

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION No 2313504
BY LINKIN PARK LLC
TO REGISTER A TRADE MARK
IN CLASSES 9, 14, 16, 18, 21, 25, 26 AND 41**

DECISION AND GROUNDS OF DECISION

Background

1. On 18 October 2002 Linkin Park LLC of 15260 Ventura Boulevard, Suite 2100, Sherman Oaks, California, CA 91403, United States of America applied to register the trade mark LINKIN PARK in Classes 9, 14, 16, 18, 21, 25, 26 and 41.

2. Following the transfer of “Key rings” from Class 26 to Class 6 registration is sought for the following goods and services:

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| Class 6 | Keyrings. |
| Class 9 | Audio, visual and audiovisual recorded materials; records, compact discs, and cassettes bearing audio recordings; DVDs, videotapes and film bearing audiovisual recordings. |
| Class 14 | Articles of or coated with precious metal; jewellery; clocks and watches. |
| Class 16 | Books; printed matter; stationery; address books; appointment books; autograph books; notebooks; poster books; song books; tour books; diaries; magazines; posters; calendars; cards; greeting cards; Christmas cards; albums; writing implements; pencils; pens; writing paper and envelopes; decals; stickers; paperplace mats; paper coasters and lithographs. |
| Class 18 | Wallets; purses; bags; handbags, shoulder bags, rucksacks and articles of baggage; umbrellas. |
| Class 21 | Candle holders; mugs; small domestic containers and utensils; tableware. |
| Class 25 | Clothing, footwear and headgear; T-shirts; jackets; baseball caps. |
| Class 26 | Badges for wear. |
| Class 41 | Entertainment services; live musical performances; endorsement and publicity appearances; production of films, videos, radio and television programmes; performances intended for distribution via wide area networks. |

3. Objection was taken against the application under Section 3(1)(b) and (c) of the Act because the mark consists of the name LINKIN PARK the whole being a sign that may serve in trade to designate the subject matter of the goods. This objection was taken in Classes 16 and 21 only and it was taken because LINKIN PARK is the name of a Californian music band formed in 1996 who have produced five albums and have participated in several tours. They are well known in the United Kingdom where their music appeals to the younger music fan. My understanding is that these facts are not in dispute.

4. At a hearing, at which the applicants were represented by Mr Gallafent of Gallafent & Co, their trade mark attorneys, the objection under Section 3(1)(b) and (c) was waived in Class 21 but maintained in Class 16 in respect of “Printed matter, posters, calendars, decals, stickers”. The objection was waived in respect of the remaining goods in Class 16.

5. Following subsequent correspondence the objection was maintained only against “Printed matter, posters and poster books” in Class 16.

6. 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.

The Law

7. Section 3(1)(b) and (c) of the Act reads as follows:

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

(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;”

The case for registration

8. At the hearing and during subsequent correspondence, Mr Gallafent placed great reliance upon the decision by the Court of Appeal in *Arsenal v Reed* [2003] RPC 710. In correspondence dated 20 October 2003 Mr Gallafent made *inter alia* the following submissions:

“Referring to the core judgment of the Court of Appeal at paragraph 48, the Court of Appeal found that Mr Reed’s use in the *Arsenal* case “was liable to jeopardise the guarantee of origin which constituted the essential function of the trade mark rights owned by Arsenal.”

The judgment of the Court of Appeal goes on to say:

“As found by the judge, the trade marks, when applied to the goods, were purchases and worn as badges of support, loyalty and affiliation to Arsenal, but that did not mean that use by a third party would not be liable to jeopardise the functions of the trade marks, namely the ability to guarantee origin. To the contrary, the wider and more extensive the use, the less likely the trade marks would be able to perform their function. As the ECJ pointed out, the actions of Mr Reed meant that goods, not coming from Arsenal but bearing the trade marks, were in circulation. That affected the ability of the trade marks to guarantee the origin of the goods. I therefore conclude that the result reached by the ECJ was inevitable once their judgment had made it clear that the material consideration was whether the use complained of was liable to jeopardise the guarantee of origin, not whether the use was trade mark use.”

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We turn, therefore, to the specific consideration of the question of whether, following Arsenal, the Registrar can properly maintain a position that, under the provisions of Section 3(1)(c), printed matter, posters, calendars, decals and stickers should be refused registration of what is otherwise a distinctive and registrable mark.

We submit that in connection with posters, calendars, decals and stickers, there can be little doubt. All four are specific items which are customarily “traded”. The sale of posters, calendars, decals and stickers takes place through a wide variety of trade channels and we submit that the sale of such items (which could, of course, be purchased by the purchaser with a view to showing their allegiance to the party whose name appears on them) would be economically detrimental to the owner of the mark if the goods in question were made otherwise than by that owner or with his permission.”

