

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**APPLICATION No.2216981**

**TO REGISTER A TRADE MARK IN CLASS 38**

**IN THE NAME OF**

**TELEWEST COMMUNICATIONS PLC**

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**DECISION**

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1. Telewest Communications Plc (*“the Applicant”*) applied on 10th December 1999 to register SURFUNLIMITED and SURF UNLIMITED as a series of two trade marks for use in relation to the following services in Class 38:

“Telecommunication services; data communication services; collecting, supplying and transmitting data, information and communications by telephone, computer, tele-printer, electronic mail, laser beam, satellite or by electronic or optical means; electronic communication services; rental, hire, and leasing of communications apparatus and of electronic mailboxes; telex, telegram, facsimile, internet and telephone services; digital transmission services; mobile radio communications; video conferencing and communications services; news agency services; radio and television broadcasting; postal and wire services; telephone services for internet access; message sending and delivery; consultancy services, all relating to telecommunications and data communication services; information and advisory services relating to the foregoing.”

2. It is necessary to point out that the application was submitted in accordance with the provisions of Section 41(2) of the Trade Marks Act 1994 on the basis that the two marks in the series “*resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark*”. Seen from that perspective, the marks in question consist essentially of the words SURF and UNLIMITED in combination.

3. The Applicant made no claim to registration on the basis of distinctiveness acquired through use in the United Kingdom prior to the date of the application.

4. Objections to registration were raised by the Registry under Sections 3(1)(b) and 3(1)(c) of the 1994 Act. An objection was also raised in relation to the wording of the specification on the ground that the terms “*postal and wire services*” and “*internet services*” were too vague to satisfy the requirement for legal certainty as to the identity of the services the Applicant was seeking to specify.

5. These objections were maintained in a written decision issued by Mr. R.A. Jones acting on behalf of the Registrar of Trade Marks on 13th March 2002. He concluded upon examining the marks for registrability in relation to the specified services that:

“The relevant public would see the term SURF UNLIMITED, on first impression, as no more than an advertising statement equivalent to ‘(You can) surf unlimited’ or as a natural alternative to the phrase ‘unlimited surfing’. Therefore, I consider the marks applied for consist exclusively of signs which may serve in trade to designate the kind or quality of the services and are, therefore, excluded from registration by Section 3(1)(c) of the Act. For the same reasons I consider the marks to be devoid of any distinctive character and therefore not acceptable for registration under Section 3(1)(b) of the Act”.

6. The Applicant gave notice of appeal to an Appointed Person under Section 76 of the Act, contending in substance that registration of the marks in question should have been allowed consistently with the guidance provided by the European Court of Justice in Case C-383/99P Procter & Gamble v OHIM (BABY-DRY) [2001] ECR I-6251.

7. In paragraphs 39 to 42 of its Judgment in the BABY-DRY case the ECJ held that the exclusion from registration contained in Section 3(1)(c) of the 1994 Act is applicable to signs and indications which consist simply and solely of designations “*which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought*” (paragraph 39) and which may therefore be viewed as a normal way of referring to the goods or services or of representing their essential characteristics in common parlance (paragraph 42).

8. In paragraphs 43 to 46 of its Judgment the Court held that the exclusion did not apply to signs or indications identifiable as “*syntactically unusual juxtapositions*” of words in the nature of “*lexical inventions*” (in that case, BABY-DRY for disposable diapers made out of paper or cellulose and diapers made out of textile).

9. For the reasons I gave at greater length in CYCLING IS Trade Mark [2002] RPC 37. p. 729 I consider that the BABY-DRY Judgment addresses the scope of the objection prescribed by Section 3(1)(c) of the Act and does so without laying down any general rule to the effect that signs which are not wholly descriptive should, for that reason, be regarded as distinctive and therefore free of objection under Section 3(1)(b) of the Act.

10. I believe that similar views have been expressed by Advocate General Colomer in Opinions delivered in Case C-363/99 Koninklijke KPN Nederland NV v. Benelux-Merkenbureau (POSTKANTOOR) on 31st January 2002 and Case C-104/00 P DKV Deutsche Krankenversicherung AG v. OHIM (COMPANYLINE) on 14th May 2002, although I have not yet seen the official English translations of those Opinions.

11. The Judgment of the ECJ in the COMPANYLINE appeal was delivered on 19th September 2002. The appellant, DKV, had applied unsuccessfully for registration of the designation COMPANYLINE as a Community trade mark in relation to insurance and financial affairs in Class 36. Its appeal to the ECJ was dismissed.

12. In paragraph 20 of its Judgment the ECJ held that there is no obligation to rule on the possible dividing line between the concept of lack of distinctiveness and that of minimum distinctiveness when considering whether a mark is *“devoid of any distinctive character”* within the meaning of Section 3(1)(b) (Article 7(1)(b) CTMR). It found (paragraphs 21 to 24) no error in the reasoning of the Court of First Instance to the effect that *“coupling the words ‘company’ and ‘line’ - both of which are customary in English-speaking countries - together, without any graphic or semantic modification, does not imbue them with any additional characteristic such as to render the sign, taken as a whole, capable of distinguishing DKV’s services from those of other undertakings”*. In paragraphs 31 to 36 of its Judgment the Court specifically rejected the appellant’s contention that the mark in issue should not have been refused registration under Section 3(1)(b) (Article 7(1)(b) CTMR) without consideration of the question whether it was free of objection under Section 3(1)(c) (Article 7(1)(c) CTMR).

