TRADE MARKS ACT 1994

In the matter of application no.2029981
by Rover Group Limited
to register a Trade Mark in Class 12

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IN THE MATTER OF APPLICATION TO REGISTER
TRADE MARK NO 2109330 IN CLASS 12
IN THE NAME OF ROVER GROUP LIMITED

On 6 September 1996, Rover Group Limited of International House, Bickenhill Lane, Bickenhill, Birmingham, applied under the Trade Marks Act 1994 to register a series of two trade marks, **XE** and **Xe** in Class 12 in respect of:-

> "Motor land vehicles"

Objection was taken to both marks under paragraph (b) of Section 3(1) of the Act on the grounds that the marks are devoid of any distinctive character.

At a hearing at which the applicants were represented by Mr Cooper, the Head of Trade Marks at Rover Group Limited. Mr Cooper asked that the first mark in the series, the letters XE in upper case be deleted from the application and for the application to be allowed to proceed for the mark "Xe". The objection under Section 3(1)(b) was maintained and following refusal of the application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of decision and the materials used in arriving at it.

No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

Sections 3(1)(b) of the Act reads as follows:-

> 3(1) The following shall not be registered -
>
> (b) trade marks which are devoid of any distinctive character,

It is clear from Section 1(1) of the Act that letters are capable of being registered as trade marks. In the case of an unused mark the question must therefore be whether the letters are descriptive or devoid of any distinctive character. No objection has been taken, in this case, under the former heading.

The Registrar generally regards <u>random</u> combinations of three or more letters as being distinctive. Whether a random combination of two letters has any distinctive character as a trade mark will depend on various considerations including:-

a) whether the letters are likely to be taken as a short, pronounceable invented word;

b) whether the letters are commonly used in the relevant trade(s) as catalogue or model references;

As far as I am aware, apart from its use as a chemists' symbol to denote "xenon", Xe is not an English dictionary word and no claim to this has been made by the applicants. Whether the letters are able to be pronounced is, I accept, arguable. The agent has contended that they are and cited words beginning with the letter "X", namely, Xantia, Xsara and Xena to support this view.

The combination "Xe" at the beginning of a word is not that common in the English language. Collins English Dictionary has a number of entries for English words which have the letters Xe forming the first syllable of the word, and shows that the pronunciation is variable. In the word Xenia the first syllable is shown as being pronounced "zɨ" as in "**see**", in the word Xenon the pronunciation is shown as "zɛ" as in "**sai**d" and in the trade mark Xerox the pronunciation is shown as "zɪə" as in "**sear**". The pronunciation of the letters Xe in these words appears to be influenced by the following letters, the consequence being, I believe, to make the pronunciation of the letters on their own even more uncertain. However, even if the letters are accepted as being capable of being pronounced, this does not make them acceptable for registration.

Mr Robin Jacobs QC sitting as the Secretary of State's Tribunal in the IUC CHOICE trade mark case (Application No. 1409562, unreported) stated:-

> "The test must be whether the public would take the letters as signifying a word. The question is not "can these letters be pronounced as a word" but "would these letters be taken as a word"

Setting aside the question of whether the letters can be pronounced, I am of the view that this is a combination of letters which is unlikely to be regarded as a word.

From my own knowledge I am aware that it is common practice in the trade at issue to designate trim levels, engine capacity or type, special or limited editions, etc, of models of particular vehicles by the use of letters. I acknowledge that certain combinations of letters may be exclusive to one particular trader although that is not always the case, and is not the case with respect to the letters "XE" which to my knowledge are, or have been used upon the same goods by at least two other traders, namely Peugeot and Nissan.

Some letters appear to be an abbreviation, eg, "TD" is frequently used to denote vehicles having Turbo Diesel engines, "i" to denote vehicles having a fuel "injection" system, etc,. Others appear not to be an abbreviation but indicate an aspect of the vehicle, eg "GTi" is used by a number of traders to indicate that the vehicle has a high performance engine. Other combinations, eg. LX GLX, SE, etc., do not appear to have any particular meaning, a point acknowledged by the agent at the hearing. Whether the letters Xe have a meaning or not does not materially affect my decision since I am inevitably led to the conclusion that, taking the usual practices of the trade into account, that the mark applied for will not be seen by traders or customers as a badge of origin, and therefore, that it is devoid of any distinctive character.

In British Sugar Plc v James Robertson & Sons Ltd (1996) RPC 281, Jacob J made the following comments:

> "Next, is "Treat" within Section 3(1)(b). What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate

> for the goods concerned ("North Pole" for bananas) can clearly do. But a common laudatory word such as "Treat" is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word *inherently* from the old Act but the idea is much the same) devoid of any distinctive character."

Although the goods involved in the TREAT decision were foodstuffs, every day consumer items, the same considerations apply to technical goods. Therefore, I consider the marks to be devoid of any distinctive character and are not acceptable, prima facie, for registration under Section 3(1)(b).

As indicated earlier the application is for a series of two marks, XE and Xe. Mr Cooper of his own volition requested that the first of these marks, XE be deleted from the application leaving the second mark Xe which he claimed qualified for registration. Taking account of the specific letters at issue and the circumstances in the trade, I do not believe that the case for registration of Xe is materially stronger than for the mark XE. I have already explained that I do not think that Xe is likely to be taken as an invented word. In that event I do not think that the presentation of two letters in upper and/or lower case significantly changes the case for registration. The applicants appear to have taken the same view at the time of application when they applied to register the marks as a series. In other words two marks which differ only as to matters which do not substantially affect their identity.

I believe that I am also entitled to have regard to the statement on the application form attesting to the applicants' intention to use the mark applied for. In the case of a series of marks this statement must be regarded as applying to each mark in the series. If so, this underlines the fact that this application was originally made on the footing that two marks with essentially the same identity, were to be registered and subsequently used with trivial variations. This does not sit well with the applicants subsequent contention that it is the variation between the marks which gives the one mark a distinctive character where the other does not.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) and Section 3(6) of the Act.

Dated this 13 day of July 1998.

MIKE FOLEY
For the Registrar
The Comptroller General