

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2413091 IN THE NAME OF
IT3 INTERNET APPLICATION SOLUTIONS LIMITED TO
REGISTER THE FOLLOWING AS A SERIES OF FIVE TRADE MARKS IN
CLASSES 9, 16, 41 AND 42**



seo site builder

seo TOURISM
site builder

seo PROPERTY
site builder

seo AUTOMOTIVE
site builder

AND

**OPPOSITION THERETO UNDER NO. 94993 IN THE NAME OF
BABYLON TECHNOLOGIES LTD**

Trade Marks Act 1994
IN THE MATTER OF application No. 2413091
in the name of IT3 Internet Application Solutions Limited
to register a series of five trade marks in Classes 9, 16, 41 and 42

And

Opposition thereto under No. 94993
in the name of Babylon Technologies Ltd

BACKGROUND

1. On 6 February 2006, IT3 Internet Application Solutions Limited made an application to register a series of five trade marks in Classes 9, 16, 41 and 42 in relation to the following specifications of goods and services:

- Class 09** Application software; compact discs and DVDs including audio video and read-only memory; computer operating programs; computer programs including recorded and downloadable software; computer interfaces; search engine optimisation programs; search engine optimisation software; floppy discs; memory storage devices for use with computer apparatus in particular memory cards, cartridges and sticks for use with computer apparatus, all included in Class 9.
- Class 16** Publications; printed matter, booklets; books: brochures; handbooks; manuals; training manuals; training manuals relating to computer program operation including search engine optimisation program operation and website management; training manuals for use in computer program operation seminars and workshops including search engine optimisation program operation and website management seminars and workshops; reference books; magazines; newsletters; instructional and teaching materials and in particular in relation to search engine optimisation and website management services; stationery; writing implements; wall charts; diaries; notebooks, all included in Class 16.
- Class 41** Arranging and conducting of seminars and training workshops, particularly seminars and training workshops relating to computer program operation including search engine optimisation programs; educational information; instructions service; practical training services, all included in Class 41.
- Class 42** Computer programming; computer software design and maintenance and updating; creating and maintaining websites for others; hosting computer websites; website management and maintenance services in particular website management and maintenance provided online; licensing of computer software to others, all included in Class 42.

2. On 19 February 2007, Babylon Technologies Ltd filed notice of opposition to the application, the grounds of opposition being expressed as follows:

“The earlier right SEO has been used extensively with regard to an acronym for search engine optimisation (seo) and the mark of the application opposed will be perceived simply as the acronym seo standing for search engine optimisation. Elements of the other marks of the series are common terms and descriptors.

The earlier right has been used since 2002 at least by the opponent and extensively since that date and before by others.

The opposition is in relation to all goods and services of all Classes - 09, 16, 41, 42 of the application directly and/or indirectly.”

and;

“Statement of case

1. The opponent has used the term SEO as an acronym for search engine optimisation extensively along with other users such that the mark SEO as an acronym is a common generic term with regard to provision of search engine optimisation with respect to software and website access and associated goods and services. Thus the opponent and/or others have used the mark SEO extensively in relation to the same or similar goods as UK trade mark No. 2413091 either directly upon the same services and goods or goods sufficiently similar to cause confusion.

2. UK trade mark application No. 2413091 essentially relates to the mark SEO in that the dominant element of the mark subject to UK trade mark application No. 2413091 is the mark SEO with other elements commonplace.

3. Use of the mark subject to trade mark application No. 2413091 will lead to confusion with earlier and established rights and common usage of the acronym SEO by virtue of the laws of passing off.

4. The mark SEO as an acronym for search engine optimisation is descriptive and generic with regard to the goods and services subject to UK trade mark application No. 2413091 and all other elements are relatively diminimus or commonplace such that the mark of UK trade mark application No, 2413091 is not distinctive with regard to the goods and services subject to UK trade mark application No. 2413091.”

