

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application no. 2398973**

**By FSTC Ltd Foundation for Science Technology and Civilisation**

**To register a trade mark in class 41**

**BACKGROUND**

1. On the 10th August 2005 FSTC Ltd Foundation for Science Technology and Civilisation applied to register the following trade mark:-

**MuslimHeritage.com**

2. The services for which registration is sought are:-

**Class 41:**

FSTC LTD owns and maintains the internationally recognised award winning educational website MuslimHeritage.com, this website is well known for being the best online reference site on all matters of Muslim Heritage and FSTC LTD is registering the mark in its entirety as this is distinctive to its use.

3. An objection was raised against the mark "MuslimHeritage.com" under Section 3(1)(b) of the Trade Marks Act 1994 ("the Act"), on the grounds that it would be seen as a non-distinctive sign offering/providing information on Muslim Heritage on line. A re-wording of the specification was also suggested.

4. The applicant responded 25th March 2006 with counter arguments. The revised specification of "Information relating to all matters of Muslim Heritage, provided on-line" was accepted.

5. An Official response to the applicants letter of 25th March 2006 was issued on 11th May 2006, in which the Section 3(1)(b) objection was maintained. The applicant had mentioned in his letter that his mark had become distinctive through use. Information on the filing of evidence was issued with the Official Letter. The applicant was asked to reply by 11th July 2006.

6. The applicant failed to respond to the Official Letter of 11th May 2006 and the application was finally refused on 16th August 2006.

7. Whilst the applicant referred to the use made of the mark, no formal evidence was supplied in support of the application. Therefore, I have no alternative but to only consider the prima facie case. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of the decision and the material used in arriving at it.

## **The Law**

8. Section 3(1)(b) of the Act reads as follows:

3- (1) the following shall not be registered-

(b) trade marks which are devoid of any distinctive character.

## **The applicant's case for registration**

9. The applicant submitted that the objection raised under 3(1)(b) should be waived. He maintained that the mark 'MuslimHeritage.com' has become a widely recognised brand over many years. It is also a definitive source for information on Muslim Heritage with a global readership of over 20,000 readers a day. A simple search for this site would bring back 37,000 hits on Google, and it is the first external reference site for BBC Islam.

10. It was also submitted that "Muslim Heritage.com" hosted a successful exhibition called "1001 Inventions: Discover the Muslim Heritage of our World". Sponsored by the UK Home Office, Foreign Office and the Department for Trade and Industry. Many distinguished guests attended including the Right Honourable Mike O'Brien (QC Solicitor General, on behalf of Tony Blair). Web links were also included in the applicants letter of 25th March 2006, which gave more information on the event. The applicant had claimed the mark was distinctive through use, but no evidence was filed with the letter.

## **DECISION**

11. The following is an extract from the Registry Practice Manual on the registration of domain names:

"A domain name is a written representation of an Internet electronic address, e.g. www.patent.gov.uk, which is the Office's web site address. It is common-place for goods and services to be sold in the UK under such a name, i.e. the domain name is being used as a trade name or trade mark, and the Registrar will, subject to the usual criteria of the Act, permit domain names to be registered as trade marks.

Elements of the domain name such as ".com" or ".co.uk" are considered to be totally non-distinctive, much in the same way as "Ltd" and "Plc". As a general rule, one should consider whether the remainder of the mark is descriptive or non-distinctive; if so, there is likely to be an objection under Section 3(1)(b) of the Act.

There may be exceptions. For example TWIST AND SEAL would be liable to an objection for storage jars on the basis that it describes a characteristic of the goods, whereas the addition of ".COM" gives the sign as a whole a trade mark character."

