

O-009-04

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION No 2313609
BY SOUTHALL TRAVEL LIMITED
TO REGISTER A TRADE MARK
IN CLASSES 39, 41 AND 43**

DECISION AND GROUNDS OF DECISION

Background

1. On 18 October 2002 Southall Travel Limited of Palmoak House, 19 South Road, Southall, Middlesex, UB1 1SU applied to register the following series of three trade marks in classes 39, 41 and 43.

**HOLIDAY GURU
TRAVEL GURU
TOUR GURU**

2. The amended specifications of services are:

Class 39

Transport and storage; transport of persons and goods, in particular by road, rail, water and air; portage; guarded transport of money and valuables; arranging, booking and arrangement of travel, excursions and cruises; organising transport services; organising, booking and arrangement of tours, excursions and sightseeing; travel consultancy and personal chaperoning of travellers; rental, booking and arrangement of aeroplanes, rental, booking and arrangement of boats, in particular rowing boats and motor boats, yachts and canoes, rental, booking and arrangement of motor vehicles and bicycles, horses, diving equipment; packaging and storage of goods; parcel delivery; organisation of tours, sightseeing, holiday camps and holidays; travel agency services (included in Class 39), in particular consultancy and booking of travel, provision of travel information, arranging of transport and travel; reservation services (included in Class 39) for sporting, scientific, political and cultural events; online information, reservation and booking services in the field of tourism and business travel (online travel agencies); traffic information services; location of vehicles by computer; all the aforesaid services, in particular in the field of travel and leisure.

Class 41

Providing of training and further training and education consultancy; instruction, in particular correspondence courses and language instruction; entertainment; film and video production, film and video rental, film and video showings; artist management; artists' services; musical performances; circus performances; public entertainment; theatre productions; arranging and conducting of after-school childcare; organising sports lessons and language instruction, film showings and musical performances; health

club services, training club and fitness studio services, providing golf facilities, tennis court and riding facilities, nursery schools, cinemas, discotheques, museums, amusement arcades, sports camps, sports facilities and amusement parks; organization of sports competitions; arranging and conducting of sporting and cultural events; reservation services (included in Class 41) for sporting, scientific, political and cultural events; rental of films, data carriers, projection apparatus and accessories; lending and distribution of newspapers periodicals, publication of books, newspapers, periodicals and other printed matter, and of electronic media, including CD-ROMs; publication of printed matter, in particular books, periodicals, catalogues and newspapers in the field of business and leisure; videotaping (production); organization of exhibitions for cultural or educational purposes; leisure centres and amusement parks in the field of education and entertainment; production of radio and television programmes; television and radio entertainment, interpreting and translation services, photography.

Class 43

Provision of accommodation, food and drink; accommodation services; arranging and rental of holiday homes, tourist homes and apartments; room and hotel reservation services, hotels motels, saunas, spas, swimming pools.

3. Objection was taken under Section 41(2) of the Act because the three marks were not considered to form a series of marks.
4. Further objection was taken under Section 3(1)(b) and (c) of the Act because the marks consists exclusively of the words HOLIDAY GURU, TRAVEL GURU and TOUR GURU being signs which would not be seen as trade marks as they describe the kind of services on offer, e.g. services relating to travel arrangements and destinations offered by a leading authority on holidays, travel and tours.
5. At a hearing, at which the applicants were represented by Mr Jennings the objections were maintained.
6. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.
7. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

Objection under Section 41(2)

The Law

8. Section 41(2) of the Act reads as follows:

“41.-(2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a

non-distinctive character not substantially affecting the identity of the trade mark.”

The Decision

9. In order to satisfy the requirements of Section 41(2) of the Act all three marks must, while differing from one another, differ only in respect of matter of a non-distinctive character which does not substantially affect the identity of each mark, that is to say its identity with each and every other mark in the group propounded as a series.

