

O-423-14

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NUMBER 2655156  
BY CANARY WHARF GROUP PLC  
TO REGISTER THE FOLLOWING TRADE MARK  
IN CLASSES 16, 36, 37 AND 39:**

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## **CANARY WHARF**

### **Background**

1. On 6 March 2013, Canary Wharf Group Plc ('CWG' or 'the applicant') applied for registration of the sign 'Canary Wharf' in respect of the following goods and services:

Class 16: Printed matter, printed publications, printed reports and circulars.

Class 36: Real estate affairs; real estate investment; financing services for real estate development; real estate management; real estate appraisal and valuation; real estate leasing; real estate rentals; information, consultancy and advisory services relating to the aforesaid services.

Class 37: Building construction services; construction project management services; on-site building project management; property development and maintenance services; information, consultancy and advisory services relating to the aforesaid services.

Class 39: Car parking services; parking place rentals; information and advisory services relating to the aforesaid services.

Class 42: Building design services; advisory services relating to building design; information, consultancy and advisory services relating to the aforesaid services.

Class 44: Landscape design; information, consultancy and advisory services relating to the aforesaid services.

Class 45: Security services; information, consultancy and advisory services relating to the aforesaid services.

2. The application faced initial objection under sections 3(1)(b) and (c) of the UK Trade Marks Act 1994 ('the Act') on the basis that the words 'Canary Wharf' may serve in trade to designate the geographic origin and geographic focus of the services e.g. any services provided from the Canary Wharf area, or focusing on that area.

3. The objection was supported by a reference taken from 'A Dictionary of London Place Names (2nd edition) A D Mills, Oxford University Press 2010, which states the following:

“The Canary Wharf area can be described as: Tower Hamlets. This grand commercial development with its massive 850-ft tower (the highest building in the country), begun in 1987, takes its name from a modest fruit warehouse! Canary Wharf was the name given to a warehouse built in 1937 for the Canary Islands and Mediterranean fruit trade of a company called ‘Fruit Lines Ltd’. The name of the Spanish island of Canary (i.e. Gran Canaria, this giving its name to the whole group of ‘Canary Islands’) is of course also of interest: it is derived (through French and Spanish) from Latin Canaria Insula, that is ‘isle of dogs’ (apparently with reference to the large dogs once found here), see Isle of Dogs.”

4. The objection was contested by the attorney for the applicant for the reasons given below. These submissions, which were initially used to contest the examination report, have subsequently formed the basis of the applicant’s further evidence and arguments:

- The words ‘Canary Wharf’ form the main element of the names of the group of companies which created and developed, and continue to develop, manage and own the freehold of the estate now known as the Canary Wharf estate<sup>1</sup>, being the applicant, CWG. CWG, or its predecessor (Olympia and York Canary Wharf Group Ltd), built all 35 buildings currently on the estate.
- The estate was formerly a derelict docklands location in and around the Isle of Dogs; parts of the area only exist because the land was reclaimed under the applicant’s management.
- The area that is now the Canary Wharf estate was not known under that name before the activities of CWG and its predecessor, but was merely the name of a single warehouse or docking berth built by Fred Olsen in the late 1930s and demolished in 1986 on what is now the estate. The London Dictionary of Place Names to which the examiner referred confirms that ‘Canary Wharf’ is not, and never has been, the name of the area *now* known as the Canary Wharf estate *prior* to the Canary Wharf group’s adoption of that name for the estate. It was CWG’s activities, marketing and consumer education that brought Canary Wharf to the public’s mind, as a reference to the buildings and estate.
- The choice of name thus reflects the choice of the applicant and is analogous to the choice of a name for a landmark building or other construction such as the Shard, the London Eye, and the Westfield and Bluewater shopping developments.
- Canary Wharf continues to develop today, both on the original estate itself and elsewhere, with its recent acquisition the Wood Wharf Limited Partnership and

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<sup>1</sup> The Canary Wharf estate is described at Para 41 of Mr Garwood’s evidence as currently comprising over 16 million square feet of office, retail and leisure space. There are: 35 completed buildings which are used by over 100,000 workers in a range of industries (predicted by the Centre for Business and Research (CEBR) to double by 2025 from 2006 to 200,000); more than 280 shops, bars, cafes and restaurants across four retail malls; two Dockland Light Railway Stations (over 16 million people pass through the Canary Wharf Station each year); the Canary Wharf Underground Station (over 40 million people pass through the station each year); one pier (with 980 river bus visits per week); six car parks (for over 2,900 cars); and 4.25 miles of roads.

associated companies, and an overriding 250 year lease for the adjacent 16.8 acre Wood Wharf site.

- There is no good reason why any third party should wish to use 'Canary Wharf' to describe its goods and services.

