

**Trade Marks Act 1994**

**IN THE MATTER OF Application  
No. 2222412 by Unmissable Ltd  
to register a trade mark in classes  
16 and 38 and in the matter of  
Opposition No. 51184 thereto by  
IPC Media Ltd**

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**Background**

1. On 16<sup>th</sup> February 2000 Unmissable Ltd applied to register the trade mark UNMISSABLE in respect of the following goods:

Class 16  
Printed publications

Class 38  
Provision of information via wide area networks and relating to travel, live events and consumer products.

The application was accepted by the Registrar and published in the Trade Marks Journal.

2. Following publication, the Registry received observations under Section 38 (3) of the Act from fj Cleveland on behalf of IPC Magazines Ltd challenging the acceptance of the application, on both absolute and relative grounds. The Registry responded to these observations and provisionally concluded that the application had been accepted in error. The Registry also concluded that a further error had occurred in that none of the services applied for in class 38 should have been classified under that class heading. I shall return to this matter later in this decision.

3. As the provisional view was that the application had been accepted in error, notice was given of the intention to refuse the mark under Section 40 of the Trade Marks Act 1994. The Registrar cannot, however, refuse acceptance of a published mark until after the expiry of the opposition period and until such times as any opposition which may be filed is withdrawn or decided in favour of the applicant (S40(1) (a) and (b)). Notice of opposition was filed on 18 July 2000 by fj Cleveland on behalf of IPC Magazines Ltd, who subsequently underwent a change of name to IPC Media Ltd. Although the view had been expressed on behalf of the Registrar that the application has been accepted in error, this was a provisional finding and I have considered matters afresh in reaching my decision.

4. The grounds of opposition are, in summary:

- Under section 3(1) (b), (c) and (d) because the mark is devoid of any distinctive character or consists of a sign used in trade to indicate quality, kind etc or consists

exclusively of signs which have become customary in the current language or in the *bona fide* and established practices of the trade.

- Under section 5(2)(b) in that the opponent has the following earlier trade marks which are similar and for goods which are similar, if not identical, to the trade mark sought to be registered by the applicant.

Application No	Mark	Filing Date
2212846 (UK)	UNMISSABLE TV	29 October 1999
2220472 (UK)	UNMISSABLE TV & Device	27 January 2000
1633262 (CTM)	UNMISSABLE TV	28 April 2000 (Claiming priority date of 29 October 1999 from UK mark 2212846)

All three applications have the following specifications:

Goods

Class 35: Advertising and promotional services

Class 41: Information and advisory services relating to television, television programmes, entertainment and education, including such services provided via the Internet

5. Gallafent & Co, on the applicant's behalf, filed a counterstatement defending the application. Only the opponent filed evidence. The opponent asked for an award of costs. In line with current Registry practice the Registrar wrote to the parties and advised that having reviewed all the papers filed, the Hearing Officer had reached the conclusion that there was sufficient information available to enable a decision to be reached without recourse to a hearing. The parties were, however, reminded of their right to be heard or to make written submissions in lieu thereof. Neither party requested a hearing in this matter although the opponent indicated support for a decision to be taken from the papers. No further submissions were filed. After a careful study of the papers and acting on behalf of the Registrar, I now give this decision.

### **Opponent's evidence**

6. This consists of a statutory declaration dated 26 November 2001 by Imogen Wiseman who confirms she is a registered Trade Mark Attorney acting on behalf of IPC Media Ltd. Ms Wiseman firstly restates the grounds of opposition.

7. Ms Wiseman exhibits at IOW1 extracts from various dictionaries published between 1993 and 2000 which define the word UNMISSABLE. She goes on to say that the word UNMISSABLE is used in relation to a wide range of subject matter, including travel, art, literature, theatre, education and conferences and exhibits at IOW2 various printouts from the Internet to support her claim. She also exhibits at IOW3 pages from what she claims

is the applicant's own website showing how the word is used in a number of descriptive ways.

8. Ms Wiseman states that the word UNMISSABLE is contained within a large number of domain names and used there descriptively. She exhibits at IOW 4 the results of an independent domain name search, carried out on 9 June 2000.

9. Ms Wiseman challenges the classification of the goods of the application in suit in relation to those classified in class 38 and exhibits at IOW 6 a page from the Registry's Classification Guide to support her contention. As I indicated earlier in this decision, this has already been raised with the applicant by the Registry.

10. Ms Wiseman contends that both specifications cover the provision of information. She goes on to say that both the applicant's and the opponent's marks cover the provision of information via the Internet and other electronic networks. She further contends that the provision of information in printed publications and over the Internet or electronic networks are complementary and that many companies provide information under the same trade mark using both media. At IOW 7 she exhibits pages taken from magazines and websites bearing the same mark to support her claim. She contends that the public would expect printed publications and websites bearing the same trade mark to emanate from a common source. Ms Wiseman also exhibits at IOW 8 and 9 magazines and print-outs from the Internet to show how varied their subject matter can be.

### **Decision**

11. I will deal first with the grounds of opposition based upon Section 3. The relevant provisions state:

- “3. –(1) The following shall not be registered –
- (a) .....
  - (b) trade marks which are devoid of any distinctive character,
  - (c) trade marks which consists 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.”

12. The applicant has filed no evidence of use and cannot therefore benefit from the proviso to the sub-section which is included only for the sake of completeness. I have only the prima facie case to consider.

