

O-221-04

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. 2340273
TO REGISTER A SERIES OF FOUR TRADE MARKS
IN CLASSES 9, 35, 36, 37, 38, 39, 41 & 42
BY TIME GROUP LIMITED**

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DECISION AND GROUNDS OF DECISION

Background

1. On 9th August 2003, Time Group Limited of Time Technology Park, Burnley, Lancashire, BB12 7TG applied to register the following four trade marks:



The applicant claims the colours blue, red and white as an element of the first and second series of the marks.

2. The goods and services for which protection is sought are as follows:

Class 9:

Computer hardware; computer software; computer games; computer peripheral devices; amusement apparatus adapted for use with television receivers; photographic apparatus and equipment; apparatus and equipment for recording and/or reproducing sound and/or images; telecommunications apparatus and equipment; compact discs; DVD's; magnetic data media; audio and video tapes and cassettes; publications in electronic format; spectacles; spectacle frames; sunglasses; sunglasses frames; spectacle and sunglasses cases; luminous signs; batteries; battery chargers; electronic time recording devices; optical data media; data processing apparatus; electric plugs, sockets, contacts and connectors; remote control apparatus; automatic time switches; parts and fittings for all the aforesaid goods.

Class 35:

Advertising, promotional and information services; business advisory and information services; all provided on-line, or via the Internet; the bringing together for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase goods from a general merchandise catalogue by mail order, or by means of telecommunications, and from a general merchandise website, and from a retail electrical and electronic store, a retail computer store, and a retail telecommunications store.

Class 36:

Credit services; insurance services; warranty services.

Class 37:

Installation, maintenance, repair and servicing of computer hardware, computer peripheral devices, photographic, apparatus and equipment, apparatus and equipment for recording and/or reproducing sound and/or images, and telecommunications apparatus and equipment; advisory, information and consultancy services relating to the aforesaid.

Class 38:

Telecommunications services; provision of access to the Internet; electronic mail services; provision of Internet access services in a café; advisory and consultancy services relating to the aforesaid.

Class 39:

Transport of goods; packing and packaging services; warehousing services; storage services; advisory and consultancy services relating to the aforesaid.

Class 41:

Entertainment, education and information relating thereto provided on-line from a computer database or via the Internet; electronic games services provided on-line or via the Internet; provision of on-line publications; gaming services; advisory and consultancy services; relating to the aforesaid.

Class 42:

Computer design services, computer programming services; advisory and consultancy services relating to computer hardware, computer software, computer networks; web site maintenance, creation and hosting services; providing access, and leasing access time to computer networks, computer databases and the Internet; provision of café services which offer Internet facilities; computer rental services; advisory and consultancy services relating to the aforesaid.

3. Objection was taken against the application under Sections 3(1)(b) of the Act because the marks consist essentially of the words COMPUTER SHOP, being a sign which is devoid of any distinctive character for any goods or services provided in a computer shop.

4. A hearing was held on 5th February 2004 at which the applicant was represented by Mr Bruce Marsh of Wilson Gunn M’Caw, Trade Mark Attorneys. The objection was maintained and the application was subsequently refused on 8th March 2004 in accordance with Section 37(4) of the Act.

5. Following refusal of the application 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.

6. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

The law

7. The relevant part of Section 3 of the Act is as follows:

“Section 3(1):

The following shall not be registered-

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

Decision

8. In support of the application, Mr Marsh referred me to the mark of the applicant’s later filed application no. 2344345, covering the same range of goods and services, which was accepted by the registrar and subsequently registered. That mark is reproduced below:



9. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently 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, Windward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

“37. It must first of all be observed 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 and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule 1 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* [2002] ECR I-5475, 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”.

10. I must assess the marks’ distinctiveness in relation to the goods and services for which the applicant seeks registration taking into account the perception of the relevant consumers. In my view, given the range of goods and services involved, the items for which protection is sought would likely be purchased by a wide cross section of the population, ranging from the trade to the general public. Furthermore, it is well established that the test for distinctiveness must be judged against the marks as a whole.

11. The marks tendered for registration comprise the words THE COMPUTER SHOP together with other matter. In the case of the first two marks in the series, these words are shown on a red coloured rectangular background which is bordered by two vertical blue coloured strips. The remaining two marks are essentially the same with the exception that they are represented in monochrome.

12. In my view the words contained in the marks are their most prominent feature and their meanings are so well known that I do not have to provide dictionary definitions. The presence of the definite article “the” does not, in my view, add anything of distinctive character to the marks. However, I must, of course, consider the marks as a whole before deciding whether they are devoid of any distinctive character. In doing so I need to take account of the presence of the device and colour elements and whether the combination of these and the words result in distinctive trade marks.

13. In relation to the marks which include colour claims, I do not consider that there is anything particularly distinctive about these colours or about the way in which they are presented. The colours red and blue are no more distinctive than any other two colours and furthermore, the colours as presented are mere background to the words. I am therefore of the view that the presence of these colours does not affect the question of overall distinctiveness.

14. In consideration of all the individual elements when viewed in their totality, it is my opinion that all four marks are devoid of any distinctive character. In the context of the products supplied under the mark, the overall impression which is likely to be conveyed to potential customers is that the applicant operates a shop which specialises in computers and from which various goods or services may be obtained. For example, the Class 35 specification includes an indication that the applicant intends to provide retail services in this particular field. There is no origin or trade mark message which might lead me to believe that goods or services originate from a particular undertaking and thus distinguish the applicant’s products from products of other undertakings.

15. I should also deal with the registration Mr Marsh brought before me at the hearing. In essence of course it is well established – see *British Sugar v. James Robertson & Son Ltd* [1996] R.P.C. 281 and *Madame* [1966] R.P.C. 541 that precedents or the state of the Register are in principle irrelevant. However, this is a very recent acceptance of an application made by the same applicant. In my view the two cases can be distinguished by the overall visual impact they create. Registration no 2344345 has a visual identity quite different to the application in suit and

whilst on the face of it the marks share some features, they are certainly not completely analogous. In particular, the registration includes a distinctive feature that is prominently placed to the left of the words “the computer shop”. Whilst this mark was accepted in the prima facie, I do not agree that its acceptance assists the present case for registration. It is my view that in order to achieve registration of the marks of this application, it will be necessary for the applicant to show that they have acquired a distinctive character through use in the market place.

Conclusion

16. In this decision I have considered all documents filed by the agent, and for the reasons given the application is refused under the terms of Section 37(4) of the Act because the mark fails to qualify under Sections 3(1)(b) the Act.

Dated this 27th day of July 2004.

Charles Hamilton
For the Registrar
the Comptroller-General