

**O-148-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1266583  
AND THE REQUEST BY VIKING GLOBAL TECHNOLOGY PTY LTD  
TO PROTECT IN THE UK THE TRADE MARK:**

**TRAVEL AWARE**

**IN CLASSES 9 AND 39**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 405855 BY G4S RISK CONSULTING LIMITED**

## Background and pleadings

1. On 30 June 2015, Viking Global Technology PTY Ltd (“the holder”) applied to protect in the UK International Trade Mark number 1266583 for the following trade mark:

**TRAVEL AWARE**

2. A priority date of 6 May 2015 is claimed. The mark was accepted and published in the Trade Marks Journal on 16 October 2015 in respect of the following goods and services:

Class 9      Application software; computer software; computer software (programs); computer software (recorded); computer software applications (downloadable); computer software downloaded from the internet; downloadable software applications (apps).

Class 39      Advisory services relating to travel; consultancy for travel; information services relating to travel; provision of information relating to travel; provision of travel information; travel advisory services; travel consultancy; travel information services.

3. G4S Risk Consulting Limited (“the opponent”) opposes the trade mark on the basis of sections 3(1)(b), 3(1)(c) and 3(1)(d) of the Trade Marks Act 1994 (“the Act”). In respect of section 3(1)(b), the opponent argues that:

“The term TRAVEL AWARE speaks for itself. A consumer would immediately understand, without further reflection, the commercial nature of the product and service being offered by the holder’s business, i.e. the raising of awareness in travel-related matters”.

4. Regarding section 3(1)(c), the opponent states that:

“[...] the term TRAVEL AWARE serves merely to designate the kind and intended purpose of the goods and services, i.e. information and advisory services relating to travel which serve to raise the consumer’s awareness of travel issues. Accordingly, the term TRAVEL AWARE is fully descriptive of the goods and services in issue”.

5. The opponent also claims, under section 3(1)(d), that:

“A Google UK search for the explicit term “travel aware” produces almost 3000 results. Some of these (only naturally) refer to the holder’s own product which has been recently launched. However, there are many instances of generic use of the words “travel aware””.

6. The holder filed a counterstatement denying the claims made. It argues, in relation to section 3(1)(b), that:

“[...] the trade mark TRAVEL AWARE is **not** devoid of distinctive character. The trade mark consists of a made up term which has no clearly defined meaning and does not, to the applicant’s knowledge, appear in any English language dictionary as a stand alone term. The applicant submits that, when viewing the trade mark TRAVEL AWARE, the average consumer would not immediately understand the exact nature of the goods and services being offered”.

7. In defence of the claim under section 3(1)(c), the holder reiterates its arguments in respect of section 3(1)(b) and claims that the mark:

“[...] does not explicitly divulge to the average consumer the nature of the goods or services provided under the mark. It follows that the mark cannot be said to designate the kind and intended purpose of the goods and services in question”.

8. The holder denies the claim under section 3(1)(d) and comments on specific websites mentioned in the statement of grounds.

9. Both sides filed evidence, which I will summarise to the extent that I consider necessary. Both sides also filed written submissions. I have read all of the submissions carefully and will refer to them as appropriate during this decision but I do not intend to summarise them here.

10. Neither party requested a hearing and so this decision is taken from the papers. Both parties have been professionally represented throughout, the holder by Maucher Jenkins (formerly RGC Jenkins and Co) and the opponent by Stevens Hewlett & Perkins. Both parties have requested an award of costs.

## **Evidence**

### *Opponent's evidence*

11. This consists of the witness statement of Julie Gonard, dated 20 June 2016, with seven accompanying exhibits. Ms Gonard is the opponent's trade mark attorney. The witness statement contains a mixture of evidence and submissions: I will not repeat all of the submissions here but will bear them in mind.

12. Ms Gonard provides definitions of the words "travel" (as a noun) and "aware", from [www.oxforddictionaries.com](http://www.oxforddictionaries.com), as follows:<sup>1</sup>

Travel:

"1 The action of travelling [...]

1.1 [COUNT NOUN] (travels) journeys, especially abroad [...]

