

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2108532  
BY LOCAL PAGES LIMITED  
TO REGISTER A TRADE MARK  
IN CLASS 16**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No 48349  
BY THOMSON DIRECTORIES LIMITED**

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### **BACKGROUND**

1. On the 27<sup>th</sup> August 1996, Local Pages Limited (“the applicants”) applied to register a trade mark under application No. 2108532 in Class 16. The mark in question was of the words **LOCAL PAGES** in plain block capital letters.

2. The mark was accepted on the basis of “distinctiveness acquired through use” and was published as such in Trade Mark Journal No. 6206, page 14520 on the 17<sup>th</sup> December 1997 for a specification of goods in Class 16 reading “Classified telephone directories”.

3. On the 17<sup>th</sup> March 1998, Thomson Directories Limited (“the opponents”) filed a notice of opposition, accompanied by a statement of grounds for the opposition. The grounds on which they relied were stated as sections 1(1); 3(1)(a)(b)(c) and (d); 3(6) and 5(4) of the Act. They state further that the evidence filed in support of the application does not establish that the mark applied for has in fact acquired a distinctive character as a result of the use made of it and the applicants should therefore not be entitled to rely on the proviso to section 3(1).

4. The applicants filed a Form of counterstatement and counterstatement on the 1<sup>st</sup> July 1998, in which they denied all the grounds for opposition and in which they state that the evidence filed in support of the application has established that the trade mark in question has, in fact, acquired a distinctive character as a result of the use made of it and that they are thus entitled to rely on the proviso to section 3(1) of the Act.

5. Both sides seek an award of costs in their favour.

6. The matter came to be heard on the 17<sup>th</sup> August 2001 via a video conference facility. Mr Boris Bernard Haykhan (“Mr Bernard”), the Managing Director and majority shareholder of the applicants appeared on their behalf in Newport. Mr Mark Foreman of Rouse & Co. International appeared as Agent on behalf of the opponents in London.

7. In his skeleton arguments received prior to the hearing, Mr Foreman announced the opponents’ wish to withdraw the section 3(6) and section 5(4) grounds of opposition. That

left the section 1(1) and 3(1)(a)(b)(c) and (d) grounds.

## **OPPONENTS' EVIDENCE**

8. This consisted of the following:

- (a) A statutory declaration of **Kendall Gordon** (Senior Marketing Manager of the opponents). This largely gives the history and alleged reputation of the opponents and their trade marks. Only paragraphs 9, 10 and 11 have any bearing on the remaining grounds of opposition, and in short say that the evidence of acquired distinctiveness filed in support of the application for the mark LOCAL PAGES fails to fulfill this purpose. Mr Gordon's view is that the Registry's initial findings that the mark was both prima facie objectionable under section 3(1)(b) and (c) and that this had not been overcome by the user filed, was the correct one. The view arrived at by the hearing officer, who accepted the mark on the basis of "distinctiveness acquired through use" was wrong, in his opinion.
- (b) Exhibits KG1 - KG3 have no bearing on this case as it now stands, being as they are, examples of the opponents' marks in use and the publicity attached to them.
- (c) Exhibit KG4 is a copy of a survey carried out for the opponents to establish their reputation in the words "THE LOCAL". It was carried out in late 1997, outside the material date in these proceedings, but it has no bearing in these proceedings as they now stand in any event.
- (d) Exhibit KG5 is a copy of what appears to be a substantial part (open to public inspection) of the Registry case file for the application in suit, including internal Registry documents and official letters and the evidence filed by the applicants in support of their case to show distinctiveness acquired prior to the date of application.
- (e) A statutory declaration of **Mark Roland Foreman** (agent for the opponents) in which he states his view that "the mark [in suit] is inherently non-distinctive in relation to the goods for which registration is sought. The mark simply describes a classified telephone directory which is of local significance. The trade mark is one which other traders could legitimately wish to use in the course of their business". He also includes at exhibit MRF1 a search made on the internet showing two other uses of the term LOCAL PAGES. This search was made over three and a half years outside the material date (of 27<sup>th</sup> August 1996) in these proceedings.

