

O-156-18

TRADE MARKS ACT 1994

**CONSOLIDATED PROCEEDINGS
IN THE MATTER OF
APPLICATION NOS 3156382 & 3156384
BY SAIL WEEK CROATIA LIMITED
TO REGISTER**



&

sailweek

**AS TRADE MARKS IN CLASSES 16, 25, 39, 41 & 43
AND
OPPOSITIONS THERETO (UNDER NOS. 407053 & 407054)
BY
NAVIGATE TRAVEL LIMITED**

Background

1) On 23 March 2016, Sail Week Croatia Limited ('the applicant') applied to register the two marks shown on the cover page of this decision in respect of the following goods and services:

Class 16: Catalogues, advertising materials, brochures, magazines, books, maps, guides and timetables

Class 25: Clothing, footwear, headgear, eyewear; wet suits for water-skiing; waterproof clothing; bathing drawers; bathing suits.

Class 39: Transport; packaging and storage of goods; travel arrangement; travel agency and tourist services relating to sailing holidays; sightseeing (tourism); transportation of passengers' luggage; vehicle rental; boat transport; booking of seats for travel; marine transport; transport of travellers; boat storage; chartering, rental and leasing of yachts; chartering, rental and leasing of marine vessels; yacht rental; arrangement of tours and cruises; storing yachts; provision of mooring for yachts; rental of diving suits; travel reservation; arrangement of excursions; dissemination of travel information; traffic information.

Class 41: Education; providing of training; arranging of courses and training relating to sailing, the use of boats/yachts and their equipment, chart and map reading, first aid and survival; conducting of courses and training relating to sailing, the use of boats/yachts and their equipment, chart and map reading, first aid and survival; organization of sailing activities and competitions; publishing of training materials; entertainment; sporting and cultural activities; publication of newsletters; blogging namely writing of texts; publication of blogs on-line; production of sporting events for film/radio/tv; organization of competitions (education or entertainment); recreation facilities (providing -); providing sports facilities; club services (entertainment or education); organization of sports competitions; sport camp services; photographic

reporting; photography; videotaping; arrangement of competitions for training purposes; rental of sports equipment; production of film.

Class 43: Hotel services; provision of temporary accommodation; restaurant and catering services; provision of exhibition facilities; booking and reservation services for all the aforesaid; services for the provision and booking of accommodation for travellers; provision of information and advice related to holidays.

2) Both applications were published for opposition purposes on 29 April 2016 and notice of opposition was filed thereafter by Navigate Travel Limited ('the opponent'). The opponent claims that the applications offend under 3(1)(b), (c) & (d) of the Trade Marks Act 1994 ('the Act').¹

3) The opponent claims that both marks designate characteristics of the contested goods and services because 'sailweek' indicates that they all relate to a week's sailing holiday. The sail device in mark 3156382 is said to add to the descriptiveness of 'sailweek' within that mark.

4) The applicant filed counterstatements. It's primary position is that both marks are inherently distinctive and do not fall foul of section 3(1)(b), (c) or (d). It also claims to have used both marks extensively in the UK such that, if it is found that the marks offend under any of the grounds raised by the opponent, they should be accepted on the basis of acquired distinctiveness.

5) Both parties filed evidence. The opponent also filed written submissions². A hearing took place before me at which both parties were represented by counsel; the opponent by Mr Guy Tritton and the applicant by Ms Amanda Michaels.

¹ Other grounds under section 3(1)(a) and 3(6) were originally pleaded but Mr Tritton confirmed at the hearing that the opponent no longer wished to pursue those grounds.

² Dated 24 August 2017.

Evidence

6) The opponent's evidence in chief comes from one of its directors, Mr Daniel Painter. He states that the opponent offers sailing holidays under its 'Sail Week brand'. He explains that he has worked in the sailing holiday industry since 2010 and, in his experience, the term Sail Week is used throughout the industry and within the sailing community to denote a week's sailing. He provides examples of the use of the term Sail Week on social media by a number of individuals and businesses³. Mr Painter says that these are descriptive uses by third parties to describe a week's sailing and they are not a reference to the applicant. The examples include a print from the website of a business trading as Nicholson Yachts entitled 'Antigua Sail Week' to describe a seven day sailing event around the island of Antigua. Another from a business named Wanderable offers a week's sailing around Sardinia referred to as 'Sardinia Sail Week'. A third print is from the website of North Lincolnshire and Humberside Sailing Club showing a photo gallery from a training event they held for their members entitled 'Sail Week'. A fourth print is from the website of Plas Menai, the National Outdoor Centre for Wales, which offers a range of outdoor pursuits. The term Sail Week is used in relation to training courses they run teaching people to sail e.g. 'Family Sail Week' which is an event intended to teach families to learn to sail.

