

O/302/13

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NUMBER 2471906
BY RACEPARTS (UK) LIMITED
TO REGISTER THE FOLLOWING TRADE MARKS IN CLASS 35:**

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Background

1. On 2 November 2007 RACEPARTS (UK) LIMITED ('the applicant') applied to register the trade marks shown above, as a series of two, for the following services:

'Retail services connected to parts and fittings for vehicles, parts and fittings for racing vehicles of all types.'

2. On 25 November 2007, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, the following objections were raised:
 - A series objection was raised under section 41(2) of the UK Trade Marks Act 1994 ('the Act') because addition of the letters 'UK' in the second mark was felt to render the two marks materially different.
 - The first mark 'RACEPARTS' was considered to be unacceptable under sections 3(1)(b) & (c) of the Act because it may serve in trade to designate the kind of services e.g. 'retail services connected to the sale of race parts'. The second mark was also considered to be unacceptable under sections 3(1)(b) & (c) because it may serve in trade to designate the kind of services e.g. 'retail services connected to the sale of race parts in the UK'.

The examiner attached seven Internet references showing apparent generic and descriptive use of the term 'race parts' by third parties based in the UK.

3. Following a series of time extensions, on 23 October 2008 the agent representing the applicant at that time, Fry, Heath & Spence LLP, submitted evidence in support of a claim to distinctiveness acquired through use. The examiner was not convinced that the evidence demonstrated the marks had acquired distinctiveness through use and duly informed the agent of this in a letter dated 7 November 2008.
4. Following more extensions of time and the appointment of a new representative, Lynton Foster, a letter was received on 5 May 2009 providing some historical context for the application, and the extent to which the signs applied for *are* recognised as indicators of trade origin within the world of motorsport. These supplementary submissions were rejected by the examiner in her letter of 4 June 2009. The agent, the representative, and various representatives from the trade all then submitted documents in an attempt to persuade the Registrar that the sign was recognised as a trade mark for the applicant's services. These submissions were rejected by the examiner and an *ex parte* hearing was arranged for 8 September 2011. One day prior to the hearing, the agent provided

further evidence consisting of testimonial letters from companies which recognise the sign applied for as being an indication of trade origin.

5. At the hearing, the objections taken under sections 3(1)(b) and (c) were maintained. Following the hearing, the agent, in his letter of 16 February 2012, made further submissions regarding alleged distinctiveness of the marks. I was not persuaded by these submissions and maintained the objection in my letter of 4 May 2012. I then allowed one final two-month extension of time for further submissions to be made, emphasising that any such submissions should only contain facts and/or arguments that had not already been presented either in correspondence or at the hearing.
6. On 8 November 2012, Jensen & Son replaced Lynton Foster as agent for the case, and subsequently filed new submissions, which focused largely on identifying the relevant consumer for the services provided by the applicant. These further submissions did not persuade me that the mark was acceptable, and so I refused the application via my letter of 29 January 2013.
7. On 1 March 2013 the agent, Jensen & Son, submitted a form TM5 seeking a statement of reasons for the Registrar's decision. I am now asked under section 76 of the Trade Marks Act 1994, and Rule 69 of the Trade Marks Rules 2008, to state in writing the grounds of my decision and the materials used in arriving at it.

Section 41(2)

8. Both at the hearing and in correspondence, the agent failed to address the objection raised under section 41(2), which states:

"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."

9. To the best of my knowledge, no other EC Member State apart from the UK and Ireland recognises the concept of the registration of series of trade marks in their harmonised trade mark laws. In the circumstances, there is little case law addressing this issue.
10. In the *Logica* decision [BL 068/03] Professor Annand, sitting as the Appointed Person, considered the meaning of the phrase 'materially affecting the identity of the mark', and stated the following:

"Turning to the meaning of "not substantially affecting the identity of the trade mark", I believe it would be hard to improve on Jacob J.'s observation in Neutrogena Corporation v. Golden Limited [1996] RPC 473, at 488 - 489 regarding, in effect, the identical phrase in section 30(1) of the Trade Marks Act 1938:

'Not substantially affecting its identity' means what it says, both in this section and in other sections of the Act (e.g. section 35). An alteration which affects the way a mark is or may be pronounced, or its visual impact or the idea conveyed by the mark cannot satisfy the test.'

