

O-019-15

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NUMBER 3006224  
BY HENLEY ROWING CLUB  
TO REGISTER THE FOLLOWING SERIES OF TWO TRADE MARKS  
IN CLASS 41:**

**Henley Rowing Club**

**Henley RC**

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IN CLASS 41:**

**Henley Rowing Club  
Henley RC  
(Series of two)**

**Background**

1. On 16 May 2013, Henley Rowing Club ('the applicant') applied to register trade mark application number 3006224 consisting of the words 'Henley Rowing Club' (mark one) and 'Henley RC' (mark two) for the following services in class 41:

Class 41: Provision of sporting club facilities

2. On 7 June 2013, the UK Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under section 41(2) of the Trade Marks Act 1994 ('the Act') on the basis that (in the examiner's own words), *"the marks are aurally and visually different. Whilst both marks contain the geographical location "Henley", the word "rowing club" in the first mark is changed to the acronym "RC". Therefore, the mark would not be considered as a series"*.
3. The examiner raised further objections under sections 3(1)(b) and (c) of the Act on the basis that, again in the examiner's own words, *"the mark consists exclusively of a sign which may serve in trade to designate the kind and geographical location of the services e.g. provision of sport club facilities being a rowing club in Henley"*. In line with routine IPO procedure, a period of two months was allowed for the applicant to respond.
4. No response was received from the applicant within the date set, and so the application was subsequently refused by way of a letter dated 13 August 2013.
5. On 19 August 2013, the applicant responded by way of an email, claiming that Henley Rowing club had been formed in 1839, and that the other rowing clubs in Henley are known by other names such as 'Upper Thames Rowing Club' and 'Leander Rowing Club'. It was further claimed that the examination report, which had been sent by e-mail from IPO's automated system to the applicant's email address as recorded on the application form, had gone into the applicant's 'junk' email folder. It is assumed that this was a plea on the applicant's part as to why it had failed to meet the deadline for response. Nonetheless, despite being sent to its 'junk' folder, the report was available to read and no request was made to grant further time to respond to the substantive objections raised at examination stage.

6. On 23 August 2013, the IPO received a form TM5 requesting a statement of reasons for the Registrar's decision. It is assumed from this that the applicant did not want to formally re-open the examination process but instead sought fuller reasons for the refusal. In providing these reasons for our refusal, I will, though, address the applicant's points about the formation of the club and others in the area. I have only the *prima facie* case to consider.

## Decision

7. By way of preface, and for reasons that will become clear later in the decision, I propose to deal with the section 3(1)(b) and (c) objections first.
8. The relevant parts of section 3 of the Act read as follows:

*"3.-(1) The following shall not be registered -*

*(a) ...*

*(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,*

*(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."*

## Section 3(1)(c)

9. There are now a number of judgments from the CJEU which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 (recoded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1)(c) of the Community Trade Mark Regulation (the 'CTMR'), whose provisions correspond to section 3(1)(c) of the UK Act. The following main guiding principles which are relevant to this case are noted below.
  - Article 3(1)(c) 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. The provision therefore prevents such signs or indications from being reserved to one undertaking alone because they have been registered as trade marks (see judgment of 4 May 1999 in Joined cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions-und Vertriebs GmbH (WSC) v Boots-und Segelzubehör Walter Huber and Franz Attenberger* ('Chiemsee') [1999] ECR I-2779, at paragraph 25).

- It is also a well-established principle these days that the Registrar's role is to engage in a full and stringent examination of the facts, underling the Registrar's frontline role in preventing the granting of undue monopolies, see to that effect CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z.o.o. v OHIM* [2011] ECR I-1541.
- There must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics - see CJEU Judgment C-468/01 P to C472/01 P '*Tabs*' at paragraph 39, and General Court Judgment T-222/02 '*Robotunits*' at paragraph 34.
- As regards signs or indications which may serve to designate the geographical origin of the categories of services 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 services concerned, but they may also, in various ways, influence consumer tastes by, for instance, associating the services with a place that may give rise to a favourable response (see '*Chiemsee*', cited above, at paragraph 26: judgment of 25 October 2005 in Case T-379/03 *Peek & Cloppenburg KG v OHIM ('Cloppenburg')* [2005] ECR II-4633, at paragraph 33).
- The registration of geographical names as trade marks is excluded under section 3(1)(c) not only where they designate specified geographical locations which are already famous or known for the category of services concerned, and which are, therefore, associated with those services in the minds of the relevant consumers; it is equally excluded if the geographical name is liable to be used by other traders and must remain available to them as indications of the geographical origin of the category of services concerned (see '*Chiemsee*', at paragraphs 29 and 30). However, section 3(1)(c) does not 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, such persons are unlikely to believe that the category of services concerned originates there (see '*Chiemsee*' at paragraph 33).
- In light of all the foregoing, a sign's descriptiveness cannot be assessed other than by reference to the goods or services concerned, on the one hand, and by reference to the understanding which the relevant persons have of it, on the other (see judgment of 15 October 2003 in Case T-295/01 *Nordmilch eG v OHIM ('Oldenburger')* [2003] ECR - 4365, at paragraphs 27 to 34).

