

**O/565/19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3302758**

**BY LUKE WADEY TO REGISTER**

**Dorset DPC**

**AS A TRADE MARK IN CLASS 37**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 413238**

**BY PROKIL HOLDINGS LIMITED**

## BACKGROUND AND PLEADINGS

1. On 10 April 2018, Mr Luke Wadey (“the applicant”) applied to register the trade mark Dorset DPC in the UK. The application was published for opposition purposes on 27 April 2018. The applicant seeks registration for the following services:

*Class 37: Damp proofing services; Services for the damp proofing of buildings during construction.*

2. The application was opposed by Prokil Holdings Limited (“the opponent”). The opposition is based upon Sections 3(1)(c) and 3(1)(d) of the Trade Marks Act 1994 (“the Act”).

3. Under section 3(1)(d), the opponent claims that the abbreviation ‘DPC’ is a commonly used abbreviation in the damp control trade for ‘Damp Proof Course’ and/or ‘Damp Proof Control’ and that the abbreviation is used by many traders in the relevant trade. It claims that the mark “*will essentially be viewed by the damp control/ damp proofing trade as ‘Dorset Damp Proof Control, or ‘Dorset Damp Proof Course’*” and that “*if the mark proceeds to registration, it will allow the applicant to have a monopoly over the words ‘Dorset DPC’, which may unfairly restrict third parties in the trade from using the term ‘Dorset DPC’ or arguably ‘Dorset Damp Proof Course’, even if such a third party is offering damp proof course services in the Dorset area.*”

4. Under Section 3(1)(c), the opponent further contends that as a result of or in addition to the applicant’s mark being a sign or indication which has become customary in the current language or in the bona fide and established practices of the damp control trade, it also offends Section 3(1)(c) of the Act as a sign which may serve to designate the kind, intended purpose and geographical origin of the services in question.

5. The applicant filed a notice of defence and counterstatement denying the claims made. Notably, the applicant:

- a) admits that 'Dorset DPC' stands for Dorset Damp Proofing Course;
- b) claims that the mark contains inherent distinctive character;
- c) disagrees that the mark consists exclusively of a sign which serves to designate the kind, intended purpose and geographical origin of the services in question;
- d) claims that 'Dorset DPC' is a brand and not merely a description;
- e) claims that the mark has been used since 2014 by himself and has acquired distinctive character as a result of the use made of it.

6. The facts stated by the applicant in support of his claim to acquired distinctiveness, are as follows:

- that he is a plasterer and damp proofer by trade;
- that he has been trading under the name Dorset DPC since 2014 and opened a shop under the same name in 2016;
- that he has spent a lot of time and money on building up the business Dorset DPC;
- that he has three staff members and sub-contracts four self-employed people;
- that the sign Dorset DPC is used on headed papers, invoices, staff uniforms and company vehicles, namely three vans and a company car. It is also used on the company's website, the company's Facebook account and the shop sign;
- that Dorset DPC sponsor several local football clubs and that the sign Dorset DPC is displayed on stadium boards and on football kits;
- that he is not willing to provide evidence of turnover and whilst is willing to provide a copy to the Tribunal, he is not willing to show the opponent.

7. The applicant also made various allegations against the opponent (which the opponent denies). I do not propose to descend into particularities of these allegations. Suffice it to say the applicant alleges that the opponent in reality is only seeking to obstruct the application. I do not need to deal with these allegations which are not

relevant to the issues which I must decide. This is because Sections 3(1)(c) and 3(1)(d) of the Act are concerned only with whether the mark in issue is, *prima facie*, descriptive or customary in trade. The reasons behind why the opponent has opposed the application do not come into this assessment.

8. The opponent is represented by Elkington and Fife LLP and the applicant represents itself. Neither party requested a hearing and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

### **The evidence**

9. The opponent filed evidence in the form of the witness statement of Giancarlo Marsango dated 17 December 2018. This was accompanied by written submissions, also dated 17 December 2018. The applicant filed evidence in the form of a statement of Luke Wadey dated 18 February 2019. The opponent filed evidence in reply in the form of a second witness statement of Giancarlo Marsango dated 20 May 2019. I have read all the evidence. The following records the most pertinent parts of it.

