

O-131-08

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION NO 2409366

TO REGISTER A TRADE MARK

BY HULL DAILY MAIL PUBLICATIONS LTD

IN CLASS 16

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DECISION AND GROUNDS OF DECISION

Background

1. On 19 December 2005, Hull Daily Mail Publications Ltd, of 31-32 John Street London WC1N 2QB, applied under the Trade Marks Act 1994 to register the following series of two trade marks.

THE JOURNAL
THE JOURNAL

2. Registration is sought for the following services:

Class 16

Printed periodical publications; newspapers; magazines.

3. The application was examined and objection was taken against the application under Section 3(1)(b) and (c) of the Act because both marks in the series consists exclusively of the words THE JOURNAL, the first mark being a word only and the second being presented in a slightly stylised font, both being signs which may serve in trade to designate the kind of goods e.g. goods being a newspaper or periodical.

4. At the time of examination, objection was also taken under Section 5(1) of the Trade Mark Act in respect of two earlier marks for THE JOURNAL (word only) in respect of identical goods. New legislation which came into effect on 1 October 2007 resulted in these earlier marks no longer standing as an obstacle against this application therefore I will make no further comment on them in this decision.

5. No submissions were made in relation to the Section 3(1)(b) and (c) *prima facie* objection. Evidence of acquired distinctiveness was submitted however, in the form of a Witness Statement dated 23 May 2007 made by Christopher Shears, Finance Director of the applicant company. The evidence was found by the examiner to be insufficient and the objection was maintained. A request to be heard was subsequently made.

The Hearing

6. Following a hearing which was held on 19 September 2007 at which the applicant was represented by Mr Martin Krause of Haseltine Lake, their trade mark attorneys, the *prima facie* Section 3(1)(b) and (c) objection was upheld. The evidence was considered and the objection maintained on the basis that the evidence did not

demonstrate use of the mark throughout the UK. I pointed out that following the ECJ decision *Bovemij Verzekeringen NV v Benelux Merkenbureau* (Case C-108/05), it is not possible to register a trade mark on the basis of distinctiveness acquired on a local or regional basis.

7. I drew Mr Krause's attention to Practice Amendment Notice 6/07 which states that, following the *Bovemij* judgement, it is no longer possible to register a trade mark on the basis of distinctiveness acquired on a local basis. Further to this, I pointed out that national procedural provisions, such as the entry of geographical limitations under s.13 of the Act do not allow the Examining Authority in the UK to interpret the proviso to s.3(1) in a way that permits registration in circumstances that are incompatible with the *Bovemij* judgement.

8. Mr Krause submitted that the goods in question, being local publications, are by their very nature local and that taking this into consideration, his client's application is not on all fours with the *Bovemij* judgement. Mr Krause then went on to refer in detail to further aspects of the judgement to substantiate this. As a full copy of the actual decision was not available to hand at the hearing, it was agreed that two months would be granted to for Mr Krause to file further written submissions. No submissions were received in the time allocated and subsequently, the Notice of Final Refusal was issued on 12 December 2007.

9. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

The Prima Facie Case for Registration

10. The marks in the series consist of the two well known dictionary words, THE JOURNAL, which describe the kind of goods and on this basis the objection under Section 3(1)(b) and (c) was maintained. I consider this objection to be correct and the marks to be objectionable in the *prima facie*.

The Law

11. Section 3(1) (c) of the Act reads as follows:

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

(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.”

12. In a judgement issued by the European Court of Justice on 23 October 2003, *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case - 191/01 P, (the DOUBLEMINT 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 28 - 32 of the judgement are reproduced below:

- “28. Under Article 4 of Regulation No 40/94, a Community trade mark may consist of any signs capable of being represented graphically, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.
29. Article 7(1)(c) of Regulation No 40/94 provides that 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, time of production of the goods or rendering of the service, or other characteristics of the goods or service are not to be registered.
30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.
31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 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 sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73).
32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

13. I also take account of the decision of the European Court of Justice in *Postkantoor* (Case C-363/99) which again considered the registrability of combinations of descriptive words. Paragraphs 96 – 100 of the judgement are reproduced below:

- “96. If a mark, such as that at issue in the main proceedings, which consists of a word produced by a combination of elements, is to be regarded as descriptive for the purpose of Article 3(1)(c) of the Directive, it is not sufficient that each of its components may be found to be descriptive. The word itself must be found to be so.
97. It is not necessary that the signs and indications composing the mark that are referred to in Article 3(1)(c) of the Directive actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that those signs and indications could be used for such purposes. A word must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned (see to that effect, in relation to the identical provisions of Article 7(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-0000, paragraph 32).
98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.
99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark.
100. Thus, a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has

acquired its own meaning, with the result that it is now independent of its components. In the second case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purpose of the same provision.”

