

**APPEAL TO THE APPOINTED PERSON UNDER SECTION 76
OF THE TRADE MARKS ACT 1994**

In the matter of Application No. 2120374

by Canal + to register a trade mark in Classes 9, 16, 35, 37, 38 and 41.

This application to which this appeal relates was made by Canal + on 9th July 1997 for registration of the trade mark MEDIAHIGHWAY in classes 9, 16, 35, 37, 38 and 41 in respect of the following goods and services:

Class 9

Scientific, cinematographic, checking (supervision) apparatus and instruments, access control to datum and to programs of informations, teaching apparatus and instruments; apparatus and instruments for recording, transmission, reproduction, stocking, crypting, decrypting, transformation, handling of sound or images; telecommunication, telematic and audio-visual apparatus and instruments, television sets, tape recorders, video tape recorders, radio apparatus, projectors, aerials, parabolic aerials, loudspeakers, amplifiers, hi-fi systems, computers, recorded computer software, decoders, encoders, micros, films, videotapes and phonograms (video and audio tapes), magnetic tapes, compact discs (audio and video), optical discs, magnetic discs, telephones, magnetic data carriers, magnetic cards; cards with memories (electronical), acoustic discs, television installations, automatic vending machines and mechanisms for coin-operated apparatus; data processing equipment and computers; scrambling apparatus and control access apparatus in the area of television.

Class 16

Printed matter, books, magazines, newspapers, periodicals, catalogues; photographs,

photographs stands; stationery, instructional and teaching material except apparatus; subscription cards (non-magnetic), credit cards (non-magnetic); pads (stationery).

Class 35

Advertising; rental of advertising spaces, diffusion of advertising matter, mailing for advertising purposes, distribution of advertising material (tracts, prospectus, printed paper, samples); subscription services for newspapers for others, subscription services for television programs, radio broadcast, videotapes and phonograms; editing of advertising texts; advertising by radio and television; conducting business and business administration, computerised files management; organisation of exhibitions for commercial or advertising purposes.

Class 37

Construction and repair; fitting services, maintenance services.

Class 38

Telecommunication; radio communications, telegraphic or telephonic communications, communications by television, telematic communications; diffusion of programmes by radio, television, videotapes, phonograms, cable, hertzian way and satellites; rental of apparatus for sending messages; terminal unit communication; television broadcasts.

Class 41

Entertainment by radio or television; sporting and educational activities; edition of books, magazines; production of shows, films, telefilms, television broadcasts, reportings, debates, videotapes and phonograms; modelling for artists; rental of videotapes, phonograms, films, phonographic recordings, audio recordings, cinema projectors, decoders and encoders, organisation of competitions and games in

educational matters or entertainment; setting for programs, emissions, debates, reportings; organisation and management of discussions, conferences, congresses; organisation of exhibitions for cultural and educational purposes; reservations and ticket booking.

Initially objection was taken to the mark under Section 3(1)(b) and (c), Section 3(6) of the Trade Mark Act 1994, and under Section 5(2) of that Act in respect of certain earlier marks.

At a hearing before the Hearing Officer, Mr Charles Hamilton, the Hearing Officer informed the applicants=representative that he was prepared to waive all the Section 5(2) citations if the applicants were prepared to exclude **Agames and amusement apparatus@** from the Class 9 specification and to limit the Class 37 specification to **Aconstruction and repair; fitting services, maintenance services; all relative to audio-visual apparatus and computers@**. The applicants=representative agreed to the proposed exclusion from the Class 9 specification and the limitation of the Class 37 specification. The Section 5(2) objection was therefore withdrawn. The objection taken under Section 3(6) related only to the Class 37 specification and once the limitation to it was agreed the Hearing Officer withdrew the Section 3(6) objection. The Section 3(1)(b) and (c) objections were maintained.

The Hearing Officer informed the applicants=representative that he had, in advance of the hearing, discovered certain uses of the term **MEDIA HIGHWAY** on the Internet. The Hearing Officer handed over a copy of the relevant **Ahits@** on the Internet to the applicants=representative and agreed that time should be given to the applicants to

consider this information and that a fresh hearing would be fixed. The second hearing took place before another Hearing Officer, Ms A. Pritchard.

