

TRADE MARKS ACT 1994

**IN THE MATTER OF Application N^o: 2143625
by Sport 2000 International AG to register a Trade Mark and**

**IN THE MATTER OF Opposition N^o: 49037
by Venator Group Retail, Inc.**

1. Sport 2000 International AG EY 5 CH-3063 Ittigen Switzerland applied on 2nd September 1997 for the following mark:



in respect of the following goods:

‘Cycles, bicycles, and parts and fittings for all the aforesaid goods, all included in Class 12’.

‘Hunting fire arms, hunting rifles, and parts and fittings for all the aforesaid goods, all included in Class 13’.

‘Luggage, bags, rucksacks, and parts and fittings for all the aforesaid goods, all included in Class 18’.

‘Tents, tarpaulins, awnings, parts and fittings for all the aforesaid goods, all included in Class 22’.

‘Clothing, including boots and shoes, and parts and fittings for all the aforesaid goods, all included in Class 25’.

‘Fishing rods, fishing spools, fishing drums, fishing tackle, gymnastic and sporting articles and parts and fittings for all the aforesaid goods, all included in Class 28’.

2. The mark is opposed by Venator Group Retail Incorporated, under ss. 3(1)(a), (b), (c) and (d) of the Act. The Applicants deny the grounds and both parties asked for costs. The matter came to be heard on 14th June 2001, with Ms Cole of Urquhart Dykes & Lord representing the applicants and Mr Porteous of Grant Spencer Caisley & Porteous representing the opponents.
3. The opponents’ case is explained in their first Statutory Declaration, by Mr Porteous. In his view, the mark consists of three non-distinctive elements, which form a non-distinctive whole. This is because the word ‘Colorado’, which is the main feature of the mark, is entirely descriptive of any goods which may be made, sold or used in or otherwise emanate from the State of Colorado. In fact, at the hearing, Mr Porteous argued that the mark was, effectively, a ‘Colorado’ mark, the other elements, not adding anything to detract from this. For example, Exhibit AP-6 contains a copy of a letter from Applicants’ agents in support of the application at the examination, dated 19th February 1998. This refers to the device element in the mark. Mr

Porteous says this is an unsophisticated and obvious depiction of a mountain and is therefore descriptive both of Colorado and the word HIGH, and of HIGH COLORADO - mountains being more or less synonymous with COLORADO. He states:

‘In my experience, such a simple depiction of a mountain will not serve to add distinctiveness to the mark, as the Applicant claims and will not be seen as an indirect reference to the goods specified in the opposed application. The use of the mark for the goods specified is clearly intended to evoke in the mind of the customer a direct a clear reference to the mountains of Colorado and sporting activities undertaken there.’

4. On the descriptive nature of the mark, Mr Porteous makes the following points:

C Colorado is a state of America which is well-known for being on the rocky mountain range. Its average altitude is 6,800 feet, the highest in the United States. Exhibit AP-2 contains descriptions of the State of Colorado taken from Merriam Webster’s Geographical Dictionary (3rd Edition) and The Columbia Lippincott Gazetteer of The World First Edition dated 1968. Mr Porteous states that ‘Colorado is a “high” state and the words HIGH COLORADO are no more than a description of the place’.

C Because of its altitude and associated scenery and countryside, Colorado is particularly well-known as a place for outdoor pursuits, such as walking, horse riding, trekking, biking, hunting, shooting, skiing and fishing, the practitioners of all of which are clearly intended to be the applicants’ potential customers - the goods specified are all intended to be used in outdoor pursuits of these types. Exhibit AP-3 contains a selection of Web pages relating to Colorado, and the activities pursued there. Exhibit AP-4 and Exhibit AP-5 respectively contain copies of the current Colorado vacation guide as issued by the Travel and Tourism Authority of the State of Colorado and a guide to skiing in the State of Colorado.