5. These arguments failed to persuade the examiner, who remained of the view that the average consumer would only perceive the expression 'Canary Wharf' as designating an area of London. He supplied various internet hits relating to transport links, the weather, and an article in The Guardian online newspaper of 15 May 2012 which refers to Canary Wharf as the 'second city', and as an 'evil twin' to London's financial district which, according to the Financial Times, has now overtaken its 'ancient' rival. The article then talks of the origins of the area as being part of the 1980's Docklands Development, and of it being an 'enterprise zone', designated for 'unplanned, low tax and low on 'big government' type development', quite apart from the issue of massive investment in communication projects such as The Docklands Light Railway.

6. Following maintenance of the section 3(1) objection, the applicant asked to be heard in the matter.

7. Prior to a hearing, the applicant submitted two Witness Statements. The first is from Mr John Garwood, Group Company Secretary of the applicant, and sought to prove those facts set out above in relation to the origin and history of the adoption of the words 'Canary Wharf' to describe the estate. I do not need to summarise this history in any great detail, but should reiterate that this evidence confirmed how first use of the words 'Canary Wharf' in relation to the estate occurred in the mid '80s as a means of indicating the name of both the estate and the developer. Mr Garwood also set out the current position in relation to the estate and, in particular, its management including, for example, the vetting of tenants, terms imposed on retail tenants, management of the Estate Common Parts and control over the words 'Canary Wharf'.

8. I have no reason to doubt the factual content of this evidence, although, and as detailed below, I did raise a question of fact at the hearing concerning the precise ownership/control of Canary Wharf. This question was prompted by an extract from Wikipedia to which I referred at the hearing.

9. The second witness statement is by Mrs Rita Bensley, who is Chair of the Association of Island Communities (an umbrella group for community organisations on the Isle of Dogs), and who has lived in the area for 74 years. Her evidence is said to support Mr Garwood's historical account, and to confirm that 'Canary Wharf' is used solely to refer to CWG's specific development.

10. The matter, as I have said, came before me at an *ex parte* hearing undertaken via telephone on 17 January 2014. The applicant was represented by Ms Lindsay Lane of Counsel, instructed by Clifford Chance, and a full skeleton argument had been provided prior to the hearing.

## Legal submissions and factual clarification

11. On behalf of the applicant, Ms Lane's position is that:

- (i) The words do not designate a 'geographical location' at all, as opposed to being the name of a *specific development*; and/or
- (ii) There is no 'need to keep free'; the words cannot serve in trade to designate geographic origin of the goods/services applied for since CWG is the only entity entitled to supply those goods/services under the name, by virtue of the fact it owns the development; and/or
- (iii) Before the date of application for registration, 6 March 2013, the name has acquired a distinctive character in respect of the goods/services intended for protection as a result of the use made of it.

12. Thus, Ms Lane's primary position is that the words 'Canary Wharf' are not, in fact, a geographical location at all. Rather, the expression refers to a private building development for which the applicant or its predecessor has been, in fact, solely responsible and continues to be responsible.

13. In legal consequence, Ms Lane says that the well-established case law relating to geographical locations, such as *Windsurfing Chiemsee* [2000] Ch 523, does *not* apply at all.

14. Ms Lane concedes, however, there is no or little authority directly on the point. Instead, she drew my attention in the skeleton argument and at the hearing to what she considers to be supportive analogous cases and practice as follows:

- An OHIM Cancellation case, *Think Promotions Ltd v All England Lawn Tennis Club (Wimbledon) Ltd* [2006] ETMR 36, where the word 'Wimbledon' was held to be validly registered;
- An Australian case, *Mantra IP Pty Ltd v Spagnuolo* [2012] FCA 769 (19 July 2012) ('Q1'), which concerned the name 'Q1', being an iconic high rise building of the same name, and whether that name could be registered as a trade mark for services including real estate and travel. On appeal from the Registrar of Trade Marks, the Federal Court of Australia said the following at paragraphs 59 and 60:

*"...a sign concurrently applied as the name of a privately owned building and to distinguish certain services to be provided from, or in relation to, that building, does not lose its inherent adaptability to distinguish the services concerned. The Full Court appears to have reached that conclusion because the name of a privately owned building cannot be regarded as being the equivalent of a geographical place name such that it is to be considered as part of the "common heritage" over which the public, including a competitor trading in, or near, the building can claim to have a public right to make honest use of that sign in relation to its goods or services. In other words, its use as a trade mark will not, in any way, infringe upon the "common heritage" because its concurrent use as a building name does not bring it within that*

domain. This does not, of course, prevent a trader operating within the building concerned from using the name of the building to indicate the location of its place of business.

