

O-406-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3014409
BY
PERTSHIRE MOTOR HOMES LTD
TO REGISTER THE TRADE MARK**

Perthshire Motorhomes

IN CLASSES 35 AND 39

AND

**THE OPPOSITION THERETO
UNDER NO 401259
BY
PERTSHIRE CARAVAN COMPANY (MOTORS) LIMITED**

Background and pleadings

1. Perthshire Motor Homes Ltd (“the applicant”) has applied to register the trade mark Perthshire Motorhomes in classes 35 and 39 for:

Class 35: Wholesaling, retailing and mail order, including via the Internet, connected with the sales of motor homes; Consumer advice in relation to purchasing motor homes, caravans and camping articles; Arranging of trade fairs, for commercial or advertising purposes, in the fields of motor homes, caravans and camping articles; Arranging of contracts, for others, for the buying and selling of motor homes, caravans and camping articles; Arranging of contracts, for others, for the providing of services in the fields of motor homes, caravans and camping articles.

Class 39: Rental of motor homes, caravans and camping articles; Arranging of and consultancy in relation to motor home trips, camping trips and tours.

2. The application was filed on 18 July 2013.

3. Perthshire Caravan Company (Motors) Limited (“the opponent”) objects to Perthshire Motorhomes achieving registration on several grounds:

i) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), the claim is that there would be a likelihood of confusion with its trade mark registration, number 3012642, for Perthshire Caravans;

(ii) under section 5(3), the claim is that the use of the applicant’s mark would take unfair advantage of, and be detrimental to, the distinctive character and repute of the opponent’s trade mark, 3012642;

(iii) under section 5(4)(a), the claim is that use of the applicant’s mark amounts to passing off of the opponent’s business, which has been conducted in the UK since 1936 under the sign Perthshire Caravans, for goods and services corresponding to those for which 3012642 is registered;

(iv) under section 3(1)(b), the claim is that the mark is devoid of any distinctive character;

(v) under section 3(1)(c), the claim is that the mark is descriptive both of the nature of the services and the place from which the services are provided.

4. The opponent’s registration, Perthshire Caravans, was applied for on 4 July 2013, which makes it an earlier trade mark under section 6 of the Trade Marks Act 1994 (“the Act”):

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in

question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b) a Community trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK),

(ba) a registered trade mark or international trade mark (UK) which-

(i) has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

(ii) accordingly has the same claim to seniority, or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no bona fide use of the mark during the two years immediately preceding the expiry.”

5. The opponent relies upon classes 35 and 39 of its earlier mark for its section 5(2)(b) ground; it relies upon all the registered goods and services for its section 5(3) ground; and, for its section 5(4)(a) ground, the opponent relies upon goods and services couched in identical terms to the goods and services of its trade mark registration:

Class 3: Cleaning and polishing preparations for caravans and motor homes; caravan cleaner; caravan polish; caravan wash and wax; caravan toilet fluids.

Class 35: Retail services connected with the sale of caravans and motor homes; the bringing together for the benefit of others of a variety of caravans and motor homes, and parts, fittings and accessories therefor, enabling customers conveniently to view and purchase those goods; the arranging of contracts, for others, for the buying and selling of motor homes and caravans, and parts, fittings and accessories therefor; the provision of consumer advice relating to the purchasing of motor homes and caravans and parts, fittings and accessories therefor.

Class 36: Insurance services in connection with caravans and motor homes; the arranging of contracts, for others, for the purchase of insurance relating to

caravans and motor homes; the provision of consumer advice relating to the purchasing of insurance relating to caravans and motor homes.

Class 37: Repairing, servicing, modifying and maintaining of caravans and motor homes.

Class 39: Rental services in connection with caravans and motor homes; the arranging of contracts, for others, for the rental of caravans and motor homes; the provision of consumer advice relating to the rental of caravans and motor homes.

6. The applicant filed a counterstatement, making a number of points, including:
- If the opponent has been trading since 1936, why had it not registered its trade mark until now?
 - There is no passing off because there is no strong likelihood that the applicant's customers will believe that they are dealing with the opponent;
 - Although both names are slightly similar, the products are very different (caravans and motorhomes);
 - The applicant only operates in the sale of motor homes and has "never operated in the rental or hire of motor homes";
 - In relation to sections 3(1)(b) and (c), this must also apply to the opponent's mark. If the application is refused on these grounds, then the opponent's mark should also be refused: "...we would accept the decision of the IPO provided that the Perthshire Caravans did not receive the Trade mark either".