### **Application of legal principles**

10. I must assess whether the geographical name contained within the mark is associated in the mind of the relevant class of persons with the category of services concerned, or whether it is reasonable to assume that such an association may be established in the future. In making that assessment, particular consideration should be given to the

relevant class of persons' degree of familiarity with the geographical name in question, with the characteristics of the place designated by that name, and with the category of services concerned (see '*Chiemsee*', at paragraph 37).

11. The signs must be found to designate a characteristic if the relevant public assumes that 'Henley Rowing Club / Henley RC' could plausibly designate the nature of the services, including, of course, their geographical location.
12. Taking into account the broad nature of the services covered by the application, namely *provision of sporting club facilities*, the relevant consumers in the present case are members of the public who use sporting club facilities and, in certain cases, clubs with members including both amateur and professional rowers. Thus, the relevant consumer is in part general consumers but also specialist professional rowers, all of whom would apply a reasonably high level of attention to the services being sought out.
13. The marks both contain the word 'Henley' (denoting a riverside town in Oxfordshire), followed by the words 'Rowing Club' (mark 1) and the letters 'RC' (mark 2). The words 'Rowing Club' merely designate the kind of services under consideration i.e. provision of rowing club facilities. Furthermore, the two-letter combination 'RC' is a generic abbreviation of the term 'Rowing Club' as confirmed by the Internet extracts annexed to this decision. It is clear from these extracts that the letters 'RC' placed after the names of the respective rowing club are used as a substitute for the term 'Rowing Club'. This is evidenced in the heading of the first web reference contained at Annex A (i.e. <http://www.tynerowingclub.org/>) where the author makes reference to 'Tyne RC', and then immediately qualifies it with further reference to 'Tyne Rowing Club'. Similarly, in the second reference at Annex A (<http://www.traffordrc.org/>) the author refers to 'Trafford RC' but the heading refers to 'Trafford Rowing Club'. Presented in this context, it is clear that a number of rowing and sporting clubs present and use the two-letter combination 'RC' as an abbreviation for the words 'rowing club', and so it is reasonable to assume that the relevant public will view the two letters as nothing more than an abbreviation. Having established that 'RC' is descriptive, the overall assessment therefore rests on how professional and amateur rowers (and members of the public, for that matter) are likely to perceive the geographical location of Henley in the context of providing rowing club facilities.
14. The riverside town of Henley is famous for its 'Royal Regatta', an annual international rowing event first held in 1839. Indeed, its long, straight, nearly two-mile stretch of river has made it an ideal location for rowing and it was the site of the Olympic rowing competition in both 1908 and 1948 when London hosted the Olympic Games. The history, fame and popularity of Henley as a place for rowing are evidenced in the opening in 1998 of the Henley River and Rowing Museum. In that regard, the relevant public will have no difficulty in perceiving the sign as a precise designation of rowing club facilities in the riverside town of Henley.
15. Due to its history, fame and geographical properties there can be little doubt that the riverside town of Henley is well known in the rowing fraternity, as well as by the wider public, as a desirable place to row. It is therefore likely that other traders in the field of rowing would wish to indicate that their services come from Henley. The applicant, in its

e-mail of 19 August 2013 (paragraph 4 above refers), indicates that there are two other rowing clubs located at Henley, both of which have other names dissimilar to the marks applied for. That fact notwithstanding, given the reputation Henley has for the sport of rowing and thus the likely favourable response of the relevant consumer, it is highly likely that other traders would wish to use the term 'Henley' in the course of their trade, even if there are no such other clubs currently using the name 'Henley' in their official titles. The fact remains that there is a need to keep free in this case such that it would be palpably unjust to grant a trade mark monopoly for 'Henley Rowing Club / Henley RC', especially when one bears in mind the fame and history Henley has for the sport of rowing.