*Like the Chifley Tower, "Q1" was a sign devised by Sunland, a private entity, to, among other things, signify or name its private building development. When it chose the sign "Q1", it did not adopt or incorporate a geographical name such as that of an established town, suburb or district, like Surfers Paradise, or the Gold Coast. Nor, for that matter, was it a name chosen following some public process, for example, by the Minister under the Place Names Act 1994 (Qld)."*

- This followed a previous case, *MID Sydney Pty Ltd v Australian Tourism Co Ltd* (1998) 90 FCR 236, which held:

*"There is no public policy against MID restricting those who have come to occupy space within its building as to the way in which they use its name in connection with goods they produce or services they provide."*

15. Ms Lane also notes from this case that the 'Q1' development's incorporation of both a public pathway and a piazza did *not* render it as being a generic geographical location. Other cases were mentioned at the hearing:

- 'New Covent Garden Market'<sup>2</sup> and 'Battersea Power Station'<sup>3</sup>, both of which she said were consistent with the rationale behind the Australian case referred to above.
- Ms Lane also infers from previous acceptances that, in relation to buildings and developments in general, the underlying rationale behind the 'Q1' case is also applied in the UK. Thus, she says, marks such as 'Heathrow', 'the Shard', 'Stanstead', 'Gatwick', 'the British Museum', 'Westfield' and 'Bluewater' have all been accepted for registration. Moreover, in terms of guidance in relation to 'Famous Buildings' as published in the Examination Guide, it is stated that whilst pictorial representations of such buildings may not be accepted for goods which may be 'image carriers' such as publications or photos, they may be accepted for other goods and services. She also notes that 'buildings' and 'developments' are not specifically included in guidance in relation to geographical names. She draws attention to guidance in relation to a 'spring' where, if it can be shown that the applicant is the sole owner of the rights to exploit the spring water and that the name is not so well known as being merely the name of a spring as to be incapable of also designating the trade source of the product, such a name can be registered.

16. I should also record that, at the hearing, Ms Lane addressed materials produced by the examiner in correspondence. In respect of the examiner's reliance upon a weather report, it was submitted that such reports are also produced for other private developments such as Heathrow, and that they cannot, as a result, be decisive. In respect of the other reference

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<sup>2</sup> BL O/026/06

<sup>3</sup> BL O/063/04

materials, it was submitted that both the Guardian report and the Dictionary of London Place Names refer to Canary Wharf as being a 'development'.

17. Following the hearing, I wrote to the applicant asking for clarification on certain legal submissions which I needed to record for the purposes of the hearing report.

18. Firstly, and having regard to the Appointed Person decisions in BL O/386/13 *CARDIFF INTERNATIONAL AIRPORT LTD* and *BELFAST INTERNATIONAL AIRPORT LTD*, at paragraph 18 especially, and also BL O/048/11 *MELFORT VILLAGE*, I asked for a view on whether, for my purposes, the applicant's primary question of an area being identified as a 'geographical location' should be determined by reference to public perception. That is to say, whilst the precise and actual details of legal ownership or control (including support from authoritative maps) may not necessarily be irrelevant to the question of how exactly the location was viewed by the public, the ultimate guide and touchstone had to be how a location was regarded by the *public* at the relevant time of making the application for registration.

19. The applicant makes two points in response. Firstly, it accepts that public perception is relevant, but it is expressly *not* accepted that, when considered in relation to a destination or development, public perception is decisive *where the destination or development is privately owned or controlled by a single entity*. Otherwise, any destination or development, be it a building, department store, shopping mall, private estate, hotel, entertainment venue or airport would be subject to the same objection. The applicant submits that the *CARDIFF AIRPORT* decision supports this position since that mark was allowed to proceed for those services deemed likely to be within the control of the single entity operating the airport. The applicant also notes that the Hearing Officer in *BATTERSEA POWER STATION* confirmed that buildings are not normally part of the public domain, given that they are routinely owned and controlled by individuals and undertakings.

20. The applicant's second point is that it is not sufficient to say, by reference to a single Wikipedia entry (discussed below), that the estate may be perceived at the relevant date as being a 'business district' (terms used in said Wikipedia entry); the mere possibility is insufficient. The correct question to ask is whether the public at large (as opposed to the author of a Wikipedia article) perceives the area as a business district (see *CARDIFF AIRPORT* decision at paragraph 18). I must be certain, in other words, that 'Canary Wharf' is regarded by the public as a business district.

21. The second legal issue I sought clarification on, and again based on the *CARDIFF AIRPORT* decision, was whether (with reference to Ms Lane's point (ii) at paragraph 11 above, and assuming *Windsurfing* is to apply) the 'need to keep free' is not confined to businesses and those providing services within the boundary of the estate. In my opinion, the *CARDIFF AIRPORT* decision provided support for the proposition that the 'need to keep free' could conceivably operate well outside the perimeter fences of the airport itself, and specifically in connection with services that, in some way, could be said to 'service' the destination (the provision of taxi services, for example).

22. The applicant's answer to this point is that the *CARDIFF AIRPORT* decision was based on the fact that a consumer would expect there to be more than one undertaking providing

transport services to and from the airport, and that third parties can therefore use the airport name descriptively in reference to the location. The examples 'car parking for Canary Wharf', 'rental of space for Canary Wharf', and 'building construction for Canary Wharf', do not, says the applicant, describe a characteristic of the services. Car parking is either, (a) on the estate and managed by CWG or, (b) off the estate but nearby. In the latter case it can be so described in accordance with honest practices such as, 'within half a mile of the Canary Wharf Estate'. Likewise, estate agents can market properties as being 'on or near the Canary Wharf Estate', but do not need to call themselves 'Canary Wharf Estate Agents'.

