

O-127-08

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION  
NO. 2394493A IN THE NAME OF FLY FIRST PLC  
TO REGISTER THE TRADE MARK FLY FIRST  
IN CLASS 16**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 94502 IN THE NAME OF BRITISH AIRWAYS PLC**

## **Trade Marks Act 1994**

**IN THE MATTER OF trade mark application  
No. 2394493A in the name of Fly First Plc  
to register the trade mark FLY FIRST in Class 16**

**and**

**IN THE MATTER OF opposition thereto  
under No. 94502 in the name of British Airways Plc**

### **BACKGROUND**

1. On 16 June 2005, Fly First PLC made an application to register the trade mark FLY FIRST in Classes 16, 36 and 39 in respect of the following specifications of goods:

- Class 16** Paper, cardboard and goods made from this material, not included in any other classes; paper, paper articles; stationery, books, calendars, posters, photographs, adhesive tickets; tickets; luggage tickets (printed matter); luggage identity labels; tickets of cardboard; tickets of paper; tickets of paper for use with ticket issuing machines; tickets of cardboard for use with ticket issuing machines; model aeroplanes made of card; model aeroplanes made of paper; timetables relating to air travel; instructional and teaching material (except apparatus); adhesives for stationery or household purposes; writing instruments.
- Class 36** Insurance services; travel insurance services; provision of holiday insurance; charge card and credit card services; issuing and redemption of traveller's cheques; discount card services; currency and money exchange services; issuing of travel vouchers; cheque account services; financial services relating to airports; information, consultancy and advisory services relating to all the aforesaid services.
- Class 39** Air travel services; airline services; aircraft chartering; passenger transport and air cargo transport services; arranging of flights; air ticket booking services; airline bookings; airline check-in services; rental of aeroplanes; air navigation services; advisory services relating to the operational safety of aircraft; leasing of aircrafts; courier services; transport and delivery of goods; travel agency and booking services; sightseeing, tour and cruise arranging services; package holiday services; car hire services; tourist information services; air freight transportation; airline services for the transportation of cargo; airline services for the transportation of goods; airline services for the transportation of passengers; airline transportation services; arrangement for the transportation of goods by air; arrangement for the transportation of passengers by air; arrangement of transportation of goods by air; arrangement of transportation of people; arrangements

for transportation by land, sea and air; information, consultancy and advisory services relating to all the aforesaid services.

2. On 21 July 2006, British Airways plc filed notice of opposition to the application, the grounds being as follows:

- 1. Under Section 3(1)(a)** because FLY FIRST is a natural abbreviation for “fly first class” or could simply be used in the whole phrase “fly first class”. Alternatively, the phrase “fly first” is a natural phrase to be used in advertising to encourage the use of air travel. The mark is therefore incapable of distinguishing the Applicant’s goods and services from those of other undertakings.
- 2. Under Section 3(1)(b)** because FLY FIRST is a natural abbreviation for “fly first class” or could simply be used in the whole phrase “fly first class”. Alternatively, the phrase “fly first” is a natural phrase to be used in advertising to encourage the use of air travel.
- 3. Under Section 3(1)(c)** because FLY FIRST is a natural abbreviation for “fly first class” or could simply be used in the whole phrase “fly first class”. Alternatively, the phrase “fly first” is a natural phrase to be used in advertising to encourage the use of air travel. The mark therefore consists exclusively of a sign or indication which may serve, in trade, to designate the kind, quality, intended purpose, or value of the goods or of rendering of services, or other characteristics of goods or services.
- 4. Under Section 3(1)(d)** because FLY FIRST is a natural abbreviation for “fly first class” or could simply be used in the whole phrase “fly first class”. Alternatively, the phrase “fly first” is a natural phrase to be used in advertising to encourage the use of air travel. The mark therefore consists exclusively of a sign or indication which may serve, in trade, to designate the kind, quality, intended purpose, or value of the goods or of rendering of services, or other characteristics of goods or services.
- 5. Under Section 3(3)(b)** because FLY FIRST is a deceptive trade mark unless it is only used in relation to goods and services connected with first class air travel. The specification of this application contains no such limitation.

3. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based. Both sides ask that an award of costs be made in their favour.

4. Both sides filed evidence, which, insofar as it may be relevant I have summarised below. The matter came to be heard on 22 January 2008, when the opponents were represented by Mr Benet Brandreth of Counsel, instructed by RGC Jenkins & Co, their trade mark attorneys. The applicants were represented by Mr Thomas Mitcheson of Counsel, instructed by Murgitroyd & Co, their trade mark attorneys.