5. Finally, in support of the view that ‘Colorado’ cannot distinguish, Mr Porteous pointed out that under the Trade Marks Act 1938, when the Registry had the power to require disclaimers, it was standard practice for ‘Colorado’ to be disclaimed in any registration including this word. Exhibit AP-1 contains three examples of this. One is trade mark registration N^o 1533168: COLORADO ROCKIES.

6. In response, the applicants enclose one Statutory Declaration from Anthony Neil Pawlyn, a trademark attorney from Urquhart-Dykes & Lord, their agents. In Mr Pawlyn’s view, the mark applied for comprises four elements which together form a distinctive whole and this is the way consumers would view it - they would not engage in a dissection and element by element analysis. In defence of this view, Mr Pawlyn referred to the registered marks in the opponents’ Exhibit AP1, which contains elements, if considered individually, could be argued to be descriptive, e.g. COLORADO ROCKIES, the Rockies being a well known mountain range part of which runs through Colorado. Mr Pawlyn also refers to other registered marks which feature states of the USA. He states:

‘As far as the particular case of the opposed trademark application is concerned, when considered as a whole the trademark is not descriptive. The combination is neither a realistic description of the kind, intended purpose or origin of the goods. The trade mark suggests the “outdoors life” in a general sense, but is not descriptive in the particular sense

argued for by the opponent, nor in any other sense. If it were it would be unsuitable for use on the wide range of goods it is applied to as it would suggest a limited applicability and hence limited market for the goods. The goods for which protection is sought are intended for a wide range of purposes and are of wide ranging kinds as a result. The goods can be used on roads, in forests, at shooting ranges, for all sorts of travelling, in and on rivers, in flat lands, at sea level and for a large number of other purposes. A customer would not see the trademark as indicating the goods were for use on “a high jagged mountain in Colorado USA”.

7. Mr Pawlyn also refers to evidence which he states demonstrates the mark acting as an indicator of origin (Exhibit ANP4). This is an extract from an American website, which shows use of the mark on walking boots and shorts, e.g. ‘Colorado Men’s TKO Hiker’.

Decision

8. S. 3 of the Act states, *inter alia*:

(1) The following shall not be registered -

(a) signs which do not satisfy the requirements of section 1(1),

(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..’

I have left out the proviso to this section, as evidence of use of the mark in suite was not submitted and thus is not a factor in this decision. The sign stands or falls on its inherent capacity to perform as a trade mark, when considered against the criteria in s. 3(1).

9. Taking s. 3(1)(a) first, it is now generally accepted that the test under this section establishes a threshold that is rather low; Ms Cole directed me to the *AD 2000 Trade Mark* [1997] RPC 5 168 case:

‘..the requirements of section 1(1) are satisfied even in cases where a sign represented graphically is only “capable” to the limited extent of being “not incapable” of distinguishing goods or services of one undertaking from those of other undertakings. Such signs are not excluded from registration by section 3(1)(a). Section 3(1)(a) has the more limited effect envisaged by article 3(1)(a) of the Directive of preventing the registration of “signs which cannot constitute a trade marks” at the time when they are put forward for registration.’

10. I do not believe this the mark in suite is so hopeless as to fail here. It is the opponents’ first ground that does that.
11. The Appointed Person in AD2000, however, went on to say: ‘It is clear that signs which are not objectionable under section 3(1)(a) may nevertheless be objectionable under other provisions of

section 3 including sections 3(1)(b), 3(1)(c) and 3(1)(d)'. These are the opponents next grounds.

