

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**OPPOSITION No. 400900**

**IN THE NAME OF GAP (ITM) INC**

**TO TRADE MARK APPLICATION No. 2655091**

**IN THE NAME OF GAP 360 LTD**

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**DECISION**

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1. On 5 March 2013, Gap 360 Ltd (**'the Applicant'**) applied under number 2655091 to register **GAP 360** as a trade mark for use in relation to various services in Classes 35, 36, 39 and 41. The list of services was amended on 15 January 2015 pursuant to a request filed by the Applicant in the prescribed manner under Section 39(1) of the Trade Marks Act 1994 and Rules 24 and 25(1) of the Trade Marks Rules 2008.
2. The list as amended identified the services of interest to the Applicant in the following terms:

Class 35: Advertising services relating to the travel industries; recruitment and placement services; information relating to jobs and career opportunities; administration of temporary employment programmes; organising and conducting volunteer programmes and community service projects; information, consultancy and advisory services for all the aforesaid services.

Class 36: Travel insurance; financial services relating to travel; insurance services relating to travel; issuing of vouchers; information, consultancy and advisory services for all the aforesaid services; **[all]** relating to gap travel.

Class 39: Transport; packaging and storage of goods; travel arrangement; travel advice; travel agency and booking services; arranging for travel visas, passports and travel documents for persons travelling abroad; safety training courses; tours; bus tours; travel guides; travel escorts; coordinating travel arrangements for individuals and groups; package holiday services; information relating to travel; holiday reservation services; transportation of luggage; travel clubs; information, consultancy and advisory services for all the aforesaid services.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; technical training relating to safety; job training services; recreation; arranging of group recreational activities; arranging for students to participate in recreational activities; information services relating to recreation; education and training relating to travel; publications relating to travel; travel guides; teaching; information, consultancy and advisory services for all the aforesaid services; all relating to gap travel.

3. I have put square brackets around the word ‘**all**’ in the list of services in Class 36: although that word was requested and accepted for inclusion, it was inadvertently omitted from the list as subsequently published and recorded in the Register of Andreas Stihl AG & Co’s Trade Mark Application [2001] RPC 215; BL O-379-00; and more recently: Ennis v. Lovell (THE SWINGING BLUE JEANS Trade Mark) [2014] RPC 32; BL O-148-14 at paragraphs [15] to [18] with regard to ‘Rectification or correction of the register’ under Section 64 of the 1994 Act; TWG Tea Company Pte Ltd v. Mariage Frères SA BL O-396-15 at paragraphs [17] to [19] with regard to ‘Correction of irregularities in procedure’ under what is now Rule 74 of the 2008 Rules.
4. The application for registration was, at the time when the list of services was amended, under opposition from Gap (ITM) Inc (‘**the Opponent**’) in proceedings commenced by the filing of a Form TM7 Notice and Grounds of Opposition on 24 September 2013. The Opponent raised no objection under Rule 25(2) to the making of the amendments requested by the Applicant. And the time for doing so (one month from publication of the amendments or their effect in the Trade Marks Journal) has long since expired.

5. The opposition was on the one hand upheld in relation to the application for registration in Classes 35 and 39 and on the other hand rejected in relation to the application for registration in Classes 36 and 41 for the reasons given by Mr. George Salthouse in a decision issued on behalf of the Registrar of Trade Marks under reference BL O-413-15 on 2 September 2015. It is sufficient for present purposes to note that in his reasons for allowing the opposed application to proceed to registration Classes 36 and 41, the Hearing Officer attached importance to the limiting effect of the words *'all relating to gap travel'*. He did so with respect to the application for registration in Class 36 simply upon the informal basis that: *'At the hearing it was agreed that the word 'all' should have been in the amendment to class 36'* (paragraph [12] of the Decision).
6. In paragraph [34] of his Decision, the Hearing Officer determined as follows with regard to interpretation of the words *'gap travel'*:

[34] When the term "Gap Year" was initially coined it referred to taking a year out between either, finishing at school and starting at university, thus taking an academic year off rather than actually travelling for a year. To my mind, it will still retain this meaning. The term "gap" was also used to describe a break between finishing university and starting work, but this was usually a period of months, not usually a year. The evidence filed by the applicant shows that the majority of references within the industry are to "gap year travel" not "gap travel". I have no doubt that the former will be recognised by the majority of consumers. I am willing to accept that "gap travel" would be recognised by the majority of average consumers as well as the travel profession as relating to travel during a gap or gap year.

7. On 15 September 2015, the Applicant appealed to an Appointed Person under Section 76 of the 1994 Act against the rejection of its application for registration in Classes 35 and 39. In substance it maintained that the sign **GAP 360** was no less capable of distinguishing services of the kind specified in those classes than it was of distinguishing services of the kind specified in Classes 36 and 41 for which it had (with the assistance of the limiting effect of the words *'all relating to gap travel'*) been accepted for registration in the decision under appeal.