16. The applicant states that it has been in existence for many years. However, in the context of a *prima facie* assessment based on inherent characteristics only, and in the absence of any substantiated claim to distinctiveness acquired through use, I cannot take this fact into account.

### **Section 3(1)(b)**

17. In the event I am wrong on the finding under section 3(1)(c), I will go on to consider the additional ground of objection under 3(1)(b). Of course, a sign that is found to be subject to a section 3(1)(c) objection will automatically also be subject to a section 3(1)(b) objection. However, each ground is potentially independent and requires a separate consideration
18. I approach this ground of objection on the basis of the following principles derived from the CJEU cases referred to below:
- An objection under section 3(1)(b) operates independently of objections under section 3(1)(c) - (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);
  - For a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
  - A mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86);
  - A trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);
  - The relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

19. Furthermore, in relation to section 3(1)(b) it was held in *Postkantoor* that:

*“In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.” (Paragraph 86)*

20. I do not consider that an application should necessarily escape objection if it is considered too imprecise a term to indicate a direct and specific relationship with the services at issue without further thought, but is, in some sense, more generally non-distinctive. I have indicated in paragraph 14 how I feel the average consumer will perceive the mark. I do not believe that the sign is capable of performing the essential function of a trade mark as I consider consumers would not consider the mark to be that of any particular provider of rowing club facilities in the riverside town of Henley.

21. Anna Carboni, sitting as the Appointed Person in *COMBI STEAM*, O-363-09, conveniently summarised the leading case law in respect of this part of the Act:

*“It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs “a residual or sweeping-up function”, backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: Procter & Gamble Ltd’s Trade Mark Application [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): Koninklijke KPN Nederland BV v Benelux-Merkenbureau Case C-363/99 (POSTKANTOOR) [2004] ETMR 57 (ECJ) at [86]”.*

22. For reasons already given, the Registrar considers the sign to be descriptive of specific characteristics of the services. The words comprising the mark are descriptive of rowing club facilities in the riverside town of Henley, and are words that other traders should be free to use in the course of their trade. It is clear from the above guidance that if a mark is entirely descriptive of characteristics of services, it will also be devoid of any distinctive character under section 3(1)(b). As I have found that the mark in question is open to objection under section 3(1)(c) of the Act, it follows that it is also open to objection under section 3(1)(b) of the Act.

## **Section 41(2)**

23 As indicated in paragraph 11 above the letters ‘RC’ in the context of the services applied for would be perceived as the generic abbreviation of the words ‘Rowing Club’. The identity of the marks is therefore the same and the objection under section 41(2) has therefore been waived. Waiver of this objection does not, however, affect the validity of the refusal under sections 3(1)(b) and (c)

## **Conclusion**

24. In this decision, I have considered all documents filed by the applicant and all arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is refused because it fails to qualify under sections 3(1)(b) and (c).

**Dated this 14th day of January 2015**

**Lee Scott  
For the Registrar  
The Comptroller-General**



## ANNEX A

Examples of third party use in trade of the abbreviation 'RC' for 'Rowing Club' taken from:

<http://www.tynerowingclub.org/>

### Welcome to Tyne RC

Tyne Rowing Club is based on the River Tyne at Newburn, just west of Newcastle upon Tyne. We have the longest and best stretch of river for rowing in the north of England. We have active squads for men, women, veteran men, intermediates, novices and juniors.

You will usually find us rowing or training at the club on Monday, Tuesday, Wednesday and Thursday evenings from 6.00 to 8.00pm and on Saturdays and Sundays from 8.00am till about 1.00pm. Each squad has its own schedule of sessions - most rowers don't come down every day!

We are pleased to welcome new members. If you have some experience on the water, you can probably start right now. If not, we run Learn to Row courses every summer for both adults and juniors, with taster sessions over winter and spring. You can get in touch with us [here](#).

<http://www.traffordrc.org/>

#### Trafford Rowing Club Website

Trafford RC has been rowing on the [Bridgewater Canal](#) since 1957 and is the only rowing club in South Manchester. We are a growing, friendly club who row competitively as well as just for fun or fitness. We do take our racing seriously, but we don't take ourselves so seriously that we lose the friendly atmosphere of our club. New members are made to feel welcome and we have active recreational, veteran, and junior sections, as well as the men's and women's senior squads.

