

O-312-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
APPLICATION No 2290226  
BY THE COUNCIL OF THE BOROUGH OF HARROGATE  
TO REGISTER A TRADE MARK  
IN CLASS 32**

**DECISION AND GROUNDS OF DECISION**

**Background**

1. On 16 January 2002 The Council of the Borough of Harrogate of Crescent Gardens, Harrogate, HG1 2SG applied to register the trade mark **HARROGATE SPA WATER** in Class 32.

2. The application was made in respect of the following goods:

“Water; bottled and other table, spring, mineral and aerated water; drinking water.”

3. Objection was taken under Section 3(1)(b) and (c) of the Act because the mark consists of the words “Harrogate Spa Water” being a sign that may serve in trade to designate the geographical location of the goods e.g. water emanating from a spa in Harrogate.

4. Objection was also taken under Section 5(2) in respect of an application which was subsequently refused, therefore I need say no more about it.

5. In a letter dated 16 July 2002 Bailey Walsh & Co on behalf of the applicant asked for the evidence filed on registration no 2056795 to be copied across to this application to enable the application to proceed. The examiner informed Bailey Walsh & Co that the evidence did not enable him to waive the objection because it related to a different mark ie HARROGATE WATER.

6. At a hearing, at which the applicant was represented by Mr P B Dyson of Bailey Walsh & Co, their trade mark attorneys, Mr Dyson asked for clarification of what further evidence would be required. I advised him that I would consider evidence that this mark (HARROGATE SPA WATER) had acquired distinctiveness through use, such as turnover, exhibits etc showing use of this mark up to the filing date of this application, and evidence that the applicant owns exclusive rights in all sources of spa water in Harrogate.

7. Further evidence was submitted, which I did not consider to be sufficient to prove that the mark had acquired a distinctive character as a result of the use made of it. The objection was maintained and the application was subsequently refused on 21 July 2004 in accordance with Section 37(4) of the Act.

8. Following refusal of the application 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.

**The Law**

9. The relevant parts of Section 3(1) 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.”

**The prima facie case for registration**

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

10. In the ruling of the Court of Justice of the European Communities (ECJ) in *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v. Boots-und Segelzubehör Walter Huber*, Cases C-108/97 and C-109/97 [1999] ECR I-2779 it is stated:

“1. Article 3(1)(c) of the First Council Directive 89/104/EEC of 21 December 1988 [equivalent to section 3(1)(c) of the Trade Marks Act] to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that:

- it does not prohibit the registration of geographical names as trade marks solely where the names designate places which are, in the mind of the relevant class of persons, currently associated with the category of goods in question; it also applies to geographical names which are liable to be used in future by the

undertakings concerned as an indication of the geographical origin of that category of goods;

- where there is currently no association in the mind of the relevant class of persons between the geographical name and the category of goods in question, the competent authority must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods;

- in making that assessment, particular consideration should be given to the degree of familiarity amongst the relevant class of persons with the geographical name in question, with the characteristics of the place designated by that name, and with the category of goods concerned;

- it is not necessary for the goods to be manufactured in the geographical location in order for them to be associated with it.”

11. In *Windsurfing*, the ECJ noted (at para. 26) the public interest that geographical names remain available “not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response”. Furthermore, it is clear from a subsequent decision of the ECJ (see Case C-53/01) *Linde A.G. v. Rado Uhren A.G.* (8th April 2003) and a recent opinion of Advocate General Jacobs (see Case C-191/01P *OHIM v. Wm. Wrigley Jr. Company*) that the concept of keeping signs free for descriptive use is a consideration which continues to apply in assessing registrability under Section 3.

12. I believe that Harrogate is well known in the United Kingdom as a spa town, and therefore I am of the opinion that the average consumer would be likely to perceive it as an indication of the geographical origin of the goods applied for and it is thus debarred from registration. However the mark has to be considered in its totality as HARROGATE SPA WATER. I believe that SPA WATER is a non-distinctive element because it is merely a description of the type of goods, but I must consider whether the addition of these words creates a mark that is *prima facie* distinctive in its totality.

