

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2216478
BY RANSOMES JACOBSEN LIMITED TO REGISTER A
TRADE MARK IN CLASSES 7 AND 12**

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DECISION AND GROUNDS OF DECISION

On 7 December 1999, Ransomes Jacobsen Limited of Ransomes Way, Ipswich, IP3 9QG, applied under the Trade Marks Act 1994 to register the trade mark PATHWAY in respect of the following goods:

Class 7 - Industrial, municipal, and commercial cleaning machines; on and off road cleaning and sweeping machines; indoor and outdoor cleaning and sweeping machines; self-propelled ride-on and hand operated cleaning and sweeping machines; machines and apparatus for the collection of litter and refuse; parts and fitting for all the aforesaid goods.

Class 12 - Vehicles for cleaning and sweeping and for the collection of litter and of refuse; parts and fittings for all the aforesaid goods.

Objection was taken under paragraphs (b) and (c) of Section 3(1) of the Act on the grounds that the mark is a sign that other traders may legitimately wish to use on, eg, goods designed for use on pathways.

At a hearing at which the applicants were represented by Ms R Bercow of Trade Mark Owners Association Limited, their trade mark agents, the objections under Sections 3(1)(b) and (c) were maintained. Following refusal of the application under Section 37(4) of the Act 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 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:

“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, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services”.

The mark consists of the English Dictionary word PATHWAY. Collins English Dictionary (Millennium Edition) defines PATHWAY as meaning another word for “path”. The same dictionary defines “path” as meaning "1. a road or way, esp. a narrow trodden track. 2. a surfaced walk, as through a garden".

At the hearing Ms Bercow made the following submissions:

- the word PATHWAY no more than alludes to the goods claimed. A pathway is more a dirt track that runs through a field rather than a purpose built walk way.
- paths in public places would not be of a sufficiently hard material to enable machinery or motorised vehicles to clean them.
- there are various different ways to refer to a pathway, such as “path” or “pavement”.
- the Registry Work Manual Chapter 6 at Paragraph 4.8.4 gives the impression on objections concerning “intended purpose” that PATHWAY should be acceptable in this case. This is because in the example given, KETTLE CLEAN, it states that such words would not be registerable for preparations for cleaning kettles. The agent claims that this must mean therefore that the word KETTLE alone must be registerable for such products because it doesn't state the intended purpose which is to actually clean the kettle. By analogy, PATHWAY must be considered a registerable term for the goods claimed in this application.
- the applicant is building up a family of “WAY” marks for their various machines (eg FAIRWAY and HIGHWAY) and so the public will recognise the mark applied as another trade mark of this applicant.

I rejected all of these submissions made at the hearing and maintained the Section 3(1)(b) and (c) objections. The word PATHWAY, in my view, is a direct descriptor for any piece of machinery or motorised vehicle intended, in the sense of "particularly suited", for use on pathways. I believe that the general public will perceive the word PATHWAY as meaning a purpose built pathway running either at the side of a road or through a park or other purpose built area. I do not accept the agents submissions that pathways would not be durable enough to withstand machinery or motorised vehicles being used on them for cleaning or sweeping purposes.

I went on to reject the submission that the Work Manual Chapter 6 can be interpreted as meaning that a noun alone cannot be regarded as “intended purpose” under the meaning of Section 3(1)(c). The Work Manual, Chapter 6 gives the example of KETTLE CLEAN as follows:

Paragraph 4.8.4 “Intended Purpose”

"Words which refer directly to the use to which the goods are put, or which describe the consequences of providing the service are not acceptable. Examples are: KETTLE

CLEAN for preparation for cleaning kettles"

This wording does not state that KETTLE would be registerable solus, nor does it, in my view, give any such impression. The word PATHWAY in this case will clearly signify to the general public that the piece of machinery or motorised vehicle concerned is designed for use on a pathway as opposed to any other purpose built areas such as a highway or a fairway. Other traders could easily wish to use the term to describe their products in the course of trade. The mark therefore in my view clearly signifies the intended purpose of the goods ie designed for use on pathways.

I also rejected the agents submission that because the applicant has adopted a number of trade marks incorporating the word WAY for their range of products, the term PATHWAY will be seen as yet another trade mark of the applicants. I have no reason to believe that this will be the case, especially as all such words would appear pure descriptors for the goods concerned. The agent has not advanced details of any prior use of marks containing the word WAY.

The agents submissions, in total, do not persuade me that the application is acceptable within the meaning of Section 3(1)(c) because I consider that it is a sign that designates the intended purpose of the goods. Consequently, it follows that the application is also debarred from acceptance within the meaning of Section 3(1)(b), because it is devoid of any distinctive character.

I bear in mind the comments of Mr Geoffrey Hobbs QC in the AD 2000 Trade Mark Case [1997] RPC 168 at page 176, lines 9 to 23 where he said:

“Although Section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse registration of signs which are excluded from registration by the provisions of Section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacob Esquire QC in his decision on behalf of the Secretary of State in *Colorcoat Trade Mark* [1990] RPC 511 at 517 in the following terms:

“That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see eg *Yorkshire Copper Work Ltd's Trade Mark Application* [1954] RPC 150 at 154 lines 20-25 per Viscount Simonds LC. Essentially the reason is that the privilege of a monopoly should not be conferred where it might require “honest men to look for a defence”.”

I have also considered the comments of Mr Justice Jacob in the TREAT judgement [1996] RPC 281, where he said:

"Next is "TREAT" within Section 3(1)(b). What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sought of word (or sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or word inappropriate for the goods

concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “TREAT” is, absent use and recognition as a trade mark, in itself, (I hesitate to borrow a word from the old Act *inherently* but the idea is much the same) devoid of any distinctive character”.

In this decision I have considered all the documents filed by the applicant and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under paragraphs (b) and (c) of Section 3(1) of the Act.

Dated this 13TH day of June 2001

**Janet Folwell
for the Registrar
the Comptroller General**