

O-144-08

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION NO 2342182

TO REGISTER A TRADE MARK

BY COMPASS MAPS LIMITED

IN CLASS 16

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DECISION AND GROUNDS OF DECISION

Background

1. On 30 August 2003 Compass Maps Limited of The Coach House, Beech Court, Winford, Bristol BS40 8DW applied under the Trade Marks Act 1994 to register the following series of two marks:

POPOUT
PopOut

2. Registration is sought for the following goods:

Class 16

Printed matter; printed publications; stationery; paper; cardboard and goods made from these materials; magazines; brochures; teaching and instructional materials; promotional and advertising materials; maps; guides; posters; travel documents.

3. The application was examined and an objection was taken against the application under Section 3(1)(b) of the Act because the first marks in the series consists exclusively of the words POP and OUT conjoined and in upper case font and the second mark in the series consists of the words Pop and Out conjoined and in upper and lower case font, both being signs which would not be seen as a trade mark as they are devoid of any distinctive character for goods in the form of maps or printed matter with a pop out function.

4. Evidence of acquired distinctiveness was submitted in the form of a Statutory Declaration dated 20 January 2005 made by Derek Dacey, Managing Director of the applicant company. However the evidence was found by the examiner to be insufficient and the objection was maintained.

5. The applicant then proposed in correspondence to delete 'maps' from the specification of goods. The objection was maintained however on the basis that the specification includes 'printed matter' at large. A request to be heard was subsequently made.

The Hearing

6. The matter came to be heard on 5 April 2006 when the applicant was represented by Mr Webster of Stevens Hewlett Perkins their trade mark attorneys.

7. At the hearing, the Hearing Officer, Mr Dan Anthony, maintained the objection under Section 3(1)(b) of the Act. In addition, he raised a late objection under Section 3(1)(c) on the grounds that the mark describes a characteristic of the goods e.g. printed matter or maps which pop out and open to a large size for ease of viewing, by the user simply opening a cover. Mr Anthony concluded at the hearing that the *prima facie* objection to the mark was strong. Evidence of use submitted as a means of overcoming the objection was considered and Mr Anthony pointed out that the one exhibit supplied of the mark in use showed it in a stylised form and not as filed. It was pointed out that lack of clear exhibits showing reliance of the term as a trade mark resulted in the evidence being unacceptable. A period of two months was granted after the hearing for the submission of further evidence.

Post Hearing Communication

8. On 23 March 2007 the first of a series of Witness Statements from the trade was filed. The Witness Statement was dated 21 March 2007 and was in the name of Ms Marian Behn. Three further Witness Statements from the trade were filed on 29 March 2007. These were in the names of Mr Andy Riddle, dated 28 March 2007, Mr John Sadler, dated 26 March 2007 and Mr Julian Ball, dated 23 March 2007. A fifth Witness statement was filed on 11 May 2007 in the name of Imogen Hall and dated 8 May 2007.

9. Having taken over responsibility for the case in the absence of Mr Anthony, I noted that unfortunately the exhibits filed with the original evidence had been misplaced. Copies of these exhibits were requested by the Registry and subsequently a sample of the documents were submitted, however the applicant was unable to provide a copy of Exhibit 1, being an inner London map and the only exhibit showing the mark in use.

10. Following consideration of all of the available evidence including the evidence from the trade I did not consider it to be sufficient to overcome the objection. In my letter of 25 October 2007 I gave reasons for my decision to refuse the application.

11. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

The Prima Facie Case for Registration

12. The marks in the series consist of two well known dictionary words which describe a characteristic of the goods and on this basis the objection under Section 3(1)(b) and (c) was maintained. I consider this decision to be correct and the mark to be objectionable in the *prima facie*.

The Law

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

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

(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,

14. In a judgement issued by the European Court of Justice on 23 October 2003, *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 Court gives 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). Paragraphs 28 - 32 of the judgement are reproduced below:

- “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 the goods or 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.”