### **The opponent's evidence in chief**

10. Mr Giancarlo Marsango explains that the opponent, Prokil Holdings Limited, is a holding company that holds all intellectual property and franchises on behalf of Prokil Limited and that he is a Director of both companies. Mr Marsango says that his companies provide damp proofing services as well as other related building services, that he has over 30 years of experience in the damp proofing and general construction trade and that, as a long-term trader in these industries, he is genuinely concerned that the applicant has applied to register a trade mark which includes the term DPC which is widely used and understood in the industry as meaning Damp Proofing Course. In this connection, Mr Marsango states:

*“...the applicant's trade mark is directly descriptive of all of the services listed in his application, namely “Damp proofing services; Services for the damp proofing of building during construction”. When I, or other traders in the damp proofing and general construction industry see a name such as Dorset DPC, it*

*immediately describes Dorset based Damp Proof Course services, or Damp Proof Course services provided in the county of Dorset.”*

11. The exhibits to Mr Marsango’s first witness statement include:

- print outs from Companies House which shows that the opponent was incorporated on 1 July 2015 and Prokil Limited on 8 January 2001 (GM1);
- print outs from the opponent’s website (GM1);
- print outs from various websites which show that the term DPC is a standard abbreviation for Damp Proof Course, including (GM2):
  - i. a print out from Wikipedia which states: *“A damp-proof course (DPC) is a barrier through the structure designed to prevent moisture raising by capillary action such as through a phenomenon known as raising damp. [...] The damp proof course may be horizontal or vertical. A DPC layer is usually laid below masonry walls [...]”*;
  - ii. a print out from [www.quota.com](http://www.quota.com) which states: *“What is meant by DPC in construction? Damp proof course. In brickwork or blockwork, it usually consists of a heavy-duty plastic strip laid in a mortar bed a couple of courses up from the ground. It stops damp from the ground being drawn up the wall and causing damp problems”* and *“a damp-proof course (DPC) is a barrier in a wall designed to resist moisture [...]”*;
  - iii. print outs from websites of UK online retailers of building material showing that the words ‘Damp Proof Course’ are used in the categorisation/description of products consisting of damp-proof membranes and injection creams for use in raising damp courses and treatments;
- print outs from websites of third party companies which use the words Dorset and DPC/Damp Proof Course/Damp Proof together. These include use to identify the trader’s name or its trade mark, i.e. Dorset Damp Course Company, as well as use in a descriptive manner, i.e. Abbots - Damp Proofing Bournemouth, Poole & Dorset refers in the description of its services to damp-proof course (DPC) (GM3).

## **The applicant's evidence**

12. Mr Luke Wadey initially submitted evidence alongside his counterstatement but this was not filed in the correct format and so he was advised to refile it during the evidence rounds. He subsequently filed evidence which, although it was not in ideal format, was considered acceptable and was admitted into the proceedings.

13. Although, in his statement, Mr Wadey did not reproduce all the paragraphs in the counterstatement that contain evidence, he made clear that he stands by all of them. The only exhibits to Mr Wadey's evidence are:

- LW1 – it contains: (a) a copy of a trade mark registration relating to a different mark incorporating the words DryWallDpc (figurative) and (b) a photograph of a shop sign and a van displaying the words Dorset DPC and a logo device;
- LW2: a copy of a certificate of incorporation which confirms that Mr Marsango is a Director of Dorset DPC Ltd, a company incorporated on 26 July 2017 and that that company is dormant.

## **The opponent's evidence in reply**

14. In his second witness statement Mr Marsango makes a number of submissions which I will not repeat here but I will bear in mind. He also addresses the evidence relating to the registration of Dorset DPC Ltd in his name. He states:

*“Whilst my registration of the company DORSET DPC LTD is irrelevant to the grounds of this opposition, I confirm that the company is currently dormant because I was advised that the name DORSET DPC is descriptive and non-distinctive. I am therefore considering whether I still wish to trade under the name in the future. I reiterate that I have no issue with Mr Wadey using the name Dorset DPC, as it should be free for use by all traders in the damp proofing and general construction industry. However, he should not be able to obtain a registered trade mark monopoly in a name which should be free for other traders to use. I also do not appreciate Mr Wadey's continued and*

*unsubstantiated allegation that I registered DORSET DPC LTD to prevent him from doing so, or that he is somehow entitled to the company name, given that it is a descriptive name which features a geographical location and a descriptive term that is common in the damp proofing and general construction trade.”*

15. Mr Marsango also provides at Exhibit GM4 prints from Companies Houses showing a number of companies in the building industry which incorporate the letters DPC in their company names, namely DPC BUILDING CONTRACTOR LTD, DPC BUILDING SERVICES LTD, DPC BUILDING SOLUTIONS (CENTRAL) LIMITED, DPC COATING LTD, DPC CONSTRUCTION LONDON LTD, DPC CONSTRUCTION SOUTHERN LIMITED and DPC CONSTRUCTION SOUTHERN (GROUNDWORKS) LIMITED.

