

O-271-15

TRADE MARKS ACT 1994

IN THE MATTER OF

**TRADE MARK REGISTRATION NOS. 2566826, 2588950, 2546829, 2542440 &
2542333 FOR THE TRADE MARKS**

OCN London



OCNLR

LOCN

locn

Locn

(a series of three)



AND

**THE APPLICATIONS FOR DECLARATIONS OF INVALIDITY THERETO
UNDER NOS. 500423, 500425, 500428, 500429 AND 500453
BY NOCN LIMITED**

Background and pleadings

1. Open College Network London Region Limited (“the proprietor”) owns the five trade mark registrations shown below:

(i) 2566826	OCN London	Class 41: <i>Education; providing of training.</i>	Filing date: 13 December 2010 Registration date: 1 April 2011
(ii) 2588950		<p>Class 16: <i>Printed matter; printed publications; books; magazines; journals and newspapers; instructional and teaching materials; stationery.</i></p> <p>Class 35: <i>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.</i></p> <p>Class 41: <i>Education; providing of training; entertainment; sporting and cultural activities.</i></p>	<p>Filing date: 25 July 2011</p> <p>Registration date: 16 December 2011</p>
(iii) 2546829	OCNLR	Class 41: <i>Education, Training.</i>	Filing date: 6 May 2010

			Registration date: 6 August 2010
(iv) 2542440	LOCN locn Locn (a series of three)	Class 41: <i>Education; providing of training.</i>	Filing date: 19 March 2010 Registration date: 16 July 2010
(v) 2542333		Class 41: <i>Education; providing of training</i>	Filing date: 19 March 2010 Registration date: 23 July 2010

2. NOCN Limited (“the applicant”) contends that these five trade mark registrations should never have been accepted for registration and has applied to have the registrations declared invalid under section 47(2) of the Trade Marks Act 1994 (“the Act”); specifically, under section 5(2)(b) of the Act on the basis of ten earlier registered marks owned by the applicant, shown below. The applicant claims that there is a likelihood of confusion between the proprietor’s marks and its earlier marks:

2317870	OCN	Class 16: <i>Books relating to education and training.</i> Class 41: <i>Education and training services; provision of advice and information relating to the aforesaid services; publication of books relating to education and training.</i> Class 42: <i>Accreditation of education and training; certification of education and training.</i>	Filed on 6 December 2002	Relied upon against all the proprietor’s marks
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2578768		<p>Same for all nine marks:</p> <p>Class 16: <i>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; printed publications; paint boxes for children.</i></p> <p>Class 35: <i>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.</i></p> <p>Class 41: <i>Education; providing of training; entertainment; sporting and cultural activities.</i></p>	All filed on 15 April 2011	All relied upon against the proprietor's mark (ii)
2578769				
2578775				
2578776				
2578778				
2578791				
2578792				
2578794				
2578795				

3. The proprietor denies the applicant's claim of a likelihood of confusion, essentially on the basis that the applicant consented to the use and registration of the marks, and/or was aware of the use and registrations and did not object. The proprietor also denies that its marks are similar to the earlier OCN word mark. Finally, the proprietor claims that there is no adverse effect on the essential function of the marks and/or that there has been honest concurrent use.

4. The proprietor does not put the applicant to proof of use of its mark 2317870 OCN¹. This is the only of the applicant's marks which had been registered for five years or more when the invalidation applications were filed (20 June 2014).

5. The five invalidation actions were consolidated following the filing of the defences and counterstatements.

6. Both sides filed evidence and the matter came to be heard by me via video conference on 6 May 2015. Ms Jessie Bowhill, of counsel, instructed by Virtuoso Legal, represented the applicant. Ms Fiona Clark, of counsel, instructed by Waterfront Solicitors LLP, represented the proprietor.

Evidence

7. The applicant's evidence comes from Graham Hasting-Evans, who is the applicant's Managing Director. He has filed three witness statements and supporting exhibits. The proprietor's evidence comes from Jacquie Mutter, its Chief Executive. Ms Mutter has filed two witness statements and supporting exhibits. Ms Mutter's second statement and Mr Hasting-Evans' third statement were admitted at the hearing as further evidence, under rule 42(5) of the Trade Marks Rules 2008. I will give my reasons for allowing the further evidence towards the end of the evidence summary.

Graham Hasting-Evans' first witness statement

8. Mr Hasting-Evans does not say how long he has been in the post of the applicant's Managing Director, although he states that the facts in his statement are true to the best of his knowledge and belief. He gives some background about the applicant:

- It was formed in 1987 as the National Open College Network (NOCN for short) in association with some "open and access" colleges; at this time it was an informal organisation. It later became a registered charity on 18 August 1999 and changed its name to NOCN in 2013.
- It is a learning credit-based awarding organisation which creates qualifications for other educations and training organisations, and accredits education and training courses to lead to recognised qualifications.

¹ The present proprietor filed an application for revocation against this mark, which is the subject of a decision by the Registrar, BL O/114/14, dated 11 March 2014. The outcome of the revocation decision was that the present applicant retained the list of goods and services shown in paragraph 2 of my decision.

