

**BEFORE:**

**MR SIMON THORLEY QC**

**IN THE MATTER OF THE TRADE MARKS ACT 1994**

**AND**

**IN THE MATTER OF APPLICATION NO 2103419 FOR REGISTRATION  
OF THE MARK BONUS GOLD IN CLASS 36  
IN THE NAME OF HALIFAX BUILDING SOCIETY**

**APPEAL OF APPLICANT FROM THE DECISION OF  
MR C J BOWEN DATED 22<sup>ND</sup> DECEMBER 1997**

**MR K L HODKINSON of Messrs Marks & Clerk appeared as Agent  
on behalf of the Applicant**

**MR A JAMES appeared on behalf of the Patent Office**

**D E C I S I O N**

Mr Thorley: This is an appeal to the Appointed Person by Halifax Plc against the decision of Mr Bowen, the Officer acting for the Registrar, dated 22 December 1997. In that decision he refused to register the trade mark BONUS GOLD pursuant to application No 2103419 in Class 36 in respect of investment account services. He held that as an unused mark  
5 registration of the words BONUS GOLD would offend against section 3(1)(b) and (c) of the 1994 Act.

He cited from dictionary definitions defining the word “bonus” and the word “gold” and he also cited the extract from the Registrar’s practice with regard to the word “gold”. This  
10 practice states that “in most instances the word “gold” is open to objection because it is a common surname and is also laudatory.”

However, having considered this, he went on to conclude:

15 “When placed together, and when used in connection with the services for which registration is sought, the meaning the words BONUS GOLD are likely to convey to the public, is that here we have an investment account which pays a superior (or higher) level of bonus to that of an ordinary account.”

20 I was helpfully provided with a very full statement of case in support of the appeal and that has been amplified before me today by Mr Hodgkinson who appeared on behalf of Halifax. His first and primary objection to the Hearing Officer’s decision was that he was wrong to consider the meaning of the trade mark BONUS GOLD be reference to separate integers. He contended that the correct course was to consider the words as a combination. He said it was a novel  
25 combination and amplified the sentence in paragraph 2 of his statement of case which contended that “the combination did not in any way give an indication in itself to the type of service or account offered.”

The consideration of combination marks always raises the problem of how much weight  
30 should be given to the individual integers as contrasted with the mark as a whole. Mr James, who appeared for the Registrar, suggested that it was proper to consider the components

separately and then to ask whether in combination they constituted more than the sum of the individual parts. I think this is a helpful approach as long as it does not cause the Registrar to lose sight of the fact that what is sought to be registered is the mark as a whole. In order to assess the impact of the whole on the public, it must be proper to consider the various integers separately and then to consider whether as a whole the possible descriptive or other objectionable indication of the individual words is subsumed into the totality.

It was in this respect that Mr Hodkinson sought to criticise the reference to the Registrar's practice because he said that whilst that may be appropriate for a mark consisting of the word "gold", it was inappropriate when it is a mark which merely comprises the word "gold".

The Registrar's practice is a useful guideline to practitioners. It cannot however be allowed to supplant the actual language of the Act. Plainly there are some cases where the word "gold" either alone or in combination will have a descriptive meaning, other cases where it would be laudatory, others surnominal and others no doubt distinctive.

As I see it, the question on this appeal is what could be the significance of the expression BONUS GOLD in relation to investment account services? Looking first at the word "gold", it is a matter of common knowledge - as Mr Hodkinson readily accepted - that gold is a word currently in relatively widespread use in the field of banking and finance to indicate some form of premium services. In relation to the class of goods for which registration is sought (investment account services) the term "gold" is both descriptive and laudatory.

So far as concerns the word "bonus" that is not unknown in the financial field, but it is also extremely well-known and used as a descriptive term in the course of ordinary use of language. Mr James suggested that by itself it was incapable of distinguishing and I think he is right.

The next consideration is whether putting the two together does create, as Mr Hodkinson suggested, a combination phrase that has no real meaning in English which, at best, merely alludes to or points in the direction of the type of service to be provided, and was not as such

contrary to Section 3(1)(b) and (c).

I have concluded that this is a case where putting the two words together does give nothing more than the sum of the individual parts. I listened with care to Mr Hodkinson's submission to try and see whether I could discern any virtue in the combination over and above the obvious meanings of the two words separately and I could not. Prima facie therefore believe Mr Bowen's conclusion cited above is correct. He did not fall into error by failing properly to consider the mark as a combination.

However, Mr Hodkinson went on to support his argument by reference to the previous registration of a number of marks by Halifax containing the word gold. He accepted that a number of these were registered with evidence of use, but said, quite properly, that taking the easy course and relying on use cannot be indicative that the marks were unregistrable as prima facie applications.

He submitted that the use that had been made of these other marks was indicative that there was no need to educate the public (that the mark BONUS GOLD was a trade mark) because they were already educated by reason of the use of the earlier marks. This is an argument which has to be considered with care.

In the TREAT case, *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, at 305 Jacob J considered the effect of previous registrations and concluded as follows:

“Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of work in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular

mark tendered for registration, see eg MADAME Trade Mark, and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

5 Mr Hodkinson did not dissent from this as a statement of law, but did urge that things were different when he was relying upon the use of the former marks rather than their mere existence on the register. I can see the substance of this as a point of argument, but what in truth he is seeking to do is to substitute the use of the old marks for use of the new mark to try and show that the new mark is itself distinctive.

10 As I said, this is a submission which has to be approached with care. The nature and length of the use that was sufficient to obtain registration under the old Act may well not be the same as the nature and the extent of the use which is required to register under the new Act. Equally evidence of use in relation to a mark such as OVERSEAS GOLD may well be different to the evidence that would be needed to support the mark BONUS GOLD.

15 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.

25 I have not found this an easy case. The arguments and submissions of Mr Hodkinson have made the decision more difficult and I am grateful for the arguments. But in the end I am of the clear view that this is not a mark that should be registered without evidence of use. I therefore dismiss this appeal.

No order as to costs?

30 Mr James: Yes, Sir, we have to go along with the normal arrangements.