7. The opponent is represented by a firm of solicitors, Thorntons Law LLP, and the applicant is self-represented. Neither party opted to be heard on the substantive merits of the opposition. The opponent filed evidence, written submissions alongside its evidence, and very brief written submissions in lieu of a hearing. The applicant did not file evidence or written submissions. I make this decision after a careful reading of all the papers filed by both parties.

The opponent's evidence

8. Ian McCormack has been a director of the opponent since 1988 and gives his evidence in a witness statement dated 23 April 2014. He states that there has already been confusion, which has taken place after the date of application. The magazine *Practical Motorhome*, awarded the Silver Award for 'New Motorhomes: Direct Sales' to the opponent, but mistakenly sent the award to the applicant, a mistake which was subsequently rectified¹.

9. Mr McCormack states that the opponent's reputation is long-established, having been built up since 1936 in relation to caravans and motor homes in the Perthshire

¹ Exhibits IM1 and IM2.

area and throughout the UK under the name Perthshire Caravans. Mr McCormack states that the opponent's reputation is such that Scottish Highways Authority erected "Perthshire Caravans" road signs in the opponent's locality (Errol) in 2003², visible from the A90.

10. Exhibits IM5, IM6 and IM7 include examples of advertising from 2002 (*The Courier and The Sun*) and 2003 (*The Sunday Times*). Mr McCormack states that a fire in 2009 destroyed the opponent's premises, including its documentation located on the premises. He states that this has prevented the opponent from being able to provide a significant portion of material showing its repute back to 1936. Mr McCormack exhibits at IM8 and IM9 newspaper articles reporting the huge fire and the opening of the new premises in 2010. I note from the photograph of the new premises that the showroom is of a considerable size and that the article says that it is probably the largest covered caravan and motor home showroom in the UK. The article also refers to the opponent as a dealer for the Swift Group, Bailey and Elddis caravans, and motor homes by Auto-Sleepers, Auto-Trail, Burstner, Elddis, Escape, Excel, Mondial, Romahome, Swift and Tribute.

11. Mr McCormack states that the opponent's websites feature the mark and advertise its services on a national scale. Further, the mark is featured in relation to the opponent's business across a range of supplier websites, such as Elddis, Auto-Sleepers and Bailey of Bristol, Exhibits IM10, IM11 and IM12. In IM10, there is a pop-up window on the Elddis website under the heading 'Find a Retailer', which says "Perthshire Caravans and Motorhomes", with the opponent's address. The other two exhibits show something along similar lines.

Decision

12. Section 5(2)(b) of the Act states:

"(2) A trade mark shall not be registered if because –

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

13. The leading authorities which guide me in relation to section 5(2)(b) of the Act are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) C-334/05 P (LIMONCELLO). It is clear from these cases that:

² Photographs of the road signs are shown in Exhibit IM4.

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

14. The opponent's mark predates the filing date of the application by a fortnight, which makes it an earlier mark, as set out above in section 6 of the Act. The applicant's counterstatement raises a 'sauce for the goose, sauce for the gander' point; namely, that if the application is refused under sections 3(1)(b) and (c) of the Act, then so, too, should the opponent's mark be refused under those grounds. It must be understood, however, that the opponent's mark is registered. The fact of registration is *prima facie* evidence of validity, as per section 72 of the Act, which states:

"In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be *prima facie* evidence of the validity of the original registration and of any subsequent assignment or other transmission of it."

15. It is, therefore, not open to the applicant as part of this opposition to challenge the validity of the registered mark.

16. Since the opponent's trade mark is both earlier than the application (as per section 6(1)(a)) and is deemed to be valid (section 72), it may be relied upon for its opposition under section 5(2)(b) (and section 5(3) of the Act).

Average consumer and purchasing process

17. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. The assessment of the nature and purchasing behaviour of the average consumer is to be carried out according to the notional scope of the parties' specifications. The average consumer for the retailing of caravans and motor homes is the general public (legally able to drive). Purchasing caravans and motor homes is an expensive, considered process³, so the selection of a retailer of such expensive goods will be one to which a good level of attention will be paid. A good degree of attention will be paid in the case of rental of caravans and motor homes to ensure that the vehicle meets the hirer's requirements. The purchase of the services is visual, in the research and the examination of the retailer and the vehicles available, although I bear in mind that there will also be an aural aspect (e.g. during discussion with a dealer or vendor).

18. The average consumer for the applicant's arranging of trade fairs, for commercial or advertising purposes, in the fields of motor homes, caravans and camping articles are the retailers of such goods and a relatively high degree of attention will be paid owing to the cost and time expended in attending such events.

