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UK INTELLECTUAL PROPERTY OFFICE

Rolls Building
7 Rolls Buildings,
Fetter Lane,
London EC4A 1NL.

Friday, 14th September 2012

Before:

MR. GEOFFREY HOBBS QC
(Sitting as the Appointed Person)

.....

In the Matter of the TRADE MARKS ACT 1994

and

In the Matter of Application Number 2549968
in the name of JETSKISAFARIS LTD

and

An appeal to the Appointed Person from the decision of
MS. BRIDGET WHATMOUGH, acting on behalf of the Registrar of
Trade Marks, dated 15th November 2011

.....

(Transcript of the Shorthand Notes of:
Marten Walsh Cherer Limited,
1st Floor, Quality House, 6-9 Quality Court,
Chancery Lane, London WC2A 1HP.
Telephone: 020 7067 2900
email: info@martenwalshcherer.com)

.....

MR. ROSS CEATON and MR. DAVID CEATON appeared on behalf of the
Appellant.

MR. NATHAN ABRAHAM appeared on behalf of the Registrar.

.....

DECISION
AS APPROVED BY THE APPOINTED PERSON

.....

1 THE APPOINTED PERSON: On 11th June 2010 Jetskisafaris Limited
2 applied under no. 2549968 to register the following sign as a
3 trade mark for use in relation to: "Provision of tutored and
4 supervised Jet Ski excursions and Royal Yachting Association
5 personal watercraft training" in Class 41:

6 **JETSKISAFARIS**

7
8 The application for registration was refused for the
9 reasons given in a written decision issued by Ms. Bridget
10 Whatmough on behalf of the Registrar of Trade Marks under
11 reference BL O-394-11 on 15th November 2011. She found that
12 the mark in issue was simply descriptive in relation to
13 services of the kind specified and, therefore, caught by the
14 exclusion from registration contained in section 3(1)(c) of
15 the Trade Marks Act 1994. This prevents the registration of:
16 "trade marks which consist exclusively of signs or indications
17 which may serve, in trade, to designate the kind, quality,
18 quantity, intended purpose, value, geographical origin, the
19 time of production of goods or of rendering of services, or
20 other characteristics of goods or services."

21 The Hearing Officer's appraisal of the mark is set out
22 in paragraphs 16 to 21 of her Decision as follows:

23 "The Mark

24 "16. Although it is paramount that any assessment of
25 distinctiveness takes into account the mark's totality, it is
also useful to first analyse the mark by reference to its
constituent parts.

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17. The mark applied for, it consists of the sign 'JETSKISAFARIS', presented in a stylised font. The words within the mark are defined in Chambers 21st Century Dictionary as meaning:

Jet-ski; noun a powered craft, similar to a motorbike, adapted for skimming across water on a ski-like keel.

Safari; noun an expedition or tour to hunt or observe wild animals, especially in Africa on safari.

18. In determining the mark's suitability for acceptance and registration under section 3(1)(c), the Registrar is obliged to consider the semantic content of the sign and consider, in the context of the services claimed, whether or not the relevant consumer is likely to perceive it as being a denotation of a particular characteristic. Both of the above dictionary definitions demonstrate that the sign 'jet ski safaris' not only possesses a consistent and recognisable meaning likely to be understood by the average English speaking consumer, but also that it is suitability apt to act as descriptor of the services covered by the application. Given these dictionary definitions, the Registrar finds it likely that the relevant consumer would recognise the sign as conveying a particular message, and that the message conveyed would be understood as having a functional (rather than 'supplier-identifying') role to play in respect of the services it is used upon.

19. For the services covered by the application, the section 3(1)(c) objection is based on the premise that the term 'jetskisafaris', when used in respect of jet ski excursions and watercraft training, would be understood as reference to the kind of the services, i.e. an expedition or tour which takes place on a jet ski. Whilst I note that the definition of the word 'safari' is defined as meaning 'an expedition or tour to hunt or observe wild animals, especially in Africa on safari, and might seem unusual in relation to activities on water, I see no reason why the meaning of the word could not extend to an expedition or tour around the British coastline or similarly an expedition or tour of waterways or lakes in the UK. It seems to me that the term 'jet ski safaris' would serve to designate the kind of services claimed.

20. I am strengthened in this finding, given evidence of the use of the term. For example, it is helpful to consider how the applicant describes his own services. The following is taken from the applicant's website at www.jetskisafaris.co.uk (Annex 1) and explains what a 'jetski safari' is;

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So what is a Jetski Safari?

A Jetski Safari is an experience in which you will receive a safety briefing and instruction from a Qualified Personal Watercraft instructor before being taken to the water on your very own Jetski with no prior experience needed. Once on the water the Instructive will give you further guidance to get you comfortable with both driving the Jetski and your aqua surroundings. Once comfortable and feeling in control of the jetskis you will be led on a guided safari, during which you will experience the performance of our watercraft both within Poole Harbour and out on the open sea, along the stunning Jurassic Coastline.

I think that the above reinforces the clear descriptive message conveyed by the term.

21. In support of this, I refer to the four internet pages attached as Annexes to this decision. The first four references (Annexes 2, 3, 4 and 5), all show use of the sign designating safaris available on a jet ski and which are available in the UK. The fifth and sixth references, (Annexes 6 and 7), show use of the term in relation to jet ski safaris which are available in Fuerteventura and Malta and which are targeted at consumes in the UK wishing to holiday abroad. I also consider that the word 'safari' is now used in a far more general sense as meaning a journey of some sort. To support my finding I refer to instances of use of the word in the context of a 'Greek island safari culinary tour', (Annex 8), a 'literary safari' (Annex 9), a 'musical safari' (Annex 10) and also a 'Scottish football safari' (Annex 11). These are a small sample of references, illustrating how the word 'safari' is used to describe 'a journey' and which support my view that the term is no longer exclusively used in its more traditional sense."