10. In Logica’s Trade Marks [BL O/068/03] Professor Ruth Annand sitting in her role as the Appointed Person established that Section 41(2) of the act contains three conditions which must be met. In her decision she stated:

“38 *I agree with Mr James that section 41(2) contains three conditions and not two but prefer to describe them according to their positive and negative aspects. First, on the positive side, section 41(2) requires that trade marks for which registration is sought to resemble each other in their material particulars. Second and third, the negative aspects are that any difference in the trade marks must not comprise matter, which when considered:*

- (a) as a separate element of the trade mark would be regarded as having distinctive character; and*
- (b) in the context of the trade mark as a whole, substantially affects the identity of the trade mark.”*

11. Guidance on the examination of applications for series of marks was issued as Practice Amendment Notice PAN 1/03. For the sake of convenience a copy of this is attached at Annex A.

12. I note that in respect of all three marks the word GURU is preceded by each of the words HOLIDAY, TRAVEL and TOUR. The result of this is that the words HOLIDAY, TRAVEL and TOUR now appear as being integral to the identities of the three marks. When presented in this way these words form part of the material particulars of the trade marks and varying the first word therefore substantially affects the identities of the marks.

13. Neither at the hearing, nor in subsequent correspondence, have the applicants or their representative provided any indication that any of these marks are to be deleted. Neither has any request to divide the application in accordance with Rule 21(2) of the Trade Marks Rules 2000 been received.

14. Consequently, I have concluded that the marks contained within this application differ as to their material particulars in such a way that they do not satisfy the requirements of Section 41(2) of the Act.

Objection under Section 3(1)(c)

The Law

15. Section 3(1)(b) and (c) of the Act reads as follows:

“3.-(1) The following shall not be registered-

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,”

The case for registration

16. At the hearing Mr Jennings placed great reliance on the dictionary definition of the word GURU. It is clear from Collins English Dictionary (5th. Edition first published 2000) that the primary definition is:

“n. 1. a Hindu or Sikh religious teacher or leader, giving personal spiritual guidance to his disciples.” and

“2. often derogatory; a leader or chief theoretician of a movement, esp. a spiritual or religious cult.”

17. Mr Jenkins referred me to the Internet reports which were forwarded to the applicants with the official letter dated 1 April 2003 as support for the objection. However, I do not consider that they are of particular relevance in this matter and I will not refer to them in this decision. Finally, Mr Jenkins referred me to other trade marks incorporating the word GURU which have achieved registration. However, I noted that all but one of these were for goods and not services. The exception is the trade mark CAR GURU which is registered *inter alia* for services relating to cars and car products. Details of this registration are attached at Annex B.

Decision

18. In a judgement issued by the European Court of Justice on 20 September 2001, *Procter & Gamble Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case - 383/99P, (the BABY-DRY case), the Court gives guidance on the scope and purpose of Article 7(1)(c) of the community Trade Mark Regulation (equivalent to Section 3(1)(c) of the Trade Marks Act). Paragraphs 37, 39 and 40 of the judgement are reproduced below:

“37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Procter & Gamble and the OHIM acknowledge, to prevent registration as trade

marks signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function.”

“39. The signs and indications referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other sign or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.”

“40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”

19. These paragraphs indicate that marks which may serve in trade to designate the relevant goods or services or their characteristics are now debarred from registration by Section 3(1)(c) of the Act. This is confirmed by the Judgement of the European Court of Justice in *Joined cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003). Paragraphs 73 and 74 of the judgement are reproduced below:

“73. According to the Court’s case law, Article 3(1)(c) of the directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, to that effect, *Windsurfing Chiemsee*, paragraph 25).

74. The public interest underlying Article 3(1)(c) of the Directive implies that, subject to Article 3(3), any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristic of goods or a service within the meaning of that provision must be freely available to all and not registrable.”

