

O-356-14

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NUMBER 3002172
BY SPABREAKS.COM LIMITED
TO REGISTER THE FOLLOWING TRADE MARK
IN CLASSES 35, 39, 41, 43:**

Spabreaks.com

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Background

1. On 16 April 2013, Spabreaks.com Limited ('the applicant') applied to register trade mark application number 3002172 consisting of the words 'Spabreaks.com' for the following services in classes 35, 39, 41, and 43:

Class 35: The bringing together, for the benefit of others, of a variety of travel products, namely printed publications, duty free goods and gift items, namely jewellery, clothing, fashion accessories, media players and consumer electronic devices and accessories, toys and games, cameras, personal grooming products, ornaments, writing implements, stationery, hand tools, bags, wallets and leather goods, confectionery enabling customers to conveniently view and purchase those goods in a retail store; the bringing together, for the benefit of others, of a variety of travel products, namely printed publications, duty free goods and gift items, namely jewellery, clothing, fashion accessories, media players and consumer electronic devices and accessories, toys and games, cameras, personal grooming products, ornaments, writing implements, stationery, hand tools, bags, wallets and leather goods, confectionery enabling customers to conveniently view and purchase those goods from a catalogue by mail order or by means of telecommunication; consultancy services relating to the acquisition of goods and services; business advisory and information services; provision of trade, business, economic and statistical information; business research services; compilation and provision of business information; dissemination of business information relating to financial markets.

Class 39: Travel and tourist services; arranging of cruises; arranging tours and excursions; agency services for arranging travel; reservation and booking services for travel and for tickets; advisory and information services relating to transportation and travel tourism, tour conducting and escorting, advisory and information services relating to transportation, travel and tourism; air transport, railway transport, car transport, bus transport, boat transport, truck transport; packaging of goods; freight brokerage, freight forwarding; tour conducting and passenger escort services; booking of seats and travel reservations for travel and for tickets; delivery of goods; parcel delivery; parking place rental; rental of cars, aeroplanes, ships and boats; services for the arranging of the transportation of travellers and for the warehousing of goods relating thereto; agency services for the arranging of transportation of goods.

Class 41: Sporting, leisure, entertainment, training and instructional services; provision of sports and recreational facilities; organising of entertainment, sports events and competitions; ticket reservation services; arranging and conducting of conferences and exhibitions; information and advisory services relating to the above services; health and fitness club services; exercise and fitness classes; gym club services; provision of swimming pool facilities; personal trainer services; cruise ship entertainment services; holiday camp services; cinema facilities.

Class 43: Travel agency services for booking accommodation; arranging of temporary accommodation; reservation of temporary accommodation; hotel and holiday accommodation services, being villas, homes, estates, apartments; hotel reservations; tourist office services (provision of temporary accommodation); booking/reservation of restaurants and holiday accommodation.

2. On 14 May 2013 the UK Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised against classes 39, 41 and 43 under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act') on the basis that (in the examiner's words):

"...(the sign is one which) may serve in trade to designate the kind of services e.g. services that provide the customer with information and the means to undertake a holiday or a short break at leading destination spas, health spas and spa resorts via an Internet website. The term Spabreak is commonly used in trade to describe the services applied for in the above classes and to that end I have attached a small number of references taken from the Internet that illustrate this point"

3. No objection was raised against class 35.

4. Although internet hits were mentioned by the examiner at examination stage, I can find no evidence of them on the file and I am placing no reliance on them for the purposes of the refusal and statement of grounds.

5. On 2 July 2013, a response from the applicant's representative was filed requesting an extension of time of 2 months, indicating that the applicant was looking to file evidence of acquired distinctiveness in support of the application, but was also in Australia at that time and so would benefit from the additional time. The extension was granted by IPO, with a later response date of 2 September 2014 being set.

6. On 6 September 2013, Mr Oliver Smith of Keystone Law representing the applicant requested by telephone a further extension of one month until 2 October 2013. No reason for this request was provided with the request, but the extension was granted nonetheless.

7. On 26 September 2013, a further extension of time was requested by telephone (again for undocumented reasons) and again was duly granted, with a response date of 3 December 2013 set.

8. No response was received from the applicant's representative within the date set and so the application was formally refused by way of the Registrar's letter dated 28 January 2014.