23. In Ms Lane's submission, if the 'need to keep free' is to prevent registration for any goods and services that might be 'for' a building, development or destination, then no geographical term could ever be registered for anything. This was plainly not so in the case of Cardiff Airport, where registration was permitted for many goods and services. Such a conclusion would, in Ms Lane's view, go far beyond the decision in *Windsurfing* and it is not the law. *Windsurfing* requires a current or likely future 'association' between the geographical area and the relevant goods and services and there is no such association in this case.

24. Finally, I had clarified the position that as regards the goods of class 16, the objection under section 3(1)(c) went to the fact that 'Canary Wharf' could designate 'subject matter', as distinct from geographical location. The applicant says this is dependent on an assumption by the relevant consumer that the sign will be recognised as a description of the content or character of such goods or services. The applicant says that if the subject matter will be assumed to have come from a single undertaking it will not then be seen as descriptive, and that since the sign will be generally understood to refer to the Canary Wharf estate (i.e. under private ownership and control), it will be assumed the relevant goods in class 16 will derive from a single undertaking and thus avoid the objection.

### **Factual clarification - ownership and control of Canary Wharf**

25. Subsequent to the hearing, I also asked for clarification on the question of ownership and control of Canary Wharf. Specifically, I was concerned that a current Wikipedia article on Canary Wharf reported that, of 14 million sq ft of office and retail space, less than 8 million is owned by CWG. This statement was referenced to a Reuter's article, published in 2007. I asked for comments on this after the hearing, specifically the precise ownership details of Canary Wharf, including its common areas, waterways and transport links. The applicant explains that the said Reuters article was derived from CWG's Final Financial Report Dec 2006 ('the Report') and published the same day as that article. The report makes clear that 16 properties on the Canary Wharf Estate make up the figure of 7.9m sq ft and CWG owns the freehold of these properties subject to short leases which generate income. Of the remaining 6.3m sq ft (14 properties), this was made up by two kinds of property; first, those where CWG owns the freehold but had granted long term leases, and second, a small number of properties where CWG had sold the freehold to a third party.

26. The reason, then, the Reuters article gave an impression that ownership of properties in Canary Wharf was not exclusively in the hands of CWG, was the fact that the first group of properties identified as being in CWG's ownership *generated income* which was then documented in the Report; the second group did not generate income, or at least regular



annual income. This pattern of ownership continues to the present day, says the applicant. As of 2013, CWG owns 18 properties generating income from short term leases. Of the 17 remaining properties, 13 are owned by CWG, having granted a long term lease and the remaining 4 have had their freeholds sold to a third party.

27. The point the applicant stresses, however, is that CWG retains *control* over all three categories of property via contractual arrangements with the occupants.

28. As far as the other areas of the estate are concerned, the applicant says it owns the Estate Common Part, the roads (with one exception), four public car parks and an area of water that was originally transferred in 1998 and subsequently reclaimed and developed. As far as transport links are concerned (Underground, Docklands Light Railway, and Crossrail services), ownership differs as between the four stations concerned. For example, London Underground Ltd owns the tube station and the freehold to the tunnels, but CWG owns the land and airspace above the tube station, and also has various 99 year leases on certain retail areas/kiosks at the station. CWG has granted a lease to Docklands Light Railway Ltd ('DLR') in respect of a station called 'Heron Quays'. CWG owns the freehold to the subsoil and land comprising the DLR station called 'Canary Wharf', although DLR owns the freehold to the rail viaduct, station structure and airspace. The new Crossrail station is under construction, built on land which was compulsorily acquired by the Secretary of State for Transport on behalf of Transport for London Ltd. CWG has a 125 year lease in respect of a planned over-station development.

29. Having sought and received, subsequent to the hearing, factual clarification as to ownership and control of Canary Wharf and the legal submissions, I was in a position to issue my formal decision. By letter dated 27 March 2014 I refused the application in its entirety, giving brief reasons. I am now asked to provide a fully reasoned statement of grounds for my refusal.

## **Decision**

30. The relevant sections of the Act read as follows:

*"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.”*

31. The above provisions mirror Article 3(1)(b) and (c) of First Council Directive 89/104 of 21 December 1988 (subsequently codified). The proviso to section 3 is based on the equivalent provision of Article 3(3).

### **Legal principles**

32. The Court of Justice of the European Union ('CJEU') has repeatedly emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (Case C-37/03P *Bio ID v OHIM* paragraph 59 and the case law cited there and, more recently, Case C-273/05P *Celltech R&D Ltd v OHIM*).

33. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provisions referred to above) the Court has held that “...*the public interest... is, manifestly, indissociable from the essential function of a trade mark*” (Case C-329/02P *SAT.1 Satelliten Fernsehen GmbH v OHIM*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark 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 (see paragraph 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function.

