

O-109-16

**TRADE MARKS ACT 1994 & THE TRADE MARKS (INTERNATIONAL REGISTRATION)
ORDER 2008 (as amended)
IN THE MATTER OF INTERNATIONAL REGISTRATION WO0000001231916
BY HAPPY FEW RACING
TO PROTECT THE FOLLOWING TRADE MARK
IN CLASS 41:**

FATHER AND SON

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Background

1. On 22 January 2015, HAPPY FEW RACING ('the applicant') requested protection in the United Kingdom under the provisions of the Madrid Protocol for the trade mark 'FATHER AND SON'.
2. Protection was sought in class 41 for the following services:

Education; training; entertainment; sporting and cultural activities; information relating to entertainment or education; vocational retraining; providing recreation facilities; publication of books; lending libraries; production and rental of motion pictures; rental of sound recordings; rental of television sets; rental of show scenery; videotape editing; photography services; organization of competitions (education or entertainment); organization and conducting of colloquiums, conferences or congresses; organization of exhibitions for cultural or educational purposes; booking of seats for shows; game services provided online from a computer network; gambling services; publication of electronic books and journals on-line; electronic desktop publishing.
3. On 27 January 2015 the Intellectual Property Office ('IPO') issued notification of a provisional total refusal of protection in response to the application. In that notification an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act') on the basis that the mark consists exclusively of a sign which may serve in trade to designate the intended purpose of the services e.g. those aimed at fathers and sons. The examiner informed the agent that the objection would be reconsidered if examples of use of the mark were provided.
4. Although the specification submitted covers a wide range of services (see paragraph 2 above), Marion Rocou of BRM Avocats ('the agent') informed the IPO that the intention is to use the mark in connection with a motor rally open only to teams composed of a father and son. They already have such an event in France named 'Rallye Père-Fils (France)', and in 2016 they intend to hold an event in Italy named 'Padre-Figlio' with the car manufacturer Ferrari. The agent went on to inform the examiner that this trade mark application is connected to the intended launch of an exclusive event in the UK with a British car manufacturer. The IPO responded on 26 June 2015 maintaining the objection as the examiner felt that the mark did not indicate trade origin, but was instead an indication of who the services are aimed at.
5. On the 1 October 2015 a letter refusing the application was sent to the agent, and on 29 October 2015 the agent submitted a form TM5 requesting a statement of reasons for the Registrar's decision.

6. I am now asked under section 76 of the Trade Marks Act 1994, and rule 69 of the Trade Marks Rules 2008, to state in writing the grounds of my decision and the materials used in arriving at it. No formal evidence of use has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, in respect of the services listed at paragraph 2 above, I have only the *prima facie* case to consider.

Section 3(1)(c)

7. 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.”

8. There are 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 main guiding principles which are relevant to this case are noted below.

- Subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (*Wm Wrigley Jr & Company v OHIM, C-191/01P (Doublemint)* paragraph 30);
- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all (*Doublemint*) paragraph 31;
- It is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes (*Doublemint*) paragraph 32);
- It is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in

paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question (*Koninklijke KPN Nederland NV v Benelux Merkenbureau*, C-363/99 (*Postkantoor*), paragraph 57);

- An otherwise descriptive combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word trade mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark (*Postkantoor*, paragraph 99);
 - 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 category of goods and services in question or one of their characteristics (*Ford Motor Co v OHIM*, T-67/07 – paragraph 24).
9. It is clear from the aforementioned case law that, assuming notional and fair use, I must determine whether or not the mark applied for will be viewed by the average consumer as a means of directly designating essential characteristics of the services being provided, or seen as an indicator of trade origin. In doing so I must pay regard to the comments made in *Matratzen Concord AG v Hukla Germany SA*, C-421/04 (*Matrazen*), where the CJEU stated that:

"...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, who are reasonably well informed and reasonably observant and circumspect, in the territory in respect of which registration is applied..."

