

O/167/06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2325815
BY NEW REG LIMITED TO REGISTER THE
TRADE MARK NEW REG IN
CLASSES 20 AND 35**

AND

**IN THE MATTER OF OPPOSITION NO 92880 BY
REGISTRATION TRANSFERS LTD**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2325815
By New Reg Limited to register the trade mark
NEW REG in Classes 20 and 35**

And

**IN THE MATTER OF Opposition No 92880 by
Registrations Transfers Ltd**

BACKGROUND

1. On 6 March 2003 New Reg Limited applied to register the mark NEW REG for:

Class 20

Vehicle number plates; registration plates.

Class 35

The bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods from an internet website by means of telecommunication; searching for vehicle number and registration plates; purchasing number and registration plates for others to order; office functions relating to the searching and purchasing of number plates and registration plates; undertaking vehicle number plate and registration plate transfers for others; advice and information in connection with all the aforesaid services.

2. The application (No 2325815) was published for opposition purposes in the Trade Marks Journal with the clause "Proceeding because of distinctiveness acquired through use".

3. On 19 October 2004 Registration Transfers Ltd filed notice of opposition on the following bases:

3(1)(b) - in that the phrase "new reg" consists of one full word and one common abbreviation which frequently occur in this combination. There is nothing unusual, exclusive or unique about this phrase.

3(1)(c) - in that the phrase "new reg" is a concise term commonly used to refer to a new registration plate. It is used by many people, both connected and unconnected with the personal registrations industry to describe a new registration or number plate.

3(1)(d) - in that “new reg” is a common informal term used by practically all dealers in the personal registrations trade. It is frequently used by customers who call and say: “I would like to buy a new reg for my car”. It appears in the text of dealer websites in contexts meaning “new registration”. It is frequently used within the industry and by customers in contexts that in no way refer to the company seeking to register this phrase.

4. Listed at the foot of page 2 of the statement of grounds are various websites which are said to exemplify use of the term. No print-outs from the websites have been supplied.

5. The applicant filed a lengthy counterstatement denying each of the grounds of objection and exhibiting a copy of a witness statement filed at the examination stage to establish the distinctiveness of the mark. The applicant makes a number of further claims including:

- the opponent is said to have previously acknowledged the applicant’s exclusivity in the NEW REG brand and has agreed not to use it in any of its marketing, as an internet metatag or in connection with a “paid for placement” search engine.
- a similar position is said to pertain in relation to several other competitors.
- the DVLA is also said to have acknowledged the applicant’s exclusive right.
- internet usage on its own, as relied on by the opponent, is insufficient to establish the opponent’s case. Unregulated websites may be misusing NEW REG.
- as hard copies of the website material have not been supplied the applicant has no information on dates.
- the applicant’s own use goes back to 1991.

6. Both sides filed evidence in these proceedings. Neither side has asked to be heard. Written submissions have been received on behalf of the applicant. This consists of a letter from the applicant’s professional representatives dated 22 February 2006 covering a witness statement by Steven Jackson (who has also given evidence) containing the said submissions. So far as I can see the witness statement/submissions contains no new evidence so it is not clear why they are in this format. However, nothing appears to turn on the point.

7. Acting on behalf of the Registrar and with the above material in mind I give this decision.

Opponent's Evidence

8. Paul Nicholas Brown, Company Secretary of Registration Transfers Ltd, has filed a witness statement. He refers to Collins English Dictionary which indicates that REG is an abbreviation, inter alia, for register. He says that the main objection is that 'NEW' and 'REG' are generic terms and to permit the combination to be registered would not allow other companies within the industry to trade fairly. He exhibits the following in support of his claim:

- PB1- The GOOGLE search engine keyword assistant showing what members of the public type into the search box when looking for the opponent's product.

- PB2-13 Various pages from websites and e-mails that show the term NEW REG used by members of the public without reference to the applicant.

- PB14-18 Various newspaper and magazine articles containing the term NEW REG.

- PB-19 Results from Google showing that, when NEW REG is searched, not all of the hits relate to the applicant.