- It is a membership network of regional “open colleges networks”. This included the proprietor which, at formation in 7 November 1989, was called “London Open College Federation (LOCF)”. The idea of a network was to recognise, formally, non-traditional learning achievements.
- From 1997, the majority of the regional network members called themselves Open College Networks. In March 2000, the applicant became the recognised awarding body for Open College Networks; the regulator (which was Ofqual’s predecessor) would not allow the individual organisations to become awarding bodies in their own right. This later changed; e.g. the proprietor became an awarding body in 2011.
- In 2002, all the Open Colleges agreed to the applicant registering OCN as a trade mark. Mr Hasting-Evans states “There was no debate at the time that any OCN was entitled to use the mark OCN other than in accordance with NOCN’s permission”.
- Following restructuring in 2005, a “new family of brands owned and controlled exclusively by the Applicant” were formed: NOCN (for national contracts) and eleven regional OCN brands, e.g. OCN Eastern Region, OCN North West Region and OCN London Region.
- The new OCN companies were set up and named by the applicant and the ‘swoosh’ logos were created. The OCN’s were formally licensed by the Applicant to deliver the applicant’s qualifications and to use NOCN and OCN branding and logos. A copy of the licence “Standards and Criteria for the Licensing of the Open College Networks in the English Regions, in Wales and Northern Ireland” is shown at pages 47-56 of exhibit GHE1. The proprietor entered into the licence in December 2005.
- In 2006, further brand identity guidelines were issued by the applicant. The version sent to the proprietor for its brand corresponds to the proprietor’s mark (v) (pages 57-94 of GHE1).
- The 2005 licence agreement with the proprietor remained in force until 2011 when the parties entered into a two-year collaboration agreement. Pages 95 to 129 of GHE1 show a copy of the agreement. Clause 13.1 of the agreement says “All Intellectual Property Rights in the Materials, Agreed Qualifications, other NOCN qualifications under development by or on behalf of NOCN during the Term, including any being developed jointly between NOCN and Third Parties, and NOCN’s Brand shall be and remain the exclusive property of NOCN.”
- On 23 January 2013, the proprietor confirmed in writing that it (along with the other colleges which had not already done so) wished to terminate the collaboration agreement with effect from 31 December 2013. Some of the organisations removed the letters OCN from their names.

9. In relation to the proprietor's defence that the applicant had consented to the use and registration of the marks, Mr Hasting-Evans says this is incorrect:

"51 In early 2011 the Applicant, decided that it would be prudent to register all the "swoosh" marks that were created in 2005. This was an exercise that the Applicant undertook itself rather than appoint a representative.

52 After the Applicant submitted the application for the  logo (application number 2578774) the Proprietor advised that it had already applied for registration of this mark. The applicant's application was therefore withdrawn. A letter was sent to the Applicant [sic, should read Proprietor] advising that the application was to be withdrawn (page 171)."

10. The letter is shown below:



Professor Daniel Khan, OBE
Chief Executive
Open College Network London Region
15 Angel Gate
City Road
London
EC1V 2SF

27th June 2011

Dear Daniel,

TRADE MARKS

Thank you for your letter dated 22 June concerning the above.

An exercise was undertaken a while ago to ensure that all trade mark registrations were up to date, as several were not. You are right to say that London Region's trade mark is up to date and the application is un-necessary. I confirm I have written today to withdraw the application.

Yours faithfully

A handwritten signature in black ink, appearing to read 'Graham Hasting-Evans', written in a cursive style.

Graham Hasting-Evans
Interim Managing Director

11. Mr Hasting-Evans goes on to say:

“53 That letter does not give “consent” to the Proprietor’s registration it merely explains that, as the Applicant was undertaking an exercise to make

sure all registrations of the logos were up to date and that, since the  had been applied for, then London Region’s trade mark was up to date and the Applicant’s application was unnecessary. In any event the letter is relevant to the  mark but none of the others.

54 The Applicant was unaware that the Proprietor had registered 2542440

 “LOCN”, 2542333 , 2546829 “OCNLR” and 2566826 “OCN London” between March and December 2010, without the permission of the the Applicant’s Board of Trustees. This only came to light in around May 2012 when the Applicant appointed Virtuoso Legal to manage its trade mark portfolio and progress the outstanding trade mark applications which were going through the system and for which various queries with regard to specifications and classifications had been raised by the IPO.

55 Around the same time in early 2012 that the Applicant was in discussions with the Proprietor regarding whether they wished to continue their association with the Applicant or whether they wished to leave the network. Those discussions included the issue of the Proprietor entering into a formal trade mark licence in respect of all the ICN brands with the Applicant.

56 For as long as the Proprietor was going to remain in the Applicant’s

 network then the fact that the  trade mark was in the Proprietor’s name did not unduly concern the Applicant – what was important was that it was registered – the details of who was recorded as the owner and licensing arrangements could be sorted out later.

57 It subsequently became clear, in early 2013 that the relationship between the Proprietor and the Applicant had broken down. The Proprietor did not want to remain with the Network but wanted to continue using the OCN brands. Negotiations were entered into regarding transitional arrangements. That agreement is at pages 172 to 174. The Proprietor was aware from at least March 2013 that the Applicant required the Proprietor to assign to the Applicant all the Marks the subject of these proceedings but the Proprietor refused to do so and even made an unsuccessful attempt to invalidate the Applicant’s 2317870 “OCN” mark.

58 At no time did the Applicant consent to or acquiesce to the registration of the Proprietor’s Marks. As I have explained above 4 of the Marks were

registered without the approval of the Applicant's Board of Trustees and the Applicant was unaware, until May 2012 that these 4 Marks had been registered by the Applicant.

59 It would also be wrong to say that the Applicant acquiesced to the use, by the Proprietor, of "OCN" and any mark containing OCN or the swoosh logo. The fact is that The Applicant licensed the Proprietor to provide the services on its behalf by reference to the OCN brands.

...

61 It did not grant any other rights to the Proprietor in relation to the use of its brands or trade marks and it did not grant any rights to use, or to apply for registration of, any other similar trade mark."

12. Mr Hasting-Evans says that for these reasons there is also no defence of honest concurrent use. The proprietor was a licensee of the applicant.