16. That concludes my summary of the evidence filed in so far as I consider it necessary.

## **DECISION**

17. Section 3(1)(c) and 3(1)(d) of the Act read as follows:

“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 product of goods or of rendering of services, or other characteristic of goods or services,

(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.”

18. The relevant date for determining whether the mark is objectionable under Sections 3(1)(c) and 3(1)(d) is the date of the application in issue – 10 April 2018.

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

19. I will begin with the opponent’s objection under Section 3(1)(d). Section 3(1)(d) prevents the registration of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court (GC) summarised the case law of the Court of Justice of the European Union (CJEU) under the equivalent of Section 3(1)(d) of the Act<sup>1</sup>, 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).

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<sup>1</sup> See also: *Merz & Krell GmbH & Co* [2002] ETMR 21 (CJEU) and *Stash Trade Mark* – BL O/281/04 (AP).



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)."

20. In its written submissions, the opponent claims:

*"The evidence supplied in Exhibits GM2 and GM3 of the witness statement of Giancarlo Marsango, clearly demonstrates that the sign DPC and Dorset DPC have become customary in the general construction and damp proofing traders, and commonly used by third party traders to promote Damp Proof Course goods and service"*

21. In his second witness statement, Mr Marsango points out that *"Mr Wadey himself makes a clear admission in paragraph 5 of his counterstatement that Dorset DPC stands for Dorset Damp Proofing Course"*. I also note that the admission is repeated in Mr Wadey's submissions in lieu, in which he states: *"the sign DPC has become customary in the trade as it does indeed stand for damp proof course or damp proof company"*.

22. The current mark consists of the words Dorset DPC. In order for the opposition to succeed under Section 3(1)(d) I must be satisfied that the sign Dorset DPC had, at the relevant date, become customary in the current language or in the bona fide and established practices of the trade to designate the services in question. There is no dispute between the parties that DPC stands for Damp Proof Course. The applicant also admitted that DPC is customary in trade. Whilst traders in Dorset might use the term DPC alongside the geographical name Dorset to denote the place of origin of the services, there is no specific association between Dorset and DPC other than the services, (which are of the type that one would expect to be provided in all parts of the country), might be provided locally in the county of Dorset.

23. It seems clear to me that the opponent's objection unduly disregards the fact that the element Dorset is not part of the sign which, it is accepted, is customary in trade. As the mark must be considered in its totality as Dorset DPC (not as DPC alone), the addition of the word Dorset means that the ground under Section 3(1)(d) is not satisfied. **Consequently, the opposition under Section 3(1)(d) fails.**

### **Section 3(1)(c)**

24. 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 set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“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 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).

And

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]."

25. The descriptiveness of the mark must be assessed through the perception of the relevant parties, including those in the trade. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, the CJEU held that:

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPNNederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

26. In *Exalation v OHIM*, Case T-85/08, the GC confirmed that, at least where technical terms are concerned, it is appropriate to take account of meanings known to those in the trade. The court stated that:

“38. In paragraph 18 of the contested decision, the Board of Appeal stated that the applicant had not submitted any substantiated evidence to invalidate the examiner’s observations to the effect that the element ‘lycopin’ (lycopene) designated a carotenoid with antioxidant properties.

39. For the first time at the hearing, the applicant challenged the Board of Appeal’s assessment that the term ‘lycopin’ is descriptive. The Court observes that the applicant has not given any details to support its claims and there is thus no need to consider whether such an argument may be raised at this stage in the proceedings. In particular, the applicant has put forward no argument capable of calling into question the meaning attributed to the term ‘lycopin’ by the Board of Appeal. In those circumstances, the Court must find that the applicant has not succeeded in challenging the meaning attributed to the element ‘lycopin’ by the examiner and by the Board of Appeal.

