

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 3791686

BY THE CHANCELLOR, MASTERS AND SCHOLARS OF THE UNIVERSITY OF
CAMBRIDGE

TO PROTECT THE FOLLOWING TRADE MARK IN CLASSES 9, 16, 41 and 42:

CAMBRIDGE

Background

1. On 24 May 2022 the Chancellor, Masters and Scholars of the University of Cambridge applied to register the above mark in the following classes:

Class 9: Teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines; fire-extinguishing apparatus; pocket calculators; sound transmitting apparatus; sound recording apparatus; sound reproduction apparatus; CD-ROMs; magnetic data media; magnetic tapes; magnetic disks; optical discs; optical data media; videotapes; computer software; downloadable computer software; educational software; computer programmes for interactive games or quizzes; computer software for communicating with users of hand-held computers; computer software in the field of electronic publishing; downloadable books; downloadable image files; downloadable text files; downloadable video files; downloadable exam papers; downloadable quizzes; downloadable assessment criteria; downloadable educational materials; downloadable periodical publications; downloadable journals; downloadable dictionaries; downloadable reference books; downloadable lecture notes; downloadable educational worksheets; downloadable slide presentations; downloadable flashcards; downloadable vocabulary lists; electronic publications, downloadable; printed publications in electronically readable form; printed publications in optically recorded form; databases; podcasts; talking books; downloadable publications; downloadable educational materials including exam papers, course materials and lecture notes; computer hardware; electrical components; mouse pads; sleeves for laptops; sleeves for tablet computers; sleeves for portable computers; cases for mobile phones, tablets or portable computers; computer software for the provision of training, education, examination and assessment including software for operation by remote computer access; magnetic, optical and other disks, magnetic tape and other media for electronically recording data or software carrying computer data or computer software for the provision of training, education, examination and assessment; parts and fittings for all the aforesaid goods.

Class 16: Paper, cardboard; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; arithmetical tables; atlases; biological samples for use in microscopy [teaching materials]; booklets; bookmarkers; books; calendars; cards; charts; comic books; diagrams; printed forms; geographical maps; handwriting specimens for copying; histological sections for teaching purposes; magazines [periodicals]; manuals; handbooks; newsletters; newspapers; pamphlets; periodicals; pictures; postcards; posters; printed publications; prospectuses; school supplies [stationery]; song books; stickers; teaching materials [except apparatus]; terrestrial globes; exercise books; bibles; printed awards; printed certificates; reference books; dictionaries; directories; reports; journals; exam papers; lecture notes; worksheets; quizzes; educational assessment criteria; flashcards; vocabulary lists; documents; forms; brochures; instructional and teaching materials in this class all relating to the training, testing, examination and assessment of candidates for educational achievement, and to the provision of training, testing, examination and assessment services, including computer assisted, computer mediated services and on-line services and to the provision of distance learning programmes; parts and fittings for all the aforesaid goods.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; academies [education]; boarding schools; schools; nursery schools; services of schools [education]; coaching [training]; education information; physical education; practical training; teaching services; educational services; instruction services; tuition; vocational guidance [education or training advice]; vocational retraining; adult education services; analysing educational test scores and data for others; arrangement of training courses; business educational services; business training; certification of education and training awards; computer assisted education services; computer assisted examination services; design of educational courses, examinations and qualifications; development of educational material; educational assessment services; educational examination services; academic examination services; educational research; provision of educational examination facilities; setting of educational standards; university education services; university services; provision of distance learning programmes; arranging and conducting of colloquiums, workshops [training], congresses, conferences, seminars and symposiums; correspondence courses; distance learning courses; organisation of competitions [education or entertainment]; organisation of exhibitions for cultural or educational purposes; arranging of festivals for educational purposes; club services [entertainment or education]; game services provided on-line from a computer network; holiday camp services [entertainment]; holiday camp services [education]; sport camp services; electronic desktop publishing; publishing consultancy services; advisory services relating to publishing; publishing services; electronic publishing services; providing electronic publications; publication of printed matter and printed publications; production of radio and television programmes; providing online electronic publications, not downloadable; publication of texts, other than publicity texts;

publication of books, reference books, directories, manuals, reports, magazines, journals, periodicals, dictionaries, exam papers, lecture notes, worksheets, quizzes, puzzles, examination marking criteria, pamphlets, booklets, flashcards, vocabulary lists and educational material including online publication; publishing; writing of texts, other than publicity texts; bibliographic information; language interpreter services; translation; lending libraries; mobile library services; providing museum facilities; teaching, examination and assessment services including computer assisted and computer mediated services and on-line services; information, advisory and consultancy services relating to the aforesaid services.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; research, testing and analysis services; computer-aided research, testing and analysis services; laboratory research, testing and analysis services; scientific research, testing and analysis; academic research, testing and analysis; agricultural research, testing and analysis; ecological research, testing and analysis; engineering research, testing and analysis; environmental research, testing and analysis; industrial research, testing and analysis; medical research, testing and analysis; technological research, testing and analysis; veterinary research, testing and analysis; agrochemical research, testing and analysis; archaeological research, testing and analysis; biological research, testing and analysis; chemical research, testing and analysis; physics research, testing and analysis; biochemical research, testing and analysis; biomedical research, testing and analysis; biotechnological research, testing and analysis; bacteriological research, testing and analysis; therapeutics research, testing and analysis; chemical engineering research, testing and analysis; civil engineering research, testing and analysis; electrical engineering research, testing and analysis; genetic engineering research, testing and analysis; historical research, testing and analysis; information technology research, testing and analysis; mechanical engineering research, testing and analysis; geological research, testing and analysis; mechanical research, testing and analysis; optical research, testing and analysis; astrophysical research, testing and analysis; pharmaceutical research, testing and analysis; urban planning research, testing and analysis; scientific research and development; medical research and development; engineering research and development; industrial research and development; agricultural research and development; technological research and development; pharmaceutical research and development; information technology research and development; communications research and development; research and development of new products for others; consultancy relating to research, testing, analysis and development in the fields of science, medicine, drug discovery, engineering, therapeutics, agriculture, technology, information technology, communications; providing technical advice in the fields of science, medicine, drug discovery, engineering, therapeutics, agriculture, technology, information technology, communications; preparation of scientific reports; preparation of industrial reports; preparation of medical reports; preparation of academic reports; preparation of technical reports; preparation of technological reports; preparation of engineering reports; preparation of agricultural reports;