### **Opponents' evidence**

5. This consists of a Witness Statement dated 2 February 2007, from Timothy George Pendered, a trade mark attorney with RGC Jenkins & Co, the opponent's representatives in these proceedings.

6. Mr Pendered conducts an analysis of the mark applied for, stating that FLY FIRST consists of two ordinary English words that are familiar, and well known by "virtually everyone in the UK." In relation to any services connected with air travel the word FLY is "clearly directly descriptive" and should remain free for use by those within the air travel industry, or an ancillary industry. Referring to, and exhibiting a copy of the examination report (which referred to the registry practice in relation to the word FIRST) as Exhibit TGP1, Mr Pendered asserts that FIRST is laudatory in the sense of denoting something pre-eminent or "of the highest order". He further states that adding the name of the services in question, in this case "FLY" does not make the mark any more distinctive.

7. Citing the practice on the railways, Mr Pendered goes on to assert that FIRST has existed in the travel industry in general for many years where it has been used to indicate the best available service on offer. In respect of airlines he says that FIRST is one of the generic terms used in such a way, in support citing the examples shown in Exhibits TGP2 and TGP3. These consist of extracts from various websites at which travel can be booked, in the first instance relating to on-line ticketing agencies for airlines, and those containing air travel related information, respectively. Further examples of airlines using FIRST to denote their highest level of service are shown as Exhibits TGP4 and TGP5.

8. Mr Pendered goes on to argue that the evidence shows airlines use FIRST to denote their top level or FIRST CLASS service, and that being the case, the word on its own is recognisable as denoting the service as such. He states that use in relation to services that are not FIRST CLASS, use of the word FIRST would be misleading. He concludes by asserting that adding FLY to FIRST did not create a distinctive whole.

### **Applicant's evidence**

9. This consists of a Witness Statement dated 2 May 2007 from Eleanor Gail Coates, a trade mark attorney with Murgitroyd & Company Limited, the applicant's representatives in these proceedings. The Witness Statement consists of submissions on the substance and merits of the case, including a reference to the fact that the mark was examined by the Registry who did not raise an objection on these grounds. In the ordinary course of events it would not be necessary or appropriate to summarise submissions. However, as they represent the entirety of the applicant's evidence I have set out Ms Coates arguments below.

“4. In respect of the ground of opposition under Section 3(1)(a), the Application consists of two words, which are capable of being represented graphically. These are the key words of this absolute ground for refusal. Marks may consist of words, which the mark does, and these are capable therefore of distinguishing the goods and services. The minimum requirements to satisfy this ground is low as it does not deal with distinctiveness, simply whether the mark is capable of being graphically represented. Clearly, the Mark the subject of the Application meets this minimum requirement. The opposition under Section 3(1)(a) should therefore be refused in its entirety.

5. In respect of the grounds of opposition under Section 3(1)(b),(c) and (d), the Opponent argues that the mark FLY FIRST is a natural abbreviation of the phrase "fly first class" and that "fly first" is a natural phrase to be used in advertising. The evidence needed to support claims that a mark offends under Section 3(1)(b), (c) and (d) must demonstrate why the Mark in dispute cannot function as a trade mark and should not have been accepted. Further, Marks refused registration under this ground can overcome such an objection if it can be shown that the Mark has, by reason of its use, acquired distinctiveness prior to the filing date.

6. Exhibit 2 of the Witness Statement of Timothy George Pendered contains extracts from the Internet showing that travel providers use the phrase FIRST CLASS. The fact that FIRST CLASS is a designation of the level of service is not denied. However, the Mark the subject of the Application is not FIRST CLASS and the use of this term by others in the travel industry does not render the mark FLY FIRST non-distinctive, descriptive or customary in the current language or trade. Similarly, the Opponent seeks to argue that other operators in the field use the abbreviation of FIRST. One of the meanings of the word FIRST is laudatory and no one party can have an exclusive monopoly of the word FIRST for any goods or services. This is set out in the Registry's Work Manual. The Applicant is not seeking a monopoly in the word FIRST, however, and the rights given by registration of FLY FIRST would not give the Applicant the right to prevent such use. As such, such evidence is irrelevant as it does not illustrate that the Mark FLY FIRST offends under Section 3(1)(b), (c) or (d) of the Act.