40 First, that technical term designates a food supplement necessarily known by some of the relevant public, in particular professionals dealing with dietetic, pharmaceutical and veterinary preparations.

41 Secondly, the Board of Appeal established in the contested decision that the meaning of the term 'lycopin' was easily accessible to consumers of all the goods covered by the application for registration. The meaning of the term 'lycopin' does in fact appear in dictionaries and on web sites. It is probable therefore that the substance designated by that term is also known by some of the consumers of all the goods listed in paragraph 3 above.

42 Thirdly, consumers of pharmaceutical, veterinary, dietetic and sanitary preparations for medical use who are not aware of the meaning of the term 'lycopin' will often tend to seek advice from the informed section of the relevant public, namely doctors, pharmacists, dieticians and other traders in the goods concerned. Thus, by means of the advice received from those who prescribe it or through information from various media, the less well-informed section of the relevant public is likely to become aware of the meaning of the term 'lycopin'.

43 The relevant public must therefore be regarded as being aware of the meaning of the term 'lycopin', or at least it is reasonable to envisage that the relevant public will become aware of it in the future (see paragraphs 25 and 26 above).”

27. I also bear in mind that in *Canary Wharf Group Ltd v Comptroller General of Patents, Designs and Trade Marks* [2015] EWHC 1588 (Ch), Mr Iain Purvis QC, sitting as a Deputy Judge of the High Court, made the following comments in relation to geographical names:

“20. Before me, Mr Malynicz (who did not appear below) accepted that the Hearing Officer was correct to find that Canary Wharf was, in the perception of the public, a geographical area. However, he contended that the Hearing Officer had made a number of other errors in carrying out the assessment

required by Windsurfing Chiemsee. These errors, he said, undermined the decision to refuse registration.

21. His first objection was to a passage in paragraph 50 of the Hearing Officer's Decision which states as follows:

*'The case [Windsurfing Chiemsee] was, and is, important because it plainly identified the 'need to keep free' principle to be applied in the specific instance of geographical names or locations. But such a principle can apply, notwithstanding that a particular location may not have a current or likely UK-wide 'association' with particular goods or services. Thus, if those goods or services may be considered to be ones which could be considered 'local' in nature, such as, say, hairdressing, the provision of meeting places for worship or other activities, garage services and so forth, then the name of any small town or even village may need to be 'kept free.'*

Mr Malynicz attacked this on the basis that the Hearing Officer was effectively identifying a 'blacklist' of goods or services (ones which could be considered 'local' in nature) for which any place name would always be refused registration.

22. It seems to me that the basic point being made in this passage is a perfectly valid one. A large number of services falling with the Nice Classification (possibly most services), including those listed by the Hearing Officer, are of a kind that one would expect to be available locally in any major centre of population in the UK. The names of most cities and towns would therefore be capable, when used in the UK, of designating the geographical origin of those services and therefore would be excluded from registration under s3(1)(c) in the absence of acquired distinctiveness.

23. However, the Hearing Officer may have been guilty of over-generalisation. First of all, the mere fact that services are of a kind which one would expect to be provided 'locally' does not mean that there is a blanket ban on the registration of all place names in respect of such services. Locally-provided



services may be of a kind which one simply would not expect to be provided in all parts of the country. For example, an application for the name of a city far inland such as 'Coventry' might be allowed for 'lobster pot repair services' (unless of course the evidence was that the public would expect lobster pots to be sent away to inland industrial areas to be repaired).

24. Secondly, there may be issues connected with the obscurity of the place-name in question. The Hearing Officer's reference to *'the name of any small town or village'* would cover many place names which are unknown to the majority of potential consumers of the services in question in the UK. Such names are capable of designating geographic origin to people living in or near the town or village in question, but perhaps not to the 'average consumer'. The CJEU in Windsurfing Chiemsee noted in paragraph 33 that names which were *'unknown to the relevant class of persons'* were not *'in principle'* prohibited from registration. On the other hand, it could be said in the Hearing Officer's favour that the public policy underlying the restriction on registration of geographical terms is not served by allowing monopolies to be obtained over the names of small towns for the kind of services already being provided by numerous traders in those towns. This seems to me to raise a difficult question of policy.

