

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION Nos 1545222, 1545225,
1545226 AND 1545229 BY WER LIEFERT WAS? GMBH
TO REGISTER MARKS IN CLASSES 9 AND 41**

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER Nos 43116/7 AND UNDER Nos 42856/7
BY REED TELEPUBLISHING LTD**

TRADE MARKS ACT 1994

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by Reed Telepublishing Ltd

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DECISION

20 Wer Liefert was? GmbH (hereafter “WLw”) applied on 18 August 1993 under the Trade
Marks Act 1938 to register the following marks in Classes 9 and 41.

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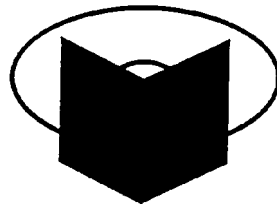
CD-BOOK

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No	Class	Specification
1545222	9	Data carriers in the form of compact discs; all bearing directory information
1545225	41	Publication and distribution of books and recorded data carriers; all relating to directories and suppliers

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CD-BOOK

	No	Class	Specification
15	1545226	9	Data carriers included in Class 9
	1545229	41	Publication and distribution of books and recorded data carriers; all included in Class 41

20 Following the introduction of the new 1994 Trade Marks Act the applicants decided to take advantage of the Transitional Provisions and transfer their applications for consideration under the new Act. The applications are now therefore all dated 30 October 1994.

25 Following examination the applications were published in the Trade Marks Journal for opposition purposes. The applications are opposed by Reed Telepublishing Ltd (hereafter "RTL"), who filed notice of opposition on 14 September 1995. I summarise the grounds of opposition as follows:

- 30 1. The opponents claim that the marks are devoid of any distinctive character and that registration is therefore contrary to Section 3(1)(b) of the Act.
- 35 2. The opponents claim that the marks consist exclusively of signs or indications which may serve in trade to designate kind, intended purpose or other characteristics of the services specified and that registration would therefore be contrary to Section 3(1)(c) of the Act.
- 40 3. The opponents contend that the marks 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, and that registration would therefore be contrary to Section 3(1)(d) of the Act.
- 45 4. The opponents object to registration of the applications on the basis of Section 3(3)(b) of the Act.
5. The opponents object to registration of the applications on the basis of Section 3(6) of the Act.

The applicants filed a counterstatement denying each and every ground of opposition.

Both parties ask for an award of costs in their favour.

5 Both sides filed evidence in these proceedings and the matter came to be heard on 11 February 1998 when the applicants were represented by Mr R Prentice of Messrs R R Prentice & Co and the opponents were represented by Mr A Bernard of Messrs F J Cleveland & Co.

10 As indicated in the headnote these four oppositions have been consolidated into two groups of two. However, the evidence filed in the proceedings is essentially the same and the same submissions were made to me at the hearing. I have therefore decided to issue only one decision.

15 Opponents' Evidence

This comprises a Statutory Declaration by Richard Price dated 26 April 1996, and supporting declarations by Lee Martin Curtis, Lennart Scharff, James Wetenhall and David Worlock. Mr Price is a product manager for Reed Information Services, which he states to be a division
20 of Reed Telepublishing Ltd. He is responsible for the KOMPASS range of directories, a position he has held since April 1994. Mr Price says that Reed Information Services have provided CD-ROM versions of directories since 1989, and that the KOMPASS directories were launched in this format in October 1994 under the title KOMPASS CD-BOOK. He exhibits samples of packaging of CD-ROMs published by Reed IS under the names
25 KOMPASS CD-BOOK and KELLY's CD-BOOK. He goes on to state that the manner in which the data is presented in these products is arranged so as to resemble hard copy equivalents, and that this led to the choice of the description CD-BOOK: it is a book recorded on a CD so that the user can use it like a book. Finally, he believes that both the pictorial elements in the mark, and the phrase "Wer Liefert Was?" being German for "who supplies
30 what" are simply descriptive references to the product, and cannot therefore serve to distinguish one company's directories on Cds from those of another.

Mr Curtis is employed as a Trade Mark Assistant at F J Cleveland & Company, the opponents' agents. His evidence consists of an account of various visits to stores in London
35 selling musical recordings and books. He refers to and exhibits a number of CD catalogues and guides, which show that the device of a CD is used in relation to such products.

Mr Scharff is a citizen of Luxembourg and Executive Director of the European Information Industry Association (EIIA), a position he has held since 1990. He says that the EIIA has two
40 kinds of members: the national associations for the information industry, and individual company members. Reed is mentioned as being one of the information companies which has individual membership. Mr Scharff declares that from his knowledge of the industry he can confidently state that CD-BOOK would be regarded as a generic term by members of EIIA.

45 Mr Wetenhall's Declaration confirms that the words "Wer Liefert Was?" are in the German language and mean "Who delivers what", or "Who supplies what".

