

O/745/21

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK REGISTRATION NO. 2545349

ArtFund 

ArtFund 

(SERIES OF TWO)

IN THE NAME OF NATIONAL ART COLLECTIONS FUND

AND

APPLICATION 502954 BY VIA ART FUND, INC.

FOR THE REVOCATION OF THE TRADE MARKS

ON GROUNDS OF NON-USE

Background and pleadings

1. On 12th December 2019, Via Art Fund, Inc. (“the applicant”) filed an application to revoke the series of two trade marks (“the contested marks”), shown on the cover page of this decision, on grounds on non-use. The contested marks are registered under No. 2545349.
2. The registered proprietor of the contested marks is National Art Collections Fund (“the proprietor”). The contested marks were applied for on 20 April 2010. The registration procedure was completed on 24 September 2010. Following a partial surrender, the registration now covers the following goods and services:

Class 9 Video recordings.

Class 16 Paper, cardboard and goods made from these materials, not included in other classes; printed matter, books, printed publications; periodicals; books; magazines; brochures; newsletters; posters; stationery; instructional and teaching material (except apparatus).

Class 18 Shoulder bags; shopping bags.

Class 35 Advertising, marketing and promotional services; business management; business administration; customer relationship management; organisation, operation and supervision of sales and promotional incentive schemes; preparation and presentation of audio visual display for advertising purposes; dissemination of advertising matter; arranging and conducting of trade shows and exhibitions; compilation of business statistics and commercial information; provision of business information.

Class 36 Charitable fundraising; financial sponsorship; provision of loyalty schemes; provision of online information relating to any of the

aforesaid services; information, research, evaluation and consultancy services relating to any of the aforesaid.

Class 41 Educational and cultural services namely, conducting classes, seminars, conferences, and workshops in the fields of art, sculpture, painting, engraving, pottery, ceramics, business, advertising, marketing, information technology; art gallery services; museum services; commissioning of artist works; organisation of artistic competitions; instructional and teaching services relating to all the aforesaid; production of sound and video recordings; publishing services; library services; arranging and conducting of exhibitions and conferences; ticket reservation services; provision of online information relating to any of the aforesaid services; information, research, evaluation and consultancy services relating to any of the aforesaid.

3. The applicant seeks revocation of the contested marks under section 46(1)(a) and/or (b) of the Trade Marks Act 1994 (“the Act”).
4. Revocation is sought under section 46(1)(a) as a result of alleged non-use of the contested marks during the 5-year time period immediately following the date of completion of the registration procedure i.e. 25 September 2010 to 24 September 2015. On this basis, the applicant requests revocation of the contested marks with effect from 25 September 2015.
5. Alternatively, revocation is sought under section 46(1)(b) as a result of alleged non-use of the contested marks for the following 5-year periods:
 - a. From 26 September 2010 to 25 September 2015, with effect from 26 September 2015;
 - b. From 12 December 2014 to 11 December 2019, with effect from 12 December 2019.

6. The proprietor filed a counterstatement denying the grounds for revocation.
7. The proprietor is represented by Farrer & Co LLP and the applicant is represented by Derchert LLP. A hearing took place before me by video conference on 21st July 2021 at which Mr Jamie Muir Wood appeared as counsel for the proprietor and Mr Nathan Smith of Derchert LLP appeared on behalf of the applicant.
8. The proprietor's evidence-in-chief consists of the witness statement dated 2 November 2020, by Carolyn Young, the Director of Marketing of the proprietor, together with one exhibit (CY1). The applicant's evidence comes in the form of the witness statement dated 14 January 2021, by Nathan Smith, Senior Associate at Dechert LLP together with one exhibit (NS1).
9. The proprietor also filed evidence in reply. This comprises of two witness statements from Ms Young dated 15 March and 15 April 2021 together with exhibits CY2 and CY3, respectively.
10. Whilst I will not summarise either parties' evidence here, I have taken it into consideration and will refer to it where necessary.

The law

11. Section 46 of the Act states that:

“(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 ("the variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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 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.”

12. Section 100 of the Act is also relevant, which 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.”

13. In *Walton International Ltd & Anor v Verweij Fashion BV*, Arnold J. summarised the case law on genuine use of trade marks as follows:¹

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-

¹ [2018] EWHC 1608 (Ch)

442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 *P Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].
- (5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].
- (6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].
- (7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use

if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

14. In *Awareness Limited v Plymouth City Council*,⁷ Mr Daniel Alexander, QC, sitting as the Appointed Person, observed that a “tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive”.

15. As conceded by the parties at the hearing, if the proprietor can show genuine use of the contested marks in the more recent 5-year period of alleged non-use, the registration will not be revoked. Therefore, the question of genuine use in this case would be assessed for the period 12 December 2014 – 11 December 2019 (“the relevant period”). If no genuine use is demonstrated, the earliest revocation date, i.e. 25 September 2015 would apply. I should also record that the applicant advanced an alternative case of partial revocation under section 46(5).

Form of the mark

16. Ms Young states that the proprietor, over the years, adopted various signs, including the signs “ART FUND” and since 2016, the sign “Art Fund_”.² Ms Young claims that the use of those signs also amount to the use of the contested marks. There is ample evidence of the use of the marks in the

² Ms Young’s first witness statement, para 16

registered form in relation to various goods and services (I will return to this matter shortly). I will, therefore, consider the matter of variant use only if it is necessary.