10. I must therefore assess who I consider the average consumer to be. In view of the wide range of services covered by the application, the average consumer will differ according to the services being provided. For the majority of the services provided the average consumer will be the general public, but for those services covered by the wide term 'education and training' the consumer could comprise both the general public and professionals in the field of education. Services such as 'organisation and conducting of colloquiums, conferences or congresses' are likely to be aimed at businesses, and so for these services, and those aimed at educational professionals, the level of attention paid is likely to be higher than that given by the general public when accessing services such as, for example, television rental and lending library services.
11. In paragraph 10 above I have considered who the average consumer is likely to be for the wide range of services covered by the application. However, as the agent has informed us that the mark will be used in connection with a motor rally event aimed at fathers and sons (see paragraph 4 above), it is reasonable for me to consider - in particular - who the average consumer is for those specific services which the agent has suggested the mark is intended for use upon. For these services it is reasonable to

assume that the average consumer of 'motor rally services' which are aimed at fathers and sons are likely to be those members of the general public who enjoy motor racing and the purchasers of such services could comprise fathers and sons who want to enjoy some time together, or maybe others who wish to provide a treat for a father and a son. As a rally event is likely to be an expensive purchase, the average consumer would apply a reasonably high level of attention to the purchase of such services.

12. In determining whether the ground for objection under section 3(1)(c) applies, the Registrar is obliged to consider the semantic content of the sign. On that basis, I firmly believe that the words FATHER AND SON convey a clear message which would be understood by the relevant consumer as designating a characteristic of services which are aimed in particular at fathers and sons. It is feasible to assume that there are certain services included in the wide terms 'education', 'training', 'entertainment' 'sporting activities' and 'the organisation of competitions' which could be aimed at fathers and sons and the objection must apply to those services. However, the specification goes wider than those services and I must therefore consider the comments made by Mr Richard Arnold QC sitting as the Appointed Person in the *Sensornet* decision [Case O/136/06] where he stated the following at paragraph 50:

"...if an objection to registrability only applies to some goods or services in the specification applied for, then the application should only be refused in so far as it covers those goods or services and should be allowed to proceed in respect of the remainder. I consider that this is equally true during examination and during opposition."

I believe the mark must be acceptable for those services which would not specifically be aimed at fathers and sons and I have identified those services at paragraph 20 below.

13. As the meanings of the words 'father and son' are so well known, I do not think it necessary to include corresponding dictionary definitions here. I do not believe the combination of these words can lay claim to any grammatical or linguistic imperfection or peculiarity that might help to escape the inherent descriptiveness. In this respect, I refer to comments made in *Postkantoor* where the CJEU held that:

"98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned."

15. As I have stated above, I believe the average consumer for the services which could be aimed at fathers and sons will only see the sign as descriptive and it is unlikely that they will give the sign any trade mark significance. When carrying out the necessary research to enable me to ascertain whether the objection raised by the examiner was valid, I visited the applicant's website which clearly shows that the services provided are aimed

at fathers and sons, and the comments in the agent's communication, referred to in paragraph 4 above, confirm this.

16. In carrying out that Internet research, I found that other organisations provide events and activities that are aimed at fathers and sons, and are marketed as such. I have listed some of those found at Annex A. They include golfing breaks organised for fathers and sons at Aubrey Park and St Andrews; activity breaks in woodland and caves organised by Global Adventure; a cycling and trekking event at Rockingham; quad biking at Aberdeen; and a bowling championship run by The Royal Marsden Cancer Charity. Further details of these and other Father and son events can be found at Annex A. Should we grant a monopoly in the words 'FATHER AND SON' to any one organisation it would prevent others from being able to describe that they are holding a father and son event. In this respect I am mindful of the guidance given in *Linde A.G. v Rado Uhren A.G.* (Case C-53/01 at paragraphs 73 - 74

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

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

17. Having considered the mark to be descriptive of services specifically aimed at, and provided for, fathers and sons I have to decide whether that constitutes a characteristic of the services and would therefore be barred from registration under section (1)(c) of the Act. The provisions of section 3(1)(c) preclude from registration those signs 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 services, or other characteristics of goods or services'. The word 'other' is there to cover those characteristics which have not been specifically listed. As Arnold J stated in his decision on *Linkin Park* [O-035-05]:

"...a considerable diversity of characteristics is embraced by section 3(1)(c). In my judgment, the purpose of the words 'other characteristics' is to make it clear that section 3(1)(c) extends beyond the specific types of characteristics mentioned. I see no reason why subject matter should not qualify."

As with subject matter, I consider those to whom the services are aimed at would fall within the category 'other characteristics' and would therefore be precluded from registration under section 3(1)(c).