3. The opposition is made in relation to the following sections of the Act:

1. **Under Section 3(1)(a)** because the sign does not satisfy the requirements of section 1(1) because it is not capable of distinguishing goods or services of one undertaking from those of other undertakings.
2. **Under Section 3(1)(b)** because the mark is devoid of distinctive character.
3. **Under Section 3(1)(c)** because the mark consists of signs or indications which may serve, in trade, to designate characteristics of the goods for which it is sought to be registered.
4. **Under Section 3(1)(d)** because the mark consists exclusively of signs or indications which have or are likely to become customary in the current language and bona fide established practices of the trade.

4. The applicants filed a counterstatement in which they concede that the letters SEO in capitals would constitute an acronym for the description SEARCH ENGINE OPTIMISATION, but deny that represented in lower case, and with the “magnifying glass symbol” being part of the mark, they will be interpreted as the acronym, and consequently, are not devoid of distinctive character.

5. Both sides filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. The matter came to be heard on 18 June 2008, when the applicants were represented by Dr Gillian Whitfield of Astrum-IP Limited. The opponents were represented by Mr Kevin Parnham of Swindell and Pearson.

Opponents’ evidence

6. This consists of three Witness Statements. The first is dated 24 August 2007, and comes from Adrian McLean, Managing Director of Babylon Technologies Limited, the opponents in these proceedings. Mr McLean says that he is also the Managing Director of Expect IT Limited who trade in relation to internet services and IT. Mr McLean says that he has been involved in developing and providing internet services for ten years. The Statement consists of a combination of evidence of fact, and submissions on the substance of the proceedings. Where facts are presented these have been summarised, otherwise I have noted the submissions but will not include them in the summary of the evidence.

7. Mr McLean says that to his own company and the related industry, “search engine optimization”, is known by the acronym “SEO”, stating that both the full description and the acronym are generic and well known terminology with regard to internet services. Mr McLean says that the acronym is used in both upper and lower case, stating that with regard to e-mail and website addresses, lower case is the only or normal font available. Mr McLean refers to a search on Google having returned 140 million results, Exhibit A being the front page of the search results. This relates to a

search for “seo” done on 16 August 2007, the results clearly showing the letters SEO to be an acronym for “Search Engine Optimisation”, which the results from Wikipedia (Exhibit B) describe as being “...the process for improving the volume and quality of traffic on a web site from search engines...”. The results almost exclusively show SEO in upper case, although at the foot of the second page it is also shown in lower case. Exhibit C consists of an extract from the applicant’s website. Beneath a contact telephone number, the page is headed “SEARCH ENGINE OPTIMISED SITE BUILDER” with “tm” and the words “site builder” opposite. Beneath there are several mentions of “SEO Site Builder”, and also “SEO CMS Solution”, “SEO results” and the text “SEO Site Builder will enable you to manage and control your online presence with a difference. This CMS has been developed in a way unlike any other using the best search engine optimisation (SEO) techniques.” The page explains that CMS is an acronym for Content Management System.

8. Mr McLean refers to, and challenges the applicant's description of their mark, and their assertion that acronyms are represented in capitals. He states that as can be seen from Exhibit D, there is no tradition or rule that acronyms should be in uppercase and the mark will be seen as the acronym. The Exhibit consists of an extract from Collins Dictionary & Thesaurus, and the Abbreviations Dictionary, both of which show abbreviations and acronyms represented in upper and/or lower case.

9. The remainder of Mr McLean's Statement consists of submissions on the applicant's claims and the substance of the opponent's case. Whilst it is not appropriate or necessary that I summarise these, I will of course, take them fully into account in my determination of these proceedings.

10. The second and third Witness Statements are both dated 23 August 2007, and come from Paul Yates of Just Search, and Nigel Muir of DBD Media, who Mr McLean approached in relation to the opposition proceedings. The Statements appear to have been prepared for Mr McLean and Mr Muir, ready for the relevant blanks to be filled in (or in Mr Yates' case, not), as appropriate. Both attest to having used SEO in relation to Search Engine Optimisation, in Mr Yates case since 2002, and in the case of Mr Muir, since 2000. They assert that the acronym SEO is generic and utilised widely in the UK with regard to the service of Search Engine Optimisation. Both comment on the nature of the mark, and state that the acronym SEO can be represented in upper or lower case.