Has there been genuine use of the mark?

17. There is considerable disagreement between the parties on the issue of genuine use. Mr Smith repeatedly argued that the proprietor failed to show that there has been real commercial exploitation or attempt to create or preserve a market for various goods and services it claimed genuine use for. My attention was also drawn to the fact that the proprietor was unable to adduce any sales or turnover figures or contracts with third parties in relation to the provision of various goods and services in the specification. In *SdS InvestCorp AG v Memory Opticians Ltd* (BL O/528/15), Professor Ruth Annand, sitting as the Appointed Person, observed that “it is clear from the CJEU case law including *Reber* that the relevant question for the tribunal to address is whether the proven use was commercially warranted in the marketplace taking account of all the relevant facts and circumstances of the case, which are interdependent.” Rather than looking at each piece of evidence independently (or the lack thereof), I am, therefore, required to make an assessment based upon the picture shown by all of the evidence before me.

18. Although most of the evidence are from 2015-2016, I remind myself that even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving a market for the relevant goods or services.

19. Citing the ruling in *Case C-17/06 Céline Sarl v Céline SA [2007] ETMR 80*, Mr Smith also advanced an argument that the contested marks were used to refer to the charity name of the proprietor and not as an indication of origin.³ In his skeleton argument and at the hearing, he specifically referred to a few examples. In this regard, I bear in mind the Court’s findings in *Verein Radetzky-*

³ Applicant’s skeleton argument para 12.3

Orden V Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'
(C-442/07) on genuine use of a trade mark in relation to charitable activities:

“17. The fact that a charitable association does not seek to make profit does not mean that its objective cannot be to create and, later, to preserve an outlet for its goods or services.

18. [...]

19. .. trade marks registered by a non-profit-making association may have a *raison d'être*, in that they protect the association against the possible use in business of identical or similar signs by third persons.

20. As long as the association in question uses the marks of which it is the proprietor to identify and promote the goods or services for which they were registered, it is making an actual use of them which constitutes 'genuine use' within the meaning of Article 12(1) of the Directive.

21. Where non-profit-making associations register as trade marks signs which they use to identify their goods or their services, they cannot be accused of not making actual use of those marks when in fact they use them for those goods or services.

....

24. ...a trade mark is put to genuine use where a non-profit-making association uses the trade mark, in its relations with the public, in announcements of forthcoming events, on business papers and on advertising material and where the association's members wear badges featuring that trade mark when collecting and distributing donations.”

It seems to me that the nature of the use is such that the relevant consumers would perceive the contested marks as the source identifier.

20. Before proceeding to assess the question of genuine use in relation to the each of the proprietor's goods and services, I will mention the law on fair

specification. This is because where I am satisfied that the extent of use as demonstrated entitles the proprietor to retain only some goods and services, I will devise a fair specification as I go along.

21. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as Appointed Person summed up the law relating to fair specification as:

“In the present state of the law, fair protection 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.”

22. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average Page 37 of 39 consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that

use in relation to holdalls justified a registration for luggage generally; Thomas Pink at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46"

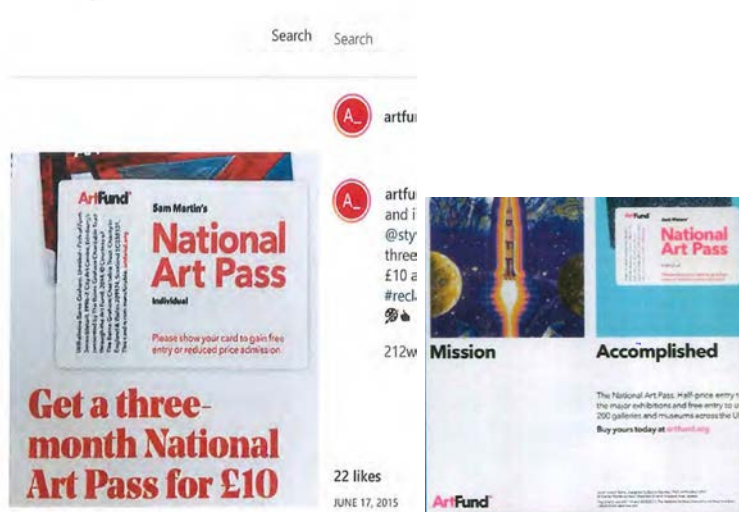
23. Mr Smith also submitted that if there is any use, it will be in respect of the proprietor's services in Class 36. I will, therefore, begin my assessment starting with Class 36 services. Where I refer to "contested mark" in the decision, it is either the mark **ArtFund™** or **ArtFund™**.

Class 36: Charitable fundraising; financial sponsorship; provision of loyalty schemes; provision of online information relating to any of the aforesaid services; information, research, evaluation and consultancy services relating to any of the aforesaid.