## APPLICANTS' EVIDENCE

9. This consisted of:

- (a) A statutory declaration of **Mr Bernard**, the Managing Director and majority shareholder of the applicants. In this he, inter alia, gives the history of the applicant company; the date of first use of the mark from 1982; the circulation to be 339,000 copies of the directories in the South West of England and Wales and the annual turnover to be £358,000 (although for how long or in which particular year is not stated). Mr Bernard spends some time commenting on the statutory declaration of Mr Gordon and on grounds of opposition which were subsequently dropped. His exhibit BBH2 (there is no BBH1) is not relevant to the proceedings as they now stand, being as it is examples of the geographical spread and type of usage of the opponents marks. He comments on the remaining section 3(1) grounds by reference to Mr Gordon's paragraph's 9, 10 and 11 (as referred to above), by disagreeing with Mr Gordon's stated views.
- (b) A statutory declaration of **Anne Maclean** (Business Co-ordinator of 2050 Training Limited, trading as Intelligent Marketing). At her exhibit AM1 is the copy of some market research commissioned by the applicants regarding the LOCAL PAGES trade mark. The research was carried out in late 1999/early 2000 (after the material date in these proceedings) and does not refer back to the relevant period in question ie pre August 1996.

10. No evidence in reply was filed by the opponents, so that concludes my summary of the evidence in so far as I see it as necessary to the surviving grounds

## THE DECISION.

11. Sections 1(1) and 3(1) of the Act are still relied upon in the remaining grounds of attack. Section 1(1) states:

*1. - (1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.*

*A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.*

12. And Section 3(1) states:

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

*(a) signs which do not satisfy the requirements of section 1(1),*

*(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) 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.*

13. Much of the evidence submitted in these proceedings went to grounds which were subsequently dropped by the opponents. On those which remain, let me say at the outset that according to the Opinion of Advocate General Ruiz-Jarabo Colomer in the Court of Justice of the European Community in Case C-299/99 Philips Electronics NV v. Remington Consumer Products Ltd [2001] R.P.C. 38 page 754 paragraph 43 and 44, that there is not a category of marks which are *incapable* of acquiring a distinctive character, that would not otherwise be excluded by section 3(1)(b)(c) and (d) of the Act and the proviso thereto. In my view there is no basis for the section 3(1)(a) and section 1(1) grounds in the case here of the word mark at issue. Neither have they been specifically pursued in the evidence or at the hearing. Consequently I dismiss them.

14. Also the Section 3(1)(d) ground is not substantiated in any way. Mr Foreman produced evidence at MRF1 (see the summary above) which I take it was intended to go to this ground and indeed at the hearing recounted another incidence he had come across in the week of the hearing, of the words LOCAL PAGES being used in trade. However, as I have said earlier, the evidence at MRF1 cannot be taken into account because it was after the material date at issue in these proceedings and it follows that the same is true of Mr Foreman's submission at the hearing. This, in any case, was seemingly an attempt at introducing evidence into the proceedings through submissions, which of course cannot be allowed. In these circumstances, this ground is also dismissed.

15. There was in fact very little direct evidential assistance by either party to support or refute the remaining grounds under section 3(1)(b) and (c). There was some argument and assertion in the statutory declaration's of Messrs Gordon and Foreman and again by Mr Foreman at the hearing (and I shall return to this later), but real factual evidence was conspicuous by its absence. Much of the hearing was spent by both parties analysing and deconstructing the two pieces of survey evidence filed (one by each party - see paragraphs 8(c) and 9(b) above), but

as can be seen from those paragraphs, neither of those two surveys were relevant to my considerations under the remaining grounds of opposition.

16. It can be seen from the evidence (at paragraphs 10 and 11 of the statutory declaration of Mr Gordon and at KG5) that the decision to accept the mark LOCAL PAGES for classified telephone directories was reached after a hearing had taken place on the initial rejection of the mark under Section 3(1)(b) and (c) grounds at the examination stage in the Registry. Clearly the opponents disagree with the findings of the hearing officer. The applicants of course share her views. I am now called upon in these proceedings to reassess the position.