Applicant's evidence

11. This consists of two Witness Statements. The first is dated 10 December 2007, and comes from Adam Price, Managing Director of IT3 Internet Application Solutions Limited. Mr Price confirms that he has been involved with the design and development of Content Management Systems (CMS), and websites, particularly for E-commerce for over 12 years.

12. Mr Price describes the mark applied for as the letters "se" and a "stylistic representation of a magnifying glass comprising a circular "lens" and a straight handle located at around 45° to the vertical". He refers to letters shown as Exhibit E1, sent by the opponent's providing observations in respect of the subject trade marks, and the Registry's decision not to take any action.

13. Mr Price goes on to refer to the applicants having confirmed to the opponents that the marks applied for were device marks and as such could not, and would not be used to prevent use of the letters SEO by a third party (including the opponents). The applicants offered a written undertaking to this effect; this was refused.

14. The remainder of Mr Price's Statement consists of submissions on Mr McLean's evidence, and the claims and the substance of the opponent's case. Whilst it is not appropriate or necessary that I summarise these, I will of course, take them fully into account in my determination of these proceedings.

15. The second Witness Statement is dated 10 December 2007, and comes from Dr. Gillian Whitfield, Managing Director of Astrum-IP Limited, the applicant's representative in these proceedings. Ms Whitfield recounts the history of the application, including contact with the opponents in which the written undertaking was offered, and exhibiting the letters referred to by Mr Price as Exhibit 1 (E1) and a screen dump from the applicant's website as Exhibit 2 (E2). Ms Whitfield says that Mr McLean's recollection of events is different to the record of a telephone conversation that they had. This record is shown as Exhibit 3 (E3), which, in substance is the same as Paragraph 4 of her Witness Statement, and is stated to have been created immediately after the conversation.

Opponent's evidence in reply

16. This consists of a Witness Statement dated 10 March 2008, from Adrian McLean, Managing Director of Babylon Technologies Limited and Expect IT Limited. Not surprisingly for evidence in reply this Statement consists of submissions on the applicant's claims and the evidence provided by Mr Price and Ms Whitfield in support of the applicant's case, and on the substance and merits of these proceedings as established by the opponent's evidence. Whilst it is not appropriate or necessary that I summarise these, I will, of course, take them fully into account in my determination of these proceedings.

Decision

17. At the hearing Mr Parnham withdrew the ground under Section 5(4)(a). This leaves one ground which the Statement of Case puts as being under Section 3(1) of the Act. At the hearing Mr Parnham refined this to be first under Section 3(1)(d), and to a lesser extent (or in the alternative) Section 3(1)(b) and (c). Those sections read as follows:

"3 (1) The following shall not be registered —

(a) ...

(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,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

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."

18. There is no claim that the mark has become distinctive by virtue of the use made of it, but in any event, apart from a screenshot from the applicant's website there is no evidence of it having been used, so the proviso is not relevant in these proceedings.

19. Turning first to the opponent's primary case which is under Section 3(1)(d) of the Act. The leading guidance from the European Court of Justice on Article 3(1)(d) (equivalent to Section 3(1)(d) of the UK Act) is contained in *Merz & Krell GmbH & Co*, [2002] ETMR 21:

"41. It follows that Article 3(1)(d) of the Directive must be interpreted as meaning that it subjects refusal to register a trade mark to the sole condition that the signs or indications of which the trade mark is exclusively composed have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought. It is immaterial, when that provision is applied, whether the signs or indication in question describe the properties or characteristics of those goods or services."

