

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 2149161
BY
PSYGNOSIS LIMITED
TO REGISTER A TRADE MARK IN CLASS 9

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DECISION

Background

On 28 October 1997, Psygnosis Limited of Napier Court, Stephenson way, Wavertree Technology Park, Liverpool, UK, applied under the Trade Marks Act 1994 for registration of the mark **WORLD TOUR GOLF**, in respect of the following goods in Class 9:

Computer and video games; computer and video game programs.

Objection

An objection to the application was taken under Section 3(1)(b) of the Act on the ground that the mark is devoid of distinctive character for goods relating to the game of golf. No objection was taken under Section 3(1)(c) of the Act, but it is clear from the reasons set out in this decision that the mark is devoid of any distinctive character because it consists exclusively of a sign which may serve in trade to designate the kind or intended purpose of the goods.

Hearing and decision

At a hearing at which the applicant was represented by Mr B Marsh of Wilson Gunn M’Caw, the objection was maintained and 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 provide a statement of the reasons for my decision. No evidence of use was filed in these proceedings . I therefore only have the prima facie case to consider.

At the hearing and in correspondence, Mr Marsh put forward various arguments in support of the application. Mr Marsh did not dispute that the subject matter of the computer and video games and computer and video game programs related to golf, but, he argued, there was no such thing as a “World Tour” golf competition and the term, in its entirety, was an invented and fanciful term which to referred a fictional event. Moreover, the mark was not being used in Class 41 in respect of golf tournaments but in Class 9 as a computer game or games program and therefore the objection was inappropriate. Mr Marsh pointed out that the mark was presented as **WORLD TOUR GOLF** and not **WORLD GOLF TOUR** and that the ordering of the three words comprising the mark was a factor which I ought to take into consideration.

Prior to, and at the hearing, Mr Marsh was given various print-outs obtained from web sites on the Internet in which reference was made to the future setting up of a World Tour in relation to golf. A sample of these is attached to the annex to this decision.

5 Mr Marsh disputed the validity of the information conveyed to him and argued that references from the Internet which referred to events post-dating the date of application should not be relied upon by the registrar. Mr Marsh stressed that at the date of the application no world tour golf competition existed and the mark was distinctive in relation to the goods applied for.

10 These arguments did not persuade me that the mark was not devoid of any distinctive character.

The relevant part of the Act under which the objection was taken is as follows:

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

15 (b): trade marks which are devoid of any distinctive character.”

The mark consists of the World Tour Golf. The words “world” and “golf” are well known and do not require explanation. The word “tour” has a number of meanings, and the most relevant definition is shown in the New Oxford Dictionary of English, 1998 edition as follows:

20 **tour 2 • (the tour)** (in golf, tennis, and other sports) the annual round of events in which top professionals compete.

25 Without reference to the goods included in the application, the phrase “world tour golf” would, in my view, indicate to the public a golf competition which is conducted on a worldwide basis. It was common ground that at the date of the application there did not appear to be a World Tour Golf competition in existence, but it is clear from information found on web sites on the Internet that such a competition is in the process of being developed. It seems that these plans have not yet to come to fruition. However, I take the view that the question of whether there was an
30 actual competition in being at the date of application is not a relevant test to apply when considering the question of distinctiveness. The phrase “World Tour Golf” is in my view a wholly apt description for a golfing competition and given its derivation is neither fanciful nor invented when used in relation to computer games or games programs which have a golfing theme.

35 In relation to new products with wholly descriptive names, Templeton L.J. said in the McCain International Ltd v Country Fair Foods Ltd and another (1981) RPC 69 (The “Oven Chips” case) before the Court of Appeal (in which referring to the Cellular Clothing Company v Maxton & Murray (1899) A.C. 326 case), on page 75 line 35 continuing to line 5 on page 76:

40 “Similarly in the same case at page 344, again in words I find helpful in the present case because they deal with the invention of a new product, Lord Davey said this:

45 ...where a man produces, or invents, if you please, a new article and attaches a descriptive name to it - a name which, as the article has not been produced before, has, of course, not been used in connection with the article - and secures for himself either a legal monopoly or a monopoly in fact of the sale of that article for a certain time, the evidence of persons

5 who come forward and say that the name in question suggests to their minds and is associated by them with the plaintiff's goods alone is of a very slender character, for the simple reason that the plaintiff was the only make of the goods during the time that his monopoly lasted, and therefore there was nothing to compare with it and anybody who wanted the goods had no shop to go to, or no merchant or manufacturer to resort to, except the plaintiff....If a man invents a new article and protects it by a patent....he has a legal monopoly; but when the patent expires all the world may make the article, and if they may make the article they may say that they are making the article, and for that purpose use the name with the patentee has attached to it...."