Jacque Mutter's first witness statement

13. In a lengthy witness statement, Ms Mutter also gives background to the Proprietor, but her evidence also calls some of Mr Hasting-Evans' facts into question. She disagrees with his statement, reproduced above in paragraph 8, that "[T]here was no debate at the time that any OCN was entitled to use the mark OCN other than in accordance with NOCN's permission". She states that she does not recall the matter being debated or agreed. Ms Mutter states that Mr Hasting-Evans joined the applicant in 2011 and has not been involved with the applicant from the beginning, whereas she has been involved with the proprietor for over nineteen years and has firsthand knowledge of events which occurred throughout this period. However, as I go on to note, some of her evidence is hearsay, rather than firsthand.

14. Ms Mutter states that the term 'Open College' has been used in the UK since the 1980s. The term 'Open College Network' and OCN for short was used informally by the open Colleges, including the proprietor, and many went on to adopt the term formally in their titles. Open Colleges were first established in London in 1982. At an Open College seminar in November 1986, various open colleges agreed to establish a National Open College Network to act as an informal forum and network. Open Colleges in London joined together in November 1989, using the names "London Open College Federation" and "LOCF" (shown in exhibit JM-1, from 1991).

15. Mr Hasting-Evans is incorrect in stating that the London Open College Federation became part of the applicant's network – because the applicant was not a legal entity in its own right (in November 1989) and it did not have a network "as such". When originally formed, the National Open College Network was not an organisation. It was an informal group created by and for the already existing Open College Networks, including the proprietor. It had no budget and no offices.

16. This loose arrangement for standardising practice, award levels and credits, persisted until, in June 1992, the Open College Networks drew up a constitution for

the National Open College Network, shown at exhibit JM-2. The previous year, Leicestershire OCN had been the first Open College Network to incorporate the letters OCN into its name. Others, voluntarily, followed suit. The constitution provided for the maintenance of the independence of the individual member Open Colleges.

17. In November 1993, the proprietor was incorporated, but continued to use the names London Open College Federation and LOCF until March 1998, when it changed its names to London Open College Network and LOCN, which was publicised in its newsletters (exhibit JM-6). Use of these names continued until 2005 (as shown in newsletters and website screenprints in exhibits JM-7 and JM-8). Exhibit JM-9 shows a copy of a letter from the proprietor to the applicant, about funding for the latter, dated 1 September 2003, which is headed with its names London Open College Network and LOCN.

18. A further constitution was agreed by the Open College Networks in 1997. The National Open College Network did not employ anyone until late 1999. Prior to that year, the chairmanship was passed between various heads of individual Open College Networks. The Chair in 1998 wrote to the chairs of all the Open College Networks inviting expressions of interest about obtaining licences from the applicant to the existing Open College Networks to offer awards within the applicant's accreditation framework and to use the applicant's related materials. NOCN qualifications were different to those already offered by the proprietor (accreditation services for regional courses and Access to Higher Education Diploma courses). The licence was nothing to do with permission for each organisation to continue to use its name nor, Ms Mutter states, the marks the subject of these proceedings.

19. The applicant was incorporated on 18 August 1999 under the name The National Open College Network. Until this point, the applicant was only a vehicle for cooperation between the various UK Open College Networks. It was only a learning credit-based awarding organisation after 1999. At no point has the applicant accredited the courses offered by Open College Networks outside of the NOCN qualifications (i.e. the regional courses and Access to Higher Education Diploma courses, which were not part of the licence).

20. In relation to Mr Hasting-Evans' statement that the regulator would not allow the regional Open College Networks to become awarding bodies in their own right, this was because a national reach was required (from the year 2000 onwards); this was the reason that the regional Open College Networks funded the applicant as their national awarding body operation. As they developed qualifications, they would use the applicant as a means to submit the national qualifications for approval from the regulator. In relation to its other courses, the proprietor has a separate arrangement for the Access to Higher Education qualifications via a regulatory authority which has no connection to the applicant. These courses make up the bulk of the proprietor's income. Therefore, use of OCN was not solely linked to the applicant's accredited courses, but was also used in relation to the proprietor's courses which were independent of the applicant.

21. Ms Mutter states that the applicant's OCN 2003 trade mark application was made unbeknownst to her or the proprietor, contrary to Mr Hasting-Evans' statement that the application was made with the agreement of all the Open College Networks. She denies that there was any such agreement and claims that if there had been it would be recorded in the national meeting minutes.

22. NOCN was restructured in 2005, following a vote by the Open College Networks the previous year. There were henceforth nine regional Open College Networks. The proprietor was already operating as a regional body for London. Suggestions by the applicant that e.g. all the Open Colleges merge to form a single organisation, run by the applicant were rejected by the Open College Networks because they were both contrary to their autonomous nature and to the role of the applicant. The applicant had no control over the decision-making of individual Open College Networks.

23. Licensing arrangements were made in 2005 for delivering NOCN qualifications, the fees giving the applicant its income. The licence is exhibited by Mr Hasting-Evans at pages 47 to 56 of exhibit GHE01.

24. The re-structuring was followed by re-branding for all the Open College Networks, to use the 'swoosh' logos (as per the parties' composite marks in these proceedings). Ms Mutter states that, contrary to Mr Hasting-Evans' claims, the rebranding was not originally commissioned by the applicant, but by OCN South East Region. Ms Mutter disagrees with Mr Hasting-Evans' claim that the logos were "created and the OCN's were formally licensed by the Applicant's licensing committee to deliver the Applicant's qualifications and to use the NOCN and OCN branding and logos." Instead, the new logo was admired by the other Open College Networks, and it was agreed by each of their respective boards that they would all adopt similar logos. She states that the applicant only had a remit to manage the new brand in the sense of dealing with the administration of the new brand, not ownership of it. JM-16 shows a copy of a letter with the proprietor's new name and logo, sent to the applicant's CEO by the proprietor's CEO, on 11 July 2005. These were used, in addition to OCNLR, from 2005. The change was widely publicised (exhibit JM-19).