20. As this case indicates, an objection based on this ground is not to be determined on the basis that the mark is in some way descriptive of the goods or services; that is a matter to be considered under the provisions of Sections 3(1)(b) and (c) of the Act. It would therefore follow that if the decision is not to be made on the basis of descriptive aptness, any assertion that a mark has become customary in the language and practices of the trade connected to the relevant goods and services has to be supported by clear and cogent evidence. Whilst the evidence shows that SEO in upper or lower case is customary in the current language or in the *bona fide* and established practices of the trade, it is not a description of the goods or services covered by the application; it describes their purpose. Additionally, the marks include other matter, such as the "line" which the applicants say is the handle of a magnifying glass, and other text, none of which can be said to be in the current language or established practices of the trade. Accordingly the marks cannot be "exclusively composed" and

the ground under Section 3(1)(d) must fail.

21. I now turn to the grounds founded under Section 3(1)(b) and (c). In the *Cycling Is* decision [2002] R.P.C 37, it was stated that the distinctiveness of a trade mark is not to be considered in the abstract, but rather by reference to the goods or services in respect of which registration is sought, and the relevant public's perception of that mark. In the judgment issued in respect of Joined Cases *C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003), paragraphs 37, 39 to 41 and 47, the European Court of Justice (ECJ) summarized the considerations in respect of assessing distinctiveness under Section 3(1)(b) 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.

.....

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)”

22. As paragraph 40 of this judgment makes clear, distinctive character means 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.

23. In *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-191/01P, the *Doublemint* case, the ECJ gave the following 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:

“28. Under Article 4 of Regulation No 40/94, a Community trade mark may

consist of any 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- 3161, 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.”

24. From this it is clear that the prohibition to registration under Section 3(1)(c) of the Act includes signs that may not be being used as a designation of a characteristics of the relevant goods or services, but nonetheless could be apt for such use.

25. In *Doublemint* the ECJ found the mark to be purely descriptive and the fact that 'double' and 'mint' in combination gave rise to a variety of possible meanings did not automatically mean that the words are not descriptive. The Advocate General, in a precursor to the ECJ decision, suggested that a proposed trade mark should be assessed as follows:

What is the relationship between the mark and the product?—If the mark to be used is a general description in the particular trade then registration will be refused,

How immediately is the message conveyed? If the mark quickly conveys the characteristic of the goods/services then it will not be registrable,

What is the significance of the characteristics in relation to the product in the consumer's mind? – If the characteristics are intrinsic to the product or the consumer's choice of product, then the grounds for refusing registration because of the descriptive element are high.

26. The ECJ held that a sign must be refused registration if one of its possible meanings is capable of designating a characteristic of the goods concerned, and it was held that the only lexical invention in *Doublemint* was the removal of a space between the words “double” and “mint”. The mark was considered to have a tangible reference to a mint flavour which is doubled in some way. As the mint flavour was a prominent feature of the product for which the mark was to be used, it was considered that this relevance would be 'readily perceived' and registration was denied.

27. In the *Postkantoor* case the ECJ reviewed the decisions in *Biomild* and *Baby-Dry*. In that case Koninklijke KPN Nederland NV's had made an application to register *Postkantoor* (meaning 'post office' in Dutch) for 'paper, advertising, stamps, telecommunications and education', the Benelux Trade Mark Office refused the application as being exclusively descriptive of the relevant goods and services in relation to a post office. The refusal was referred to the ECJ who stated that if due to the unusual nature of the combination of words which form a trade mark, the overall impression of the mark is sufficiently far removed from the descriptive elements of the words concerned, and the combination creates a different impression from the individual words, the mark is registrable. If the new word has established its own meaning, independent of the individual components which make up the mark, then again it is registrable. This case confirmed the tests laid down in the *DOUBLEMINT* decision.

28. The opponent's objection is based on the assertion that the marks applied for are the letters SEO, and whether represented in upper or lower case, are no more than an acronym for the term “Search Engine Optimisation”. The applicants do not dispute that these letters are an acronym, although maintain that this is only so when used in capitals. Even without this concession the evidence clearly shows that SEO in whatever case it may be represented, is a sign or indication which is customary in the current language or in the *bona fide* and established practices of the trade.

29. The opponent's say that the marks are no more and no less than these letters. The

applicant's maintain that the marks applied for are a combination of text and graphic elements, more specifically, the letters "se" and a "stylistic representation of a magnifying glass comprising a circular "lens" and a straight handle located at around 45° to the vertical."