25. In my view, however, neither of the potential difficulties I have identified with the Hearing Officer's general statement in paragraph 50 is capable of affecting the outcome of this case. So far as the first point is concerned, the services for which CANARY WHARF is sought to be registered are precisely the kind of services one would expect to be provided in, from or to the geographical area of Canary Wharf. So far as the second is concerned, it is accepted by the Applicant that Canary Wharf is famous throughout the UK."

28. In its written submissions, the opponent states:

*"The opponent submits that the relevant consumer in this case will understand the sign Dorset DPC to mean "Dorset Damp Proof Course" which will immediately inform the consumer that use of the services applied for, will result in specific specialised damp proofing services located in the county of Dorset.*

*The mark therefore conveys obvious and direct information regarding the kind, intended purpose, and geographical origin of the services listed in the application. The word combination Dorset DPC is in no way ambiguous and is readily and immediately understandable. It is no more than the sum of its part.”*

29. In his submission in lieu, the applicant states:

*“The average consumer will not look at the sign Dorset DPC and regard services of damp proofing course in Dorset to be the only damp proof course undertaken in the County of Dorset. Therefore the applicant submits that the meaning of Dorset and DPC are not used in this manner;*

*Dorset DPC might be considered descriptive of damp proof courses provided in Dorset, however we believe that as the UK IPO initially accepted our application without raising this objection this suggests the name is capable of functioning as a trade mark.”*

30. The applicant himself accepts that his mark is descriptive of damp proof courses services provided in Dorset. However, I feel bound, in circumstances where the applicant has no legal representative, to set out why, I believe, the grounds under Section 3(1)(c) are made out.

31. As I have already said, there is an acceptance between the parties that the element DPC is a standard abbreviation for ‘Damp Proof Course’. Further, the opponent’s evidence shows that the element DPC denotes a barrier or membrane used to prevent damp, which has been fitted/installed into the lower course of brick work to prevent upward damp ingress. So far as the trade is concerned, the applicant accepted that DPC is customary in the construction trade. This inevitably carries an acceptance that those in the relevant trade, namely builders and traders, will know the full meaning of the abbreviation. To the extent that the applied for services can be supplied to the general public, i.e. owners seeking to damp-proof their property, who might not be familiar with the meaning of DPC, the opponent’s evidence shows that the meaning of DPC is easily accessible on websites and it is used by other traders in their marketing material. Further, the choice to carry out the damp-proofing work on the property will

be based on the result of a survey so anyone, even the less-informed consumers, are likely to become aware of the meaning of the abbreviation DPC by means of discussions and advice received from those providing the services. In my view, when the abbreviation DPC is used in the context of damp-proofing services involving the application/installation of the physical Damp Proof Course into the walls, traders and average consumers who are (or are likely to be) aware of the meaning of the abbreviation DPC, will readily perceive it as describing the kind of services. As regards the element Dorset, it is a county in southwest England and it is, in the perception of the relevant public, a well-known geographical area.

**32. In conclusion, I find that the 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 for which the applicant seeks registration, namely *Damp proofing services; Services for the damp proofing of buildings during construction* (in class 37). 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 other undertakings.**

33. Having found that the mark is *prima facie* descriptive for all the services for which it has been applied for, I will go on to consider the applicant's claim that the mark had acquired a distinctive character before the date of application.

#### **Claim to "acquired distinctiveness"**

34. The applicant claims in his notice of defence and counterstatement that his Dorset DPC mark has acquired distinctiveness through use in relation to the services for which he seeks registration for the purposes of Section 3(1). The opponent denies the claim.

35. The CJEU provided guidance in *Windsurfing Chiemsee*, Joined cases C-108 & C-109/97, about the correct approach with regard to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: 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 class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37).”

36. Also, it is clear from *Oberbank AG & Banco Santander SA and Another v Deutscher Sparkassen- und Giroverband eV* (Joined cases C-217 and 218/13), that the burden of establishing acquired distinctiveness rests on the applicant (or, in the case of invalidation proceedings, the proprietor). The relevant part of the court’s judgment is as follows:

“66. As to the substance, it is true that recital 6 in the preamble to Directive 2008/95 states, inter alia, that Member States should remain free to fix the procedural provisions concerning the invalidity of trade marks acquired by

registration and determine, for example, the form of invalidity procedures. However, it cannot be inferred that the question of the burden of proof concerning distinctive character acquired through use in the context of invalidity proceedings pursuant to Article 3(1)(b), (c) or (d) of Directive 2008/95 constitutes such a procedural provision falling within the competence of Member States.

