

**IN THE MATTER OF APPLICATION NUMBER 2162786
IN THE NAME OF WINDMILLER & HILSCHER
TO REGISTER A TRADE MARK IN CLASS 9**

And

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 50023
BY INTERNET SERVICE PROVIDERS ASSOCIATION**

**IN THE MATTER OF application number 2162786
in the name of Windmüller & Hofschier
to register a trade mark in Class 9**

And

**In the matter of opposition thereto under number 50023
by Internet Services Providers Association**

Background

On 11 November 1997, Windmüller & Hofschier filed an application to register the trade mark ISP in Class 9 in respect of the following goods:

Computer programmes and software, all for system control, system monitoring, quality assurance, data logging, data filing and recipe management; but not including any goods utilising instruction set processor.

By a letter dated 7 June 1999, the specification was further limited by the exclusion of goods relating to an internet service provider, the specification as a whole subsequently being:

Computer programmes and software, all for system control, system monitoring, quality assurance, data logging, data filing and recipe management; but not including any goods utilising instruction set processor or any goods relating to an internet service provider.

The opponents refer to the fact that this amendment to the application was not published. That may well be the case, but it still has effect. On 27 July 1999, Internet Services Providers Association filed notice of opposition in which they say that ISP is an internationally recognised acronym for Internet Service(s) Provider(s) referring to firms generally in the business of providing access and hosting services relating to the Internet, and that these businesses consistently and routinely involve the supply and use of computer programs and software, both for use by customers and for ISPs themselves. The grounds of opposition are in summary:

- 1. Under Section 3(1)(a)** Because the mark is incapable of distinguishing goods (or services) of one undertaking from those of other undertakings,

2. **Under Section 3(1)(b)** Because the mark is devoid of any distinctive character,
3. **Under Section 3(1)(c)** Because the mark consists exclusively of a sign which serves in the course of trade to designate the kind, quality or intended purpose, origin or other characteristics of the goods or services,
4. **Under Section 3(1)(d)** because the mark consists of a sign which has become customary in the current language or in the bona fide and established practices of the trade,
5. **Under Section 3(3)(b)** because use of the mark in relation to goods (or services) not being for or relating to Internet Service Providers would be such as to deceive the public, for instance as to the nature, quality or other characteristic of the goods (or services).

The applicants filed a counterstatement in which they deny the grounds on which the opposition is based. Both sides request that an award of costs be made in their favour.

Both sides filed evidence in these proceedings. The matter came to be heard on 25 June 2001, when the applicants were represented by Ms Denise McFarland of Counsel, instructed by J A Kemp & Co, their trade mark attorneys, and the opponents by Mr Malcolm Chapple of Counsel, instructed by Page Hargrave, their trade mark attorneys.

Opponent's evidence

This consists of a Statutory Declaration dated 16 February 2000 from Nicholas Jeffrey Lansman, a Director and Secretary General of the Internet Services Providers Association, also known as ISPA-UK, a company that represents Internet Service providers in the United Kingdom. Mr Lansman says that he has held this position since 1998 and has been actively involved in the Association's formation, development and operations since its inception in 1995. He confirms that the information in his Declaration is from his personal knowledge, from the records of his company or other sources as specifically identified.

Mr Lansman refers to exhibit NJL1, which consists of numerous reference to ISP although much is either undated or dated after the date of application and cannot be taken to be evidence of use at, or prior to the relevant date. Parts of the exhibit of relevance are as follows:

- S a letter dated 7 June 1999 from the applicant's representatives, to the Registrar, in which they accept that ISP may be an acronym for Internet Service Provider, but saying that as it also has other meanings (giving the example of Instructions Set Processor) it does not consist exclusively... They go on to say that the products of the application are not related to the Internet but are computer software intended for use in the control of factory machines used in the printing, packaging and plastics industry, and offer the exclusion of goods relating to an Internet Service Provider,
- S A transcript entitled House of Commons Hansard WRITTEN Answers for 26 Jun 1997 mentioning ISPs,
- S The Gemini Strategic Research Group's Essential Guide to Digital Age Terminology (undated) which has an entry Internet Service Provider (ISP): Organization that provides gateway connection to the Internet. Prominent ISPs include Netcom and PSI,
- S Encyclopedia of Definition and Links (undated) containing references to Internet Service Provider search engine detailing this as a searchable database of over 4,000 ISPs, ISP news stated as a collection of ISP news articles and ISP World shown as ISP Worlds ISP news and information page,
- S Press release from the applicants showing ISP to mean Information System Production, the name for an automatic production data recording and evaluation system for recording production data.