11. Professor Annand went on to add:

“Section 21(2) of the Trade Marks Act 1938 found almost its exact counterpart in section 39(1) of the Australian Trade Marks Act 1955. In Re Lynson Australia Pty Ltd (1987) 9 IPR 350 at 351-352, Chief Assistant Registrar S. Farquhar had to construe the meaning of the stipulation in section 39(1)(c) of the 1955 Act (section 21(2)(c) 1938 Act) that the marks should differ only in matter not substantially affecting their identity:

‘Briefly, and only in general terms, the variation between members of a series must be such that no additional element or dimension is contributed thereby to the overall identity of the marks; the “idea” of the mark must remain the same. If the marks consist of a word, then that word must be the only element in the identity of each member of the series. The typescript may be varied, but only between known, conventional scripts, not fanciful get-up. The spelling may be varied, but only if the pronunciation and meaning remain unaffected. The separation of one word into two, or the running together of two words would be governed by the same considerations; the sound and meaning must remain the same. The appearance of the word or words must also be taken into account when the spelling or physical arrangement of the letter is varied. Minor changes (such as ‘pelican’ and ‘pelikan’ or ‘fastfoto’ and ‘fast-foto’), will be acceptable where more extensive ones will not (e.g. ‘tablet’ and ‘tablett’ or ‘tab-let’, ‘ta-blet’ and ‘tablet’).

12. In this case, the examiner considered that the addition of the letters ‘UK’ in the second mark materially altered its identity from that of the first mark, and that this change therefore fell short of requirements set out in the series provisions. In reviewing the case, I also have to consider whether alteration of the second mark *does* materially affect its identity and therefore distinguish it from the first mark. Although the suffix ‘UK’ might well be regarded as a non-distinctive element, when the marks are viewed overall, its addition does substantially affect the identity of the two signs. Addition of the letters ‘UK’ are a clear indication that the services provided under that mark are provided in the United Kingdom whereas, with the mark ‘RACEPARTS’ *solus*, there is no such indication. The marks clearly differ in their visual, phonetic and conceptual properties, and so the section 41(2) objection must be maintained.

The applicant's case for *prima facie* registration

13. Although the applicant has submitted evidence of acquired distinctiveness I must first consider the *prima facie* case for acceptance.
14. Although the agent had responded to initial receipt of the examination report by submitting evidence of use, I was aware that in correspondence since that time, submissions had been made relating not only to the issue of acquired distinctiveness, but also to the question of *inherent* distinctiveness. At the *ex parte* hearing, I invited Mr Lynton and Mr Bloore (the applicant) to confirm whether or not there were additional submissions to be made in respect of the latter point.

15. In response, Mr Lynton stressed that the relevant consumer should not be assumed to be any and all purchasers/users of automotive parts. I was told that the applicant was operating in a highly specialised area; that it was the first company to identify and provide the services intended for protection; and that the mark's use of 'U.K.' was an intentional move intended to reflect the UK's international reputation for motorsport and related engineering activities. Mr Bloore emphasised the *conjoining* of the words 'race' and 'parts', submitting that it rendered his marks different from the more conventionally-punctuated term 'race parts' as used by other providers. Mr Bloore indicated that he had no interest in preventing third party use of the term as shown on Internet references attached to the Examination Report (most of which presented the term in a non-conjoined fashion) - he simply wanted protection for the marks as filed.

Section 3(1) - the Law and relevant authorities

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

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,

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

The above provisions mirror Article 3(1)(b) and (c) of First Council Directive 89/104 of 21 December 1988 (subsequently codified as Directive 2008/95/EC of 22 October 2008) (the Directive). The proviso to Section 3 is based on the equivalent provision of Article 3(3).

17. The Court of Justice of the European Union ('CJEU') has repeatedly emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 (subsequently codified as Council Regulation (EC) No 207/2009 of 26 February 2009) on the Community Trade Mark (the Regulation), in the light of the general interest underlying each of them (*Bio ID v OHIM*, C-37/03P, paragraph 59 and the case law cited there and, more recently, *Celltech R&D Ltd v OHIM*, C-273/05P).
18. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. For example, in the case of the registration of colours *per se* not spatially delimited, the Court has ruled that the public interest is aimed at the need not to restrict unduly the availability of colours for other traders in goods or services of the same type. Also, in relation to section 3(1)(b) (and the equivalent provisions referred to above) the Court has held that "...the public

interest... is, manifestly, indissociable from the essential function of a trade mark” (Satelliten Fernsehen GmbH v OHIM C329/02 (‘SAT.1’)). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment).