³ The advertisements in the opponent's evidence include a motor home for close to £60,000.

Comparison of services

19. The parties' specifications must be considered for what they notionally cover, not what either mark has actually be used upon; as per *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*⁴, in which the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. I note that the applicant's counterstatement says:

"...we would like the opposition to note that Perthshire Motor Homes only operate in the sale of motor homes and have never operated in the rental or hire of motor homes".

20. The applicant has included rental of motor homes in Class 39. It is not entirely clear what effect the applicant meant this statement to have, but for present purposes it suffices to say that the applicant, if it were to obtain the registration which it now seeks, would have a trade mark registration which covers rental of motor homes.

21. I show below the competing specifications of the parties' marks:

Opponent	Applicant
<i>Class 35: Retail services connected with the sale of caravans and motor homes; the bringing together for the benefit of others of a variety of caravans and motor homes, and parts, fittings and accessories therefor, enabling customers conveniently to view and purchase those goods; the arranging of contracts, for others, for the buying and selling of motor homes and caravans, and parts, fittings and accessories therefor; the provision of consumer advice relating to the purchasing of motor homes and caravans and parts, fittings and accessories therefor.</i>	<i>Class 35: Wholesaling, retailing and mail order, including via the Internet, connected with the sales of motor homes; Consumer advice in relation to purchasing motor homes, caravans and camping articles; Arranging of trade fairs, for commercial or advertising purposes, in the fields of motor homes, caravans and camping articles; Arranging of contracts, for others, for the buying and selling of motor homes, caravans and camping articles; Arranging of contracts, for others, for the providing of services in the fields of motor homes, caravans and camping articles.</i>
<i>Class 39: Rental services in connection with caravans and motor homes; the arranging of contracts, for others, for the rental of caravans and motor homes; the provision of consumer advice relating to the rental of caravans and motor homes.</i>	<i>Class 39: Rental of motor homes, caravans and camping articles; Arranging of and consultancy in relation to motor home trips, camping trips and tours.</i>

22. As per the judgment of the General Court ("GC") in *Gérard Meric v Office for Harmonisation of the Internal Market (OHIM)*, Case T-133/05, services can be

⁴ Case C-533/06.

considered as identical when the services of the earlier mark are included in a more general category, included in the specification of the trade mark application. Vice versa, if the services of the application are included in a more general category included in the specification of the earlier mark, they must be identical. With the exception of *arranging of trade fairs, for commercial or advertising purposes, in the fields of motor homes, caravans and camping articles*; the parties' specifications are identical in meaning and effect. Consequently, except for *arranging of trade fairs, for commercial or advertising purposes, in the fields of motor homes, caravans and camping articles*, the applicant's services are identical to the opponent's services.

23. Retailing or rental of goods (or services) is not the same as arranging a trade fair at which retailers appear as participants. The purpose of retail is to sell something. The purpose of arranging a trade fair is to enable the trade fair to take place. The consumers of the retail service are the general public, whilst the consumers of the arranging of a trade fair are the retailers. The services are not in competition, are not complementary, and do not share trade channels. The applicant's *arranging of trade fairs, for commercial or advertising purposes, in the fields of motor homes, caravans and camping articles* are not similar to the opponent's services.

Comparison of trade marks

24. The marks to be compared are:

Opponent's mark	Applicant's mark
Perthshire Caravans	Perthshire Motorhomes

25. The authorities cited earlier in this decision direct that, in making a comparison between the marks, I must compare each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details, as per *Sabel BV v Puma AG*, paragraph 23:

“That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their dominant and distinctive components.”

26. There is a reasonable level of visual and aural similarity between the marks because the first half of each mark, Perthshire, is identical. Perthshire is the first element which will be seen and spoken. This gives it some dominance over Caravans/Motorhomes. Conceptually, the two marks share the geographical meaning of Perthshire. The applicant submits in its counterstatement that caravans and motor homes are “two very separate products”. I disagree. Caravans and motor homes use the same campsites and are used by people wishing to tour campsites in

more comfort than in a tent. They are fitted out inside in similar ways. Although there is some conceptual difference, in that a motor home is a caravan with an integral vehicle, rather than being towed by a separate vehicle, there are more conceptual similarities than differences as both are touring vehicles for holidays. There is a high degree of conceptual similarity. Overall, there is a good deal of similarity between the parties' marks.

