

O-513-14

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NUMBER 3040713  
BY ROCHDALE ONLINE LTD  
TO REGISTER THE FOLLOWING TRADE MARK  
IN CLASS 35**

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**Background**

1. On 4 February 2014, Rochdale Online Ltd ('the applicant') applied to register trade mark application number 3040713 consisting of the words 'Rochdale Online' for the following services in class 35:

*The provision of news, information and advertising services for the borough of Rochdale.*

2. On 25 February 2014, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act'), on the basis that the mark consists exclusively of a sign which might serve in trade to designate the intended purpose of the services e.g. news, information and advertising services provided online about the borough of Rochdale. In line with routine IPO procedure in respect of so-called 'Right Start' applications, a period of 14 days was allowed for the applicant to respond.
3. On 10 March 2014, the applicant filed a Form TM3S in order to pay the second part of the 'Right Start' application fee. In addition to providing the applicant with a means of continuing with the (objectionable) application, the TM3S form also provides the applicant with an opportunity to present arguments and submissions in response to any objections raised. In the present case, the applicant - via a form TM3S - provided information regarding its use of the mark to date, and submitted arguments regarding consumer perception including recognition for the mark amongst professional business consumers, local politicians and the BBC. It was submitted that the average consumer would consider the sign 'Rochdale Online' as coming from one particular trader.
4. On 20 March 2014, IPO issued its response by maintaining the objection. This was because, in the examiner's view, the sign would not be given any trade mark significance by the average consumer. The examiner did acknowledge the applicant's claims regarding local distinctiveness of the sign in Rochdale, the use made of it up to the date of filing, and the willingness to provide a sworn statement confirming such facts. In the context of the applicant's apparent interest in submitting evidence of acquired distinctiveness, relevant hyperlinks to pages on the IPO website were provided containing information on how to submit such material. A period of two months was then granted for the applicant to respond.

5. No response was received from the applicant on expiration of the deadline, and so the application was subsequently refused by way of a letter dated 21 May 2014.
6. On 23 June 2014, the IPO received a Form TM5 requesting a statement for the Registrar's decision. It is assumed from this that the applicant did not want to formally re-open the examination process, but instead was seeking more detailed reasons for the refusal. In providing these reasons, I have only the *prima facie* case to consider.

## Decision

7. The relevant parts of section 3 of the Act 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) ...*

*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."*

8. There are now a number of judgments from the Court of Justice of the European Union ('CJEU') which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 (recoded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1)(c) of the Community Trade Mark Regulation (the 'CTMR'), whose provisions correspond to section 3(1)(c) of the UK Act. The following main guiding principles which are relevant to this case are noted below.

- Subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (*Wm Wrigley Jr & Company v OHIM, C-191/01P (Doublemint)*, paragraph 30);
- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all (*Doublemint*, paragraph 31);
- It is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes (*Doublemint*, paragraph 32);

- It is irrelevant whether there are other more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question (*Koninklijke KPN Nederland NV v Benelux Merkenbureau*, C-363/99 (*Postkantoor*, paragraph 57));
- An otherwise descriptive combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word trade mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark (*Postkantoor*, paragraph 99).

9. In *Concord AG v Hukla Germany SA*, C-421/04 (*Matrazen*), the CJEU stated that:

*“...to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, who are reasonably well informed and reasonably observant and circumspect, in the territory in respect of which registration is applied...”*

10. I am also mindful of the decision of the General Court (formerly the Court of First Instance) in *Ford Motor Co v OHIM*, T-67/07 where it was stated that:

*“...there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics.”*

11. It is clear from the aforementioned case law that, assuming notional and fair use, I must determine whether or not the mark applied for will be viewed by the average consumer as a means of directly designating essential characteristics of the services being provided. It is reasonable to assume that the average consumer is likely to consist of anyone seeking information on, or about, the borough of Rochdale. This customer base would consist of both a *professional* public (for example, businesses seeking to advertise their goods and services towards an audience situated in Rochdale), and also the general public at large. Due to the nature of the services, I consider that the average consumer would apply a reasonably high level of attention to the services being sought out since the consumer would be seeking out *inter alia* professional services.

12. In assessing the mark applied for, I have taken into account dictionary definitions of the individual words contained within it. The following definitions are taken from the Collins English Dictionary and the Dictionary of Publishing and Printing, respectively:

**Rochdale** a unitary authority in NW England, in Greater Manchester. Population: 207 600 (1995 est.). Area: 159 sq. km (61 sq. miles).