7) The applicant's evidence comes from one of its directors, Mr Vincent Ivan Radonich. He states that the applicant provides sailing holidays and ancillary goods and services including transportation, tours, accommodation, organisation of events, training and associated merchandise and has been using the mark SAILWEEK in the UK and the EU since 2012. He explains that the applicant currently provides holidays predominantly to Croatia but the vast majority of its customers are based in the UK.

8) Mr Radonich states that since the inception of the business in 2012, it has grown significantly. Total (approximate) revenue figures are: 2013 £27k; 2014 £186k; 2015 £595k; 2016 £1.2m; 2017 over £2m (predicted).

³ Exhibits 1 - 3.

9) In the period up to 31 October 2016, the opponent has invested approx. £80k in brand development and marketing. At the date of his witness statement, Mr Radonich says that this figure has increased by a further £40k. As a result, he states that the applicant has a significant reputation in the UK (and Croatia). He provides prints from the EUIPO showing details of the applicant's EU registered trade marks and a list of various domain names incorporating SAILWEEK owned by the applicant.⁴

10) Mr Radonich says that the industry tends to use the likes of 'sailing holiday' or 'week yachting' to describe sailing holidays, not SAILWEEK. He also states that the opponent's position appears to be confused since Mr Painter states in his evidence that the opponent uses the term 'Sail Week' as a brand.

11) The opponent's evidence in reply comes from three individuals. The first is Mr Dai Thomas, the Junior National Sailing Coach. He states that, to him, the term 'Sail Week' would imply either a week long sailing training course or a week long racing event run by a Yacht Club or flotilla and that during his time in the sailing industry he has been involved in many such events. The second individual is Mr Nick Sawyer, Chief Instructor at Cardiff Bay Yacht Club. He says that that the term 'Sail Week' has a broad meaning to him and that he would use it to refer to any week's sailing training that he may be running at a sailing club. Alternatively, the term could be used to refer to a regatta or racing event. The third individual is Mr Roger Dunstan who states that he has had many roles in the sailing industry including Club Commodore, a Yacht delivery skipper and a racer. Mr Dunstan states that the term 'Sail Week' has a broad meaning to him and he would perceive it as referring to a week on a boat. Messers Thomas, Sawyer and Dunstan all also state that they would not associate the term sail week with a particular company or brand as it is a generic term used in the industry.

12) The applicant's further evidence comes from Robert Denny (Director of Xambor Watersports Limited), Martin Osbaldeston (Sales and Marketing Representative of Robinsons Holidays), Marc Harris (managing director of The Holiday Shop Limited, a

⁴ Exhibit VIR

holiday company specialising in UK and EU holidays and day trips), Andrew Kinnaird (Director of O. & C. Holdsworth Ltd, hotel and coach tour company), Tara Adsett (Finance Director of Big Screen Media Limited, specialising in LED Screen Hire and video and Audio equipment) and Christina Clarke (managing director of Venture Sailing Ltd). Each of these six individuals has provided a brief witness statement. The wording of the witness statements is identical (save for their names, addresses and occupations). Each witness states that: i) they have no relationship with the applicant, ii) they are not aware of SAILWEEK being used descriptively in relation to sailing holidays, training or events and it doesn't have any particular meaning them, iii) if they were to describe a week's sailing holiday they would call it a 'sailing week' as 'sailweek' wouldn't make sense to them, iv) they are aware of the applicant's use of the name SAILWEEK and would see any use of SAILWEEK as referring to Sail Week Croatia's holidays and the like (i.e. holidays provided by the applicant).