8. On 30 September 2015, the Opponent appealed to the High Court of England and Wales under Section 76 of the 1994 Act against the rejection of its opposition to the application for registration in Classes 36 and 41. The Opponent's appeal mounts what I can for present purposes characterise as a three-pronged attack upon the Hearing Officer's reasoning and decision in relation to the application for registration in those two classes. First, the Opponent contends that the words '*all relating to gap travel*' should have been disregarded for lack of clarity and precision. Second, it contends that even upon taking account of the words '*all relating to gap travel*', the wording should have been found to be a deficient limitation. Third, it contends that even upon giving operative effect to the words '*all relating to gap travel*', the wording should have been found to render the application for registration in Classes 36 and 41 no less objectionable than the application for registration in Classes 35 and 39 which the Hearing Officer had rejected in the decision under appeal.
9. The first of these propositions proceeds upon the premise that the Hearing Officer's determination with regard to the meaning to be ascribed to the words '*all relating to gap travel*' (see paragraph [34] of his decision) should, compatibly with the correct approach to interpreting the wording of a list of goods or services (as to which see Omega Engineering Incorporated v. Omega SA [2012] EWHC 3440 (Ch) (Arnold J) at paragraphs [20] to [34] and Total Ltd v. YouView TV Ltd [2014] EWHC 1963 (Ch) (Sales J) at paragraphs [57] to [63]) be completely rejected, because the wording in question is far too vague to satisfy the legal requirement for clarity and precision (as to which see Case 307/10 Chartered Institute of Patent Attorneys v. Registrar of Trade Marks EU:C:2012:361 at paragraphs [40] to [49]). The consequence of that is said to be that the wording should be disregarded, by analogy with the approach adopted by the General Court in a line of cases including: Case T-162/08 Frag Commercial Internacional SL v. OHIM EU:T:2009:432 at paragraphs [9] and [31]; Case T-571/11 El Corte Inglés SA v. OHIM EU:T:2013:145 at paragraphs [12] and [51] to [55]; appeal dismissed in Case C-301/13P EU:C:2014:235; and Case T-229/12 Advance Magazine Publishers Inc v. OHIM EU:T:2014:95 at paragraphs [3], [33] to [38] and [42]. I

should add that I have been asked to assume that the validity of the unopposed amendment to the list of services in January 2015 will be challenged by the Opponent in the context of its appeal to the High Court.

10. The second of the three propositions advanced on behalf of the Opponent in its appeal to the High Court allows for the Hearing Officer's interpretation of the words '*all relating to gap travel*' to stand, but challenges it on the basis of 'the POSTKANTOOR principle' (as to which see Omega Engineering at paragraphs [43] to [57]) for describing characteristics which may be present or absent without changing the nature, function or purpose of the specified services and being for that reason a deficient limitation.
11. The Opponent's third proposition controverts in large measure the basis upon which the Applicant is challenging the rejection of its application for registration in Classes 35 and 39 on appeal to an Appointed Person. Unsurprisingly, the Opponent filed a respondent's notice under Rules 71(4) to (6) of the 2008 Rules on 6 October 2015 enabling it to contest the Applicant's pending appeal on the basis of that proposition. There is, to that extent, an overlap between the matters raised for determination in the parallel appeals pending before the Appointed Person and the High Court.
12. On 28 October 2015, the Opponent raised a request for the Applicant's pending appeal to this Tribunal to be referred to the High Court under Section 76(3) of the 1994 Act, alternatively stayed pending the determination of the Opponent's pending appeal to the High Court. The request was amplified in a statement of reasons filed on 4 November 2015. It was opposed by the Applicant in a statement of reasons filed on 10 November 2015 and opposed by the Registrar in a statement of reasons filed on 13 November 2015.
13. The general contours of the exercise of discretion by this Tribunal under Section 76(3) are identified in paragraph [10] of the decision of Mr. David Kitchin QC sitting as the Appointed Person in ELIZABETH EMANUEL Trade Mark [2004] RPC 15 where he derived the following principles from the decisions of the

Appointed Persons in AJ and MA Levy's Trade mark [1999] RPC 291 (Mr. Matthew Clarke QC) and ACADEMY Trade Mark [2000] RPC 35 (Mr. Simon Thorley QC):

- (a) the Appointed person has a discretion whether or not to refer an appeal to the court; he has that discretion even if it appears to him that a point of general legal importance is involved;
- (b) the power to refer appeals to the court should be used sparingly, otherwise the clear object of the legislation to provide a relatively inexpensive tribunal would be defeated;
- (c) it will be very rare to make a reference in circumstances where a point of general legal importance cannot be identified;
- (d) the cost and expense to the party not seeking to refer should be taken into account; this is a matter which may be of particular significance in a case where the party in question is an individual or small company or partnership;
- (e) regard must be had to the public interest generally. There is a public interest in having any uncertainty as to the state of the register resolved as soon as possible. On the other hand there is a public interest in having important points of law decided by the higher courts;
- (f) the attitude of the registrar is important but not decisive.

