

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 2180596
BY ROBINSONS SOFT DRINKS LIMITED
TO REGISTER A TRADE MARK IN CLASSES 7 AND 11**

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DECISION AND GROUNDS OF DECISION

10 On 27 October 1998, Robinsons Soft Drinks Limited of Britvic House, Broomfield Road, Chelmsford, Essex, CM1 1TU, applied under the Trade Marks Act 1994 to register the trade mark ROBINSONS in Classes 7 and 11 for the following goods:

15 Class 7 Beverage dispensing apparatus; soft drinks dispensing machines; parts and fittings for the aforesaid goods.

20 Class 11 Beverage dispensing equipment and soft drinks dispensing machines incorporating apparatus for purifying, sterilising and filtering water; drinks refrigeration and cooling apparatus, water fountains; refrigerated beverage and water dispensers; parts and fittings for the aforesaid goods.

25 Objection was taken to the application under Section 3(1)(b) of the Act because the mark is a common surname.

At the Hearing at which the applicants were represented by Mr N Baker of Trade Mark Owners Association Limited, their trade mark agents, the objection was maintained and the application refused.

30 Following refusal of the application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

No evidence of use has been put before me. I have therefore only the prima facie case to consider.

35 The relevant part of Section 3(1)(b) of the Act is set out below:

“The following shall not be registered-

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

The surname ROBINSON appears more than 1,400 times in the London Telephone Directory. The Registrar’s practice on surnames alone is set out in the Registry’s Work Manual Chapter 6, August 1998, at pages 37 to 39, and is as follows:

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3.12.1 Surnames Alone

In considering an appeal against the Registrar's refusal to register the trade mark MISTER LONG (unreported at the time of writing), Geoffrey Hobbs QC, acting as The Appointed Person stated:

Section 1(1) of the Act (implementing Article 2 of the Directive) confirms that personal names are eligible to be regarded as signs capable of registration. Different persons having the same name nevertheless share the right to use it in accordance with honest practices in industrial or commercial matters under Section 11(2)(a) of the Act (which gives effect to Article 6(1)(a) of the Directive). And Section 3(1)(b) of the Act (which implements Article 3(1)(b) of the Directive) prohibits the registration of trade marks which are devoid of any distinctive character. These provisions indicate to my mind that surnames are neither automatically eligible nor automatically ineligible for registration under the Act. In each case the question to be determined is whether the surname put forward for registration possesses the qualities identified in Section 1(1) of the Act and non of the defects identified in Section 3. For the reasons I gave at greater length in AD2000 TM (1997) RPC 167 I think that in order to be registrable a surname or any other sign must possess the capacity to communicate the fact that the goods or services in relation to which it is used recurrently by the applicant are those of one and the same undertaking. When assessing the capacity at the relevant date (the date of application) it is, of course, necessary to bear in mind that surnames, as such, are naturally adapted to identify all individuals so named".

The surname LONG appearing more than 800 times in the London Telephone Directory was found not to possess a distinctive character. However, Geoffrey Hobbs QC decided that the words MISTER LONG were unlikely to be understood as having surnominal signification in respect of the applicants goods - which were unusually elongated frozen confections. Accordingly, the trade mark was deemed registrable for a restricted specification which reflected this characteristic of the goods.

In the light of this case, the Registrar will not accept words which are surnames for registration *prima facie*, unless having regard to:

- a) the commonness of the surname;
- b) the size of the market (in terms of the number of traders in it) in the goods or services specified in the application;
- c) the nature of the goods or services;
it is likely that the trade mark will be taken as a sign identifying goods or services originating from a single source.

A surname will be regarded as common if there are more than **100 entries** in the London Telephone Directory.

Where the market in the goods or services is small, more common surnames may be capable of distinguishing goods or services. Where the market is very small, e.g airline

services, even very common surnames may be capable of distinguishing.

5 Where a word, which is also a surname, is more likely to be taken as a fanciful illusion to the nature of the goods or services (as per MISTER LONG), the trade mark may be capable of distinguishing, even though it is also a common surname. However, a common surname should not be accepted simply because it has another meaning e.g. WALKER or READ.

10 Every case should be decided on its own merits taking account of the above guidance.

15 Taking account of the guidance set out above it is clear that this mark, (the possessive form of the common surname ROBINSON) in respect of the goods applied for will only be seen as a surname, as the word has no other meaning apart from insignificant geographical locations in the United States of America.