34. Section 3(1)(c) on the other hand pursues an aim which reflects the public interest in ensuring that descriptive signs or indications may be freely used by all (see Case C-191/0P *Wm Wrigley Jr v OHIM 'Doublemint'* at paragraph 31). A fuller expression of the legal principles engaged by section 3(1)(c) may be stated as follows:

- The words ‘may serve in trade’ include within their scope the possibility of future use even if, at the material date of application, the words or terms intended for protection are not in descriptive use in trade (see, to that effect, CJEU Cases C-108/97 and C109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots and Segelzubehor Walter Huber and others*);
- As well as the possibility of future use, the fact that there is little or no current use of the sign at the date of application is also not determinative upon the assessment. The words ‘may serve in trade’ can be paraphrased as meaning ‘could’ the sign in question serve in trade to designate characteristics of the goods/services;
- In order to decide this issue, it must first be determined whether the mark designates a characteristic of the goods in question;
- In this regard, there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately

to perceive, without further thought, a description of the goods or services in question or one of their characteristics see CJEU judgment C-468/01 P to C-472/01 P, 'Tabs', paragraph 39, and General Court judgment T-222/02, 'Robotunits', paragraph 34;

- The assessment of a sign for registrability must accordingly be made with reference to each discrete category of goods or services covered by an application for registration, see Case C-239/05 *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* [2007] ECR I-1455 at paragraphs 30 to 38; Case C-282/09 P *CFCMCEE v OHIM* 2010 ECR I-00000 at paragraphs 37 to 44;
- It is also a well-established principle these days that the Registrar's role is to engage in a full and stringent examination of the facts, underling the Registrar's frontline role in preventing the granting of undue monopolies, see to that effect, CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z.o.o. v. OHIM* [2011] ECR I-1541.

In addition to these well-known principles, in the specific case of geographical names or locations, further guidance has been given in the *Windsurfing* case as follows:

*"24. It should first of all be observed that Article 3(1)(c) of the Directive provides that registration is to be refused in respect of descriptive marks, that is to say marks composed exclusively of signs or indications which may serve to designate the characteristics of the categories of goods or services in respect of which registration is applied for.*

*25. However, Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.*

*26. As regards, more particularly, signs or indications which may serve to designate the geographical origin of the categories of goods in relation to which registration of the mark is applied for, especially geographical names, it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response.*

*27. The public interest underlying the provision which the national court has asked the Court to interpret is also evident in the fact that it is open to the Member States, under Article 15(2) of the Directive, to provide, by way of derogation from Article 3(1)(c), that signs or indications which may serve to designate the geographical origin of the goods may constitute collective marks.*

*28. In addition, Article 6(1)(b) of the Directive, to which the national court refers in its questions, does not run counter to what has been stated as to the objective of Article 3(1)(c), nor does it have a decisive bearing on the interpretation of that provision.*

*Indeed, Article 6(1)(b), which aims, inter alia, to resolve the problems posed by registration of a mark consisting wholly or partly of a geographical name, does not confer on third parties the right to use the name as a trade mark but merely guarantees their right to use it descriptively, that is to say, as an indication of geographical origin, provided that it is used in accordance with honest practices in industrial and commercial matters.*

*29. Article 3(1)(c) of the Directive is not confined to prohibiting the registration of geographical names as trade marks solely where they designate specified geographical locations which are already famous, or are known for the category of goods concerned, and which are therefore associated with those goods in the mind of the relevant class of persons, that is to say in the trade and amongst average consumers of that category of goods in the territory in respect of which registration is applied for.*

*30 Indeed, it is clear from the actual wording of Article 3(1)(c), which refers to '...indications which may serve... to designate... geographical origin', that geographical names which are liable to be used by undertakings must remain available to such undertakings as indications of the geographical origin of the category of goods concerned.*

*31. Thus, under Article 3(1)(c) of the Directive, the competent authority must assess whether a geographical name in respect of which application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future.*

*32. In the latter case, when assessing whether the geographical name is capable, in the mind of the relevant class of persons, of designating the origin of the category of goods in question, regard must be had more particularly to the degree of familiarity amongst such persons with that name, with the characteristics of the place designated by the name, and with the category of goods concerned.*

*33. In that connection, Article 3(1)(c) of the Directive does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons - or at least unknown as the designation of a geographical location or of names in respect of which, because of the type of place they designate (say, a mountain or lake), such persons are unlikely to believe that the category of goods concerned originates there.*

*...*

*35. Finally, it is important to note that, whilst an indication of the geographical origin of goods to which Article 3(1)(c) of the Directive applies usually indicates the place where the goods were or could be manufactured, the connection between a category of goods and a geographical location might depend on other ties, such as the fact that the goods were conceived and designed in the geographical location concerned."*

## **Application of the legal principles**

35. I agree with the applicant that if there is no section 3(1)(c) objection in this case, there is also no section 3(1)(b). This is not a case where the scope of section 3(1)(b) is broader than that under section 3(1)(c), the two provisions are co-extensive. The objection is based, then, solely on the words 'Canary Wharf' describing or designating geographical origin, or, in the case of goods of class 16, that the words would comprise 'subject matter'. I will now consider each of the applicant's submissions (as detailed in paragraph 11) in turn, and in the sequence given.

