

O-049-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2343099
BY SW GOLF LIMITED TO REGISTER A
TRADE MARK IN CLASSES 18, 25 AND 28**

AND

**IN THE MATTER OF OPPOSITION
THERE TO UNDER NO. 93226 BY FAIRWAY OF COURSE LIMITED**

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by SW Golf Limited to register a trade mark
in Classes 18, 25 and 28**

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**IN THE MATTER OF Opposition thereto
under No. 93226 by Fairway Of Course Limited**

BACKGROUND

1. On 11 September 2003, SW Golf Limited applied to register the trade mark shown below:



2. The application, which included the following colour claim:

“The applicant claims the colours blue, green and yellow as an element of the mark”

was accepted and published for opposition purposes for the following range of goods:

Class 18: Golf umbrellas.

Class 25: Golf shoes, golf gloves, water proofs for golfing, golf clothing, golf tops, golf trousers, golf jackets, golf shorts, golf hats.

Class 28: Golf clubs, golf bags, tees, golf accessories.

3. On 28 February 2005, Fry Heath & Spence LLP acting as agents for Fairway Of Course Ltd filed a notice of opposition. The opposition is based on Sections 3(1)(b) and (c) of the Act. The Opponent express their attack in the following terms:

“The Opponent submits that the mark onlinegolf.co.uk which is the subject of the Opposed Application consists exclusively of a sign that would serve in trade to designate the kind and intended purpose of the goods specified in the Application. That is to say, goods which relate to golf which are available to buy or are accessible through the Internet “on line” or as it is commonly referred.”

4. On 4 March 2005, Groom Wilkes & Wright LLP acting as agents for the Applicant filed a counterstatement in which the grounds of opposition are denied. They do so in the following terms:

“In particular, the Applicant submits that the mark that forms the subject of Application No. 2343099 comprises a distinctive logo element; “onlinegolf” per se is distinctive for the goods for which registration is sought; and the Applicant has used the subject mark to the extent that the same is de facto distinctive (Section 3(1) proviso refers).”

5. Only the Opponent filed evidence in these proceedings; both parties ask for an award of costs. The parties were invited to say whether they wished to be heard; neither indicated a wish to do so. However, written submissions have been received on behalf of the Applicant from their Trade Mark Attorneys (their letter of 5 January 2006). Acting on behalf of the Registrar I give this decision.

EVIDENCE

Opponent’s Evidence

6. This consists of a Statutory Declaration dated 21 September 2005 by Alan Fry. Mr Fry explains that he is a partner in the firm of Fry Heath & Spence and has been a registered trade mark attorney for over twenty years.

7. He states that in his opinion:

- the instant application consists exclusively of a sign that would serve in trade to designate the kind and intended purpose of the goods specified in the application i.e. goods which relate to golf which are available to buy or are accessible through the internet “on line” as it is commonly referred;
- the instant application consists exclusively of the well recognised terms ONLINE, GOLF and domain part .CO.UK.

8. Mr Fry comments that in the context of general knowledge, the term ONLINE is well recognised as describing trading over the internet. To support this contention, he provides as Exhibit 1 a copy of the entry for “on-line” which he says appears in Chambers 21st Century Dictionary. He notes that the entry includes, *inter alia*, the following: “said of a service, etc: run with a direct connection to and interaction with a computer – on line shopping.

9. At Exhibit 2 he provides examples of printouts for searches conducted by his firm using the Google search engine for the terms “online shops”, “online clothes” and “online sports”. From this exhibit he concludes that the search engine used interprets “online shops” as those shops which are capable of being accessed “online” i.e. using the internet. He adds that in his opinion substituting “shops”, “clothes” or “sports” with the term “golf” would be interpreted to mean a golf shop or company that trades in golfing equipment which is accessible “online” i.e. using the internet. Such shops are, he says, commonly referred to as “online golf shops”. Exhibit 3 consists of a printout of a search conducted using the Google search engine for “online golf”. From this exhibit he concludes that in view of the many search entries for “online golf”, that the Applicant has not acquired distinctiveness of the term “online golf” through use.

10. Mr Fry states that in his view the term “.co.uk” is well recognised as part of a UK domain name and lends no distinctiveness to the overall mark. He adds that in his view, the style or colouring of the Applicant’s mark lends no distinctiveness to the mark particularly in view of the fact that the style or colouring is not taken into consideration for “online” or telephone sales.

11. That concludes my review of the evidence filed in these proceedings.

The Applicant's written submissions

12. The Applicant's written submissions are contained in the letter mentioned above. I will, for the most part, refer to them as necessary in my decision. That said, I note that in relation to the Opponent's evidence summarised above, they say, that in their view, the evidence submitted by the Opponent consists of opinion and presumption. Having referred to paragraph 7.3.1 of Chapter 15 of the Trade Marks Registry's Work Manual, which reads:

“Evidence needed to support a case under sections 3(1), 3(2) and/or 3(3) of the Act needs to demonstrate why the mark in suit cannot function as a trade mark and should not have been accepted. Where relevant this evidence could comprise such information as dictionary references (general or technical), expert evidence as to the meaning of words, evidence from the trade, examples of use of the word in the market-place. Evidence should be directed to the United Kingdom or explain why use in another jurisdiction is relevant.”