She considered that the visual presentation of the word JETSKISAFARIS was too insignificant to prevent the mark in issue from consisting exclusively of descriptive subject matter. In that connection, she drew upon the reasoning of my decision in Quick Wash Action Trade Mark BL O-205-2004, and the reasoning of the decision given by Mr. Richard Arnold QC in Sun Ripened Tobacco Trade Mark BL O-200-2008. It should,

1 however, be pointed out that these were both decisions in
2 which registration was refused under section 3(1)(b) and not
3 under section 3(1)(c) of the 1994 Act.

4 "Section 3(1)(b) prevents the registration of trade
5 marks which are devoid of any distinctive character in
6 relation to goods or services of the kind for which they are
7 sought to be registered. For the purposes of that exclusion,
8 the word "devoid" means "unpossessed". For the reasons given
9 in paragraphs 26-29 of her Decision, the Hearing Officer
10 considered that the mark in issue was excluded from
11 registration by section 3(1)(b) because the message it
12 conveyed was permeated by the origin neutral connotations of
13 the descriptive wording it contained.

14 Having carefully considered the evidence of use filed on
15 behalf of the Applicant in paragraphs 30 and 31 of her
16 Decision, the Hearing Officer concluded that there was no room
17 for any finding to the effect that the mark in issue had
18 acquired a distinctive character through use prior to the date
19 of the application for registration so as to be acceptable for
20 registration under the proviso to section 3(1) of the Act.

21 The Applicant appealed to an Appointed Person under
22 section 76 of the Trade Marks Act 1994 contending, in
23 substance, that the Hearing Officer had applied too strict an
24 approach to the test for registrability in the present case
25 and in doing so had placed undue reliance on the materials

1 attached as annexes to her Decision.

2 In its Statement of Grounds of Appeal, the Applicant
3 referred to the test for distinctiveness under the case law
4 mentioned in the Hearing Officer's Decision and summed up its
5 case for registration in the following terms: "To reiterate at
6 the time of the hearing our company was unique in the UK for
7 the provision of this service and therefore people (i.e.
8 relevant class) who wished to go on an escorted jetski
9 safari contacted our company (thus identifying goods as
10 originating ...') to go on an escorted jetski excursion."

11 The case for the Applicant was further developed in oral
12 argument at the hearing before me. I am clear in my own mind
13 that this is not a case in which the mark in issue can be said
14 to consist exclusively of a sign or indication which may serve
15 in trade to designate the kind, intended purpose or other
16 characteristics of services within the specification for which
17 registration is requested.

18 The logo-type presentation of the wording cannot simply
19 be ignored. I am satisfied that there is enough visual
20 stylisation in the graphic representation to prevent it from
21 being examined under section 3(1)(c) as if it consisted of
22 nothing more than the word Jetskisafaris. It, thus, appears
23 to me that the Hearing Officer over-extended the scope of
24 section 3(1)(c) in relation to the mark in issue and that she
25 ought, instead, to have focused on the question of whether the

1 mark as a whole should or should not be refused registration
2 for lack of distinctiveness under section 3(1)(b).

3 I agree with the Hearing Officer in thinking that the
4 message of the mark is, for all practical purposes, conveyed
5 by the wording it contains and that the fate of the
6 application for registration therefore depends upon whether
7 the message conveyed by the wording would be origin specific
8 or origin neutral from the perspective of the relevant average
9 consumer of the services concerned.

10 Taken in isolation, the word "safari" is evocative of
11 travel in African game reserves and I can see that there is
12 what might be interpreted as "zebra-stripe treatment" applied
13 to the second half of the word Jetskisafaris, which may, for
14 some people, at least, tap into that connotation. The word
15 "safari" is, none the less, contextualised in the compound
16 expression Jetskisafaris in a way which is apt to be
17 understood as referring to guided jetski trips providing an
18 adventurous waterborne experience.

19 This is confirmed by the manner in which the Applicant
20 uses the expression to inform people of the nature of the
21 services it provides, as illustrated by Annex 1 to the Hearing
22 Officer's Decision, and also by parts of the narrative in its
23 Statement of Grounds of Appeal. It is further confirmed by
24 the other annexes to the Hearing Officer's Decision. I was
25 told that most of the annexes were brought to the attention of

1 the Applicant for the first time when it received the
2 Decision.

3 The right course would have been for the Hearing Officer
4 to have given the Applicant an opportunity to comment on the
5 materials she was minded to take into account rather than
6 simply deciding to rely on them in the Decision she
7 subsequently issued. Whilst there is room for dissatisfaction
8 on the part of the Applicant in that regard, I do not think it
9 would be an act of kindness to it to remit the matter to the
10 Registry for further consideration on that ground.

11 I think it is reasonably apparent that the word "safari"
12 is nowadays used quite broadly to refer to the making of an
13 adventurous journey or expedition. As part of the compound
14 expression "Jetskisafaris" it is informative and explanatory
15 as to the nature of the relevant services without also being
16 indicative of trade origin. I am not prepared to say that the
17 Hearing Officer was wrong to regard the mark as objectionable
18 under section 3(1)(b), and I am satisfied that there is no
19 basis upon which it can realistically be said that she erred
20 in her rejection of the claim to distinctiveness acquired
21 through use. The application for registration must therefore
22 stand refused.

23 That conclusion is not affected by the fact that the
24 mark Waverunner Safaris may have been registered for services
25 identical or similar to those in issue in the present case.