25. The applicant did not have a governing role. The CEOs of each regional Open College Network made the national decisions on a monthly basis. The applicant was not in a position to, and did not, license the proprietor to use the marks. Nor did the applicant's Brand Identity Guidelines of August 2006 (shown at pages 57 to 94 of Mr Hasting-Evans' evidence) refer to ownership of the marks. It was about consistency of branding across the Open College Networks as regards colours, fonts, literature and stationery. The branding guidelines were issued by the applicant in its capacity as a linking and supporting body for the Open College Networks. The guidelines were advisory, not compulsory, as can be seen from the first page of the guidelines (page 60 of the evidence). Ms Mutter refutes Mr Hasting-Evans' statement that the guidelines are "prima facie evidence that the Applicant had exclusive control over the goodwill its associated value and brands that they had created and licensed to the network."

26. On 17 May 2005, the proprietor was renamed “Open College Network London Region”. Ms Mutter stresses that it was still the same company, that it was not “named by the Applicant”, which is Mr Hasting-Evans’ claim, and that the applicant played no part in, nor had any control or influence over the naming decision. The proprietor continued to use the name Open College Network London Region, OCNLR and the logo until July 2013. Documents showing the use are exhibited at JM-20.

27. In 2010, the proprietor conducted a review of the trade marks it had been using over the years and began to register its trade marks. Mr Hasting-Evans joined the applicant in 2011 and it was then that the applicant also commenced registration of trade marks being used by the respective Open College Networks. There was no prior agreement between the Open College Networks and the applicant about the applicant registering the marks. The regional swoosh mark applications by the applicant included a version which was identical to the OCN London Region mark used by the proprietor. The proprietor was notified of the application, which was a “complete surprise” to the proprietor.

28. On 22 June 2011, the proprietor wrote to the applicant and asked it to withdraw the application, on the basis of its own identical registration. A copy of the letter is provided at exhibit JM-28. The letter was sent to Mr Hasting-Evans from Professor Daniel Khan, the proprietor’s CEO. Mr Hasting-Evans replied on 27 June 2011, in a letter which I have reproduced in paragraph 10. I have also quoted from Mr Hasting-Evans’ statement where he states that the details of who was recorded as the owner and the licensing arrangements could be sorted out later; Ms Mutter says that this demonstrates Mr Hasting-Evans’ lack of understanding as to the relationship between the parties, perhaps because he joined the applicant many years into that relationship. There is not, and never has been, any licensing arrangement between them in relation to the OCN London Region’s swoosh mark or any of the marks the subject of these proceedings. Ms Mutter denies that the proprietor was required to seek and obtain the permission of the applicant’s board of trustees to register its marks and points out that there is no evidence of this.

29. The parties entered into a collaboration agreement on 19 December 2011, which commenced on 2 January 2012. A copy of this is shown in Mr Hasting-Evans’ evidence (pages 95 to 129). The agreement was in relation to the delivery and award of NOCN qualifications, not the proprietor’s own qualifications and not qualifications regulated elsewhere. I have set out in my summary of Mr Hasting-Evan’s evidence the clause relating to intellectual property. Ms Mutter’s interpretation of the clause (13.1) is that NOCN’s brand, which is undefined, is the name NOCN and National Open College Network, rather than Open College Network or OCN, or any of the proprietor’s marks, contrary to Mr Hasting-Evans’ interpretation. Ms Mutter states that this was not a trade mark licence.

30. The proprietor terminated the collaboration agreement with effect from 31 December 2013 because, amongst other reasons, the applicant was attempting to centralise the activities of the Open College Networks, which the proprietor found unacceptable.

Mr Hasting-Evans' reply to Ms Mutter's evidence

31. Mr Hasting-Evans' does not respond to Ms Mutter's statement that he has only worked for the applicant since 2011 and therefore does not have firsthand knowledge of events prior to that year. He does not state how long he has worked for the applicant. In fact, he states that the applicant's case comes from documentary records and not from the memory of Ms Mutter who has, at times, held junior posts and would not necessarily have the knowledge relating to the applicant's governance and brand rights.

32. Mr Hasting-Evans' states that, contrary to Ms Mutter's statement, the applicant's accreditation framework also covered the Access to Higher Education Diplomas and local units. He also challenges Ms Mutter's statement that the Open College Networks had no knowledge of the applicant applying for the mark OCN in 2002; Mr Hasting-Evans exhibits (GE2, page 107) the minutes from the meeting of the applicant's board of trustees, where it shows at paragraph BT.03.15 that the Board agreed that the applicant would register OCN and NOCN in their shorter forms in classes 9 and 41. One of the Board members was also a Director of the proprietor. In relation to the branding guidance, he states that the proprietor "had to" implement the guidance.

33. Mr Hasting-Evans states:

"53. With regard to paragraph 85 of Ms Mutter's statement – the Proprietor's Chief Executive Officer, then Professor Daniel Khan, had informed me that he had registered the trade mark in order to protect the network and the Applicant. At that stage I was dealing with major issues of non-compliance with the Regulator Ofqual and had not had the opportunity to research fully the legal position in respect of trade marks."

34. With respect to the collaboration agreement, Mr Hasting-Evans states that "NOCN's brand" includes OCN, registered to the applicant in 2002. The agreement does not give the proprietor the right to use the applicant's brands, but merely recognises that the proprietor may deliver services outside its arrangement with the applicant.

35. The proprietor sought permission to file further evidence to reply to Mr Hasting-Evans' evidence in reply, chiefly to respond to the point about Professor Khan registering the trade mark OCN London Region and swoosh device, and the implications of the correspondence between Mr Hasting-Evans and Professor Khan, in relation to consent.

36. The proprietor submitted that to obtain the further evidence, it had had to review historic files from as far back as the 1980s, check archived email accounts and contact third parties, such as Professor Khan, who no longer works for the proprietor. Ms Mutter was unaware of the emails exhibited to her further evidence when she made her first statement. The proprietor submits that these emails were known to Mr Hasting-Evans, as he is one of the correspondents.