9. On 26 February 2014, IPO received a form TM5 (being a request for a statement of grounds for refusal) from the applicant's representative, Mr Smith. Although the applicant had initially expressed an intention to submit evidence in support of a claim to distinctiveness acquired through use, no such evidence ever materialised - not before expiry of the initial deadline of 14 July 2013 set by the Examination Report, nor before expiry of the later deadlines set by the three separate requests for additional time. As a result, I therefore have only the *prima facie* case to consider.

Decision

10. The relevant parts of section 3 of the Act read as follows:

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

(a) ...

(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,

(d) ...

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."

Legal principles – section 3(1)(c)

11. The relevant authorities at European and UK level have established certain key legal principles to be applied in relation to section 3(1)(c) of the Act. These can be summarised as follows:

- By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 (the equivalent of section 3(1)(c) of the Act) 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 the 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).

- It is also a well-established principle these days that the Registrar's role is to engage in a full and stringent examination of the facts, underling the Registrar's frontline role in preventing the granting of undue monopolies, see to that effect CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z.o.o. v. OHIM* [2011] ECR I-1541.
- 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 goods and services in question or one of their characteristics - see *CJEU Judgment C-468/01 P to C472/01 P 'Tabs'* at paragraph 39, and General Court Judgment T-222/02 *'Robotunits'* at paragraph 34.
- Refusal under section 3(1)(c) is not dependent upon the signs and/or indications of which the mark is composed being 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.
- The assessment of a sign for registrability must be made with reference to each discrete category of goods or services covered by an application for registration, see Case C-239/05 *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* [2007] ECR I-1455 at paragraphs 30 to 38; Case C-282/09 P *CFCMCEE v OHIM* 2010 ECR I-00000 at paragraphs 37 to 44.

Application of the legal principles

12. Firstly, I need to identify exactly who the relevant public or average consumer would be in this case. I consider that these services are accessible by all and are not specialised or aimed at a certain market or consumer. Therefore the average consumer will be the general public.

13. Although it is paramount that the assessment of the mark is based on its totality, it is also useful to first analyse the mark in regards to its constituent parts.

14. Any reasonable assessment should begin with reference to the intrinsic meaning of the words. The word 'spa' is defined in the Oxford Dictionary of English (3 ed.) as follows:

noun

- 1. *a mineral spring considered to have health-giving properties: [as modifier] : the Victorian spa town of Buxton.*
 - ■ *a place or resort with a mineral spring.*
 - ■ *a commercial establishment offering health and beauty treatment through such means as steam baths, exercise equipment, and massage.*

- **2. (also *spa bath* or *pool*) a bath containing hot aerated water.**

The word 'break' is defined in the same dictionary as meaning:

'a short holiday e.g.: a weekend break in the Cotswolds.'

The two words, considered in the order presented, would therefore create a readily understood meaning of a short holiday which includes the use of a spa, being *either* an aerated bath *or* an establishment offering health and beauty treatment including steam baths, pools or a combination of these elements (or both). In my opinion the average consumer, who is considered to be reasonably well informed and circumspect, would also arrive at this meaning on first impression of the mark. These dictionary meanings will reflect the average consumer's understanding of the two words 'spa' and 'breaks' in the context of the services applied for.

15. That said, the two words are conjoined. However, it is established that the conjoining of descriptive words, in and of itself, may not be sufficient to warrant registration (see, for example, *Feedbackmatters BL O/185/12*, along with General Court Cases T-30/99 *Investorworld* and T-270/02 *Bestpartner*). The question is whether the act of conjoining has the effect of creating a new word which is more than the sum of the individual parts (*BIOMILD* Case C-265/00). My view is that the term 'spabreaks' is naturally and immediately perceived as being comprised of the two descriptive words 'spa' and 'breaks', and that there is little perception of it being seen as a 'newly created' word, above and beyond the sum of the individual words. In this case, there is no perceptible difference or unusual variation from the pure descriptive words.

16. The next point to consider is the remaining element of the mark, '.com'. As to the question of the effect or otherwise of the '.com' element, according to recent statistics published by ABTA¹, 49% of people now book their holiday or short break via the internet. Given this information, it is very plausible to assume that a significant proportion of the general public would see nothing unique about so-called 'top level domain names' such as '.com' or '.co.uk' being combined with a descriptor of the travel or tourist service they require. I do not, therefore, consider that the addition of '.com' would have the effect of rendering the sign free from objection. The '.com' acts simply to indicate the availability of the service through the medium of an internet domain name. I find support for this conclusion in Case T-338/11 *Getty Images US, Inc. v OHIM*, in which the Court held that a combination of the two inherently non-distinctive components 'photos' and '.com' would be immediately recognisable as the normal structure of an internet site address, indicating that goods and services can be obtained or viewed online or are internet-related. In that case, the conclusion was reached on the basis that the word 'photos' immediately informs the relevant public that the goods and services relate to photography, whilst the '.com' element is both technical and generic.