10 And on page 72, lines 37-48, Templeton L.J. said:

15 "Mr Harman, in a very forceful and if I may say so, very attractive argument, submitted that "oven chips" is a fancy name and not a phrase in common use in the English language, so that it will be associated with one particular manufacture and not with a product. He said it is novel phrase - and that is true; it has never been used before - that also is true. He castigated the phrase as ungrammatical aggregate of two English nouns and said that it was nonsensical without an explanation. But in my judgement the words "oven chips", grammatical or not, constitute an expression which is an ingenious and apt description of the contents, namely, potato chips prepared for cooking in the oven; and although the consumer may not have been aware, and could not have been aware of what the expression meant until oven chips came on to the market, once they had come on the market he could recognise a name which is apt and appropriate to describe a product rather than a manufacturer, the product being potato chips prepared for cooking in the oven".

25 I have to acknowledge that in the present application there is not an exact parallel with the above case, in that "oven chips" were both the goods and the mark. In the present application, the goods which are sold under the mark, computer games or games programs, simulate a golf competition and I therefore agree with Mr Marsh that these goods are a stage removed from the conducting of a golf competition, since a real golfing tour is not involved. However, I believe the same principle as set out in the above decision applies to this application. The fact that the use of the mark is confined to computer games or games programs, which relate either to a fictitious golf tour in the present, or a real golf tour in the future, cannot turn WORLD TOUR GOLF, which is an apt description, into a sign which is prima facie distinctive for the goods.

35 In *British Sugar PLC and James Robertson and Sons Ltd* (1996) RPC 281 (referred to as the TREAT decision), Mr Justice Jacob said (page 306, lines 2-13):

40 "Next, is "Treat" within Section 3(1)(b). What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned ("North Pole" for bananas) can clearly do. But a common laudatory word such as "Treat" is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word *inherently* from the old Act but the idea is much the same) devoid of any distinctive character."

5 In my view a mark which is put forward for registration and is a wholly apt description for a sporting competition, whether fictional or real, must also be devoid of any distinctive character for the title of a computer game or games program which is based on that competition. In the present application, the fact that the tour may not have been in existence at the date of application is not relevant - the issue that has to be determined is whether the mark put forward is one which is a distinctive mark for the goods. Having established that WORLD TOUR GOLF is an apt name for a golfing competition, I do not consider that the public would perceive such a combination as a distinctive trade mark when used as a computer game or games program title. The public would require education that WORLD TOUR GOLF was a trade mark.

10 Moreover, I have to take into account the effect that registration of the mark would have on other businesses. In the AD2000 trade mark (1997) RPC 168, Geoffrey Hobbs QC said:

15 “Although Section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse registration of signs which are excluded from registration by the provisions of Section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacob Esq QC in his decision on behalf of the Secretary of State in *Colorcoat Trade Mark* [1990] RPC 551 at 517 in the following terms:

20 “That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see e.g. *Yorkshire Copper Work Ltd’s Trade Mark Application* [1954] RPC 150 at 154 lines 20-25 per Viscount Simonds LC. Essentially the reason is that the privilege of a monopoly should not be conferred where it might require ”honest men to look for a defence”.”

30 In the LAURA ASHLEY trade mark (1990) RPC 539, Robin Jacob QC said:

35 “What the Registrar has to have in mind is what monopoly is being created. He has to ask himself, as a guardian of the public interest, whether that monopoly will interfere with the legitimate rights of others, not only of today, but “tomorrow and the day after tomorrow”, to use Viscount Simonds’ vivid expression, *YORKSHIRE Trade Mark* (1953) 71 RPC.”

40 It seems to me that the applicant is attempting to establish a monopoly in a mark which at the present time ought to remain in the public domain. However, I do not say WORLD TOUR GOLF is in that category of marks which is incapable of distinguishing and consequently unregistrable and it may be the case that through use it in the market place it could, in time, acquire a distinctive character.

45 There is one final point. Mr Marsh urged me take account of the ordering of the words in the mark- it was presented as WORLD TOUR GOLF rather than WORLD GOLF TOUR. In my view these differences do not affect the matter one way or another since either version would be interpreted by the public as a description and not as an indicator of origin.

Conclusion

The mark is not acceptable prima facie because it is debarred from registration under Section 3(1)(b) of the Act.

5 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.