19. There are a number of CJEU judgments which deal with the scope of Article 3(1)(c) of the Directive and Article 7(1)(c) of the Regulation, whose provisions correspond to section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- Subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (*Wm Wrigley Jr & Company v OHIM, C-191/01P (Doublemint)*, paragraph 30);
- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all (*Doublemint*, paragraph 31);
- It is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes (*Doublemint*, paragraph 32);
- It is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question (*Koninklijke KPN Nederland NV v Benelux Merkenbureau, C-363/99 (Postkantoor)*, paragraph 57);
- An otherwise descriptive 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 trade 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 (*Postkantoor*, paragraph 99).

20. In *Matratzen Concord AG v Hukla Germany SA, C-421/04*, the CJEU stated that:

“...to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, who are reasonably well informed and reasonably observant and circumspect, in the territory in respect of which registration is applied...”.

I am also mindful of the decision of the General Court (formerly the Court of First Instance) in *Ford Motor Co v OHIM, T-67/07* where it was stated that:

“...there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics”.

21. I must also be aware that the test is one of immediacy or first impression, as confirmed by the General Court which, in its decision on *Sykes Enterprises v OHIM (Real People Real Solutions)*, [2002], ECT II-5179, stated:

“...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin.”

Section 3(1)(c) - Registrar's decision

22. It is clear from the aforementioned case law that I must determine whether, assuming notional and fair use, the marks in suit will be viewed by the average consumer as a means of directly designating essential characteristics of the goods. In identifying the average consumer, Mr Lynton stressed that the relevant consumer should not be assumed to be any and all purchasers/users of automotive parts, largely because the applicant was operating in a highly specialised area. However, it is clear from the Internet findings that general use of the term is *not* limited to the level of competitions at which the applicant operates. Those findings indicate that purchasers of race parts could be anyone - from those involved in amateur and semi-professional motorsport, through to enthusiasts and those simply looking to customise their machines in order to improve performance. The Internet research shows that the term 'race parts' is in common use by a wide range of UK-based suppliers of automotive parts, with terms such as 'Race Parts & Equipment', 'motorcycle road and race parts' and 'rally/race parts' all frequently being used in a manner which strongly suggests that the sign applied for is both generic and descriptive for high performance automotive parts. Examples showing this type of third party use were forwarded to the applicant with the *ex parte* hearing report dated 8 September 2011, and have been retained on the file.
23. At the hearing, Mr Bloore highlighted the *conjoining* of the words 'race' and 'parts' as being an intentional element of presentation, employed specifically to create more distinction between his own mark and the generic term 'race parts' as used by others in the trade. I was not persuaded by these submissions. Although there are occasions where the conjoining of two words can make significant contribution to a mark's overall visual identity (sometimes to such an extent that the relevant consumer would perceive the sign conjoined as being something *other* than a descriptive reference), in the main, the combining of two descriptive words usually separated by spacing or other punctuation is unlikely to give rise to a sign which is inherently distinctive in its totality. In this instance, I do not believe that the relevant consumer will see the signs as anything more than a reference to the kind of goods being provided by the retailer, and refer in

this respect to comments made in *Koninklijke KPN Nederland NV and Benelux-Merkenbureau*, Case C-363/99 (*Postkantoor*) where the CJEU held that:

“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 be not descriptive within the meaning of article 3(1)(c) of the Directive, if 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”