### **(i) Geographical location?**

36. The primary question posed by the applicant is whether 'Canary Wharf' is, in fact, a geographical location for my purposes at all, which in turn would render it susceptible, or not, to analysis on the basis of recognised precedents such as the *Windsurfing* case.

37. Fundamentally, I do not agree with the applicant's legal submission that, in effect, the fact of private ownership or control, in some way, 'trumps' public perception for my purposes. Clearly, if the applicant were correct in this, the names of other well-known areas of London, such as Mayfair, Belgravia, Kensington or Regent Street may all be subject to registered trade mark protection by virtue of being owned in large part by the Duke of Westminster or the Crown Estate. Given the public interest principles which underlie the grounds of objection this would be a highly undesirable outcome.

38. This is not to say the underlying details of ownership or control must in all cases be irrelevant (as in the example in the Examination Guidance relating to a water spring), where they could be said to have impacted upon public perception. But ultimately, it is the question of public perception which must be my guide rather than the matter being determined, absolutely and definitively, by ownership or control. How, then, does the public, at the material date of filing, perceive the area known as Canary Wharf - as an estate/development or as a business district?

39. I am in no doubt about this. Consistent referral to the area as an 'estate', not just by the applicant but others might have helped the applicant's cause, but plainly that has not been possible, especially in circumstances where the area has emerged out of an urban enterprise 'zone', where it possesses its own tube station and other transport links, and where it has such a diversity of usage as to be regarded by the Guardian newspaper, reflecting the common-held view no doubt, that Canary Wharf is a 'business district'.

40. I regard the Guardian and Wikipedia articles to the effect the area is thought of by the public as a 'business district', to be enough, in and of themselves, to accurately reflect the understanding of the public. Of course I accept the fact that, but for the applicant's efforts, the words may not have entered the public consciousness at all. However, the fact that one has coined/invented a term intended for use in respect of a specific physical 'area', and may still be largely responsible for its control, does not, subject to my further comments below, obviate the fact that it is still, at the material time of filing, regarded as a business district. The evidence of Mrs Rita Bensley, insofar as it may suggest otherwise, should be

considered in light of the fact that she is, or has been, resident and intimately active in the community and is, therefore, unlikely to be representative of the public at large.

41. I wish to consider the words ‘material date of filing’ specifically, here. I think it is clear from my reading of the Australian *Q1* case that a very different outcome would have been arrived at had the application for trade mark registration been made at a time when the designation ‘Q1’ could have been said to have first entered the public consciousness.

42. In contrast to *Q1*, it is very significant in this case that the applicant did not file the application prior to, or shortly after, the development had been started or named, but instead, has waited almost 30 years after the term was first in use. This has allowed some thirty years of uncontrolled media coverage to, at the very least, render the factual basis of ownership/control obscure as far as the relevant consumer or wider public is concerned.

43. Further, and insofar as it has been suggested, I do not regard the question of ‘public perception’ as to whether the sign applied for is perceived as denoting a ‘business district’ as opposed to an ‘estate’ to be something I must empirically prove. Certain things can, in my view, be assumed on my part. For example, the fact this application has been some 30 years in the waiting, since the name was first coined; the absence of referral on the part of third parties to the area as an ‘estate’ or in a manner from which it may be concluded it is an estate; the nature of the area and its diversity of use; the media interest and the fact it arose out of an area identified as an inner city development ‘zone;’ and its servicing by wider transport links all combine, in my opinion, to reasonably allow me to make such a conclusion. The circumstances here may be contrasted with, say, the development of an area such as ‘Bournville’ which, as is fairly well-known, comprises a self-contained ‘model village’ built around the Cadbury chocolate factory, in order to house its workers in a pleasant environment. Most people would, then, I think, associate ‘Bournville’ with the Cadbury family. I do not think the same can be said here.

44. But, lest I am wrong on the question of ‘public perception’, I am nonetheless also of the view that the precedents relied upon by the applicant are *not* on a par with the application in suit in terms of the purely factual question of ‘control’.

45. Specifically, I am not convinced the applicant exercises control to the extent, nature and sheer simplicity that may apply in relation to a single building, a shopping centre, a market (as in ‘*NEW COVENT GARDEN MARKET*<sup>4</sup>’), a power station (as in ‘*BATTERSEA POWER STATION*<sup>5</sup>’) or even a self-contained holiday village (as in ‘*MELFORT VILLAGE*<sup>6</sup>’, BL O/048/11). Control is inevitably a key tenet of the applicant’s argument and it is easy to see why. For example, in the case of *Land Securities and others v The Registrar of Trade Marks* [2008] EWHC 1744 at paragraph 10, a shopping centre is defined thus:

*“A collection of retail outlets, restaurants and entertainment facilities gathered together in one set of premises under the control of a shopping centre operator.”*

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<sup>4</sup> BL O/026/06

<sup>5</sup> BL O/063/04

<sup>6</sup> BL O/048/11

46. In the Canary Wharf area there are currently 35 buildings, as well as transport links, air above, and soil - albeit reclaimed - underneath. Potentially there will be hundreds more buildings if the area expands into predominantly residential land, as is currently anticipated. The applicant concedes that, in fact, it does not currently own the freehold to a proportion of those existing buildings, including stations. It is not clear whether it will own the freehold to the residential property intended to be acquired or built. This is patently not, in my view, 'BATTERSEA POWER STATION' or the 'Q1' tower, both of which may be said to have blessed with rather more simplistic mechanics of ownership and/or control.