30. Putting the position very simply, both sides accept that SEO is an acronym for Search Engine Optimisation. Given that goods and services for such a purpose are specifically mentioned in the specifications of the application, if the marks are the letters SEO then they are undeniably descriptive of at least these, and any other terms that could implicitly cover goods or services for such a purpose. I do not see that this case hangs on whether acronyms are usually expressed in upper or lower case letters; the evidence shows that they are represented in both. The question is whether the marks are the letters and device that the applicants say they are, or just the letters SEO with some minor addition. Neither side addressed me on the relevance of the additional text included with some of the marks, which could be because there is no dispute as to their descriptive relevance for the goods and services of the application. For the sake of certainty I shall start by considering their significance, individually and as part of the mark as a whole.

31. The reference from Wikipedia describes Search Engine Optimisation in the following terms:

"Search Engine Optimisation (SEO) is the process of improving the volume and quality of traffic to a web site from search engines via "natural" ("organic" or "algorithmic") search results. Usually the earlier a site is presented in the search results, or the higher it "ranks", the more searchers will visit the site. SEO can also target different kinds of search, including image search, local search, and industry-specific vertical search engines."

32. It seems to me that the term "SITE BUILDER" is quite apt to describe the purpose of Search Engine Optimisation in that it builds the volume and quality of traffic to a site. Having determined this, it seems to me that the other parts of the descriptions, namely TOURISM, PROPERTY and AUTOMOTIVE add nothing more than a description of the subject content of the site, and in totality read through to make a meaningful whole. Accordingly, I come to the view that if there is any distinctiveness in the marks, it must exist in the disputed element.

33. Where a mark cannot be said to consist exclusively of a sign which may serve in trade to designate the kind of goods etc, it will not be devoid of any distinctive character. That is, unless the distinctive element is proportionately too small within the whole of the mark so that the distinctive element is not visible and legible as a matter of first impression, the mark may be considered to lack distinctive character. Whether a sign has a distinctive character will depend upon the impact of the presentation, which will be affected by the descriptiveness of the core of the mark; the more descriptive - the less likely it will be that the average consumer's perception of the sign will be changed by minor elements of get-up. Additionally, where the get-up is commonplace or simply emphasises the descriptiveness of the other element, it is unlikely to provide the mark with a trade mark character.

34. There is no argument that the marks contain the letters "SE", the dispute is

whether the remaining element is a letter "O" with an insignificant embellishment, or graphical matter that either has a distinctive life of its own that carries the mark, or in combination with SE, contributes to a distinctive whole.

35. Turning first to the question of whether the marks are the letters SEO with a comma between the E and O. Ms Whitfield said that this was a new line of argument from the opponents. That may, or may not be the case, but I still need to consider whether it has substance. Ms Whitfield argued that if the mark were as claimed, "...the three letters would no longer be evenly spaced. The comma would take up a single digit field, thereby separating the E and the O by a distance twice as great as that between the S and the E." On a cursory glance it would be possible to mistake the line for a coma and see the mark as being SE,O, but as can be seen here, as stated by Ms Whitfield, a comma interjects between letters and occupies a space for a character, creating a clear separation. I do not see that the mark will be viewed in this way and dismiss this argument.

36. Whilst I am not sure that an ordinary consumer would analyse the mark in the same detailed way as Ms Whitfield, I must take into account that the services here are of a technical nature, aimed at a sophisticated user who will be better informed and knowledgeable than normal. They will be more observant and circumspect than a consumer of more basic goods and services and will undoubtedly see and recognise SEO in the mark. They will no doubt also take note of the line pointing at the letter O and may see this as a magnifying glass that the applicants say it represents.

37. If the applicant's intention had been to create a mark that would be seen as the letters "se" and a "stylistic representation of a magnifying glass" they could have done so in a way where this would be clearly the case. Whether or not they intend to assert any rights to the acronym, that they used the same lettering as the preceding letters says to me that they may well have intended that the marks should be capable of being seen as SEO; they are certainly very capable of being seen as such.