Charitable fundraising and financial sponsorship

24. There is a significant overlap in the evidence filed in support of those services. The evidence for charitable fundraising services primarily relates raising funds through the National Art Pass (“Pass”). The proprietor runs a subscription-based membership scheme that was rebranded and launched as the Pass where the members of the Pass are offered reduced entry tickets to various exhibitions at participating museums and art galleries.⁴ During 2014-2016, the period when most of the use is identified, the proprietor widely promoted its fundraising activities through its Pass under the contested marks on social media and the press. Some of the examples from the evidence are given below:

Art Fund on Instagram: “Get away from your desk and into a ga



Besides the Pass, the proprietor also engages in fundraising campaigns to save works of art for galleries and museums. For example, there is evidence of campaigns in the form of a Facebook video from 2016, under the contested marks, to save the work of art titled Armada Portrait of Elizabeth 1 for the Royal Museums of Greenwich, for which the proprietor later raised £16.25 million.⁵ The evidence also indicates that the proprietor raised nearly £53 million during 2014-2016.⁶ I note Ms Young’s statement that the proprietor raised funds under a number of different signs, including the contested marks. I take that into account when considering these figures; clearly, they will not relate entirely to the contested marks. However, bearing in mind the extent of use demonstrated

⁴ Ms Young’s first witness statement para 12.

⁵ Exhibit CY1, page 227 and Ms Young’s first witness statement para 27.

⁶ Ms Young’s first witness statement para 17.

of the contested marks, it is reasonable to assume that a proportion of that sum is attributable to funds raised under the contested marks. Ms Young states that the funds collected through the sales of the Pass enable the proprietor to support artists and museums in various ways, including the purchase of works of art and funding exhibitions.

25. Ms Young gives evidence that during 2014 -2016, the proprietor had spent over 30 million pounds on grants, for example, for acquisitions or projects.⁷ Ms Young also states that the proprietor offered £1 million of financial assistance to the National Galleries of Scotland and Tate to acquire various artworks from the d'Offay collection exhibited at museums and art galleries under the name Artist Rooms exhibitions. Several invitations to Artists Rooms exhibitions bearing the contested marks from the relevant period are in evidence, and they clearly indicate the financial support the proprietor provided to the National Galleries of Scotland and Tate. Taking the evidence in round, I am satisfied that the proprietor has demonstrated genuine use in relation to charitable fundraising and financial sponsorship services. I will return to the matter of fair specification shortly.

Provision of loyalty schemes

26. Although Mr Smith accepted that the proprietor provides loyalty scheme services, he argued that these services are provided under the National Art Pass brand. I find no merit in this argument. There is ample evidence to show that the proprietor used the contested marks to promote and identify its subscription-based membership scheme offered under the Pass during the relevant period. This includes promotion of the Pass on social media and press such as The Guardian and the Telegraph. There is also evidence of posters about the Pass that are supported by five “to whom it may concern” letters/emails from Directors of various galleries or museums who confirm that the posters the bearing the contested marks was displayed in their museums between 2012-2019.⁸ Mr Muir Wood invited me to place some weight on them

⁷ Ms Young’s first witness statement, para 18.

⁸ Exhibit CY3

as there is no reason why the Directors would be trying to mislead the Registry. Although there are no witness statements, I see no reason to give less weight to that evidence from the Directors. The reach of the Pass is further evident from the number of members; during 2014 - 2019, the annual members rose from 117,000 to 159,000. Considering all those factors, I see no reason to find against the proprietor on this point, and genuine use is established. I will return to the matter of fair specification shortly.

Provision of online information relating to any of the aforesaid services; information services relating to any of the aforesaid

27. For the same reasons given at paragraphs 24-26, I hold that the genuine use is established in relation to the above-mentioned services.

Research, evaluation and consultancy services relating to any of the aforesaid

28. In support of the claim of genuine use, the proprietor relies largely on documents such as project summary and evaluation form used at Treasure Plus Conference purportedly organised by the proprietor to focus on improving public engagement with treasure and archaeological collections.⁹ An evaluation form used to capture participant's feedback or documents summarising an event do not demonstrate that the contested marks were used in relation to evaluation, let alone research or consultancy services in relation to charitable fundraising, financial sponsorship or loyalty scheme services. There is no evidence that the proprietor offered these services to third parties under the contested marks. The other documents relied upon include cover pages of documents titled "Patron Circle" or "How the Art Fund can support your museum or gallery". It is also not clear how these documents would assist the proprietor in establishing genuine use in relation to research, evaluation or consultancy services, either. Genuine use is not established.

⁹ Exhibit CY1 pages 158-169, 183

29. The applicant's position is that if there is a use in relation to services in Class 36, the specification must be cut down to reflect the precise nature of the services, i.e. services in the field of art. The applicant also proposed the following specification:

"Charitable fundraising; financial sponsorship; provision of loyalty schemes; provision of online information relating to any of the aforesaid services; all of the aforementioned services in the field of art"