47. An area such as Canary Wharf is potentially far more organic, in terms of its capacity for growth and the legal instruments of its control, as compared to a single building, or even, in some cases, a collection of buildings, of which the control may be quite fixed or static. It also goes without saying that the rights afforded by trade mark registration are potentially permanent; they relate to the very use of the words 'Canary Wharf'.

48. Summarising these findings I conclude, then, that 'Canary Wharf' was, at the material date, perceived by the public as a geographical location, namely and specifically, a business district. Further, I am not persuaded the applicant has (or may have in the future), and as a matter of fact, the kind or nature of control which would bring its own circumstances into line with those which may have prevailed in relation to any precedents. Therefore this case proceeds to having the *Windsurfing* findings, and any other considerations I feel relevant, applied.

## **(ii) Application of *Windsurfing***

49. So far as I can understand, the applicant's position on this is that there is no *Windsurfing* type of 'association' between the area and the goods and services specified. Secondly, inasmuch as *Windsurfing* may have identified a public interest principle of 'need to keep free', such concerns do not exist in this case since all goods and services have been selected on the basis that the applicant already and contractually controls such activity within the area. Thirdly and finally, the applicant is fortified in its submissions by the fact that there are many examples of registrations which have already been allowed, albeit for limited goods or services that may have reasonably been considered to be under the control of the applicant.

50. My response is that I do not think the *Windsurfing* case can be treated as a complete codification of the way that all 'geographical location' cases must be treated. The case was, and is, important because it plainly identified the 'need to keep free' principle to be applied in the specific instance of geographical names or locations. But such a principle can apply, notwithstanding that a particular location may not have a current or likely future *UK-wide* 'association' with particular goods or services. Thus, if those goods or services may be considered to be ones which could be considered 'local' in nature, such as, say, hairdressing, the provision of meeting places for worship or other activities, garage services and so forth, then the name of *any* small town or even village may need to be 'kept free'.

51. In this case, I start with my premise that 'Canary Wharf' is known as a 'business district' and therefore the likely activity within its boundaries will be, by the very nature of the place, diverse, but predominantly business-related. I regard all the services claimed as being those

which would potentially exist within such an area (and elsewhere, for that matter). To be more specific, the services specified are rental, development, construction, design and security services, all of which may be said to perfectly natural to reside in or service a business district. The relevant consumer for such services is likely to be other businesses; the only obvious exception would, to my mind, be car parking services, for which the general public could be said to be the relevant consumer. Notwithstanding that the services may be those usually accessed by other businesses, I have no reason to suppose their understanding of the words 'Canary Wharf' would be any different to that of the wider population - namely that it is a reference to a business district.

52. As I understand it, the applicant's response on the 'need to keep free' point comes very close to a familiar argument, consistently rejected by the UK courts and appellate authorities. Namely, that a trader, such as a car park operator, who uses the term, e.g. 'near to Canary Wharf Estate' has, in fact, nothing to be concerned about in connection with any possible trade mark infringement action and the possible defences thereto. But as soon as they use the term, e.g. 'Canary Wharf Car Park', that term would be materially different in relation to trade mark infringement and no defence would lie. I do not think any trader should be forced into considering the potential legal ramifications of such a fine distinction. My view is that, especially if that trader was operating on or close to Canary Wharf, and even at a distance, on one of its established or anticipated transport links, it is very easy to see why it would want to use that designation and why should it not be able? The UK courts have consistently rejected the possibility of a defence as reason enough to abandon a full and stringent examination to prevent undue monopolies; the rationale being, why should an innocent trader be forced to find a defence in the first place?<sup>7</sup>

53. In the *CARDIFF AIRPORT* decision, certain services were refused by the hearing officer and this was upheld. Had the matter been open to the Appointed Person to consider completely afresh, my view is that she may have refused the application for far more terms than those identified by the hearing officer (see, especially, paragraphs 32 and 33). At paragraph 18 of that decision, the Appointed Person says that, in her view, the expressions 'Cardiff Airport' and 'Belfast Airport' would be perceived as descriptions of characteristics of the services specified (car parking for Cardiff Airport), rather than as designations of origin. How, then, is 'car parking (or building, real estate, landscape design or security services) for 'Canary Wharf' any different? The expression 'Canary Wharf' would *still* operate as a description of a characteristic.