14. Neither side took issue with the appropriateness of approaching the matter in that way or with the appropriateness, in a situation such as the present, of taking account of the principle reflected in Section 49(2) of the Senior Courts Act 1981:

‘Every Court ..., subject to the provisions of this or any other Act, shall so exercise its jurisdiction in every cause or matter before it as to secure that, as far as possible, all matters in dispute between the parties are completely and finally determined, and all multiplicity of legal proceedings with respect to any of those matters is avoided.’

and further reflected in the case law noted in paragraphs 5-118 and 20-203 of Kerly's Law of Trade Marks and Trade Names 15<sup>th</sup> Edn (2011).

15. I agree with the submissions of the Applicant and the Registrar to the effect that the appeal presently pending before this Tribunal raises no issues of fact or law which would warrant referral of it to the High Court on assessing it independently of the Opponent's pending appeal to the High Court. And as I made clear at the hearing before me, I regard the absence of the wording '*all relating to gap travel*' from the list of services for which registration is requested by the Applicant in Classes 35 and 39 as sufficient to support the conclusion that there is no need to consider the first and second of the Opponent's three propositions referred to in paragraphs [8] to [11] above in order to determine the Applicant's appeal against the rejection of its application for registration in those two classes. However, there is an overlap between the pending appeals in the area of the third of the three propositions, as I have noted in paragraph [11] above.
16. I am satisfied that the existence of that overlap makes it undesirable and inappropriate for two tribunals (the Appointed Person in relation to the application for registration in Classes 35 and 39 and the High Court in relation to the application for registration in Classes 36 and 41) to proceed in parallel to independent determinations in the separate appeals pending before them. In the absence of any application to the High Court for a stay of the Opponent's appeal pending determination of the Applicant's appeal to an Appointed Person, I think the question to be decided boils down to whether I should refer the Applicant's appeal to the High Court for determination at the same time as the Opponent's appeal or stay it pending determination of the Opponent's appeal to the High Court for the purpose of enabling the Applicant to retain the legitimate advantages of bringing it before this Tribunal rather than the High Court.
17. At the conclusion of the hearing before me, I was concerned that referral of the Applicant's appeal to the High Court would be liable to subject the Applicant to a

degree of financial pressure which might lead it to withdraw not only from its own appeal, but also from defending the Opponent's appeal. The witness statement of its Managing Director (Mr. David Stitt) filed in support of its application for a costs capping order under CPR 52.9A in relation to the High Court proceedings, and the matters raised with me in submissions on its behalf, left me with the impression that there was a real and substantial prospect of such withdrawal.

18. My concern was subsequently allayed on being informed that in the aftermath of the hearing before me, the parties had reached an agreement to the following effect:

- “1. Gap 360 Ltd consents to the referral of the Appointed Person appeal to the High Court, to be consolidated with the High Court appeal (case no. CH/2015/0450, also in respect of the appeal of UK IP Office decision in Opposition No. OP000400900). The request for referral of the Appointment Person appeal to the High Court is therefore uncontested;
2. the parties agree to capping the costs liability in the High Court appeal (case no. CH/2015/0450) to that available in an appeal to the Appointed Person. This cap on costs liability applies to both parties (Gap 360 Ltd and Gap (ITM) Inc.);
3. the parties agree that there be no order as to costs in relation to both: (a) Gap (ITM) Inc.'s request under rule 72(1)(b) of the Trade Marks Rules 2008 to refer the Appointed Person appeal to the High Court; and (b) Gap 360 Ltd's application to the High Court dated 20 November 2015; and
4. the parties agree that any opposition proceedings filed by Gap (ITM) Inc. against Gap 360 Ltd's new GAP 360 trade mark application (UK Trade Mark No. 3126392) should be stayed pending the outcome of the consolidated High Court appeal (case no. CH/2015/0451).”

19. On balance I am satisfied that the Applicant's pending appeal to this Tribunal should, in the light of that agreement, be referred to the High Court of England



and Wales under Section 76(3) of the Trade Marks Act 1994 and I so direct. I should add that it is now incumbent upon the Applicant to take the steps necessary within the time prescribed by the Civil Procedure Rules to complete the process of referral to the Court.

Geoffrey Hobbs Q.C.

7 January 2016

Mr. Julius Stobbs of Stobbs IP Ltd appeared on behalf of the Applicant.

Mr. Simon Malynicz instructed by Stephenson Harwood LLP appeared on behalf of the Opponent.

Mr. Raoul Colombo provided written submissions on behalf of the Registrar.