The evidence does not show widespread use of the mark FLY FIRST or even FLY FIRST CLASS. Only one extract, from [www.waytetravel.co.uk](http://www.waytetravel.co.uk) (dated 30 January 2007) includes the word FLY FIRST in the longer sentence FLY FIRST OR BUSINESS CLASS TO AUSTRALIA. Given this, the evidence actually illustrates that the industry does not use the term FLY FIRST and therefore it is capable of being distinctive as a trade mark by one entity.

Further, the evidence put forward in Exhibit 2 of the Witness Statement of Timothy George Pendered consists of internet extracts, which are either dated 30 January 2007 or 1 February 2007, or not all at. As such, they cannot be evidence of the position of use of the term FLY FIRST, FIRST or FIRST CLASS at the Relevant Date in these proceedings. The Law Section of the Trade Marks Registry Work Manual states that *"A particular point to note for all evidence is that in each case there is a relevant date or period of time, evidence which relates to activities after such a date or outside the*

*relevant period is not admissible*". The evidence submitted in Exhibit 2 of Timothy George Pendered must therefore be disregarded in its entirety.

There is now shown and produced before me, Marked Exhibit EC 1, an extract from Chapter 6 of the Registry's Work Manual relating to the practice and relevancy of internet evidence.

7. Exhibit 3 of the Witness Statement of Timothy George Pendered purports to show further evidence of use of the term FIRST in other related travel sites on the internet, such as news sites, passenger survey sites and chatrooms. The first extract is a new release dated 2 September 2004 stating that British Airways and Gulf Air are offering business class passengers the chance to sample the luxury of first class. No use of the word FIRST alone is made and use of FIRST CLASS does not illustrate that the mark FLY FIRST is devoid of distinctive character, descriptive of a characteristic or customary in the trade.

The second extract is a questionnaire from [www.worldairlinesurvey.com](http://www.worldairlinesurvey.com) (dated 31 January 2007) which refers to the words FIRST CLASS. My comments above again apply and it is noted that despite being a survey on first class travel, undertaken by a leading airline commentator, no use of the word FIRST alone is made in relation to the travel class.

The third extract is from the website [www.flyertalk.com](http://www.flyertalk.com) (dated 1 February 2007, although the chain of the forum appears to be dated 13 June 2004). This dialogue refers to the FLY3/FLYFREE FLY6/FLYFIRST CERTIFICATES. The website is a US website, as illustrated by the layout of the date, the location of the forum participants (all US and Canada) and the fact that if you log into the website the clock on the website illustrates is the time in the United States. Given this, the evidence is irrelevant to proceedings in the UK and should be disregarded.

Further, the actual thread of forum is discussing a scheme being run by a US airline under the marks FLY3/FLYFREE FLY6/FLYFIRST. This is not generic use but illustrate that a US company was using FLYFIRST as a trade mark in relation to an upgrade scheme. Again, this actually illustrates that FLYFIRST is not commonly used in the industry, is therefore not devoid of distinctive character or descriptive and has been used by an entity in the US as a trade mark, which does not prevent it being so used in the UK.

The fourth extract is from the website [www.flyfirst.com](http://www.flyfirst.com), a US website in which the words FLY FIRST are used as a trade mark. Again, this evidence actually illustrates that the mark FLY FIRST is considered to be capable of identifying an entity in a trade mark sense in the US and does not illustrate generic use of the term in the UK aviation industry. Further, the internet extract is dated 1 February 2007 and does not therefore show use of the mark prior to the Relevant Date. There is now produced and shown to me, marked Exhibit EC2, extracts from [www.flyfirst.com](http://www.flyfirst.com) which illustrate that the website is directed solely at US consumers as the flight prices are shown in dollars, the airport delays tool only relates to US airports, the airport maps tools has predominantly US airports, the weather tool requires a zip code (the US equivalent of

a post code) to be entered and the airport security wait times are only given for US airports.

8. Exhibit 4 of the Witness Statement of Timothy George Pendered consists of advertising material of the Opponent in which it uses the word FIRST. Again, use of the mark FIRST by third parties in the airline industry would not be prevented by the registration of FLY FIRST, as the word FIRST alone would not be considered distinctive. The advertising material is not dated and therefore does not show that the Opponent was using the word FIRST in advertising at the Relevant Date. The date of the internet extracts appears to be 31 January 2007 but this cannot be made out entirely.

Further, or in the alternative, this advertising material shows use of the word FIRST in a trade mark sense by the Opponent. This is illustrated by the fact that the use of FIRST is highlighted in capitals.