Decision

15. Section 3(1)(c) of the Act excludes signs which may serve in trade, to designate the kind of goods or other characteristics of goods. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the goods in question.

16. This is an application to register the series of two marks POPOUT and PopOut. POP and OUT are well known dictionary words and there is no need for me to refer specifically to their individual dictionary meanings. I must in any case, consider the mark in its entirety, bearing in mind the meanings of the individual elements in relation to the goods applied for. In relation to the goods, I have concluded that the mark would be perceived in one way – as printed matter or maps with a ‘pop out’ function. By this, I mean printed matter or maps which pop out when the cover is opened, unfolding and opening out to a large size to enable easy viewing by the user. With this in mind it follows that the marks POPOUT and PopOut describe a characteristic of the goods and are therefore excluded from prima facie registration under Section 3(1)(c) of the Act.

17. Having found that the marks are to be excluded from registration by Section 3(1)(c) of the Act, that effectively ends the matter, but in case I am found to be wrong in this decision, I will go on to determine the matter under section 3(1)(b) of the Act.

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

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

(b) trade marks which are devoid of any distinctive character,

19. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in Joined Cases C-53/01 to C-55/01 *Linde AG, Winward Industries Inc and Rado Uhren AG* (8th April 2003) 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.”

20. For the same reasons that I found this trade mark is to be excluded by the provisions of Section 3(1)(c) of the Act I have concluded that the relevant consumer of the services in question would not consider this mark to denote trade origin. The average consumer of these goods will, upon encountering the words POP OUT, perceive them as no more than an indication that they relate to items with a 'pop out' function'. That is why it will not be seen as a badge of origin. I am not persuaded that the trade mark applied for is sufficient, in terms of bestowing distinctive character on the sign as a whole, to conclude that it would serve, in trade, to distinguish the services of the applicant from those of other traders.

The case for Registration based upon acquired distinctiveness

The Law

21. The proviso to Section 3 of the Act permits acceptance of a mark that is otherwise unacceptable under the provisions of Section 3(1)(b) if it has in fact acquired a distinctive character because of the use made of it. Guidance on the test to be applied was provided by the ECJ in *Windsurfing Chiemsee (C108&109/97)* [1999] ETMR 585 where it was stated:

“If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied.”

22. Having regard to the guidance provided above, it seems to me that if the proviso is to be utilised the evidence must show that the mark in suit is taken by the average

consumer as a guarantee that the goods sold under it originate from the applicant because of the use of the mark for that purpose.

23. I now go on to assess the evidence filed on that basis.

Preliminary issues

24. On 7 February 2005, Mr Webster provided evidence of use of the mark which consisted of a Statutory Declaration in conjunction with exhibits. The Statutory Declaration was made by Derek Dacey, who is the Managing Director of Compass Maps Limited – the applicant company. Mr Dacey has held the position since 1993 and is authorised to speak on behalf of the company.

25. In a letter dated 30 March 2005 Mr Webster proposed to delete the term ‘maps’ from the specification. Although this was duly noted by the examiner in his letter dated 6 April 2005, it was pointed out that it does not overcome the objection as the specification contains ‘printed matter’ at large.

The evidence and the decision

26. The mark for which registration is sought was first used by the applicant in 1992. The Statutory Declaration refers to Exhibit 1, dated 1992, being the only example filed showing the mark in use and being a sample copy of an inner London map. I have been unable to inspect this exhibit however, as it is unfortunately missing from the file and a replacement is not available to me. I note however that in the examiner’s letter dated 7 March 2005, the exhibit is referred to as being ‘unacceptable’ as it shows use of the mark in the form of a word and device. In addition the examiner points out that the exhibit shows use of the mark descriptively as the map does in fact ‘pop out’. Mr Anthony the Hearing Officer had sight of the exhibit at the hearing held on 5 April 2006, and in the Hearing Report he echoes the examiner’s view that the example shows descriptive use of the mark. I am mindful of the fact that evidence of use does not always equate to evidence of distinctiveness as a trade mark. The use must be in a distinctive sense to have any materiality (*Bach Flower Remedies Ltd v Healing Herbs Ltd [2000] RPC 513 at 530*).