Finally, Mr Worlock's Declaration states that he is a director of Information and Communication Industry Association Ltd, and chairman of Electronic Publishing Services Ltd. ICIA is an association of companies representing the electronic publishing sector, of whom Reed IS is a member. EPS is an electronic publishing consultancy firm. He regards the term CD-BOOK as generic, and believes it would be wrong for any one company to have a monopoly in the words for any products and services in the publishing fields. He states that he knows of companies that are using the term, and would expect others to do so in the future. The pictorial elements convey to him a book on a disc using CD-ROM technology.

Applicants' Evidence

This comprises a Statutory Declaration by Peter Schulze, dated 5 November 1996, and a supporting declaration by Raymond Roy Prentice. Mr Schulze states that he has been employed by Wer liefert was? GmbH since January 1978, during which time he has been involved in the sale and advertising of the various directories produced by the company. He was appointed manager of the company in March 1994. He says that the trade marks in suit was adopted by his company in 1993. Both the device mark and the letters and word CD BOOK (solus) have since been registered in the Republic of Ireland.

Mr Schulze also refers to various circulars and leaflets sent out to Chambers of Commerce, Universities and Associations in the UK advertising his company's products. He states that the opponents' evidence shows that their use of the term CD-BOOK began only in October 1994, that the opponents were aware of his firm's use of the trade mark CD-BOOK, that they have set out to plagiarise his company's mark, and that their evidence does not support the contention that other companies use the term in a descriptive sense. He maintains that the ovals and chevron device are distinctive, and that no other company would need to use the device in relation to CD-ROM products.

Mr R Prentice's Declaration states that he is a Trade Mark Agent, and has acted for the applicants since 1989. His evidence consists largely of a critique of Mr Price's Declaration, in which he states that none of the catalogues or guides referred to by Mr Curtis has any reference to the term CD-BOOK, and that similarly none of the directories referred to by Mr Worlock use the term CD-BOOK in their reference or publicity material. He makes various statements about the views of Hearing Officers in the Trade Mark Registry which I am not able to take into account.

Opponents' Evidence in Reply

This consists of a further Statutory Declaration from Mr Richard Price, dated 7 February 1997. Mr Price criticises the contents of the declarations of Mr Schulze and Mr Prentice and says they contain a number of unsubstantiated assertions. In particular however, he defends his company against the charges made by Mr Schulze and says that any use by his company of the term CD BOOK has been normal descriptive use. He says CD BOOK is self evidently a generic term.

In relation to the applicants marks as applied for Mr Price says that the devices of a compact disc and open book are obvious symbols and relevant to the product. However, it is the prominence of the letters and word CD BOOK in the marks which give most concern since people will be deceived into thinking that CD BOOK is a protected title, particularly when the applicants use the registered symbol ® close by.

That completes my review of the evidence and I now turn to the grounds of opposition.

I will deal firstly with the grounds based on Section 3(1)(b)(c) and (d) of the Act which 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) 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.”

Before going on to consider the distinctiveness of the marks before me I record the fact that I had two very long and detailed submissions from Mr Bernard and Mr Prentice who represented their clients before me. The evidence filed was exhaustively dissected and numerous reported cases were referred to. I bear these submissions in mind in my consideration of the distinctiveness of the marks applied for.

I first of all deal with the mark as applied for under Nos 1545222 and 1545225.

The mark at issue is a composite one and I must in the final analysis consider, in its totality, whether it is devoid of distinctive character. However it is inevitable that appreciation of the mark as a whole depends on an understanding of the significance of the parts. The mark includes two sets of words “CD-BOOK” and “Wer liefert was?”. Dealing with the first of these elements the opponents say that it is now common in the trade to publish books, directories and the like in a CD-ROM format reflecting the availability of multi-media facilities on computers and the greater ease and convenience that such a format provides. They further say that the accepted abbreviation for CD-ROM is CD and, therefore, that a

book recorded in CD format is most naturally referred to as a CD-BOOK. At the hearing Mr Prentice, for the applicants, conceded that this was the case and that his clients could not claim a monopoly in these words in the United Kingdom at this time. I think that is self-evidently right on the basis of the evidence filed. Indeed the applicants' own evidence relating to their directories makes the position abundantly clear as can be seen from the following extract from Exhibit PS4 to Mr Schulze's declaration:

"The CD-BOOK version -- "the paperless book" -- is a modern answer to the continuous expansion of this reference work. Whereas the classic edition in bound book form now encompasses eight volumes, all the data from these books has been stored on a CD-ROM weighing just 15 grams. The desired information can be called onto the screen in form of a book-like page and the data contained can be processed electronically."

I conclude that the words CD-BOOK are an apt description of the goods and related services even if the applicants were amongst the first to introduce the term to the public (see the OVEN CHIPS case 1981 RPC 69).

The second word element in the mark is "Wer liefert was?" appearing in the silhouetted book device. The (German) words are said to translate into English as "Who supplies what?". The applicants are in the business of publishing directories. The words in question, albeit in German, have an obvious significance in indicating the nature and purpose of the directories. The applicants' evidence puts it as follows:

"Even more countries are covered by this extensive reference work. With listings for Germany, Austria, Switzerland and -- for the first time -- the Netherlands, Belgium and Luxembourg, "Wer liefert was?" provides information on manufacturers and service firms in a total of six countries."

