

TRADE MARKS ACT 1994

**In the matter of application No 2141412
by Cine Cinema Cable
to register a Trade Mark in Class 38 and 41**

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION TO REGISTER TRADE MARK NO 2141412 IN CLASSES 38 And 41 IN THE NAME OF CINE CINEMA CABLE

On 31 July 1997, Cine Cinema Cable of Immeuble Quai Ouest, 42 Quai du Pont du Jour, 92100 Boulogne Billancourt, France, applied under the Trade Marks Act 1994 to register a trade mark consisting predominantly of the words Cine Classics in respect of:-

Class 38

Communication services including press and information agencies, communications services using radio telephone, telephone, telegraph and telematics and all teleprocessing means, by interactive videographics and particularly on terminals, computer peripherals or electronic and/or digital equipment and specifically videophones, visiophones and video-conferences; dispatch and transmission of releases and messages, broadcasting of television programmes and more generally multi-media programmes (computerised setting of texts and/or images, fixed or motion and/or of sound, musical or otherwise), for interactive usage or otherwise; radio and television programmes and more generally audiovisual and multimedia programmes (computerised setting of texts and/or images, fixed or motion and/or of sound, musical or otherwise) for interactive usage or otherwise; telex, telegram, teleprinter services, telematics information networks, telematics services for obtaining information contained in databases, services using all methods of communication and telecommunication providing information to the general public; communication services on computerised networks in general, communication services in the audiovisual, video and multimedia field, services for the transmission of information Contained in databases, computer, teleprocessing and telematics appliances and instrumentation rental services; information and advisory services relating Thereto.

Class 41

Teaching and training services; educational and entertainment services; cultural and sporting activities; services providing recreation for the general public (entertainment), correspondence courses; publication of texts, illustrations, books, reviews, newspapers, periodicals, magazines and publications of all types and in all formats, including electronic and digital publications; teaching and education for the initiation of perfecting of all subjects of general interest, seminars, courses and classes; organisation of conferences, forums, congresses and symposiums; production of television and radio programmes, audiovisual and multimedia programmes (computerised setting of texts and/or images, fixed or motion and/or of sound (musical or otherwise), for interactive usage or otherwise; publication of books, organisation of competitions, games and information campaigns and of events, professional or otherwise; television and radio information and entertainment programmes, audiovisual and multimedia programmes (computerised setting of texts and/or images, fixed or motion and/or of sound (musical or otherwise) for interactive usage or otherwise; shows, production and hire of films and cassettes including video

cassettes and more generally of all sound and/or visual media and of multimedia media (interactive discs, audio-digital ROM compact discs); publishing and publication service for all sound an/or visual media, for recording, transmission and reproduction of sound and/or images and of multimedia media (interactive discs, audio-digital ROM compact discs), publishing services for multimedia programmes (computerised setting of texts and/or images, fixed or motion, and/or of sound (musical or otherwise), for interactive usage or otherwise; lending of books and other publications, video libraries, games' libraries, services provided by a franchise-holder, basic staff training; information and advisory services relating thereto

Objection was taken under paragraphs (b) and (c) of Section 3(1) of the Act on the grounds that the mark consists predominantly of the words "CINE" (a combining form meaning motion picture) and "CLASSICS", being a sign which other traders may legitimately wish to use on, eg. Services relating to classic films. Objection was also taken under Section 3(6) on the grounds that the specification of services applied for in Class 41 is so wide that there is doubt whether the applicant is using, or intends to use the mark on all of the services applied for. The Registrar also questioned the inclusion of the term "Services provided by a franchise holder" as this was considered to be too imprecise for classification purposes.

At a hearing at which the applicants were represented by Mr Mark Hickey, of Castles, their trade mark agents, the objections under Section 3(1)(b)&(c) and Section 3(6) were maintained. 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.

Section 3(1)(b) & (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 the trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of the goods or services.

The mark consists of the words "CINE" in italics and lower case, the word "CLASSICS" in plain characters and in upper case, inserted in a diamond shape background covered with a mottled or "distressed" pattern. For ease of reference I have inserted an example of the mark below:-



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The pattern on the background makes the word “CINE” less prominent, but it is nonetheless able to be recognised. Collins English Dictionary (Third Edition updated 1994) contains the following entry for “CINE”:

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CINE: combining form, indicating motion picture or cinema; cine camera; cinematography

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Although noted as a combining form, “CINE” is also used as a word in its own right, usually in conjunction with another photographic or cinematographic description, such as “CINE FILM” or “CINE CAMERA”. When used in relation to particular services covered by this application, for example, broadcasting or entertainment, I take the view that the majority of persons in the United Kingdom would recognise the term as describing services related to cinematography, or more specifically, motion pictures. The term is descriptive of a characteristic of the services, and consequently, is devoid of any distinctive character.