1.2 [AS MODIFIER] (Of a device) sufficiently compact for use on a journey  
[...]

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<sup>1</sup> Paragraph 4.

2. The range, rate or mode of motion of a part of a machine”.

Aware:

“Having knowledge or perception of a situation or fact [...]

1.1 [WITH ADVERB OR IN COMBINATION] Concerned and well informed about a particular situation or development [...]”.

13. Ms Gonard submits that “[c]ombined together, the terms clearly mean “being well-informed about a journey””.<sup>2</sup> She claims that:

““travel aware” is not syntactically unusual; it is a familiar juxtaposition of terms which speaks for itself. Travelling always requires a fair amount of organisation and many issues can arise, often relating to safety. Being conscious of these matters is being travel aware”.<sup>3</sup>

14. Moreover, Ms Gonard submits that:

“the word “aware” is commonly combined with another term, which qualifies it. Following the same pattern, expressions such as to be self aware, fashion aware, politically aware or cost aware are commonly used in English”.<sup>4</sup>

15. Exhibit JG1 consists of Google search results for the term “travel aware”. It bears a printing date of 20 June 2016 but is not otherwise dated. Some of the uses shown are irrelevant, such as the results from Amazon books, which detail publications “by Travel Aware” (p. 1) or a warning that “you must let Mainstage Travel aware [sic] in writing [...]” (p. 4). Other instances show use of the term “travel aware” to describe individuals, such as “[t]ravel aware young people” (p. 1 and p. 2, dated 2013), “even Santa needs to be travel aware” (p. 2) and “a travel aware workforce” (p. 2, repeated at p. 3). One hit shows use of the term “new ‘travel aware’ messaging” (p. 2).

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<sup>2</sup> Paragraph 5.

<sup>3</sup> Paragraph 8.

<sup>4</sup> Paragraph 7.

16. Exhibit JG2 contains website prints from [www.cornwall.gov.uk](http://www.cornwall.gov.uk) and [www.sense-of-place.co.uk](http://www.sense-of-place.co.uk), where “travel aware” is used in the form “[h]ow can we be travel aware?” (pp. 1-2). These are not dated save for the printing dates in June 2016. However, exhibit JG10 of the opponent’s reply evidence is an archive print of the same [www.sense-of-place.co.uk](http://www.sense-of-place.co.uk) web page. It is taken from the Wayback Machine and is dated 14 August 2012 (i.e. before the relevant date). There is also a web print from [www.howedell.herts.sch.uk](http://www.howedell.herts.sch.uk), where the term “travel aware” is used in the context “[c]ommunity involvement in making us all travel aware” (p. 5). The page contains a link to information sheets and curriculum details dated 2014.

17. Exhibit JG3 consists of two UK government publications. The first features the words “[t]ravel safely, travel aware” (pp. 1-1) and indicates it was published on 5 April 2016. The second brochure has a copyright date of 2002. It refers to “[b]ecoming travel aware” and organisations which “become more travel aware” (p. 10).

18. JG4 consists of web prints of eleven articles which, it is claimed, show “use of the term travel aware in a descriptive manner”.<sup>5</sup> They are as follows:

- An article from [medium.com](http://medium.com) dated 18 March 2013 about a “Travel-Aware Calendar”. This is a proposal for a diary which takes into account, for example, different time zones. However, the website appears to be a US enterprise, as it states that it is “A Medium Corporation [US]”.
- A blog from [www.belowtheblonde.com](http://www.belowtheblonde.com), where the words “TRAVEL AWARE” appear in the keyword tags at the end of the article but not in the blog itself. It is dated 23 July 2015.
- An article entitled “Travel aware, travel Smart” from [www.blogs.ubc.ca](http://www.blogs.ubc.ca). It also includes the comment “to travel aware is to travel smart”. The article is dated 23 November 2015. The domain name and the fact that the author is described as an “IR major” suggest it originated in North America.
- An article from the North Wales Daily Post, dated 17 October 2007. It reports on an initiative to make “everyone more travel aware”.

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<sup>5</sup> Paragraph 12.