9. Exhibit 5 of the Witness Statement of Timothy George Pendered contains two extracts, purporting to show samples of other airlines using the word FIRST in their advertising. The first extract is from the website [www.jal.co.jp](http://www.jal.co.jp) for Japan Airlines. As a co.jp website, this cannot be considered to illustrate the position in the UK or that it is use in the UK. Further, it uses the term FIRST CLASS, not FIRST. The extract is dated 31 January 2007, and cannot therefore be used as evidence of the position in industry or use of the mark at the Relevant Date. It must therefore be disregarded.

The second extract is from [www.emirates.com/uk](http://www.emirates.com/uk) and uses the words "first and business class lounges". The term being used here is first class, not FIRST alone. Further, this extract is undated and therefore cannot be considered to illustrate the position at the relevant date. It must therefore be disregarded.

10. The onus is on the Opponent to show, through evidence, that the Mark FLY FIRST offends against Section 3(1)(b),(c) and (d). The evidence provided in the Witness Statement of Timothy George Pendered does not do this. Firstly, the evidence relates solely to "airline travel services". In addition, no evidence of other parties using the term have been produced which indicates that it is a natural abbreviation of FLY FIRST CLASS. The term FLY FIRST is not such a natural abbreviation and would not be perceived, by the average consumer as being so but is rather an unusual juxtaposition of two words. The Opposition should therefore be refused under Section 3(1)(b),(c) and (d) in its entirety in respect of "airline travel services" and the Application allowed to proceed to registration.

11. Further, or in the alternative, not only has the Opponent has [sic] not shown that the mark FLY FIRST offends against Section 3(1)(b),(c) and (d) in respect of airline travel services, no evidence at all has been submitted that the words FLY FIRST are not distinctive in respect of the other goods or services for which protection is sought under the Application. In particular, no evidence has been provided in relation to the following services in Class 39:-

"Rental of aeroplanes; air navigation services; advisory services relating to the

operational safety of aircraft; leasing of aircrafts; courier services; transport and delivery of goods; travel agency and booking services; sightseeing, tour and cruise arranging services; package holiday services; car hire services; tourist information services; air freight transportation; airline services for the transportation of cargo; airline services for the transportation of goods; arrangement for the transportation of goods by air; arrangement of transportation of goods by air; arrangements for transportation by land and sea; information, consultancy and advisory services relating to all the aforesaid services.”

It is submitted that the mark FLY FIRST is distinctive in relation to all of the goods and services in respect of which protection is sought. However, where the services have no level or class of travel associated to them, its distinctiveness is enhanced. The transportation of goods, provision of services in relation to holidays, courier services, delivery services and rental services do not have levels or class of travel and no evidence has been provided to show that this is not the case.

The Opposition should therefore be refused in its entirety in respect of Classes 16, 36 and 39, and the Application allowed to proceed to registration.

12. The opposition is also based on Section 3(3)(b) on the ground that the mark FLY FIRST is deceptive unless it is only used in relation to first class services. This is incorrect and no evidence has been provided to show otherwise. While the term FIRST CLASS relates to a level of service when travelling, the word FIRST alone has not been illustrated to. FIRST is a word which has many meanings and consumers would not assume that it automatically implied the goods and services would be first class. The mark for which protection is sought is not FIRST, but FLY FIRST and it is the combination of the words which renders it distinctive. FIRST has many meaning[s] in relation to travel, as it could mean they would be the first to arrive, the first to depart, first in the queue, first to go, first to travel and therefore the meaning is allusive, not deceptive. The Opposition should therefore be refused on the basis of Section 3(3)(b) and the Application allowed to proceed to registration.

13. The Applicant requests that the Registry refuses the Opposition on all grounds and allows the Mark the subject of the Application to proceed to registration.”

10. Ms Coates provides the following Exhibits:

- EC1 extract from the Registry Work Manual in relation to the “Use of the Internet by Examiners and Hearing Officers”.
- EC2 extract from the FlyFirst.com FareWatch website – headed “FlyFirst.com – free first class air travel tools to assist with your travel planes”. It goes on to list air fares and give travel related information, none of which is specifically in relation to first class travel.

### **Opponent’s evidence in reply**

11. This consists of a Witness Statement dated 2 October 2007 from Timothy George

Pendered, a trade mark attorney with RGC Jenkins & Co.

