

TRADE MARKS ACT 1994

In the matter of  
application no: 2127720  
by Golf International (Services) Limited  
to register a Trade Mark in  
Class 16

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**IN THE MATTER OF APPLICATION NO 2127720  
BY Golf International (Services) Limited  
TO REGISTER A TRADE MARK IN CLASS 16**

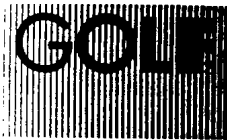
On 26 March 1997, Golf International (Services) Limited of 125 Hemingford Road, London N1 1BZ applied under the Trade Marks Act 1994 for registration of the Trade Mark



in Class 16 in respect of “Printed matter; magazines; books; newsletters; periodicals; brochures; printed publications; manuals”.

Objection was taken to the application under paragraphs (b) and (c) of Section 3(1) of the Act because the mark consists exclusively of the words “essential reading from the best in the game Golf international” which may serve in trade to designate the kind and quality of the goods eg the best reading material covering international golf.

Objection was also taken to the application under Section 5(2) of the Act in respect of the following earlier mark:-

<u>Mark</u>	<u>Number</u>	<u>Class</u>	<u>Specification</u>
	1388401	16	Hygienic papers, gift papers, gift cartons; exercise books, music books, painting books, pads, notepads, jotters, blotting paper, coloured paper, copying paper, tracing paper, carbon paper, loose leaf paper, artists paper, folders, file covers, index cards, sticky cards; office requisites; photo albums, stamp albums and coin albums; guest books, writing cases; stationery; envelopes, postcards and congratulatory cards; writing materials; pencils, coloured pencils, crayons, painting pencils, ball-point pens, fountain-pens, indelible pencils, erasers, pencil sharpeners; paint boxes; all included in Class 16

At a hearing at which the applicants were represented by Ms Wood of RM Trade Marks Limited, their agents, Ms Wood offered to delete “printed matter, printed publications and brochures” from the specification of goods, and on this basis the objection under Section 5(2) was waived and I need say no more about it. The objection under Section 3(1)(b)&(c) was maintained and following refusal of the application 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) and (c) of the Act read as follows:-

3(1) The following shall not be registered -

(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, geographic origin, the time of production of goods or of rendering of services, or other characteristics of goods or services.

At the hearing Ms Wood argued that the mark is not devoid of any distinctive character, that in view of the stylisation and the number of words, no-one else would wish to use this combination.

The mark consists of the words GOLF INTERNATIONAL and the phrase “essential reading from the best in the game”. The different elements of the mark are presented in different typefaces and different sizes, there is some shading around parts of the mark which give it a slight three-dimensional effect. The mark was applied for in the colours green and white although colour was not claimed as an element of the mark.

The meanings of the words “golf” and “international” are well known. The participants in professional and major amateur golf tournaments are drawn from a wide range of nationalities, as anyone who has watched television coverage of the game of golf will be aware. Therefore the bringing together of the two words in the phrase GOLF INTERNATIONAL is not inventive and is a phrase which anyone may wish to use eg as the title of a magazine, book or any other publication whose subject matter relates to the game of golf in an international context.

The mark also contains the phrase “essential reading from the best in the game”. Collins English Dictionary offers the following definitions *inter alia*:

**essential**      1. vitally important; absolutely necessary 2. basic; fundamental

**reading**      1.a. the act of a person who reads  
3. any matter that can be read; written or printed text

**best** 11. **the best** the most outstanding or excellent person, thing or group in a category.

It seems to me that this phrase is not inventive, it is a perfectly ordinary construction using words in their ordinary dictionary meaning in a way that anyone else may wish to do, to indicate that their publication contains important or necessary reading matter from the most outstanding contributors in the game of golf. That this is not the only way of saying this is immaterial. As Mr Hugh Laddie said in the PROFITMAKER case (1994) RPC 613 at page 616 lines 38-44:

“The fact that honest traders have a number of alternative ways of describing a product is no answer to the criticism of the mark. If it were, then all those other ways could, on the same argument, also be the subject of registered trade marks. The honest trader should not need to consult the register to ensure that common descriptive or laudatory words, or not unusual combinations of them, have been monopolised by others”.

Therefore in totality the words GOLF INTERNATIONAL and “essential reading from the best in the game” are words which others may wish to use on a magazine or other publication about international golf.

I am aware that the words are presented in different sizes and typefaces and in the colours green and white. Section 3(1)(c) of the Act refers to marks which consist exclusively of signs or indications .... etc. The presentation of the words is not an unusual presentation for eg the title of a magazine and does not, in my opinion, differ from the words *per se* to the extent that the sign does not consist exclusively of the words. There is no device or other additional matter other than a non-distinctive green background to the words “essential reading from the best in the game”.

I find therefore that the mark consists exclusively of a sign which may serve, in trade, to designate the kind and quality of the goods at issue, and so does not qualify under Section 3(1)(c) of the Act.

In case I am found to be wrong I go on to consider the mark under Section 3(1)(b) which bars registration of “marks which are devoid of any distinctive character”.

The test of distinctiveness was laid down by Mr Justice Jacob in the TREAT case (1996) RPC 281 page 306 lines 2-5 when he said:-

“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 ..... devoid of any distinctive character”.

I have already found that the words contained within the mark are meaningful for the goods. The agent argued at the hearing that because of the stylisation the mark is not devoid of any distinctive character. I disagree. In this context I refer again to the words of Mr Justice Jacob

in the TREAT case at page 300 lines 10-13 when he considered whether the average customer would see “Toffee Treat” as a trade mark:

“I am of course aware that the words “Toffee Treat” are written in a fancy way. But then so are many mere descriptors. One only has to look at the way British Sugar write such words as “meringue mix” or “golden syrup” to see parallel sorts of use. I do not think this affects the matter one way or another”.

To my mind the descriptive nature of the words is strong and the stylisation does not provide sufficient surplus to justify protection. For this reason I consider the mark to be devoid of distinctive character and therefore not acceptable, *prima facie*, for registration under Section 3(1)(b).

That is not to say that the mark can never be registered - I do not think that is the case - but, to repeat the words of Mr Justice Jacob in the “TREAT” case, it is the sort of sign “which cannot do the job of distinguishing without first educating the public that it is a trade mark”. At the hearing Ms Wood asked me to take account of the colours in which the mark is used. Whilst I do not consider the colours green and white to be particularly unusual or distinctive *prima facie*, it may be that they can assist in enabling the mark to acquire distinctiveness through use.

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 (c) of the Act.

Dated this 13 day of January 1999.

**ANNE PRITCHARD**  
**For the Registrar**  
**The Comptroller General**