There was no evidence of use produced by the applicants and, accordingly, the Hearing Officer had only the *prima facie* case to consider. She noted that the mark consists of two words MEDIA and HIGHWAY conjoined. She furthermore observed that the Collins English Dictionary defines the words, *inter alia*, as follows:

Amedia: 1. a plural of (**medium**). 2. the mass media collectively.

highway: 4. a direct path or course

and

medium: 5. a means of agency for communicating or diffusing information, news, etc., to the public.@

Reference to the MacMillan Dictionary of Information Technology showed that the word HIGHWAY has been used in the field of data communication since at least 1989 to denote a means of transmitting information. The Hearing Officer went on to say:

Whilst I acknowledge that this may not be in exactly the same context as the goods and services of this trade mark application, I mention the fact as illustration that the word had already taken on a meaning in the communications field before the advent of interactive television, interactive computer technology and the Internet, therefore it seems quite natural for it to have been adopted in relation to this new technology as indeed has been the case. From my own knowledge and from browsing the Internet I am aware that terms such as INFORMATION HIGHWAY and INFORMATION SUPERHIGHWAY are commonly used to refer to the Internet. It seems logical therefore that others may wish to combine the word MEDIA with the word

HIGHWAY to denote a means for communicating information to the public via an interactive television or computer network.®

The applicants were represented before me by Mr. A. Porteous of Messrs Grant Spencer Caisley and Porteous. He explained that the products or services in respect of which the mark was being used, and would be used, were what were described as interactive TV programming which products and services would cover a wide range of subject matter from interactive games to television shopping, to interactive opinion polling. Mr Porteous contended that the word MEDIAHIGHWAY did not have a clear dictionary meaning. He pointed out that the Hearing Officer had in fact only found three hits on the Internet where the words MEDIA, HIGHWAY or HIGHWAYS had been found in combination and he argued that it was inappropriate to deduce from that that the mark was objectionable in terms of either Section 3(1)(b) or Section 3(1)(c) of the 1994 Act. If anything, he said, the low number of hits supported his contention that the mark was distinctive and that it did not fall foul of Section 3(1)(c). I am satisfied, however, that on a proper understanding of the Hearing Officer's approach to this matter, she was merely saying that the hits on the Internet provided support for her view that the mark was objectionable rather than that simply because of the hits it was objectionable.

The Hearing Officer's approach was based on her own knowledge or from browsing the Internet that the expression INFORMATION HIGHWAY and INFORMATION SUPERHIGHWAY were commonly used to refer to the Internet. She went on to say that: *It seems logical therefore that others may wish to combine the word MEDIA with the word HIGHWAY to denote a means for communicating information to the public via an interactive TV or computer network.®* That view was as she put it, *Reinforced®*

by the hits on the Internet which showed the use of the two words MEDIA HIGHWAY in relation to modern means of communicating information.

While the Hearing Officer's decision was that the mark was objectionable both on the basis of Sections 3(1)(b) and 3(1)(c), before me, Mr Morgan, appearing for the Registrar, was content to say that the decision to refuse was justified having regard to Section 3(1)(c) which is in the following terms: *The following shall not be regarded as trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, the time of production of goods or of rendering of services, or other characteristics of goods or services*. The question in this case is, in my view, whether the expression MEDIAHIGHWAY is one which honest traders might legitimately want to use in relation to, for example, compact discs and magnetic discs as comprised in Class 9, diffusion of programmes by television, cable, hertzian way and satellites, in Class 38, entertainment by television and television broadcasts in Class 41. It seems to me, having regard to what might be said to be the developing *lingua franca* of information technology, that the expression is one which may well be adopted by honest traders to use in relation to such goods and/or services. The Hearing Officer appears to have considered that there is already in existence an established phenomenon which can properly be described as the MEDIA HIGHWAY, which I think led her to the conclusion that the Section 3(1)(b) objection was established. I am not satisfied that that was a view she was entitled to reach, on the evidence before her, but I am satisfied that she was justified in reaching the conclusion, under reference to the law as set out in the case of **Profitmaker** (1994) RPC 117 and **AD 2000 Trade Mark** (1997) RPC 168, that the Section 3(1)(c) objection was made out, since the expression

MEDIAHIGHWAY was an apt term to use to designate the kind and intended purpose of at least certain of the goods and services applied for in the instant application. (It should be noted that the applicants made no application before me to restrict the very wide specifications applied for.) The Hearing Officer was also correct, in my view, to reach the conclusion that the fact that the words were not used separately did not make them any less objectionable under Section 3(1)(c).

I should add that Mr Porteous for the applicants informed me that the mark had been accepted for registration in various other jurisdictions. Under reference to the case of **Swift's Application** (1962) RPC 37 he submitted that this should be taken into account in deciding whether registration in the United Kingdom should be allowed or not. He presented no evidence, however, to me as to the circumstances in which those registrations were granted, or in respect of what they were granted, and I consider it inappropriate for me, in that situation, to have regard to the mere assertion that registration had taken place elsewhere, when reaching my decision as to whether the Hearing Officer's decision in this case was sound or not. The case of **Swift's Application** involved the court of one jurisdiction having regard to the reasoned decision of another court in respect of the registration of a patent, in reaching its own decision, which is quite a different level of affairs than the mere assertion before me that the mark has been accepted for registration in other jurisdictions.

For the foregoing reasons I consider that the appeal should be refused.

M.G. CLARKE QC
5th November 1999.