

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2129557 BY GIBSON GUITAR CORPORATION TO REGISTER A TRADE MARK IN CLASS 25.

DECISION AND GROUNDS OF DECISION

On 15 April 1997 Gibson Guitar Corporation of 1818 Elm Hill Pike, Nashville, Tennessee 37210 applied under the Trade Marks Act 1994 for registration of the trade mark GIBSON in Class 25 in respect of the following goods:

“Clothing for men, women and children; outer clothing for men, women and children; t-shirts, sweatshirts, caps, long sleeve and short sleeve polo shirts, long sleeve Henley style shirts, collared golf shirts, jackets (both cloth and leather) neckties, men’s boxer shorts; boots, shoes and slippers; parts and fittings for all the aforesaid goods.”

Objection was taken to the application under Sections 3(1)(b) and (c) of the Act because the mark is a common surname and that the word “GIBSON” is a generic term for footwear. Objection was also taken to the inclusion of the word “HENLEY” in the specification because it is a registered trademark.

Evidence of use of the mark was filed on 13 February 1998 with the purpose of showing that the mark had acquired a distinctive character as a result of that use. At the same time the specification of goods was amended to :

“Shirts, tee-shirts, sweatshirts, caps, jackets, neckties and men’s boxer shorts.”

This revised specification allows the objections bases on the word “GIBSON” being generic for footwear and the inclusion of the word “HENLEY” in the specification to be waived. However, the evidence was not considered sufficient to overcome the surnominal objection and a hearing was requested by the applicant.

At the hearing, at which the applicant was represented by Mr Allen of J A Kemp & Co, their trade mark agents, the objections were maintained and the application refused.

Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it.

I am satisfied that the objection under Section 3(1)(c) should be waived and I will, therefore, make no further reference to it in this decision.

The relevant part of Section 3(1)(b) of the Act is set out below:

“The following shall not be registered-

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

Firstly I must consider the prima facie case for acceptance.

The surname GIBSON appears more than 600 times in the London Telephone Directory. The Registrar’s practice on surnames alone is set out in the Registry’s Work Manual Chapter 6, August 1998, at Page 37 to 39, and is as follows:

3.12.1 Surnames alone

In considering an appeal against the Registrar’s refusal to register the trade mark MISTER LONG (unreported at the time of writing), Geoffrey Hobbs Q.C., acting as The Appointed Person, stated:

Section 1(1) of the Act (implementing Article 2 of the Directive) confirms that personal names are eligible to be regarded as signs capable of registration. Different persons having the same name nevertheless share the right to use it in accordance with honest practices in industrial or commercial matters under Section 11(2)(a) of the Act (which gives effect to Article 6(1)(a) of the Directive). And Section 3(1)(b) of the Act (which implements Article 3(1)(b) of the Directive) prohibits the registration of trade marks which are devoid of any distinctive character. These provisions indicate to my mind that surnames are neither automatically eligible nor automatically ineligible for registration under the Act. In each case the question to be determined is whether the surname put forward for registration possesses the qualities identified in Section 1(1) of the Act and none of the defects identified in section 3. For the reasons I gave at greater length in AD2000 TM (1997) RPC 167 I think that in order to be registrable a surname or any other sign must possess the capacity to communicate the fact that the goods or services to which it is used recurrently by the applicant are those of one and the same undertaking. When assessing that capacity at the relevant date (the date of application) it is, of course, necessary to bear in mind that surnames, as such, are naturally adapted to identify all individuals so named.”

The surname LONG appearing more than 800 times in the London Telephone Directory was found not to possess a distinctive character. However, Geoffrey Hobbs Q.C. decided that the words MISTER LONG were unlikely to be understood as having surnominal signification in respect of the applicants’ goods - which were unusually elongated frozen confections. Accordingly, the trade mark was deemed registrable for a restricted specification which reflected this characteristic of the goods.

In the light of this case, the Registrar will not accept words which are surnames for

registration *prima facie*, unless having regard to:

- a) the commonness of the surname;
- b) the size of the market (in terms of the number of traders in it) in the goods or services specified in the application;
- c) the nature of the goods or services

- it is likely that the trade mark will be taken as a sign identifying goods or services originating from a single source.

A surname will be regarded as common if there are more than **100 entries** in the London Telephone Directory.

Where the market in the goods or services is small, more common surnames may be capable of distinguishing goods or services. Where the market is very small, eg airline services, even very common surnames may be capable of distinguishing.

Where a word, which is also a surname, is more likely to be taken as a fanciful allusion to the nature of the goods or services (as per MISTER LONG), the trade mark may be capable of distinguishing, even though it is also a common surname. However, a common surname should not be accepted simply because it has another meaning, eg WALKER or READ.

Every case should be decided on its own merits taking account of the above guidance.

Taking account of the guidelines set out above, it is clear that this mark, in respect of these goods, will only be seen as a surname. The surname GIBSON appears more than 600 times in the London Telephone Directory. The goods applied for are ordinary articles of clothing and the clothing industry is one of the largest industries in the United Kingdom.

The word GIBSON does have meanings other than a common surname.