Distinctiveness of the earlier mark

27. I need to consider the distinctive character of the opponent's mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

28. The opponent submits that Perthshire Caravans may be inherently descriptive of the kind and geographical origin of the opponent's services, but that the opponent considers that its use of the mark has meant that it has acquired distinctiveness. The acceptance of the opponent's mark for registration was on the basis of distinctiveness acquired through use of the mark. From the opponent's admission in relation to inherent distinctiveness, it follows that any enhancement of distinctive character through use starts from a very low base. It is unfortunate that the opponent's business suffered a devastating fire in 2009 which destroyed documentation held at the premises. It is clear from the exhibits that there was a business in 2002/3 and there was still one in 2009. Further, there was a business large enough to rebuild at a cost of £1.7 million pounds to become the largest undercover caravan showroom in the UK, in 2010. I think that, in Scotland, the opponent was well-known at the relevant date (18 July 2013) as a caravan dealer.

29. Registered trade marks give national, not local, rights; they allow their owners to restrain the use of other's signs and marks throughout the UK. Accordingly, if trade

mark owners intend to claim the benefit of enhancement to distinctive character obtained through use, that use must be more than local. Otherwise, a national monopoly is obtained which is unjustified⁵ and unfair.

30. The opponent's evidence is insufficient to demonstrate enhanced distinctiveness. Although, understandably, pre-fire documentation was lost, the opponent could have put in evidence from between 2009 to 2013 demonstrating the use and reputation of the mark. There are no turnover figures, but that is not fatal if other evidence builds a picture. Invoices would have shown whether the sales under the mark are local or national. The three exhibits which show that third party websites have a search facility, whereby one enters a postcode and finds a local dealer (including the opponent), does not suggest to me that people from outside Scotland source their caravans from the opponent.

31. The fact that the opponent's mark was accepted on the basis of use means that it filed evidence of use at the *ex officio* (examination) stage. That evidence was not adopted for these proceedings. I note that the witness statement on the examination file (from Mr McCormack) states "I believe that our market share in relation to the caravans and motor homes business in Scotland would be in the region of 30%". This statement confirms my view that the evidence filed in these proceedings does not permit me to find an enhanced level of distinctive character UK-wide. In conclusion, there is no enhanced distinctive character for the purposes of this opposition.

Likelihood of confusion

32. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified. This includes keeping in mind the whole mark comparison, because the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. It also includes the principle of interdependency, whereby a lesser degree of similarity between the services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). In these proceedings, I have found that the parties' services are either identical or not similar. Where goods or services are not similar, there can be no likelihood of confusion⁶. Accordingly, the section 5(2)(b) ground fails in respect of *arranging of trade fairs, for commercial or advertising purposes, in the fields of motor homes, caravans and camping articles*.

33. There is a real possibility of confusion between the marks. The services are identical, the first half of the marks are identical and the second element in each mark is the name of the goods retailed or rented, which are sold side by side in caravan/motor home dealerships. The average consumer will assume that the services derive either from companies which are linked economically (one specialises in caravans, the other in motor homes) or that it is the same company, with separate caravan and motor home divisions. If I am wrong about the level of

⁵ See the comments of Mr Richard Arnold QC, sitting as the Appointed Person, in *The Journal Trade Mark*, BL O/273/08, available on the IPO website.

⁶ CJEU Case C-398/07 *Waterford Wedgwood plc v OHIM*.

attention that consumers will give to the two marks, then confusion will be of the direct sort: the marks will be imperfectly recollected on account of the descriptive second elements which are so conceptually similar. **The opposition succeeds against the application under section 5(2)(b) except for arranging of trade fairs, for commercial or advertising purposes, in the fields of motor homes, caravans and camping articles.**

34. The opponent submits that its own mark, Perthshire Caravans, may be inherently descriptive, a view shared by the examiner prior to accepting the opponent's mark on distinctiveness acquired through use. In the same way as the opponent's mark consists of the geographical location of its services plus the name of the goods to which those services relate, so too does the application for Perthshire Motorhomes. Section 3(1)(c) provides:

“3.— (1) The following shall not be registered –

- (a) ...
- (b) ...
- (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,
- (d) ...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

35. The leading authority in relation to geographical names and section 3(1)(c) of the Act is the judgment of the CJEU in *Windsurfing Chiemsee Produktions-und Vertriebs GmbH (WSC) v Boots-und Segelzubehor Walter Huber and Franz Attenberger* (Joined cases C-108/97 and C-109/97) (“Windsurfing”):

“24. It should first of all be observed that Article 3(1)(c) of the Directive provides that registration is to be refused in respect of descriptive marks, that is to say marks composed exclusively of signs or indications which may serve to designate the characteristics of the categories of goods or services in respect of which registration is applied for.