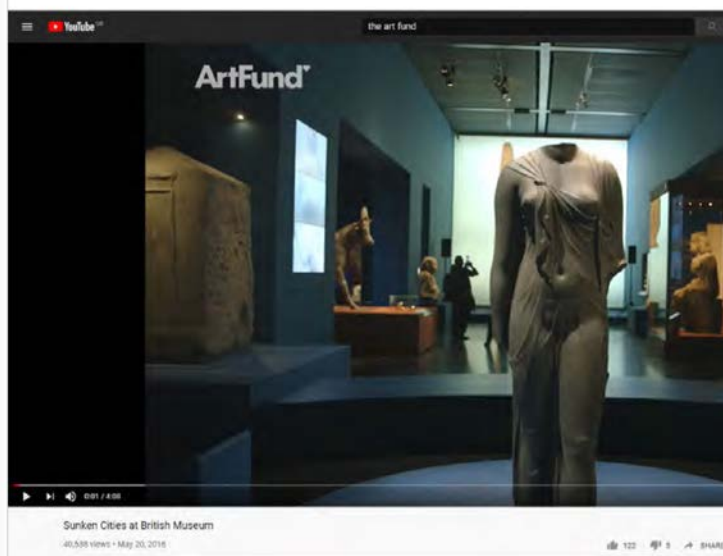
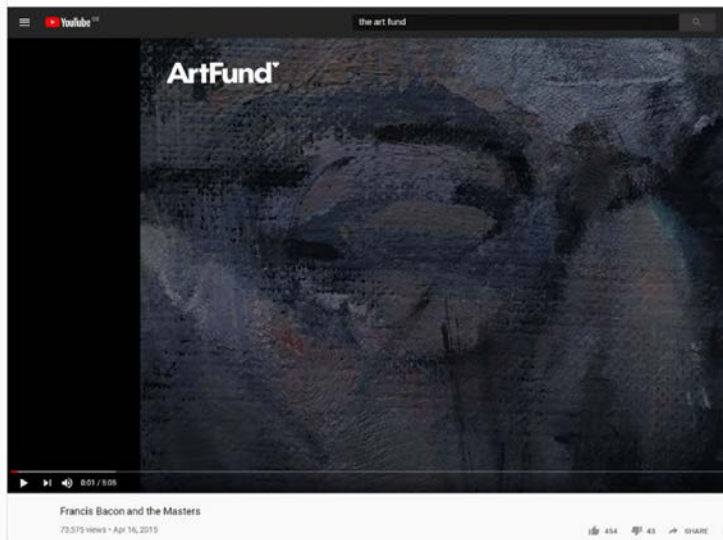
In response, Mr Muir Wood argued that the terms as contained in the specification are unlikely to create an unfair monopoly in the proprietor's favour. The question before me is, therefore, whether the applicant's proposed fair specification is a fair description of the use shown in the evidence. I am of the view that charitable fundraising, financial sponsorship and provision of loyalty schemes are broad terminologies and it is appropriate to sub-categorise those terms. I accept that "services in the field of art" is a distinct sub-category, and the use of the marks have been demonstrated only in relation to that category. I, consider the following to represent a fair specification of the use made:

Class 36: Charitable fundraising; financial sponsorship; provision of loyalty schemes; provision of online information relating to any of the aforesaid services; information services relating to any of the aforesaid; all of the aforementioned services in the field of art.

Class 35: Advertising, marketing and promotional services; business management; business administration; customer relationship management; organisation, operation and supervision of sales and promotional incentive schemes; preparation and presentation of audio visual display for advertising purposes; dissemination of advertising matter; arranging and conducting of trade shows and exhibitions; compilation of business statistics and commercial information; provision of business information.

Advertising, marketing and promotional services

30. In support of the claim of genuine use, the proprietor provides screenshots of a number of YouTube videos, copies of exhibition guides from 2015 – 2016 and extracts from the proprietor’s website. Although I consider that some of the videos are merely promotional materials for its National Art Pass or the Museum of the Year award competition, there are nearly twelve videos from 2015-2016 that I consider do not fall into that category.¹⁰ Those videos claimed to be presented by cultural commentators or art historians such as Jacky Klein cover topics such as an introduction for or an overview of the art gallery or museum exhibitions or painters such as Francis Bacon. Listed below are a few examples from the evidence:



¹⁰ Exhibit CY2

31. The contested mark is seen of all the screengrabs. I am satisfied that the evidence corroborates Ms Young's statement that the proprietor produced and published materials such as videos to promote exhibitions of museums and galleries.¹¹ Similarly, in relation to the exhibition guides, such as



Mr Muir Wood concedes that the proprietor did not operate the exhibitions mentioned in those guides either. This, when considered together with Ms Young's statement that the proprietor promotes exhibitions of museums and galleries through guides, I am drawn to infer that the purpose of the videos and exhibitions guides was to promote the activities of third parties. Mr Smith, however, criticised that the proprietor did not provide any third-party agreements in this regard. Even in the absence of evidence of third party agreements, it is reasonable to infer that there must be some arrangements with museums and art galleries that would have permitted the proprietor to use images of works of art on exhibition guides or produce videos for them. There is also evidence that the proprietor offered marketing services to Sotheby's Institute of Art.¹² Ms Young also states that the proprietor has spent millions on advertising and promotion during the relevant period. Although no breakdown figures have been provided to assist me in determining what proportion the proprietor spent on promoting third party activities under the contested marks, I accept that at least some proportion of this must have been spent on such activities given the evidence discussed above. Taking the evidence in round, I hold that the evidence the proprietor has provided is sufficient to demonstrate genuine use in relation to advertising, marketing and promotional services. However, these terms are broad enough to encompass services offered in a wide variety of fields. As the evidence has demonstrated that the contested marks were actually used only in relation to services

¹¹ Ms Young's first witness statement para 40.