**Online** relating to data or information that is available when a terminal is connected to a central computer via a modem

13. The word 'Rochdale' has an obvious descriptive meaning in relation to *the provision of news, information and advertising services for the borough of Rochdale*. That is to say, it would be understood by the relevant consumer as being a direct reference to the town/borough of Rochdale, and one would further assume that the news, information and advertising services in question are being provided within, or for the benefit of, those within Rochdale. Addition of the word 'Online' would merely indicate that the news, information and advertising services being provided are available via electronic means (i.e. provided 'online'). In that regard, I have noted that the applicant has disclaimed any exclusive rights to the words individually. However, I must consider how the average consumer would perceive the mark in totality. In other words, I must consider what the combination of the words would mean to the average consumer.
14. I do not believe that the combination of these two words can lay claim to any grammatical or linguistic imperfection or peculiarity such as might help to escape its inherent descriptiveness. From a purely semantic and literal analysis of the expression 'Rochdale Online', I do accept that one cannot literally 'place' the geographical area of Rochdale into an online context. That is to say, Rochdale is itself a tangible location rather than a virtual environment. However, and the previous point notwithstanding, in the context of services for providing news, information and advertising for and about Rochdale, the word 'Rochdale' would undoubtedly be taken to mean e.g. 'things happening in Rochdale' and/or 'business operating in Rochdale' and/or 'weather in Rochdale' etc.
15. Given how this sign is likely to be used, and assuming that the word 'Rochdale' is likely to be interpreted by the relevant consumer as actually meaning 'things and events happening in Rochdale', then addition of the word 'online' does little to affect the sign's overall impression. This second word only serves to inform the relevant consumer that the information and services in question are being provided via the Internet, rather than via more traditional means. In my opinion, the average consumer, who is considered to be reasonably well informed and circumspect, would clearly understand the message being conveyed by the sign on first impression of the mark, and would recognise it as designating the services being provided.
16. The applicant says that the expression 'Rochdale Online' is recognised by the BBC and others as a distinctive brand. That may be the case, and the applicant was provided with an opportunity to present evidence in order to substantiate such a claim. However, no evidence was ever submitted during prosecution of the application. Therefore, it is not a fact which, in the *prima facie* case, and in the context of an assessment based on inherent characteristics only, I can take into account.
17. For these reasons, the application is refused under section 3(1)(c) of the Act. Of course, a sign which is subject to objection under section 3(1)(c) on the basis that it designates a characteristic of the relevant services will, of necessity, also be devoid of distinctive character under section 3(1)(b) - see, to that effect, paragraph 86 of Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau ('Postkantoor')*. But plainly,

and given the public interest behind the two provisions, they must be assessed independently of each other as their scope is different. That is to say that section 3(1)(b) will include within its scope marks which, whilst not designating a characteristic of the relevant services, will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin.

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

18. In the event that I am wrong on the finding above under section 3(1)(c), I will go on to consider the additional ground of objection under section 3(1)(b) separately.
19. I approach this ground of objection on the basis of the following principles derived from the CJEU cases referred to below:
  - An objection under section 3(1)(b) operates independently of objections under section 3(1)(c) - (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);
  - For a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
  - A mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86);
  - A trade mark's distinctiveness 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 by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);
  - The relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).
20. Furthermore, in relation to section 3(1)(b) it was held in *Postkantoor* that:

*“In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.” (Paragraph 86)*
21. It is clear from the above case law that an application should not necessarily escape objection if it is considered too imprecise a term to indicate a direct and specific relationship with the services at issue without further thought, but is, in some sense, more generally non-distinctive.

22. Anna Carboni, sitting as the Appointed Person in *COMBI STEAM*, O-363-09, conveniently summarised the leading case law in respect of this part of the Act:

*“It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs “a residual or sweeping-up function”, backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: Procter & Gamble Ltd’s Trade Mark Application [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): Koninklijke KPN Nederland BV v Benelux-Merkenbureau Case C-363/99 (POSTKANTOOR) [2004] ETMR 57 (ECJ) at [86]”.*

23. It could be said that the sign in question has a degree of linguistic quirkiness and surprise given that, as was explained at paragraph 14 above, one cannot literally have ‘Rochdale’ online. In theory at least, one could also argue that this sort of linguistic/semantic ‘step’ might take the sign outside the very clearly-defined scope of section 3(1)(c). However, I have indicated (also at paragraph 14) how I think the word ‘Rochdale’ would be perceived as meaning, for example, ‘things happening in Rochdale’. I believe that this meaning will be readily understood and comprehended by the average consumer when used in relation to the services intended for protection. Thus, even if it were the case that the phrase ‘Rochdale Online’ was found not to designate a characteristic (or characteristics) of the services claimed (which I do not believe to be the case), in my opinion it would still be regarded by the relevant consumer as being, at the very least, origin-neutral rather than origin-specific. The mark in question is therefore devoid of any distinctive character, and must also be refused under section 3(1)(b) in its own right.

## **Conclusion**

24. In this decision I have considered all the papers on file and the submissions made. Taking all of these factors in to account, the objection under sections 3(1)(b) and (c) is maintained, and the application is refused on that principal basis for all the services claimed in class 35.

**Dated this 3rd day of December 2014**

**Lee Scott  
For the Registrar  
The Comptroller-General**