They conclude their written submissions on the following basis:

“The Statutory Declaration of Alan Valentine Fry dated 21 September 2005 is the only evidence which has been filed in support of this opposition and we consider that the paragraphs numbered 2, 3, 7 and 8 of the Statutory Declaration should be disregarded as inadmissible. These paragraphs consist entirely of the opinion of Alan Valentine Fry. The evidence put forward at paragraphs 4, 5 and 6 does not prove the Opponent's grounds of opposition. With regard to paragraph 4 of the Statutory Declaration we do not dispute the dictionary definition of the word “on-line.”

DECISION

13. The grounds of opposition are based on sub-paragraphs (b) and (c) of Section 3(1) of the Act. These read 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,

(d) Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or 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.”

Section 3(1)(c)

14. The Applicant has not filed any evidence in these proceedings. I have therefore only the inherent characteristics of their mark to consider.

15. There are a number of European Court of Justice judgments which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark 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* – Case 191/01P (Doublemint) paragraph 30;
- thus 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 – *Wm Wrigley Jr v OHIM*, 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 – *Wm Wrigley Jr v OHIM*, 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*, Case C-363/99 (Postkantoor), paragraph 57;
- if a mark which consists of a word produced by a combination of elements is to be regarded as descriptive for the purposes of Article 3(1)(c) it is not sufficient that each of its components may be found to be descriptive, the word itself must be found to be so – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, paragraph 96;
- merely bringing together descriptive elements without any unusual variations as to, for instance, syntax or meaning, cannot result in a mark consisting exclusively of such elements escaping objection – *Koninklijke Nederland v Benelux Merkenbureau*, paragraph 98;
- however such a combination may not be descriptive if it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements – *Koninklijke Nederland NV v Benelux Markenbureau*, paragraph 99.

16. The mark the subject of the application consists of the words online golf in lower case, with the letters .co.uk (in significantly smaller script) positioned at the foot of the letter “f” of the word golf. The mark also contains a triangular device above the letter “i” and a circle and curve device appearing at the end of the mark. The word “online” is presented in blue, the word “golf” and the letters “.co.uk” are presented in green, and the triangle, circle and curve devices are presented in yellow. I note that the applicant claims these colours as elements of the mark.

17. It is well established that the distinctive character of a mark must be assessed in relation to the goods for which registration is sought. In the present case, that is for a range of golf related goods in Classes 18, 25 and 28. The mark must also be assessed by how it is likely to be perceived by the average consumer which, in this case, I consider to be the general public.

18. In their written submissions, the Applicant comments on the ground of opposition based on Section 3(1)(c) of the Act. They do so in the following terms:

“Section 3(1)(c) provides that “trade marks which consist **exclusively** of ...” shall not be registered. This mark does not consist “exclusively” of such a sign or indication. This mark consists of words, devices and colours none of which designate any characteristics of the goods concerned.

In any event we wish to emphasise that this is **not** a service mark, it is a mark for goods and it must be assessed accordingly. The mark is not particularly strong for ‘services’ such as for example; retail services in respect of golfing equipment. However, this is irrelevant because this application does not cover any services. This application is concerned only with **goods** in classes 18, 25 and 28 and for goods even the trade mark ONLINE [word] is sufficiently distinctive to meet the requirements of Section 3, of course this mark comprises also a device element. This application does not therefore contravene the provisions of Section 3(1) c. The mark alludes to the nature of the goods concerned but it is not a mark which exclusively designates the characteristics of the goods.”

19. In addition to the words and letters “online golf.co.uk”, the instant application contains device elements both above the letter “i” and at the end of the mark, and the mark is presented (and the Applicant has claimed) three colours as an element of the mark. As such, the mark cannot, in my view, and (in the words of Section 3(1)(c) of the Act) “..consist exclusively of...” and the opposition based on Section 3(1)(c) of the Act is dismissed accordingly.

I now turn to the objection based on Section 3(1)(b) of the Act.

Section 3(1)(b)

20. 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*, Journal 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 (*Koninklijke KPN Nederland v Benelux Merkenbureau*, 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*).

21. In their written submissions, the Applicant comments on the ground of opposition based on Section 3(1)(b) of the Act in the following terms:

“Section 3(1) b provides that “trade marks which are devoid of any distinctive character” [emphasis added] shall not be registered. The mark that forms the subject of Application No. 2343099 consists of words and a device namely a triangle shaped device appearing above the letter ‘I’ in the word ‘online’ and a curved device and circle appearing at the end of the word “golf”. In addition to these devices the mark incorporates distinctive colouring in blue, green and yellow and these colours have been claimed as elements of the application. The mark is not therefore devoid of any distinctive character, the mark in its entirety is distinctive for the goods concerned.”