24. Having taken into account both the Internet use of the words ‘race parts’ by professionals and amateurs alike to describe parts for enhancing the performance of vehicles, and also my own consideration that the conjoining of those words adds no distinctive character to the mark, I have concluded that the marks applied for consist exclusively of signs which may serve, in trade, to designate the kind or type of goods, and are therefore excluded from registration in the prima facie case by section 3(1)(c) of the Act. For the first sign, the descriptiveness relates solely to the kind of goods being provided; for the second sign, it extends to designating both the kind and the geographical origin of the goods (where the suffix ‘U.K.’ would be perceived as denoting the manufacturing origin and/or the commercial origin which, in either case, would not serve to denote trade origin).
25. Having found that to be the case, it effectively ends the matter. However, in case I am found to be wrong in this regard, I will go on to determine the matter under section 3(1)(b) of the Act. I should at this point stress that since objection has been made under section 3(1)(c), this automatically engages section 3(1)(b). However, it can be useful to also consider section 3(1)(b) in its own right - the scope of the two provisions is not identical, and marks which are not descriptive under section 3(1)(c) can nonetheless be devoid of any distinctive character.

Section 3(1)(b) - Registrar’s decision

26. I approach this ground of objection on the basis of the following principles derived from the ECJ cases referred to below:

- An objection under section 3(1)(b) operates independently of objections under section 3(1)(c) - (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);
- For a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- A mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86);
- A trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought, and by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01, paragraphs 72-77);
- The relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

27. Furthermore, in relation to section 3(1)(b), it was held in paragraph 86 of *Postkantoor* that:

"In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive."

28. I do not consider that an application should necessarily escape objection if it is considered too imprecise a term to indicate a direct and specific relationship with the goods or services at issue without further thought, but is, in some sense, more generally non-distinctive. Nor do I believe that the sign would be capable of performing the essential function of a trade mark without the relevant public being educated into seeing it that way. In my view, consumers would not consider the mark to be that of any particular supplier of parts and fittings for motor vehicles. It could be properly at home on any of them.

29. Anna Carboni, sitting as the Appointed Person in *Combi Steam* (O-363-09), conveniently summarised the leading case law in respect of this part of the Act:

"It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs "a residual or sweeping-up function", backing up the other

two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: Procter & Gamble Ltd's Trade Mark Application [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): Koninklijke KPN Nederland BV v Benelux-Merkenbureau Case C-363/99 (Postkantoor) [2004] ETMR 57 (ECJ) at [86]".

30. For reasons already given, I consider the sign to be descriptive of specific characteristics of the goods. It is clear from the above guidance that if a mark is entirely descriptive of characteristics of goods or services, it will also be devoid of any distinctive character under section 3(1)(b). As I have found that the mark in question is open to objection under section 3(1)(c) of the Act, it follows that it is also open to objection under section 3(1)(b) of the Act.

Applicant's claim to distinctiveness acquired through use

31. Amongst the spread of materials submitted over the past two years, there are four main sets of submissions that are most relevant to the applicant's claim that the mark has acquired distinctiveness through use. They are as follows:

- (i) The Witness Statement of Mr Bloore and exhibits JB1-JB10 filed in October 2008 by Fry, Heath & Spence.
- (ii) The letter from Mr Edward Lynton dated May 2009 which provided extensive background on the applicant - in particular, details of its history and repute within the world of motorsport.
- (iii) A second set of evidence supplied in December 2009, consisting primarily of advertisements from a selection of motorsport publication, and letters from individuals within the competitive motorsports sector which confirmed their recognition for the sign.
- (iv) A final set of evidence submitted prior to the *ex parte* hearing, consisting of further testimonial letters from those involved in motor racing, details of the applicant's company name registrations held at Companies House, and proof that the sign applied for is not recognised by English dictionaries.

32. At the hearing, I sought to set aside the submissions listed at (ii) above. Being made aware of the applicant's history was helpful in terms of providing context, and I cannot dispute the applicant's pedigree, or recognition for the sign from those small numbers active in the upper echelons of competitive motorsport. However, a company's goodwill alone cannot support a claim to acquired distinctiveness. It was important for me to therefore make the distinctions between on the one hand, the applicant company, and on the other, the use of the marks applied for.

33. On the issue of use, the evidence has clear shortcomings. In its favour, the first Witness Statement confirmed that the applicant has made longstanding use of the sign (around

30 years), and both the turnover figures and marketing spend are both fairly impressive. However, of all the exhibits submitted, I could find only three instances where the marks as filed (either or both) were being used. The first of these is an advertisement from 'Autosport' magazine dated February 2008 showing use of the sign 'Raceparts UK' (Exhibit JB2). The second is in Exhibit JB4 where page 1 of *one* of the catalogues presents the term 'raceparts' *solus* in its introductory paragraphs. Thirdly, the applicant's own website submitted as Exhibit JB8 contains some evidence of the term being used as filed.

