O-096-11

In the matter of UK Trade Mark Application No. 2502431 by DAVID MICHAEL THROWER ("the Applicant")

To register the following mark in class 28

"PUTTERSCOPE"

And in the matter of an Appeal to the Appointed Person by The Applicant against the Decision of the Hearing Officer on behalf of the Comptroller General dated 17 May 2010

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D E C I S I O N

1. David Michael Thrower ("the Applicant") has applied to register the following device mark:

in class 28 for the following goods:

Golf practice apparatus, golf putters, golfing apparatus, golf training aids, golf swing alignment apparatus

2. The mark has been refused by the Trade Marks Registry, following a hearing before the hearing officer Ms Jane Hallas, on the grounds that it is devoid of distinctive character and therefore offends against s3(1)(b) of the Trade

Marks Act 1994.

3. This appeal is, like most appeals from hearing officers, a "review" not a "re-hearing". The first question before me is the degree of caution which an appellate tribunal should apply before it is prepared to reverse a decision of a hearing officer on the question of whether a mark is devoid of distinctive character.

4. The leading authority on the role of appellate tribunals on appeals from decisions of mixed fact and law was set out (in the context of an appeal from the Trade Marks Registry) by the Court of Appeal in Reef [2003] RPC 5. Having cited the well-known decisions in Norowzian v Arks [2000] FSR 363, Designers Guild v Russell Williams [2000] 1 WLR 2416, Pro Sieben v Carlton [1999] 1 WLR 605 and Biogen v Medeva [1997] RPC 1, Robert Walker LJ concluded at paragraph 26 that there no single standard of reluctance to interfere. It varied according to (in particular):

(a) the nature of the evaluation required;
(b) the standing and experience of the fact-finding judge or tribunal;
(c) the extent to which the judge or tribunal had to assess oral evidence.

In Reef itself, the evaluation was the question of "likelihood of confusion"

under s5(2)(b). The decision was made by an experienced hearing officer but there was no oral evidence. Robert Walker LJ concluded in the circumstances that the appellate tribunal should *"show a real reluctance, but not the highest degree of reluctance, to interfere in the absence of a distinct and material error of principle."*

5. Factors (b) and (c) will typically be (and are in this case) the same for a decision of a hearing officer under s3(1)(b) as they are for a decision under s5(2)(b). The question is whether factor (a) – the nature of the evaluation – is also equivalent. For the Registry, Dr Trott contended that the question of whether a mark was "devoid of distinctive character" involved the same degree of multi-factorial global assessment as the question of "likelihood of confusion" and therefore that I should exercise the same "real reluctance" in a s3(1)(b) case as Robert Walker LJ held to be appropriate in a s5(2)(b) case. I do not agree. It seems to me that the global assessment required under s5(2)(b) generally involves a consideration of many more variables than are raised by the question of distinctiveness under s3(1)(b). Indeed this must logically be true since the inherent distinctiveness of a trade mark is itself one of the variables which must be considered when assessing the likelihood of confusion [Sabel v Puma [1998] RPC 199 at 22-24].

6. Dr Trott contended that there were a large number of variables underlying the

decision under s3(1)(b) and that the Hearing Officer had listed a number of them in paragraph 14 of her Decision. In fact paragraph 14 is simply a recitation of various principles established by the ECJ as to how the question of distinctive character should be approached. Ultimately, there is one single variable in the present case: the extent to which the elements of the mark are so descriptive of the goods of the specification that the combination of those elements in the mark would not be taken by the average consumer as having any trade mark significance.

7. I therefore do not regard this as a case where it would be necessary to have any serious degree of reluctance to overturn the decision of the hearing officer if I were of the opinion that she had come to the wrong conclusion.

8. The hearing officer approached the question before her in two steps. First of all she asked whether the plain words "Putter Scope" were purely descriptive. Having found that they were, she asked whether the device element of the mark made the mark sufficiently different from the words themselves to give it distinctive character. Although I agree that it necessary for the purpose of explanation to break down the mark into its component parts, one must be aware of the danger that such an iterative approach may be unfair to the applicant. Each individual part of a mark may be non-distinctive, but the sum of the parts may have distinctive character – see Satelliten Fernsehen GmbH

v OHIM [2005] ETMR 20 [SAT 1], at paragraph 28. Ultimately the decision making tribunal must stand back from the detailed breakdown of the mark and envisage how the entire trade mark would be understood by the public when applied to the goods of the specification. Would the average consumer consider that it was a trade mark indicating goods from a particular source or would they consider that it simply indicated the function of the goods?

9. In the present case, the applicant criticizes the decision of the hearing officer on two grounds. First, that she was wrong to find that the words "Putter Scope" amounted to no more than a description of the goods for which the mark was applied. Second, that she was wrong to dismiss the device elements of the mark as having no distinctive character.

10. As for the words, it is common ground that "Putter Scope" is not a term in use in the field of golf equipment (or indeed, I suspect, in any other field). The hearing officer however, rightly noted the decision of the Court of First Instance in Wm Wrigley Jr & Company v OHIM C-191/0P ("DoubleMint") as follows:

"It is not necessary that the signs and indications composing the mark…actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which

the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes."