13) I will say upfront that neither the opponent's evidence in reply nor the six witness statements from the applicant filed as further evidence are of assistance to me in reaching the following decision and I will make no further mention of them. As regards the applicant's evidence, despite all of the witnesses stating that they have no relationship with the applicant, none of the witnesses explain how they nevertheless have come to know of it or how they are aware of the applicant's use of the sign SAILWEEK. Furthermore, as I noted above, all of the witness statements are written in identical terms. Such statements invite scepticism of the kind expressed by Lord Esher MR in *Re Christiansen's Trade Mark* [1885] 3 RPC 54, at 60:

"Now, to my mind, when you have evidence given upon affidavit, and you find a dozen people, or twenty people, all swearing to exactly the same stereotyped affidavit, if I am called to act upon their evidence, it immediately makes me suspect that the affidavits are then not their own views of things and that they have adopted the view of somebody who has drawn the whole lot of affidavits, and they adopt that view as a whole and say „I think that affidavit right“ and they put their names to the bottom.”

Insofar as the opponent's evidence in reply is concerned, the three witnesses also provide strikingly similar witness statements and none of them explain what relationship they have with the opponent such that it not clear what their motives are for providing the opinions that they do.

Decision

14) At the hearing, Mr Tritton confirmed that the opponent's primary objection is under s. 3(1)(c) and that the s. 3(1)(b) and (d) grounds add nothing to the opponent's case. Accordingly, if the opponent fails under s. 3(1)(c), it would also fail under the other grounds.

15) Section 3(1)(c) of the Act states:

“3(1) The following shall not be registered –

(a) ...

(b) ...

(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.”

16) The case law under this ground was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp.*

z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).**

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM (C-48/09 P) , paragraph 43).**

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley , paragraph 31 and the case-law cited).*

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign

on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland* , paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*,

paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of

Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

17) The matter must be assessed from the perspective of the relevant consumer of the goods and services at issue, including those in the trade.⁵ In the instant case the average consumer is the general public and may also include professionals in the sailing community. Those consumers are to be regarded as reasonably well-informed and reasonably observant and circumspect.

The *prima facie* position

18) Ms Michaels was critical of Mr Painter’s evidence which she submitted does not show that ‘sailweek’ is used descriptively by third parties. She also argued that the more natural way of describing a week’s sailing would be ‘Sailing week’. I remind myself that the correct approach is to ask whether the term could be used descriptively in relation to the relevant goods and services.⁶ Accordingly, even if I were to accept both of Ms Michaels’ points, they are not fatal to the opponent’s case.

19) In *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (Postkantoor) Case C-363/99, where the CJEU stated that:

“98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements

⁵ *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, para 24

⁶ *Wm Wrigley Jr & Company v OHIM* C-191/0P

together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark”.

The court has repeated the above in subsequent cases which should now be considered settled law.⁷ I find that ‘sail’ and ‘week’ within the contested mark ‘sailweek’ are each descriptive of a characteristic of the applicant’s goods and services such as ‘travel agency and tourist services relating to sailing holidays’. Furthermore, I consider that the overall combination ‘sailweek’ sends an immediate and clear descriptive message in relation to such goods and services i.e. those that involve or relate to a week’s sailing. The fact that the more usual and grammatically correct way of describing such goods and services may be ‘sailing week’, as submitted by Ms Michaels, does not disturb this finding since the average consumer is likely to immediately, and without further thought, recognise that ‘sailweek’ is an obvious shortening of that phrase. I find that the combination of ‘sail’ and ‘week’ in the mark does not “create an impression which is sufficiently far removed from that produced by the simple combination of those elements”. The mark is *prima facie* excluded from registration under section 3(1)(c) of the Act as it describes a characteristic of the applicant’s goods and services which may involve or relate to a week’s sailing. This includes the goods and services for which the mark may be used to describe the subject matter (e.g. ‘brochures’, ‘guides’ etc.) and services which may be provided for a week on a boat/yacht (e.g. ‘hotel services’ (which would include yacht hotels), ‘conducting of courses and training relating to sailing, the use

⁷ See, for example, *Campina Melkunie*, Case 265/00P

of boats/yachts and their equipment, chart and map reading, first aid and survival' etc.).

20) The mark is not, however, objectionable under s. 3(1)(c) for goods and services for which the mark 'sailweek' clearly does not designate a characteristic of the goods and services or is no more than allusive or suggestive in relation to them, such as the goods in class 25, 'restaurant services' in class 43 and 'packaging and storage of goods' in class 41.