18. Taking all of the above into account I have concluded that the mark applied for consists exclusively of a sign which may serve in trade to designate a characteristic of services when used in respect of the following:

“Education; training; entertainment; sporting activities; organisation of competitions (education or entertainment).”

The aforementioned services are therefore excluded from registration in the *prima facie* case by section 3(1) of the Act.

19. As I have stated in paragraph 12, the application covers a wide range of services, and I do not consider that the objection can be applied to all of them. The assessment of the mark must be made with reference to each discrete category of services covered by the application, see Case C-239/05 *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* [2007] ECR I-1455 at paragraph 34 where it was stated:

“34. ...an examination of the grounds for refusal listed in Art.3 of the Directive must be carried out in relation to each of the goods and services for which trade mark registration is sought and, secondly, that the decision of the competent authority refusing registration of a trade mark must, in principle, state reasons in respect of each of those goods or services.”

20. For those services which are unlikely to be aimed at fathers and son the sign could designate trade origin. The mark is therefore acceptable for the following services:

“Cultural activities; Information relating to entertainment or education; vocational retraining; providing recreation facilities; publication of books; lending libraries; production and rental of motion pictures; rental of sound recordings; rental of television sets; rental of show scenery; videotape editing; photography services; organization and conducting of colloquiums, conferences or congresses; organization of exhibitions for cultural or educational purposes; booking of seats for shows; game services provided online from a computer network; gambling services; publication of electronic books and journals on-line; electronic desktop publishing.”

There may be some services within the wide terms ‘educational and entertainment services; sporting events and the organisation of competitions’ for which the phrase ‘father and son’ has no meaning, but no request has been made to limit the specification and I can only consider the objection in relation to the specification before me.

Section 3(1)(b)

21. In case I am found to be wrong regarding the objection under section 3(1)(c), I will go on to determine the matter under section 3(1)(b). I should at this point stress that since an objection has been made under section 3(1)(c), this automatically engages section 3(1)(b). However, it can be useful to also consider section 3(1)(b) in its own right - the scope of the two provisions is not identical, and marks which are not descriptive under section 3(1)(c) can nonetheless be devoid of any distinctive character.

22. 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*).

23. 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)

24. Ms. Anna Carboni, sitting as the Appointed Person in *COMBI STEAM* (BL O-363-09), conveniently summarised the leading case law in respect of this part of the Act when, at paragraph 7 of that decision, she stated the following:

"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]."

25. I do not believe the sign would be capable of performing the essential function of a trade mark without the relevant public being educated into seeing it that way. There is no linguistic quirkiness or stylisation which may add some distinctive character to the words. A mark can only be considered distinctive if it can be perceived immediately by the relevant public as an indication of the commercial origin of the goods and services. This was confirmed by the General Court which, in its decision on *Sykes Enterprises v OHIM (Real People Real Solutions)* [2002], ECT II-5179, stated:

"...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin."

In respect of this mark, I do not consider that the average consumer would see the sign as an indicator of trade origin for those services identified in paragraph but would instead merely see it as referring to the services being aimed at fathers and sons. In my view, the sign is not a memorable one that would evoke the services of the applicant, but merely be perceived as origin neutral rather than origin specific.

26. I have concluded that the sign applied for will not be identified as a trade mark for those services listed in paragraph 12 without first educating the public that it is an indication of trade origin. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from *prima facie* acceptance under section 3(1)(b) of the Act for those services. However the mark can be accepted for the services listed in paragraph 20 above.

Conclusion

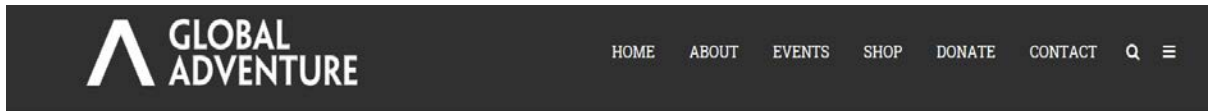
27. In this decision I have considered all the documents filed by the applicant, and all the arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is refused under the terms of section 37(4) of the Act because it fails to qualify under sections 3(1)(b) and 3(1)(c).

Dated this 3rd day of March 2016

**Linda Smith
For the Registrar
The Comptroller-General**

Annex A

1. Taken from <http://global-adventure.org/fathers-and-sons/>



Fathers And Sons

Woodlands. Caves. Mountaintops. Riverbanks. Rugged coastlines.

