

O-164-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3133721 BY UNI BAGGAGE LTD TO
REGISTER THE FOLLOWING SERIES OF TWO TRADE MARKS**

**UNI BAGGAGE
UNIBAGGAGE**

IN CLASSES 9, 16, 35 AND 41

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO 406184
BY SENDMYBAG (NI) LTD**

Background and pleadings

1) Uni Baggage Limited (“the applicant”) applied to register the trade mark no. 3133721 for UNI BAGGAGE/UNIBAGGAGE (Series of 2 marks) in the UK on 20 October 2015. It was accepted and published in the Trade Marks Journal on 4 December 2015 in respect of the following list of services:

Class 39: *Courier services for the delivery of goods.*

2) Sendmybag (NI) Ltd (“the opponent”) opposes the trade mark on the basis of sections 3(1)(b), (c) and (d) and section 3(6) of the Trade Marks Act 1994 (“the Act”). Its section 3(1) grounds are on the following basis:

- The marks “designates the kind and intended purpose of the claimed services”;
- “[d]ue to the descriptive nature of the term ...the mark is unable to provide distinctive character”, and;
- The marks are “customary in current language and in the bona fide and established practice of the trade”.

3) In respect of the grounds based upon section 3(6), the opponent claims that the parties have been involved in litigation (and subsequently resolved in mediation) and that, during the litigation, the applicant counter-claimed that the opponent’s use of “university baggage” and “uni baggage” was descriptive. The contested application was subsequently filed. The opponent further claims that the application is an attempt to stifle use of the term “university baggage” or “uni baggage” by other couriers in a descriptive context. It argues that this is particularly relevant because the Registry’s examiner took no initial objections (as he did in respect of the contested marks) to the word and device marks that reflect the applicant’s actual use.

4) The applicant filed a counterstatement denying all the claims and stating that the terms “uni baggage” and “unibaggage” are not descriptive claiming it is a manufactured word thought up by the founder of the applicant.

5) The applicant was unrepresented in these proceedings and the opponent was represented by Hanna IP.

6) Both sides filed evidence in support of their case, but neither side requested a hearing and I make my decision after careful consideration of the papers,

Opponent’s Evidence

7) This takes the form of a witness statement by Adam Ewart, Chief Executive Officer of the opponent. At Exhibit SMB1 he provides a print-out for the search for the term “uni” obtained from the “OneLook Dictionary” platform that lists numerous dictionaries where a reference to “uni” can be found. He provides a screenshot from two of these: the first from www.collinsdictionary.com that defines “uni” as a noun short for “university”. A second screenshot is provided from www.macmillandictionary.com that provides a similar definition.

8) At Exhibit SMB2 definitions obtained from the same source are provided for the word “baggage”. Oxford Dictionaries define the word as a noun – “Personal belongings packed in suitcases for travelling; luggage”. Collins English Dictionary defines it as: “suitcases, bags etc., packed for a journey; luggage”.

9) Mr Ewart acknowledges that there are other definitions of the term “uni”, but submits that a set of words cease to be descriptive simply because it can have several meanings.

10) To counter the applicant’s claim that the term is not a natural word used to describe luggage owned by students, at Exhibit SMB3, Mr Ewart provides a number of Internet advertisements by the applicant showing, what he submits, is descriptive use. These provide contact details as either niparcels.com or unibaggage.com and, at Exhibit SMB27, Mr Ewart provides an article written by Paul Stewart of the

applicant describing the applicant as “a courier group, which consists of Uni Baggage, NI Parcels”. Typical of these advertisements is the one shown below:

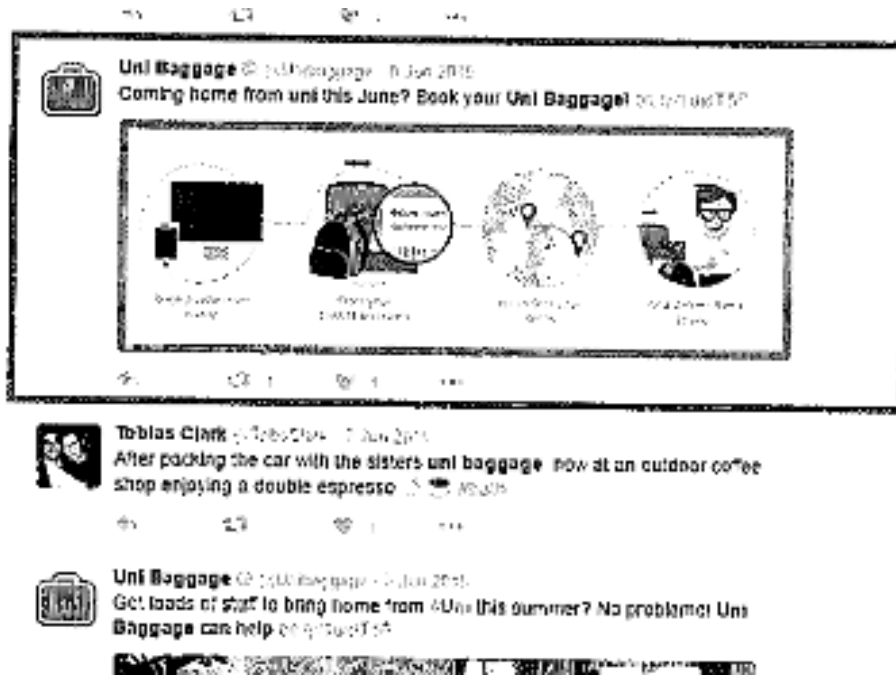


11) Exhibit SMB4 consists of a number of examples of, what Mr Ewart claims, is the applicant using its mark descriptively. The following two extracts are typical examples:

(dated 30 September 2015)



(dated 8 June 2015)



12) Exhibit SMB5 includes a screen shot from the applicant's website, dated 23 May 2016, and shows a section entitled "Uni Baggage Boxes". Mr Ewart asserts that this is an obvious reference describing "boxes for your uni baggage". He points out that this is so because the applicant does not provide boxes (and it recommends, to the reader, a pack of boxes available on *Amazon*) and, consequently, no other meaningful expression can be inferred.

13) Exhibit SMB6 consists of a selection of seventeen screen shots from a *Twitter* feed showing students making descriptive reference to their "uni baggage". These are dated between 10 December 2011 and the filing date of the application and a small but typical selection of these is shown below:

"Buzzing that I got my teddy fitted into my uni baggage. Clothes less now for the next 3 days" (11 September 2015)

"Overcome with fear that the labels will fall off my suitcase n I'll never get my uni baggage back" (15 January 2015)

“really hope my uni baggage comes soon as they said it would be delivered by 6 and I’m not in tomorrow” (22 September 2014)

14) Exhibit SMB7 consists of screenshots from the website www.myunidays.com illustrating, what Mr Ewart asserts is “generic use of a slight variation of the [applicant’s] mark”. The relevant two references appear to be: “Choose Your Topman Uni Bag” and “WHICH BAG SHOULD YOU CHOOSE FOR UNI”. Mr Ewart dates the article to approximately August 2015. A further example is provided at Exhibit SMB8 consisting of a “student life blog” from the website of the University of Wales, dated 19 September 2014 entitled “4 things to make sure you have in your Uni Bag!”

15) A screen shot of a Google search result for “uni + baggage” conducted on 17 July 2016 is provided at Exhibit SMB9. One hit is entitled “Moving Uni Baggage & Student Luggage When Studying Abroad”. A copy of the full article is also provided.

16) At Exhibits SMB10, SMB11 and SMB12, Mr Ewart provides a number of the opponent’s own press releases dating back to October 2012 which includes the following text at the end:

“For further information about avoiding excess baggage fees, or for a competitive quote to ship holiday or uni baggage, please visit www.sendmybag.com”

17) The following evidence of the opponent’s descriptive use of the term “uni baggage” on its own website is provided:

Exhibit SMB13: an extract dated 15 March 2015 where, on page 4, it includes the partial sentence states “...worldwide and getting your uni baggage to you on time hassle free”;

Exhibit SMB14: an extract dated 25 June 2014 and includes “...book your delivery online at SendMyBag ... and your uni baggage will be collected to be taken ready and waiting for you at your digs”;

Exhibit SMB15: a print out from the opponent's Irish website, dated 2 October 2015, and includes the following statements: "[The opponent] is a student luggage shipping provider and student removals expert which can send your excess uni baggage worldwide ...", and "...getting your uni baggage to you on time, hassle free".

