

**TRADE MARKS ACT 1938 (as amended)
TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION No 1283825
BY PITMAN EDUCATION & TRAINING LTD
TO REGISTER A TRADE MARK IN CLASS 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 33209 BY SIR ISAAC PITMAN LTD**

TRADE MARKS ACT 1938 (as amended)
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**IN THE MATTER OF Application No 1283825 by
Pitman Education & Training Ltd to Register a mark
in Class 42**

10 **and**

**IN THE MATTER OF Opposition thereto under No 33209
by Sir Isaac Pitman Ltd**

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BACKGROUND

On 1 October 1986 Pitman Education & Training Ltd, applied under section 17 of the Trade
Marks Act 1938 to register the mark PITMAN for a specification of goods which reads:

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Computer programming services; all included in Class 42.

The application is numbered 1283825.

25 On 5 October 1992 Sir Isaac Pitman Ltd filed a notice of opposition to this application. The
grounds of opposition in summary are:-

30 Under Section 11 because of their use of trade marks incorporating the word PITMAN
such that any use by the applicants of their trade mark on the services specified in the
application is likely to deceive and cause confusion.

Under Section 12(3) because the applicants' trade mark so nearly resembles the
opponents trade marks detailed below for which applications for registration have been
filed.

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By the time this matter came forward for a hearing the opponents' trade marks on which the
opposition is founded had been registered. The objection therefore falls to be considered
under Section 12(1). The trade marks are shown below:

40	<u>No.</u>	<u>Mark</u>	<u>Class</u>	<u>Specification</u>
45	1289373	SIR ISAAC PITMAN	41	Assessment services; provision of examinations and other forms of assessment leading to qualifications; including national vocational qualifications; certification in relation to examinations and other forms of assessment; curriculum development relating to development

5 and specification of standards, practices, syllabuses and accreditation systems to enable national and international assessment of candidates; implementation of control procedures, quality control procedures and maintenance of student records in relation to examinations and other forms of assessment; arranging for exhibitions and seminars in relation to assessment services, standards, qualifications, practices and syllabuses; all included in Class 41.

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1289376 PITMAN 41 Assessment services; provision of examinations and other forms of assessment leading to qualifications, including national vocational INSTITUTE qualifications; certification in relation to examinations or other forms of assessment; curriculum development relating to the development and specifications of standards, practices, syllabuses and accreditation systems to enable national and international assessment of candidates; implementation of control procedures, quality control procedures and maintenance of student records in relation to examinations and other forms of assessment; arranging for exhibitions and seminars in relation to assessment of services, standards, qualifications, practices and syllabuses; all included in Class 41.

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30 The applicants filed a counter-statement denying the above grounds.

Both parties ask for the exercise of the Registrar's discretion and an award of costs in their favour. Both sides filed evidence and the matter came to be heard on the 25 November 1999 when the applicants were represented by Mr Simon Belcher of Urquhart-Dykes & Lord, Trade Mark Attorneys and the opponents by Ms Sarah Leno of Forrester Ketley Co, Trade Mark Attorneys.

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By the time the matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provision of the old law.

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Opponents Evidence

5 This consists of a single statutory declaration dated 28 April 1996 by Mr Timothy Edward Statham the Secretary to The City and Guilds of London Institute, a position he has held for the last three and a half years.

10 Mr Statham states that Sir Isaac Pitman Limited, the opponents, are a wholly owned subsidiary of The City and Guilds of London Institute and that he is authorised to make the declaration on behalf of the opponents.

15 Mr Statham says that the opponents are the applicants in respect of trade mark application numbers 1289373, SIR ISAAC PITMAN in class 41 and 1289376 PITMAN EXAMINATIONS INSTITUTE in class 41. Both applications date from 1 October 1986. Mr Statham goes on to explain that Sir Isaac Pitman developed his system of shorthand in 1840 and that the system grew in popularity and the Pitman Examinations Institute was developed. He states that whilst shorthand is still one of the major subjects, in recent years the range of subjects has been extended to include new office technology with examinations in keyboarding, data processing, word processing, understanding computers, etc.

