

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION No 2219991
BY BILL GROSS' IDEALAB!
TO REGISTER A TRADE MARK
IN CLASSES 35, 36 AND 42**

DECISION AND GROUNDS OF DECISION

1. On 21 January 2000 Bill Gross' idealab! of 130 West Union Street, Pasadena, California 91103, United States of America applied under the Trade Marks Act 1994 for registration of the following series of twelve trade marks in classes 35, 36 and 42.

**IDEALAB.AC.UK
IDEALAB.GB.COM
IDEALAB.GB.NET
IDEALAB.LTD.UK
IDEALAB.NET.UK
IDEALAB.NHS.UK
IDEALAB.ORG.UK
IDEALAB.PLC.UK
IDEALAB.SCH.UK
IDEALAB.UK.CO
IDEALAB.UK.COM
IDEALAB.UK.NET**

2. It was subsequently agreed that the specifications be amended to read as follows:

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| Class 35 | Business management; business administration; office functions; marketing; advertising and promotional services and information services relating to business management, business administration, compilation of advertisements for use as web pages on the Internet; consultancy, advisory and information services related to business management; business marketing consultation services: accountancy: information relating to accountancy; business research. |
| Class 36 | Financial services; real estate affairs; information relating to financial services and real estate affairs; information relating to the aforesaid provided on-line from a computer database or the Internet; financial consultation, management and research; investment management, consultation and advice. |
| Class 42 | Legal services; graphic design; graphic design for the compilation of web pages on the Internet; information provided on-line from a computer database or from the Internet; creating and maintaining web sites; hosting the web sites of others; installation and maintenance of computer software; leasing access time to a computer database; computer software design for others and computer consultation |

services.

3. Objection was taken to the application under Section 41(2) of the Act because the marks do not form a series of marks because they differ in material detail.

4. At a hearing, at which the applicants were represented by Mr Olsen of Field Fisher Waterhouse, their trade mark attorneys, the objection under Section 41(2) of the Act was maintained.

5. 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 Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

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

7. Section 41(2) of the Act reads as follows:

“41.- (2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.”

8. In order to satisfy the requirements of Section 41(2) of the Act all twelve marks must, while differing from one another, differ only in respect of matter of a non-distinctive character which does not substantially affect the identity of each mark, that is to say it's identity with each and every other mark in the group propounded as a series.

9. At the hearing Mr Olsen agreed that all twelve marks are domain names but submitted that all marks consist of the distinctive word IDEALAB with the addition of suffixes which, in all instances, consist of approved domain name elements which do not affect the material particulars of the marks.

10. The Trade Marks Registry has developed a practice in relation to applications to register domain names as a series of marks. This is set out in a published Practice Amendment Circular (PAC 14/00). A copy of this PAC is attached at Annex A.

11. A domain name is an Internet electronic address and comprises two or more components. In all of the marks contained in this application the first element is the word IDEALAB which is a distinctive element. All of the marks contain additional matter which are known as top level domains and second level domains. Internet domain names should be read from right to left. The reason for this is that the top level name is the most important and always appears on the right hand side. The characters appearing to the immediate left of the top level domain name comprise the second domain name and functions as a qualifier to the top level domain name. With this in mind I have concluded that the marks IDEALAB.UK.CO and IDEALAB.UK.COM are acceptable as a series of two marks. Both of these marks consist of the word IDEALAB together with suffixes which indicate that the top level domain names both refer to commercial enterprises while the second level domain names both indicate that the commercial enterprises are based in the United Kingdom. However, it is my view that none

of the remaining ten marks form an acceptable series of marks, either with each other or with the two acceptable marks referred to earlier in this decision.

12. The remaining ten marks have several top level domain names. These consist of the letters UK, COM, and NET. The letters UK denote that the Internet address is based in the United Kingdom, the letters COM indicate a commercial enterprise and the letters NET are used to indicate the address of an Internet Service Provider.

13. The second level domain names present in the ten remaining marks are more varied and comprise the letters AC, GB, LTD, NET, NHS, ORG, PLC, SCH and UK. To the best of my knowledge these letters denote different types of activities. The letters AC denote academic activities. The letters GB denote activities within Great Britain while the letters UK denote activities within the United Kingdom. LTD denotes a limited company whereas NET denotes the activities of an Internet Service Provider. The letters NHS denote the National Health Service and the letters ORG denote a charitable or non-profit-making organisation. The letters PLC indicate a public limited company and SCH denote school activities.

14. The combinations of top and second level domain names indicate the Internet address of a particular type of organisation. The first mark is IDEALAB.AC.UK which indicates that the Internet address is within the United Kingdom, it is in the academic field and the name to which the address relates is IDEALAB.

15. Many of the suffixes contained within these marks may be well known to a substantial number of the relevant public but others may not be so well known. To a person who is aware of the meaning of -AC.UK it will convey a different message to -PLC.UK. However, to those (probably greater number of) persons who do not know what -AC.UK means, it will suggest itself as an arbitrary addition to IDEALAB and hence add to the distinctive character of that sign alone. In my view the suffixes contained within these marks substantially affect the identity of the marks.

16. At the hearing Mr Olsen voluntarily offered to enter disclaimers of the suffixes in all of the marks. For ease of reference Registrars practice in respect of voluntarily disclaimers is attached at Annex B.

17. In my view all of these marks must be judged in their totality and I do not accept that the entering of a disclaimer in respect of selected elements within the marks will have any effect on this decision. No disclaimer has yet been entered but in my judgement, should such voluntary disclaimers be entered in respect of any of the marks contained in this application it will not assist me in reaching my conclusion as to whether this application should be accepted or refused.

18. Given the differences between the marks applied for and the fact that they relate to different types of activities and to different types of organisations I am satisfied that the marks contained within this application differ as to their material particulars in such a way that they do not satisfy the requirements of section 41(2) of the Act.

19. In this decision I have considered all of the documents filed by the applicants and all of the arguments submitted 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 in that it fails to qualify under Section 41(2) of the Act.

Dated this 06 day of November 2001

A J PIKE

**For the Registrar
The Comptroller General**

ANNEX A

www.patent.gov.uk/tm/reference/pac/pac1400.htm

ANNEX B

Disclaimers

These are covered by Section 13(1)(a), and the wording is such that they are voluntary.

Unlike the power conferred by Section 14 of the 1938 Act, the Registrar will no longer be able to request a disclaimer of an objectionable element in a mark. It will however be open to the applicant to voluntarily enter a disclaimer. The most likely circumstances of this happening are as a result of opposition proceedings, but requests may be made at the initial application stage by applicants wishing to forestall opposition in due course.

Against this background examiners will be guided by the following principles:

Marks which would have been acceptable under the 1938 Act with disclaimed elements should be accepted without disclaimers under the 1994 Act.

The above applies equally to marks which consist entirely of descriptive/non-distinctive elements but where the totality forms an acceptable combination (that is to say marks which would only have been accepted on separate disclaimers in the past).

It follows that the offer of a disclaimer will not, in itself, influence the decision on the acceptability of a mark, and a disclaimer should only be accepted if volunteered by an applicant or an agent.

Where a disclaimer is requested by an applicant it will be for the applicant or his agent to provide the necessary wording. It will be accepted without editing, but if obvious errors are spotted, they should be brought to the attention of the applicant/agent. (See Chapter 9 for an example of wording that may be suggested to an applicant if he requires assistance).