preparation of ecological reports; preparation of environmental reports; preparation of historical reports; preparation of urban planning reports; providing advice, information and data relating to research, analysis, testing and development in the fields of science, medicine, drug discovery, engineering, therapeutics, agriculture, technology, information technology and communications; providing information and data relating to research, analysis, testing and development in the fields of science, medicine, drug discovery, engineering, therapeutics, agriculture, technology, information technology and communications from an on-line searchable database; computer-aided design; development and testing of computing methods, algorithms and software; software engineering; scientific surveys; drug discovery services; drug development services; clinical trials; DNA screening for scientific research purposes; genetic testing for scientific research purposes; topographical surveying; archaeological exploration; underwater exploration; creating and maintaining web sites for others; hosting web sites; IT consultancy; providing information on computer technology via a website; website design consultancy; designing, managing and monitoring online forums for discussion; creating electronically stored web pages for online services and the internet; hosting of digital content; information provided on-line from a computer database or from the internet; computer services; design of websites; online hosted computer services; managing web sites for others; constructing an internet platform for the exchange of information; providing an internet platform for the exchange of information; provision of a website containing information and advice relating to education, teaching, training and assessment; testing, authentication and quality control services; certification [quality control]; providing quality assurance services; process monitoring for quality assurance; accreditation services for developing, evaluating and test standards for the purpose of accreditation; software as a service [SaaS]; calibration [measuring]; cloud computing; computer programming; computer software design; computer system analysis; computer system design; computer software consultancy; computer technology consultancy; conversion of computer programs and data, other than physical conversion; creating and designing website-based indexes of information for others [information technology services]; data encryption services; digitization of documents [scanning]; electronic data storage; installation of computer software; maintenance of computer software; monitoring of computer systems by remote access; monitoring of computer systems to detect breakdowns; monitoring of computer systems for detecting unauthorized access or data breach; outsource service providers in the field of information technology; quality control; recovery of computer data; surveying; technical research; web site design consultancy; platform as a service [PaaS]; development of computer platforms; technological consulting services for digital transformation; artificial intelligence consultancy; providing scientific information, advice and consultancy relating to carbon offsetting; architectural services; land surveying; information, advisory and consultancy services relating to the aforesaid services.

2. On the 5 August 2022, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under section 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act') which reads as follows:

“The application is not acceptable in Classes 9,16,41,42. There is an objection under Section 3(1)(b) and (c) of the Act. This is because the mark consists exclusively of a sign which may serve in trade to designate the geographical origin or the subject matter of the goods/services e.g. education services offered in and around Cambridge or educational material on the general topic of Cambridge.

Cambridge is a city in East England with a population of around 149 thousand people. Given this sizable population it would not be appropriate to grant a monopoly on the term Cambridge itself as there exists a need to keep the term accessible for other traders. It is believed that when considered in the context of the relevant goods and services, the average consumer would perceive the term Cambridge as indicating the location of the services offered or see it as the point of geographical origin/subject matter of the goods.”

3. On the 4 October 2022 the appointed representative of the applicant, Stobbs requested a hearing.

4. The hearing took place on 31 October 2022 between Mr Stobbs (the attorney) and myself. Prior to the hearing Mr Stobbs submitted details of previous registrations owned by the applicant together with the evidence of use submitted in respect of those registrations. As this information was only submitted late on the day prior to the hearing I had not had a chance to look at it prior to the hearing. Mr Stobbs informed me that, in respect of an earlier application, he had suggested a territorial limitation which he did not feel had been fully addressed. This limitation request was not a geographical limitation but a condition of registration that the rights conferred by registration would not apply in Cambridge or the surrounding area. Mr Stobbs pointed out that if, for example, a school or nursery was called Cambridge in maybe East Anglia or Sheffield the average consumer would not see this as being descriptive and would see it as a trade mark. I reserved my opinion at the hearing in respect of this in order that I could consider the matter further.

5. Regarding the earlier ‘Cambridge’ marks which had been accepted on the basis of distinctiveness acquired through use, I informed Mr Stobbs that I was happy for this application to proceed on the basis of distinctiveness acquired through use for those goods and services which have already been accepted under applications 3523931 and 3243445 if he confirmed in writing that the use of the mark on those goods and services has been ongoing. Mr Stobbs then referred to goods such as computer software which would not be considered descriptive if the software was limited and I agreed to look at any limitation that was put forward.

6. At the hearing the discussion mainly revolved around the request for a territorial limitation and there was little discussion about the inherent acceptability of the mark, but for completeness I felt that I should address that in my hearing report. The geographical name ‘Cambridge’ is well known throughout the UK and worldwide. I appreciate that much of this renown will be because of the university, i.e. the applicants. However, for many of the goods and services I consider consumers will only identify the name as being that of a geographical location and not that of a trade mark. In this respect I refer to decision of the High Court in *Canary Wharf* (Case CH/2014/0564) in particular paragraph 29:

29.But the ‘need to keep free’ principle is not limited to use of a geographical name in respect of which the goods or services for which a particular area is already famous. On the contrary it can cover the use of the name in respect of services for which it has never been used before. The question is simply whether it is reasonable to assume that the name is capable of indicating geographical origin.