¹² Exhibit CY1, pages 219-220.

connected to art, I consider the fair specification to be advertising, marketing and promotional services in the field of art.

Preparation and presentation of audio visual display for advertising purposes; dissemination of advertising matter

32. Following my conclusion in the paragraph above, I am satisfied that the proprietor prepares advertising videos for museums and galleries and presents them to the public through social media and its website. Genuine use is established. Based on the earlier findings, I consider it appropriate to limit the specification to: preparation and presentation of audio visual display for advertising purposes; dissemination of advertising matter; all of the aforementioned services in the field of art.

Business management and business administration

33. Business management and administration appear to be services where an undertaking manages and administers business operations such as goal settings, revenue models or project management for other companies. Mr Muir Wood directed me to the evidence of the Treasure Plus conference purportedly organised by the proprietor.¹³ Arranging a conference on treasure and archaeological collections does not demonstrate that the proprietor offers business management and administration services to third parties.¹⁴ I, therefore, conclude that genuine use is not established.

Customer relationship management

34. Customer relationship management appears to be a service provided to businesses to manage their interactions with current or potential customers. The evidence filed in support of the claim of genuine use in relation to these services consists of a number of newsletters the proprietor sent to its members.

¹³ Exhibit CYI, pages 158-169

¹⁴ Exhibit CYI, page 183

It does not demonstrate that the proprietor offers customer relationship management services to third parties. Genuine use is not established.

Organisation, operation and supervision of sales and promotional incentive schemes

35. The evidence comes in the form of various press releases, posters and videos on Pass. They clearly relate to the promotion of the proprietor's own incentive scheme. This is no evidence whatsoever to support a conclusion of genuine use in relation to the services of organising, operating and supervising sales and promotional incentive schemes for third parties. Genuine use is not established.

Arranging and conducting of trade shows and exhibitions

36. The proprietor relies on the same evidence filed in support of its services related to arranging and conducting exhibitions in Class 41. There is a difference between services in Class 35 and 41. Services in Class 35 concern trade shows and exhibitions for commercial and advertising purposes, while Class 41 concerns arranging and conducting exhibitions on work of art. The proprietor's evidence concerns exhibitions related to works of art. It does not support a conclusion of use in relation to services in Class 35. Accordingly, I find that no genuine use has been established.

Compilation of business statistics and commercial information; provision of business information

37. Compiling business statistics and commercial information services concern those services offered to third parties in compiling and interpreting data and information. The only evidence the proprietor has provided is that of its own annual reports or reports of conferences apparently prepared by the proprietor. Preparing one's own reports is plainly not evidence to support the claim of use in relation to any of the services listed above. No genuine use has been established.

Class 41: Educational and cultural services namely, conducting classes, seminars, conferences, and workshops in the fields of art, sculpture, painting, engraving, pottery, ceramics, business, advertising, marketing, information technology; art gallery services; museum services; commissioning of artist works; organisation of artistic competitions; instructional and teaching services relating to all the aforesaid; production of sound and video recordings; publishing services; library services; arranging and conducting of exhibitions and conferences; ticket reservation services; provision of online information relating to any of the aforesaid services; information, research, evaluation and consultancy services relating to any of the aforesaid.

Educational and cultural services namely, conducting classes, seminars, conferences, and workshops in the fields of art, sculpture, painting, engraving, pottery, ceramics, business, advertising, marketing, information technology

38. The proprietor's evidence in support of the claim of genuine use in relation to the services mentioned above comes in the form of several newsletters bearing the contested marks issued to its members. The newsletters' contents suggest that the proprietor organised various lectures and/or museum/castle/art gallery visits through its fundraising committees. The lectures were referred to as "lecture, written especially for us", and covered various topics such as Chinese ceramics, British artists, or The Royal Collection, and were delivered by guest speakers.¹⁵ Members as well as their friends and families were allowed to book tickets to those events.¹⁶ At the hearing, I was also referred to page 219 of the evidence, which appears to be a letter from the proprietor addressed to Sotheby's Institute of Art on a course titled "Navigating the Art Market". According to the programme agenda, the course was designed to provide curators with various information such as an understanding of how the art market functions and legal aspects of acquiring art.¹⁷ Raising criticism at this evidence, Mr Smith argued that the proprietor did not offer the course itself; instead, agreed only to market it. While it might be a case that the course might