Mr Lansman comments on the above letter forming part of the exhibit, stating that the mark consists exclusively of the letters ISP which is a term that is contrary to the provisions of Section 3. He notes that the possible uses of the goods in the specification is wider than that given by the applicants in the letter forming part of exhibit NJL1. Mr Lansman goes on to reiterate that the business of Internet Service(s) Provider(s) (ISPs) consistently and routinely involves the supply and use of computer programs and software, both for use by customers and for ISPs themselves for operating and monitoring their systems. He makes particular reference to the term recipe management which he says is likely to be relevant to ISPs, and that the term ISP software collectively, descriptively and generically embraces computer programs for such use and functions. Mr Lansman says that any exclusion would not assist because it would lead to deception and confusion, and in any event, would not be visible to customers. He says that investigations have shown many instances of use of ISP, exhibit NJL1 being the tip of the iceberg.

Applicant-s evidence

This consists of a Witness Statement dated 15 August 2000 from Patrick George Armine Ellis-Jones, a partner and registered trade mark attorney of J A Kemp & Co, the applicants-s representatives in these proceedings.

Mr Ellis-Jones says that he understands that the opponent-s principal objection is that the mark ISP is an acronym for the words Internet Service Provider, and descriptive and non-distinctive for goods for use by such a business. He refers to the exclusion stating that this effectively removed such goods.

Mr Ellis-Jones refers to the Declaration by Nicholas Lansman on behalf of the opponents, in which it is alleged that use of the letters ISP in relation to software not for ISP use would be deceptive and confusing, saying that Mr Lansman fails to appreciate the specialised and unusual nature of the goods of interest to the applicants, which are for use in controlling machinery and equipment used in the packaging industry. Mr Ellis-Jones says the applicant-s software would be bought by large companies in the packaging and printing industry, and it is inconceivable that any confusion would arise with software relating to an Internet Service Provider.

Mr Ellis-Jones refers to the applicants having succeeded in registering ISP in Germany, saying that this should, in principle mean that it should also be acceptable in the United Kingdom. A photocopy of the registration certificate is shown as exhibit PGAEJ/1, from which it can be seen to relate to the mark ISP, but the statement of the goods for which it has been accepted is in German, and no translation has been provided. Mr Ellis-Jones goes on to refer to other registrations for the mark ISP, details of which he shows as exhibit PGAEJ/2. The exhibit shows there to be several marks on the trade marks register that consist of or incorporate the letters ISP, one specifically mentioning use in relation to the World Wide Web, others seeming to have no such connection.

Mr Ellis-Jones reiterates that ISP has several meanings, referring in particular to Instruction Set Processor, details of other meanings being given in exhibit PGAEJ3. The exhibit consists of a the results of a search downloaded on 25 February 2000 from an Internet site called **AAcronym Finder@**, which returned 29 hits for ISP, including Internet Service Provider, and 43 other hits for ISP with other matter, including ISPA-UK, the opponent-s association.

Opponent-s evidence in reply

This consists of a second Statutory Declaration, dated 14 November 1999, from Nicholas Jeffrey Lansman. He refers to the Declaration by Mr Ellis-Jones filed on behalf of the applicants, making the following comments:

- S as the application was not advertised with the exclusion the observations made in paragraphs 6 and 7 are still applicable,
- S that the way in which the specification is worded and the manner in which the applicant's trade, confusion will arise and will not be avoided by a disclaimer,
- S registration in Germany is irrelevant, what matters being that ISP is now a generic and universally recognised in the United Kingdom,
- S prior registrations for ISP in the United Kingdom are also irrelevant,
- S there is insufficient information on the other meanings of ISP, some of which are very obscure, to be of any assistance, but in any event, the evidence of its use in relation to Internet Service Provider(s) is overwhelming, exhibit NJL2 (extract from the Acronym Finder database) showing this to be the most common definition.

The exhibit also consists of:

- S examples of the use of ISP in relation to Internet Service Provider without any accompanying explanatory definition. The exhibit consists of extracts from the Internet dating from October/November 2000, well after the relevant date. They contain some references to ISPs operating in 1997 but this cannot be taken to show use of ISP at that time; they could just as easily be a writer using a current term of art that had not been around at the earlier date,
- S details taken on 9 November 2000 from web sites giving details of ISP as meaning either Internet Service Provider or Instruction Set Processor, or sites that refer to ISP services.