7. Regarding the suggested territorial limitation I did not agree that this overcame the objection, see my rationale for this below at paragraphs 10 and 26.

8. I maintained the objection against those goods and services for which no evidence of use has previously been received (details given at Annex A) and allowed two months for the Attorney’s response.

9. Following this the Attorney asked me to reconsider my decision regarding the request that a territorial limitation be added to the above application under the provision of Section 13(1)(b) of the Trade Mark Act 1994 i.e.:

13 (1) An application for registration of a trade mark, or the proprietor of a registered trade mark, may –

(a) ..

(b)

(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation.

In my hearing decision I considered that a territorial limitation would not be ‘Postkantoor’ compliant (C 363/99) as such a limitation would lead to legal uncertainty on the part of other traders as it would be unclear to them that the registered rights did not extend to Cambridge. I reconsidered my decision, as in the Postkantoor decision it was considered that if a mark is registered only in so far that the goods or services do not possess a particular characteristic that would create legal uncertainty as to the extent of protection offered by the mark. On reconsideration I felt that the Postkantoor decision, which relates to the limitation of specifications, would not extend to territorial limitations which are clear and applied through a condition of registration, rather than a limitation to the specification. I informed the Attorney that I would be prepared to add a territorial limitation to the application under Section 13(b) of the Act, and asked for his suggestions as to the wording of it, but pointed out that it would not overcome the objection raised under Section 3(1) of the Act.

10. On the 5 June 2023 the attorney submitted a form TM12 to divide the application into two parts, one part including those goods and services which have already been accepted on the basis of distinctiveness acquired through use and the other part to include those goods and services which have been deemed to be objectionable. The division covers application 3926090 for those goods and services which have already been accepted on the basis of use and those goods which can be considered to be covered by the wide terms in the specification. See Annex A for

those goods. That application has proceeded to advertisement. This leaves the following goods and services in this remaining application:

Class 9 – Electrical components

Class 41 - Education; providing of training; entertainment; sporting and cultural activities; academies [education]; boarding schools; schools; nursery schools; services of schools [education]; coaching [training]; education information; physical education; practical training; teaching services; educational services; instruction services; tuition; vocational guidance [education or training advice]; vocational retraining; adult education services; arrangement of training courses; business educational services; business training; computer assisted education services; provision of educational examination facilities; provision of distance learning programmes; arranging and conducting of colloquiums, workshops [training], congresses, conferences, seminars and symposiums; correspondence courses; distance learning courses; organisation of competitions [education or entertainment]; organisation of exhibitions for cultural or educational purposes; arranging of festivals for educational purposes; club services [entertainment or education]; game services provided on-line from a computer network; holiday camp services [entertainment]; holiday camp services [education]; sport camp services; production of radio and television programmes; language interpreter services; translation; lending libraries; mobile library services; providing museum facilities.

Class 42 - Creating and maintaining web sites for others; hosting web sites; IT consultancy; providing information on computer technology via a website; website design consultancy; designing, managing and monitoring online forums for discussion; creating electronically stored web pages for online services and the internet; hosting of digital content; information provided on-line from a computer database or from the internet; computer services; design of websites; online hosted computer services; managing web sites for others; constructing an internet platform for the exchange of information; providing an internet platform for the exchange of information; provision of a website containing information and advice relating to education, teaching, training and assessment; testing, authentication and quality control services; certification [quality control]; providing quality assurance services; process monitoring for quality assurance; accreditation services for developing, evaluating and test standards for the purpose of accreditation; software as a service [SaaS]; calibration [measuring]; cloud computing; computer programming; computer software design; computer system analysis; computer system design; computer software consultancy; computer technology consultancy; conversion of computer programs and data, other than physical conversion; creating and designing website-based indexes of information for others [information technology services]; data encryption services; digitization of documents [scanning]; electronic data storage; installation of computer software; maintenance of computer software; monitoring of computer systems by remote access; monitoring of computer systems to detect breakdowns; monitoring of computer systems for detecting unauthorized access or data breach; outsource service providers in the field of information technology; quality control; recovery of computer data; surveying; technical research; web site design consultancy;

platform as a service [PaaS]; development of computer platforms; technological consulting services for digital transformation; artificial intelligence consultancy; providing scientific information, advice and consultancy relating to carbon offsetting; architectural services; land surveying; information, advisory and consultancy services relating to the aforesaid services.

11. On the same date that the request to divide the application was received, i.e. 5 June 2023, the attorney submitted a form TM5 requesting a statement of reasons for the Registrar's decision to maintain the objection in respect of the original application 3791686. I am now asked under Section 76 of the Trade Marks Act 1994 and Rule 69 of the Trade Mark Rules 2008, to state the grounds of my decision and the material used in arriving at it. No formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness in respect of the goods and services remaining in this application, therefore I only have the prima facie case to consider.

The Law

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

3(1) The following shall not be registered –

(a) ...

(b) trade marks which are devoid of 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.