12. Of course, just as there are applications which require evidence to clear these hurdles, so may oppositions that raise them. In the former case the evidence saves the mark, in the latter it damns it. Some applications (or oppositions) impel more evidence than others. An obvious example is under s. 3(1)(d) where a sign is alleged to be part of the technical language of a particular trade, and material is required to conform this. Of course, no one was arguing that 'Colorado' was a technical word, but the opponents' case stands or falls on the average consumer perceiving the mark as to be so descriptive (ss. (1)(c) and (d)) or otherwise undistinctive (s. (1)(b)) to fail, without use, to stand up as a mark of trade. And I need evidence to be able to assess that. I summarised this above, listened to submissions at the hearing, and I have two comments to make.
13. First, my view of the material provided by the opponents is that it describes the reactions that 'Colorado' might enlist from consumers in the USA, but is silent in relation to the likely reaction of those in the UK. Taking Exhibits AP-3, AP-4 and AP-5 as examples, the references to hunting in the website material suggests it is directed to the US market, and the brochures are all clearly so. At best, they can only reflect the images and impressions the State may have for US citizens.
14. Next, concerning the dictionary references supplied by the opponents, it seems to me that such sources of reference are hardly reliable determinants of the state of knowledge of the average consumer in the UK (particularly where American publications are cited). Dictionaries contain both common and uncommon knowledge, and are used as much, if not more, to determine the latter than the former. Of the given 'chief products' of the State 'skiing' may fall into the 'commonly known' category, but less so would be 'other outdoor recreations' and the fact that Colorado contains the Rocky Mountain National Park. Certainly falling into 'not commonly known' category is that Colorado is also noted for the production of 'Wheat, sugar beets, corn, livestock ..' none of which, I surmise, have any particular reputation in the UK.
15. So, what does 'Colorado' signify here? I am none the wiser on the basis of the opponents' material, and I must use my own best judgement. I think I am prepared to take judicial notice of the fact that the reputation Colorado has for skiing has extended to many consumers in the UK, though possibly not all (not everyone skis, not every skier knows about Colorado). This forms a link with mountains, which the applicants' mark picks up on, but is not enough to establish a reputation for 'Colorado' in the UK for the products specified. Ms Cole argued in her skeleton, and at the hearing, that the name could refer to the river of the same name as much as the State. I struggle to accept this as the word 'high' in the mark somewhat precludes the reference, as does the 'mountain' device. Instead, I think I am inclined to the view espoused by Mr Pawlyn, when he states: 'The trade mark suggests the "outdoors life" in a general sense, but is not descriptive in the particular sense argued for by the opponent, nor in any other sense'. 'Colorado' summons images of rugged countryside and outdoor activities - an allusion to the goods at issue which may be applicable to other States in the US - but not enough to be, in Mr Porteous' words 'a direct clear reference to the mountains of Colorado and sporting activities undertaken there'.
16. I think this tends to decide the matter, but I want to deal with each of the grounds in turn which, given this background, I think can be shortly dealt with.

17. In reference to s. 3(1)(c), Ms Cole directed me to *Windsurfing Chiemsee Produktions und Vertriebs GmbH (WSC) v Boots-und Segeizubehbr Waiter Huber and Franz Attenberger* [2000] 2 WLR 205, which was concerned with the equivalent article in Directive 89/104. In particular, this Article (3(1)(c)) is to be interpreted as meaning:

‘..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’.

18. As I have found, it has not been shown that ‘Colorado’ has direct relevance to the goods at issue. And it was further pointed out by Ms Cole that the mark was more than just the name ‘Colorado’. There was other material as well, and the mark should be viewed as a whole. I was referred to the 13th Edition of *Kerly’s, The Law of Trade Marks and Trade Names*, paragraph 7-89:

‘In each of the grounds concerned with distinctiveness, there is a word which sets the standard: section 3(1)(b) - devoid; section 3(1)(c) and 3(2) - exclusively. To avoid these grounds, the mark must possess a minimum degree of distinctive character. An important practical issue arises in the operation of each ground: what is required to surpass the standard? For example, if application is made for a trade mark which contains a descriptive term, what else must the mark contain so that it successfully avoids being *exclusively* a sign or indication included in section 3(1)(c)? One answer is easy enough to state: the mark must contain something else, a surplus or a sufficient capricious addition, some other matter which gives it sufficient distinctive character to justify registration. The quantum of this other matter must depend on the mark, the trade and all relevant circumstances’.