17. Essentially, there are two remaining questions to be answered.

- (a) Does the mark LOCAL PAGES qualify in the prima facie for registration under section 3(1)(b) and (c)?
- (b) If not, does it qualify under the proviso to section 3(1)?

18. On the first question, the opponents clearly argue the answer is “no” under both subsections. Mr Foreman in his statutory declaration for the opponents states that “the trade mark LOCAL PAGES is inherently non-distinctive in relation to the goods for which registration is sought” and this was reiterated in his skeleton arguments provided just prior to the hearing and indeed at the hearing. On the 3(1)(c) ground, Mr Foreman states “the mark [in suit] simply describes a classified telephone directory which is of local significance”. He elaborated further in his skeleton arguments when he said the mark “consists of two ordinary dictionary words “LOCAL” and “PAGES” which may serve in the trade to designate kind and intended purpose of the goods...The mark is wholly descriptive of classified telephone directories”. He goes on to say “The trade mark is not a coined phrase, but serves to designate the kind and intended purpose of the goods applied for, classified telephone directories relating to a local area”.

19. Mr Foreman also said at the hearing that (I quote from the official transcript of the hearing) “I think it has been accepted by the applicant, again looking at the note of the Hearing Officer [as exhibited in KG5] that the mark is prima facie non-distinctive, and that if this mark is to qualify for registration, it is to qualify on the basis that it has acquired distinctiveness through use”. I have to say I don’t necessarily read that interpretation into the Hearing Officer’s report of the hearing, neither did Mr Bernard admit as much at the hearing. The applicants denials of all grounds in their counterstatement and the statutory declaration of Mr Bernard would not seem support this view either.

20. I have to determine the prima facie case for acceptance of the mark under section 3(1)(b) and (c), before progressing to the second question of whether the proviso to section 3 is satisfied.

21. The opponents primary ground of objection is clearly under section 3(1)(c) of the Act and

it is this I will deal with first. In his skeleton arguments at paragraph 6, Mr Foreman states that “The mark is wholly descriptive of classified telephone directories”. At the hearing when I asked Mr Foreman to explain the basis for his clients objection to the mark, he said “The thrust of directories is for you to find something. If it is a local directory, that means you are looking for something in your region which is localized. Directories, and here we are talking goods in Class 16, printed matter, directories consist of pages. So you are looking at something which are pages which are of a local nature. This is not a national directory, but here is a page with local information. As opposed to being county wide or regional wide. Here is a particular directory, a particular page or set of pages which are of a local nature” (taken from the official transcript of the hearing).

22. Exhibit KG5 to Mr Gordon’s statutory declaration contains a copy of much the Registry’s case file, including some of the research undertaken by the examiner in reaching the registrar’s initial conclusions that the mark LOCAL PAGES was objectionable under the terms of section 3(1)(b) and (c). That research includes dictionary references taken from the Collins English Dictionary (Third Edition Updated 1994) for both the words in suit:

- LOCAL - 1. characteristic of or associated with a particular locality or area. 2. of, concerned with, or relating to a particular place or point in space. 3. Med.of, affecting, or confined to a limited area or part...4. (of a train, bus, etc) stopping at all stations or stops...6. an inhabitant of a specified locality. (There are six other definitions listed, but none are relevant here).
- PAGE - 1. one side of one of the leaves of a book, newspaper, letter, etc. or written or printed matter it bears.2. a leaf considered as a unit: insert a new page. (None of the other references are relevant).

23. Separately then, the meanings of the two words are fairly obvious and it is easy to see how each individually can be construed in the context of classified telephone directories. Telephone directories are local by their very nature, although the degree of locality varies and they obviously consist of pages. That however is not the full or correct test under the relevant sections of the Act. It is, well established that trade marks should be assessed in totality, not purely in their constituent parts. So what of the words LOCAL PAGES together, when viewed in relation to the goods at issue in this case?

