

O-008-04

**TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION No 2313605
BY SOUTHALL TRAVEL LIMITED
TO REGISTER A TRADE MARK
IN CLASSES 39, 41 AND 43**

DECISION AND GROUNDS OF DECISION

Background

1. On 18 October 2002 Southall Travel Limited of Palmoak House, 19 South Road, Southall, Middlesex, UB1 1SU applied to register the trade mark **HOLIDAY TEAM** in classes 39, 41 and 43.
2. The amended specifications of services are:

Class 39

Transport and storage; transport of persons and goods, in particular by road, rail, water and air; portage; guarded transport of money and valuables; arranging, booking and arrangement of travel, excursions and cruises; organising transport services; organising, booking and arrangement of tours, excursions and sightseeing; travel consultancy and personal chaperoning of travellers; rental, booking and arrangement of aeroplanes, rental, booking and arrangement of boats, in particular rowing boats and motor boats, yachts and canoes, rental, booking and arrangement of motor vehicles and bicycles, horses, diving equipment; packaging and storage of goods; parcel delivery; organisation of tours, sightseeing, holiday camps and holidays; travel agency services (included in Class 39), in particular consultancy and booking of travel, provision of travel information, arranging of transport and travel; reservation services (included in Class 39) for sporting, scientific, political and cultural events; online information, reservation and booking services in the field of tourism and business travel (online travel agencies); traffic information services; location of vehicles by computer; all the aforesaid services, in particular in the field of travel and leisure.

Class 41

Providing of training and further training and education consultancy; instruction, in particular correspondence courses and language instruction; entertainment; film and video production, film and video rental, film and video showings; artist management; artists' services; musical performances; circus performances; public entertainment; theatre productions; arranging and conducting of after-school childcare; organising sports lessons and language instruction, film showings and musical performances; health club services, training club and fitness studio services, providing golf facilities, tennis court and riding facilities, nursery schools, cinemas, discotheques, museums, amusement arcades, sports camps, sports facilities and amusement parks;

organization of sports competitions; arranging and conducting of sporting and cultural events; reservation services (included in Class 41) for sporting, scientific, political and cultural events; rental of films, data carriers, projection apparatus and accessories; lending and distribution of newspapers and periodicals, publication of books, newspapers, periodicals and other printed matter, and of electronic media, including CD-ROMs; publication of printed matter, in particular books, periodicals, catalogues and newspapers in the field of business and leisure; videotaping (production); organization of exhibitions for cultural or educational purposes; leisure centres and amusement parks in the field of education and entertainment; production of radio and television programmes; television and radio entertainment, interpreting and translation services, photography.

Class 43

Provision of accommodation, food and drink; accommodation services; arranging and rental of holiday homes, tourist homes and apartments; room and hotel reservation services, hotels motels, saunas, spas, swimming pools.

3. Objection was taken under Section 3(1)(b) and (c) of the Act because the mark consists exclusively of the words HOLIDAY TEAM, being a sign which would not be seen as a trade mark as others in the trade may wish to use it, e.g. services relating to holidays/travel provided by a team of people.

4. At a hearing, at which the applicants were represented by Mr Jennings, the objection was maintained.

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

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

The Law

7. Section 3(1)(b) and (c) of the Act reads 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, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,”

The case for registration

8. In correspondence prior to the hearing, and at the hearing itself, Mr Jennings placed great reliance on the fact that there are numerous trade marks on the register which incorporate the word TEAM. Some of these are stylised and/or contain additional matter. At the hearing Mr Jennings provided me with details of these registered marks. For the sake of convenience details of these are attached at Annex A.

9. Mr Jennings submitted that the words HOLIDAY TEAM are a meaningless combination which does not describe the services applied for. I suggested to Mr Jennings that the words HOLIDAY TEAM are words which other traders would legitimately wish to use when advertising their services. In support of this I suggested the following example of such use: “Our holiday team is here to advise you”.