It is clear that the goods and services at issue relate to reference works which act as a guide to suppliers of particular products or services. I note from Exhibit PS5 that the applicants' mailing list is predominantly aimed at Chambers of Commerce and Trade Associations who would no doubt use the directories as a source of information for their members. In this context the words "Who supplies what?" would have no significance other than to designate the intended purpose of the goods and services. It is of no assistance to the applicants that the words are in German because German is a major European language known to many people in this country. It would also help to reinforce the international dimension to the directory (see the above extract). I therefore find that the words CD-BOOK and Wer liefert was? designate the format and purpose respectively of the goods and services to be supplied under the mark.

The third element of the mark is a device. Conflicting views exist as to its significance in trade mark terms. The applicants refer to it in their evidence as "the ovals and chevron device" and say that no other company would need to use the device in relation CD-ROM products unless they wanted to copy their mark. The device must of course be considered in the context in which it is to be used, that is to say on data carriers and the publication and

distribution of books and recorded data carriers. In this respect I do not think that the device would be seen as other than a line drawing of a CD and a silhouette of a book. Unless it has acquired a distinctive character through use within the meaning of the proviso to Section 3(1) (and no such claim is made), a device of this kind is only likely to escape the prohibitions of the Section if there is sufficient stylisation to give it a distinctive character of its own or if there is something novel about the presentation of otherwise non-distinctive elements. In my view the applicants face some difficulty in making such a case for the device at issue. The opponents have provided evidence to show that it is common in the trade to include, for instance, representations of CDs on the packaging of goods or publications relating to such goods. The presentation here is of a silhouetted book overlapping and partly obscuring the outline shape beneath. I do not say that such a device is incapable of acquiring a distinctive character but I take the view that the public would need to be educated into seeing the mark in this way.

Whilst it has been necessary to consider the elements of the mark I must return to the question of the overall character of the mark. The question to be addressed is whether, notwithstanding my views on the elements that go to make up the mark, the totality is devoid of distinctive character. It was well established under the 1938 Act that individually non-distinctive elements could nevertheless be combined and arranged so as to create a mark that was adapted to distinguish (see the DIAMOND T trade mark case 1921 RPC 373). I have come to the conclusion in this case, however, that the conjoining of non-distinctive elements does not give the mark as a whole a distinctive character. It is, I think, somewhat naive of the applicants to suggest that the device will merely be seen as ovals and a chevron when the words CD-BOOK appear below in bold lettering. Rather this is a case where the device reinforces the very clear message contained in the words. Within the overall context of the mark the words Wer liefert was? merely serve to indicate the content and purpose of the underlying goods and services. In short it does not assist the mark in its totality simply to bring within it a combination of words and a device which refer directly to the character and format of the goods and services. I, therefore, find that the applications fall foul of the requirements of Section 3(1)(b)(c) and (d) of the Act.

In reaching this decision I do not say that this mark as a whole could not achieve registration in due course. In view, however, of the prominence of the descriptive term CD BOOK in the mark and the non-distinctive nature of the other elements, it appears to me that it would require some years of extensive user to show that it has the capacity to distinguish the applicants goods and services from those of others, without infringing upon the legitimate rights of other traders.

What I have said above in relation 1545222 and 1545225 also applies to 1545226 and 1545229. In this latter case however the absence of the German words Wer Liefert Was? highlights the book device appearing in the mark but this does not in my view add in any way to the distinctiveness of the mark as a whole. I take the view, therefore, that these two marks also fall foul of the requirements of Sections 3(1)(b)(c) and (d) of the Act.

I should also mention that the applicants have registrations of their device marks and also for the term CD BOOKS in Germany and Ireland. I have no knowledge as to the reason for such acceptances and have taken no account of them in reaching my decision above.

5 The opponents also raised a ground of opposition under Section 3(3)(b) of the Act. I need not go into detail in respect of this ground since Mr Prentice confirmed at the hearing that his clients would be prepared to restrict their specifications, where appropriate, to avoid objection under this head. Therefore, if these applications were to eventually to proceed, the applicants should file a Form TM21 to restrict their specifications as appropriate.

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Finally there is a ground of opposition under Section 3(6) of the Act. This ground relates to bad faith and was answered by Mr Prentice at the hearings. He confirmed that his clients have the necessary business facilities to have the intention to trade in goods and provide the services envisaged in the specifications of these applications. I say no more about this

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One final matter. Subsequent to the hearing the applicants requested permission to withdraw the four applications, the subject of these proceedings, the applicants were asked for their comments and said that in any short decision which the Registrar might issue, they asked that the applicants concession as regards the term CD BOOK be recorded. Having carefully

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considered the matter and particularly as the proceedings had passed the hearing stage, I have decided to issue here, what is in effect, a full decision.

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In conclusion therefore application Nos 1545222, 1545225, 1545226 and 1545229 stand refused.

As the opponents have been successful in these proceedings they are entitled to a contribution to their costs. I hereby order the opponents to pay to the applicants the sum of **£2,000**.

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Dated this 29th day of April 1998

N A HARKNESS

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**Assistant Registrar of Trade Marks
for the Registrar
the Comptroller-General**