- A user profile from [www.airbnb.co.uk](http://www.airbnb.co.uk). In a review dated June 2015, the user is described as “very travel aware”.
- An article dated 19 September 2009 from [www.travellingalone.co.uk](http://www.travellingalone.co.uk), in which it is stated that “all teenagers can benefit from becoming more travel aware”.
- An article dated 29 January 2016 from [www.cruise-adviser.com](http://www.cruise-adviser.com), in which the author talks about “when I first became travel aware”.
- An article from [www.wessexscene.co.uk](http://www.wessexscene.co.uk), dated 3 February 2016. It states that “even Santa needs to be travel aware” and is one of the search results shown at JG1.
- An article from [www.keepingcardiffmoving.co.uk](http://www.keepingcardiffmoving.co.uk), which refers to “opportunities for everyone to become Travel Aware”. The article is not dated but refers to various awards dated 2012.
- An article from [www.southerntrust.hscni.net](http://www.southerntrust.hscni.net) dated 26 February 2016 entitled “Travel aware young people”, which also refers to “a travel awareness programme”.
- An article from [www.huffingtonpost.co.uk](http://www.huffingtonpost.co.uk) entitled “Five ways to Be an Eco-Conscious Student Traveller”. One of the sub-headings is “Travel Aware”, where respect for the local laws, customs and culture is discussed. The article is dated 3 April 2016.

19. Exhibit JG5 features an article from [www.thetravelfoundation.org.uk](http://www.thetravelfoundation.org.uk) containing the heading “Travel Aware”, which raises the issues of a tourist’s environmental footprint and sustainable tourism. It is said to be dated 2012. There is also a print from the Royal College of Music website, dated 12 February 2013, which refers to “Travel-aware Monday” in the context of “Go Green Week”.

20. JG6 is a print from [slideshare.net](http://slideshare.net) which mentions “[l]ocation and travel aware Calendar applications”. It is dated 2009. Ms Gonard states that this exhibit “shows that the term “travel aware” is used in relation to class 9 goods specifically”.<sup>6</sup> However, it is not clear that this exhibit shows use in the UK, as “Yahoo! India” appears underneath

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<sup>6</sup> Paragraph 14.

the author's name on the first page of the exhibit, next to the caption "I am here!!" over what resembles a map of India.

21. Exhibit JG7 consists of two decisions of the EUIPO. I have read them but have not found them to be helpful as the marks at issue in those proceedings ("WORLD AWARE" and "CUSTOMER-AWARE") are different from that in the instant proceedings.

*Holder's evidence*

22. This consists of the witness statement of Cara Baldwin, dated 22 August 2016. Ms Baldwin is a trade mark attorney at RGC Jenkins & Co as was, the holder's professional representatives. Ms Baldwin's statement also contains both evidence and submissions. As with the opponent's evidence, I will not summarise the submissions in full here, though I will bear them all in mind.

23. Ms Baldwin disputes the opponent's claims that "aware" is commonly combined with another word, attaching at exhibit CNB1 web prints from dictionary.cambridge.org which show definitions of the terms "fashion-conscious" and "cost-conscious". These, Ms Baldwin submits, are the apt terms, not "fashion aware" and "cost aware".

24. Exhibit CNB2 is an extract from the Trade Marks Manual outlining the considerations which may be brought to bear in determining whether a sign has become "customary" or "established".

25. Ms Baldwin exhibits at CNB4 to CNB7 prints from the websites shown in the opponent's Google search results at JG1 (CNB3 merely reproduces the opponent's exhibit). Although the prints show the terms in the context of a full article rather than a few sentences, they do not show any additional uses from those shown in the search results at JG1 (and CNB3) and are of no material assistance to the holder. Ms Baldwin makes a number of submissions as to the weight which I should accord these results



and the way in which they should be interpreted (for example, that CNB6 shows journalistic use of the term, which should be disregarded or given little weight).

26. CNB8 is a web print from [www.cornwall.gov.uk](http://www.cornwall.gov.uk). The web pages are different from those exhibited by Ms Gonard but show use of the term in the form “[h]ow can we be travel aware?” (pp. 1 and 3). The pages are not dated, except for an indication at p.3 that the last update was in June 2016. The website traffic data for the Cornwall Council website between April and July 2016 is provided at CNB9, which shows between 244,948 and 362,102 unique visitors each month.