Mr Lansman concludes his Declaration saying that the evidence further supports the opponent's contentions and demonstrates the significance of the alternative meanings put forward by the applicants.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

Turning first to the grounds under Section 3(1)(a)(b)(c) and (d). Those sections read as follows:

3.-(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:

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.

There is no evidence of use of the mark by the applicants so I have only the prima facie case to consider.

There is no suggestion that the mark applied for is not represented graphically, so the ground under Section 3(1)(a) (such that it relates to Section 1(1)) must be that it is a sign that is not capable of distinguishing the goods of the applicant. In determining the grounds of opposition I have regard to the case of Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] FSR 332 in which it was said:

A... according to the settled case-law of the court, the essential function of the trade mark is to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all goods bearing it have originated under the control of a single undertaking which is responsible for their quality.®

I begin by looking at how the law stands. In the case of Phillips Electronics NV v Remington Consumer Products Ltd [1999] 23 RPC 908, Aldous LJ considered the scope of Section 3(1) saying:

AThe more a trade mark describes the goods, whether it consists of words or shape, the less likely it will be capable of distinguishing those goods from similar goods of another trader. An example of a trade mark which is capable of distinguishing is WELDMESH, whereas WELDED MESH would not be. The former, despite its primary descriptive meaning, has sufficient capricious alteration to enable it to acquire a secondary meaning, thereby demonstrating that it is capable of distinguishing. The latter has no such alteration. Whatever the extent of use, whether or not it be monopoly use and whether or not there is evidence that the trade and public associate it with one person, it retains its primary meaning, namely mesh that is welded. It does not have any feature which renders it capable of distinguishing one trader's mesh from another trader's mesh.

The requirement under section (Article 3(1)(b)) is that a mark must have a distinctive character to be registrable. Thus it must have a character which enables it to be distinctive of one trader's goods in the sense that it has a meaning denoting the origin of the goods.@

From the letter dated 7 June 1999 (exhibit NJL1) it would appear that the applicants accept ISP to be an abbreviation or acronym for the descriptive term Internet Service Provider, but rely on the fact that the letters also have other meanings. In my view, if a trade mark consists exclusively of a sign that is wholly descriptive, it will, prima facie, be regarded as being devoid of the capacity to distinguish. It does not become distinctive because it has alternative meanings. Many words in the English language have several, and sometimes very different meanings, for example, the word **AfileA** can mean an abrading tool or a folder for containing papers, and in neither case would it be acceptable as a trade mark for the goods it describes.

Whether or not the applicants accept the meaning, the evidence shows widespread use of ISP, both in conjunction with the description Internet Service Provider(s), and also on its own, and clearly establishes that ISP is widely used and is likely to be recognised as such, but that in itself does not necessarily mean that it is incapable of registration. In the *Bach Flower Remedies Limited v Healing Herbs Limited* case (2000) RPC 513, (Court of Appeal) Morrit L.J said:

AThus the terms **ABunsen Burner@** and **Aa Wellington Boot@** are wholly descriptive and cannot, without more, distinguish such burners or boots of one undertaking from those of another.@ The question is whether or not the word **ABACH@** had, by 1979, acquired such a meaning so as to be incapable, without more, of affording the requisite distinction.@A.it is both permissible and necessary in considering the application of paragraph (a) to determine the meaning of the word as used at the time of application for registration.@

So the question is not just whether the sign has the meaning, but whether it did so at the relevant date, in this case, 11 November 1997. The transcript entitled House of Commons Hansard WRITTEN Answers for 26 Jun 1997 discusses use of the Internet and makes mention of ISPs. Although Hansard does not say that ISP is an abbreviation for Internet Service Providers, by virtue of the references to the Internet I consider it reasonable to infer this to be the case. There are also historical references to the formation of Internet Service Providers in 1997 but it is not clear whether the term ISP was in use at that time or whether the writer is using a current term of art that had not been around at the earlier date. Either way, the evidence shows use of ISP close to the relevant date and is sufficiently widespread that it would not be unreasonable to infer that this did not come into use overnight.

Having accepted that at the relevant date ISP was readily known as an abbreviation or acronym for Internet Service Provider, the next question is whether the term is devoid of distinctive character for the goods covered by the application.

