

O-459-13

TRADE MARKS ACT 1994

In the matter of registration no 2586213

of the trade mark:



in the name of Open College Network London Region Ltd

in classes 16, 35 and 41

and the application for invalidation thereof

under no 84618 by

National Open College Network

1) Registration no 2586213 was filed on 29 June 2011 and the registration procedure was completed on 18 November 2011. It stands in the name of Open College Network London Region Ltd (London). It is registered for the following goods and services:

paper, cardboard and goods made from these materials; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters; packaging materials; printers' type; printing blocks; disposable nappies of paper for babies; printed publications; paint boxes for children; cheque book holders;

advertising; business management; business administration; office functions; electronic data storage; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information; retail services connected with the sale of accreditation and qualifications;

education; providing of training; entertainment; sporting and cultural activities.

The above goods and services are in classes 16, 35 and 41 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 7 December 2012 National Open College Network (NOCN) filed an application for the invalidation of the registration. Its grounds of opposition are made under sections 5(2)(b), 5(3) and 60(3)(a) of the Trade Marks Act 1994 (the Act). Owing to the findings in this decision, it is only necessary to consider the section 5(2)(b) ground. In relation to section 5(2)(b), NOCN relies upon one trade mark registration which is subject to proof of use under section 47(2A) of the Act and nine trade marks which are not subject to proof of use. It is only necessary to consider these trade mark registrations. United Kingdom registration no 2578769 is for the trade mark:



The application for registration was filed on 15 April 2011 and the registration procedure was completed on 12 August 2011. The application is registered for the same goods and services as London's registration with one difference; it

does not include *retail services connected with the sale of accreditation and qualifications* at the end of the class 35 specification. The other eight registrations upon which NOCN relies were applied for on the same date and the registration procedure was completed on the same date. They have the same specification. The only variance is in the colour of the representation and in that they have a different geographical indication ie NORTH EAST REGION, NORTHERN IRELAND, NORTH WEST REGION, SOUTH EAST REGION, SOUTH WEST REGION, WEST MIDLANDS REGION, YORKSHIRE & HUMBER REGION and EAST MIDLANDS REGION. In these circumstances it is only necessary to consider -769.

3) London has denied the grounds of invalidation. It requested proof of use of the trade mark that is subject to this provision. In relation to the suite of trade marks upon which NOCN relies for section 5(2)(b) of the Act, London admits that the respective goods and services are identical. It states:

“It is denied that the Proprietor’s mark is similar to the Applicants’ marks, listed at 2.above. Given there are 10 OCN regions using the OCN mark followed by their regional name, it is submitted that the dominant and distinctive elements of the marks are the name of the geographical region.”

4) Subsequent to the filing of its counterstatement, London has taken no part in the proceedings. NOCN has filed evidence and written submissions.

5) Section 5(2)(b) of the Act states:

“(2) A trade mark shall not be registered if because -
.....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

6) London has accepted that the respective goods and services are identical. Despite this admission against interest, the position of *retail services connected with the sale of accreditation and qualifications* will be considered. These services are not included in the services of -769. However, they are closely connected to *education* and *providing of training* in terms of purpose, complementarity, end user, channels of trade and nature. Consequently, *retail services connected with the sale of accreditation and qualifications* are highly similar to *education; providing of training*.

7) The EASTERN REGION element of -769 simply advises the consumer where the services are supplied or from where the goods emanate. The distinctive and

dominant component of -769 is the letters ocn. With the exception of the geographical indication, the respective trade marks are visually and orally identical.

8) -769 is represented in colour but, as neither it nor London's trade mark is limited to colour, it is necessary to drain colour from the trade mark of NOCN for the purposes of comparison.ⁱ

9) The respective trade marks are exceptionally similar.

10) The dominant and distinctive component of the trade mark of NOCN does not relate or allude to the goods and services of the registration. The trade mark enjoys a good degree of inherent distinctiveness. The respective goods and services are identical or highly similar. The respective trade marks are exceptionally similar. It is not so much that there is a likelihood of confusion, there is a certainty of confusion.

11) The registration was made in contravention of section 5(2)(b) of the Act and, in accordance with section 47(6) of the Act, the registration is deemed never to have been made.

Costs

12) A party to proceedings may be cautious in its approach and plead a number of grounds and rely upon a number of trade marks for safety sake. However, in this case the ground under section 5(2)(b) of the Act in relation to the suite of trade marks is, in the vernacular, a "slam dunk". There was no reason to rely upon other grounds or on a trade mark which was subject to proof of use. There was no need to file evidence. Consequently, no costs will be awarded in relation to the evidence that was filed.

13) NOCN, having been successful, is awarded costs upon the following basis:

Preparing a statement and considering statement of London:	£400
Application fee:	£200
Written submissions:	£200
Total:	£800

14) Open College Network London Region Ltd is ordered to pay National Open College Network the sum of £800. 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.

Dated this 18th day of November 2012

**David Landau
For the Registrar
the Comptroller-General**

ⁱ In *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) Mann J stated:

“119. It is not clear to me that this is a debate which advances the case very much, but the position seems to me to be as follows. As a matter of principle the exercise involves comparing the offending sign with the registered mark and assessing the likelihood of confusion or association. The two things have to be compared. Since we live in a visual world, and signs are visual, some form of appearance has to be considered. If the registered mark is limited to a colour, then the mark that is used has to be compared, as used, to the mark that is registered, as registered (and therefore in colour). If the registered mark is unlimited as to colour then it is registered for all colours. This means that the colour of the offending sign becomes irrelevant. It will not be possible to say that its colour prevents there being an infringement. At this point one can take one of two courses, each of which ought to have the same result. The first is to imagine the registered mark in the same colour as the offending sign. The second is to drain the colour from the offending sign. Either way one then has the material for comparison. One could even imagine them both in a third colour. It does not matter. So in a sense both Mr Purvis and Mr Bloch are right. As a matter of visual convenience it seems to me to be easier to imagine the registered mark in a colour than to imagine the offending sign drained of colour, and I propose to adopt that course.”

Also see *Mary Quant Cosmetics Japan Ltd v Able C & C Co Ltd* BL O/246/08.