54. As far as the goods in Class 16 are concerned, the applicant's position is that the words 'Canary Wharf', used upon, e.g. a printed publication, would be seen to derive from a single undertaking. I cannot accept that; Canary Wharf is a hugely famous business district, both in the UK and probably abroad as well. I very much doubt if there is a person in this country, whether resident in London or elsewhere, who has not heard of it. They are most unlikely to regard a book (or other form of printed publication), either entitled or otherwise containing the words 'Canary Wharf', as inevitably derived from a single source.

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<sup>7</sup> See to that effect, e.g.: AD 2000 [1997] RPC 168 which applies older case law under the 1938 Act (YORKSHIRE TM [1954] RPC 150 at 154 lines 20-25) to the 1994 Act also.



55. I conclude that, in the *prima facie*, objection under section 3(1)(c) (and 3(1)(b) as a consequence) is maintained across the board in relation to all goods and services.

### (iii) Acquired distinctiveness

56. Ms Lane's fall-back position is based on the proviso to section 3(1), being acquired distinctiveness. The legal principles can be expressed as follows:

- Mere evidence of use, even if substantial, does not make the case for acquired distinctiveness.
- If, to a real or hypothetical individual, a word or mark is ambiguous in the sense that it may be distinctive or descriptive then it cannot comply with the requirements of the Act for it will not provide the necessary distinction or guarantee. It is in that sense that common or descriptive meaning must be displaced<sup>8</sup>.
- It follows that, with regard to the acquisition of distinctive character through use, the identification by the relevant class of persons of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark. The expression 'use of the mark as a trade mark' in section 3 refers solely to use of the mark for the purposes of the identification, by the relevant class of person, of the product as originating from a given undertaking<sup>9</sup>;
- The mark must have acquired distinctiveness through use throughout the territory of the UK.
- In assessing whether a trade mark has acquired a distinctive character the competent authority must make an overall assessment of the relevant evidence, which in addition to the nature of the mark may include (i) the market share held by goods bearing the mark, (ii) how intensive, geographically widespread and long-standing the use of the mark has been, (iii) the amount invested by the proprietor in promoting the mark, (iv) the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor, (v) evidence from trade and professional associations and (vi) (where the competent authority has particular difficulty in assessing the distinctive character) an opinion poll. If the relevant class of persons, or at least a significant proportion of them, identifies goods or services as originating from a particular undertaking because of the trade mark, it has acquired a distinctive character<sup>10</sup>;
- The position must be assessed at the date of application, being 6 March 2013.

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<sup>8</sup> Both the first two principles are stated in *Bach and Bach Flower Remedies Trade Marks* [2000] RPC 513, paragraphs 49 and 45 respectively.

<sup>9</sup> See, e.g. *Societe des produits Nestlé SA v Mars UK Ltd*, (C-353/03 ('Nestlé')); *Philips Electronics NV v Remington Consumer Products Ltd* (C-299/99); *Henkel KGaA v Deutsches Patent – und Markenamt* (C-218/01) and also see Case BL O/166/08 *Vibe Technologies* to which I drew attention at the hearing (Para 60 onwards).

<sup>10</sup> *Windsurfing*; Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-1318 at [23], *Philips v Remington* at [60]-[62], *Libertel v Benelux-Merkenbureau* at [67], *Nestlé v Mars* at [31] and C-25/05P *August Storck KG v Office for Harmonisation in the Internal Market (Storck II)* [2006] ECR I-5719 at [75].

57. Based on these principles, the case for acquired distinctiveness is also, and emphatically, rejected. Whilst the applicant has produced evidence to show that it may provide the services specified within the area known as 'Canary Wharf', it only provides them in very limited areas outside that area and in very close proximity. There is, then, no evidence that the sign is used across the UK. Further, and even more crucially, there is no evidence that the words 'Canary Wharf' are being used as, and would be recognised by the relevant consumer, as a trade mark, as distinct from the name of a geographical business district.

59. The only evidence filed in this case is that to which I have referred above at paras 7 – 9. This is evidence which, primarily, goes to the factual issues of control and historical growth rather than the kind of evidence normally required by the legal authorities on acquired distinctiveness and to which I have referred. Whilst it is true that the witness statement of Mr John Garwood, for example, refers to and exhibits certain branded items used to support the activities of the applicant's retail customers (paras 65-67), the specification does not even contain 'retail services' per se. As for the other goods and services, it is not sufficient in my opinion to demonstrate that the applicant may provide or be responsible for those services in connection with the area. What matters is whether that provision and responsibility translates into a significant proportion of relevant consumers across the UK regarding the words 'Canary Wharf' as a trade mark. Based on the evidence filed, I simply cannot say this is the case, especially where, as I have already found, as far as public perception is concerned, the words 'Canary Wharf' denote a geographical area.

### **Conclusion**

60. For the reasons given the application is refused in its entirety.

**Dated this 3rd day of October 2014**

**Edward Smith  
For the Registrar  
The Comptroller General**