The word ‘exclusively’ refers to the content of the mark at issue: effectively, do the other elements in the mark add up to enough to take the mark beyond, as Mr Porteous argued (paragraph 3), just a ‘Colorado’ mark. In my view there is more to it than this when viewed as a whole. Coupled with the lack of evidence of any direct association between Colorado and the goods specified, the mark, in my view, falls the correct side of the line and this ground also fails.

19. Turning to s. 3(1)(d), there is nothing to suggest the ‘Colorado’ has a trade significance for any of the goods in the applicants’ specification. Evidence in Exhibit ANP4 was used by both parties to either support distinctiveness (paragraph 6 of Mr Pawlyn’s Declaration) and commonality in the trade (submission by Mr Porteous). As this comes from a website clearly directed at the US market, it’s rather irrelevant anyway. The question I have asked myself is anyone in this country calling bicycles, guns, bags, rucksacks, tents, fishing-rods, clothing or footwear ‘Colorados’, or to regard the term as one a number of traders use on these products? I don’t think so. Not on this evidence.
20. Finally, s. 3(1)(b). Based on the foregoing, the mark is not devoid of distinctive character. Considered as a whole, it is likely to be taken as a badge of origin by consumers (see *Duralit’s*

Trade Mark Application [1999] RPC 890, paragraph 28), and (*AD2000*, page 175, line 31) and it is endowed with the capacity to communicate the fact that the goods with which it is being used recurrently are those of one and the same undertaking. As a consequence - though I might have baulked at allowing registration of a mark such as this on skiing equipment - I do not think the reputation of the state extends to the other activities to which the products listed by the applicants are relevant. Taken as a whole the mark is allusive and contains enough arbitrary character to act a trade mark without evidence of use.

21. The applicants have won, but I want to ‘mop-up’ one or two outstanding points, in case this matter is appealed. First, Mr Porteous raised the issue of disclaimers (see paragraph 5). S. 9(1)(d) of the Trade Marks Act 1938 contained a condition that marks should not, according to their ordinary signification, be geographical names. Following the decision in the *York Trade Mark* [1984] RPC 231, the practice of the Registrar under the old Act was strict in respect of applications using such appellations. Chapter 9 of the Trade Marks Registry Work Manual, published in November 1989, states at paragraph 9-85:

‘The registration of major geographical place names as trade marks for goods is barred absolutely - reference the Liverpool, Yorkshire and York decisions - and even in the case of less well known names the Courts and the Registry have been reluctant to encroach upon the freedom of traders (present and future) to use place names for their original purpose i.e. to indicate geographical origin.’

It was also the practice of examiners under the old Act to expect evidence from applicants in respect geographical place names. This approach would certainly have been followed where a large, well known, American State was concerned. It is not surprising that use of ‘Colorado’ would attract disclaimers. As the applicants point out, this does not mean such words cannot now be registered under the new Act (see Trade Marks Registry Work Manual Chapter 6 Examination and Practice section 14.1).

22. Next, the applicants put in evidence referring to a number of marks taken from the Register, which didn’t, in my view, provide them much help. For example, in Mr Pawlyn’s declaration there is (Exhibit ANP3) CALIFORNIA LIFESTYLE for footwear and (from the opponents’ Exhibit AP1) COLORADO ROCKIES for various goods in Class 25. He says: ‘These illustrate some of the large number of registrations accepted in the UK which feature states of the USA which are associated with the Rockies or outdoor lifestyle and which have been accepted despite other arguably descriptive elements being present in them’. As I have been given no information as to the background against which these marks were registered, none of these examples were a factor in my decision. Was there evidence of use? I do not know.
23. Anyhow, the applicants have won and are thus entitled to some help with their costs: I award them £700. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2ND Day of July 2001.

**Dr W J Trott
Principal Hearing Officer
For the Registrar, the Comptroller General**