

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2239970
BY COPPLESTONE STORES
TO REGISTER THE TRADE MARK:
PARCELPOINT
IN CLASS 39**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 51955 BY
PAYPOINT NETWORK LIMITED**

TRADE MARKS ACT 1994
IN THE MATTER OF Application No 2239970
by Copplestone Stores
to register the trade mark:
PARCELPOINT
in class 39
and
IN THE MATTER OF Opposition thereto under No 51955
by Paypoint Network Limited

Background

1) On 20 July 2000 Copplestone Stores applied to register the trade mark **PARCELPOINT**. The application was published on 4 October 2000 with the following specification:

storage of parcels and similar items – class 39

2) On 4 January 2001 Paypoint Network Limited filed notice of opposition to this application.

3) The opponent states that the trade mark in suit is directly descriptive of the service as it has the meaning of a point i.e. place at which parcels may be stored for later collection. The opponent states that in these circumstances the registration of the trade mark in suit would interfere with the freedom of competitors legitimately to describe competitive or similar services. Consequently the trade mark in suit is devoid of any distinctive character and its registration would offend against the provisions of section 3(1)(b) of the Act.

4) The opponent filed a counterstatement denying the above grounds.

5) Both parties seek an award of costs. Both parties filed evidence. They both agreed that a decision could be made on the basis of the papers filed. Consequently a decision will be taken from a careful study of the papers.

6) Acting on behalf of the registrar I duly give the following decision.

Opponent's evidence

7) The opponent's evidence consists of a witness statement dated 2 July 2001 by Mark Alan Armitage, who is a trade mark attorney.

8) Mr Armitage exhibits at MAA1 a copy of the official file for the application in suit. The exhibit shows that the application was originally objected to under section 3(1)(b) of the Act but that this objection was subsequently waived following submissions from the applicant. Mr Armitage states that in his view the examiner was wrong to waive the official objection upon the basis of the applicant's submissions. He states that the clear meaning of PARCELPOINT is, as originally stated by the examiner, a collection/storage point for parcels being a term which others in the trade may legitimately wish to use for such services.

9) Mr Armitage states that the applicant filed various documents in response to the objection, including one entitled “Cobblestone Stores – Latest News” which describes the services in considerable detail. He states that this document emphasises that the PARCELPOINT service provides “somewhere to have your parcels kept for you in a secure environment and available to be picked up at a time that is convenient”. Mr Armitage states that in other words it provides a collection point for parcels and it is difficult to envisage a combination of words which is more apt to describe such a service than the words “parcel” and “point”. He states that the applicant clearly recognises the descriptiveness of these words in the “Comments on PARCELPOINT Application” as it is stated in point 6 “there is no reason that the words Parcel Point cannot be used. The difference is the space between. We have no reason or wish to consider that as part of our trademark. The trade if so required could still use these words”. Mr Armitage states that this is tantamount to a recognition by the applicant of the descriptiveness of the words “parcel” and “point” with a claim that the distinctiveness of the trade mark in suit resides in the fact that the words are conjoined. Mr Armitage states that this is confirmed again at point 7 where it is stated that “Not having the space is a distinct difference”. He states that it is a well accepted principle of trade mark law that merely conjoining two descriptive words does absolutely nothing to increase the distinctiveness of the words as a trade mark. Mr Armitage finds it extremely puzzling that the examiner, having raised what appears to be a perfectly valid objection, saw fit to withdraw it on the basis of the submission that the distinctiveness of the trade mark lies in the absence of a space between the words. Mr Armitage states that the examiner also refers to “previous acceptances” and states that this surely cannot be a reference to the words listed at point 3 – paypoint, postman, postbox, postcard, mailbag and mailpoint. Mr Armitage submits that such acceptance was clearly misconceived (sic).

10) Mr Armitage states that postman, postcard and mailbag are not trade marks as claimed by the applicant but generic terms open to all to use. He states that exclusive rights could not be claimed in these words, whether or not conjoined, in relation to any form of postal service. He states that the same applies or should apply for the trade mark in suit. Mr Armitage states that the trade mark in suit would be seen as having a place or point at which a parcel can be obtained, which is how the applicant intends the trade mark to be perceived.

11) Mr Armitage states that the application in suit should be refused as its registration would hamper the right of competing businesses to describe similar services providing a point at which parcels can be collected, notwithstanding the applicant’s assurances that the trade could still use the words in the form Parcel Point. He states that this might be the view of the applicant but that there is nothing to stop him assigning the trade mark to a third party who might take a completely different view of the extent of the rights.

Applicant’s evidence

12) The applicant’s evidence consists of witness statement dated 27 September 2001 by Michael Alan James, who is the proprietor of Cobblestone Stores.

13) Mr James states that the applicant has set up and developed the parcel collection initiative, initially in order to provide a service to those living in rural areas, providing a delivery point at a local shop. He states that the service has been developed by small shops and enables other small stores to provide an additional service to their customers. Mr James states that the service is established and that the applicant has been using PARCELPOINT

since May 2000. He states that it is intended to expand the service and to set up delivery locations at stores throughout the country.