34. Nearly all of the remaining exhibits in the first set of evidence show use of the sign 'Raceparts (UK) Ltd'. Although the abbreviation 'Ltd' conveys an obvious meaning in the context of goods and services being provided by a limited company, it nonetheless significantly changes the identity of the mark. Whereas the mark 'raceparts' denotes the *goods* being offered for sale, the sign primarily shown in the evidence denotes a *company* likely to be providing such goods. Whether the phrase 'Raceparts (UK) Ltd' is distinctive in its own right is immaterial. The primary question is whether a significant proportion of the relevant public have been exposed to the signs seeking protection - i.e. 'Raceparts' and 'Raceparts UK' - to the extent that they are perceived as denoting trade origin rather than any characteristic of the service. Demonstrating use in respect of the sign 'Raceparts (UK) Ltd' does not assist the applicant's case because it does not enable the Registrar to determine the answer to that primary question. The sign being shown in the evidence is *different* to the signs applied for.
35. Similar concerns affect the value of the second set of exhibits submitted in December 2009, where the vast majority of advertisements printed in the 'Autosport' publication between 1980 and 2009 show 'Raceparts (UK) Ltd'. The only advertisements showing the signs as applied for are from January 2008 and January 2009, both of which occur *after* the date of filing this application. Similarly, the advertisement from 'RaceTech' magazine shows the 'Ltd' marks, as do the invoices relating to the applicant's presence at the Birmingham trade shows.
36. Having set out my concerns with the 'conventional' evidence filed in support of the claim to acquired distinctiveness (i.e. details on the length of use, turnover, marketing spend, and exhibits etc.), I now turn to the supplementary trade evidence filed alongside the various exhibits. At the hearing, Mr Lynton encouraged me to place greater stock in the various testimonial letters submitted, on the basis that they are better reflectors of the applicant's goodwill and repute than are the examples of publicity material.
37. From the Registrar's point of view, the testimonial letters and other historical evidence of goodwill are of limited value. As documented above, one of the fundamental issues discussed at the hearing was identification of the relevant consumer. Notwithstanding the applicant's repute amongst some of the biggest names in Motorsport, the relevant public must be determined by reference to the services claimed. And as the customer of high performance and racing-standard automotive parts goes well beyond those limited to involvement in top class motor sport, any impact made by letters from the likes of Virgin Racing and Lotus Racing is tempered by the absence of any use showing the sign being directed towards the wider purchasing public. In some cases, evidence from the trade is often used to supplement more conventional evidence of acquired

distinctiveness where such evidence is perhaps not quite enough to support the claim. It is not the case that trade evidence is routinely used as a *substitute* for 'conventional' evidence, as is the case here. Without a solid base of materials showing that the mark *as filed* has been extensively used amongst the relevant public, I cannot place too great a value in the testimonial letters and other documents from the trade.