21) I now turn to consider the applicant's other mark which looks like this:



Ms Michael's submitted that the device is very significant in the overall impression and is an unusual and attractive part of the mark such that the mark, as a whole, cannot be said to be exclusively descriptive. Mr Tritton submitted that the device merely reinforces the descriptive message sent by the word element 'sailweek' and therefore the mark as a whole falls foul of s.3(1)(c).

22) I accept that the device makes a significant visual impact and that the representation of the sail is slightly unusual/attractive in the sense that it is made up of numerous sweeping lines. However, I do not think that this will change the immediate impression that the sail device will have on the consumer which is that it merely supports the descriptive message conveyed by the words.

23) In *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*⁸, Arnold J. held that a descriptive word with a minor figurative embellishment was, as a whole, descriptive of a characteristic of the services at issue. He found that:

⁸ [2013] F.S.R. 29

“116. Taking all of the evidence into account, I conclude that the CTM is precluded from registration by art.7(1)(c) in relation to the services in issue because NOW would be understood by the average consumer as a description of a characteristic of the service, namely the instant, immediate nature of the service. The figurative elements of the CTM do not affect this conclusion. In the alternative, if the inclusion of the figurative elements means that the CTM does not consist exclusively of the unregistrable word NOW, I consider that the CTM is devoid of distinctive character and thus unregistrable by virtue of art.7(1)(b) .

117. I would comment that it appears to me that PCCW only succeeded in obtaining registration of the CTM because it included figurative elements. Yet PCCW is seeking to enforce the CTM against signs which do not include the figurative elements or anything like them. That was an entirely foreseeable consequence of permitting registration of the CTM. Trade mark registries should be astute to this consequence of registering descriptive marks under the cover of a figurative figleaf of distinctiveness, and refuse registration of such marks in the first place.”

I also note that in *Thomas Pink Ltd v Victoria's Secret UK Ltd*⁹, Birss J. found that the registration of the descriptive word PINK (for clothing) with the letters in the colour pink and in a unique form of script, all within a rectangular box, did not prevent the mark being *prima facie* unregistrable under s.3(1)(c).

24) In the instant case, I find that the presence of the sail device is insufficient to justify the conclusion that the mark consists of more than a sign which may serve, in trade, to designate a characteristic of the goods and services. That characteristic being that they involve or relate to a week's sailing (as per paragraph 19 above). I find that the mark, as a whole, is *prima facie* excluded from registration under section 3(1)(c) in respect of the same goods and services as the mark 'sailweek'.

⁹ [2014] EWHC 2631 (Ch)

25) Both applications are *prima facie* excluded from registration under s. 3(1)(c) of the Act in relation to the following goods and services:

Class 16: Catalogues, advertising materials, brochures, magazines, books, maps, guides and timetables

Class 39: Transport; travel arrangement; travel agency and tourist services relating to sailing holidays; sightseeing (tourism); transportation of passengers' luggage; vehicle rental; boat transport; booking of seats for travel; marine transport; transport of travellers; boat storage; chartering, rental and leasing of yachts; chartering, rental and leasing of marine vessels; yacht rental; arrangement of tours and cruises; storing yachts; provision of mooring for yachts; travel reservation; arrangement of excursions; dissemination of travel information.

Class 41: Education; providing of training; arranging of courses and training relating to sailing, the use of boats/yachts and their equipment, chart and map reading, first aid and survival; conducting of courses and training relating to sailing, the use of boats/yachts and their equipment, chart and map reading, first aid and survival; organization of sailing activities and competitions; publishing of training materials; entertainment; sporting and cultural activities; publication of newsletters; blogging namely writing of texts; publication of blogs on-line; production of sporting events for film/radio/tv; organization of competitions (education or entertainment); recreation facilities (providing -); providing sports facilities; club services (entertainment or education); organization of sports competitions; sport camp services; photographic reporting; photography; videotaping; arrangement of competitions for training purposes; rental of sports equipment; production of film.

Class 43: Hotel services; provision of temporary accommodation; booking and reservation services for all the aforesaid; services for the provision and booking of accommodation for travellers; provision of information and advice related to holidays.

Acquired distinctiveness?