Decision

10. In a judgement issued by the European Court of Justice on 20 September 2001, *Procter & Gamble Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case - 383/99P, (the BABY-DRY case), the Court gives guidance on the scope and purpose of Article 7(1)(c) of the community Trade Mark Regulation (equivalent to Section 3(1)(c) of the Trade Marks Act). Paragraphs 37, 39 and 40 of the judgement are reproduced below:

“37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Procter & Gamble and the OHIM acknowledge, to prevent registration as trade marks signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function.”

“39. The signs and indications referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other sign or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.”

“40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their

essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”

11. These paragraphs indicate that marks which may serve in trade to designate the relevant goods or services or their characteristics are now debarred from registration by Section 3(1)(c) of the Act. This is confirmed by the Judgement of the European Court of Justice in *Joined cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003). Paragraphs 73 and 74 of the judgement are reproduced below:

“73. According to the Court’s case law, Article 3(1)(c) of the directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, to that effect, *Windsurfing Chiemsee*, paragraph 25).

74. The public interest underlying Article 3(1)(c) of the Directive implies that, subject to Article 3(3), any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristic of goods or a service within the meaning of that provision must be freely available to all and not registrable.”

12. The primary definition of the word TEAM in Collins English Dictionary (5th. Edition first published 2000) is:

“a group of people organized to work together.”

13. The word HOLIDAY is a very well known word and, in relation to the services applied for, it will be recognised by all as meaning a period away from work which often includes travel to a different location for a short period of time. There are many individuals and groups who provide services relating to the provision and organisation of holidays. These services may include the organisation of travel to the holiday destination, the provision of accommodation for the duration of stay, the provision of meals and the provision of related services such as sporting activities, sightseeing trips, musical entertainment, car and boat hire and the provision of guidance and advice on any problems their clients may face. Providers of such services are numerous and each face, and must deal with, intense competition from each other. One way in which they may do this is to advertise their services. Such advertisements may be placed in the local or national press, on radio and television or on web-sites. Such traders may well wish their advertisements to indicate that they can offer a variety of services from a collection of well trained and organized individuals who function together as a team. I consider it a genuine likelihood that traders would refer to themselves as a holiday team. Most advertisements now provide contact details and I see nothing unusual in traders using statements such as “Contact our holiday team on” or “Our holiday team is here to advise you”.

14. The words HOLIDAY TEAM would, in my view, be instantly recognised by the relevant consumer as an indication that the services are provided by a group of people organized in such a

way that they can provide a range of services relating to holidays. I make no distinction between the different services of the application in suit because they are all part of the same commercial context.

15. As far as the registered marks referred to by Mr Jennings are concerned (Annex A) I do not accept that they are of any direct relevance in deciding the issues pertinent to this application.

16. Consequently, I have concluded that the mark applied for consists exclusively of a sign which may serve in trade to designate the kind and intended purpose of the goods and services and is, therefore, excluded from registration by Section 3(1)(c) of the Act.

17. Having found that this mark is to be excluded from registration by Section 3(1)(c) of the Act that effectively ends the matter but in case I am found to be wrong in this decision I will go on to determine the matter under section 3(1)(b) of the Act.

18. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 46 to 47 of its Judgment in *Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

“37. It must first of all be observed that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule 1 Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see Philips, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 Gut Springenheide and Tusky [1998] ECR I-4657, paragraph 31, and Philips, paragraph 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

19. In my view the relevant public, bearing in mind that services in relation to the provision of holidays are in common supply via a large number of individuals and organisations, would not consider this mark to denote trade origin. I am not persuaded that the combination of the words HOLIDAY TEAM is sufficient, in terms of bestowing distinctive character on the sign as a whole, to conclude that it would serve in trade to distinguish the goods and services of the applicants from those of other traders.

20. In my view, even if the words HOLIDAY TEAM in combination are found not to be a designation of a characteristic of the services, but are found to be a term liable to be used in trade to designate characteristics of the undertaking providing the services, then this is sufficient to justify an objection under Section 3(1)(b) of the Act in the alternative to the objection under Section 3(1)(c). This is because a sign viewed as above will not be considered as a sign which distinguishes the services of one undertaking from another.

21. In my view the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

Conclusion

22. In this decision I have considered all the documents filed by the applicants 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 8th day of January 2004

A J PIKE
For the Registrar
The Comptroller General

ANNEX A