9. Mr Brown disputes the opponent's interpretation of the reason why his company agreed not to use NEW REG in marketing etc. He says this was on the understanding that the applicant would likewise stop using the term REG TRANSFERS. Finally, contrary to the opponent's claim, potential customers do frequently ring to ask for a NEW REG particularly since new series of marks are issued twice a year by the DVLA. Any registration that they purchase will be a 'NEW REG' for their vehicle and is commonly described as such.

Applicant's Evidence

10. Steven Jackson, the Managing Director of New Reg Limited, has filed a witness statement. This in turn refers back to evidence filed at the ex parte stage to overcome objections raised by the examiner. A copy of that evidence has been exhibited to the counterstatement and is also at Appendix 2 to the opposition evidence but without the accompanying exhibits. However, a new set of exhibits has been filed with Mr Jackson's evidence in the opposition and will be described below.

11. Mr Jackson describes the background to his company's business as follows:

“In particular, the New Reg business was formed following the introduction by the DVLA of new regulations that permitted the number plates to be transferred from a vehicle to a “retention certificate”, before being transferred to another vehicle. The DVLA did not perform the legal transfer of the number plates, and the applicant was set up to deal with the provision and transfer of these plates. The catalyst for setting up New Reg was the introduction of the new regulations.”

12. Turnover since 1991 is given (in the examination stage evidence) as being:

2002	£10,648,761
2001	£ 8,318,906
2000	£ 4,109,678
1999	£ 2,902,319
1998	£ 2,663,450
1997	£ 1,695,538
1996	£ 563,846
1995	£ 498,622
1994	£ 233,048
1993	£ 103,421
1992	£ 91,805
1991	£ 42,514

and advertising expenditure as:

2002	£ 1,125,559
2001	£ 781,557
2000	£ 151,289
1999	£ 155,500
1998	£ 141,741
1997	£ 41,034
1996	£ 41,351
1995	£ 20,804
1994	£ 10,734
1993	£ 12,166
1992	£ 8,462
1991	£ 2,622

13. Promotion of the mark has been through a variety of means including advertising campaigns in service stations, pubs/clubs, shopping centres, radio, television and cinema (Appendix 8), sponsorship activities in particular of Preston North End FC (Appendix 9), press advertising, including Auto Trader, Top Gear, Top Marques, BMW Magazine, Sunday Express, Sunday Telegraph, Sunday Times, Auto Express, Car and What Car (Appendix 10). A considerable bundle of advertisements from Auto Trader and Top Marques are exhibited at Appendices 11 and 12.

14. Mr Jackson says the applicant has had an internet presence since 1995 and is the registrant of newreg.co.uk. It has also acquired the domain name newreg.com. In 2000 it set up an affiliate scheme enabling visitors to websites operated by third parties to access information about NEW REG products. These third parties' websites include the BBC, Lycos, Freeserve, Times online, Sunday Times, A1 Motorstores, Alliance & Leicester and numerous Premiership football clubs. In 2002 the applicant is said to have completed over 16000 sales of cherished number plates on line and claims to have sold more such plates on line than any other company.

15. The applicant is also a member of various trade associations, many of whom are said to have acknowledged the applicant's exclusive rights in the NEW REG brand.

16. The next part of Mr Jackson's evidence deals with the alleged descriptiveness of the mark applied for. He interprets the opponent's objection as being that "Reg" is an abbreviation for registration and, as such, cannot be distinctive in the context of the sale of cherished number plates. Mr Jackson exhibits a number of dictionary references (Appendices 13 to 15) that, with the exception of the Oxford English Dictionary, do not list 'registration' as one of the recognised meanings of the abbreviation 'reg'.

17. He goes on to submit that, even if 'reg' is accepted as a common abbreviation for registration, the juxtaposition is unusual and distinctive. He says that people who wish to purchase a cherished number plate never ask for a 'new reg'. On the basis of the opponent's evidence Mr Jackson says that 'new reg' is used to describe a standard number plate for a new car, in other words the release of vehicle registrations for new cars.