25. However, 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 categories 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.

26. As regards, more particularly, signs or indications which may serve to designate the geographical origin of the categories of goods in relation to which registration of the mark is applied for, especially geographical names, it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response.

27. The public interest underlying the provision which the national court has asked the Court to interpret is also evident in the fact that it is open to the Member States, under Article 15(2) of the Directive, to provide, by way of derogation from Article 3(1)(c), that signs or indications which may serve to designate the geographical origin of the goods may constitute collective marks.

28. In addition, Article 6(1)(b) of the Directive, to which the national court refers in its questions, does not run counter to what has been stated as to the objective of Article 3(1)(c), nor does it have a decisive bearing on the interpretation of that provision. Indeed, Article 6(1)(b), which aims, *inter alia*, to resolve the problems posed by registration of a mark consisting wholly or partly of a geographical name, does not confer on third parties the right to use the name as a trade mark but merely guarantees their right to use it descriptively, that is to say, as an indication of geographical origin, provided that it is used in accordance with honest practices in industrial and commercial matters.

29. Article 3(1)(c) of the Directive is not confined to prohibiting the registration of geographical names as trade marks solely where they designate specified geographical locations which are already famous, or are known for the category of goods concerned, and which are therefore associated with those goods in the mind of the relevant class of persons, that is to say in the trade and amongst average consumers of that category of goods in the territory in respect of which registration is applied for.

30. Indeed, it is clear from the actual wording of Article 3(1)(c), which refers to '...indications which may serve ... to designate ... geographical origin, that geographical names which are liable to be used by undertakings must remain available to such undertakings as indications of the geographical origin of the category of goods concerned.

31. Thus, under Article 3(1)(c) of the Directive, the competent authority must assess whether a geographical name in respect of which application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future.

32. In the latter case, when assessing whether the geographical name is capable, in the mind of the relevant class of persons, of designating the origin of the category of goods in question, regard must be had more particularly to the degree of familiarity amongst such persons with that name, with the characteristics of the place designated by the name, and with the category of goods concerned.

33. In that connection, Article 3(1)(c) of the Directive does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons — or at least unknown as the designation of a geographical location or of names in respect of which, because of the type of place they designate (say, a mountain or lake), such persons are unlikely to believe that the category of goods concerned originates there.

...

36. Finally, it is important to note that, whilst an indication of the geographical origin of goods to which Article 3(1)(c) of the Directive applies usually indicates the place where the goods were or could be manufactured, the connection between a category of goods and a geographical location might depend on other ties, such as the fact that the goods were conceived and designed in the geographical location concerned.”

36. The applicant’s mark consists exclusively of a sign or indication which may serve, in trade, to designate both the geographical origin of the services and the kind of the services. It is a combination which is liable to be used by undertakings as an indication of the geographical origin and of the category of services provided. The combination must, in the public interest, remain available to those undertakings to indicate the geographical origin of their services. There is no use of the mark prior to the date of application and so the proviso to section 3(1)(c), i.e. whether the mark had acquired a distinctive character before the date of application, cannot be considered. The services which survived the section 5(2)(b) ground, *arranging of trade fairs, for commercial or advertising purposes, in the fields of motor homes, caravans and camping articles*, are objectionable under section 3(1)(c) of the Act, as are all the services applied for (and, by extension, section 3(1)(b) as they are devoid of any distinctive character).

37. As the opposition has succeeded in full under sections 5(2)(b), 3(1)(b) and 3(1)(c) of the Act, there is no need for me to consider the grounds under sections 5(3) and 5(4)(a). Indeed, given my comments regarding the evidence filed in these proceedings, the opponent would have had no better prospect of success under sections 5(3) and 5(4)(a).

Outcome

38. The opposition succeeds in full. The application is refused.

Costs

39. The opponent has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. The opponent's evidence was thin and did not assist me in a finding of a likelihood of confusion. Consequently, I will make a reduced award for the opponent's evidence. I will make an award for the first set of written submissions, but not for the second set, which was very brief and repeated points made previously.

Preparing a statement and considering the counterstatement	£300
Opposition fee	£200
Evidence	£250
Written submissions	£150
Total:	£900

40. I order Perthshire Motor Homes Ltd to pay Perthshire Caravan Company (Motors) Limited the sum of £900 which, in the absence of an appeal, should be paid within seven days of the expiry of the appeal period.

Dated this 23rd day of September 2014

**Judi Pike
For the Registrar,
the Comptroller-General**