13. A judgement, issued by the European Court of Justice on 20 September 2001, *Procter & Gamble Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case - 383/99P, (the BABY-DRY case), gives guidance on the scope and purpose of Article 7(1)(c) of the community Trade Mark Regulation [equivalent to Section 3(1)(c) of the Trade Marks Act]. Paragraphs 37, 39 and 40 of the judgement are reproduced below:

"37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Procter & Gamble and the OHIM acknowledge, to prevent registration as trade marks signs or indications which, because they are no different from the

usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function."

"39. The signs and indications referred to in Article 7(1)(c) of Regulation 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."

14. These paragraphs indicate that only marks which are no different from the usual way of designating the relevant goods or services or their characteristics are now debarred from registration by Section 3(1)(c). In my view, there is nothing unusual about the phrase HARROGATE SPA WATER. The relevant public would not consider the mark to denote trade origin; their perception would be that the goods were water from a spa at Harrogate. The application is debarred from prima facie acceptance under Section 3(1)(c) of the Act.

### **Section 3(1)(b)**

15. For the same reasons the mark is not capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings. It is devoid of any distinctive character, and therefore it follows that this application is debarred from prima facie acceptance under Section 3(1)(b) of the Act.

### **The Case for Registration based on Acquired Distinctiveness.**

#### **The evidence copied across from Registration no 2056795**

16. The evidence was filed in support of an application to register the mark HARROGATE WATER. It consists of a Statutory Declaration of Gerald Fitzmaurice of the Council of the Borough of Harrogate (CBH) who states that the trade mark

HARROGATE WATER has been used by the applicant since at least the 16<sup>th</sup> century. He states that the goods on which the trade mark has been used are medicinal and non-medicinal still and sparkling waters from a variety of water sources within or near the town of Harrogate. The Statutory Declaration is accompanied by exhibits showing an extract from a history of Harrogate, advertisements for Harrogate water, and photographs of bottles of various types of Harrogate water. None of these exhibits shows the trade mark HARROGATE SPA WATER.

### **The evidence filed after the hearing on Application no 2290226**

17. The evidence consists of two Statutory Declarations. The first is by Gerald Fitzmaurice of CBH and is in large part a repeat of the Statutory Declaration filed in respect of Registration no 2056795. He states that shortly after 1891 water from various sources around the town of Harrogate was bottled and sold commercially as Harrogate Water, Harrogate Spring Water, Harrogate Spa Natural Table Water, and Harrogate Spa Sparkling Water. He states that annual sales under the various trade marks have varied from over 17,000 bottles each year in the 1930s to below one thousand in the 1990s. The Statutory Declaration is accompanied by exhibits as before, none of which shows the trade mark HARROGATE SPA WATER.

18. The second Statutory Declaration is by Paul Martin who is Managing Director of Harrogate Spa Water Ltd which, he states, is a joint initiative partner with CBH to produce and distribute bottled water from natural sources in the Harrogate area under the name Harrogate Spa Water. He states that CBH has distributed waters since at least the 16<sup>th</sup> century under various names including HARROGATE SPA WATER. Exhibit PM1 is a historical research paper entitled “References to the association of the words “Harrogate”, “spa”, and the subject of bottling, as practised by (1) private enterprise (2) Harrogate Council or its predecessors”, which traces the history of sales of spa water from Harrogate and the surrounding area from 1571 to date. He goes on to state that towards the end of the 1990s CBH decided to exploit the sales of spa water on a wider basis and commissioned a water source completion report, a copy of which comprises Exhibit PM2. He then traces the incorporation of his company Harrogate Spa Water Ltd and its agreements with CBH for lease of premises and production of bottled water to be sold under the name HARROGATE SPA WATER, copies of the relevant papers being shown in Exhibits PM3-5. Mr Martin states that his company commenced production of bottled waters under the trade mark HARROGATE SPA WATER and the first sales were made in May 2002. Exhibits PM6-13 relate to use of the trade mark on or after May 2002. These latter exhibits show that the applicant had begun to establish a brand under the trade mark since the relaunch of the product in May 2002. However, as this use of the mark is after the date of filing the application, it is of no assistance in demonstrating that the mark had acquired a distinctive character as a result of the use made of it before the date of application for registration, as required by the proviso to Section 3(1).