18. Mr Jackson goes on to deal with use of NEW REG by other traders:

“14.1 Prior to the **1991** regulations enabling number plates to be transferred, when the Applicant was set up and began to use the name NEW REG, there was no “trade” in cherished number plates. The Applicant has spent a considerable amount of time and money in developing its brand recognition and goodwill in the name NEW REG for over 14 years. During this time, the Applicant is the only trader of car number plates to have used this name to describe a business selling cherished number plates. It would now be extremely difficult for a third party to use the words NEW REG without taking unfair advantage of the Applicant's goodwill and reputation.

14.2 Apart from occasional instances of its competitors deliberately using NEW REG on the internet as a metatag or a sponsored link, the Applicant is not aware of any of its competitors or any other companies in the motor trade using the name NEW REG in the context of cherished car number plates, whether descriptively or otherwise;

15 In each case, third parties using NEW REG as a sponsored link or a metatag have promptly removed the reference to the Applicant's brand name upon being put on notice of the Applicant's rights. However, the reason the name NEW REG was selected as a metatag/sponsored link by these third parties was precisely because NEW REG is a well-known brand in the context of cherished number plates, and was more likely to increase traffic to the competitors' websites than a descriptive or generic phrase.”

19. The next part of Mr Jackson's evidence is by way of a commentary/critique on the exhibits to the opponent's evidence. The main points are:

- the Google keyword assistant showing what members of the public type into the search box (PB1) is intended to provide information to intended purchasers of sponsored links and accordingly reflects a wish to be linked to the applicant.
- other exhibited material (PB14, 15 and 17 for instance) contains words such as "New 05 Reg Supplement" rather than the applied for mark.
- other exhibits such as PB3, 4, 5, 12 and 13 do not show use in trade but rather are private internet postings or chat room use.
- the Google search at PB19 does not demonstrate that NEW REG has become customary in the trade. The two highest listings refer to the applicant.
- a number of the results are unconnected with the sale of cherished plates or the motor industry.
- each of the examples in Exhibits EPB1-19 are dated after 6 March 2003.

20. Finally Mr Jackson deals with third party acknowledgement of the applicant's rights in NEW REG. The first part of this deals with exchanges (Appendix 17) between the parties dealing with appearances of words in search terms. Appendices 18 and 19 consist of a letter from DVLA agreeing to remove "your company's name as a key word in Overture's search engine facility" and an e-mail from Elite Registrations agreeing not to use the NEW REG trading name in any search engines. I will return to this material in the body of my decision.

21. That completes my review of the evidence.

DECISION

The Law

22. This action has been brought under Section 3(1)(b)(c) and (d). The relevant part of the statute reads as follows:

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

- (a)
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time

of production of goods or of rendering of services, or other characteristics of goods or services,

- (d) 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.”

Relevant Authorities

23. The main thrust of the opponent’s case is that ‘new reg’ is used and understood descriptively in the context of the trade in personal registration plates. I propose, therefore, to start with the objection under Section 3(1)(c).

24. There are now a number of judgments from the ECJ which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), whose provisions correspond to Section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – *Wm Wrigley Jr & Company v OHIM* – Case 191/01P (Doublemint) paragraph 30;
- thus Articles 7(1)(c) (Section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM*, paragraph 31;
- it is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes – *Wm Wrigley Jr v OHIM*, paragraph 32;
- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question – *Koninklijke KPN Nederland NV and Benelux Merkenbureau*, Case C-363/99 (Postkantoor), paragraph 57;
- if a mark which consists of a word produced by a combination of elements is to be regarded as descriptive for the purposes of Article 3(1)(c) it is not sufficient that each of its components may be found to

be descriptive, the word itself must be found to be so – *Koninklijke KPN Nederland NV and Benelux Merkenbureau*, paragraph 96;

- merely bringing together descriptive elements without any unusual variations as to, for instance, syntax or meaning, cannot result in a mark consisting exclusively of such elements escaping objection – *Koninklijke Nederland NV and Benelux Merkenbureau*, paragraph 98;
- however such a combination may not be descriptive if it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements – *Koninklijke Nederland NV and Benelux Markenbureau*, paragraph 99.

