

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION No 2220880
BY DAVID GRAHAM HIGGINS
TO REGISTER A TRADE MARK
IN CLASSES 9 16 35 38 41 AND 42**

DECISION AND GROUNDS OF DECISION

1. On 31 January 2000 David Graham Higgins of 5 Sorrells Close, Basingstoke, Hampshire, RG24 8TB applied under the Trade Marks Act 1994 for registration of a series of three hundred and fourteen marks in classes 9, 16, 35, 38, 41 and 42. Representations of these marks are attached at Annex A.

2. It was subsequently agreed that the specifications be amended to read as follows:

- | | |
|----------|--|
| Class 09 | Computer software; computer software development tools; computer programs and computer databases; computer software for application in the field of network and system management as well as for the development of further software; computer software for entering and retrieving information into and from the Internet and the World-wide Web; computer programs for using the Internet and worldwide web; computer software for access to Internet systems and for the use of said systems; computer software operating systems; graphic user interface routines, graphic user interfaces for computer circuits; data stored on data carriers and computer software encoders and decoders for electronic, magnetic and optical memorisation data; floppy discs; magnetic discs, optical plates, each with or without information recorded thereon; data protection apparatus; computer programs and operating systems stored on machine-readable data carriers; data carriers of all kinds with machine-readable computer programs; portable computer systems comprising operating system, network software and utility programs; entertainment apparatus as additional equipment for television sets or computers; operating and user instructions stored in digital form for computers and computer software, in particular stored on floppy disks or CD-ROM; sales units of computer programs; parts and fittings for the aforesaid. and computer software development tools; cd-roms, compact discs, pre-recorded audio and video tape and cassettes; on-line electronic publications (downloadable). |
| Class 16 | Printed matter. |
| Class 35 | Business management; business development; business administration; office functions; marketing; advertising and promotional services and information services relating to business management, business development, business administration; business information services; business services provided on-line from a computer database or the |

Internet; compilation of advertisements for use as web pages on the Internet; consultancy, advisory and information services for retail outlets carried out via a global computer network, on-line from a computer database or the Internet; consultancy, advisory and information services related to business management; providing start-up activities for businesses of others; business consultation services; new product and services development services; and business marketing consultation services; business research.

Class 38 Electronic data transmission over a global remote data processing network, including the Internet; on-line services, namely on-line services relating to computer software; electronic transmission of computer programs via the Internet; provision of access to data networks, in particular to the Internet, to Internet forums, to the world wide web and to server services; electronic mail services; telecommunications; collection and delivery of messages by electronic mail.

Class 41 Electronic data transmission over a global remote data processing network, including the Internet; on-line services, namely on-line services relating to computer software; electronic transmission of computer programs via the Internet; provision of access to data networks, in particular to the Internet, to Internet forums, to the world wide web and to server services; electronic mail services; telecommunications; collection and delivery of messages by electronic mail.

Class 42 Consultancy, namely consultancy relating to business management, consultancy relating to business project management, consultancy relating to computer management; legal services; business research; graphic design; graphic design for the compilation of web pages on the Internet; information provided on-line from a computer database or from the Internet; creating and maintaining web sites; hosting the web sites of others; installation and maintenance of computer software; leasing access time to a computer database; computer software design for others and computer consultation services.

3. Objection was taken to the application under Section 41(2) of the Act because the marks do not form a series of marks because they differ in material detail.

4. Objection was also taken under Section 3(6) of the Act but this was subsequently waived and I need make no further mention of it in this decision.

5. At a hearing, at which the applicants were represented by Mr Olsen of Field Fisher Waterhouse, their trade mark attorneys, the objection under Section 41(2) of the Act was maintained. The applicant was allowed time in which to make further submissions in support of this application. However, no further response was received and notice of refusal was issued on 11 October 2001.

6. Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

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

8. Section 41(2) of the Act reads as follows:

“41.- (2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.”

9. In order to satisfy the requirements of Section 41(2) of the Act all three hundred and fourteen marks must, while differing from one another, differ only in respect of matter of a non-distinctive character which does not substantially affect the identity of each mark, that is to say it's identity with each and every other mark in the group propounded as a series.

10. At the hearing Mr Olsen advised that all but the first seven marks of the three hundred and fourteen marks applied for are domain names but submitted that all marks consist of the distinctive letters and numerals EZ4 with the addition of suffixes which, in all instances, consist of approved domain name elements which do not affect the material particulars of the marks.

11. The Trade Marks Registry has developed a practice in relation to applications to register domain names as a series of marks. This is set out in a published Practice Amendment Circular (PAC 14/00). A copy of this PAC is attached at Annex B.

12. A domain name is an Internet electronic address and comprises two or more components. All of the marks contained in this application comprise or incorporate the letters and numeral EZ4 or letters EZ FOUR, in varying presentations, which are distinctive combinations. Apart from the first seven marks, all of the remaining three hundred and seven marks contain additional matter which are known as top level domains and second level domains. Internet domain names should be read from right to left. The reason for this is that the top level name is the most important and always appears on the right hand side. The characters appearing to the immediate left of the top level domain name comprise the second domain name and function as a qualifier to the top level domain name.