18) Mr Ewart provides the following examples of use of "uni baggage" by competitors of the opponent and applicant, prior to the filing date of the contested application:

Exhibit SMB16: a screen shot from a *Twitter* feed, dated September 2010 where Seven Seas Worldwide, tweets "How do you get someone else to take your uni baggage to your new place ..." and "Off to #uni but no idea how to take all your gear with you? Good news – we have the perfect uni-baggage solution!"

Exhibit SMB18: a screen shot from the website www.baggageshippinglondon.co.uk, carrying a 2015 copyright notice, where it is stated "We can help International students studying in London to move, ship, send luggage, bag, suitcase of books worldwide from the perspective universities in London We can collect your uni baggage from all over Greater London student halls ..."

Exhibit SMB19: an undated screen shot of a *Google* search for "unibaggage" that shows an advertisement where the website link is www.luggagemule.co.uk/Unibaggage.

Exhibit SMB20: an undated screen shot of a *Google* advertisement that Mr Ewart asserts is for a competitor called First Luggage, but this is not discernable from the advert that is headed "Uni Bag Delivery Service". Two identical extracts from First Luggage's website, dated 18 December 2014 and 9 January 2016 respectively, are provided at Exhibit SMB21, and include the same statement "We will arrange for your uni luggage to be collected ...". Mr Ewart submits that the relevant consumer will understand the terms "uni luggage" and "uni baggage" to have identical meanings.

Use by non-UK third parties of the term “uni baggage” in a similar way to use in the above examples is also shown in Exhibit SMB22 to SMB25.

19) At Exhibit SMB29, Mr Ewart presents *Google* trend information in relation to the term “uni baggage”. This illustrates that there were searches for the term at times of the year from 2005 (i.e. before the applicant commenced trading in 2009), but that there was a general trend of increasing number of searches between 2009 and 2013 before becoming more consistent thereafter.

20) Exhibit SMB26 consists of an article that appeared in the *Guardian* newspaper and another that appeared in the *Financial Times* dated 12 and 7 September 2014, respectively. Both refer to the applicant as “Uni Baggage”. These are articles relied upon by the applicant when overcoming the objections of the Registry’s Examiner during the application process. Mr Ewart points out that these references are both in respect of the applicant providing transportation for students to university and not their belongings.

21) In support of the opponent’s claim of bad faith, Mr Ewart provides a timeline of events between the parties, the most relevant of which are:

31 March 2015: the opponent filed a claim against the applicant with regard the publication of false and misleading information about the opponent’s business;

13 April 2015: the applicant filed a counterclaim alleging passing off and seeking the removal of “university baggage” and “uni baggage” from the opponent’s website;

21 October 2015: the opponent responded pointing out the descriptive nature of the terms and that “uni baggage” is not a registered trade mark;

28 October 2015: the applicant applied for the contested marks;

13 November 2015 – 1 December 2015: examination process where the marks were originally objected to because of their perceived descriptive nature, but the objections were subsequently waived

Applicant's Evidence

22) This takes the form of a witness statement by Paul Stewart, managing director of the applicant. Mr Stewart makes numerous submissions (rather than evidence of fact) that I will keep in mind but not detail here.

23) At Exhibit A, Mr Stewart also provides *Google Trends* evidence in respect of the search terms “Uni Baggage” and “UniBaggage”. The timelines shown at the base of the graphs is imprecise, but the activity related to the terms appear to begin about halfway between 1 December 2007 and 1 January 2011 and appears to be approximately consistent with Mr Stewart's claim that was not used online before the applicant was founded in 2009. Mr Stewart points out that the opponent's similar evidence is different because the opponent's search term did not include quotation marks. He states that this is important because quotation marks limit the search to only the phrase within the quotation marks and removes trends for such use as “I wonder how much baggage I will need to take to Uni”.

24) Mr Stewart believes the mark is acceptable *prima facie* but that, nevertheless, it is acceptable because of the prior use of the mark made by the applicant. At Exhibits B and H he provides articles that appeared in mainstream media and are about the applicant's business and services. All refer to the applicant as “Uni Baggage”. An article that appeared in the *Belfast Telegraph* on 25 September 2012 notes that the “business [...] was only launched properly in March 2010”. The same *Financial Times* article that is exhibited by the opponent is also included, as is an article that appeared in the *MailOnline* on 1 September 2014 and refers to “the delivery specialist Uni Baggage”. Articles that appeared in the *Daily Mirror*, *Irish News & News Letter* and on the website *BelfastLive* are shown, but it is not possible to discern the text or the date.