25. Two other cases are relevant in considering the application of these principles. In *Campina Melkunie BV and Benelux-Merkenbureau* – Case C-265/00 (BIOMILD) the ECJ indicated that a mark consisting of a neologism composed of elements descriptive of characteristics of the goods was itself descriptive of those characteristics within the meaning of Article 3(1)(c), unless there was a perceptible difference between the neologism and the mere sum of its parts. In contrast, in *Procter & Gamble Company and OHIM*, Case C-383/99P (BABY-DRY) the Court held that, whilst the word combination, BABY-DRY unquestionably alluded to the function of the goods, this did not satisfy the disqualifying criteria set out in Article 7(1)(c) of the Regulation. This was because, whilst each of the two words in the combination may form part of expressions used in everyday speech their syntactically unusual juxtaposition was not a familiar expression in the English language either for designating the goods in question (babies' nappies) or for describing their essential characteristics.

The prima facie position

26. The word NEW requires no explanation. Evidence has been filed dealing with the meaning of REG. The applicant points out that two of the three dictionary references provided give a number of different meanings but that 'registration' is not one of them. The applicant very fairly concedes that the Oxford English Dictionary on the other hand does indicate that it means registration. More than that it does so in the context of vehicles – "a vehicle's registration mark, especially the letter denoting the year of manufacture: a B-reg lorry". It places the origin of the abbreviation as being in the 1960s. So it would appear to be a longstanding and accepted meaning.

27. The mere fact that 'reg' has other possible meanings in different contexts does not assist the applicant's case. It is well established that marks must be seen in the context of the goods or services concerned and by reference to the perception of consumers. It is inevitable that in the context of a trade in vehicle registration plates that REG will be interpreted as meaning 'registration'. Nor, in my view, is that understanding likely to be displaced by the fact that, according to the applicant, the mark was chosen to reflect the fact that new regulations were introduced to facilitate the sale of cherished number plates. Even accepting that this is the case, it seems to me that the applicant must have appreciated the potential for playing on the element 'reg' in terms of suggesting its more obvious meaning.

28. Nevertheless, the applicant has this to say about its choice of mark:

“13.5 Even if the word “reg” is accepted as a common abbreviation of “registration”, the juxtaposition of the two words is unusual, and accordingly, the combination is distinctive of the Applicant’s goods and services. I selected the expression NEW REG in 1991 as a trading name for my new cherished car number plate business because it was not a familiar expression in the trade, nor was it used descriptively by members of the public. Accordingly, the words “new” and “reg” do not frequently occur in this combination, as the opponent claims. The juxtaposition of those two words renders the mark distinctive in relation to the Applicant’s goods and services. For example, people who wish to purchase a cherished number plate never ask for a “new reg”.

and

“13.6 To the extent that the combination NEW REG is used descriptively, it is apparent from the Opponent’s own evidence that it is used to describe a standard number plate for a new car.”

29. A number of points arise from this. Contrary to the applicant’s view, once it is accepted that ‘reg’ is an abbreviation for registration there is nothing at all unusual about the combination NEW REG. In terms of the *BIOMILD* case, if it is treated as a neologism, it is composed of elements descriptive of characteristics of the goods and services and there is no “perceptible difference between the neologism and the mere sum of its parts.” Nor is this a case like *BABY-DRY* where it can be said that it is a syntactically unusual juxtaposition of familiar elements. It is a straightforward adjective and noun combination.

30. However, the applicant submits that the descriptive usage of NEW REG is really in the context of a standard number plate for a new car rather than the business of selling so-called cherished number plates. The first point that needs to be made is that that observation seeks to distinguish new car registration plates from the applicant’s actual trade in cherished plates. But I must consider the notional scope of the specification applied for which is vehicle number plates and registration plates in Class 20 and services in Class 35 closely associated with the sale of such goods. The specification is thus not restricted to the sale of cherished plates.

31. Based on the normal meaning of the words, NEW REG appears to be entirely apt for use in a number of contexts – firstly, any cherished number plate is new to the purchaser, that is to say for him or her it is a new registration. Secondly, the term accurately and obviously describes a new registration plate purchased to replace a damaged one. Thirdly, it describes newly issued registrations. For instance, Appendix 11 of the applicant’s evidence shows “New 03 Registrations”. The advertisement in question is from Auto Trader for 7-13 February 2003 ie at about the time of the issue of new year plates and uses the 03 element in such a manner as to suggest words (eg PR03 LEM). Fourthly, it also appears from the evidence that the DVLA periodically releases registration numbers that have not previously been available (this is a separate matter from the twice yearly release of new vehicle

plates). An example that can be found in Auto Trader is “New WIL Reg’s”. These are also, therefore, new registrations.