67. If the question of the burden of proof concerning distinctive character acquired by use which has been made of a mark in the context of invalidity proceedings were a matter for the national law of the Member States, the consequence for proprietors of trade marks could be that protection would vary according to the legal system concerned, with the result that the objective of ‘the same protection under the legal systems of all the Member States’ set out in recital 10 in the preamble to Directive 2008/95, where it is described as ‘fundamental’, would not be attained (see, by analogy, Case C-405/03 *Class International* EU:C:2005:616, paragraph 73 and the case-law cited, and Case C-479/12 *H. Gautzsch Großhandel* EU:C:2014:75, paragraph 40).

68. In view of that objective and the structure and purpose of Article 3(3) of Directive 2008/95, the Court finds that, in the context of invalidity proceedings, the burden of proof concerning distinctive character acquired following the use which has been made of the mark at issue must be borne by the proprietor of that mark which invokes that distinctive character.

69. First, in the same way that distinctive character acquired following the use which is made of a mark is, in proceedings for registration, an exception to the grounds for refusal listed in Article 3(1)(b), (c) or (d) of Directive 2008/95 (see, to that effect, Case C-108/05 *Bovemij Verzekeringen* EU:C:2006:530, paragraph 21), distinctive character acquired following the use which is made of a mark is, in the context of invalidity proceedings, an exception to the grounds for invalidity listed in Article 3(1)(b), (c) or (d). Since it is an exception, the onus is on the party seeking to rely on it to justify its application.

70. Second, the Court finds that it is the proprietor of the mark at issue which is best placed to adduce evidence in support of the assertion that its mark has

acquired a distinctive character following the use which has been made of it. The same applies, in particular, to evidence capable of establishing such use, in respect of which the case-law cited in paragraphs 40 and 41 above contains a list of examples, such as evidence relating to how intensive, widespread and long-standing use of the mark has been and the amount invested in promoting it.

71. Consequently, where the proprietor of the mark at issue is requested by the competent authority to adduce proof of distinctive character acquired following the use which has been made of a mark which is intrinsically devoid of distinctive character but fails to do so, that mark must be declared invalid.”

37. A similar finding was made by Lloyd J. in *Dualit Ltd's Trade Mark* [1999] RPC 890 in the context of opposition proceedings.

38. I can deal with this point very briefly. The only piece of evidence supplied by the applicant to support the claim of acquired distinctiveness is a photograph of (what I assume is) his commercial premises showing how the sign Dorset DPC is used on a van and a shop sign. There is no indication of turnover or marketing spent, there is a complete absence of promotional material, the use appears to be of local nature and the mark seems to have been used alongside more distinctive figurative elements. Whilst there is no reason to doubt that the applicant has been using the mark in relation to his business, I agree with the opponent that the material submitted falls a long way short in terms of proving that the mark had, at the relevant date, acquired distinctive character.

### **Final remarks**

39. The applicant sought to rely on the fact that the UK IPO initially accepted the application without raising any objection. The argument must be dismissed. The initial acceptance of the mark by the examiner was made without the benefit of the third-party evidence of the opponent (or the parties' submissions and concessions) and I do not consider myself bound by that acceptance.

## Conclusion

40. **The opposition succeeds under Section 3(1)(c) of the Act and, subject to appeal, the application for registration is refused.**

## Costs

40. The opponent has been successful and is entitled to a contribution towards its costs.

41. In his submissions in lieu, the applicant claims that the opponent did not complete and return its Cost Pro-Forma and that the opponent's request for costs should, consequently, be rejected. The applicant evidently refers to the Registrar's practice on costs relating to litigants in person, which requires the litigant in person to file a Cost Pro-Forma setting out any disbursements which the litigant claims he has incurred, and a statement of the time spent by the litigant in dealing with the proceedings. This approach does not apply to professionally represented litigants and, therefore, the opponent (who is professionally represented) was not required to complete a Cost Pro-Forma being entitled to an award based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £ 1,200 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Official fees:	£200
Preparing a statement and considering the applicant's statement:	£300
Preparing evidence and submissions and considering the applicant's evidence:	£700
Total:	£1,200

42. I therefore order Luke Wadey to pay Prokil Holdings Limited the sum of £1,200. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**25 September 2019**

**Teresa Perks**

**For the Registrar**

**The Comptroller – General**