12. Mr Pendered refers back to Exhibit TGP2 filed with his earlier Statement, that he says showed examples of FIRST being used on its own, and which has been criticised by Ms Coates as not being "...evidence of the position of use of the term FLY FIRST, FIRST or FIRST CLASS at the Relevant Date in these proceedings." In reply Mr Pendered introduces Exhibits TGP6 and TGP7, which consist of extracts taken from www.archive.org, giving details of the site, and pages from travel booking agency websites that were in operation prior to the relevant date. The pages from the travel sites that allow the entry of search criteria show, amongst other things, the word FIRST being used in a field for the class of flight, CLASS being the heading for the field.

## **DECISION**

13. Turning first to the grounds under Section 3(1) of the Act reads. That Section reads as follows:

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

- (a) signs which do not satisfy the requirements of section 1(1),
- (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) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

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."

14. There is no claim that the mark has become distinctive by virtue of the use made of it, and in any event there is no evidence of it having been used, so the proviso is not relevant in these proceedings.

15. Turning first to the ground under Section 3(1)(a). That section states that signs which do not satisfy the requirements of section 1(1) shall not be registered. Section 1(1) reads as follows:

### **"1 Trade marks**

(1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking

from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

(2)...”

16. There is no suggestion that the mark is not represented graphically; quite clearly it is, so any objection must be based on the contention that the “sign” is not capable of distinguishing. The meaning of Sections 1(1) and 3(1)(a) of the Act, and in particular the words “capable of distinguishing” were considered by Jacob J in *British Sugar PLC v James Robertson & Sons Ltd* 1996 RPC 281 (the TREAT case). He said:

Thus, *capable of distinguishing* means whether the mark can in fact do the job of distinguishing. So the phrase in Section 1(1) adds nothing to section 3(1) at least in relation to any sign within sections 3(1)(b)-(d). The scheme is that if a man tenders for registration a sign of this sort without any evidence of distinctiveness then he cannot have it registered unless he can prove it has a distinctive character. That is all. There is no pre-set bar saying no matter how well it is proved that a mark has become a trade mark, it cannot be registered. That is not to say that there are some signs which cannot in practice be registered. But the reason is simply that the applicant will be unable to prove the mark has become a trade mark in practice - “Soap” for “Soap” is an example. The bar (no pun intended) will be factual not legal.”

17. In *Philips Electronics NV v Remington Consumer Products Ltd* [2003] RPC 2 paragraph 30, the ECJ stated that the words “capable of distinguishing” must be construed by reference to the essential function of a trade mark, which the ECJ has described as being:

“...to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin, and for the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality....”

18. There is a class of signs that although lacking in the character necessary to function as a trade mark, can nonetheless acquire that capacity through use. However, signs that are open to objection under Section 3(1)(a) of the Act cannot achieve this because they are not included in the proviso to Section 3.

19. So for an objection under Section 3(1)(a) to be appropriate, the sign has not only to be devoid of distinctive character, it has to be of a nature such that it is not capable of becoming distinctive by use, (see *Bach and Bach Flower Remedies Trade Marks* [2000] RPC 513). Such signs are often illustrated by the ‘soap for soap’ example, in other words the sign applied for is nothing more than the common name for the goods with no capacity to serve

the essential function of a trade mark, no matter how much ‘use’ has been made of it (see, for example, *Jeryl Lynn* [1999] FSR 491).

20. The opponent’s objection is based on the assertion that FLY FIRST is a “natural abbreviation for “fly first class” or could simply be used in the whole phrase “fly first class”, or alternatively, is a natural phrase to be used in advertising to encourage the use of air travel.” Whilst the sign tendered for registration could have a reference to some aspect of the goods and services for which registration is sought, whether it does, and if so, to what the degree I will come to later. I do not consider that it can be said to be in the “soap” category to which I have referred, and I have little hesitation in dismissing the ground under Section 3(1)(a).

21. Turning next to the ground under Section 3(1)(d) of the Act. The leading guidance from the European Court of Justice on Article 3(1)(d) (equivalent to Section 3(1)(d) of the UK Act) is contained in *Merz & Krell GmbH & Co*, [2002] ETMR 21:

“41. It follows that Article 3(1)(d) of the Directive must be interpreted as meaning that it subjects refusal to register a trade mark to the sole condition that the signs or indications of which the trade mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought. It is immaterial, when that provision is applied, whether the signs or indication in question describe the properties or characteristics of those goods or services.”

22. As this case indicates, an objection based on this ground is not to be determined on the basis that the mark is in some way descriptive of the goods or services; that is a matter to be considered under the provisions of Sections 3(1)(b) and (c) of the Act. It would therefore follow that if the decision is not to be made on the basis of descriptive aptness, any assertion that a mark has become customary in the language and practices of the trade connected to the relevant goods and services has to be supported by clear and cogent evidence.