The relevant legal principles – section 3(1)(c)

13. There are a number of judgments from the CJEU which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 (recoded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1)(c) of the Community Trade Mark Regulation (the 'CTMR'), whose provisions correspond to section 3(1)(c) of the UK Act. For the avoidance of doubt, it is noted that the Trade Marks Act 1994 is largely derived from EU law (Directive 2015/2436). In relation to the interpretation of such retained law, the case law of the Court of Justice of the European Union (CJEU) (including the General Court) issued before the end of the transition period continues to apply, and is binding, as retained EU case law under section 6 of the Withdrawal 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*, C191/01P ‘Doublemint’, paragraph 30);
- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest, namely that signs or indications relating to the categories of goods or services in respect of which registration is sought may be freely used by all. The provision therefore prevents such signs or indications from being reserved to one undertaking alone because they have been registered as trade marks (see judgment of 4 May 1999 in Joined cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots-und Segelzubehör Walter Huber and Franz Attenberger (Chiemsee)* [1999] ECR I2779, at paragraph 25).
 - It is also a well-established principle that the Registrar’s role is to engage in a full and stringent examination of the facts, underlying 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 (*Technopol*).
 - 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 and services in question; it is sufficient that it could be used for such purposes (*Doublemint*, paragraph 32);
 - When determining whether a sign is devoid of distinctive character or is descriptive of the goods or services in respect of which registration is sought, it is necessary to take into account the perception of the relevant consumer who is reasonably well-informed and reasonably observant and circumspect (*Matratzen Concord AG v Hukla Germany SA*, C421/04);
 - There must be a sufficiently direct and specific relationship between the sign and the goods in question to enable the relevant consumer immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics (*Ford Motor Co v OHIM*, T67/07);
 - It is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods and services. The word ‘exclusively’ in Paragraph (c) is not intended 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);
 - However, section 3(1)(c) does not preclude the registration of geographical names which are unknown to the relevant class of persons (or at least unknown as the designation of a geographical location), or of names in respect of which, because of the type of place they designate, such persons are unlikely to

believe that the category of services concerned originates there (see Chiemsee at paragraph 33).

14. The leading authority in relation to geographical names and section 3(1)(c) of the Act is the judgment of the Court of Justice of the European Union (“CJEU”) in *Windsurfing Chiemsee Produktions-und Vertriebs GmbH (WSC) v Boots-und Segelzubehor Walter Huber and Franz Attenberger* (Joined cases C-108/97 and C109/97) (“Windsurfing”):

“24. It should first of all be observed that Article 3(1)(c) of the Directive provides that registration is to be refused in respect of descriptive marks, that is to say marks composed exclusively of signs or indications which may serve to designate the characteristics of the categories of goods or services in respect of which registration is applied for.

25. However, Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

26. As regards, more particularly, signs or indications which may serve to designate the geographical origin of the categories of goods in relation to which registration of the mark is applied for, especially geographical names, it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response.

27. The public interest underlying the provision which the national court has asked the Court to interpret is also evident in the fact that it is open to the Member States, under Article 15(2) of the Directive, to provide, by way of derogation from Article 3(1)(c), that signs or indications which may serve to designate the geographical origin of the goods may constitute collective marks.

28. In addition, Article 6(1)(b) of the Directive, to which the national court refers in its questions, does not run counter to what has been stated as to the objective of Article 3(1)(c), nor does it have a decisive bearing on the interpretation of that provision. Indeed, Article 6(1)(b), which aims, inter alia, to resolve the problems posed by registration of a mark consisting wholly or partly of a geographical name, does not confer on third parties the right to use the name as a trade mark but merely guarantees their right to use it descriptively, that is to say, as an indication of geographical origin, provided that it is used in accordance with honest practices in industrial and commercial matters.

29. Article 3(1)(c) of the Directive is not confined to prohibiting the registration of geographical names as trade marks solely where they designate specified

geographical locations which are already famous, or are known for the category of goods concerned, and which are therefore associated with those goods in the mind of the relevant class of persons, that is to say in the trade and amongst average consumers of that category of goods in the territory in respect of which registration is applied for.

30. Indeed, it is clear from the actual wording of Article 3(1)(c), which refers to '...indications which may serve ... to designate ... geographical origin, that geographical names which are liable to be used by undertakings must remain available to such undertakings as indications of the geographical origin of the category of goods concerned.

31. Thus, under Article 3(1)(c) of the Directive, the competent authority must assess whether a geographical name in respect of which application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future.

32. In the latter case, when assessing whether the geographical name is capable, in the mind of the relevant class of persons, of designating the origin of the category of goods in question, regard must be had more particularly to the degree of familiarity amongst such persons with that name, with the characteristics of the place designated by the name, and with the category of goods concerned.

33. In that connection, Article 3(1)(c) of the Directive does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons — or at least unknown as the designation of a geographical location or of names in respect of which, because of the type of place they designate (say, a mountain or lake), such persons are unlikely to believe that the category of goods concerned originates there.

...

36. Finally, it is important to note that, whilst an indication of the geographical origin of goods to which Article 3(1)(c) of the Directive applies usually indicates the place where the goods were or could be manufactured, the connection between a category of goods and a geographical location might depend on other ties, such as the fact that the goods were conceived and designed in the geographical location concerned."

15. I have also taken into account the consequences for third parties of granting the applicant a monopoly. In *Linde A.G. v Rado Uhren A.G.* Case C-53/01 the following guidance was given at paragraphs 73 – 74:

"73. According to the Court's case-law "Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of 12 which registration is applied for may be freely used by all, including as

collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see to that effect, Windsurfing Chiemsee, paragraph 25).

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

16. It is clear from the aforementioned case law that I must determine whether or not the mark applied for will be perceived by the relevant consumer as a means of directly designating the characteristic of the goods being provided. In this case, the characteristic being the geographical origin of the goods and services. In order to do this, I must assess who I consider the relevant consumer to be.