27. Exhibit CNB10 consists of the information sheet for parents referred to at p. 5 of the opponent’s exhibit JG2. It is entitled “New Walk to School project launch!”. The term “travel aware” is not visible.

28. Exhibit CNB11 is a screenshot from [www.howedell.herts.sch.uk](http://www.howedell.herts.sch.uk) which shows that the number of site visits was 35,429. The exhibit does not show when these visits occurred; the only dates visible are noticeboard posts in July and August 2016.

29. CNB12 includes an article dated 17 February 2015, which indicates it is from the British Embassy Berne. It makes no use of the term “travel aware”. The holder submits that the brochure shows use of the term in Switzerland, not in the UK. It is exhibited in response to the opponent’s exhibit JG3 (pp. 1-3) but it is not entirely clear how the article relates to the opponent’s evidence.

30. Exhibit CNB13 is a print of the [medium.com](http://medium.com) home page. It describes the website but gives no other information. It does not assist the holder.

31. CNB14 is a print of the Twitter account of Amanda Weldon, said to be the author of the [belowtheblonde.com](http://belowtheblonde.com) article exhibited at JG4 of the opponent’s evidence. It indicates that her location is in Canada.

32. Exhibit CNB15 is a news article from [www.bbc.co.uk](http://www.bbc.co.uk) entitled “Concern over newspapers’ decline in Wales”. It is dated 28 August 2010 and shows that daily circulation of the Daily Post was 32,414. Ms Baldwin submits that this evidence shows that the article is “unlikely to have been seen by a large percentage of the public” and that the use shown in the Daily Post article in the opponent’s evidence should be given “little, if any, weight, as it is mere journalistic use, rather than use in the course of trade”.<sup>7</sup>

33. Exhibit CNB16 consists of a web print from [www.southerntrusthscni.net](http://www.southerntrusthscni.net) which gives information about the trust, including population figures (365,712). Ms Baldwin states that the website is “obscure” and that the figures indicate that “the article is therefore unlikely to be read by a large population of the UK”.<sup>8</sup>

34. At CNB17, Ms Baldwin provides web prints from [www.slideshare.net](http://www.slideshare.net). Page 2 shows the same image as the opponent’s exhibit JG6, p. 2, though there is additional information in the holder’s exhibit. It shows a publication date of February 2009, that the presentation has 2 ‘likes’ and has been viewed 2,211 times. The author appears to have 58 followers (p. 1).

35. Exhibits CNB18 consists of a list of trade marks containing the word “aware” which have been accepted by the UK Registry and by the EUIPO. These results do not assist the holder, given that the marks are different from the mark at issue in these proceedings.

*Opponent’s evidence in reply*

36. This consists of the second witness statement of Julie Gonard, dated 24 October 2016. Again, the statement contains both evidence and submissions.

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<sup>7</sup> Paragraph 14(e).

<sup>8</sup> Paragraph 14(j).

37. Exhibit JG7 contains multiple articles featuring the word “aware” in conjunction with another term, such as “Environment Agency urges people to be “flood aware”” (p. 1). The exhibit also includes lists of “awareness events” in 2016, some of which are in the UK. Although there are several “awareness” events (e.g. Breast Cancer Awareness Month (p. 15)), none uses the word “aware”. “Travel aware” does not feature anywhere in the exhibit.

38. Exhibit JG8 consists of a print from Google Play which shows book titles which contain the word “aware”. Prices are given in sterling and the copyright date is 2016. Some of the terms appear to be concerned with software (e.g. “Mobility Aware Technologies and Applications” (p. 1)). The mark applied for is not visible.

39. Exhibit JG9 is a web print showing the apps available on the Google Play store which contain the word “aware” in their title. The copyright date is given as 2016 but the information is not otherwise dated. At pp. 6-30 are web prints showing full details of eleven of the applications listed at pp. 1-3. There is only one instance of “Travel Aware”, which appears to be the holder’s own app (p. 1).

