

TRADE MARKS ACT 1994
AND
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

In the matter of
International Registration no: 676820
and the request by Tesa Brown & Sharpe S.A.
to protect a trade mark in Class 9

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to protect a trade mark in Class 9**

On 14 May 1997, Tesa Brown & Sharpe S.A. of 38, rue Bugnon, CH-1020 Renens, Switzerland, on the basis of a registration in that country, requested protection in the United Kingdom, under the provisions of the Madrid Protocol, of the Trade Mark:

The image shows the word "Derby" written in a cursive, handwritten style. The letters are connected, with a prominent flourish under the 'y' that extends back under the 'b' and 'r'. The ink is black on a white background.

The following words appear beneath the mark on the form of notification:

Indication relating to the nature or kind of mark: standard characters.

The International Registration is numbered 676820 and protection is sought in Class 9 in respect of

“ Dual-coordinate measuring machines, triple-coordinate measuring machines”.

It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 the Trade Marks (International Registration) Order 1996 and notice of refusal was given under Sections 3(1)(b)&(c) of the Trade Marks Act 1994 because the mark consists exclusively of the word “Derby” being a sign which may serve in trade to designate the geographical origin of the goods.

At a hearing at which the applicants were represented by Mr D Lutkin of David Lutkin & Associates, their agents, the notice of refusal was upheld. I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of decision and the materials used in arriving at it.

No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

Sections 3(1)(b) and (c) of the Act read as follows:-

3(1) The following shall not be registered -

(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, geographic origin, the time of production of goods or of rendering of services, or other characteristics of goods or services.

At the hearing Mr Lutkin argued that the word DERBY has many meanings and is not therefore exclusively an indication of geographical origin. Collins English Dictionary (3rd ed 1994) gives the following definitions:

derby the US and Canadian name for **bowler**

Derby 1. the an annual horse race run at Epsom Downs, Surrey, since 1780: one of the English flat-racing classics. **2.** any of various other horse races **3. local Derby** a football match between two teams from the same area.

Derby 1. a city in central England, in Derbyshire: engineering industries (esp. aircraft engines and rolling stock). Pop. 215,000 (1985 est). **2.** a firm-textured pale-coloured type of cheese. **3. sage Derby.** A green and white Derby cheese flavoured with sage.

In the judgement of the European Court of Justice in conjoined cases C-108/97 and C-107/97 *Windsurfing Chiemsee v Huber and Windsurfing Chiemsee v Attenberger* the Court ruled:

1. *Article 3(1)(c) of the First Council Directive 89/104/EEC, [which is reproduced in Section 3(1)(c) of the Trade Marks Act 1994], is to be interpreted as meaning that:*

— *it does not prohibit the registration of geographical names as trade marks solely where the names designate places which are, in the mind of the relevant class of persons, currently associated with the category of goods in question; it also applies to geographical names which are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods;*

— *where there is currently no association in the mind of the relevant class of persons between the geographical name and the category of goods in question, the competent authority must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods;*

— *in making that assessment, particular consideration should be given to the degree of familiarity amongst the relevant class of persons with the geographical name in question, with the characteristics of the place designated by that name, and with the category of goods concerned;*

— *it is not necessary for the goods to be manufactured in the geographical location in*

order for them to be associated with it.

With this judgement in mind I find that the sign applied for may serve, in trade, to designate the geographical origin of the goods in question. Although Derby's reputation for engineering is, according to Collins, *especially* for aircraft engines and rolling stock, it does not seem unreasonable to expect there to be other types of engineering industry in the region, which could include the manufacture of measuring machines. Even if this were not so, the ECJ judgement states that Section 3(1)(c) does not apply *solely where the names designate places which are currently associated with the category of goods in question*, it also applies to *geographical names which are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods*. I am instructed that I *must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods*.

It seems to me unlikely that anyone seeing the word Derby used in relation to measuring machines would have any reason to associate it with bowler hats, horse racing, football matches or cheese. On the other hand Derby is a large city in England with a reputation in the engineering field, therefore my assessment is that potential purchasers of measuring machines in the United Kingdom are more likely to see the mark as a reference to the English city and thus as an indication of the geographical origin of the goods.

Mr Lutkin also argued that the mark is highly stylised and for that reason does not consist exclusively of the word DERBY. The wording beneath the representation of the mark on the form of notification indicates that the mark is in standard characters, which I take to mean that the stylisation is not claimed as part of the mark. However, in case I am mistaken, I go on to deal with the agent's submissions on this point.

In *British Sugar plc and James Robertson & Sons Ltd* decision [1996] RPC 281 (referred to as the TREAT decision), Mr Justice Jacob said:

"I am, of course, aware that the words "Toffee Treat" are written in a fancy way. But then so are many other mere descriptors. One only has to look at how British Sugar write such words as "Meringue mix" or "Golden Syrup" to see parallel sorts of use. I do not think this affects the matter one way or the other"

TREAT was a descriptor whereas DERBY, as I have found, is an indication of geographical origin, but I think the principle is the same. Merely presenting the word in script form does not turn it from being an indication of geographical origin into a trade mark.

Mr Lutkin argued further that the particular script in which this mark is presented is not just a font, but is very heavily stylised with particular emphasis being given to the letters "D" and "y". In my opinion the presentation is no more than neat handwriting with a flourish at the start and end of the word and does not add sufficient surplus to the word to justify protection.

It appears to me, therefore, that the mark consists exclusively of a sign which may serve, in trade, to designate the geographical origin of the goods at issue, and so does not qualify under Section 3(1)(c) of the Act.

For the same reason I consider the mark to be devoid of distinctive character and therefore not acceptable, prima facie, for registration under Section 3(1)(b).

That is not to say that the mark can never be registered - I do not think that is the case - but, to use the words of Mr Justice Jacob in the "TREAT" case, it is the sort of sign "which cannot do the job of distinguishing without first educating the public that it is a trade mark".

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, the notice of refusal was upheld.

Dated this 20 day of July 1999.

ANNE PRITCHARD
For the Registrar
The Comptroller General