20 In my view anyone seeing the mark ROBINSONS used in relation to the goods for which registration is sought, would only see the mark as a surname. This is because the word is such a common surname in the United Kingdom that it does not, in itself, have the capacity to communicate the fact that the goods in relation to which it is used recurrently by the applicant are those of one and the same undertaking. Also, taking account of the nature of the business involved and the potential size of the market, the word ROBINSONS could be used by other manufacturers of beverage dispensing apparatus as well as specialist suppliers who may provide industry at large with such equipment for use in, for example, offices, factories and public buildings. The public are therefore likely to consider that there is more than one party trading in beverage dispensing apparatus under the name ROBINSONS. I therefore consider the mark to be devoid of distinctive character. It follows that the application is debarred from prima facie acceptance for registration by Section 3(1)(b).

30 However, that is not the end of the matter as, at the Hearing attended by the applicants' trade mark Agent, Mr Baker, he submitted that I should accept this application based on the earlier registrations of the word ROBINSONS which are all in Classes 5, 30 and 32. He pointed to registration Nos. 866931, 678737, B821478, 888728, 1079075, 1061953 and 1218463 as examples. All of these earlier registrations proceeded by virtue of evidence of acquired distinctiveness as a result of use made. His argument was that the public who buy soft drinks will associate the actual drinks dispensing apparatus as being from the same origin as the producer of the drinks. He urged me to accept the application based on the prior rights of these earlier registrations.

40 The proviso to Section 3(1) is in the following terms:

“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.”

45 The earlier registrations cited by the agent are all in respect of food and drink in Classes 5, 30 and 32. He commented at the Hearing that these registrations proceeded on evidence of use in respect only of the goods applied for. There is therefore no use of the mark in respect of

the drinks dispensing apparatus applied for in Classes 7 and 11 for me to consider.

I bear in mind at this juncture the comments of Mr Simon Thorley QC in his role as The Appointed Person in the BONUS GOLD decision [1998] RPC 859 at page 862, lines 21 to 28:

“I have reached the conclusion that although this argument could carry weight, it can only carry weight if the Hearing Officer has before him the actual evidence of use that is relied upon so that both he and I on appeal can assess the weight that can be placed upon that evidence. Without that evidence I believe it is correct to come back to the prima facie case and ask: Is the mark BONUS GOLD unused disqualified from registration? For the reasons I have given, I believe that it is”.

I also bear in mind the comments of Mr Mathew Clarke QC in the unreported decision of the GIBSON Appeal (Application No. 2129557 dated 17 December 1999) where he said:

“While I think that Counsel for the applicants did accept that the question as to whether the proviso to Section 3 of the 1994 Act applies must turn on evidence of use, it appeared to me that at times his submissions were amounting almost to a legal proposition of that, in certain situations, a non-distinctive mark may acquire a distinctiveness in relation to one class of goods, simply because it had acquired a distinctiveness in relation to very different types of goods emanating from the same source. If that was a correct understanding of the applicants position then, in my view, it clearly goes too far, if it is meant to be a proposition of general application, which means that, in certain classes of cases, the necessary evidential basis for distinctiveness having been acquired can be foregone.”

He went on in that decision to comment:

“.....I consider that it is not sufficient, in a case such as the present, to say that, absent adequate evidence, an inference of distinctiveness can be drawn simply because of the distinctiveness of the mark or a similar mark when used in relation to the proprietor’s other goods”.

My understanding from discussions at the Hearing is that the applicant has prior rights in the word ROBINSONS for food and soft drinks, but no evidence was put before me. It is, in any event, clear from Registry practice and the authoritative cases already mentioned, that for a prior registration to even possibly assist, the goods applied for would need to be the same or similar to those which the mark is already registered. I do not consider that soft drinks are similar goods to the dispensing apparatus itself. Indeed the purchasers of soft drinks on seeing the mark ROBINSONS on the drinks dispensing apparatus would in my view, consider this to be a sign to indicate the actual product on offer ie. the drink itself. The relevant purchasing public of drinks dispensing apparatus are, to my mind, a different purchasing group altogether. I have therefore concluded that such prior rights are of no assistance insofar as this application is concerned.

It is my conclusion that the mark is devoid of any distinctive character. Furthermore there is

no evidence that the mark has acquired a distinctive character as a result of the use made of it. I therefore conclude that the application is not acceptable for registration under Section 3(1)(b) of the Act.

5 In this decision I have considered all the documents filed by the applicant and all the submissions made to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 3(1)(b) of the Act.

10 **Dated this 23 day of May 2000**

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JANET FOLWELL (MS)
For the Registrar
20 **The Comptroller General**