¹⁵ Exhibit CY1 Page 241, 244, 248, 249-250, 251-253, 254, 257-262

¹⁶ Exhibit CY1 Page 101, 147-148, 162

¹⁷ Exhibit CY1 Page 232

have been delivered by Sotheby's, the proprietor appears to have provided guidance on how to run the course, including detailed instructions on delivering the course, capturing feedback, when to run this course and return the evaluation form to the proprietor. Moreover, the participants were also requested to confirm their place on the course by sending out a booking form to an email address maintained by the proprietor i.e., courses@artfund.org. The contested mark is also seen on the programme agenda for the course. Considering all these factors, I am prepared to draw an inference in favour of the proprietor. The proprietor also relies upon the Treasure Plus Conference.¹⁸ Mr Muir Wood stated that the conference was organised to educate those in the museum industry. I note that the conference is itself referred to as "The Art Fund Treasure Plus Conference", the evaluation form and the conference summary being prepared by the proprietor.¹⁹ The contested mark is seen throughout the documents. Taking all of the evidence into account, I am satisfied that genuine use has been established. In arriving at a fair specification, I agree with Mr Smith that Treasure Plus was a one-off instance of evidence in support of conference. However, I consider that the average consumer is likely to perceive the terms classes, seminars, conferences, and workshops to belong to the same category, and, therefore, limiting the specification would be overly restrictive. I also consider that the term "art" encompasses the terms "sculpture, painting, engraving, pottery, ceramics", and in terms of fair specification, those terms are fair as it stands. The evidence, however, does not demonstrate that the contested marks were used in relation to conducting courses or conferences in the field of business, advertising, marketing, information technology. Accordingly, the genuine use claim in relation to educational and cultural services namely, conducting classes, seminars, conferences, and workshops in the fields of business, advertising, marketing and information technology fails.

Art gallery services and Museum services

¹⁸ Exhibit CY1 page 183

¹⁹ Exhibit CY1 pages 162-169

39. The above-mentioned services are offered by art galleries and museums and include services such as collection, preserving or exhibiting works of art or objects of artistic or cultural significance. As rightly noted by Mr Smith, the proprietor is neither an art gallery nor a museum. Instead, as the evidence indicates, the proprietor is a charitable organisation that raises funds and offers financial assistance through various activities to art galleries and museums. Genuine use is, therefore, not established.

Commissioning of artist works

40. Commissioning of artist works appears to be a service offered by undertakings to commission work of art based on client's specifications. Mr Muir Wood directed to me page 119 of the evidence which is the sole evidence filed in support of the above-mentioned service. It is a receipt for collection of work titled "*Tania Kovats The Space of Reading*". The contested mark is seen at the top right-hand side of the page. The contents of the receipt suggest that the document is merely a receipt issued by the proprietor upon collection of the work by the owner/agent/applicant from the proprietor. It does not appear to me nor is there evidence that this work of art was commissioned by the proprietor for third parties, nor that the contested mark was used in relation to commissioning of artist works services. Moreover, there is also no evidence of scale of use. In the absence of evidence, I find that genuine use is not established.

Organisation of artistic competitions

41. The proprietor relies on the evidence of the "Museum of the Year" competition it runs annually where the winning museum is given £100,000.²⁰ As rightly noted by Mr Smith, Museum of the Year competitions are contests between different museums, and it is not an artistic competition. The proprietor also relies on the evidence of the photography competition it organises, where participants are invited to send pictures of the finalist museum they went to.

²⁰ Ms Young's first witness statement, para 31.

This competition appears no more than an event organised to promote the proprietor's museum of the year competition and in any event I do not consider the extent of the use shown to be sufficient. I, therefore, hold that genuine use is not established.

Instructional and teaching services relating to all the aforesaid

42. As I have already concluded, the proprietor has failed to demonstrate genuine use in relation to art gallery services, museum services, commissioning of artist works, and organisation of artistic competitions. Therefore, genuine use claim in relation to instruction and teaching services relating to only those services fails.

Production of sound and video recordings

43. For the same reasons given at paragraph 30, I conclude that the genuine use is established. Production of sound and video recordings is a broad term and it is appropriate to sub-categorize. I find the fair specification to be production of sound and video recordings in the field of art.

Publishing services

44. Referring to quarterly magazines the proprietor sends to its members, Mr Muir Wood argued that the proprietor by publishing those magazines, is preserving a corner of the market for publications. The other evidence filed in support of publishing services consists of cover pages of exhibition guides. The publication services are aimed at individuals who wish to disseminate their work in written or electronic form. Evidence does not suggest that that is the case. It does not follow automatically that an entity that issues quarterly magazines or prepares exhibition guides also offers publication services to its members or the public. In the absence of evidence, I find that genuine use is not established.

Library services

45. The purpose of library services is to make publications available to the public, usually by lending or providing online access to materials. The Proprietor's evidence comes in the form of two undertakings given by people to access certain records held by the proprietor relating to the acquisitions of works of art by art galleries.²¹ Given that the proprietor provides financial assistance to galleries to acquire various works of art, the archive the proprietor claims to be maintaining for galleries is more likely to be an arrangement to manage their internal records. Evidence of providing access to those records does not lead to a conclusion that the proprietor is offering library services let alone attempting to create or maintain a market for those services. Genuine use is not established.

Arranging and conducting of exhibitions and conferences

46. The proprietor's evidence comes in the form of lectures and conferences, invitations to Artist Rooms exhibitions and screengrabs of videos. In the context of the proprietor's core services, the term exhibition means a public event at which pictures, sculptures, or other objects of interest are displayed, for example, at a museum or art gallery.²² Lectures and conferences are not exhibitions. There is also no evidence to lead me to a conclusion that the Artist Rooms exhibitions were arranged and conducted by the proprietor. As mentioned earlier, I am convinced that the exhibitions referred to in the videos and exhibitions guides were operated by third parties such as museums and galleries. In the circumstances, I hold that the genuine use has not been demonstrated in relation to services of arranging and conducting exhibitions. In relation to the services of arranging and conducting conferences, following my findings at the paragraph 38, I hold that genuine use is established. However, the specification must be limited to arranging and conducting conferences in the field of art.