22. The Trade Marks Registry's published practice in relation to the distinctiveness of trade marks containing domain names appears in paragraph 28 of Chapter 6 of the Work Manual. It reads as follows:

“A domain name is a written representation of an Internet electronic address, e.g. www.patent.gov.uk, which is the Office's web site address. It is common-place for goods and services to be sold in the UK under such a name, i.e. the domain name is being used as a trade name or trade mark, and the Registrar will, subject to the usual criteria of the Act, permit domain names to be registered as trade marks.

Elements of the domain name such as ".com" or ".co.uk" are considered to be totally non-distinctive, much in the same way as "Ltd" and "Plc". As a general rule, one should consider whether the remainder of the mark is descriptive or non-distinctive; if so, there is likely to be an objection under Section 3(1)(b) of the Act.

There may be exceptions. For example TWIST AND SEAL would be liable to an objection for storage jars on the basis that it describes a characteristic of the goods, whereas the addition of ".COM" gives the sign as a whole a trade mark character.”

23. I note that in their written submissions the Applicant say: “With regard to paragraph 4 of the Statutory Declaration we do not dispute the dictionary definition of the word ‘on-line’.” Whilst keeping in mind the Applicant's comments on the nature of Mr Fry's evidence (see paragraph 12 above), in my view, exhibit 2 of Mr Fry's declaration and the conclusion he draws from it i.e. “It is clear that the search engine interprets “online shops” as those shops which are capable of being accessed “online” i.e. using the internet” is a reasonable one. I note for example references to: Want to shop? Online shopping is easy with Shopsafe, the UK shops directory; Amazon.com: Online shopping for electronics, apparel, music books..; UK Shopping Guide – online shops in the UK; Jigsaw online clothes store; Clothes UK Online Clothing Stores; Online Sports Home Page and Sports Equipment in Online Sporting Goods Stores.

24. Exhibit 3 to Mr Fry's Declaration consists of a search for the words "online golf" I note that this search revealed, *inter alia*, the following hits (other than the Applicant's web site): www.golffonline.com; Online Golf Games – Best Free Online Golf Games; Golf Today – Europe's Premier Online Golf Magazine; The Golf Warehouse – The Net's Premier Online Golf Superstore; GOLFMagic – the total online Golf resource and Online Golf Course at NabiscoWorld.

25. I should say that in reaching a conclusion, I do not rely on Mr Fry's evidence to any great extent. The searches were, it would appear, conducted on 22 June 2005 i.e. a little under two years after the material date in these proceedings; in addition, it appears that some of the "hits" may relate to non UK web sites. Had I not been provided with the information contained in the exhibits to Mr Fry's Declaration, it would, in my view, have been acceptable for me to have taken judicial notice of the meanings of the words "online" and "golf" and of the domain name identifiers ".co.uk". These meanings would, in my view, have been the same at the material date in these proceedings and would have been known by the average consumer as such.

26. Earlier in this decision I found that the device elements and colours present in the mark were sufficient for the Applicant to escape the ground of opposition based on Section 3(1)(c) of the Act. Does this conclusion assist them in relation to the ground of opposition based on Section 3(1)(b)? In my view, it does not.

27. It is clear from the authorities mentioned above, that (i) an objection based on Section 3(1)(b) of the Act operates independently of an objection under Section 3(1)(c) of the Act, (ii) that for a mark to possess a distinctive character it must identify the product for which registration is sought as originating from a particular undertaking and thus to distinguish that product from the products of other undertakings and (iii) that 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.

28. In my view, when combined in the form "online golf .co.uk", the words and letters appearing in the mark would do no more than to indicate to the average consumer the location of a business i.e. ".co.uk", a method of trading i.e. "online" and the area of trade in which the business is engaged i.e. "golf". In so far as the colours present in the mark are concerned, it is, in my view, commonplace for all manner of traders to present their marks in a range of colours and this presentational aspect does little, in my view, to add distinctive character to the mark as a whole. I take a similar view in relation to the device elements present in the mark. In my view, the triangle device appearing above the letter "i" is likely to go unnoticed and the size and positioning of the circle and curve device is an insufficient addition to the mark as a whole to render it distinctive.

Taking all these factors into account, the mark the subject of the application is, in my view, and when taken as a whole, devoid of any distinctive character and the opposition based on Section 3(1)(b) of the Act succeeds accordingly.

COSTS

29. The Opponent has succeeded and is entitled to a contribution towards its costs. I order the Applicant to pay to the Opponent the sum of £900. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of February 2006

C J BOWEN
For the Registrar
the Comptroller-General