17. The application covers a wide range of goods and services and the relevant consumer would consist of not only the general public for services such as nursery services and library services, for example, but also those working in the educational sector who would be involved in services such as education and training and research services. The level of attention will vary depending on the consumer; however, I consider that it is reasonable to assume that the prospective purchaser of the applicant's goods and services would apply at least a moderate level of attention and circumspection when considering whether or not to purchase.

18. Having assessed who the average consumer would be, assuming notional and fair use, I must determine whether or not the mark applied for will be viewed by the average consumer as a means of directly designating essential characteristics of the goods and services being provided. The mark consists of the geographical name 'Cambridge' and I have to ascertain the average consumers' familiarity with the geographical name in question, the characteristics of the place designated by that name and with the goods and services concerned. As stated in the Chiemsee decision referred to above "where there is currently no association in the mind of the relevant class of persons between the geographical name and the category of goods in question, the competent authority must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods: in making that assessment, particular consideration should be given to the degree of familiarity amongst the relevant class of persons with the geographical name in question, with the characteristics of the place designated by that name, and with the category of goods concerned"

19. The Oxford online dictionary defines 'Cambridge' as "*the main city and administrative centre of Cambridgeshire, England, on the River Cam. It is famous for its university, the second oldest in Britain, and is visited by many tourists.*" The name is well known throughout the UK and worldwide. I appreciate that much of this renown will be because of the university, i.e. the applicant. However, for many of the goods and services I consider consumers will only identify the name as being that of a geographical location and not that of a trade mark. In this respect I refer to

decision of the High Court in *Canary Wharf* (Case CH/2014/0564) in particular paragraph 29:

29.But the 'need to keep free' principle is not limited to use of a geographical name in respect of which the goods or services for which a particular area is already famous. On the contrary it can cover the use of the name in respect of services for which it has never been used before. The question is simply whether it is reasonable to assume that the name is capable of indicating geographical origin.

20. Cambridge is not only well known for its university, Cambridge has a diverse economy with strength in sectors such as research and development and software consultancy. Cambridge and the surrounding area are sometimes referred to as 'Silicon Fen', an allusion to 'Silicon Valley' because of the density of high-tech businesses that have developed on science parks around the city. The following are just some references to this:

<https://tbtech.co/business/leadership/cambridge-is-the-new-silicon-valley-andmore/>

But although California's Bay Area has experienced an era-defining transformation over the last half-century, the rise of Silicon Valley is by no means unique. In fact, just a mere 50 miles north of London, the 800-year-old university city of Cambridge is rapidly becoming known as the tech capital of Europe.

With a startup scene burgeoning over the past decade, Cambridge is home to 5,000 tech companies, employing around 68,000 employees, and generating over £12bn in turnover every year. This melting pot of tech innovation, also dubbed the 'Cambridge Cluster', dates back to the 1960s and is one of the oldest and most successful concentrations of tech companies in Europe.



<https://www.cambridge-news.co.uk/news/cambridge-news/what-is-silicon-fen-cambridge-23115655>

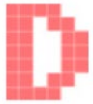
What is the Cambridge phenomenon? It was nicknamed so because it happened spontaneously through independent initiatives in 1960, when the city saw an incredible explosion of technology, life sciences and service companies.

During the first half of the 20th century the city lacked an industrial sector like the car manufacturers of Oxford, but that was all to change.

The founding of the [Cambridge Science Park](#) kick-started a wave of new business in 1970 and in the five years leading to 1998 there were more than 1,000 high-tech companies who set up shop in the area.

That's when the region started to begin to be referred to as the Cambridge Cluster, before it was called 'Silicon Fen' after Silicon Valley in California, because it lies at the southern tip of the English Fenland.

<https://citywire.com/wealth-manager/news/can-cambridge-become-the-uk-sanswer-to-silicon-valley/a1319343>



ubbed the Silicon Fen, Cambridge has established a burgeoning reputation as a growing powerhouse of hi-tech over the past decade, with a raft of tech and life science start-ups emerging from the internationally renowned research facilities at the its prestigious university.

The city has long been known as a hub of creativity and ideas which have gone on to change the world. Perhaps most famously of all, it was where James Watson and Francis Crick first discovered the structure of DNA back in 1953.

But in recent years, its flourishing science parks have increasingly attracted the attention of both tech investors and global giants alike. Microsoft, Amazon, Samsung and AstraZeneca all have bases in Cambridge, while between 2013 and 2017 the university's many spinouts raised \$2.2bn (£1.7bn) between them, according to figures from Global University Venturing. 'This success is based on the coming together of an eco-system which has been decades in the making,' said Paul Jourdan, chief executive at Amati Global Investors.

21. As I stated in my hearing report, services such as library services, surveying services, museum services and nursery services, for example, are all services that are usually provided locally and therefore consumers would likely to see the word 'Cambridge' as descriptive of the geographical origin of such services.

22. In the Canary Wharf decision ([2015] EWHC 1588 (Ch), the Court concluded that given the nature and in particular, extent of the area and the nature of goods and services it seemed reasonable to assume that the relevant consumer could see the words as designating a characteristic (geographical location or origin) of the goods or services. The decision in Canary Wharf therefore confirms the consideration of public interest in marks incorporating a geographical location, whether or not there currently exists, or in the future is likely to exist, an association between that location and the goods or services on offer. I find that, on seeing the mark, consumers will perceive immediately a descriptive message indicating that the goods and services provided are from Cambridge and others should be free to use the word Cambridge in the course of trade. As stated above, the Windsurfing decision at Paragraph 32 states that, in assessing whether the name is capable of designating the origin of the goods, regard must be had to the fame of the geographical name, familiarity with the characteristics of the place, and familiarity with the goods or services. In respect of 'Cambridge' it is famous for university educational services and scientific research provided by the university i.e. by the applicants and it also has a tourist industry. It is therefore likely that consumers, when seeing the word in connection with university services for example, would see the sign as indicating those services provided by the applicant but in respect of other services which are likely to be considered those

provided locally consumers are likely to see the word as relating to the geographic place Cambridge and not see it as a trade mark.