20 Mr Statham says that until 1985 the business was run as a family business but that at that time the business was split into three parts, one of which was Sir Isaac Pitman Limited and the Pitman Examinations Institute. In December 1990 The City and Guilds of London Institute took over Pitman Examinations Institute and Sir Isaac Pitman Limited (the opponents).

25 Mr Statham states that the first use in the United Kingdom in relation to examining, certifying and assessment activities of Sir Isaac Pitman Limited provided under its trade marks SIR ISAAC PITMAN and PITMAN EXAMINATIONS INSTITUTE was made at least as long ago as 1955. At TES1 he exhibits literature illustration the range of qualifications available together with regulations and syllabuses, examination papers and certificates. These cover a wide range of subjects including shorthand, word processing, English, French, disk management and numeracy and accounts.

30 Mr Statham then sets out figures for the combined turnover in relation to the activities mentioned above. Figures for the period 1983 to 1991 are given as:-

35	to 31/3	1983	1,387,692
	to 31/3	1984	1,474,300
	to 31/3	1985	1,966,349
	calender year	1986	2,381,100
40	calender year	1987	2,245,013
	calender year	1988	2,595,398
	calender year	1989	2,543,400
	calender year	1990	2,518,938
	calender year	1991	2,529,790

45 Mr Statham states that 45-50 per cent of the opponents business is conducted overseas and the above figures include income from overseas remitted to the opponents in sterling.

Mr Statham says that the opponents are engaged in extensive advertising in different media. At TES2 he exhibits a schedule of advertisements together with examples of advertisements and the dates on which they have appeared. These cover national and regional press. The opponents have also promoted their activities at exhibitions held both in the United Kingdom and abroad. At TES3 he exhibits photographs of the display stands at exhibitions together with a schedule of conferences and exhibitions attended in 1989 and 1990 which give an idea of conferences previously attended at home and overseas.

Mr Statham then sets out the advertising, promotions literature and exhibition expenditure figures in relation to the activities mentioned above and provided under the trade marks SIR ISAAC PITMAN and PITMAN EXAMINATIONS INSTITUTE for the period 1984 to 1991.

	to 31/3	1984	5,986
15	to 31/3	1985	17,301
	calender year	1986	62,206
	calender year	1987	127,171
	calender year	1988	50,837
	calender year	1989	58,379
20	calender year	1990	53,987
	calender year	1991	94,029

Mr Statham states that the opponents have also displayed the trade marks Sir ISAAC PITMAN and PITMAN EXAMINATIONS INSTITUTE on company stationery, etc. AT TES4 he exhibits examples of stationery. These appear to show PITMAN EXAMINATIONS INSTITUTE used on a range of stationery including moderator reports, application forms and requisition forms etc.

Mr Statham states that the opponents have effected sales throughout the United Kingdom and at TES5 he exhibits a list of towns and cities in which such sales have been effected and samples of requisition forms received in respect of examinations. These cover the whole of the United Kingdom.

Finally, Mr Statham states that the use of the trade marks sought to be registered is likely to be brought into conflict with the opponents' use of trade marks comprising the words PITMAN and PITMANS in relation to examination and related services. He states that this is likely to deceived or cause confusion and lead people to think, contrary to the fact, that the computer programming services emanate from the opponents. Moreover, registration of the mark applied for would unfairly prejudice the opponents in the conduct of their business under their trade marks.

Applicants' Evidence

The applicants filed a statutory declaration dated 22 January 1997 by Helen Margaret Johnstone, the trade mark agent responsible for the conduct of this opposition on behalf of the applicants. Ms Johnstone refers to a statutory declaration of Karl Edward Chapman which was filed by Pitman Education & Training Limited in support of application numbers:

1283823, 1283824, 1283826, 1283827, & 1370317. A copy of Mr Chapman's declaration together with exhibits is attached at exhibit HMJ.