17. The significance of the aforementioned case seems to me to be that, although a domain name may be 'unique' (in the sense that one single entity will hold proprietorship), that

¹ See <http://abta.com/news-and-views/news/abta-reveals-online-holiday-booking-habits>

aspect of uniqueness does not necessarily have any impact upon the registrability of a trade mark in terms of its inherent capacity to guarantee trade origin. The registration of a domain name and the assessment of a sign's capacity to denote trade origin (as part of attempting to register it as a trade mark) are two wholly separate and disparate processes. Were it otherwise, entirely descriptive words which happen to be accompanied by a top (or any other) level domain designation would gain the benefits of trade mark registration. The possession or use of a domain name, which in actuality is only an address or means of access, does not avoid the fact that the whole sign designates a characteristic of the relevant services.

18. Having assessed the individual elements which combine to form the sign, I now have to determine the extent to which that combination of elements creates a trade mark that would immediately be perceived by the average consumer as an indication of origin. In this case, the public would receive an immediate meaning from the words 'spa breaks' which would inform them of the *type* of the break or holiday being offered. With the addition of the '.com' being only a reference to the technical and generic means of accessing the services in question, to my mind the whole sign would simply describe to the consumer the nature of the services and the means of accessing them and would therefore fail to indicate the actual origin of those services.

19. In consideration of the scope of the objection in regards to the services applied, I am mindful of the *Sensornet* decision (BL O/136/06), and consider that the examiner has taken a pragmatic approach in regards to the extent of where the objection applies. In my opinion, the examiner was correct in only raising a partial objection and agreeing to accept the mark for the class 35 services, as it would be overzealous to consider that the mark would describe a characteristic of a retail service. However, as regards the remainder of the specification, namely classes 39, 41 and 43, the initial objection is credible, as the sign attaches itself neatly to the relevant services claimed. Class 39 covers travel and tourist services along with transportation. The average consumer when viewing the mark on these services would reasonably assume that the travel and tourist services in question encompass *either* a break to a spa *or* the travel services involved to arrive at such a destination (or both) which is bookable online. Class 41 covers inter alia the provision of sporting and leisure services, and so the sign would serve to directly describe the kind of those sporting and leisure services i.e. those which involve a break to a spa, again which are accessible online. Class 43, meanwhile, covers various travel agency services for booking accommodation; again this service relates directly to the sign as the kind and intended purpose of these services, allowing the average consumer to immediately perceive the nature of the services available.

20. For these reasons the application is refused under section 3(1)(c) of the Act.

Section 3(1) (b)

21. It is well established that a sign that is found to fall foul of section 3(1)(c) will, by definition, also be devoid of distinctive character under section 3(1)(b). It is also recognised that section 3(1)(b) can operate independently, and that signs which are not descriptive may nonetheless be devoid of distinctive character. This point was usefully summarised by Ms.

Anna Carboni, sitting as the Appointed Person in *COMBI STEAM*, BL O-363-09, paragraph 7:

“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 6 O-490-12 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].”

22. As regards this ‘residual or sweeping up function’, my view would be that even if the addition of the ‘.com’ element had the effect of taking the sign outside the scope of section 3(1)(c), the sign would nonetheless still be devoid of distinctive character under section 3(1)(b) only. That is to say, the average consumer would not see the elements, taken together, as performing the essential function of a trade mark by indicating the origin of the services. The sign as a whole will be perceived, simply, as the web address of any commercial undertaking offering ‘spa breaks’. For this reason the mark is also refused on the alternative basis under 3(1)(b).

Conclusion

23. In this decision I have considered all the papers on file and the submissions made. Taking all of these factors in to account, the objection under sections 3(1) (b) and (c) is maintained, and the application is refused on that principal basis for classes 39, 41 and 43.

Dated this 8th day of August 2014

**Sarah Grant
For the Registrar
The Comptroller General**