10 Dated this 30 day of November 1998

15 Charles Hamilton
For the Registrar
the Comptroller General



By Brendan Moloney

18 September 1996

World Tour moves closer to reality

After years of talk and speculation about a world circuit, the ruling bodies of professional golf have given approval for events after 1998 that will allow the best players in the world to take part in "world championship" style competition.

The move was most recently proposed as a privately-run venture recently by Greg Norman with backing from media magnate Rupert Murdoch and got some support from leading players, before being bitterly attacked by the bulk of the players and Tour officials around the world.

The initiative was announced at Lake Manassas in Virginia, jointly by the Tours of the US, Australasia, Japan, Europe and South Africa after the President's Cup.

A statement issued by US Tour Commissioner Tim Finchem on Monday said the aims of the five Tour groups were:

- The formation of the PGA Tour International Federation.
- Joint sanctioning by the members of the Federation of significant competitions, including some at the world championship level, for the game's top players.
- Setting up a structure generally accepted as a worldwide ranking system.

Australasian Tour chief Brian Allan, Japan's Shoichi Asami and Brent Chalmers of South Africa attended the talks while European boss Ken Schofield participated by phone from England.

"Over the past two years, the five Tours have worked towards some common goals," said Finchem. "We feel we need a federation to help promote the game internationally. We also see a need to provide more opportunities, including at least three world championship events, for the top ranked players in the world to compete internationally.

"We recognise the need for a jointly sanctioned world ranking system that would offer all golf organisations and the major championships a consistent method of determining eligibility for their events. And we wanted to do all of that in a manner consistent with the general principles for the expansion of international competition that were announced two years ago."

At the first President's Cup meeting in 1994, following a proposal from Brian Allan, the five Tours now in the Federation formed a group known as the World Forum of PGA Tours to discuss matters of common interest. Over coming months the new Federation will develop a plan for joint sanctioning of events including at least three world championship events for 1999. It is proposed there will be one strokeplay, one matchplay and one teams event.

"The three world championships and other potential co-sanctioned events will be organised in such a way as to enhance existing Tour schedules and ensure the major golf tournaments of the world retain their premier status," Finchem said.

Fields in the world championship events will be chosen primarily through a world ranking system and the PGA Tours International Money List - a compilation of money won on all five Tours expressed in US dollars - which was introduced earlier this year.

"As we move forward, we will do so in keeping with the principles agreed upon in 1994," Finchem said. "Those principles require that any increase in international competition must be beneficial to the game of golf and positively impact the image of the sport and its players; command the support of world golf and the major organisations; be compatible with the world golf structure; and be consistent with the competitive playing opportunities sponsored by the existing Tours and their memberships."

The Federation is holding discussions with the organisers of the Sony Rankings which were introduced 10 years ago in an attempt to compare the performances of players on circuits around the world. It was a difficult task because the majority of players being ranked seldom, if ever, competed in the same events.

"We have proposed certain modifications to the governing structure of the Sony Rankings," said Finchem. "If these discussions (with Mark McCormack's International Management Group) are successful, it will lead to a Sony Ranking System with such enhanced credibility that it will be used as part of the eligibility mix by the major championships and, along with the PGA Tours International Money List, these rankings will be major criteria for eligibility in the world championships of the Federation. We hope to announce specifics of these modifications within the next 90 days."

Bransdon wins at Barham

Victorian David Brandson shot rounds of 68 and 70 at the weekend to take out the \$20,000 Barham pro-am by a stroke from Darren Cole.

Brandson's opening four under par 68, the lowest score in the two-day event, was matched by Darren Eckhardt and Darryl Brown in the second round but was still two shots short of the course record held by Barham GC professional Robbie McNaughton and Tour player Tim Elliott.



Runner-up Darren Cole playing his tee shot at the par three 10th hole.

Cole produced rounds of 70 and 69 while third place was shared by Englishman Ben Jackson, the winner of last year's Victorian PGA Order of Merit, and Euan Walters on 140.



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FTC closes investigation of regulations of PGA Tour

The Federal Trade Commission has voted to close its investigation of certain regulations of the PGA Tour without taking any action.

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The investigation resulted from the PGA taking action to prevent its members from competing on the World Tour. Greg Norman rattled the golf world by announcing the formation of a world golf tour in cooperation with the Fox television network. PGA Tour Commissioner Tim Finchem responded to the initiative by insisting that any participants in the World Tour would have to resign from the PGA Tour.

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"We are delighted that the Federal Trade Commission has closed its investigation and chosen not to issue a complaint," said Finchem. "The PGA Tour intends to continue its strategy of growing golf and its charitable contributions in the years ahead."



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