### **The Decision**

19. In connection with an earlier application to register the mark HARROGATE SPA WATER the applicant's trade mark attorneys had been advised by the registry that, if they agreed to copy across the evidence from their registration no. 2056795 HARROGATE WATER, the application to register HARROGATE SPA WATER would be allowed to proceed because of the applicant's prior rights in the earlier registration, in line with the registrar's practice at that time. However, by the time Mr Dyson asked the examiner to copy the evidence across to the present application, the registrar's practice had been revised, as set out in Practice Amendment Notice PAN 3/02, the relevant extracts from which are as follows:

“.....

### **General Principles**

2. In the case of a mark which has been accepted on the basis of factual distinctiveness in the UK, the Registrar will not routinely require applicants to prove that the mark is distinctive for the purposes of a subsequent application to register a later mark, incorporating the earlier mark, for the same goods/services.

.....

4. In all other cases, such as where the applicant applies to register a mark which consists of, or contains, a mark which is similar to an existing registered trade mark in its name for the same goods/services, or where the applicant applies to register an existing registered mark for goods/services which are similar to those for which it is already registered, the earlier registration will have whatever value it provides as a precedent.

### **Reasons**

5. The proviso to Section 3(1) of the Act makes it clear that a trade mark which is excluded from *prima facie* registration by Section 3(1)(b) - (d), may nevertheless be registered 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"*

6. The final words of the proviso make it clear that the question of factual distinctiveness must be determined by reference to the *use made* of the trade mark. In the TREAT case (1996 RPC 281) Jacob J criticised the registration of the TREAT mark for 'dessert sauces and syrups' when the evidence of use filed only showed use of the mark on 'ice cream toppings'.

7. The words *"acquired a distinctive character as a result of the use made of it"* therefore mean the use made of the mark in relation to the goods/services for which it is proposed to be registered. There is no provision in the 1994 Act

corresponding to the "special circumstances" provisions in Sections 9 and 10 of the 1938 Act. In this connection it should be noted that the infringement rights under the new law extend to the use of the same or similar marks in respect of similar goods/services, provided that there exists a likelihood of confusion.

8. Further, as the test for distinctive character under the new law has generally proved to be lower than under the old law, those marks which still fail the *prima facie* test for registrability tend to be so lacking in distinctive character that they cannot be assumed to be distinctive for new goods/services just because they have previously been shown to have acquired a distinctive character for other, albeit similar, goods/services.

9. The same applies to marks which consist of, or contain, a feature which is merely similar to the subject matter of an earlier registration in the applicant's name.

### **Detailed Practice**

#### **New trade mark includes existing registered mark - same goods/services**

10. A later trade mark which is *prima facie* objectionable under Section 3 of the Act will not normally face an official objection where the trade mark proposed for registration *includes*:

- an earlier trade mark which is already registered in the UK in the applicant's name and which proceeded on the basis of distinctiveness acquired through use;

AND

- which is registered in respect of ALL the goods/services covered by the later application;

PROVIDED THAT the earlier trade mark is *not*:

(i) *de minimis* in the later mark; OR

(ii) included in the later mark in such a way as to take away any distinctive character the earlier mark had when viewed alone.

11. For example, if an applicant already has a registration of JAMES (for ties) it would be appropriate to accept a subsequent application to register JAMES TIES or JAMES'S TIES (for ties). However, it would not follow that CHOICE COMPUTERS has acquired a distinctive character (for computers) because an applicant had established that PC CHOICE had acquired a distinctive character (also for computers) through use. Where all the elements in a trade mark are non-distinctive, the distinctive character is to be found in the specific combination of

the elements. CHOICE COMPUTERS is not therefore a minor variation on PC CHOICE. Nor would it be appropriate to accept an application to register KEEPS YOUR BABY DRY on the basis that the applicant had an existing registration of BABY-DRY because any distinctive character that BABY-DRY has is lost when incorporated into the longer phrase.