14. Section 3(1)(c) of the Act has common roots to Art. 7(1)(c) of the CTMR, and is substantially identical to that provision. Accordingly, the ECJ’s guidance with regard to that provision may be taken to apply equally to Section 3(1)(c) of the Act. The provision excludes signs which may serve, in trade, to designate the kind of goods or other characteristics of goods. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the goods in question.

15. Having found that the 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.

16. Section 3(1)(b) of the Act reads as follows:

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

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

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

“37. It is to be noted at the outset 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 or services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule in 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.”

18. For the same reasons that I found this trade mark is to be excluded by the provisions of Section 3(1)(c) of the Act I have concluded that the relevant consumer of the services in question would not consider this mark to denote trade origin. The average consumer of these goods will, upon encountering the words THE JOURNAL, perceive them as no more than an indication that they relate to items being newspapers or periodicals. That is why it will not be seen as a badge of origin. I am not persuaded that the trade mark applied for is sufficient, in terms of bestowing distinctive character on the sign as a whole, to conclude that it would serve, in trade, to distinguish the services of the applicant from those of other traders.

Decision

19. The application put forward for registration consists of a series of two marks. The first mark in the series consists exclusively of the words THE JOURNAL and the second mark consists of the words THE JOURNAL in a slightly stylised font. The examiner considered that in the *prima facie* the mark describes the goods and is therefore objectionable under Section 3(1)(b) and (c) of the Act.

20. No arguments were put forward at the hearing regarding the *prima facie* objection to the mark, however I concluded that the *prima facie* objection is strong.

21. Given that the correctness of the *prima facie* registrability of the mark has not been challenged I do not believe that I need say much more about it.

22. On the face of it, the mark clearly describes the goods and as such is excluded from *prima facie* registration under Section 3(1)(b) and (c) of the Act.

The case for Registration based upon acquired distinctiveness

The Law

23. The proviso to Section 3 of the Act permits acceptance of a mark that is otherwise unacceptable under the provisions of Section 3(1)(b) and (c) if it has in fact acquired a distinctive character because of the use made of it. Guidance on the test to be applied was provided by the ECJ in *Windsurfing Chiemsee (C108&109/97) [1999] ETMR 585* where it was stated:

“If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied.”

24. Having regard to the guidance provided above, it seems to me that if the proviso is to be utilised the evidence must show that the mark in suit is taken by the average consumer as a guarantee that the goods sold under it originate from the applicant because of the use of the mark for that purpose.

25. I also take into account the ECJ decision in *Bovemj Verzekeringen NV v Benelux Merkenbureau* (Case C-108/05) where it was held that a trade mark may be registered on the basis of acquired distinctiveness, “only if it is proven that the trade mark has acquired distinctive character through use throughout the territory of a member state.”

26. I now go on to assess the evidence filed on that basis.

The evidence and the decision

27. I do not consider that there is a need to go into detail with regards all of the evidence submitted as the reason for my decision is based upon the ECJ decision in *Bovemj Verzekeringen NV v Benelux Merkenbureau* (Case C-108/05) following which Practice Amendment Notice 6/07 relating to evidence of acquired distinctiveness through use was issued.

28. The marks have been used since 1989 in respect of local publications. Although I accept that sometimes local publications may not be limited locally and may rather be distributed over a large geographical area, I have not found this to be so in this instance.

29. Exhibit CS1 consists of photocopies of the front page of the publication dating from May 2004 and May 2005, these do not demonstrate widespread UK use however. Exhibit CS2, provides background information and includes an extract from the Hull Daily Mail Careers website referring to the mark being firmly established in the East Yorkshire area. This exhibit also refers to distribution in West Hull villages, select areas of the East Riding, Beverley and York. Further, the witness statement does not claim use of the mark throughout the UK but refers to its use, “in newsagents, at the local racecourse, in local directories, in mail publications websites, and in the Applicant’s publications Hull Daily Mail and East Riding Mail.”

30. Therefore absent of any positive proof that the mark has been relied upon as an indication of origin throughout the UK, the evidence has failed to demonstrate that the mark applied for is factually distinctive.

Conclusion

31. In this decision I have taken into account all the written submissions/evidence filed to support this application. I have concluded that the mark is excluded from *prima facie* registration under section 3(1)(b) and (c) of the Act because it consists of words which describe the goods. Having regard to the guidance provided in *Bovemj Verzekeringen NV v Benelux Merkenbureau* (Case C-108/05), the I have concluded that I do not consider that the evidence demonstrates acquired distinctiveness as it only refers to use of the mark on a local basis.

32. Consequently the application is refused under the terms of Section 37(4) of the Act because it fails to qualify for registration under Section 3(1)(b) and (c).

Dated this day 7 of May 2008

**Karen Stephens
For the Registrar
The Comptroller-General**