

O-258-05

TRADE MARKS ACT 1994

**IN THE MATTER OF AN
APPLICATION No 2360256B
BY HALEWOOD INTERNATIONAL
BRANDS LIMITED
TO REGISTER A TRADE MARK
IN CLASSES 16 AND 21**

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DECISION AND GROUNDS OF DECISION

Background

1. On 5 April 2004 Halewood International Brands Limited of The Sovereign Distillery, Wilson Road, Huyton Business Park, Liverpool, L36 6AD applied to register the trade mark AMBERLEIGH HOUSE in Classes 16, 18, 21, 25, 32 and 33.

2. The application was subsequently divided into two applications. One was accepted and I need say no more about that section of the original application. The other divisional application, which is the subject of this decision, covers the following goods in classes 16 and 21:

Class 16 Posters, stickers, transfers, photographs and paintings.

Class 21 Figurines and statues

3. Objection was taken against the application under Section 3(1)(b) and (c) of the Act because the mark consists of the name AMBERLEIGH HOUSE 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 AMBERLEIGH HOUSE is the name of the winning horse in the Grand National in 2004. Internet reports confirming this were sent to the agent, W P Thompson & Co, with the examination report. Copies of these are attached at Annex A. My understanding is that these facts are not in dispute. Objection was also taken under Section 3(6) and Section 5(2) of the Act but these objections were subsequently waived and I need make no further reference to them in this decision.

4. At a hearing, at which the applicants were represented by Mrs Maddox of W P Thompson & Co, their trade mark attorneys, the objection under Section 3(1)(b) and (c) was maintained.

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.

The Law

6. 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,”

Decision

7. 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 of 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.”

8. As I have previously indicated this objection now relates only to “Posters, stickers, transfers, photographs and paintings ” in Class 16 and “Figurines and statues” in Class 21.

9. 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 famous racehorse and when used in relation to the goods for which registration is sought, it will do no more than represent the subject matter 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 the goods in question purchase them because they represent something to them. In this case the name AMBERLEIGH HOUSE represents the racehorse which won the Grand National in 2004. The name AMBERLEIGH HOUSE appearing on these

goods is the subject matter of the goods which itself is an essential characteristic of such goods.

16. I must consider if there is, or is liable to be, a wide demand for these goods when bearing the name AMBERLEIGH HOUSE . The Grand National is a famous sporting event which is well known in the united Kingdom. Many people in the United Kingdom follow horse racing but the fame of the Grand National goes much wider and it attracts interest from members of the public who may, at other times of the year, have no or little interest in such sport. Sweepstakes are held in offices and factories throughout the United Kingdom and many members of the public place wagers and bets on this race, although this may be the only race where they would act in such a way. It is the fame of this race that that leads me to conclude that there is likely to be a wide demand for the goods in question.

17. The next question to be considered is, given that there is likely to be a wide demand for e.g. posters and photographs etc. bearing the name AMBERLEIGH HOUSE 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 horses which win famous horse races such as the Grand National – the copyright in a picture of AMBERLEIGH HOUSE belongs to the creator of it and not necessarily to the owners of the horse. 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.

18. Turning to the goods in Class 21, I am aware from my personal knowledge that there is considerable trade in sporting memorabilia. Throughout the United Kingdom there are many establishments where statues and figurines of animals, including horses, may be purchased. These are very collectible and when this trade is considered in conjunction with the trade in sporting memorabilia I conclude that there is likely to be trade in e.g. representations of horses which have won the Grand National race. Upon encountering a statue or figurine of a horse bearing the words AMBERLEIGH HOUSE it is my view that the prospective purchaser would perceive these words to be an indication of the name of the horse and not as a sign guaranteeing that the goods under consideration are the goods of a single undertaking. In such circumstances the words are descriptive of the subject matter and do not function as a badge of origin.

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 is to be noted at the outset 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 or services of one undertaking from those of other undertakings.
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39. Next, pursuant to the rule in 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).
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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 the goods for which registration is sought would not consider this mark to denote trade origin. I am not persuaded that the combination of the words AMBERLEIGH HOUSE 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 16th day of September 2005

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