40. Exhibit JG11 is a print from the gov.uk website entitled “Travel Aware- staying safe and healthy abroad”. The words “travel aware” are also used in figurative form (a tick replaces the “v”) in the image at the top of the page. At p. 2, there is the statement “Travel Aware works with over 400 companies and organisations”. The pages are not dated save for the printing date of 24 October 2016 but the list of partner organisations was updated on 13 October 2015 (p. 3).

41. Exhibit JG12 is said to be “examples of use in trade by some of the said Government’s partners”.<sup>9</sup> The use shown is the same word-only use as at exhibit JG11, above.

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<sup>9</sup> Paragraph 12.

*Holder's further evidence*

42. This is the second witness statement of Cara Baldwin, dated 13 December 2016. Again, it is a mixture of evidence and submissions.

43. Exhibit CNB19 are prints from [www.englishclub.com](http://www.englishclub.com) and [www.englishgrammar.org](http://www.englishgrammar.org) giving definitions of the word "collocation" and examples of common collocations. It does not show the term "TRAVEL AWARE".

44. Exhibit CNB20 are prints from [www.dictionary.cambridge.org](http://www.dictionary.cambridge.org) showing definitions of the words "conscious" and "aware". The holder submits that "aware" is not identified as a suffix (as "conscious" is) which means that "the word "aware" has not been embraced in the English language as a common suffix".<sup>10</sup> I note, however, that examples of "aware" are provided in the forms "to be ecologically/politically aware" and "sexually aware".<sup>11</sup> At p. 9, there are links to "[m]ore meanings of aware", namely "self-aware" and "brand-aware".

45. Exhibit CNB21 relates to a "Smoke Aware" article exhibited at JG7 of the opponent's evidence and shows that it is a project at Northeastern University in the US.

46. Exhibit CNB22 contains details of trade mark registrations for the marks "Wind Aware", "FlightAware" and "PilotAware". As each mark must be assessed on its own merits and in its totality, the exhibit does not assist the holder.

47. At exhibit CNB23 are the trade mark details for the European Union Trade Marks included in the holder's exhibit CNB18. They show that the marks were registered without showing evidence of acquired distinctiveness. For the reasons already given in relation to CNB18, this evidence does not assist the holder.

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<sup>10</sup> Paragraph 6.

<sup>11</sup> p. 7.

48. The opponent having chosen not to file further evidence in reply, that concludes my summary of the evidence.

Section 3(1)(c)

49. The relevant provisions read:

“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”.

50. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza*

*Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders

offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

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46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also

devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland* , paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality,



quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]).”

51. The question under this ground is whether the combination of the words “TRAVEL AWARE” is simply a direct description of the goods and services or some characteristic(s) of them.<sup>12</sup> I accept that the word “TRAVEL” on its own would be

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<sup>12</sup> Although I note that the mark is classed as figurative, nothing turns on this point as the stylisation of the typeface is very slight and likely to go unnoticed, and there are no other elements, such as a device, in the mark.

descriptive of a characteristic of the services at issue, all of which are concerned with providing advice and information about travel. I also accept that the holder's goods may be concerned with travel-related matters. However, the mark also contains the word "AWARE". The user of the holder's goods and services may wish to become more "aware" of travel-related matters but the word is clearly not descriptive of the goods and services themselves or their subject matter. Its combination with the word "TRAVEL" does not alter that: the term "TRAVEL AWARE" is not directly descriptive of either the goods or services in the specification. My initial view is that the mark in its totality is prima facie unobjectionable under section 3(1)(c).

52. The opponent has filed a good deal of evidence which, it claims, shows that the mark is descriptive. I accept that much of the evidence shows use of the words "travel aware" as a descriptor but the difficulty for the opponent is that the vast majority of its evidence shows that the term is used to describe people or, in one case, organisations (JG3, p. 10), rather than the goods or services at issue. The few instances in the opponent's evidence where the term appears to describe software (such as a "travel aware calendar" at JG4 and JG6) do not originate in the UK and there is no other evidence to show that the terms are or may be used in that way in the UK. I have not overlooked the reference at JG1, p. 2, to "'travel aware' messaging". However, this is only one example of potentially descriptive use in many pages of evidence and the opponent has provided no context to show precisely the goods and services in relation to which the words "travel aware" are used. Taken as a whole, the evidence filed by the opponent is insufficient to disturb my initial view that the mark is not descriptive. The ground under section 3(1)(c) fails.