32. The applicant is right to suggest that care must be taken to distinguish the common usage of ‘new reg’ in terms of new vehicles. Many of the opponent’s exhibits refer to ‘new reg’ in this context to mean new registration year or period. It seems to me that in this respect ‘new reg’ is being used as a metonymic device standing for the car itself. Thus to take Exhibit PB2 as an example - from its context “The new-reg rush is over” really means the new car rush is over. Examples of this kind are not directly helpful to the opponent’s case. On the other hand Exhibit PB11 is a VRM Swansea Vehicle Registration marketing website page headed ‘NEW REG’ followed by “Are you searching for a new reg?”. These and other references in the advertisement to ‘new reg’ in a similar vein clearly refer to new registration plates. This is descriptive usage in the context not of cars but car number plates.

33. For the above reasons I have no difficulty in accepting that NEW REG is a descriptive term which is apt for use in relation to vehicle registration plates and the sale thereof. In reaching that view I have sought to distinguish use of the same words in relation to cars themselves. However, I would just add that the latter usage places the words in a closely related commercial context. It facilitates and reinforces the use of the same combination in relation to vehicle registration plates cf *FOURNEAUX DE FRANCE Trade Mark*, O/240/02 where the Appointed Person held that a mark which was directly descriptive of cookers was also open to objection in relation to cooker hoods and extractor fans because they were “an integral part of the commercial context in which the meaning and significance of the words FOURNEAUX DE FRANCE is to be regarded as essentially descriptive.”

34. Before leaving the prima facie case I should say that the evidence shows a number of terms in use to describe or refer to the key goods and related services. The most common terms are ‘cherished plates’ or ‘personalised plates’. The applicant claims to be the only trader to have used NEW REG to describe a business selling cherished number plates. It acknowledges that competitors have used the words as a metatag or sponsored link but says that this was precisely because NEW REG is a well-known brand and such links were calculated to increase traffic to the competitors’ websites. Appendices 17 to 19 deal with exchanges with third parties on this subject. To take the first of these, Appendix 17 contains e-mail exchanges with Reg Transfers (the opponent) aimed at achieving a mutually satisfactory position whereby these two traders seek to protect their trading names by ensuring that the other does not secure an unfair advantage through metatag usage or sponsored links.

35. However, the mere fact that certain players in the marketplace were seeking to protect their positions against one another is not an answer to the issue of the distinctiveness or descriptiveness of the marks under which they are trading. I have not, therefore, found these exchanges (or the DVLA’s letter at Appendix 18) to be of particular assistance. The position of the trade at large and the reasonable expectations of future members of that trade must also be considered.

36. Accordingly, I find that the mark NEW REG is open to objection on a prima facie basis under Section 3(1)(c).

37. In the light of this finding I do not propose to give separate consideration to the objections under Section 3(1)(b) and (d). In relation to (b) it was held in *Postkantoor* that:

“86 In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

38. On that basis the objection under Section 3(1)(b) will also have been made out without my needing to consider whether there is also an independent objection under this head though in my view approaching the matter from the perspective of the average consumer who encounters the mark is unlikely to produce a different result. That is to say the mark would lack the requisite degree of distinctive character to be relied on as an indicator of trade origin.

The position on acquired distinctiveness

39. I have set out my view on the prima facie position at some length so that the various bases of objection are clear. In fairness the applicant appears to accept that NEW REG is not registrable as an unused mark. I now turn to the evidence filed in support of the claim that the application is entitled to proceed on the basis of distinctiveness acquired through use. I understand that the evidence filed in this opposition is in substance the same as that filed when the matter was before the Registry's examiner.

40. The guiding principles to be applied in determining whether a mark has become distinctive through use are to be found in *Windsurfing Chiemsee Produktions v Huber* [1999] E.T.M.R. 585.