### **Section 3(1)(c)**

13. The mark consists exclusively of the word UNMISSABLE in standard characters. The word UNMISSABLE is one which is part of the ordinary English language. The opponent’s evidence provides extracts from various dictionaries with a publication date earlier than the date of the application in suit. The definitions vary slightly but all define UNMISSABLE as being an adjective used to describe something that should not be missed or something that is so good that it should not be missed. The evidence shows that the adjectival meaning has been recognised and used from a time which clearly predates the application. That adjectival use is laudatory in nature, exhorting one not to miss seeing or otherwise experiencing the subject matter. It is highly relevant in relation to the goods and services for which registration is sought in that it is descriptive of printed publications and the provision of information which are not to be missed. This descriptive use could refer to the goods or services themselves as well as to the subject matter of those goods or services. In view of this the opposition under Section 3(1)(c) succeeds.

### **Section 3(1)(b)**

14. In case I am wrong in my finding under Section 3(1)(c), I go on to consider the opposition under Section 3(1)(b) as a mark which is free from objection under Section 3(1)(c) may still fall foul of Section 3(1)(b). (*DKV Deutsche Krankenversicherung AG v OHIM* ECJ C-104/00P).

15. In considering how distinctiveness should be assessed, I take into account the comments of Geoffrey Hobbs QC sitting as the Appointed Person in the case of “Cycling IS...” (28 November 2001). He said:

“57. The question whether a particular sign possesses a distinctive character cannot be considered in the abstract: Merz & Krell, paragraph 29. It must be considered in relation to the goods or services for which registration has been requested: Merz & Krell, paragraphs 29 and 30. In order to be registrable in that connection the sign in question must possess enough of a distinctive character to be regarded as an indication of trade origin by the relevant class of persons or at least a significant proportion thereof: Windsurfing, paragraph 52.

58. The relevant class of persons consists of the trade and average consumers of the specific goods and services in the territory covered by the application for registration. Windsurfing, paragraph 29. The average consumer of the goods or services concerned is to be regarded as reasonably well-informed and reasonably observant and circumspect. Case c 342/97 Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV[1999]ECR I-3819 paragraph 26. It is to be remembered that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: Lloyd Schuhfabrik paragraph 25. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: Lloyd Schuhfabrik paragraph 26.

59. It is implicit in this approach to the assessment of distinctiveness that the perceptions of the average consumer are to be assessed in context, with due regard for the realities of the market place. In cases where the application for registration contains no limitation as to how the sign in question is to be used, it will be relevant to have regard to the various methods and practices of marketing that the average consumer of the relevant goods or services is likely to encounter under normal and fair trading conditions. It is also appropriate to bear in mind that use on business papers and in advertising is within the scope of the protection that the applicant is seeking to obtain; See Article 5(3)(d) of the Directive (Section 10(4)(d) of the Act).

60. When assessing the capacity of the sign in question to identify the relevant goods or services as coming from a particular undertaking and thus to distinguish them from those of other undertakings, account should be taken of the inherent characteristics of the sign including the fact that it does not contain an element descriptive of the relevant goods or services: Lloyd paragraphs 22 and 23”

16. The question to be answered is whether the mark possesses a distinctive character which enables it to fulfil the essential function of a trade mark in relation to the goods and services for which registration is sought. In my view, it does not. I consider the average customer would perceive the mark in use to be a statement relating to the goods or services and not an indication of the trade origin of those goods or services. Indeed I consider that the word UNMISSABLE would be seen as a description of the goods or services.

17. In her statutory declaration Ms Wiseman says:

“5 The word UNMISSABLE is used in relation to a wide range of subject matter, including travel, art, literature, film and theatre. It is even used in relation to education and conferences. The various applications of the word in everyday language can be seen from Exhibit IOW2 which contains a selection of examples of the descriptive use of the word on the internet. The descriptive use of the word UNMISSABLE can also be seen on the Applicant's own web-site, pages of which are now produced and shown to me marked Exhibit IOW3. The Applicant uses

the word UNMISSABLE in a number of descriptive ways, including references to “unmissable random ideas”, “unmissable mountain pastimes” and “unmissable experiences”.

6 The word UNMISSABLE is contained within a large number of domain names. In the majority of these, the word’s function is very descriptive. This can be seen from Exhibit IOW4 which is a domain name search for the element UNMISSABLE conducted by the independent search agency Compumark on 9 June 2000”.

18. Ms Wiseman’s evidence shows use of the word UNMISSABLE by a number of third parties. Whilst I note that this evidence is all after the relevant date it does confirm the suitability of the word UNMISSABLE as a description of the goods and services in a number of fields. The evidence, however, does no more than support my view and I would have come to the same conclusion without it.

The opposition under Section 3(1)(b) succeeds.

#### **Section 3(1)(d)**

19. The opponent contends that the word UNMISSABLE is used generally by providers of information to describe their products and has thus become customary in the current language or in the bona fide and established practices of the trade. I am, however, without any evidence of this at the material date. This ground of opposition is therefore dismissed.

#### **Section 5 (2)(b)**

20. Given that the opposition has succeeded under both Section 3(1)(b) and (c), I do not consider it to be necessary to reach a decision under the Section 5(2)(b) ground and decline to do so.

#### **Other issues**

21. As alluded to earlier in this decision, the Registry has indicated a preliminary view that the services applied for in Class 38 are not, in fact, appropriate to that class. The services themselves are quite clearly defined and I have made my decision on the basis of the services applied for, which would be the same irrespective of the classification. Should I be wrong in my findings under Sections 3(1)(b) and (c), however, the question of the correct classification of services will need to be addressed.

#### **Conclusion**

22. The opposition has succeeded and the opponent is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £900. This sum is to be paid

within 7 days of the expiry of the appeal period or within 7 days of the final determination of this case if any appeal against this decision is made.

**Dated this 27<sup>th</sup> day of November 2002**

**Ann Corbett  
For the Registrar  
The Comptroller-General**