5 The statutory declaration of Karl Edward Chapman is dated 18 June 1991. Mr Chapman says that he is director of CRT Group plc, the applicants, a position that he has held since 1989.

10 Mr Chapman explains that the trade mark PITMAN was first used in the United Kingdom not later than 1870 by Sir Isaac Pitman and his family, the predecessors in title to the applicants. On 29 December 1896 Sir Isaac Pitman and his family established a limited liability company under the name Sir Isaac Pitman & Sons Limited, which continued the use of the mark. Mr Chapman says that on 8 October 1975 Sir Isaac Pitman & Sons Limited was re-incorporated under the name Pitman Limited and that this was subsequently re-registered as a public limited company on 27 January 1982.

15 Mr Chapman states that by a series of written agreements dated between March and June 1985 a reorganisation of Pitman Plc took place whereby, inter alia, the training business was acquired by a company named Pitman Training Limited on behalf of Mark Christian Pitman, the great grandson of Sir Isaac Pitman. Mr Chapman explains that this re-organisation also involved the voluntary liquidation of Pitman Plc.

20 Mr Chapman says that on 25 March 1990 Pitman Training Limited was re-incorporation under the name Pitman Training Group Limited (PTG). On 4 January 1991 the applicant acquired the whole of the issued share capital of PTG. He explains that PTG is the parent company of Pitman Training Limited which is itself the parent company of both Pitman Education and
25 Training Limited and Pitman Language Training Limited.

Mr Chapman states that the applicant uses the mark in connection with various training courses including keyboarding, typewriting, shorthand, computing, desk top publishing etc. At KEC1 he exhibits samples of some of the applicants' current promotion brochures. One is
30 dated 1991/2 and is for business studies, secretarial training, travel and tourism. Another, undated, is headed "A new business, technology & computer training service".

Mr Chapman explains that in 1870 Sir Isaac Pitman established the Metropolitan School of Shorthand (Pitman's) and that this is now known as Pitman's Central College. At KEC2 he
35 exhibits a copy of the college's promotional brochure which he says is for the year 1882. The brochure appears to be undated but states that the school was established in 1870. Mr Chapman states that at various dates from 1870 to 1893 the college's curriculum covered a range of subjects. His list includes civil service preparation and business writing, office routine etc. At KEC3 he exhibits a prospectus said to be published in 1893 which Mr Chapman says
40 shows that the college was offering all the above subjects at that date. Reference is made to page 4 of the exhibits however, the exhibit appears to consist of the front page of this prospectus, which is entitled "Metropolitan School of Shorthand". It is also undated. Mr Chapman continues by stating that by the early 1900's the college had established a department named the Book-keeping and Business Hall and that this was equipped with the facilities
45 usually found in offices at the time.

Mr Chapman says that in February 1897 Sir Isaac Pitman & Sons Limited commissioned a special building for the exclusive use of the college. The college moved to the new building in June 1898 and still occupies that building today. At KEC4 he exhibits a prospectus from 1898, however, only a copy of the undated front page is attached.

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Mr Chapman states that the mark has been used by the college in connection with the Services throughout the United Kingdom. The college has also operated branch colleges in a number of locations throughout the period from 1915, including branch colleges in the Greater London area, north of England, Midlands and overseas in Kuwait and Africa. At KEC5 - 10 he exhibits various promotional brochures from 1915 to 1966. These include at KEC6 a brochure entitled "Pitman's School" showing branches in various locations in Greater London and in Leeds and at KEC 9 a programme for the colleges prize giving at the Royal Albert Hall in 1957. In Mr Chapman's view, these exhibits show the geographical spread of the colleges.