Post *ex-parte* Hearing

38. Although I did not formally refuse the mark at the hearing, I informed both Mr Lynton and Mr Bloore that the objections raised under sections 3(1)(b) and (c) were being maintained. I allowed a further two months for any further submissions they felt relevant, but expressed my difficulties in seeing how the objection might be overcome, and pointed out the difficulties in formulating a limited specification which would aid the applicant's case whilst also being in accordance with the law as set out in *Postkantoor*. Although the Registrar permits limitations which clearly reflect a particular sub-category of the goods and/or services claimed, limitations which relate solely and specifically to a sub-category of the customer base (as in, for example, *'retail services connected to high performance parts and fittings for racing vehicles, solely provided to Formula 1 racing teams'*) are not deemed a suitable means for overcoming an objection based on an absence of distinctiveness (or an inability to demonstrate acquired distinctiveness). Any assessment under section 3(1) has to be undertaken strictly by reference to the mark applied for and the goods/services intended for protection, and so to accept an otherwise unacceptable sign solely on account of limiting its specification to reflect the applicant's particular customer base fails to take in the true perception of the relevant consumer (which, as indicated at paragraph 24 above, is any number of auto enthusiasts seeking high performance vehicle parts).
39. On 16 February 2012, Mr Lynton wrote to IPO with further submissions. Those submissions can be summarised as follows:
- Between 2004 and 2005, the applicant began to transform its website into a full-blown e-commerce platform, and I was provided with annual turnover figures for the years 2005 through 2011 which demonstrated this growth. In 2005, the annual turnover of credit card sales exceeded £340,000; by September 2011 they had doubled to almost £680,000. This increase in sales was primarily the result of online trading, with most new customers coming from either the auto performance market or from 'track day' enthusiasts.
 - The applicant's website dominated search engine results generated by any and all online searches for the term 'raceparts', and that the combination of the three elements 'race', 'parts' and 'UK' is sufficiently distinctive in its totality.
 - The representative also repeated some points made by the applicant's previous agent, Fry Heath & Spence, in its letter of 11 May 2009, claiming that that the relevant public has learnt to associate the 'raceparts' sign with the applicant; that it was identified as being an indicator of trade origin; and that its use in advertisements combination with the abbreviation 'ltd' should not preclude its registration in the form as filed.

40. In my reply to this post-hearing correspondence (dated 4 May 2012) I reiterated points already made at the hearing, most notably that any submission of evidence in support of a claim to acquired distinctiveness should show both the *extent* of the use and the *nature* of the use, and that the evidence filed had failed to satisfy either. I had acknowledged that the applicant enjoyed reputation and goodwill amongst the relatively small group of customers engaged in high-level professional motorsport, but had also explained that the measuring of extent is undertaken strictly in the context of the goods or services claimed and not in the context of how specialised or limited the applicant's existing customer base might be.
41. The new information provided with Mr Lynton's letter of 16 February 2012 (i.e. *after* the *ex parte* hearing) had indicated the applicant's customer base had broadened beyond that demonstrated in evidence submitted before the hearing, and now included a much less specialist customer base. This still failed to persuade me that the mark had acquired distinctiveness - although the applicant's more recent figures show growth, they do not indicate any level of market dominance. Even more importantly, much of this new information related to commercial activity undertaken *after* the date of filing, and so could not be taken into account.
42. On the subject of the nature of the use I also reiterated my belief that addition of the suffix 'Ltd' to an otherwise descriptive or generic word can have reasonably significant effect upon the perception of the relevant consumer - particularly where a claim to acquired distinctiveness largely shows use of the sign intended for protection only in combination with that suffix. The sign 'Raceparts UK Ltd' conveys to the relevant consumer the impression of a limited company which no doubt trade in race parts. The signs 'Raceparts' and 'Raceparts UK' do not.
43. On 8 November 2012, Jensen & Son wrote to confirm that it had taken over as agent (now the third representative for this application), and proposed further specification amendments in order to overcome the objections. The agent supported these proposals by highlighting in even greater detail the distinctions between, on the one hand, 'everyday' motor enthusiasts who seek to customise their vehicles with high performance replacement parts and, on the other, professional motor sport competitors of the sort served by the applicant's business. The agent went on to supply a copy of EC Directive 2007/46 dated 5 September 2007 which establishes '*a framework for the approval of motor vehicles and their trailers, and of systems, components and separate technical units intended for such vehicles*' and which makes legal distinctions between vehicles intended for use on public highways and those intended for use on private racing circuits. The agent went on to propose amendments which, it was submitted, limited the applicant's goods to the latter, and excluded the former.
44. As with submissions from the previous representatives, I did not agree that the proposals to limit the specification overcame the objections raised, and went on to state that even if an acceptably-limited specification was agreed upon, the evidence still fails to demonstrate distinctiveness acquired through use.

45. Given the amount of time which had elapsed, and the amount of correspondence (both written and oral) which had been exchanged on this case, I finally refused the application under section 37(4) in my letter dated 29 January 2013.

Conclusion

46. In this decision, I have considered all documents filed by the applicant and agents, and all arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is refused because it fails to qualify under sections 3(1)(b) and (c) and 41(2) of the Act.

Dated this 30 day of July 2013

**Nathan Abraham
For the Registrar
The Comptroller-General**