14) Mr James exhibits at MAJ1 a copy of his counterstatement. He states that in October 2000 the opponent offered to purchase the trade mark in suit. He exhibits a copy of a letter dated 11 October 2000. (The letter is from Mr Armitage but does not actually mention for whom he is acting.) He submits that the opponent wished to acquire the trade mark in suit as he already owns the PAYPOINT trade mark and possibly wishes to expand his brand. Mr James states that the fact that the opponent was keen to purchase the trade mark in suit indicates to him that the trade mark is distinctive and has intrinsic value as well as value in the commercial sense.

15) Mr James refers to the application in suit initially being objected to by the registrar but that following written submissions she waived the objection. He exhibits as MAJ2 the registrar's letter in relation to this matter.

16) Mr James states that the opponent in his statement of grounds refers to the trade mark in suit being directly descriptive but that he does not specifically refer to section 3(1)(c) of the Act. He submits that the application should not be refused under section 3(1)(c).

17) Mr James exhibits at MA4 a copy of the search report for the application in suit. He notes from this that MAILPOINT was successfully registered in class 39 and has been renewed subsequently. He states that he understands that since this particular application was submitted the Trade Marks Act 1994 has come into force which has eased the requirements that have to be fulfilled by an applicant in order to qualify for registration. He argues that if MAILPOINT is registrable that PARCELPOINT is registrable prima facie. Mr James states that the opponent has successfully registered PAYPOINT. He exhibits at MAJ5 a copy of details of the trade mark PayPoint. Mr James states that Mr Armitage states in his statement that "merely conjoining two descriptive words without a space does absolutely nothing to increase the distinctiveness of the words as a trade mark." Mr James submits that the registration of PAYPOINT indicates that this argument lacks merit. Mr James states that he has previously referred to the acceptance of mailbag, postman and postcard as trade marks. He exhibits at MAJ6 trade mark searches of these words. Mr James submits that if MAILPOINT and PAYPOINT are registrable then the argument that PARCELPOINT is descriptive should fail.

18) Mr James submits that the registrar has previously determined that registration of PARCELPOINT should not be refused on the basis of section 3(1)(b) and that there is no absolute ground on which registration should be refused. He submits that PARCELPOINT does have distinctive character. He submits that if section 3(1)(b) should apply that the trade mark in suit has acquired a distinctive character as a result of the use made of it. Mr James states that newsletters setting out the scope of the service have been in circulation and used by the applicant since approximately June 2000. He states that the newsletter was sent to all shopkeepers throughout Devon on or around 29 June 2000. He exhibits at MAJ7 copies of the newsletter sent to all shopkeepers along with update newsletters sent to particular shops. None of the newsletters bear a date.

Opponent's evidence in reply

19) The opponent's evidence in reply consists of a further witness statement by Mr Armitage, dated 26 November 2001.

20) Mr Armitage submits that the trade mark in suit is descriptive of the services for which it has been applied. He exhibits at MAA2 a copy of a web page relating to Red Star Parcels Ltd. He states that this company makes use of the words "Parcel Point" to describe a place at a station where a consignment may be collected. He states that he understands that there is a parcel point at Victoria Station in London. The copy of the web page has a downloading date of 30 October 2001, after the relevant date. The one reference to "Parcel Point" is as follows:

"When a consignment is presented at any Red Star Parcel Point the customer will be advised of its arrival time at any of more than 200 destinations".

21) Mr Armitage states that Mr James was incorrect to stated that the opponent has registered the trade mark PAYPOINT. This trade mark, he states, is in fact a composite trade mark in which PAYPOINT only forms a part. Mr Armitage exhibits at MAA3 a copy of the trade mark as registered.

Decision

22) The applicant has referred to section 3(1)(c) of the Act in his evidence. However, the only ground pleaded by the opponent is section 3(1)(b). Section 3(1)(b) states:

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

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

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.

23) The applicant has referred to other registrations. In relation to POSTMAN, Mailbag and POST CARD the nature of the specifications is such that the registrations are not on a par with the application in suit. In relation to PAYPOINT this is in fact a composite trade mark, which I reproduce below:



As a composite mark with a strong device element it is not on a par with the application in suit. The trade mark MAILPOINT is, I consider, much more on a par with the trade mark in suit and encompasses similar services; inter alia storage of letters, messages and parcels.

However, although the registrar aims for a consistent approach I must consider the case before me and make a decision upon the facts of the instant case. My prime consideration is whether the trade mark in suit is registrable, it is not to effectively decide upon the merits of an earlier registration and to extrapolate a conclusion from that.