#### Section 3(1)(d)

53. The relevant provisions read:

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

(a) [...]

(b) [...]

(c) [...]

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

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”.

54. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court (“GC”) summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision

in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40)".

55. The opponent's pleaded case under section 3(1)(d) is that "there are many instances of generic use" of the mark applied for and that it is "commonly used in relation to the goods and services in question".<sup>13</sup> The holder argues that the opponent's evidence fails to show that to be the case.<sup>14</sup>

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<sup>13</sup> Submissions, paragraph 20.

<sup>14</sup> Second witness statement of Ms Baldwin, paragraph 5.

56. The wording of section 3(1)(d) stipulates that the section applies when marks consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade. Although the opponent has filed a good deal of evidence, there is virtually nothing to show that the term “TRAVEL AWARE” is used in relation to the goods and services at issue. The only evidence in that regard is a reference to “‘travel aware’ messaging” at JG1 and a “travel aware calendar” at JG4 and JG6, both of which are beset by the same difficulties I described above, namely that the context is not provided or they are not clearly shown to be uses in the UK. The claim under section 3(1)(d) must fail because there is insufficient evidence to show that the mark as a whole has (by the priority date) become customary in the current language or in the *bona fide* and established practice of the trade. The ground under section 3(1)(d) is dismissed.

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

57. Section 3(1)(b) reads:

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

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) [...]

(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”.

58. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the Court of Justice of the European Union (“CJEU”) in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes 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 those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect,

respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)".

59. I begin by observing that the parties' competing evidence regarding other marks which use the word "aware" is not pertinent: the mark under consideration must be assessed on its own merit. I also remind myself that it is not necessary under section 3(1)(b) for the opponent to show that the mark has already been used non-distinctively.

60. In its pleadings, the opponent argues that the mark is devoid of distinctive character because the consumer "would immediately understand, without further reflection, the commercial nature of the product and service being offered [...] i.e. the raising of awareness in travel-related matters". It also claims that:

"Combined together, the terms clearly mean "being well-informed about a journey". Combining two words whose individual meanings are transparently clear does not necessarily create an identity which, because of the combination, becomes distinctive; in this case, the whole is no greater than the sum of its parts".<sup>15</sup>

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<sup>15</sup> First witness statement of Julie Gonard, paragraph 5.

61. Whilst, of course, I accept that the combination of non-distinctive elements may not create a distinctive whole, I disagree with the opponent's assessment of the mark. The opponent has suggested that the meaning of the term as a whole is "transparently clear". However, to my mind, its meaning is inexact and the combination of the terms, in relation to the goods and services at issue, is somewhat unusual. In the absence of any persuasive evidence from the opponent to the contrary, I take the view that "TRAVEL AWARE" is no more than allusive in relation to the goods and services applied for. It is hardly the most distinctive of marks but I see no reason why "TRAVEL AWARE" is not capable of distinguishing the holder's goods and services from those of other undertakings. The opposition under section 3(1)(b) is rejected accordingly.

## **Conclusion**

62. The opposition has failed. Subject to appeal, the application will proceed to registration.

## **Costs**

63. As the holder has been successful, it is entitled to a contribution towards its costs. Both parties filed evidence. I note that the holder filed further evidence but that evidence did not assist me and I do not consider an additional or increased award to be appropriate. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 4 of 2007. Using that TPN as a guide, I award costs to the holder on the following basis:

Considering the Notice of Opposition and filing  
a counterstatement: £200

Filing evidence and considering the other party's  
evidence: £500



Written submissions: £300

**Total: £1,000**

64. I order G4S Risk Consulting Limited to pay Viking Global Technology Pty Ltd the sum of **£1,000**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 29<sup>TH</sup> day of March 2017**

**Heather Harrison**

**For the Registrar**

**The Comptroller-General**