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

41. I also bear in mind Morritt LJ's observation in *Bach and Bach Flower Remedies Trade Mark* [2000] RPC 513 that:

“..... use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have any materiality.”

42. There are degrees of distinctiveness/indistinctiveness. It is well established that, when comparing marks the distinctive character of the earlier trade mark is a factor to be taken into account (*Sabel BV v Puma AG* [1998] E.T.M.R. 1). A borderline distinctive mark will not attract the same penumbra of protection as an invented word or otherwise highly distinctive mark. The same must also be true in the case of marks that do not have the requisite degree of distinctiveness to achieve registration. A mark may narrowly fail the test or in the case of, say, a generic word or description it may be so wanting in distinctive character that it is incapable of improving its status. Use may assist the former but not the latter as the *Bach* case indicates. It must also follow that the amount of use required to demonstrate that the requisite distinctiveness has been achieved is likely to be dependent on the strength of the objection in the first place. In this case I consider the objection against NEW REG to be a strong one.

43. I have set out above the trading information supplied by the opponent. In terms of its duration and extent it represents a steadily expanding and significant trade. There has been extensive promotion of the business in a variety of media including high profile radio campaigns, sponsorship of Preston North End Football Club and a regular advertising presence in key motoring magazines.

44. What troubles me about the evidence is the nature of the use, the form in which the mark is used and the difficulty in knowing what impact the words NEW REG on their own have made on consumers. At this point, therefore, I need to return to the detail of the evidence.

The marks used

45. The applicant has used a number of variant forms of the mark over the years. Mr Jackson's evidence is that he commenced trading in April 1991 under the mark NU-REG. In or around March 1992 he began to use NEW REG. He says that use of the mark (that is NEW REG) has continued uninterrupted to the present day.

46. Appendices 8 to 12 to Mr Jackson's evidence in the opposition proceedings are the primary documents showing use of the mark(s). It is clear from this material that a number of different versions of marks incorporating the element NEW REG have been used over the years. Mr Jackson does not deal with the chronology of the marks. I have set out in Annexes 1 to 4 examples of the marks used with my estimates of when they were used. I accept in doing so that these are approximations and that there may be some overlap in terms of usage. In terms of the weight of evidence most of the usage is of the www.newreg.com mark (Appendix 4) reflecting, I assume, the fact that this is the most recent usage and illustrations of use of this mark are more readily to hand.

47. The earliest examples of use appear to be the Top Marques advertisements for 1997 (see Annex 1 to this decision and Appendix 12 to Mr Jackson's witness statement). The 1998 material from the same exhibit has the form of mark shown in Annex 2 to this decision. It seems, therefore, that the mark in the form applied for was only in use in 1997 and 1998 (see the Auto Freeway advertisement in appendix 10 as regards 1998 usage). It may have been used in the earlier years but I have not found examples of actual usage between 1992 and 1996.

Use of 'New Reg' in advertising

48. In addition to the fact that the words NEW REG are incorporated into a number of different forms of the mark I note from the advertising material that the applicant's use of the words in the body of advertisements sends out conflicting messages as to whether the words are intended to convey an origin message or are merely descriptive of the nature of the goods/services.

49. The more recent advertising has the consistent strapline "Whatever. We've probably got your New Reg." Interestingly, at some point the applicant started to put a TM symbol after the strapline. The first page of Appendix 11 shows the words without the TM symbol and that is dated December 2002. The same page (and it is typical of what follows) also contains.

"It's so easy to make your own 'personalised' New Reg simply follow the three steps illustrated above"

50. There are other references in a similar vein thus

"EXCHANGE YOUR OLD REG FOR A NEW REG!" (Appendix 10)

"A New Year – A New Reg?" (Appendix 11)

"Give the one you love a New Reg." (Appendix 11)

"..... choose from over 37 million New Reg's" (Appendix 11)

"We will handle ALL your documentation throughout the transfer of your New Reg" (Appendix 12)

"Whatever New Reg your looking for we're absolutely confident it will be on our database." (Appendix 12)

"Be the first to own a newly issued 52 New Reg" Appendix 12).

51. These references are, in my view, no more than natural descriptive references to the goods being offered and the service of supplying them.