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The word “CLASSICS” is by far the most prominent of the words. It is an ordinary English word in its own right and can also be the pluralised or possessive form of another ordinary English word “CLASSIC”. The most relevant meanings in Collins English Dictionary (Third Edition updated 1994) are:

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Classics The body of literature regarded as great or lasting, esp. That of ancient Greece or Rome.

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Classic: Of the highest class, esp in art or literature. Serving as a standard model of its kind; definitive.. Characterized by simplicity, balance, regularity, and purity of form; classical. Of lasting interest or significance. An author, artist or work of art of the highest excellence. A creation of work considered as definitive

The Registrars has a practice in relation to CLASSIC marks, which is as follows:

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CLASSIC

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Means "of the highest class esp. in art or literature" (Collins English Dictionary). The word is applied most often to works of literature and the fine arts but can be used to describe any object which displays artistic taste and style, for example cars. Given the purely laudatory meaning of CLASSIC and its widespread use, it must be regarded as a word which may be unregistrable. (1915 RPC 15 refers). However, like all marks under the 1994 Act , if the applicant can prove that the mark is factually distinctive it can be

registered. Trade evidence may be able to establish this for some goods/services.

The statement of grounds relating to application no. 1108537 for the mark CLASSIC in Class 21 is a source of reference. The decision of the Hearing Officer to refuse this application under the 1938 Act was upheld by Mr Justice Whitford in the High Court.

It is clear that the word “CLASSICS” is laudatory, and is used to describe works of literature or art that are considered to be of importance or of lasting interest or significance. The words are commonly used to describe goods and services relating to audio and visual entertainment and broadcasting, for example, motion pictures or television/radio shows from past years. This is a word which is prima facie devoid of any distinctive character

There is the question of whether the words “CINE” and “CLASSICS” in combination provide any degree of distinctiveness. I take the view that combining the words serves to indicate even more clearly that the service is related to cinematographic works from the past that are of high and lasting quality or importance.

This brings me to the matter of whether the background is a distinctive element in its own right, and if it is not, whether the mark as a whole has a distinctive character. The outer edge of the background is diamond in shape, which is not an unusual shape for backgrounds or borders in trade marks, and consequently, is considered to be devoid of any distinctive character.

The inner portion of the diamond is coloured black with a thin white border. The black centre portion has a “distressed” appearance with white showing through in patches. The words “CINE” and “CLASSICS” are placed centrally on the shape, the word “CINE” in lower case placed above the word “CLASSICS” in upper case. The “distressing” runs through and partly obliterates the words.

Mr Hickey's sole argument was the shape of the background and its distressed appearance gave the mark an aged appearance, and that this gave the mark sufficient distinctiveness to be registerable. The Registry's practice in relation to non-distinctive words with a graphical background can be found in Chapter 6, paragraph 3.2 of the Registry Work Manual, which reads as follows:

3.2 Non-distinctive words in a stylised form or with a graphical background

If a trade mark is sufficiently distinctive to be taken as a badge of origin (when first put into use) it will not be debarred from registration on the grounds that it contains non-distinctive elements. It does not matter whether the recognition of the sign as a trade mark arises from only a part of the trade mark or because the stylisation of some otherwise unregistrable word or sign.

It is likely that a trade mark which contains a distinctive element will be registerable prima facie. However, the question of whether the mark has a distinctive character should be posed in relation to the mark *as a whole*.

All factors must be considered including the size, prominence, positioning and impact of

the distinctive element. The more distinctive the element the less likely it is to be “lost” amongst other non-distinctive matter.

Where a word is presented in a stylised form or with a graphical background, the Registrar will consider:-

a) How strongly the meaning of the word(s) point away from the sign being a trade mark (usually how descriptive it is);

b) How strongly the stylisation or graphical background points towards the sign being a trade mark.

The test is whether the sign, because of the graphical element, is likely to be taken as a badge of origin without education of the public. The test is not (just) whether other traders will wish to use the same graphical form of the word(s).

The 24th German Appeal Senate (Court of first instance) has issued a decision on this point. The findings of foreign courts (or examination officers) are not binding upon the Registrar. However, as this is a decision of a court in a member state of the EU which relates to the interpretation of Article 3(1)b of the EU Directive (Section 3(1)(b) of the Trade Marks Act 1994), it is of persuasive value in interpreting the term “trade marks which are devoid of any distinctive character”.

A summary of the decision of the German Appeal Senate (GRUR 1996, Vol 5) is set out below:-

According to a decision of the twenty fourth senate, the *graphic form* of words incapable of protection may provide the necessary distinctiveness only if it provides a “*surplus*” which justifies protection. The necessary extent of that “*surplus*” would then depend upon the descriptive nature of the words in question. To that extent the pictorial design of a word mark would be less likely to provide its distinctiveness the more clearly a directly descriptive reference to the goods or services claimed could be recognised.