27. The Statutory Declaration refers to the applicant having a 45% market share of the goods bearing the trade mark at the date of application. There is no evidence to actually substantiate this fact, however Exhibit 2 consists of a customer database list of vendors and retailers who have purchased goods under the trade marks since 1992.

28. Exhibit 3 consists of a small selection of customer purchase orders raised in 1995 and 1996 and were filed to indicate that use of the trade marks had expanded since their introduction to the market in 1992. Exhibit 4 consists of further invoices which I am satisfied demonstrates the fact that goods bearing the trade mark have been distributed throughout the UK.

29. From 1992 until the year 2000, the applicant was directly promoting and selling the goods bearing the trade marks. Subsequent to this date, the applicant engaged the services of a sole distributor, GeoCenter International Limited, who, under the direction and control of the applicant, are responsible for generating sales of the goods

bearing the trade marks both in the UK and for export abroad. Exhibit 5 consists of a selection of sales invoices from the year 2000 to 2004, issued to the UK distributor. Further included as Exhibit 6 are reports from the distributor to the applicant detailing sales of the goods bearing the trade marks to third party retailers and vendors in Britain for the period of January to July 2003.

30. The approximate gross annual turnover value of the goods sold under the trade marks in the UK since 1995 are given as follows:

Year	Approximate Turnover (£)
1995	96,000
1996	100,000
1997	254,000
1998	207,000
1999	1,061,000
2000	1,050,000
2001	830,000
2002	1,089,000
2003	1,287,000

I am of the opinion from these figures that the turnover is substantial and can see that it has increased by approximately five-fold since the services of the sole distributor were employed.

31. The approximate figures for annual advertising of the goods sold under the trade marks are given as follows:

Year	Approximate Expenditure (£)
1995	2,000
1996	5,000
1997	14,000
1998	16,000
1999	52,000
2000	63,000
2001	68,000
2002	69,000
2003	93,000

Taking these annual figures into consideration, I am of the view that over a ten year period, a reasonable amount has been spent on promoting the goods sold under the trade mark; further, it can be seen that the amount spent on advertising and promotion has increased considerably over the period.

32. It is declared by the applicant that the goods bearing the trade marks have been sold and promoted in every major town and city in the United Kingdom. To promote the trade marks it is stated that the applicant has engaged in the following activities:

- (a) Annual attendance at the London and Frankfurt Book Fairs and Book Expo in the USA.

- (b) In-store promotion at major retailers, including Waterstones and WH Smith.
- (c) Regular advertising features in major trade publications and regional and National newspapers including “Bookseller”, “Publishers Weekly”, “Daily Mirror”, “Daily Telegraph and “London Times Lifestyle”.
- (d) Spot placement of goods bearing the Trade Marks on major television shows broadcast in the UK, including “Neighbours” and “Cheers”.

I am only able to take into consideration promotion of the trade marks within the UK, however as no examples have been provided to this end I have been unable to conclude from the evidence that a significant proportion of the relevant class of persons identify goods originating from the applicant.

Trade evidence

33. Evidence intended to demonstrate that those in the trade associate the Trade Marks with the applicant has also been filed. This is found at Exhibit A and consists of five Witness Statements:

- (a) Statement from Imogen Hall who is the Regional Publishing Manager of Lonely Planet Publications Limited (a competitor). Ms Hall states that the name POPOUT is familiar to her as she has seen it for sale in a number of retail outlets, including some outlets that stock the products of her company. She states that when she sees or hears the word POPOUT, she thinks only of the applicant’s map/travel guide product. Ms Hall is aware that the product is characterised by its ability to unfold and fold in a convenient way and believes this to be a fairly novel concept in the travel industry. As such she considers the name POPOUT to be synonymous with the goods and knows of no other party producing a similar product and labelling it in this manner.
- (b) Statement from Andy Riddle who is joint Managing Director of Footprint Handbooks Ltd (a competitor). Mr Riddle states that he is familiar with the POPOUT product and can say with surety that he has been aware of it for at least three to four years. He states that it is a well recognised product line within the travel guide market. Mr Riddle states that he knows POPOUT to be a trade mark of Compass Maps Limited and does not know of anyone else in the Industry using the name. He claims that he would be surprised if anyone else were to use this name for maps or travel guides.
- (c) Statement from John Sadler, who works for Thomas Cook Publishing (a competitor), and is primarily responsible for producing, marketing and selling a range of travel guidebooks. Mr Sadler states that he has extensive knowledge of the travel publications industry and is aware of rival products on the market. He states that he has been aware of POPOUT for at least seven years and that the name is well known to both

consumers and the retail trade. He further states that many people routinely refer to the company as POPOUT and not Compass Maps Limited. He states that it is his belief that POPOUT is a trade mark of Compass Maps limited and claims to know of no other company or party in the industry who use a similar name for travel guides, maps and travel publications.

- (d) Statement from Julian Ball, who works for Publishers' Group UK (a distributor) in the position of Key Accounts Co-ordinator. Mr Ball states that he has only worked for Publishers' Group UK for a period of two months. Prior to this he states that he was employed by Compass Maps Limited in the role of Publisher Liaison Manager. He states that he has been fully aware of the applicant's POPOUT product for the last 4 years and that it is his firm view that it is a trade mark of the applicant. He further states that in his experience nobody else has ever used such a name to describe their publications and certainly not in the travel field.
- (e) Statement from Marian Behn who works for Edward Stanford Limited as an Assistant Retail Manager. Ms Behn claims to have been fully aware of the applicant's POPOUT product for the last five years. She states that in her experience customers wanting the applicant's product ask for it specifically by reference to the name POPOUT. She states that she has no doubt that POPOUT is a trade mark of the applicant and has not before come across any other publication in the travel sector with the same name. Further, she claims that when hearing or seeing the word POPOUT in connection with maps or travel guides she thinks only of the applicant and that in her experience, nobody else has ever used such a name to describe their publications and certainly not in the travel field.

34. I have fully considered all of the evidence submitted by trade. Further, I am aware that it is well established that trade evidence may assist where there is doubt from the primary evidence about whether the mark has been used to a sufficient extent in the marketplace so as to have acquired a distinctive character in the eyes of a significant proportion of the relevant class of consumers.

35. In this particular case however, I am not convinced that the trade evidence is likely to assist. The reason for this is that the doubt does not relate to the *extent* of the use of the mark but rather to whether the *nature* of use is such as to have educated the average consumer to regard the mark as an indication of trade source of the goods. I am aware that where trade evidence is intended to fulfil this function, it must be clear that it comes from traders with direct contact with ordinary consumers of the goods, who can provide evidence of consumers reaction to and reliance upon, the mark in question *in the course of trade*. In this instance, having fully considered the witness statements submitted by those in the trade, I am not convinced that this fact has been established.

36. Therefore, absent any positive proof that the mark is relied upon as an indication of origin, the trade evidence has failed to demonstrate that the mark applied for is factually distinctive.

Conclusion

37. In this decision I have taken into account all the written submissions/evidence filed to support this application. I have concluded that the mark is excluded from prima facie registration under Section 3(1)(b) and (c) of the Act because it consists exclusively of a sign which serves to describe a characteristic of the goods, i.e. maps or printed matter with a pop out function. The evidence has failed to demonstrate that because of the applicant's use, the mark is taken by the average consumer as a guarantee that the goods sold under it originate from the applicant because of the use of the mark for that purpose.

38. Consequently, the application is refused under the terms of Section 37(4) of the Act because it fails to qualify for registration under Section 3(1)(b) and (c).

Dated this 22nd day of May 2008

**KAREN STEPHENS
For the Registrar
The Comptroller-General**