Collins English Dictionary (Third Edition Updated 1994) defines GIBSON as:

“*n. Chiefly U.S.* a cocktail consisting of four or more parts dry gin and one part dry vermouth, iced and served with a pickled pearl onion.”

It is also the name of a desert in W central Australia.

In my view anyone seeing the trade mark GIBSON used in relation to the goods for which registration is sought would only see the mark as a surname and, for the reasons given earlier in this decision, I consider it to be devoid of any distinctive character. It follows that this application is debarred from *prima facie* acceptance for registration by Section 3(1)(b) of the Act.

However, that is not the end of the matter since I have to consider the evidence filed which,

the applicants contend, shows that the mark has acquired a distinctive character as a result of the use made of it.

The proviso to Section 3(1) is in the following terms:

“Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above, if. Before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

The evidence submitted prior to the hearing consists of a Statutory Declaration from Mr Douglas Charles Ellis. Mr Ellis has been involved in the music trade, and with Gibson guitars, since 1963. In 1981 he became General Manager of Rosetti Limited, a company who were an agency for the sale of Gibson guitars. In 1985 he and Mr Peter Chapman effected a management buy-out of Rosetti Limited.

Mr Ellis goes on to state that the applicants decided to start making and marketing clothing in 1995. This clothing was very much associated with the music industry and was introduced into Great Britain in 1996. The following figures reflect the total turnover in respect of these sales, and the spend on advertising, from April 1996 to November 1997.

DATE	UNITS SOLD	TURNOVER (RETAIL)	ADVERTISING
04.1996 - 03.1997	796	£13,100	£2,825
04.1997 - 11.1997	476	£7,100	£1,300

I note that the application was filed on 14 April 1997 and I am, therefore, not able to take any account of any use of the mark after that date.

Exhibit DCE1 consists of three brochures. The first brochure is entitled “Gibson strings & Accessories”. It is dated 1996 and offers for sale electric guitar strings, articles of clothing, collectible memorabilia, replacement parts for Gibson guitars and guitar accessories. The clothing contained in the brochure is:

“Shirts, tee-shirts, sweatshirts, caps, jackets and denim jackets.”

The second and third brochures are “Rosetti price lists” dated September 1996 and April 1997. These brochures contain electric guitars, acoustic guitars, guitar cases, articles of clothing, collectible memorabilia, guitar accessories and other musical instruments.

Exhibit DCE2 consists of two magazines. The first is a magazine entitled “Guitarist” and is dated January 1997. On page 119 of this magazine is an advertisement by “Rosetti” for the following articles of clothing:

“Tee-shirts, sweatshirts, caps and denim jackets.”

The second magazine, dated July 1997, is entitled “Guitar”, and page 85 contains an identical

advertisement to the one referred to above in the magazine entitled "Guitarist".

Exhibit DCE3 is for various purchase orders for *inter alia*, the following articles of clothing:

"Tee shirts, sweatshirts, caps and denim jackets."

Many of the exhibits referred to show the goods in question but unfortunately none of these goods appear to carry the mark as applied for. The sign appearing on the goods is a stylised version of the word GIBSON which is always accompanied with other matter, usually a guitar or part of a guitar. The mark applied for does appear in the descriptions of the goods, on the price lists and on the purchase orders but I consider this use to be subordinate to the use of the stylised version of the mark.

Leaving that aside, use of the mark does not, in itself, equate to distinctiveness.

In the TREAT trade mark case (1996 RPC 296), Jacob J remarked:-

"Mere evidence of use of a highly descriptive or laudatory word will not suffice, without more, to prove that it is distinctive of one particular trader - is taken by the public as a badge of trade origin. This is all the more so when the use has been accompanied by what is undoubtedly a distinctive and well recognised trade mark."

The applicant has a very good reputation for guitars and guitar accessories. These goods appear, from the evidence before me, to be marketed under the stylised version of the word GIBSON. If the goods applied for in this application were sold under the stylised version of the mark then that mark may be able to serve as a badge of origin for such goods. However, I do not consider that the use of the word GIBSON in plain capital letters would serve as a badge of origin for these goods. The word GIBSON is a very common surname appearing more than 600 times in the London Telephone Directory. The mark has been used for a period of only 1 year with a turnover amounting to £13,100. The goods applied for are ordinary articles of clothing which are sold in many retail outlets throughout the United Kingdom. In my view this level of use of the mark is insufficient to turn the mark from one perceived as a common surname to one identifying goods that emanate from one particular source.

My understanding from discussions at the hearing is that the applicant has prior rights in the mark GIBSON for guitars and associated goods but there is no evidence before me on this. However, it is worth noting Registry practice on this point which makes it clear that for a prior registration to even possibly assist the goods applied for would need to be the same or similar to those for which the mark is already registered. I do not consider that articles of clothing in Class 25 are similar goods to guitars and associated goods in Classes 9 or 15. I have therefore concluded that such prior rights are of no assistance insofar as this application is concerned.

It is my conclusion that the mark is devoid of any distinctive character. Furthermore there is no evidence that the mark has acquired a distinctive character as a result of the use made of it. I therefore conclude that the application is not acceptable for registration under Section 3(1)(b) of the Act.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 3(1)(b) of the Act.

Dated this 16 day of June 1999

A J PIKE
For the Registrar
The Comptroller General