The application covers a range of computer software stated as being for system control, system monitoring, quality assurance, data logging, data filing and recipe management, but excluding any such goods utilising instruction set processor or relating to an internet service provider. The exclusion relating to instruction set processor is not an issue and nothing more need be said about it. The opponents say (and I see no reason why it should not be so) that software for system control, system monitoring, quality assurance, data logging, data filing and recipe management are all relevant to or likely to be used by ISPs, and in some cases, by their customers. It therefore seems that the question is whether the exclusion of goods relating to an Internet Service Provider is sufficient to be able to say that the application does not include goods where ISP would be regarded as a sign that consists exclusively of an indication of a characteristic.

I appreciate that ISP is a term used more usually to describe some body that provides access to the Internet, but in my view, it is also descriptive of goods that facilitate access and management of an internet service. The exclusion leaves behind programmes and software of the kind that allows or enables the provision, control, monitoring and management of an Internet site or service, or as the opponents say, Internet Service Provider software. Consequently I consider that even with the exclusion the mark consists of a sign or indication that may serve in the trade to designate the kind or intended purpose of the goods, and contrary to the provisions of Section 3(1)(c), and I believe it follows, Section 3(1)(b).

The registration in Germany does not alter my view; I have no evidence of the basis on which it was considered and found acceptable. Nor do I find the earlier registrations for or incorporating ISP to be persuasive. Some have been registered for goods that have no relevance to the Internet, in the case of others it may well be that at the relevant date ISP had no meaning, but either way, on the bald facts before me they prove little other than at their

respective dates of application the term was not considered open to objection.

Whilst the evidence shows widespread use of ISP in connection with the businesses that provide access to Internet services, I do not consider that it supports the contention that ISP is a term that has become customary in the current language or bona fide and established practices of the trade in relation to software, and I find no substance in the ground under Section 3(1)(d). Nor do I consider it to be a sign that is incapable of registration, and the ground under Section 3(1)(a) is also dismissed.

Turning to the ground under Section 3(3)(b). That section reads as follows:

(3) A trade mark shall not be registered if it is-

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or services).

As I have already mentioned, the term ISP is an abbreviation or acronym for the providers of Internet services, primarily access. Self evidently such businesses will utilise software themselves to enable and manage access to the Internet, and may also sell software related to, or indeed, with little or nothing at all to do with the Internet. Whilst the meaning of the mark applied for may well be apt to collectively describe such goods, it does so in very general terms. Software is a highly technical product, bought with a specific purpose in mind, and in my experience, after a good degree of deliberation. It seems to me that a person considering a purchase of software with the aim of becoming an Internet Service Provider (not an everyday activity) will be very knowledgeable and well informed, and to whom the term ISP (or Internet Service Provider) will be understood for what it is.

Although in my considerations of the grounds under Section 3(1) I dismissed the relevance of its other meanings, including some related to computing/software, I would consider this to be a relevant fact under Section 3(3)(b), for if, as they clearly do, the letters can serve as a description without causing deception, I do not see why they could not do so as a trade mark. I do not consider that the public will be deceived into regarding ISP as a description of a characteristic or function of the goods, and the ground under Section 3(3)(b) is dismissed accordingly.

Although I have found the grounds under Section 3(1)(b) and (c) to have been successful, this is, I believe, because of the general nature of the terms used in the specification. The press release forming part of exhibit NJL1 and the Declaration by Mr Ellis-Jones indicate that the applicants use ISP as an abbreviation for Information System Production, a software system for automatic production data recording and evaluation. It seems to me that the term ISP would not be said to consist of a sign or indication that designates a characteristic of such goods and that a specification limited accordingly would not be open to the same objection, nor fall foul of Section 3(3)(b). In conclusion, therefore, if

the applicants file a Form TM21 within one month from the end of the appeal period to reduce their specification to:

Computer programs, computer software, all for system control, system monitoring, quality assurance, data logging, data filling and recipe management of packaging and printing machines and equipment; but not including any goods utilising instruction set processor.

I will, in the event of no appeal, allow this application to proceed to registration. If the applicants fail to file a TM21 within one month from the end of the appeal period the application will be refused.

The opposition has been successful, although only in part, and the opponents are therefore entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of , 635, this sum 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 12 day of March 2002

**Mike Foley
for the Registrar
The Comptroller General**