9. In the same submissions Mr Gallafent said:

“Put very simply, the Arsenal decision puts in context the exceptions to infringement set out in Article 6(1) of the Directive and essentially legitimates registration of a distinctive mark for any goods and services whatever where the mark owner can be expected to profit from the use of the mark on such goods or in connection with such services and, conversely, to suffer economic detriment if such use by others were permitted.”

10. I note that Mr Gallafent refers to the “registration of a **distinctive** (emphasis added) mark”. This is important because it is my view that the words LINKIN PARK are not distinctive for the goods at issue.

Decision

11. 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 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-0000, 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.”

12. As I have previously indicated this objection now relates only to “Printed matter, posters and poster books” in Class 16.

13. 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. The mark is the name of a music band, and when used as the subject matter of posters etc., it will do no more than represent a characteristic of these goods.

14. In an Opinion issued by Advocate General Jacobs in Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Zapf Creation AG (New Born Baby) guidance was provided on this point at paragraph 28:

“28. It is an essential characteristic of many toys, and of all those classed as dolls, that they represent something. The characteristics of a toy motorcycle differ from those of a toy giraffe, and are certain to be perceived immediately by potential purchasers as defining the nature of the toy (and as relevant to their purchasing choice). In trade, the terms ‘motorcycle’ and ‘giraffe’ (or ‘racing motorcycle’, ‘baby giraffe’ etc.) are important to both buyer and seller in identifying the class or subclass of toy in question. It would surely not be compatible with Article 7(1)(c) to register ‘Giraffe’ or ‘Motorcycle’ for the relevant class of toy. The situation is the same for a child’s doll representing a new-born baby, a princess, a soldier or any other kind of person.”

15. Although that application was concerned with goods in Class 28 I believe that the same principle holds for this application. The purchasers, and potential purchasers, of posters etc. purchase particular posters because they represent something to them. In this case the name LINKIN PARK represents the band who produces music to which the purchaser enjoys listening. The name LINKIN PARK appearing on posters etc. is the subject matter of the goods which itself is an essential characteristic of such goods. By contrast, whereas the name LINKIN PARK would be perceived as subject matter when used on or in relation to posters etc. the same cannot necessarily be said about the use of the name ARSENAL when used in relation to articles of clothing.

16. In his submissions Mr Gallafent has placed reliance on the Court of Appeal judgment in Arsenal v Reed but this is a case which was concerned with the rights of the proprietor of a registered trade mark. Everything that the Court of Appeal said was necessarily postulated on the footing that the ARSENAL trade mark was validly registered. This judgment was not concerned with the question of the registrability of the trade mark ARSENAL and is therefore irrelevant to the issue in this case.

17. I note that the earlier High Court judgment [2001] E.T.M.R. 77 does include a finding that the ARSENAL trade mark is validly registered for scarves and shirts. However, because ARSENAL may be validly registered for these goods it does not necessarily follow that ARSENAL may be validly registered for posters and poster books.

18. I must consider if there is, or is liable to be, a wide demand for posters etc. bearing the name LINKIN PARK. I have already concluded that LINKIN PARK is the name

of a well known music band with an established following in the United Kingdom. In the circumstances there is likely to be a wide demand for such goods. The next question to be considered is, given that there is likely to be a wide demand for posters etc. bearing the name LINKIN PARK then are there reasons for assuming that third parties will be able to legitimately enter such trade. Third parties are, of course, entitled to take and exploit pictures of celebrities – the copyright in a picture of LINKIN PARK belongs to the creator of it and not necessarily to the group itself. A party wishing to trade in a product which is essentially the embodiment of a work in which it owns the copyright - e.g. a poster – positively needs to use the name of the subject matter in order to conduct such a trade. The name is not therefore merely “capable” of designating a characteristic of the product – it is essential.

19. Consequently, I have concluded that the mark applied for consists exclusively of a sign which may serve in trade to designate the kind and intended purpose of the goods and services and is, therefore, excluded from registration by Section 3(1)(c) of the Act.

20. Having found that this mark is 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.

21. 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, 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.”

22. In my view the consumer, bearing in mind that it is likely to be common practice for third parties to market and trade in posters and poster books which carry the name of a music band, would not consider this mark to denote trade origin. I am not persuaded that the combination of the words LINKIN PARK 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 goods of the applicants from those of other traders.

23. In my view the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

Conclusion

24. In this decision I have considered all the documents filed by the applicants 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 Sections 3(1)(b) and 3(1)(c) of the Act.

Dated this 3rd day of August 2004

**A J PIKE
For the Registrar
The Comptroller-General**