23. Not surprisingly, there is evidence that shows that at the relevant date, the words FLY and FIRST were individually in use within the air travel and related industries. There is no such evidence that the collective term FLY FIRST was customary in the common parlance or practices of the trade, that is other than as part of a longer description, exhortation, strap-line, or whatever. I do not, therefore, see on what basis I can conclude that the mark tendered for registration falls foul of Section 3(1)(d) of the Act, and the objection founded on that section is dismissed.

24. Turning next to consider the grounds under Section 3(1)(b) and (c) of the Act. I will deal first with the allegation that the mark, as a whole, “describes goods and services to do with flying in a “laudatory manner” and is precisely the sort of thing you would expect to see being used descriptively, for example, to refer to the option of “flying in the first class cabin of an aeroplane”. Whilst FIRST CLASS undoubtedly indicates that the level of service is the highest available, in this context it informs the user about the level of service they are purchasing rather than being a statement of some intrinsic feature of the quality of the service. It may be there by inference, but I do not consider FLY FIRST or even FLY FIRST CLASS is a use in a laudatory sense; it is a simple statement of fact.

25. In the *Cycling Is* decision [2002] R.P.C 37, it was stated that the distinctiveness of a trade mark 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 the relevant public's perception of that mark. In the judgment issued in respect of *Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003), paragraphs 37, 39 to 41 and 47, the European Court of Justice (ECJ) summarized the considerations in respect of assessing distinctiveness under Section 3(1)(b) in the following terms:

“37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods or services of one undertaking from those of other undertakings.

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and *circumspect* (see *Case C- 210/96 Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

26. I was referred to the judgment issued in respect of *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case -191/01 P, the *Doublemint* case, the ECJ gave the following guidance on the scope and purpose of Article 7(1)(c) of the Community Trade Mark Regulation, equivalent to Section 3(1)(c) of the Trade Marks Act:

“28. Under Article 4 of Regulation No 40/94, a Community trade mark may consist of any signs capable of being represented graphically, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of goods or of rendering of the service, or other characteristics of the goods or service are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.

31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, *inter alia*, in relation to the identical provisions of article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161), paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

27. From this it is clear that the prohibition to registration under Section 3(1)(c) of the Act relates to signs that may not be being used as a designation of a characteristics of the relevant goods or services, but nonetheless could be apt for such use.

28. In *Doublemint* the ECJ found the mark to be purely descriptive and the fact that 'double' and 'mint' in combination gave rise to a variety of possible meanings did not automatically mean that the words are not descriptive. The Advocate General, in a precursor to the ECJ decision, suggested that a proposed trade mark should be assessed as follows:

What is the relationship between the mark and the product?—If the mark to be used is a general description in the particular trade then registration will be refused,

How immediately is the message conveyed? If the mark quickly conveys the characteristic of the goods/services then it will not be registrable,

What is the significance of the characteristics in relation to the product in the consumer's mind? – If the characteristics are intrinsic to the product or the consumer's choice of product, then the grounds for refusing registration because of the descriptive element are high.

29. The ECJ held that a sign must be refused registration if one of its possible meanings is capable of designating a characteristic of the goods concerned, and it was held that the only lexical invention in *Doublemint* was the removal of a space between the words “double” and “mint”. The mark was considered to have a tangible reference to a mint flavour which is doubled in some way. As the mint flavour was a prominent feature of the product for which the mark was to be used, it was considered that this relevance would be 'readily perceived' and registration was denied.

30. I was also referred to the *Postkantoor* case in which the ECJ reviewed the decisions in *Biomild* and *Baby-Dry*. In that case Koninklijke KPN Nederland NV's had made an application to register *Postkantoor* (meaning 'post office' in Dutch) for 'paper, advertising, stamps, telecommunications and education', the Benelux Trade Mark Office refused the application as being exclusively descriptive of the relevant goods and services in relation to a post office. The refusal was referred to the ECJ who stated that if due to the unusual nature of the combination of words which form a trade mark, the overall impression of the mark is sufficiently far removed from the descriptive elements of the words concerned, and the combination creates a different impression from the individual words, the mark is registrable. If the new word has established its own meaning, independent of the individual components which make up the mark, then again it is registrable. This case confirmed the tests laid down in the *DOUBLEMINT* decision.