23. Regarding Mr Stobbs's comments that if a consumer saw the word 'Cambridge' on a school or nursery in Sheffield, for example, they would not consider that to be descriptive, but would see it as a trade mark. I do not agree, in view of Cambridge's reputation in the educational field and the applicant's reputation regarding university education, I think it is likely that consumers would consider that those schools and nurseries had a connection to Cambridge and would not see the sign as a trade mark.

24. I must now address the territorial limit requested by the applicant. In respect of an earlier application, Mr Stobbs had suggested a territorial limitation which he did not feel had been fully addressed. This limitation is not a geographical limitation but a condition of registration that the rights conferred by registration would not apply in Cambridge or the surrounding area. Mr Stobbs pointed out that if, for example, a school or nursery was called Cambridge in maybe East Anglia or Sheffield the average consumer would not see this as being descriptive and would see it as a trade mark.

25. This limitation had been considered by the hearing officer for application 3523931 who stated:

"I note that you are considering dividing out the objected to services in Class 41 and applying a geographical limitation to the divided-out application, however, having considered your proposal I regret that such a limitation would not satisfactorily overcome the absolute grounds objection raised under section 3(1)(b)&(c).

If I am correct, you are not requesting a geographical limitation to the specification of services but are requesting that the rights conferred by any potential registration would be subject to the specified territorial limitation. If that is the case, then such a territorial limitation has the same effect as adding a geographical limitation to the specification, that is, it will exclude services that have the characteristic of being located in or originating from Cambridge. Such an exclusion is not 'Postkantoor' compliant because it would simply lead to legal uncertainty on the part of other traders as it would be unclear to them that the registered rights did not extend to Cambridge. Section 3(1)(c) is underpinned by the 'need to keep free' but a sign must also be capable of distinguishing the goods and services as originating from a particular undertaking. If the application was subject to a geographical limitation which excluded protection in Cambridge, it is my view that consumers would still perceive the mark CAMBRIDGE as describing where those services emanate. They will expect the services to have some connection with the city of Cambridge and they will therefore not perceive it as designating the services of a single undertaking. The geographical location 'Cambridge' does not become distinctive simply because the services may be provided elsewhere."

I agreed with those comments and in this respect, I took into account the

comments made in the decision of *COMPANYLINE* (C-104/00) at paragraph 81:

"I wholly concur with the views expressed by the Office in its defence: nothing in the Regulation requires a sign to be assessed more leniently on the basis of other provisions limiting the protection afforded by descriptive signs."

26. As the previous hearing officer stated 'consumers would still perceive the mark *CAMBRIDGE* as describing where those services emanate. They will expect those services to have some connection with the city of Cambridge.' Consumers would not be aware of any conditions of registration and other producers of similar goods and services would not be aware if they were infringing the mark or not. In this respect I refer to the comment of Robin Jacob Esq. Q.C, in his decision on behalf of the Secretary of State in *Colorcoat Trade Mark* [1990] R.P.C. 511:

"That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see e.g. Yorkshire Copper Work Ltd.'s Trade Mark 20 Application (1954) R.P.C. 150 at 154 lines 20-25 per "Viscount Simonds LC". Essentially the reason is that the privilege of a monopoly should not be conferred where it might require "honest men to look for a defence".

27. When asked to reconsider my decision regarding this I came to the conclusion that the limitation was Postkantoor compliant. The Postkantoor decision, which relates to the limitation of specifications, would not extend to territorial limitations which are clear and applied through a condition of registration, rather than a limitation to the specification. However, this limitation would not assist in overcoming the objection raised under Section 3(1), in this respect I must take into account the comments made in the decision of *COMPANYLINE* (C-104/00) referred to above.

28. I have also taken into account the comments of Geoffrey Hobbs in decision O-287-15 where at paragraph 19(4) he stated:

"The fact that a defence to infringement is available for descriptive use of a sign in accordance with honest practices in industrial or commercial matters has no decisive bearing or intrinsic role to play in relation to the exclusion from registration; there is accordingly no interplay to be considered as between the scope of the exclusion from registration and the scope of the exclusion from liability for infringement of the rights conferred by a valid registration: Technopol paras. [59] to [62]."

Those paragraphs from *Technopol* state:

59 As regards Article 12(b) of Regulation No 40/94, the Court has had occasion to point out that the rule set out in that provision does not have a decisive bearing on the interpretation of the rule set out in Article 7(1)(c) of that regulation (see,

with regard to the identical provision laid down in Article 6 of Directive 89/104, Windsurfing Chiemsee, paragraph 28).

60 As the General Court rightly stated in paragraph 32 of the judgment under appeal, Article 12 of Regulation No 40/94 concerns the limits on the effects of a Community trade mark, whereas Article 7 of that regulation relates to the grounds for refusal to register signs as marks.