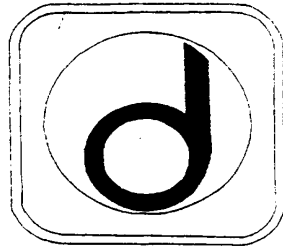
Accordingly, the mark depicted below for “body and beauty care products” was not sufficiently pictorially different from the word elements to be understood in the sense of the descriptive statement “colour collection”. (*in other words the stylised words were not sufficiently different from the words per se*).



In cases where the meaning

of the word(s) contained in a graphical mark is not so descriptive a smaller degree of visual impact would be required from the stylisation of graphical form of the mark, in order for the sign to be recognised as a trade mark. See the example below, which is considered to be just the right side of the line.

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Clothing, footwear, headgear
The Duffer of St George Ltd, 2nd Floor, 33 Old Street, London,
EC1V 9HX.

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Although this is close to being a single letter “d”, that element does not point away from the sign being a trade mark in the way that a pure description does. Place the words 'Top quality' in the above background (as below) and it would not be enough to turn the sign from a description, into a trade mark.

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I have already said that I take the view that the words “CINE” and “CLASSICS” are individually devoid of any distinctive character, and that combining them only serves to make their descriptiveness in relation to the services of this application more apparent. The question is whether the background gives the mark sufficient “surplus” to outweigh the descriptiveness of the words, so that when the words are placed upon it and the sign considered as a whole it is likely to be taken as a badge of origin without first educating the public.

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The shape of the background is prima facie devoid of any distinctive character. Mr Hickey has argued that the “distressing” gives the mark an aged look and that this gives it distinctiveness. The mark is represented in black and white, and the “distressing” in my view only gives the mark the appearance of a poor photocopy. I take the view that the graphical element is so lacking in any obvious distinctive character, when the words are placed upon it the background is likely to be regarded merely as a vehicle to contain the words. When considered as a whole, I do not believe that the sign has sufficient surplus to qualify prima facie for registration. In my view the mark is descriptive of a characteristic of the services and devoid of any distinctive character, and consequently, is excluded from registration by Sections 3(1)(b) & (c) of the Act

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At the hearing the agent argued solely on the registrability of the background. Mr Hickey did not seek to persuade me that the words were either individually or in combination distinctive, or that the combination of the words and the background created a distinctive whole. However, in a letter accompanying the Form TM5 requesting the Registrar to issue a statement of grounds of decision, the agent put forward these arguments. The letter also referred me to several previous registrations incorporating the words “CINE” or “CLASSIC” by other proprietors arguing that the mark applied for is equally distinctive and should be accepted. I have already given my views on the inherent distinctiveness of the mark applied for and there is nothing in the letter that alters my view. That leaves the matter of the state of the register. I am not aware of the circumstances surrounding the acceptance of the marks referred to in the letter, and in any event, each case must be considered on its own merits. Mr Justice Jacob commented in the TREAT decision:

“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the register. It has long been held that under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see MADAME trade mark [1996 RPC 541] and the same must be true of the 1994 Act. I disregard the state of the register evidence.”

Finally I turn to the objection to the application under Section 3(6) of the Act, which says:-

3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith..

This objection has been raised and maintained in relation to the breadth of the specification in Class 41.

On the application form for registration the agent has signed a declaration that “the trade mark is being used by the applicant, or with his or her consent, in relation to the goods or services stated, or there is a bona fide intention that it will be so used”. The specification shown for Class 41 covers all services to be found in that class. Such a specification is so wide that the Registrar has made it a matter of practice that the term would not be accepted without supporting evidence or a declaration. In Chapter 5 of the Work Manual the following is stated:

“Class 41 Wide claims should be justified. This includes “Amusement services”, “Education”, “Entertainment”, “Instruction”, “Teaching”, “Training” or “Tuition“ simply (either separately or in combination). Providing the type of entertainment is specified e.g. “Live entertainment” or “Musical entertainment” no objection should arise. Similarly in relation to “Educational services” if these are limited by subject or type, e.g. “Training in the use of computers” or “Primary school education” an objection should not normally be taken.”

In this case the applicants have sought registration in Class 41 for “Teaching and training services, educational and entertainment services, cultural and sporting activities and services providing recreation for the general public (entertainment)” at large, as well as a wide range of more specific

activities. Such a specification encompasses everything from “teaching English as a foreign language, to running an amusement park or arcade, to organising an athletics competition. No justification for this breadth of services has been put forward and without such justification I do not consider that it is reasonable to accept it. I find it difficult to envisage that even the largest of companies would be likely to supply all of the services for which registration is sought.

Consequent upon the above I determine that this application is debarred from registration under Section 3(6) of the Act in respect of the statement made about the intention to provide the services applied for in Class 41.

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) & (c) and Section 3(6) of the Act.

Dated this 15 day of January 1999

MIKE FOLEY
For the Registrar
The Comptroller General