprietor’s OCN network (20,21) represent internal use, and internal guidance on use, of the mark, and do not constitute use on the market for printed matter or publications.

18) The cover and basic publishing data of a book entitled “Measuring Improving Social, Environmental and Economic Productivity” are given at pages 155-156. The book was published in 2012. Mr Hasting-Evans explains that although this was after the period relevant under section 46(1)(a), it was more than three months before the application for revocation in the present proceedings was made, and can therefore be taken into account under section 46(3). The imprint data given in the book state: “Published by the Institute of Productivity in association with the Open College Network and the World Confederation of Productivity Science”. The mark in suit appears as follows on the cover:



The mark is used here in the way which I have already discussed in paragraph 13. For the reasons I have given in paragraph 14, this is use of the Registered Proprietor’s mark, and with the Registered Proprietor’s consent. I am given no further information about the content or readership of the book. However, the relationship between productivity and education and training provision is clear. Though the evidence is brief and basic, there is nothing to indicate that the co-publication of this book was merely 'token', intended to serve solely to preserve the rights conferred by the registration. No sales figures are given, but the book has an ISBN number, which indicates that it was available through the normal channels in the book trade. I accept that it represents real commercial exploitation of the mark on the market for books, and therefore genuine use of the mark. However, this is clearly an insufficient basis on which to sustain a registration for such wide categories as *printed matter* or *printed publications* in Class 16; I also consider *books* to be too broad a category. Given the nature of the book in respect of which use has been shown, I consider that *books relating to education and training* would be a fair specification in Class 16.

Class 41: *Education and training services; provision of advice and information relating to the aforesaid services; publication of printed matter; publications in electronic form (not downloadable)*

19) The leaflets issued during the period relevant under section 46(1)(a) to students and potential students (see pages 8 and 97), giving information and advice on the Registered Proprietor’s training courses, explain that: 1. the Registered Proprietor is

a qualification-awarding body recognised by the regulatory authorities; 2. the Registered Proprietor licenses partner organisations called OCNs to accredit courses offered by training providers, and ensures that all OCN learning programmes meet a national standard; 3. the training provider is responsible for registering the student with the OCN, which will issue the certificate in respect of credits gained; 4. OCN credits are nationally recognised. Reference is made to “OCN learning programmes” and “OCN credits”. Similar information is provided in the examples from 2007 of leaflets sent to external training providers and employers to give information about the qualifications provided by the Registered Proprietor (see page 99 *et seq*). These describe the Registered Proprietor as the leading credit-based awarding body in the UK, 2,500 centres nationally offering its qualifications. They explain: that OCN staff have the experience and expertise to offer support and advice on the use of the Registered Proprietor’s qualifications; that they offer continuing professional development for staff in provider organisations by providing training in the assessment of credit and internal quality assurance; that OCN accreditation can be used to link into and operate alongside other professional and technical qualifications; and that OCN quality assurance processes provide externality and nationally recognised and comparable certification. Reference is made to “OCN accreditation” and “OCN quality assurance processes”. I consider that consumers and potential consumers of the Registered Proprietor’s services, both students and training providers, would perceive OCN, as used in these documents, as an indication of origin distinguishing the services of the Registered Proprietor and its licensee partner organisations from those of others. This use of OCN in text is further reinforced by use of the mark as shown in paragraph 13 on material such as leaflets (97 *et seq*) and certificates issued to students on completion of accredited courses (134 *et seq*). Mr Hasting-Evans states that during the period 2003 to 2011 on average around 400,000 certificates were issued by the Registered Proprietor each year across the UK.

20) It is clear that the Registered Proprietor’s accreditation of credit-based training courses, and the resultant issue of certificates to persons completing those courses, requires considerable involvement by the OCN organisations in the actual process of education and training provided by third party providers – i.e. in the design and planning of the learning programmes, and in the provision of support, advice and continuing professional development to staff in external training bodies by providing them with training in the assessment of credit and internal quality assurance (see, for example, page 99 *et seq*). I am satisfied that the totality of the evidence shows that the mark in suit has been used by way of real commercial exploitation on the market for *education and training services; provision of advice and information relating to the aforesaid services*, and that this represents a fair specification of the services for which genuine use has been shown. I cannot see a narrower specification which would adequately encompass the services offered by the Registered Proprietor under this description.

21) I have already found at paragraph 18 that there is nothing to indicate that the co-publication of the book described there was merely ‘token’, intended to serve solely to preserve the rights conferred by the registration. I accept that it represents use of the mark on the market for publication of books. However, this is clearly an insufficient basis on which to sustain so broad a registration as *publication of printed matter*. Given the nature of the book in respect of which use has been shown, I

consider that *publication of books relating to education and training* would be a fair specification.

22) The Registered Proprietor submits that the DVD which I have already considered in paragraph 15 (141, 142) should also be regarded as an example of a *publication in electronic form (not downloadable)*. All material which is downloadable – as is the case with DVDs – are proper to Class 9. The DVD cannot serve as proof of use of the Class 41 service. Accordingly, no genuine use has been shown for *publications in electronic form (not downloadable)*.

Class 42: *Accreditation services; certification services.*

23) The Registered Proprietor's current specification in Class 42 is broader than is justified by the services in respect of which it has shown genuine use. I am satisfied that the evidence which I have already summarised in paragraph 19 shows that the mark in suit has been used by way of real commercial exploitation on the market for *accreditation of education and training* and *certification of education and training*, and that this represents a fair specification of the services for which genuine use has been shown.

OUTCOME

24) **I have found that genuine use of the mark in suit has been shown in respect of the following goods and services:**

Class 16: *Books relating to education and training.*

Class 41: *Education and training services; provision of advice and information relating to the aforesaid services; publication of books relating to education and training.*

Class 42: *accreditation of education and training; certification of education and training,*

The consequence of this is that the Registered Proprietor's registration will be revoked, save for the above goods and services, with effect from 28 June 2008.

COSTS

25) The Registered Proprietor observed that the Applicant did not bother to file submissions or evidence in support of its application, and submitted that the Applicant was without genuine belief that this was an issue to be tried and had put the Registered Proprietor to the expense of filing evidence in respect of grounds which had not been pursued. In the event the Applicant succeeded in its application to have the Registered Proprietor's registration for some of its goods and services revoked; however, it failed in respect of the Registered Proprietor's core services. On balance I consider that awarding the Registered Proprietor costs on the normal scale is appropriate and proportionate in this case.

26) National Open College Network has been substantially successful and is entitled to a contribution towards its costs. I hereby order Open College Network, London Region to pay National Open College Network the sum of £1,750. This sum is calculated as follows:

| | |
|---|--------|
| <i>Preparing a statement and considering the other side's statement</i> | £350 |
| <i>Preparing evidence</i> | £1,000 |
| <i>Written submissions</i> | £400 |

The above sum should 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 11th day of March 2014

**Martin Boyle
For the Registrar,
The Comptroller-General**