Trafford RC is affiliated to the sport's national governing body [British Rowing](#), is a Community Amateur Sports Club (CASC), and in February 2009 gained [Clubmark](#) accreditation.

[Latest News](#) section. Or why not have a look at our new [Club Kit](#) web page? We have details of all of Trafford RC's results on our [Race Results](#) page, and you can see who has won Trafford RC's own awards and honours on our new [Club Awards](#) page. We also have a dedicated [Junior Rowing](#) web page. We are hoping to have more photos and even video streaming in the not too distant future, but in the meantime please feel free to browse our website.

If you are an experienced oarsman, or if you just want to have a go one weekend, please contact the Captain via the [Club Contacts](#) page.

<http://www.avoncountyrowingclub.org.uk/>



The header of the Avon County Rowing Club website features a dark, blurred photograph of rowing oars and blades on the water. The text 'Avon County Rowing Club' is overlaid in a light, sans-serif font at the top of the image.

<b>Home</b>	<p>Welcome to Avon County RC</p> <hr/> <p><b>Come and try rowing!</b></p> <hr/> <p><b>Next set of taster sessions for adults will be in August!</b></p> <p><b>For more info and to reserve a place click <a href="#">here</a></b></p> <hr/> <p><b>W Masters C Coxed four take to the Tideway!</b></p>
About the club	
Location	
Our Events	
Learn and join	
Coaching and training	
Club wins and results	
River Conditions	
Club sections	

<http://uptonrc.org.uk/>

Upton Rowing Club is small and friendly club based in the town of Upton-on-Severn, Worcestershire. The current incarnation of the club was formed in the early 1990's and has it's base at Upton Marina.

The club welcomes members in all rowing sections from junior to veteran. We participate in competitive racing in fine-boats (both summer regatta's and winter head races) and recreational rowing in more stable boats, including tours on rivers and canals principally in the UK.

Upton RC is affiliated to British Rowing and teaches rowing in accordance with both "Learn2Row" and "Explore Rowing" initiatives.

Upton RC is one of the UK rowing clubs that holds a specific beginner's regatta in September each year.

Upton RC is a sociable club located in this small and proud town, which provides us with many fine pubs including the **Anchor Inn** where you will regularly find members re-hydrating after a satisfying row.

<http://www.wallingfordrc.co.uk/>

## Welcome to Wallingford Rowing Club

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Joining Wallingford Rowing Club gives you access to one of the best stretches of river in the UK. In addition we offer professional coaching from international standard coaches, a brand new on-site gym facility, and a large and improving boat fleet.

Since it was founded in 1947 Wallingford RC has consistently produced rowers to compete at the highest level, and has sent members to every Olympic Games since 1988. Alongside this we have a thriving membership across all ages, with a wide range of goals and abilities. Our aim is, quite simply, to help you achieve your potential and maximise your enjoyment of the sport.

If you would like to find out more about the various squads at the Club, or are new to rowing and are considering taking it up, then please visit the [Rowing pages](#) or take a look at the [News section](#) to see what's happening at the Club!

<http://www.londonyouthrowing.com/?centre=lea-rowing-club-hackney>

Lea Rowing Club is LYP's affiliated centre in North London and is located at the Spring Hill boat house in Upper Clapton, next to Springfield Park. The River Lea is a very peaceful stretch of water, ideal for teaching novices and for more advanced athletes. A towpath running alongside the river allows coaches to follow crews on bikes. The river overlooks Hackney Marshes and the Olympic Park. The club has gym equipment, a fleet of junior boats and a cafe.

People have been rowing here since the early 19<sup>th</sup> century. The Lea RC was founded in 1980, as an amalgamation of five previous clubs (Stewart Ladies, Crowland, Gladstone Warwick, City Orient and Britannia). Since then it has won six Henley medals and many National Championship gold medals, and has produced international athletes in all categories – men, women, junior and lightweight.

For information on LYP's activities at Lea RC, see:

- ✎ [Go Rowing 2012](#) (a six-session Learn2Row course for beginners, starting in September)
- ✎ [Junior Rowing at Lea RC](#) (our year-round coaching programme for Lea RC Club Juniors)

<http://hullrowingclub.webs.com/>

## Come and Try Rowing

Rowing at the club is truly under way. At Hull RC, we are offering new Explore rowing courses – this programme is designed for inexperienced rowers to learn how to row. These sessions are currently run at East park, all ages (12+) and abilities are welcome to come and try it out.