26) The CJEU provided guidance in *Windsurfing Chiemsee*, Joined cases C-108 & C-109/97, about the correct approach with regard to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37).”

27) The burden of proving acquired distinctiveness lies with the applicant.¹⁰ The relevant date is the application date of the contested marks i.e. 23 March 2016.

28) Although Mr Radonich provides revenue figures in his witness statement for four years prior to the relevant date (from 2012) which he states relate to use of the mark SAILWEEK, and whilst I note that these figures are not insignificant and have increased substantially year-on-year, the problem for the applicant is that there is nothing in the evidence to show how the mark was used in that period nor the precise goods and/or services that were provided. The evidence showing that the opponent has numerous domain name registrations and EU registered marks does not assist me as this does not show how the mark has actually been used in trade. Further, although Mr Radonich states that £80k was spent on promoting the mark up to 31 October 2016 it is not clear what proportion of this (already) modest figure relates to a time prior to the relevant date. There is also no explanation or evidence showing the kind of promotion or advertising that has taken place or where it has taken place. In the absence of further information such as invoices to customers, market share details and/or examples of advertising material I find that I am unable to conclude that either of the marks had acquired the necessary distinctive character at the relevant date.

Summary

29) The opposition succeeds against the following goods and services covered by both applications:

Class 16: Catalogues, advertising materials, brochures, magazines, books, maps, guides and timetables

Class 39: Transport; travel arrangement; travel agency and tourist services relating to sailing holidays; sightseeing (tourism); transportation of passengers' luggage; vehicle rental; boat transport; booking of seats for

¹⁰ *Oberbank AG & Banco Santander SA and Another v Deutscher Sparkassen- und Giroverband* (Joined cases C-217 and 218/13).

travel; marine transport; transport of travellers; boat storage; chartering, rental and leasing of yachts; chartering, rental and leasing of marine vessels; yacht rental; arrangement of tours and cruises; storing yachts; provision of mooring for yachts; travel reservation; arrangement of excursions; dissemination of travel information.

Class 41: Education; providing of training; arranging of courses and training relating to sailing, the use of boats/yachts and their equipment, chart and map reading, first aid and survival; conducting of courses and training relating to sailing, the use of boats/yachts and their equipment, chart and map reading, first aid and survival; organization of sailing activities and competitions; publishing of training materials; entertainment; sporting and cultural activities; publication of newsletters; blogging namely writing of texts; publication of blogs on-line; production of sporting events for film/radio/tv; organization of competitions (education or entertainment); recreation facilities (providing -); providing sports facilities; club services (entertainment or education); organization of sports competitions; sport camp services; photographic reporting; photography; videotaping; arrangement of competitions for training purposes; rental of sports equipment; production of film.

Class 43: Hotel services; provision of temporary accommodation; booking and reservation services for all the aforesaid; services for the provision and booking of accommodation for travellers; provision of information and advice related to holidays.

30) The opposition fails against the following goods and services covered by both applications:

Class 25: Clothing, footwear, headgear, eyewear; wet suits for water-skiing; waterproof clothing; bathing drawers; bathing suits.

Class 39: Packaging and storage of goods; rental of diving suits; traffic information.

Class 43: Restaurant and catering services; provision of exhibition facilities; booking and reservation services for all the aforesaid.

Costs

31) As the opponent has been largely successful, it is entitled to a contribution towards its costs. Ms Michaels requested that I take into account the work undertaken by the applicant in the counterstatement responding to the 'hopeless' section 3(6) claim which was ultimately dropped. Although the s. 3(6) ground was sensibly dropped at the hearing, I agree with Ms Michaels that it should have been obvious to the legally represented opponent from the outset that the ground had no prospect of success. I agree that the applicant should therefore be compensated for the work undertaken in this regard. I award the opponent costs on the following basis:

Opposition fee (x2)	£400
Preparing a statement and considering the applicant's statement (x2)	£300
Preparing evidence and considering the applicant's evidence (and further evidence)	£700
Preparing for and attending the hearing	£500
Total:	£1900

32) I will deduct £300 from the above total to account for the work undertaken by the applicant in responding to the 3(6) claim. I order Sail Week Croatia Limited to pay Navigate Travel Limited the sum of **£1600**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of March 2018

**Beverley Hedley
For the Registrar,
the Comptroller-General**