12. It is appropriate to mention at the outset that in my view it is debateable whether the objection to this mark ought to have been raised under both Sections 3(1)(b) and (c) of the Act. I say this because the basis of the objection is that the mark would serve as no more than an indication to the content of the particular website. That being the case the grounds of objection extend to Section 3(1)(c) of the Act. However, as it is established that marks which are descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive are, 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, nothing turns on this point. [see *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* Case C-363/99 [2004] ETMR 57 (para 86)]

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

13. The question I must therefore answer is whether, on face value, the mark will perform the essential distinguishing function, or whether it lacks the distinctiveness to do so. The approach to be adopted when considering this question was summarised by the ECJ in paragraph 37, 39 to 41 and 47 of its Judgement in joined cases C-53/01 to C55/01 *Linde AG, Winward Industries Inc and Rado Uhren AG* (8 April 2003) in the following terms:

“37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods or services of one undertaking from those of other undertakings.

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips* paragraph 35).

41. In addition, a trade mark’s distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court’s case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings”.

14. From the above I am aware that the distinctiveness of the mark must be assessed in relation to the services sought by the applicant. I must also have regard to the perception of the average consumer who is deemed to be reasonably well informed and reasonably observant and circumspect.

15. The applicant's mark has been applied for in respect of a website which provides information relating to all matters on Muslim Heritage. It is not a specialist or technical area and the average consumer will therefore be the general public. The question I must ask therefore is whether the mark would serve to indicate, when encountered by a member of the general public, that the services provided under it originate from a particular trader and, thus, distinguishes their services from those of other traders.

16. In my judgement the average consumer, on seeing this mark, would acknowledge it as a domain name leading to a website providing information on Muslim Heritage, not as an indicator of trade source.

17. There is also the question as to the impact that the “.com” element is likely to have on the perception of the average consumer.

18. Registries around the world are no doubt faced with dealing with the relationship between web addresses and registered trade marks. In a recent Board of Appeal Decision at OHIM (R 338/ 2006-2) in relation to the mark SPORTSBETTING .COM, the Board had this to say in paragraph 11:

“11. The mark consists of a second-level Internet domain SPORTSBETTING joined to a top-level domain .COM, the latter being assigned to commercial users (see *Webster's New Word Dictionary of Computer terms*). A domain name is the address of an Internet site and, as such, is used to access the website so identified. Generic top level domains will be perceived by the average Internet user as an Internet address and not as a trade mark. In this instance the mark merely tells the interested customer that *inter alia* online ‘gaming’, ‘sports’ and ‘betting’ services are found at the site SPORTSBETTING.COM, because the words ‘sports’ and ‘betting’ are nothing more than descriptive of the applicant's services. The interested public, on seeing the mark, will assume — correctly — that the website in question offers opportunities for winning money through gambling on sporting events. It is entirely lacking in any arbitrary or fanciful characteristics. The mark was rightly rejected under Art 7(1)(b) and (c) CTMR.”

19. In my view the same rationale applies here. The mark “MuslimHeritage.com” is a) a domain name which is the address of an Internet site and b) provides information about Muslim heritage. Generic top level domains will be perceived by the average Internet user as an Internet address and not as a trade mark. The mark is therefore devoid of distinctive character for the services claimed.

20. The exhibition which was organised under the banner “1001 Inventions: Discover the Muslim Heritage of our World”, does not in my opinion assist this case. Firstly the subject matter “1001 inventions: Discover the Muslim Heritage of our World”, appears to be different to the present application. The trade mark applied for is a domain name for a website on Muslim Heritage. The exhibition was very specific in its content “1001 inventions” then “Discover the Muslim Heritage of our world”. Also one exhibition in which this mark may have been advertised, is not enough evidence to prove that the mark has become distinctive through use.

21. For all the reasons given above I am not persuaded that the mark “MuslimHeritage.com” is distinctive. It would not serve in trade to distinguish the applicant’s services from those of other traders. The mark would merely indicate to the average consumer that the services claimed, plus the subject matter, as described by the mark itself, are provided via the Internet.

## **CONCLUSION**

**22. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from *prima facie* acceptance under 3(1)(b) of the Act.**

23. 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, it is refused under the terms of Section 37(4) of the Act because the mark fails to qualify under Section 3(1)(b) of the Act.

Dated this 8th January 2007

**GAIL ASHWORTH**  
**For the Registrar**  
**the Comptroller-General**