37. Ms Mutter denies, on behalf of the proprietor, Ms Hasting-Evans' statement that "Professor Daniel Khan, had informed me that he had registered the trade mark in order to protect the network and the Applicant". She says this:

"5. In response to the allegation made by Mr Hasting-Evans at paragraph 53 of his second statement, on 16 April 2015, I spoke again with Professor Daniel Khan and he denies that any discussions took place between September and October 2011, or at all, whereby he gave any sort of assurances to Mr Hasting-Evans (or anyone at the Applicant) that the Proprietor was registering any of the Marks, the subject of these proceedings, "in order to protect the network and the Applicant". In addition, during this period, I was the Proprietor's Deputy Chief Executive and would expect to have known of such assurances, but I was not aware of the same."

38. Ms Mutter states that, having seen Mr Hasting-Evans' evidence in reply, and after her discussions with Professor Khan, the proprietor reviewed its files further and found emails between Mr Hasting-Evans and Professor Khan from September/October 2011. Ms Mutter states that she was unaware of the emails, although she may have discussed the position with Professor Khan at the time. Her summary of the emails, which are exhibited at JM-32, is as follows:

"On 6 September 2011, Professor Khan emailed Mr Hasting-Evans stating "As you are aware we have already registered the [Proprietor [sic] OCN London Region Swoosh Mark]. We have also applied as an additional precautionary measure to register [the Proprietor [sic] OCN London Mark] and was very surprised to see you lodged an objection to this. I therefore would be grateful if you withdraw your objection to this. I enclose at **JM-32** a copy of this email chain. In fact, the Applicant hadn't objected to the Proprietor OCN Mark, this was a mistake on Professor Khan's behalf. However, Mr Hasting-Evans' response on 12 September 2011 makes it clear that the Applicant did not dispute the Proprietor's registration of the Proprietor [sic] OCN Mark, with Mr Hasting-Evans stating "I haven't disputed OCN London". There is no reference in this email chain to the Proprietor having registered any of the Marks, the subject of these proceedings, to "protect the network and the Applicant, as alleged by Mr Hasting-Evans."

39. In a further email, exhibited at JM-33, dated 10 October 2011, Mr Hasting-Evans writes to Professor Khan "About a month ago we were discussing issues around trade marks. At that time I confirmed that NOCN had no issues with OCN London or variants on this being registered. However it appeared that your OCN has also registered an application for OCN National and OCN Global which clear [sic] conflict with NOCN's trade marks. I understood that these were being withdrawn and I would be grateful if you could confirm this to me this week."

40. Ms Mutter states that Professor Khan told her that he had had no verbal discussions with Mr Hasting-Evans; contact was by email.

41. The remainder of Ms Mutter's second witness statement refutes Mr Hasting-Evans' evidence about the proprietor's independent offering of Access to Higher

Education Diploma courses, and the use of the terms Open College Network and OCN. It is unnecessary, for the purposes of this decision, to detail that evidence.

42. I allowed the proprietor's request to adduce this evidence because one of the defences is that consent was given by the applicant and I considered that a fuller picture of the background was desirable, given the contradictory nature of the evidence presented by the witnesses. I allowed the applicant to reply to Ms Mutter's evidence, in the form of a third witness statement by Mr Hasting-Evans. In relation to consent, he states:

"6. I have a clear recollection of Professor Khan telling me that he had registered the mark in order to protect the network and the Applicant. Given that Professor Khan was a member of the Applicant's Board at the time, and the Proprietor was a member of the Applicant, I had no reason to doubt what he told me. Professor Khan's version of events as reported in Ms Mutter's evidence is simply wrong and I am surprised given the seriousness of the allegations that Ms Mutter now makes that Professor Khan has not given a witness statement himself dealing with this point.

7. In relation to the email chain at JM-32 and in particular my response on 12 September 2011 where I state "*I haven't disputed OCN London*", this was not as Ms Mutter claims in paragraph 7, a clear statement that "the Applicant did not dispute the Proprietor's registration of the Proprietor [sic] OCN London Mark". This was simply a response to Professor Khan's previous email where he claimed that he "was very surprised to see [that I] had lodged an objection to [the Mark]". As Ms Mutter acknowledges, the Applicant had not "lodged an objection" to the Proprietor's OCN London Mark and this was a mistake on Professor Khan's behalf. My response corrected this mistake, and did no more than that. It was not intended to, and did not, give any sort of consent or approval to the Proprietor.

8. In paragraph 8 Ms Mutter points out that at paragraph 54 of my first statement I said that the Applicant was not aware that the Proprietor had registered the Marks until around May 2012, and that in the light of the emails she has exhibited this must be incorrect. To clarify, I was aware that some Marks had been registered in September 2011, but was not fully aware of all the Marks registered by the Proprietor until May 2012, which was after the Proprietor registered 2609872^[2] in February 2012.

9. Ms Mutter has exhibited an email dated 10 October 2011 at JM-33 which she deals with in paragraph 9, 11 and 12. She claims that the position the Applicant adopted was "clear and unequivocal" (paragraph 11) and that the Applicant agreed to the Marks the subject of these proceedings being registered by the Proprietor (paragraph 12). This is not the case at all. In my email of 10 October 2011 I said "*About a month ago we were discussing issues around trade marks. At that time I confirmed that NOCN had no issues with OCN London or variants on this being registered*". I said this because at

² This registration is now cancelled.

that time (i.e. October 2011) the Proprietor was a member of the Applicant's Network and was still operating under a licence from the Applicant. It therefore did not concern me that it was seeking to register trade marks as I understood it was doing so on the Applicant's behalf. However, had I appreciated that the Proprietor was seeking to register such marks so that they could be used independently from the Applicant when the Proprietor left the network, this would have caused me and the Applicant very real concern indeed."