20. In order to correctly assess this application I must consider how the relevant consumer of the services applied for will perceive the word GURU when used in conjunction with the prefixes HOLIDAY, TRAVEL and TOUR. In my view it is unlikely that the relevant consumer will

perceive the word GURU as an indication that it relates to a Hindu or Sikh religious teacher or leader. I consider it far more likely that they will perceive the word as an indication that the services in question, whether they relate to a holiday, travel or tour, will be provided by a leading authority in that particular field. In Collins English Dictionary this is confirmed by the third definition of the word GURU which is:

“3. Often facetious; a leading authority in a particular field. e.g. a cricketing guru.”

21. The words HOLIDAY, TRAVEL and TOUR are very well known words. The word HOLIDAY will, in relation to the services applied for, be identified as a period away from work which often includes travel to a different location for a period of time. The word TRAVEL will indicate methods of travel e.g. air travel, rail travel and sea travel etc.. The word TOUR will, in relation to these services, indicate “an extended journey, usually taken for pleasure, visiting places of interest along the route.” (Collins English Dictionary).

22. There are many individuals and groups who provide services relating to the provision and organisation of holidays, travel and tours. These services may include the organisation of travel to the holiday destination, the provision of accommodation for the duration of stay, the provision of meals and the provision of related services such as sporting activities, sightseeing trips, musical entertainment, car and boat hire and the provision of guidance and advice on any problems their clients may face. Providers of such services are numerous and each face, and must deal with, intense competition from each other. One way in which they may do this is to advertise their services. Such advertisements may be placed in the local or national press, on radio and television or on web-sites. Such traders may well wish their advertisements to indicate that they are a leading authority on such services and that the quality of advice, guidance and information they provide is of the highest quality and may be relied upon.

23. I consider it a genuine likelihood that traders would wish to refer to themselves as gurus. Furthermore, when such traders are providing services relating to holidays, travel and tours the natural combinations to use are HOLIDAY GURU, TRAVEL GURU and TOUR GURU.

24. These words would, in my view, be instantly recognised by the relevant consumer as an indication that they are a leading authority on the services being offered. I make no distinction between the different services of the application in suit because they are all part of the same commercial context.

25. As far as the registered marks referred to by Mr Jennings are concerned (Annex B) I do not accept that they are of any relevance in deciding the issues pertinent to this application.

26. Consequently, I have concluded that the marks applied for consist exclusively of signs which may serve in trade to designate the kind and intended purpose of the goods and services and are, therefore, excluded from registration by Section 3(1)(c) of the Act.

27. Having found that these marks are to be excluded from registration by Section 3(1)(c) of the Act that effectively ends the matter but in case I am found to be wrong in this decision I will go on to determine the matter under section 3(1)(b) of the Act.

28. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 46 to 47 of its Judgment in *Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

“37. It must first of all be observed that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule 1 Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark’s distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court’s case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and *circumspect* (see *Case C-210/96 Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

29. In my view the relevant public, bearing in mind that services in relation to the provision of holidays are in common supply via a large number of individuals and organisations, would not consider this mark to denote trade origin. I am not persuaded that the combination of the words HOLIDAY GURU, TRAVEL GURU and TOUR GURU are sufficient, in terms of bestowing distinctive character on the signs as a whole, to conclude that they would serve in trade to distinguish the goods and services of the applicants from those of other traders.

30. In my view, even if the words HOLIDAY GURU, TRAVEL GURU and TOUR GURU in combination are found not to be designations of a characteristic of the services, but are found to be terms liable to be used in trade to designate characteristics of the undertaking providing the services, then this is sufficient to justify an objection under Section 3(1)(b) of the Act in the alternative to the objection under Section 3(1)(c). This is because signs viewed as above will not be considered as signs which distinguishes the services of one undertaking from another.

31. In my view the marks applied for will not be identified as trade marks without first educating the public that they are trade marks. I therefore conclude that the marks applied for are devoid of any distinctive character and are thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

Conclusion

32. In this decision I have considered all the documents filed by the applicants and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 41(2), 3(1)(b) and 3(1)(c) of the Act.

Dated this 8th day of January 2004

A J PIKE
For the Registrar
The Comptroller General

ANNEX A

ANNEX B