61 Contrary to what Technopol appears to be suggesting, the fact that Article 12(b) of Regulation No 40/94 ensures that every trader may freely use indications relating to the characteristics of goods and services in no way limits the scope of Article 7(1)(c) of that regulation. On the contrary, that fact clearly discloses the need for the ground of refusal set out in Article 7(1)(c) of Regulation No 40/94 – which, moreover, is an absolute ground for refusal – to be actually applied to any sign which may designate a characteristic of the goods or the services in respect of which its registration as a mark is sought (see, to that effect, as regards Article 6 of Directive 89/104, Case C-104/01 Libertel [2003] ECR I-3793, paragraphs 58 and 59, and, as regards Article 12 of Regulation No 40/94, Case C-64/02 P OHIM v Erpo Möbelwerk [2004] ECR I-10031, paragraph 45).

62 Since the rule set out in Article 12(b) of Regulation No 40/94 plays no intrinsic role, therefore, in the application of Article 7(1)(c) of that regulation, the argument relating to the interplay between those two provisions is unfounded.

29. A territorial limitation may help in infringement matters, for example in the COMPANY SHOP decision (O-005-07) a territorial limitation was used to overcome a Section 5 objection where two businesses were operating in different geographical areas largely without difficulty. However, I do not consider a territorial limitation would overcome a descriptiveness objection, if this was the case then all geographical objections could be overcome in this way. We have to take into account the perception of the average consumer who would not be aware that the mark in question was subject to any limitations of registration. I believe that they would take the mark at face value and seeing the word 'Cambridge' on goods and services would merely see it as an indicator of the geographical origin or subject matter of the goods and services.

30. The application has been refused under sections 3(1)(b) and 3(1)(c). It is clear that if a mark is entirely descriptive of characteristics of the goods and services, it will also be devoid of distinctive character under section 3(1)(b). As I have concluded above that the mark 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. The objection taken under 3(1)(b) is solely on the basis that the marks designate a characteristic of the goods and services and for no other reason. In other words, the objections under section 3(1)(b) and (c) in this case are co-extensive; there is no independent, contingent or separate rationale required under section 3(1)(b)

31. For the reasons given above, I consider the sign to be descriptive of the geographical origin of the goods and services pursuant to section 3(1)(c) and, by inference, also devoid of any distinctive character. The application is therefore

refused under the terms of section 37(4) of the Act because it fails to qualify under sections 3(1)(b) and 3(1)(c).

Dated 18 July 2023

Linda Smith

For the Registrar
The Comptroller-General

Annex A

Class 9

Magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; CD-ROMs; magnetic data media; magnetic tapes; magnetic disks; optical discs; optical data media; videotapes; computer software; downloadable computer software; educational software; podcasts; talking books; computer hardware; electrical components; provision of training and education; magnetic, optical and other disks, magnetic tape and other media for electronically recording data or software carrying computer data or computer software for the provision of training, education.

Class 41

Education; providing of training; entertainment; sporting and cultural activities; academies [education]; boarding schools; schools; nursery schools; services of schools [education]; coaching [training]; education information; physical education; practical training; teaching services; educational services; instruction services; tuition; vocational guidance [education or training advice]; vocational retraining; adult education services; arrangement of training courses; business educational services; business training; computer assisted education services; provision of educational examination facilities; provision of distance learning programmes; arranging and conducting of colloquiums, workshops [training], congresses, conferences, seminars and symposiums; correspondence courses; distance learning courses; organisation of competitions [education or entertainment]; organisation of exhibitions for cultural or educational purposes; arranging of festivals for educational purposes; club services [entertainment or education]; game services provided on-line from a computer network; holiday camp services [entertainment]; holiday camp services [education]; sport camp services; publication of printed matter; production of radio and television programmes; publication of directories, manuals, reports, journals, quizzes, puzzles and pamphlets; language interpreter services; translation; lending libraries; mobile library services; providing museum facilities.

Class 42

creating and maintaining web sites for others; hosting web sites; IT consultancy; providing information on computer technology via a website; website design consultancy; designing, managing and monitoring online forums for discussion; creating electronically stored web pages for online services and the internet; hosting of digital content; information provided on-line from a computer database or from the internet; computer services; design of websites; online hosted computer services; managing web sites for others; constructing an internet platform for the exchange of information; providing an internet platform for the exchange of information; provision of a website containing information and advice relating to education, teaching, training and assessment; testing, authentication and quality control services; certification [quality control]; providing quality assurance services; process monitoring for quality assurance; accreditation services for developing, evaluating and test standards for the purpose of accreditation; software as a service [SaaS]; calibration [measuring]; cloud computing; computer programming; computer software design; computer system analysis; computer system design; computer software consultancy; computer technology consultancy; conversion of computer programs and data, other than physical conversion; creating and designing website-based indexes of

information for others [information technology services]; data encryption services; digitization of documents [scanning]; electronic data storage; installation of computer software; maintenance of computer software; monitoring of computer systems by remote access; monitoring of computer systems to detect breakdowns; monitoring of computer systems for detecting unauthorized access or data breach; outsource service providers in the field of information technology; quality control; recovery of computer data; surveying; technical research; web site design consultancy; platform as a service [PaaS]; development of computer platforms; technological consulting services for digital transformation; artificial intelligence consultancy; providing scientific information, advice and consultancy relating to carbon offsetting; architectural services; land surveying; information, advisory and consultancy services relating to the aforesaid services.