Decision

43. These proceedings are brought only under section 5(2)(b) of the Act. The issue to be decided is whether there is a likelihood of confusion and, if there is, whether the proprietor's defences of consent, acquiescence and honest concurrent succeed. I will therefore begin with an assessment as to whether there is a likelihood of confusion.

44. Section 5(2)(b) of the Act states that:

"(2) A trade mark shall not be registered if because –

(a)

(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."

45. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

46. The applicant's mark OCN (2317870) covers *education and training services*. These services are identical to the proprietor's services in its OCN London mark (2566826), *education; providing of training*; to the proprietor's services in its OCNLR mark (2546829), *education, training*; to the proprietor's services in its LOCN series of marks (2542440), *education, providing of training*; and to the proprietor's services in

its  mark (2542333), *education; providing of training*.

47. The applicant's specifications for its various composite marks (the specifications are the same for each mark), which are relied upon only against the proprietor's



mark (2588950), are shown below, together with the proprietor's specifications for that mark:

Applicant	Proprietor
<p>Class 16: <i>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; printed publications; paint boxes for children.</i></p> <p>Class 35: <i>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.</i></p> <p>Class 41: <i>Education; providing of training; entertainment; sporting and cultural activities.</i></p>	<p>Class 16: <i>Printed matter; printed publications; books; magazines; journals and newspapers; instructional and teaching materials; stationery.</i></p> <p>Class 35: <i>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.</i></p> <p>Class 41: <i>Education; providing of training; entertainment; sporting and cultural activities.</i></p>

48. The parties' services are identical. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-33/05, the General Court ("GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

Applying this principle, the parties' class 16 goods are also identical.

Average consumer

49. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. The proprietor submits that there are likely to be two groups of average consumers in relation to the parties' class 16 goods and class 41 services; the colleges and the general public (receiving the educational service and materials). As for the class 35 services, again there will be both trade and end-user consumers. In *Supreme Petfoods Limited v Henry Bell & Co (Grantham) Limited* [2015] EWHC 256 (Ch), Arnold J stated (at paragraph 53) that,

in general, it is the perception of average consumers that matters, not the perceptions of intermediaries as members of the trade are less likely to be confused than consumers, being more likely to be well informed and observant regarding trade marks in their trade sector. In this case, the proprietor submits that the end-user will also display considerable care in selecting the education or training on offer, paying attention to the cost and duration of the course, and the end-qualification. Conversely, the applicant contends that the type of education on offer by both parties is ‘bite-size chunks of adult learning’, for which there will not be a particularly high degree of care taken in selection. For the class 16 goods, the applicant submits that there would not be a particularly high level of attention, which I take to mean that the care taken would be no more than average. The applicant is silent about the class 35 services.

50. I think the real picture lies somewhere between the two. Whilst the parties may offer a particular type of learning, that fact is not reflected in the specifications, which must be considered notionally. Taking a balanced view, for the services in issue (classes 35 and 41) there will be more than an average, but not a high, degree of attention paid. This might also be the case for some of the class 16 goods, e.g. textbooks and academic reference works, but where stationery and other goods of less long-term impact, cost or importance are concerned, the level of attention will be low to average.

Comparison of marks

51. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

52. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

53. The applicant’s earlier mark OCN is pleaded against all of the proprietor’s



marks. However, in relation to the proprietor’s  mark, the applicant’s composite marks present its best case; in particular, the version containing the words EASTERN REGION (2578769), because the swoosh device is in pale blue. (The applicant’s composite marks are not pleaded against the other of the

proprietor's composite marks, 2542333, as they are not earlier marks). The two marks are shown here:



(the proprietor)



(the applicant)

These two marks are highly similar. The only differences are the geographical references, which would be perceived as descriptors of regional providers of the goods and services, and so carry little weight in the overall impression of the respective marks.

54. In relation to the other four of the proprietor's marks, I will compare them separately.

Earlier mark	Proprietor's mark
OCN	OCN London

These two marks are highly similar visually and aurally. The difference between them, as above, is that the proprietor's mark includes a geographical reference, which will be seen as a description of the origin or location of the goods and services provided, so carries little weight in the overall impression of the proprietor's mark. Conceptually, for those in the know, OCN means Open College Network, although outside of the parties, to whom the letters clearly mean a great deal, it is unclear how the general public perceives the letters. They are, therefore, either identical in meaning or neutral, depending on what the average consumer knows. Overall, the two marks are highly similar.

55.

Earlier mark	Proprietor's mark
OCN	OCNLR

Here, the first three letters of the proprietor's mark match the earlier mark, which makes for a medium level of visual and aural similarity. Some average consumers may know what OCN means in the context of the goods and services provided. However, that meaning is likely to be obscured by the extra letters LR in the later mark, which do not have any obvious meaning. The marks are, therefore, neither conceptually similar nor dissimilar.

56.

Earlier mark	Proprietor's mark
OCN	LOCN Locn Locn

57. Here, the proprietor's mark contains the earlier mark. The first letter is, though, different. It is a rule of thumb (but no more than that) that differences at the beginnings of marks can be important in differentiation between marks. Additionally, these are short marks, so a different beginning will have more impact in creating a distance between the marks. However, in this case, neither mark is capable of pronunciation other than as separate letters. They are not acronyms. There is a medium degree of visual and aural similarity between them. Some average consumers may know what OCN means in the context of the goods and services provided. However, that meaning is likely to be obscured by the extra letter L in the later mark, which does not have any obvious meaning. The marks are, therefore, neither conceptually similar nor dissimilar.

58.