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Mr Chapman says that the mark has been incorporated into various device marks over the years including in 1967 a lozenge-shaped device. This was the subject of applications numbers 1283826 and 1283827. At KEC 11 he exhibits a copy of a promotion brochure said to be from 1969 showing the use of the lozenge-shaped device. At KEC 12 he exhibits a prospectus from 1971/2 entitled "Pitmans Central College" said to show use of the mark and the lozenge, however, no lozenge is shown on the exhibit. At KEC 13 he exhibits another prospectus said to be dated 1986 which is entitled "Pitman Central College" and shows the mark PITMAN in a lozenge.

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Mr Chapman refers to exhibits KEC 14 - 16 these are said to show the 150th anniversary of the invention of Pitman shorthand, the expansion of the curriculum of the college to include word processing and in the 1980's specific computer training. Exhibit KEC 16 is said to show use of the mark and lozenge in connection with computer training. However, exhibits KEC 15 - 17 are not present.

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Finally Mr Chapman refers to various advertisements placed in various journals and newspapers. He states that the college has advertised all its services by reference to the mark and since 1967, the lozenge, throughout the United Kingdom and overseas. At KEC 17 (not present) he states that he exhibits a bundle of sample advertisements from the period 1960 to 1970. The advertisements appear to be attached as exhibit KEC 14 and relate to a range of advertisements in both national and regional publications.

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That concludes my review of the evidence.

DECISION

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This is a dispute between two parties who were originally part of the same legal entity (PITMANS plc) which split into three constituent parts. All have sought (and obtained) registration of trade marks in respect of the services they provide, as a result I understand, of negotiations between them such that lines of demarcation have been agreed. This application for registration (and opposition) is still however a matter of dispute between the applicants and opponents and thus, despite allowing time after the hearing for a negotiated settlement to be explored, I need to determine the matter.

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The opposition falls to be considered under Section 11 and 12 of the Act which state:

5 “11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

10 12. (1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- 15 a. the same goods
b. the same description of goods, or
c. services or a description of services which are associated with those goods or goods or that description”

20 The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

25 The established tests for objections under these provisions are set down in Smith Hayden and Company Ltd’s application (Volume 1946 63 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

30 **(Under Section 11)** Having regard to the user of the opponents’ marks (SIR ISAAC PITMAN AND PITMANS EXAMINATION INSTITUTE), is the tribunal satisfied that the mark applied for, if used in a normal and fair manner in connection with any services covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

35 **(Under Section 12)** Assuming user by the opponents of their mark in a normal and fair manner for any of the services covered by the registration of those marks, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their mark normally and fairly in respect of any services covered by their proposed registration?”

40 The standard test in relation to comparison of marks is that propounded by Parker J in Pianotist Co’s application (1906) 23 RPC 774. The relevant passage reads:-

45 “You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, You must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all

those circumstances, you come to the conclusion that there will be confusion - that is to say- not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case”.

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There was little dispute between the parties that the respective trade marks were similar. In each of the opponents trade marks the dominant element is the word PITMAN, which is the applicant’s trade mark. Thus I have no hesitation in holding that the trade marks are similar. The real issue for determination in this case is therefore whether the services offered by the applicants are services of the same description as those of the opponent.

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Mr Belcher submitted that prior to the date of application for registration neither party had provided any service which could fall within the specification of services of this application. The opponents were involved in the provision of services in relation to examination and assessment. In his view the opponents evidence does not show any use of their trade marks on any computer related activity other than perhaps testing or assessing the level of skill individuals have developed accessing a computer system and in-putting or amending data as an extension, for example of, testing/assessing shorthand skills. Ms Leno on the other hand submitted that references in the opponents’ evidence to the provision of examination and assessment services in respect of “typewriting, new office technology, key boarding, data processing, word processing, understanding computers” (Mr Stakin’s evidence) meant that the opponent’s services were similar to those proposed to be provided by the applicants. This was based in part on the fact that a computer programmer needed keyboard skills to programme and the opponents provided examinations to support that as well as on the theoretical aspects of computers and word processing.

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It was agreed that the test for determining whether the services were similar was that set out by Jacob J in TREAT [1996] RPC 296.