13. Although the Court declined to rule on the argument that Section 11(2)(b) (Article 12(b) CTMR) operates as a corrective to the interpretation of Section 3(1)(b) (Article 7(1)(b) CTMR), it may be noted that the reasoning of the Court of First Instance in relation to Section 3(1)(b) (Article 7(1)(b) CTMR) was found to be free of error notwithstanding that it had made no reference in the dispositive paragraphs of its Judgment (paragraphs 23 et seq.) to the provisions of Section 11 (2)(b) (Article 12(b) CTMR).

14. The Judgment of the ECJ in the COMPANYLINE case reinforces me in the view expressed in the CYCLING IS decision that Section 3(1)(b) contains an independently available objection to registration of somewhat broader scope than that prescribed by Section 3(1)(c) and that the test of registrability under Section 3(1)(b) resides in the question whether the perceptions and recollections that the sign in issue would trigger in the mind of the average consumer of the specified goods or services are likely to be origin specific or origin neutral.

15. At the hearing before me it was accepted that SURF UNLIMITED alluded to the character of the services specified in the application for registration in as much as they were to be provided with or via unmetered access to the internet. It was also accepted that “unlimited surfing” would be an unregistrable designation suitable for use in relation to such services. The case for registration was based on the proposition that SURF UNLIMITED differed distinctively from the designation “unlimited surfing” as a result of the combined effect of reversing what was said to be the natural sequence of the words “unlimited surfing” and abbreviating “surfing” to SURF.

16. The argument for the Applicant rightly recognises that the words SURF and UNLIMITED are meaningful to a degree which rendered them individually non-distinctive in relation to the services of interest to the Applicant at the date of the application for registration.

17. In the context of the internet, the word SURF is widely known and extensively used to refer to the activity of visiting websites and exploiting the possibilities they offer. There is no real difference of meaning between the words SURF and SURFING in that connection: 'surf the net' and 'surfing the net' are coalescent expressions of the same basic concept.

18. The word UNLIMITED plainly denotes absence of restriction. It retains its explanatory significance when used in expressions such as 'unlimited surfing'. To speak of '[activity] unlimited' and 'unlimited [activity]' is to convey the same basic information by means of reversible expressions that are equally informative in modern idiomatic English usage. With the relevant 'activity' described generically, either mode of expression is prone to be perceived and remembered non-distinctively.

19. Concentrating on the expression SURF UNLIMITED and considering the significance of the differences between that expression and the admittedly unregistrable expression 'unlimited surfing', I find myself unable to say that the differences have sufficient impact to support the view that the average consumer of the services concerned would, because they were marketed as SURF UNLIMITED services, take them to have come from the same undertaking or economically linked undertakings. I say that because

I consider the message directly conveyed by the words concerned to be no more and no less than ‘surf time unlimited’.

20. From a syntactical point of view SURF UNLIMITED is distinguishable from the expression ‘unlimited surfing’. However, from the point of view of linguistic communication I do not think that the expressions are sufficiently different to make it likely that the former will function as an indication of trade origin when the latter would not. It seems to me that the expression SURF UNLIMITED denotes a class or category of internet usage and remains meaningful in relation to the specified services at a level of generality that points to it being unregistrable under Section 3(1)(b) even if it is free of objection under Section 3(1)(c) on the BABY-DRY approach to the interpretation of the latter sub-section.

21. I am not persuaded otherwise by the fact that the Applicant has applied successfully under number 001432780 for registration of SURFUNLIMITED as a Community trade mark in respect of a wide range of services in Classes 38, 41 and 42 (including services of the kind specified in the Application that is now before me).

22. The Community Office may or may not have been aware that the Applicant was seeking to register SURFUNLIMITED and SURF UNLIMITED in series in the United Kingdom on the basis that the two marks “*differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark*” (Section 41(2) of the Act). It is in any event clear that each national authority is entitled to assess distinctiveness in the light of circumstances prevailing in its own territory, it being recognised and accepted that assessments are liable to vary as a result of linguistic,

cultural and social differences between Member States: see the cases referred to in paragraph 61 of the CYCLING IS decision.

23. In paragraph 39 of its Judgment in the COMPANYLINE case (above) the ECJ held that nothing in the Community Trade Mark Regulation required the Community Trade Marks Office to come to the same conclusions as those arrived at by national authorities in similar circumstances. Directive 89/104/EEC of 21st December 1988 similarly appears to permit the national authorities in the Member States to conclude that the outcome of an application for registration in the Community Trade Marks Office is not necessarily determinative of a parallel application for registration under the harmonised law of trade marks at the national level: see paragraph 58 of the Judgment of Lloyd J. in Dualit Ltd's Trade Mark Application [1999] RPC 890.

24. I do not doubt that there is a need for consistency of approach to the registration of trade marks under the applicable provisions of Community law. However, differences of approach may result from the fact that the correct approach continues to be the subject of analysis in the case law of the supervising courts in Luxembourg. And tribunals adopting the correct approach may nevertheless arrive at different conclusions as to the registrability of a particular trade mark on an overall assessment of the circumstances prevailing in the territory to which their jurisdiction extends.

25. I differ reluctantly from the position adopted by the Community Office in relation to the Applicant's Community trade mark application number 001432780, but believe it is right that I should do so for the reasons I have given above.

26. As I indicated at the conclusion of the hearing before me, the appeal will be dismissed. In the absence of any reason to depart from the usual practice in relation to appeals of this kind, it will be dismissed with no order as to costs.

Geoffrey Hobbs Q.C.

31st October 2002

Mr. Jeremy Pennant of Messrs D. Young & Co appeared on behalf of the Applicant.

Mr. Allan James, Principal Hearing Officer, appeared on behalf of the Registrar.