Earlier mark	Proprietor's mark
OCN	

The proprietor's mark is composed of three elements: OCN, the blue swoosh, and the words LONDON REGION. Of these, the words carry little weight in the overall impression, since they will be seen as a description of the origin or location of the goods and services on offer. The swoosh device is prominent, but not as prominent as the letters OCN, which are large, emboldened and central in position. This dominant and distinctive element of the proprietor's mark is identical to the entirety of

the earlier mark. The marks have a similar overall impression. They have a good deal of visual and aural similarity. As above, apart from the obvious reference to the regional location, the marks are either near-identical in meaning or neutral, depending on what the average consumer knows.

Distinctive character of the earlier marks

59. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*³ the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

60. The OCN mark, for those who know it is an abbreviation for Open College Network, has a low degree of inherent distinctive character for goods and services connected with open college network education and training services (it has more distinctiveness in relation to the class 35 services). The swoosh device in the



composite mark gives it a low to average degree of inherent distinctive character, for those who know what OCN means. However, if the abbreviation meaning is unknown, the OCN mark has an average degree of inherent distinctive character and the composite mark a slightly higher degree of inherent distinctive character.

61. Have either of these marks been used to such an extent that their levels of inherent distinctive character have been enhanced through that use? The evidence does not point to such a conclusion in relation either to the composite Eastern Region mark or any of the other regional composite marks relied upon by the applicant. Ms Bowhill took me to some exhibits in the applicant’s evidence to support her submission that the OCN mark has acquired distinctiveness through use. Firstly, page 2 of exhibit GHE1, which refers to there being over 2500 centres in

³ Case C-342/97.

2013 offering NOCN-accredited qualifications, does not demonstrate extra awareness of OCN as a trade mark. Secondly, page 15 of exhibit GHE1, which gives a history of the applicant, refers to “OCNs”; i.e. as a noun, used as an abbreviation for Open College Networks. This is not trade mark use of OCN. Lastly, Ms Bowhill submitted that the certificates shown at pages 145 and 146 of exhibit GHE1 show use of composite region marks, which include the letters OCN. These two certificates were awarded in 2004 and 2009. If I am asked to infer that all certificates include the composite marks, then I decline to do so: the voluminous evidence should have been better marshalled if the applicant wishes to rely upon such a fact. Both parties’ evidence suffers from being difficult to see the wood for the trees. In the event, nothing turns on whether the earlier marks have, or have not, enhanced their distinctive character through use because I find, prima facie, that there is a likelihood of confusion in relation to all of the proprietor’s marks, as I shall now explain.

Likelihood of confusion

62. Deciding whether there is a likelihood of confusion is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of the principles in the authorities states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). I have found that the goods and services of the parties are identical. There is a clear likelihood of confusion (near certainty) in relation to the proprietor’s marks OCN

London (2566826),  (2588950) and  which is not obviated even if an above average degree of attention was paid to the marks during purchase. Even if not recalled imperfectly and the differences between them are noticed, the assumption will be that the marks all belong to the same undertaking.

63. There is also a likelihood of confusion in relation to the other two of the marks which are attacked, OCNLR and the LOCN series of marks. Even allowing for an above average degree of attention on the part of the average consumer, the differences between these marks and OCN are insufficient to avoid imperfect recollection.

64. I now need to consider whether the proprietor’s defences alter matters. The proprietor claims that there has been honest concurrent use, citing the CJEU *Budweiser* case C-482/09⁴, in which the Court said at paragraph 210:

“The proprietor of an earlier trade mark cannot obtain the cancellation of an identical later trade mark designating identical goods where there has been a long period of honest concurrent use of those two trade marks where, in circumstances such as those in the main proceedings, that use neither has nor is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods or services.”

⁴ [2012] RPC 11

65. The Court stressed that the circumstances in *Budweiser* were “exceptional”. I note that it was found that UK consumers were “well aware” of the differences between the two beers and that they were “clearly identifiable” as being produced by different companies”. *Budweiser* was applied in *IPC v Media 10* [2014] EWCA Civ 1439, in which Lord Justice Kitchin stated that “once honest concurrent use is established, the mark does not solely indicate the goods or services of just one of the users. As Sir Robin Jacob explained, in such a case the guarantee given by the mark is different.”

66. For there to be a concurrent use defence, the proprietor needs to show that the public is used to differentiating between the parties’ marks as indicating the goods and services of more than one undertaking. The proprietor did not put the applicant to proof of use of its OCN mark. The best that can be gleaned from the applicant’s evidence in these proceedings is that OCN formed part of the composite regional marks. Even if there had been clear use in these proceedings of OCN solus, the proprietor’s own evidence shows, in quite a few of its exhibits, wording which links it to the applicant. For example,

- The 1998 and 1999 newsletters (JM-6 and JM-7) which state that the proprietor, then using LOCN (use of which ceased in 2005), is a member of the applicant.
- The 1999 and 2000 newsletters (JM-7) state that “LOCN is a member of the National Open College Network”.
- The 2000 newsletter (JM-7) carries an article informing readers that LOCN is a licensee of the applicant.
- The 2002 and 2004 newsletters (JM-7) carry the wording “LOCN is a Company Limited by Guarantee Licensed to operate by NOCN charity no.1034750”.
- A job advert from 2003 (page 33 JM-7) which states “LOCN is a licensed member of the National Open College Network...”.
- Job adverts from 2005 and 2008 (page 1 of JM-19 and page 21 of JM-20) which state that “OCNLR is a licensed member of the National Open College Network...”.
- A job advert from 2008 (page 24 of JM-20) which shows the proprietor’s OCN London Region composite mark and which begins “Open College Network London Region is part of the leading credit-based awarding body in the UK, the National Open College Network (NOCN)...”.
- A job advert from 2010 (page 44 of JM-20) for the post of the proprietor’s Chief Executive Officer, showing the proprietor’s OCN London Region composite mark and which states “We are part of the National Open College Network...”.