24. As I have said earlier, it is of course also obviously true to say that telephone directories (in Class 16) are made up of pages. But is the combination of the words LOCAL and PAGES a normal way of describing telephone directories? From the definitions in the dictionary referred to above and from my own knowledge I would say no. In coming to this view, I have taken into consideration the recent Judgement of the European Court of Justice (ECJ) in Case C-383/99 P (Procter & Gamble v OHIM) - the “BABY-DRY” case. Here at paragraphs 39-43 the ECJ said:

39. The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate,

either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.

40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.

41. It is true that Article 7(2) of Regulation No 40/94 states that Article 7(1) is to apply notwithstanding that the grounds of non-registrability obtain in only part of the Community. That provision, which was rightly cited at paragraph 24 of the contested judgment, implies that, if a combination of words is purely descriptive in one of the languages used in trade within the Community, that is sufficient to render it ineligible for registration as a Community trade mark.

42. In order to assess whether a word combination such as 'BABY-DRY is capable of distinctiveness, it is therefore necessary to put oneself in the shoes of an English-speaking consumer. From that point of view, and given that the goods concerned in this case are babies' nappies, the determination to be made depends on whether the word combination in question may be viewed as a normal way of referring to the goods or of representing their essential characteristics in common parlance.

43. As it is, that word combination, whilst it does unquestionably allude to the function which the goods are supposed to fulfil, still does not satisfy the disqualifying criteria set forth in paragraphs 39 to 42 of this judgment. Whilst each of the two words in the combination may form part of expressions used in everyday speech to designate the function of babies' nappies, their syntactically unusual juxtaposition is not a familiar expression in the English language, either for designating babies' nappies or for describing their essential characteristics.

25. I think the above considerations are entirely apt in these proceedings.

26. As I stated earlier, the word LOCAL is readily (perhaps superfluously) associated with the innate nature of a telephone directory. But there is no evidence before me to prove that the word PAGES will be regarded by the general public as meaning a collective term for publications or printed matter of any sort or to it being another word for telephone directories. So where is the evidence that the words LOCAL PAGES used together “simply describes a classified telephone directory which is of local significance”?

27. Mr Foreman at the hearing pointed to the fact that the applicants' evidence suggests that the mark was chosen because by 1982, many clients of the applicants and members of the public were already referring to the applicants' directories as “Local Pages” (see the statutory

declaration of Mr Bernard at paragraph 3). Indeed, Mr Bernard himself states in his evidence that the mark “described the product perfectly”. However, there is nothing in the statutory declaration of Mr Bernard that tells me whether the words “Local Pages” was being used at that time by his clients in a trade mark sense or descriptively. Neither should I place too much weight on Mr Bernard’s use of words. There is simply not enough evidence to prove that the words “Local Pages” can be used in everyday speech as part of a description for the goods in suit. The final sentence to paragraph 43 of the BABY-DRY judgement (see above) would seem to summarise the position in these proceedings perfectly.

28. To my mind the words LOCAL PAGES require more to be added to them in order to make them directly descriptive and words which “may serve in trade to designate” the “kind” or “intended purpose” (as the opponents contend) of the goods in question.

29. In the pleadings and at the hearing, the argument was not advanced that the section 3(1)(b) ground might succeed even if the section 3(1)(c) objection failed. Consequently, having considered the remaining grounds for opposition and been called upon to cast a fresh eye on the prima facie case under section 3(1)(b) and (c) of the Act, I find that the mark LOCAL PAGES is not excluded under section 3(1)(c) and it follows neither is it devoid of any distinctive character under section 3(1)(b). As such these grounds of opposition fail.

30. That being the case, the question of whether the mark satisfies the proviso to section 3(1) is redundant.

31. As the opposition has failed, the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £1,000. This sum is to be paid within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 30th day of October 2001**

**G J Rose’Meyer**

**For the Registrar**

**the Comptroller-General**