**Weight to be given to evidence of distinctiveness filed in respect of earlier registrations of the same mark for goods/services which are similar to those listed in the new application**

12. In all cases the applicant must file evidence showing use of the mark applied for, before the date of the application, in relation to the goods/services listed in the application.

13. However, it is recognised that marks that are factually distinctive for one range of goods/services can more quickly become distinctive for similar goods/services. Accordingly, in assessing whether the evidence the applicant has filed on the application under examination is sufficient to show that the mark has acquired a distinctive character for the goods/services listed in the application, account may also be taken of any evidence filed on earlier applications for the same or closely similar trade mark for the same or similar goods/services" [my emphasis underlined].

20. In line with the revised practice this application does not qualify for acceptance because of the applicant's prior rights. The earlier mark is HARROGATE WATER, the later mark is HARROGATE SPA WATER. Although the earlier mark is not *de minimis* in the later mark, it is not presented as a separate element in the mark, the mark in totality has a different meaning. If the distinctive character is to be found in the specific combination of the elements then the distinctive characters of the two marks are different.

21. I now turn to examine the evidence filed in respect of the present application. The question to be determined is whether, through the use made of it, the sign applied for has acquired a distinctive character as a result of the use made of it.

22. The evidence demonstrates that CBH has a long history of selling water "from various sources around the town of Harrogate", but there is nothing in the exhibits to either of the declarations of Gerald Fitzmaurice or Paul Martin showing use of the trade mark HARROGATE SPA WATER prior to the date of filing this application. It is clear from the wording of the proviso to Section 3(1) that a trade mark which is excluded from *prima facie* registration by Section 3(1)(b)-(d), may nevertheless be registered 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", and in *Windsurfing*, the ECJ ruled that:

"2. The first sentence of Article 3(3) of the First Directive 89/104/EEC [proviso to Section 3(1)(b)-(d) of the Trade Marks Act] is to be interpreted as meaning that:



— a trade mark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;”

and

“— in determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings” [my emphasis underlined].

23. Thus, in order to show that a mark has acquired a distinctive character, the evidence must show use of the mark in question. None of the evidence shows use, prior to the date of application, of the mark HARROGATE SPA WATER, therefore the evidence of use does not establish that the mark has come to identify the goods as originating from one particular undertaking.

24. The applicant has a registration of the mark HARROGATE WATER. The evidence shows that they have sold water of various kinds from various sources in and around Harrogate for a very long time. However, Exhibit 1 to the Statutory Declaration of Gerald Fitzmaurice shows examples of bottles of water from several different wells/springs/spas, and the water source completion report in Exhibit PM2 to the Statutory Declaration of Paul Martin refers to two different boreholes, together being evidence that there are several different sources of water in the Harrogate area. The historical research paper in Exhibit PM1 refers to the subject of bottling, as practised by private enterprise as well as by Harrogate Council or its predecessors. Therefore, I cannot be sure that the trade mark HARROGATE SPA WATER indicates a single trade origin, because I do not know whether CBH owns, or that a single undertaking would be perceived by consumers as having, rights in all sources of water in the area of Harrogate.

25. It has long been the registrar’s practice to accept the names of natural springs as trade marks provided the applicant could show that they had exclusive rights to sell the produce concerned; in fact under the 1938 Act it was practice to impose a condition of registration that “in the event of the proprietors of this mark ceasing to have the exclusive right to sell natural mineral water the produce of ..... , they will voluntarily cancel this registration”. Mr Dyson was invited to submit evidence that the applicant owns exclusive rights in all sources of spa water in Harrogate, but no such evidence was submitted.

## **Conclusion**

26. For the reasons indicated, the mark is not acceptable prima facie because it is debarred from registration by Section 3(1)(b)&(c) of the Act.

27. The evidence filed to substantiate the claim that the mark has acquired a distinctive character is insufficient to satisfy the proviso to Section 3(1)(b)-(d) of the Act.

28. 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 and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) and (c) of the Act.

**Dated this 13th day of October 2004.**

**Anne Pritchard**

**For the Registrar  
The Comptroller-General**