Simply evoking the names of these places make your pulse pound a bit quicker. For young boys, they are battlefields, dungeons, palace towers, jousting fields, and embarkation points to places unknown. As parents, we want to give our children the skills and experiences necessary to mold them into responsible adults. And we want to show them the love and protection of a parent.

Global Adventure was founded to create an atmosphere where fathers and their sons can bond through structured activities, physical challenges, and intentional discussions about personal character, community service, and self-esteem. We use Britain's myriad environments as backdrop to personal development, family growth, and healing relationships.

But we also have a lot of fun doing it!

2. Taken from <http://www.adventurebritain.com/father-and-son-activity-break/>

Father and Son Activity Break



Great Ideas for Family Summer Holidays in the UK

3. Taken from <https://www.oldcourse-experience.com/view-our-experiences/old-course-experience/father-son-tournament.aspx>

Father & Son Tournament

16 - 21 APRIL 2016

Held over five days, the tournament is 72 holes of competition over St Andrews New Course, Kingsbarns Golf Links, Carnoustie Championship Course and culminating at the legendary St Andrews Old Course.

In all, golfers from 22 different countries will have competed in this unique event held in honour of the legendary golfing pair of Old Tom Morris and his son Tommy.

4. Taken from <http://www.fatherandsongolf.co.uk/>



5. Taken from <http://www.tawhid.org.uk/?p=1205>



6. Taken from <http://www.rockingham.co.uk/bluebird/>

The Bluebird Trophy for Fathers and Sons at Rockingham

Make history by being part of the first ever electric car race for fathers and sons.

The opportunity to team up and race the new Bluebird electric race cars to raise money for our nominated charities.

Qualification will be through pre-race events at Rockingham on 12th or 19th August 2014. The top 20 driver pairings will qualify for the final race and join 6 legendary father and son pairings.

7. Taken from <http://www.outdoorni.com/events/1612/father-and-son-coasteering-bargain-from-just-12pp/>



Your definitive guide to Outdoor Activities in Northern Ireland

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Father and Son Coasteering Bargain from just £12pp



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July 2012

8. Taken from <http://www.offthestreet.org.uk/icf-father-and-son-day/>

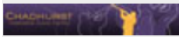
OTS
OFF THE STREET



9. Taken from <http://englandevents.co.uk/forres-father-and-son-weekend/239569>



10. Taken from <https://www.cpsa.co.uk/cpsa-trade-members-corporate---events>

	<p>Chadhurst Corporate Clays</p>	<p>We provide both individual 1:1 shotgun coaching, including the Academy courses, to large corporate clay shooting events, Stag and Hen shoots, Father and Son days, and we can provide falconry, archery and Segway's</p>	<p>www.chadhurstcorporate.co.uk</p>
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11. Taken from <http://www.visitaberdeen.com/attractions-and-activities/view/deeside-activity-park>

Purveying the finest sport for guests from all over the world, but equally offering safe, friendly activities to occasional visitors to our corner of Scotland. From the most elaborate corporate house-party to a **father and son** quad biking or family learning archery. With an intimate knowledge of what's best and available throughout the area. A sense of traditional professionalism, but just as much, a sense of what's bloody good fun.

12. Taken from <http://shropshiresports.com/allscott-father-and-son-bowling-championships/>



13. Taken from <http://www.radiomarsden.co.uk/?p=2456>

Father and Son day at The Royal Marsden Cancer Charity

BY ELLIE D'SILVA, ON JUNE 21ST, 2015



This week, fathers and sons are teaming up to help raise awareness around male cancers and to raise money in support of The Royal Marsden Cancer Charity.

Father and Son Day was set up by Daniel Marks and Jack Dyson, two friends who have both survived testicular cancer, and whose fathers both had cancer. The campaign aims to inspire men by celebrating the legacy of respect and admiration that flourishes between inspirational fathers and their sons, between men and their mentors.

Through sharing photos of fathers and their sons, the campaign aims to raise awareness of all male cancers and raise funds for two projects at The Royal Marsden that will have far reaching benefits.

14. Taken from <http://www.aubreypark.co.uk/offers/activities-golf>



FATHER AND SON GOLF BREAK



FROM JUST
£109.00

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