31. In relation to the objections under subsections (b) and (c), the opponents assert that FLY FIRST is a natural abbreviation for, or could simply be used in the whole phrase “fly first class”. In addition and in the alternative in respect of the ground under subsection (c), they state that “fly first” is a natural phrase to be used in advertising to encourage the use of air travel. Mr Brandreth argued that the words are not attached in any “lexically inventive manner” but follow “normal English grammar.”

32. “FLY” and “FIRST” are ordinary English words that will be well known to all who are familiar with the language. The word FLY is apt to describe air travel. FIRST (without any other addition) is shown by the evidence to be used to describe a class or standard of the service provided, including by providers of air travel. In some instances, such as when making

bookings for air travel, the word “FIRST” will be typed or selected in a field, usually with the word “CLASS” placed above as a label. Even without the corroboration provided by the evidence, I consider that use of the word FIRST in conjunction with travel related goods and services would be understood by the consumer to be a reference to the class of service; namely FIRST CLASS. However, the question is not whether the individual components lack distinctive character, but whether the mark as a whole does?

33. Accepting that FLY denotes a mode of travel, and FIRST indicates the “class” or level of service purchased, if there is any lexical invention in the words it is that they do not say FLY FIRST CLASS, but FLY FIRST. The words do not describe any goods or services. They are capable of being incorporated into phrases such as “FLY FIRST CLASS without changing their tense or sequence. Mr Simon Thornley QC, sitting as the appointed person, provided some guidance on abbreviations of descriptive terms in *Where All Your Favourites Come Together* BL O/573/01:

“Mr. James, on the other hand, contended that a slight extension of the slogan so that it read, "This is where all your favourites come together in one box" would plainly be unregistrable and that the average consumer would see WHERE ALL YOUR FAVOURITES COME TOGETHER as being an abbreviation for the longer expression.

...

I have reached the conclusion in this case that when used in relation to confectionery as a whole, Mr. James's submission carries weight. I believe the average consumer would see the abbreviation for what it is, namely, an abbreviation for the expression, "This is where all your favourites come together in one box.””

34. Even without the word CLASS, I consider the expression FLY FIRST to have an obvious descriptive relevance for goods and particularly services connected with air travel, and one that will be immediately apparent to the relevant consumer. I find FLY FIRST to be no more than an obvious abbreviation of the term FLY FIRST CLASS and is incapable of designating goods and services that relate to first class air travel. Accordingly, the trade mark is excluded from registration under Section 3(1)(c) of the Act for such goods and services. It follows that in relation to such goods and services the mark must also be devoid of the character necessary to be able to distinguish, and the ground under Section 3(1)(b) also succeeds.

35. It is here that I must consider the fact that the specifications do not only cover goods and services related to air travel, a fact acknowledged by Mr Brandreth who with his skeleton argument provided specifications with the “air-related” goods and services highlighted. In the circumstances where the mark is found not to be objectionable because the goods or services have no connection with air travel, in particular, first class air travel, the opponents contend that the mark would be deceptive and open to objection under Section 3(3)(b). Before determining for what goods and services the mark FLY FIRST is devoid of distinctive character, I first need to determine whether for the mark would be deceptive as claimed, for if that is the case, the application will fall in its entirety. Section 3(3)(b) of the Act states:

“(3) A trade mark shall not be registered if it is -

b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origins of the goods or service).”

36. Section 3(3)(b) of the Act derives directly from article 3(1)(g) of First Council Directive 89/104 of December 21, 1988 (the Directive). In *Elizabeth Florence Emanuel v Continental Shelf 128 Ltd* Case C-259/04 the European Court of Justice (ECJ) held:

“47. Nevertheless, the circumstances for refusing registration referred to in Article 3(1)(g) of Directive 89/104 presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived (Case C-87/97 *Consorzio per la tutela del formaggio Gorgonzola* [1999] ECR I-1301, paragraph 41).”

37. An objection under Section 3(3)(b) should therefore only be raised if in there is a real, as opposed to a purely theoretical potential for deception of the public. In the *Consorzio per la tutela del formaggio Gorgonzola* case referred to, the ECJ stated:

“41. As to that, the circumstances contemplated in Article 3(1)(c) of the First Directive 89/104 do not apply to the present case. The circumstances envisaged in the other two relevant provisions of that directive - refusal of registration, invalidity of the trade mark, or revocation of the proprietor's rights, which preclude its use being continued under Article 14(2) of Regulation No 2081/92 -presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived (see, on that subject, *Clinique*, cited above, Case C-470/93 *Mars* [1995] ECR I-1923, and Case C-313/94 *Graffione* [1996] ECR I- 6039, paragraph 24).”