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I think the sort of considerations the court must have in mind are similar to those arising under the old Act in relation to *goods of the same description*. I do not say this because I believe there is any intention to take over that conception directly. There plainly is not. But the purpose of the conception in the old Act was to prevent marks from conflicting not only for their respective actual goods but for a penumbra also. And the purpose of *similar goods* in the Directive and Act is to provide protection and separation for a similar sort of penumbra. Thus I think the following factors must be relevant in considering whether there is or is not similarity:

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(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

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(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

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(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

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This is rather an elaboration on the old judicial test for goods of the same description (Jellinek’s Application (1946) 63 RPC 59 at page 70 approved by the House of Lords in *DAQUIRIRUM* Trade Mark [1969] RPC 600 at page 620).

15 First of all I do not consider that there is any similarity between the uses of the respective services. Computer programming services in Class 42 provides bespoke software to the customer which is then applied by the operating system of the computer to achieve the desired result. The examination and assessment services of the opponent are concerned with setting
20 examinations or undertaking assessments in order that groups or individuals can be judged against standards or criteria. The users of the respective services may be the same but that would have nothing to do with their physical nature which are different. Setting tests; marking tests and awarding qualifications are some way apart from the writing of computer code to order. The trade channels are different; they are not in competition.

25 I do not consider that Ms Leno’s submissions in relation to the similarity of the services stand up to scrutiny. The fact that the opponents provide examination and assessment services in respect of skills which may be used to operate a computer (e.g. data inputting) does not enable the operator to develop computer software. That is a different skill altogether.

30 In my view the services to be provided by the applicants are neither the same as or of the same description as those offered by the opponents. That being the case the objection under Section 12(1) fails.

35 Notwithstanding my findings under Section 12(1) I go on to consider whether in view of the opponents use of their trade marks on the services covered by the registrations a different finding is possible under Section 11. In that respect, the applicants acknowledged that the opponents have a reputation in respect of their trade marks in relation to the services they provide. That is the trade marks PITMAN EXAMINATION INSTITUTE and SIR ISAAC
40 PITMAN in respect of examination and assessment services. I go on therefore to consider whether this use and reputation is likely to spill over into other areas such that use by the opponents of the word PITMAN solus on the services covered by the application is likely to cause deception and confusion.

45 In considering the matter I take account of the fact that the parties are operating in the market place each using the word PITMAN in respect of services provided to commerce and industry. That much was submitted to me at the Hearing. The parties must therefore be satisfied that at least in respect of the services currently provided the market place can distinguish the origin of

one set of services from another. But would this use of PITMAN on the computer services covered by the application upset that balance? I believe that it could if the applicant were to provide computer programming services which related to assessment services or the provision of examinations leading to vocational qualifications or accreditation services. These are the areas in which the opponents have an established reputation and unless the applicants are excluded from extending their services into these specific areas of activity the likelihood of deception and confusion amongst a substantial number of persons (the institutions requiring the examination and assessment services and the individuals undertaking them) is very real. This would not be the case if, the applicant positively excludes the provision of computer programming services - relating to examination accreditation services or assessment services whether leading to vocational qualifications or otherwise. As the application stands therefore, I consider that the Section 11 ground is made out but this can be overcome by amendment to the specification in line with the above terms. In view of my findings, the provisions of Sections 11 and 12(1) being mandatory, the exercise of the Registrar's discretion is not appropriate.

If the applicants for registration file a Form TM21 to amend the specification of services on the basis set out above within one month of the end of the expiry of the appeal period the application may proceed to registration accordingly. If no such request is made the application will stand refused.

If the application proceeds to registration, taking into account the partial success of the opposition the opponents must pay to the applicants the sum of £700. If the application must stand refused the applicants must pay to the opponents the sum of £650.

The appropriate sum to be paid within two months of the end of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 1 day of March 2000

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M KNIGHT
For the Registrar
The Comptroller General