11. The hearing officer was therefore right to ask herself (as a preliminary question) whether the term "Putter Scope" is one which could be used as a descriptive term for the goods which are the subject of the registration. However, I believe that she was wrong to answer this question in the affirmative.

12. In order for the term "Putter Scope" to be descriptive of goods within the specification for which the mark has been applied, it must in my view be possible to identify a realistic product falling with that specification which could appropriately be described as a "Putter Scope" or otherwise by reference to the phrase "Putter Scope".

13. To consider this question it is first necessary to identify the meaning of the individual words. "Putter" is easy. In the context of the specification, it is a golf club used for putting. Putting involves striking the golf ball along the ground a relatively short distance across a green and towards the hole.

14. "Scope" is a more difficult word. It has a number of meanings in English, most of which are irrelevant. In paragraph 17 of her Decision, the hearing officer cited a particular definition from The Collins English Dictionary: *"SCOPE noun, indicating an instrument for observing, viewing or detecting: microscope, stethoscope."*. One has to be careful about this. In my copy of Collins, the same definition is given but with a hyphen in front of the word "SCOPE" and the words *"combining form"* after the letter *"n"* for "noun". This shows, as I believe to be the case, that the word "SCOPE" is not used on its own to mean an instrument for observing, viewing or detecting. Rather it is a suffix which is found incorporated into certain composite nouns ("microscope", "stethoscope", "telescope", "oscilloscope"). When those words are broken down into their component parts, one can see that the "scope" element in each case indicates an instrument for observing, viewing or detecting (from the Greek "skopein" – to examine) with the prefix indicating the nature of the examination (sometimes from the Greek, sometimes from the Latin). This does not mean that the word "scope" itself is used in English outside the context of these particular composite nouns to carry the meaning cited by the Hearing Officer.

15. More relevantly, the word "scope" <u>is</u> used in English (perhaps as a shortened form of the word "telescope") to mean a telescopic sight incorporating a foreshortening lens. For example a telescopic sight mounted on a rifle is

(particularly in the US) commonly referred to as a "scope". More significantly, in the field of golf, as the hearing officer pointed out, it is known to use a telescopic sight as part of a range finder for assessing the distance to the hole. These are sometimes referred to as "golf scopes" (see the Bushnell Golf Scope RangeFinder and the Adler Focus Golf Scope referred to by the Hearing Officer at paragraph 23 of her decision).

16. However, the question in the present case is not whether the word "putter" and the word "scope" each have some kind of meaning in the field of golf. The question is whether the term "Putter Scope" itself could be used to describe a realistic product which would fall within the ambit of the specification. Such usage would require the existence of a product incorporating a telescopic sight for use in conjunction with a putter.

17. It is hard to imagine that a "scope" in the sense of a telescopic sight would be of any practical benefit in conjunction with a putter which is generally used only for short-range shots. It is therefore not surprising that no such product has been identified. The hearing officer appeared at one point to have identified such a product from her own researches in paragraph 23 of her Decision: *"From my own research, range finders are relatively common tools in the golfing trade; these goods are also referred to as "golf scopes", for example see the annex to this decision from various websites, referring to*

the Seemore Solana Protoputter…". This might be taken as suggesting that the Seemore Solana Protoputter incorporates a telescopic sight or range finder into a putter. However, the website exhibited by the hearing officer provides no support for such a suggestion. Whilst the website refers to "rifle scope technology" this seems in fact be a reference to the precision milling process used in the manufacture of the putter head, not an actual "scope" incorporated into the putter. Dr Trott tended to agree with this assessment.

18. The only other putting product referred to by the hearing officer was one which is apparently the subject of a patent application by the applicant himself. However, this is apparently some kind of alignment tool for use in conjunction with a putter, not a telescopic sight. I do not see that the term "Putter Scope" would be used by an average consumer to describe this product, were it not for the fact that it is the applicant's trade mark.

19. In the circumstances, it seems to me that the term "Putter Scope" is not apt to describe any realistic product within the scope of the specification of goods. It is therefore not itself devoid of distinctive character.

20. As to the device elements of the mark, I would agree with the hearing officer that the underlining of the word and the bold and enlarged letters P and S are of no distinctive significance. However, I disagree with her analysis of the

significance of the extra-large "O" incorporating cross hairs. Of course this is allusive to a telescopic sight. However, the device must be taken as a whole. To incorporate a figurative element like this into one of the letters of the word mark is striking and has some originality. The average consumer would in my view immediately see that the overall device is not a simple description of a putting aid. It has all the character of an original logo and would be taken by the consumer as a brand, not a description.

21. In all the circumstances, I consider that the hearing officer was wrong to refuse to register the mark under s3(1)(b). As explained in Sat 1 at paragraph 41, a mark is not devoid of distinctive character if it *"enables the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings."* The mark in this case performs that function.

22. I therefore reverse the decision of the hearing officer and direct that the Registry permit UK Trade Mark Application No. 2502431to proceed to grant. Unless asked to do so, I do not propose to issue a formal Order to this effect.

IAIN PURVIS QC

THE APPOINTED PERSON

8 MARCH 2011