38. The deception envisaged is that a consumer on seeing the mark may be led into believing that they would be purchasing FIRST CLASS travel. In determining the likelihood of deception it is, in my view appropriate to consider factors such as the nature of the goods and/or services and the circumstances in which they are obtained.

39. The public will be well aware that there are different levels of service, and that travelling first class is a premium service likely to cost considerably more than other classes. Such a service will usually be purchased either by the well-heeled, the business traveller or by those making an occasion of the trip. In each case these travellers will no doubt ask for, and receive the level of service required.

40. Obtaining travel may be a face-to-face transaction, or quite commonly these days, be done in a virtual world via the internet. It is a deliberate act that attracts a high degree of care and attention, partly because of the cost, but mostly to ensure that the service being obtained meets the purchasers requirements.

41. Where the purchase is made in person, it is not my experience that a travel advisor will assume the level of service sought. In each case they will carefully go through the arrangements and confirm the service required. I do not see that there is any potential for confusion here, either by buying the wrong mode, or the wrong class of travel. The position is not much different where the purchase is made online. The consumer knows where they want to go, how they want to get there, and will be aware of the different classes of travel. The interactive purchase requires the entry of the travel details, including how, and at what

level or class. I do not see that there can be any potential for deception in the consumer getting a rail ticket when they wished to go by air. In my experience it is also the case that the default setting for class is "ECONOMY", but even if that were not the case, each stage requires confirmation of the service being obtained. I do not see that there is any risk of deception beyond the theoretical. The ground under Section 3(3)(b) is therefore dismissed.

42. This then brings me to the specifications. Having determined that the mark is open to objection under Section 3(1)(b) and 3(1)(c) for goods and services related to air travel, and in particular, by first class, how should this be reflected in the specifications? The mark FLY FIRST is devoid of distinctive character for goods and services relating to air travel, in particular, in first class, and not air transportation per se. Accordingly, the mark is not open to objection for goods and services such as stationery, adhesives and paper aeroplanes in Class 16, financial and insurance services in Class 36, or those in Class 39 concerning cargo transport, none of which have any specific connection to passenger air travel by any class, first or otherwise. In my view the objection applies in respect of the following goods and services:

**Class 16** [Paper, cardboard] goods made from this material, not included in any other classes; paper articles; adhesive tickets; tickets; luggage tickets (printed matter); luggage identity labels; tickets of cardboard; tickets of paper; tickets of paper for use with ticket issuing machines; tickets of cardboard for use with ticket issuing machines; timetables relating to air travel.

**Class 36** Issuing of travel vouchers.

**Class 39** Air travel services; airline services; aircraft chartering; passenger transport services; arranging of flights; air ticket booking services; airline bookings; airline check-in services; sightseeing, travel agency and booking services; sightseeing, tour and cruise arranging services; package holiday services; tourist information services; airline services for the transportation of passengers; airline transportation services; arrangement for the transportation of passengers by air; arrangement of transportation of people; arrangements for transportation by air; information, consultancy and advisory services relating to all the aforesaid services.

42. On my findings the application should proceed to registration in respect of the following specifications of goods and services:

**Class 16** Paper, cardboard; stationery, books, calendars, posters, photographs; model aeroplanes made of card; model aeroplanes made of paper; instructional and teaching material (except apparatus); adhesives for stationery or household purposes; writing instruments.

**Class 36** Insurance services; travel insurance services; provision of holiday insurance; charge card and credit card services; issuing and redemption

of traveller's cheques; currency and money exchange services; cheque account services; financial services relating to airports; information, consultancy and advisory services relating to all the aforesaid services.

**Class 39** Air cargo transport services; rental of aeroplanes; air navigation services; advisory services relating to the operational safety of aircraft; leasing of aircrafts; courier services; transport and delivery of goods; car hire services; air freight transportation; airline services for the transportation of cargo; airline services for the transportation of goods; arrangement for the transportation of goods by air; arrangements for transportation by land (and) sea; information, consultancy and advisory services relating to all the aforesaid services.

### **Costs**

43. Beyond a reference to air travel the opponent's did not seek to focus on specific goods and services, at least not until the matter came to be heard. Ms Coates asserted that the opponents had failed to demonstrate the lack of distinctiveness of the mark in relation to services in Class 39, but sought to defend the application in its entirety. In these circumstances I consider it appropriate to consider the result even and do not propose to make an award of costs.

**Dated this 1<sup>st</sup> day of May 2008**

**Mike Foley  
for the Registrar  
the Comptroller-General**