

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2216981
BY TELEWEST COMMUNICATIONS PLC
TO REGISTER A SERIES OF TRADE MARKS IN CLASS 38**

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2216981 BY TELEWEST COMMUNICATIONS PLC TO REGISTER A SERIES OF TRADE MARKS IN CLASS 38

DECISION AND GROUNDS OF DECISION

1. On 10 December 1999, Telewest Communications plc of Genesis Business Park, Albert Drive, Woking, Surrey GU21 5RW, applied to register a series of two trade marks as follows:

SURFUNLIMITED

SURF UNLIMITED

in respect of the following specification of services:

Class 38

"Telecommunication services; data communication services; collecting, supplying and transmitting data, information and communications by telephone, computer, tele-printer, electronic mail, laser beam, satellite or by electronic or optical means; electronic communication services; rental, hire, and leasing of communications apparatus and of electronic mailboxes; telex, telegram, facsimile, internet and telephone services; digital transmission services; mobile radio communications; video conferencing and communications services; news agency services; radio and television broadcasting; postal and wire services; telephone services for internet access; message sending and delivery; consultancy services, all relating to telecommunications and data communication services; information and advisory services relating to the foregoing."

2. Objection was taken to the marks under Sections 3(1)(b) and (c) of the Act because they are considered to be signs which may serve in trade to designate a characteristic of the services, e.g. telecommunication services that enable endless/unrestricted access to the Internet. Objection was also taken under Section 5(2) of the Act, but this was later waived in correspondence and no further mention need be made of this matter.

3. Objection was also taken to the terms "postal and wire services" and "internet services" which are considered too vague and require further explanation before classification. In the event that the applicants are successful in any appeal, this matter will need to be remitted back to the Registrar to be resolved.

4. At a hearing at which the applicants were represented by Mr J B Pennant of D Young & Co, their trade mark attorneys, the objections under Sections 3(1)(b) and (c) of the Act were maintained. A period of time was allowed for the applicant to decide whether to pursue an Appeal or to limit the specification to services where the marks may be seen as fanciful. (Also, to address the specification queries referred to above). In due course the applicants requested that the application should be refused so that the decision could be appealed. 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.

5. Sections 3(1)(b) and (c) of the Act read as follows:

"Section 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)

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."

6. No evidence of use has been put before me, therefore the proviso to this Section of the Act does not apply and I have only the prima facie case to consider.

7. The first mark consists of the words SURF and UNLIMITED conjoined. The second mark consists of the same words presented separately. In my view, nothing rests on this. The marks were accepted as a Series under Section 41(2) of the Act in that they "resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark." Therefore, both marks consist essentially of the two words whose dictionary definitions, in the context of the services, are:

Surf:

"4a. To move rapidly and easily through a particular medium: surfing the Internet."

Unlimited:

- 1. Without limits or bounds
 - 2. not restricted, limited or qualified.
- Collins English Dictionary Fourth Edition 1998

8. In my view, the words in combination simply indicate that users of the applicants' service can surf the Internet without limit, i.e. time limit.

9. The agent referred me at the Hearing to the Advocate General's opinion on the BABY-DRY case. This is now a judgement, issued by the European Court of Justice on 20 September 2001, *Procter & Gamble Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case - 383/99P*, which gives guidance on the scope and purpose of Article 7(1)(c) of the community Trade Mark Regulation (equivalent to Section 3(1)(c) of the Trade Marks Act).

10. Paragraphs 37, 39 and 40 of the judgement are reproduced below:

"37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Procter & Gamble and the OHIM acknowledge, to prevent registration as trade marks signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function."

"39. The signs and indications referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics."

"40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark."

11. These paragraphs indicate that only marks which are no different from the usual way of designating the relevant goods or services or their characteristics are now debarred from registration by Section 3(1)(c).

12. The agent argued that the presentation of the words was in an unnatural order if offering "unlimited surfing" on the Internet and therefore qualifies under the BABY-DRY principles. I disagree. On first impression I consider it conveys the same message and is precisely the sort of abbreviated form which could be used as a "strap line" in advertising. (See comments by Mr Simon Thorley QC in the unreported decision on the DAY BY DAY appeal, who in his role as the Appointed Person said - "In my judgement, Mr James correctly submitted that I should have regard not only to natural use on packaging but also to natural use in the context of advertising"). I am also guided by the comments by the same Appointed Person on the appeal regarding WHERE ALL YOUR FAVOURITES COME TOGETHER, British Library No. 0-573-01, where he states:

" "Is it a natural or normal way of referring to the goods?" Is the appropriate way to look at the question before me. "

and

"What I have to consider is, I think, not the question of whether the customer would see it as no more than a promotional statement, but rather whether, in the course of trade, such a use would be a natural or normal way of referring to a quality of the goods."

13. I conclude that the relevant public would see the term SURF UNLIMITED, on first impression, as no more than an advertising statement equivalent to "(You can) surf unlimited" or as a natural

alternative to the phrase "unlimited surfing". Therefore, I consider the marks applied for consist exclusively of signs which may serve in trade to designate the kind or quality of the services and are, therefore, excluded from registration by Section 3(1)(c) of the Act. For the same reasons I consider the marks to be devoid of any distinctive character and therefore not acceptable for registration under Section 3 (1)(b) of the Act.

14. 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 it fails to qualify under Sections 3(1)(b) and (c) of the Act.

Dated this 13 day of March 2002.

R A JONES
For the Registrar
the Comptroller General