

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2263691
BY BASS PUBLIC LIMITED COMPANY
TO REGISTER A TRADE MARK IN CLASSES 41 AND 42**

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DECISION AND GROUNDS OF DECISION

On 9 March 2001 Bass Public Company Limited of 20 North Audley Street, London, W1Y 1WE, applied to register the trade mark shown below in classes 41 and 42.



The application consists of a series of two marks and the following colour claim was entered on the form of application

"The applicant claims the colours purple, yellow and white as an element of the first mark in the series."

The services for which registration is sought are as follows:

Class 41 Entertainment Services; provision of play rooms and games rooms, music and live music entertainment, provision of leisure and recreation facilities; amusement services; organisation of competitions; nightclub services and facilities; organisation of parties and provision of facilities for parties.

Class 42 Public House services; bar services; café services; hotel services, restaurant and snack bar services; catering, catering services for the provision of food and drink.

Objection was taken under Section 3(1)(b) of the Act because the mark consists of the non-distinctive device of a star and the laudatory words "top choice" being devoid of any distinctive character for e.g. goods or services that are regarded as being superior to those of other competitors in the market place.

At a Hearing, at which the applicants were represented by Mr Baker of Trade Mark Owners Association Limited, their trade mark attorneys, the objection was maintained and the application was subsequently refused in accordance with Section 37(4) of the Act.

Following refusal of the application 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.

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

Section 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,

The applicants representative submitted in correspondence with the examiner and by way of argument at the Hearing that the mark was not devoid of any distinctive character. He referred to the combination of elements which made up the mark and to the colour claim on the first mark in the series.

This argument did not persuade me that the mark was not devoid of any distinctive character.

The application is for the words TOP CHOICE on a star shaped background with the device of a small star above the word "top". The first mark in the series is represented in three colours which are claimed as an element of the mark.

Collins English Dictionary (Third Edition 1994) defines "top" as:-

"The best or finest part of anything."

In the same dictionary, included in the definition of "Choice" is:-

"A person or thing chosen or that may be chosen."

It is apparent from the meaning of both words that when used together in relation to the services claimed they would indicate that the services were claiming to be of a superior nature and I consider this to be reinforced by the use of a star device. In addition from my own

knowledge I am aware that star devices are commonly used in the entertainment trade as background carriers of descriptive information.

I have considered the individual elements of the mark, and even when taken in combination, I take the view that the mark as a whole is devoid of any distinctive character.

The test for distinctiveness was laid down by Mr Justice Jacob in the TREAT case [1996] RPC 281.

"Next, is "TREAT" within Section 3(1)(b). What does *devoid of 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 further 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 Mr Justice Jacob was specifically referring to a word mark, he makes it clear that the same considerations apply to other signs. In my view the applicants' mark is the type of sign falling within the category of marks which have to acquire a distinctive character before being able to function as an indication of origin.

In the "Cycling IS..." decision (series of two marks), dated 28th November 2001 and as yet unreported, Geoffrey Hobbs QC as Appointed Person made the following comments:

"66. *That brings me to the question of whether the signs possess a distinctive character enabling them to fulfil the essential function of a trade mark in relation to goods and services of the kind specified in the application for registration. (The goods and services comprise "clothing, footwear and headgear" in Class 25 and "advertising, all relating to the cycling industry" in Class 35).*

67. *The case for allowing registration rests upon the proposition that the signs are cryptic to a degree which makes it more likely than not that they would carry connotations of trade origin (whatever other connotations they might also carry) in the minds of the relevant class of persons or at least a significant proportion thereof.*

68. *The case for refusing registration rests upon the proposition that the signs are visually and linguistically meaningful in a way which is more likely than not to relate the goods and services to the activity of cycling without also serving to identify trade origin in the minds of the relevant class of persons.*

69. *The difference between these two positions resides in the question whether the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin specific or origin neutral.*

70. *The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect.*

71. *I do not suppose that such a person would pause to construe the signs when encountering them in any of the different settings (including advertising and promotional settings) in which they might be used. Even so, the degree of attention required to take note of the signs in the first place would be sufficient, in my view, to leave a well-informed and reasonably observant and circumspect person with the clear impression that the signs were being used with reference to goods and services related to cycling."*

Mr Hobbs went on to observe:

"73. Doing the best I can on the materials before me, I think that the signs in question would be perceived by the relevant class of persons as pronouncements in identifying cycling as the raison d' être for the marketing of the goods and services to which they are related. That is a message that the members of a consortium of bicycle retailers might naturally be interested in putting across to customers and potential customers. I do not think that the nature of the pronouncement or its presentation can in either case be regarded as sufficiently striking to function as an indication of trade origin in relation to goods or services of the kind specified in the application for registration that is now before me.

74. It seems to me that the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin neutral (relating to the general commercial context of the relevant trading activities) rather than origin specific."

In relation to this mark, I take the view that it would likely be perceived by the average consumer as being origin neutral rather than origin specific when viewed in the context of all the goods or services contained in the application. The mark cannot function in the prima facie as an indication of trade origin and therefore under Section 3(1)(b) of the Act I conclude that it is devoid of any distinctive character.

In this decision I have considered all documents filed by the agent, and for the reasons given the application is refused under the terms of Section 37(4) of the Act because the mark fails to qualify under Sections 3(1)(b) of the Act.

Dated this 10th day of May 2002.

Ian Peggie
For the Registrar
the Comptroller General