52. In fairness to the applicant there are some indications that NEW REG may be intended as more than a descriptive indicator. There is the use of the TM symbol but that appears to have been a more recent addition and is usually attached to the strapline referred to above or the composite/logo mark shown at Annex 4 (the 1997/8

usage of NEW REG simpliciter contained no such indication). The initial letters of the words are also capitalised (see examples above) and may attract a little more attention on that account. The applicant may also say that some of the usage is doing no more than playing on the trade mark/company name. That may be the intention but it sends out a message that is at best ambiguous and, in relation to the goods and services, just as likely to be taken as descriptive usage.

Conclusions on distinctiveness/descriptiveness

53. The most recent evidence in the exhibits to Mr Jackson's witness statement suggest that the applicant has settled on the logo version of its mark (Annex 4) and uses that form consistently in advertising and promoting its business. However, that is not the mark applied for.

54. I do not accept that the usage shown in Annex 4 (and come to that Annexes 2 and 3 as well) necessarily means that the words NEW REG simpliciter have been shown to be distinctive. Nor do I accept that the usage illustrated in Annex 1 was of sufficient duration or of such obviously trade mark character that it displaces this view of the matter.

55. The fact that certain leading players in this particular area of trade may have agreed to respect one another's usage is not proof positive that other traders in the field (existing or in the future) or end consumers will approach those marks in the same way.

56. The applicant may well say that the one consistent element of its marks as they have evolved over the years is the words NEW REG. It may be that for some consumers these words alone will function as a badge of origin. However, there is no evidence from end consumers or the wider trade in this case so the position is a matter of conjecture. To the extent that there is ambiguity then I find the following passage from the Court of Appeal's judgment in the *Bach* case to be of assistance.

“44..... It is contended that there may co-exist in a mark both a distinctive and descriptive meaning. Reliance is also placed on the statement in paragraph 52 of the judgment of the European Court of Justice in *Windsurfing Chiemsee* to the effect that it suffices that the mark is distinctive to “at least a significant proportion” of the relevant class. The converse of that proposition, it is suggested, is that the mark is descriptive to the rest of the relevant class. The suggested conclusion, having coalesced the two points, appeared to be that for the purposes of the proviso to Section 3(1) and Section 47(1) a mark might acquire a distinctive character from use if a significant proportion of the relevant class recognised it to bear both a distinctive character and descriptive connotations.

45. I do not accept those submissions either separately or as coalesced. First, it has never been the law, and counsel of HHL did not suggest that it had been, that the mark must be universally recognised as distinctive. If it were otherwise the rights of traders would be dependent on the views of the ignorant and illiterate. The observations of Viscount Maugham and Jacob J to which the judge referred were not directed to the meaning of a word or mark

to the totality of mankind. What is necessary, in the words of the Act and the Directive, is that the word or mark should “distinguish the goods or services of one undertaking from those of other undertakings” (Section 1(1)) so as “to guarantee the trade mark as an indication of origin” (10th Recital to the Directive). If to a real or hypothetical individual a word or mark is ambiguous in the sense that it may be distinctive or descriptive then it cannot comply with the requirements of the Act for it will not provide the necessary distinction or guarantee. It is in that sense that a common or descriptive meaning must be displaced.”

57. On the basis of the evidence available to me I am not persuaded that the applicant’s use has displaced the natural descriptive meaning of the words NEW REG. The applicant has failed to bring himself within the proviso to Section 3(1).

COSTS

58. The opponent has been successful and is entitled to a contribution to its costs. The opponent has not been professionally represented in these proceedings and is in effect in the position of a litigant in person. It is appropriate to reflect this in the costs award on the basis of Simon Thorley QC’s observations in *Adrenalin* Trade Mark, O/040/02.

“It is correct to point out that the Registrar’s practice on costs does not specifically relate to litigants in person but in my judgment it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6”.

59. Part 48.6 of the Civil Procedure Rules referred to in the above passage provides as follows:

“**48.6-(1)** This rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative”.

60. I order the applicant to pay the opponent the sum of **£800**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of the case if any appeal against this decision is unsuccessful.

Dated this 20th day of June 2006

**M REYNOLDS
For the Registrar
The Comptroller-General**