²¹ Exhibit CY1 pages 81 and 82

²² <https://www.collinsdictionary.com/dictionary/english/exhibition> accessed on 25 September 2021.

Ticket reservation services

47. At the hearing, Mr Muir Wood referred me to a screen-print of a webpage for Henry Moore Studios & Gardens admission to substantiate the claim of genuine use in relation to ticket reservation services.²³ As most of the texts were illegible, including the date, I was asked to refer to the index of documents enclosed with Ms Young's witness statement that provided a description of the documents exhibited to the witness statement together with its dates. The index describes the referenced document as "Art Tickets webpage for the purchase of tickets for the Henry Moore Studios Gardens, showing financial sponsorship from the Art Fund". In Ms Young's witness statement, this document is referred to as "Henry Moore Studio's ticket booking page".²⁴ I also note that, on the webpage, the contested mark appears along with the logo of The National Lottery. It is not clear to me from page filed in evidence that it was the proprietor who offered ticket reservation services in relation to that event. On the face of it, this document appears nothing more than a promotional material for the proprietor's financial sponsorship services.

48. In addition to that evidence, the proprietor relies upon a number of newsletters. The newsletters indicate that the proprietor's members, as well as their friends and families were offered to book tickets through the proprietor to various events either online or by filling out ticket application forms and making a cheque payable to the proprietor.²⁵ The contested mark is seen on the booking forms. Although the proprietor appears to have organised most of the events referred to in the newsletters, some of the events such as exhibitions at Whitworth museum, Manchester art gallery, appear to be third party events, entry tickets for which could be purchased through the proprietor.²⁶ Mr Smith criticised the evidence on the basis that it was offered to its members as a perk. I have already noted that the proprietor also allowed members' friends and families to book entry tickets to certain events. Moreover, the whole purpose of

²³ CY1 page 171.

²⁴ Ms Young's first witness statement, para 33.

²⁵ Exhibit CY1 pages 211, 244, 248, 251-253, 254, 257-262, 272

²⁶ Exhibit CY1 Pages 259-263.

being a member is to avail of certain benefits in return for a membership fee. Even if some of the services, as evidenced, were offered to its members as a part of the membership programme, this does not lessen its capacity to perform the essential function in relation to ticket reservation services. Taking evidence in round, I hold that the proprietor has demonstrated genuine use in relation to ticket reservation services, the fair specification being ticket reservation services in the field of art.

Provision of online information relating to any of the aforesaid services; information services relating to any of the aforesaid.

49. For the same reasons given at the preceding paragraphs, I hold that genuine use is established. However, the specification must be limited to reflect that the services are provided in the field of art.

Research, evaluation and consultancy services relating to any of the aforesaid.

50. In the absence of evidence, I conclude that the proprietor has not demonstrated genuine use in relation to the afore-mentioned services.

51. Based on my findings in the preceding paragraphs, I consider the fair description of the proprietor's services to be:

Class 41: Educational and cultural services namely, conducting classes, seminars, conferences, and workshops in the fields of art, sculpture, painting, engraving, pottery, ceramics; instructional and teaching services relating to all the aforesaid; production of sound and video recordings; arranging and conducting of conferences; ticket reservation services; provision of online information relating to any of the aforesaid services; information services relating to any of the aforesaid; all of the aforementioned services in the field of art.

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter, books, printed publications; periodicals;

books; magazines; brochures; newsletters; posters; stationery; instructional and teaching material (except apparatus).

Paper, cardboard and goods made from these materials, not included in other classes

52. The proprietor's evidence of use in respect to these goods mainly consists of copies of invitation cards apparently from various museums and galleries to Artists Room exhibitions, proprietor's invitations to dinners hosted in relation to museum of the year awards, or materials relating to the Pass such as its welcome pack or a copy of the card itself. While invitations to Artists Room exhibitions do not appear to originate from the proprietor, the other materials relied upon are no more than promotional materials for either events hosted by the proprietor or its membership scheme. None of the evidence indicates that the average consumer would construe the contested marks on those materials as an indication of origin in relation to paper, cardboard, or goods made from those materials. Accordingly, I hold that no genuine use has been established.

Printed matter, books, printed publications; periodicals; books; magazines; brochures; newsletters; posters; stationery; instructional and teaching material (except apparatus).

53. In support of its claim to have used the contested marks on printed matter, printed publications, periodicals, magazines, brochures and newsletters, the proprietor relies on a number of newsletters and exhibition guides. The proprietor has also provided a cover page of its quarterly magazine titled Art Quarterly from 2016.²⁷ The contested mark is seen on the top right hand corner of the newsletters, front pages of the exhibition guides and the editorial page of the magazine. Although I only have an example cover page of the magazine, in the absence of cross-examination, I accept Ms Young's statement that, Art Quarterly, is published four times a year, and provides content on art, artists, exhibitions and collections.²⁸ The evidence demonstrates the use of the

²⁷ Exhibit CY1 pages 236-237

²⁸ Ms Young's first witness statement para 34

contested mark in relation to the magazine. As mentioned earlier, the evidence demonstrates that the proprietor provides newsletters to its members based in various locations in the UK and exhibition guides to the public under the contested marks. In this regard, I bear in mind that the proprietor had a significant number of members during the period when the use is demonstrated. Although I accept that the contested marks on these goods does not relate to the proprietor's core activities, I am satisfied that the proprietor is assuming responsibility in the trade mark sense for magazines, periodicals, brochures, and newsletters. Taking evidence in round, I hold that the proprietor has demonstrated genuine use. I will return to fair specification shortly.