Annex B

The specifications for the divided off application 3926090:

Class 9: Teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; mechanisms for coin-operated apparatus; cash registers, calculating machines; fire-extinguishing apparatus; pocket calculators; sound transmitting apparatus; sound recording apparatus; sound reproduction apparatus; computer programmes for interactive games or quizzes; computer software for communicating with users of hand-held computers; computer software in the field of electronic publishing; downloadable books; downloadable image files; downloadable text files; downloadable video files; downloadable exam papers; downloadable quizzes; downloadable assessment criteria; downloadable educational materials; downloadable periodical publications; downloadable journals; downloadable dictionaries; downloadable reference books; downloadable lecture notes; downloadable educational worksheets; downloadable slide presentations; downloadable flashcards; downloadable vocabulary lists; electronic publications, downloadable; printed publications in electronically readable form; printed publications in optically recorded form; databases; downloadable publications; downloadable educational materials including exam papers, course materials and lecture notes; mouse pads; sleeves for laptops; sleeves for tablet computers; sleeves for portable computers; cases for mobile phones, tablets or portable computers; computer software for the provision of examination and assessment including software for operation by remote computer access; magnetic, optical and other disks, magnetic tape and other media for electronically recording data or software carrying computer data or computer software for the provision of examination and assessment; Magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; CD-ROMs; magnetic data media; magnetic tapes; magnetic disks; optical discs; optical data media; videotapes; computer software; downloadable computer software; educational software; podcasts; talking books; computer hardware; magnetic, optical and other disks, magnetic tape and other media for electronically recording data or software carrying computer data or computer software for the provision of training, education; parts and fittings for all the aforesaid goods.

Class 16: Paper, cardboard; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; arithmetical tables; atlases; biological samples for use in microscopy [teaching materials]; booklets; bookmarkers; books; calendars; cards; charts; comic books; diagrams; printed forms; geographical maps; handwriting specimens for copying; histological sections for teaching purposes; magazines [periodicals]; manuals; handbooks; newsletters; newspapers; pamphlets; periodicals; pictures; postcards; posters; printed publications; prospectuses; school supplies [stationery]; song books; stickers; teaching materials [except apparatus]; terrestrial globes; exercise books; bibles; printed awards; printed certificates; reference books; dictionaries; directories; reports; journals; exam papers; lecture notes; worksheets; quizzes; educational assessment criteria; flashcards; vocabulary lists; documents; forms; brochures; instructional and teaching materials in this class

all relating to the training, testing, examination and assessment of candidates for educational achievement, and to the provision of training, testing, examination and assessment services, including computer assisted, computer mediated services and on-line services and to the provision of distance learning programmes; parts and fittings for all the aforesaid goods.

Class 41: Analysing educational test scores and data for others; certification of education and training awards; computer assisted examination services; design of educational courses, examinations and qualifications; development of educational material; educational assessment services; educational examination services; academic examination services; educational research; setting of educational standards; university education services; university services; electronic desktop publishing; publishing consultancy services; advisory services relating to publishing; publishing services; electronic publishing services; providing electronic publications; publication of printed publications; publication of printed matter; providing online electronic publications, not downloadable; publication of texts, other than publicity texts; publication of books, reference books, magazines, periodicals, dictionaries, exam papers, lecture notes, worksheets, examination marking criteria, booklets, educational material including online publication; publication of directories, manuals, reports, journals, quizzes, puzzles and pamphlets; publishing; writing of texts, other than publicity texts; bibliographic information; examination and assessment services including computer assisted and computer mediated services and on-line services; information, advisory and consultancy services relating to the aforesaid services.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; research, testing and analysis services; computer-aided research, testing and analysis services; laboratory research, testing and analysis services; scientific research, testing and analysis; academic research, testing and analysis; agricultural research, testing and analysis; ecological research, testing and analysis; engineering research, testing and analysis; environmental research, testing and analysis; industrial research, testing and analysis; medical research, testing and analysis; technological research, testing and analysis; veterinary research, testing and analysis; agrochemical research, testing and analysis; archaeological research, testing and analysis; biological research, testing and analysis; chemical research, testing and analysis; physics research, testing and analysis; biochemical research, testing and analysis; biomedical research, testing and analysis; biotechnological research, testing and analysis; bacteriological research, testing and analysis; therapeutics research, testing and analysis; chemical engineering research, testing and analysis; civil engineering research, testing and analysis; electrical engineering research, testing and analysis; genetic engineering research, testing and analysis; historical research, testing and analysis; information technology research, testing and analysis; mechanical engineering research, testing and analysis; geological research, testing and analysis; mechanical research, testing and analysis; optical research, testing and analysis; astrophysical research, testing and analysis; pharmaceutical research, testing and analysis; urban planning research, testing and analysis; scientific research and development; medical research and development; engineering research and development; industrial research and development; agricultural research and development; technological research and development; pharmaceutical research and development; information

technology research and development; communications research and development; research and development of new products for others; consultancy relating to research, testing, analysis and development in the fields of science, medicine, drug discovery, engineering, therapeutics, agriculture, technology, information technology, communications; providing technical advice in the fields of science, medicine, drug discovery, engineering, therapeutics, agriculture, technology, information technology, communications; preparation of scientific reports; preparation of industrial reports; preparation of medical reports; preparation of academic reports; preparation of technical reports; preparation of technological reports; preparation of engineering reports; preparation of agricultural reports; preparation of ecological reports; preparation of environmental reports; preparation of historical reports; preparation of urban planning reports; providing advice, information and data relating to research, analysis, testing and development in the fields of science, medicine, drug discovery, engineering, therapeutics, agriculture, technology, information technology and communications; providing information and data relating to research, analysis, testing and development in the fields of science, medicine, drug discovery, engineering, therapeutics, agriculture, technology, information technology and communications from an on- line searchable database; computer-aided design; development and testing of computing methods, algorithms and software; software engineering; scientific surveys; drug discovery services; drug development services; clinical trials; DNA screening for scientific research purposes; genetic testing for scientific research purposes; topographical surveying; archaeological exploration; underwater exploration.