67. These examples – particularly the final example – show that, whatever the proprietor’s and Ms Mutter’s own opinion about the proprietor’s autonomy, its public-facing use of its trade marks has been linked to the applicant: as a ‘member’, a licensee, and as ‘part of’ the applicant. This is a long way from *Budweiser* and *IPC*. It is not surprising that there is no evidence of confusion as the proprietor has

educated the public (both sets of potential average consumers) that it is 'part of' the applicant.

68. The proprietor's claim to common-law acquiescence (its marks have not been registered long enough for a claim to statutory acquiescence⁵ to apply) also cannot succeed because the applicant has clearly thought of itself as the licensor and the proprietor as its licensee. Common law acquiescence must have encouraged the use about which the applicant now complains and the proprietor must have acted on that encouragement so as to make the complaint unconscionable. In the email from Mr Hasting-Evans to Professor Khan of 10 October 2011, he says:

"About a month ago we were discussing issues around trade marks. At that time I confirmed that NOCN had no issues with OCN London or variants on this being registered. However it appeared that your OCN has also registered an application for OCN National and OCN Global which clear [sic] conflict with NOCN's trade marks. I understood that these were being withdrawn and I would be grateful if you could confirm this to me this week."

This defence does not assist the proprietor because it did not act upon this email: it had already applied for the marks at this point.

69. Section 5(5) of the Act states:

"Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration."

70. The issue of consent was considered by Arnold J in *Dalsouple Société Saumuroise Du Caoutchouc v Dalsouple Direct Ltd & Dalhaus Ltd* [2014] EWHC 3963 (Ch):

"43. In summary, consent must be so expressed that an intention to renounce the consentor's rights is unequivocally demonstrated, but an express statement of consent satisfies that requirement. Whether an express statement of consent has been made is a question of fact to be determined in accordance with the normal civil rules of evidence. The burden of proof lies on the party making the allegation, but the standard of proof is the ordinary civil standard of the balance of probabilities. The mere fact that the allegation is one of some seriousness does not in itself mean that it is improbable."

71. Mr Hasting-Evans' letter to Mr Khan of 27 June 2011 whereby he agrees that he will withdraw the applicant's version of the OCN London Region composite trade mark application does not amount to consent to the registration of the proprietor's OCN London Region composite mark, which had already occurred. Nor can the simple statement "I haven't disputed OCN London" in relation to the email exchange of September 2011 be so construed. Failure to oppose an application does not

⁵ Section 48 of the Act.

amount to consent to its registration. Both of these communications, in relation to consent, are (at best) equivocal. They are certainly not unequivocal. Ms Mutter's statements about what Professor Khan said are hearsay. Professor Khan has not been produced as a witness, whereas the other protagonist, Mr Hasting-Evans, is a witness and has refuted Ms Mutter's hearsay evidence. Therefore, Mr Hasting-Evans' recollection that Professor Khan registered the marks to protect the applicant and the network must carry more weight than Ms Mutter's hearsay evidence.

72. In any event, I do not find that anything turns on the supposed recollections of Professor Khan and Mr Hasting-Evan's version because there is nothing in the above which amounts to an express statement of consent or an unequivocal intention to renounce the applicant's rights within the meaning of section 5(5) of the Act.

73. The email from Mr Hasting-Evans to Professor Khan of 10 October 2011, reproduced in paragraph 68 above, and the discussion, took place after the registration of the proprietor's OCN London, OCNLR, LOCN series and composite OCN London Region marks, and after the proprietor's composite OCN London mark had been filed, but before its registration. It is implicit from the wording of section 5(5) of the Act that consent must be given prior to registration – "nothing prevents the registration of a trade mark". It does not seem to fit a scenario in which marks have already been registered. At the time of this email, the proprietor's composite OCN London mark (2588950) had been filed but did not achieve registration until 16 December 2011, after the email. Was it an express statement of consent, made unequivocally? Mr Hasting-Evans sent the email and he is the applicant's witness. He has not denied that he sent the email, although he denies that the applicant ever consented to use and registration because he states that it did not matter who owned the trade mark (the composite London Region mark) as the details could be sorted out later. Mr Hasting-Evans' states that he "had not had the opportunity to research fully the legal position in respect of trade marks". This is the voice of someone who prays in aid the benefit of hindsight. Nevertheless, stating to Professor Khan that "NOCN had no issues with OCN London or variants on this being registered", but then going on to state that there was, however, a problem with two different marks is, in my view, an unequivocal expression of consent in relation to OCN London and variants. That was the effect of his words. The composite mark

2588950  is a variant of OCN London.

74. I therefore find that the applicant consented to the registration of the proprietor's composite OCN London trade mark, 2588950, but not to the other four of the proprietor's registrations the subject of these proceedings, which had already been registered prior to the giving of consent.

Outcome

75. The applications for declarations of invalidity succeed against registrations 2566826, 2546829, 2542440 and 2542333. Under section 47(6) of the Act, these registrations are deemed never to have been made.

76. The application for a declaration of invalidity fails against registration 2588950:



This trade mark remains registered.

Costs

77. The applicant has been 80% successful. I will make an award of costs to reflect this proportion of its success. Ms Bowhill asked for off-scale costs owing to the late submission of the proprietor's evidence. I do not think that the late evidence warrants going off-scale, and a small part of it did turn out to be material. The scale⁶ allows enough room to make an award for the extra trouble the further evidence caused. Both sides filed more evidence than was necessary to decide these cases. I award the applicant costs on the following basis:

Statutory fee x 4	£800
Preparing statements and considering the other side's statements x 4	£1400
Filing and considering consolidated evidence	£1000
Preparation for and attendance at hearing	£640
Total:	£3840

78. I order Open College Network London Region Limited to pay NOCN Limited the sum of £3840 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 11th day of June 2015

Judi Pike
For the Registrar,
the Comptroller-General

⁶ Tribunal Practice Notice 4/2007.