24) The applicant has attacked the argument of the opponent where he submits that “merely conjoining two descriptive words without a space does absolutely nothing to increase the distinctiveness of the words as a trade mark”. He submits that the registration of PAYPOINT indicates that this argument lacks merit. However, that trade mark is a composite trade mark and so his argument falls in relation to that basis. In the instant case I can see nothing that would turn upon the words “parcel” and “point” being conjoined or separated. The conjoining of the words does not affect their meanings or create a whole that dilutes those meanings.

25) The web site evidence of Mr Armitage emanates from well after the relevant date. The usage is also not clearly generic. The words are in capitals and form part of a composite with Red Star. Therefore, I do not consider that the web site evidence has a bearing upon the instant case.

26) The applicant argues that, even if the trade mark in suit was not registrable *prima facie*, by 20 July 2000 it had acquired a distinctive character owing to its use. The claim is somewhat optimistic. It is based upon a newsletter sent to shopkeepers in Devon on or around 29 June 2000. This clearly excludes the rest of the United Kingdom.. The applicant does not produce any figures relating to turnover. I do not consider that the issuing of a newsletter less than a month before the filing of the application in suit to a small area of the United Kingdom is indicative that the trade mark in suit has acquired a distinctive character through use. Consequently I do not consider that the applicant can prey in aid to acquired distinctiveness if I find that the trade mark in suit is objectionable under section 3(1)(b) of the Act.

27) The applicant has referred to the opponent attempting to purchase his trade mark. There is no evidence that the opponent was the person attempting to purchase his trade mark. However, as Mr Armitage was acting for the potential purchaser as well as for the opponent it can be understood why the applicant considers that the two are one and the same. Mr Armitage in his evidence in reply does not deny the claim of the applicant that the persons are one and the same. I, therefore, consider it reasonable to accept that the potential purchaser and the opponent are one and the same. The opponent through these two actions might be considered to be somewhat disingenuous in his actions but I do not consider that anything turns upon the matter. All I have to consider is whether there is a foundation to his objection. Equally I take no account of the decision of the examiner to waive the objection that was originally raised. I have to consider the issue afresh based upon the evidence before me.

28) In *EUROCOOL* Case T-34/00 the Court of First Instance stated that :

“The distinctiveness of a trade mark must be assessed, first, in relation to the goods or services for which registration of the sign has been requested (see Case T –345/99 *Harbinger v OHIM (TRUSTEDLINK)* [2000] ECR II – 3525, paragraph 32), and, second, in relation to the perception of the section of the public targeted, which is composed of the consumers of the goods or services.”

In the above decision the court goes on to state:

“The fact that the sign at issue is made up of components which may allude to certain features of the services referred to in the application for registration and that the combination of those components complies with linguistic rules is not sufficient to justify application of the absolute ground for refusal laid down by Article 7(1)(b) of Regulation No 40/94, unless it amounts to proof that such a sign, looked at as a whole, would not enable the section of the public targeted to distinguish the applicant’s services from those of its competitors.”

In the above decision the court points out that it is clear from the case law of the Court of First Instance that the absence of distinctive character cannot arise merely from the finding that the sign in question lacks an additional element of imagination or a minimum amount of imagination.

29) Adapting the test set out by the court in *EUROCOOL* the question that needs to be put in relation to the trade mark in suit is as follows:

Whether the term PARCELPOINT, taken as a whole, enables the section of the public targeted to distinguish the services of the applicant from services with a different commercial origin.

PARCELPOINT alludes to the services in that parcel appears in it, however, this does not make it necessarily devoid of distinctive character according to European jurisprudence. It is certainly not the most obvious way of describing the service of the storage of parcels or similar items. I consider that the trade mark as a whole represents to an extent an unusual combination of the words “parcel” and “point”. “Point” is not a word that one would normally use in relation to a place where one stores or even picks up parcels. In *David West t/a Eastenders v Fuller Smith & Turner PLC* case no HC 00 03374 Mr Christopher Floyd QC, sitting as a deputy high court judge held:

- i) “Sections 3(1)(b), (c) and (d) are not designed to exclude from registration marks which merely possess an indirect descriptive connotation: the words “devoid of any” in subsection (b) and “exclusively” in (c) and (d) are to be given effect to:
- ii) the fact that some mental activity is necessary in order to discern a reference to the quality or a characteristic of the goods may assist in its registrability;
- iii) uncertainty as to the precise nature of the reference to the quality or character of the goods will also assist;”

I consider that there would be uncertainty as to the precise nature of the services. I can see no reason why PARCELPOINT would not enable members of the public who pick up stored parcels or the like to distinguish the service of the applicant from other commercial concerns. I consider that the sign can readily form its purpose as indicator of origin by nature and does not require the nurture of use.

30) Consequent upon the above I find that the trade mark in suit is not devoid of distinctive character and the objection under section 3(1)(b) is dismissed.

31) The applicant is entitled to a contribution towards his costs and I therefore order the opponent to pay him the sum of £800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11TH day of March 2002

**D.W.Landau
For the Registrar
the Comptroller-General**