38. I am also aware that as can be seen from page 1 of Exhibit C to the Witness Statement of Adrian McLean, which consists of an extract from the applicant's website, the device of a magnifying glass is used to indicate a search function, a purpose connected to Search Engine Optimisation. If this element of the applicant's mark is seen as the device of a magnifying glass, it serves only to emphasise this and its impact on the relevant consumer will be minimal. In my mind the marks will be seen as the letters SEO, an acronym for Search Engine Optimisation, the words that follow are descriptive of the subject area, and the device element, such as it is, serves to emphasise the search function. I do not consider the totality to be much, if any more distinctive than the component parts.

39. The specifications of goods and the specification of services in Class 41 specifically mention Search Engine Optimisation so there can be little doubt if the marks are the letters SEO then they are undeniably descriptive of at least these. They will also be descriptive of any other terms that could implicitly cover goods or services for such a purpose. Accordingly, the trade mark is excluded from registration under Section 3(1)(c) of the Act for such goods and services. It follows that in relation to such goods and services the mark must also be devoid of the character necessary to be able to distinguish, and the ground under Section 3(1)(b)

also succeeds.

40. It is here that I must consider whether, and if so, to what extent, the specifications do not only cover goods and services for Search Engine Optimisation. At the hearing Mr Parnham argued that where the mark is found not to be objectionable because the goods or services have no connection to Search Engine Optimisation the mark would be deceptive and open to objection under Section 3(3)(b). This was the first mention of this ground, and I informed Mr Parnham that it was too late in the day to be raising new grounds and I would not consider this question.

41. The evidence from Wikipedia (Exhibit B) describe Search Engine Optimisation as being "...the process of improving the volume and quality of traffic to a web site from search engines...". Accordingly, any goods or services that are for this purpose, or related to it.

42. The Class 9 specification mentions "search engine optimisation programs" and "search engine optimisation software" for which SEO must clearly be descriptive. The same must be the case for any other software that is not described as being for a purpose that would not include SEO, and media capable of containing such software, To my mind this would include application software; computer operating programs; computer programs including recorded and downloadable software; computer interfaces; floppy discs; memory storage devices for use with computer apparatus, memory cards, cartridges and sticks for use with computer apparatus and read-only memories. The remaining items, namely DVDs, and compact discs containing audio/video are all capable of being instructional materials for SEO software and are also open to objection.

43. In respect of the goods in Class 16, the specification again mentions "Search Engine Optimisation", in this case "training manuals", "training manuals for use in computer program operation seminars and workshops" and "instructional and teaching materials". These are also stated to be of "website management" which would also encompass Search Engine Optimisation. The remaining goods, namely, publications, printed matter, booklets, books, brochures, handbooks, manuals, reference books, magazines, newsletters, instructional and teaching materials, are all capable of covering goods related to search engine optimisation. The items that are unlikely to be anything to do with Search Engine Optimisation are stationery, wall charts, diaries, notebooks and writing implements, and the application should be free to proceed in respect of these goods.

44. The services in Class 41 state that the seminars and training workshops include those relating to search engine optimisation programs, so the mark is obviously descriptive and devoid of distinctive character for these. The remaining services of educational information service and practical training services are also both capable of relating to Search Engine Optimisation, so the mark is equally descriptive and devoid of distinctive character for these services.

45. The specification for Class 42 lists computer programming, computer software design, maintenance and updating, creating and maintaining websites for others, hosting computer websites; website management and maintenance services, licensing of computer software to others, all of which are capable of being services for, or

relating to Search Engine Optimisation. Consequently, the application is open to objection in respect of all of the services in this class.

46. The position, therefore, is that the mark may proceed to registration for the following goods from the specifications applied for, but no others:

Class 16 Stationery, wall charts, diaries, notebooks and writing implements.

47. The opposition having been substantially successful, the opponents are entitled to a contribution towards their costs. I therefore order that the applicants pay the opponents the sum of £1.800 towards their costs. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of October 2008

**Mike Foley
for the Registrar
the Comptroller-General**