54. In relation to the claim of genuine use in relation to posters, the proprietor relies on a number of posters displayed at art galleries and London Underground stations. I note that out of six posters referred to in the Directors' emails, the message presented by five of the posters is that the Pass is welcome in those galleries and museums. The purpose of the posters at galleries and museums are apparently to promote the use and/or awareness of the proprietor's fundraising activities/ Pass. Similar is the purpose of the posters displayed in London Underground stations. Considering all these factors, I am not satisfied that the use was by way of real commercial exploitation of the mark on the market for posters.

55. The evidence in relation to books is also deficient to allow me to conclude in the proprietor's favour. The proprietor relies upon three documents; "The Paston Treasure Norwich Castle Museum & Art Gallery", "Patrons Circle", and "A Guide To Giving Art".²⁹ The Paston Treasure appears to be a book from Norwich Castle Museum & Art Gallery and the contested mark appearing on the page filed in evidence appears nothing more than endorsement of funding from the proprietor.³⁰ I only have the cover pages of the other two documents. It appears no more than promotional materials that are aimed at the proprietor's financial donors.³¹ Evidence in relation to stationary does not put the proprietor

²⁹ Exhibit CY1 pages 121,140 and 172

³⁰ See index of documents enclosed with Ms Young's first witness statement.

³¹ *Ibid*

in any better position. The contested marks are not seen most of the materials. Where the contested marks are seen, they appear to be nothing more than promotional materials for events hosted by the proprietor.

56. Evidence for instructional and teaching materials (except apparatus) comes in the form of conference reports, documents outlining the proprietor's financial support for museums or galleries, exhibition guides. While the purpose of guides is to promote exhibitions at galleries, the rest of the documents appears to be used to promote and provide information about the proprietor's core activities. The proprietor is clearly not providing instructional and teaching materials to third parties for creating or maintaining a market for those goods. No genuine use is established.

57. I have taken into consideration whether the proprietor is entitled to retain the broad terms "printed matter" and "printed publications". These are terms are apt to include a variety of printed matters such as books, posters, teaching materials or newspapers. The proprietor has shown the use of the contested marks only in relation to certain sub-categories of printed matter or printed publications namely, magazines, newsletters, periodicals and brochures, all of which relates to art. Therefore, I consider is a fair description of the proprietor's goods in Class 16 to be:

Periodicals; magazines; brochures; newsletters; all of the aforementioned in the field of art.

Class 18: Shoulder bags; shopping bags

58. The only evidence filed are images to two cloth bags and two paper bags and no information has been provided of the scale of use or the number of bags sold.³² I am of the view that the contested mark is not used in a manner to distinguish the trade origin of those bags from other traders in same field. Instead, it is more likely that the contested mark is used to endorse the proprietor's support to museums or exhibitions, or as promotional giveaways

³² Exhibit CY1 pages 265, 271

for the proprietor's Museum of Year Award ceremony. I hold that Class 18 specification is to be revoked in its entirety.

Class 9: Video recordings

59. Following my findings at paragraph 28, it seems apparent that video recordings are ancillary to the proprietor's services in Class 35. I am satisfied that the contested marks on video recordings is intended to generate a market for those goods in Class 9. As the use has been demonstrated only on video recordings concerning art, the fair specification is:

Class 9: video recordings in the field of art.

Conclusion

60. The application has been partially successful. Where I have found genuine use, the specification is to be limited for those goods and services to read as:

Class 9 Video recordings in the field of art.

Class 16 Periodicals; magazines; brochures; newsletters; all of the aforementioned in the field of art.

Class 35 Advertising, marketing and promotional services; preparation and presentation of audio visual display for advertising purposes; dissemination of advertising matter; all of the aforementioned in the field of art.

Class 36 Charitable fundraising; financial sponsorship; provision of loyalty schemes; provision of online information relating to any of the aforesaid services; information services relating to any of the aforesaid; all of the aforementioned in the field of art.

Class 41 Educational and cultural services namely, conducting classes, seminars, conferences, and workshops in the fields of art, sculpture, painting, engraving, pottery, ceramics; instructional and teaching services relating to all the aforesaid; production of sound and video recordings; arranging and conducting conferences; ticket reservation services; provision of online information relating to any of the aforesaid services; information services relating to any of the aforesaid; all of the aforementioned in the field of art.

61. The consequence of this is that the proprietor's registration will be revoked, save for the goods and services mentioned above, with effect from 25 September 2015.

Costs

62. At the hearing, Mr Smith stated that should the need arise, the applicant be granted permission to make further cost submissions after a substantive decision has been issued. Accordingly, **I direct that the applicant file written submissions on costs within 14 days of the date of this decision.** I will then assess the costs I consider to be reasonable and issue a supplementary costs decision.

Appeal Period

63. The appeal period will be set from the date of the supplementary costs decision.

Dated this 8th day of October 2021

**Karol Thomas
For the Registrar
The Comptroller-General**