13 For ease of reference in this decision the marks in question may be described as falling into seven categories. The first category consist of the letters and numerals EZ4 in four different presentations with the second category consisting of the letters and word E-Z-FOUR in three different presentations. The third category consist of the letters and numeral EZ4 with the addition of the following domains: COM, NET and ORG. The fourth category consists of the letters and numeral EZ4 with the addition of two different letters. The fifth and sixth category consist of the letters and numeral EZ4 together with the letters CO or COM which are themselves followed by two different letters. The seventh category consist of the letters and numeral EZ4 together with two separate combinations of two different letters.

14 The marks identified as falling into the first two categories are letter and numeral combinations and do not form domain names.

15 The marks which fall in the third category consist of the letters and numeral EZ4 in combination with the letters COM, NET and ORG. All of these marks are intended to represent domain names. In these marks the top level domains denote different types of organisations. The letters COM indicate that it is the Internet address of a commercial enterprise, the letters NET are used to indicate the address of an Internet Service Provider and the letters ORG denote a charitable or non-profit-making organisation.

16 The fourth category consist of the letters and numeral EZ4 with the addition of two different letters. At the hearing Mr Olsen advised me that all of these two letter combinations denote a different country, the two letter combination being a abbreviation approved by the World Intellectual Property Organisation (WIPO) for the purposes of identifying particular countries.

17 The fifth and sixth category of marks again consist of the letters and numeral EZ4 in combination with the letters CO or COM which are themselves followed by two different letters. The two letter combinations in these marks are again intended to denote different countries with the letters CO and COM denoting that the domain name is the Internet address of commercial organisations.

18 The seventh category consists of the letters and numeral EZ4 together with two separate combinations of two different letters. I have not been advised of the significance of these particular combinations.

19 It must be noted that in all but the first seven marks, all of the additional elements are separated from the letters and numeral EZ4 by a "dot" character.

20 I am aware that countries may be identified by two letter codes. For the purposes of identifying the countries from which International convention priority may be claimed details of those countries, together with their two letter codes, are set out as Annex M to the Trade Marks Registry Work Manual, Chapter 9. This list was last updated in August 1999 and for ease of reference a copy is attached at Annex C.

21 Many of the suffixes contained within these marks may be well known to a substantial number of the relevant public but others may not be so well known. To a person who is aware of the meaning of -.COM.MX it will convey a different message to -.NET, -.ORG or -.GU.US. However, to those (probably greater number of) persons who do not know what -.COM.MX means, it will suggest itself as an arbitrary addition to the letters and numeral EZ4 and hence add to the distinctive character of that sign alone. Other marks may, for different reasons, impart different messages to different members of the relevant public. On encountering marks such as EZ4.CO.HU, EZ4.CO or EZ4.CO.CK those with a knowledge of domain names may interpret these marks differently from those without such knowledge. Some members of the relevant public may interpret the letters CO as denoting an Internet address of a commercial organisation whereas others may identify it as a two letter code for the country Columbia. Others with little or no knowledge of domain names may see the letters CO simply as two ordinary letters from the alphabet and place no interpretation on them other than that they are an arbitrary addition to the letters and numeral EZ4 and simply enhance the

distinctive character of that sign.

22 In my view the suffixes contained within these marks substantially affect the identity of the marks.

23 At the hearing Mr Olsen voluntarily offered to enter disclaimers of the suffixes in all of the marks. For ease of reference the Registrars practice in respect of voluntarily disclaimers is attached at Annex D.

24 In my view all of these marks must be judged in their totality and I do not accept that the entering of a disclaimer in respect of selected elements within the marks will have any effect on this decision. No disclaimer has yet been entered but in my judgement, should such voluntary disclaimers be entered in respect of any of the marks contained in this application, it will not assist me in reaching my conclusion as to whether this application should be accepted or refused.

25 Given the differences between the marks applied for and the fact that they contain codes relating to different types of activities, to different types of organisations and to what may be different countries, the meaning of which would not be apparent to the average consumer, I am satisfied that the marks contained within this application differ as to their material particulars in such a way that they do not satisfy the requirements of section 41(2) of the Act.

26 In this decision I have considered all of the documents filed by the applicants and all of 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 in that it fails to qualify under Section 41(2) of the Act.

Dated this 05 day of December 2001

A J PIKE
For the Registrar
The Comptroller General

Annex A: Order a copy

Annex B: Order a copy

Annex C: Order a copy

ANNEX D

Disclaimers

These are covered by Section 13(1)(a), and the wording is such that they are voluntary.

Unlike the power conferred by Section 14 of the 1938 Act, the Registrar will no longer be able to request a disclaimer of an objectionable element in a mark. It will however be open to the applicant to voluntarily enter a disclaimer. The most likely circumstances of this happening are as a result of opposition proceedings, but requests may be made at the initial application stage by applicants wishing to forestall opposition in due course.

Against this background examiners will be guided by the following principles:

Marks which would have been acceptable under the 1938 Act with disclaimed elements should be accepted without disclaimers under the 1994 Act.

The above applies equally to marks which consist entirely of descriptive/non-distinctive elements but where the totality forms an acceptable combination (that is to say marks which would only have been accepted on separate disclaimers in the past).

It follows that the offer of a disclaimer will not, in itself, influence the decision on the acceptability of a mark, and a disclaimer should only be accepted if volunteered by an applicant or an agent.

Where a disclaimer is requested by an applicant it will be for the applicant or his agent to provide the necessary wording. It will be accepted without editing, but if obvious errors are spotted, they should be brought to the attention of the applicant/agent. (See Chapter 9 for an example of wording that may be suggested to an applicant if he requires assistance).