25) Mr Stewart states that the applicant has spent considerable time and expense creating the Uni Baggage brand and has 40,000 customers and 100,000 unique visits a month to its blog. He states that there is over 4,100 mentions of the brand on *Twitter*. It is also stated that the applicant has a blue verified badge from *Twitter* and at Exhibit C is a page describing that a blue verified badge lets people know that an account of public interest is authentic. It also indicates that the applicant has 3,761 followers.

26) At Exhibit E, Mr Stewart provides a screenshot from *Twitter* where "Uni Baggage" is used by the applicant's customers to refer to the applicant in a trade mark sense rather than in a descriptive manner.

27) Exhibit F consists of screenshots from the websites of two third party competitors that illustrate use of "Send My Bag", that Mr Stewart claims is an attempt by these third parties to rank in *Google* searches for the opponent. He provides this evidence to illustrate that it is common practice and that whilst the opponent is using "uni baggage" to assist its ranking in searches for the term, so are other companies using the same practice against the opponent.

28) In respect of the opponent's evidence showing the third party SevenSeasWorldwide using the term "uni baggage" on its *Twitter* feed, Mr Stewart states that they copied a number of the applicant's campaigns in 2010, that have since been deleted. Exhibit G consists of a tweet made by Mr Stewart, dated 15 September 2010, that reads "Seven Seas Worldwide should come up with there [sic] own marketing and stop ripping of [sic] Uni Baggage".

29) Mr Stewart also criticises the opponent's evidence of the third party, baggageshippinglondon.co.uk, stating that the website is "crammed" with "keywords relating to many baggage terms".

30) Mr Stewart criticises the examples of other third party uses of "uni baggage", "uni bag delivery" and "uni luggage" as beings strategic use of *Google Adwords*.

31) In response to the opponent's claim that the applicant's applications will stifle competition, Mr Stewart submits that this is not so because competitors are still free to use them as keywords or *Google Adwords* and that there are currently no other companies within the UK using the terms naturally within their own websites

32) In response to the opponent's claim to bad faith in respect of the motives of the applicant filing its application, Mr Stewart responds by pointing out that the applicant also filed applications during this time, and that both sides merely applied for the marks that they considered to be their branded terms.

Opponent's evidence-in-reply

33) This consists of a further witness statement by Mr Ewart. To counter the applicant's reliance on *Google Trends* data, he states that this cannot be relied upon in the absence of corroborating evidence stating that such data is "merely an indication of the popularity of a term relative to another ... [and] is not a record of what has been searched and any peaks [are] relative to the traffic on that term". At Exhibit SMB 40 is a *Google Trends* chart, as previously presented at Exhibit SMB31 but taken two hours later. The search parameters were identical as for the chart at Exhibit SHB31, but it differs by now containing new peaks in March 2005, September 2005 and March 2006. He concludes that the applicant's assertion that its mark was not searched for online before 2009 cannot be verified.

34) At Exhibit SMB36, Mr Ewart provides a current screenshot from the applicant's website that includes the statement "Ship your bags and boxes to and from Uni".

35) Mr Ewart also makes numerous submissions and criticisms of the applicant's evidence and arguments that I will not detail here, but I will keep in mind and refer to, as necessary, later in my decision.

36) Finally, Mr Ewart making a number of requests that the Registry disregard various exhibits and statements. I decline to do this, but I will consider the evidence (of both sides) with a critical eye and I will give what I believe is the appropriate weight to the evidence provided.

DECISION

Legislation

37) The relevant parts of section 3(1) of the Act read:

“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.”

38) Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

Section 3(1)

39) In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union (“the CJEU”) stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

40) Whilst I recognise that section 3(1)(b) and section 3(1)(c) are independent of each other and require separate examination, the opponent’s case in respect of section 3(1)(b) is reliant upon its claim that a lack of distinctive character is as a result of the claimed descriptive nature of the applicant’s marks. It follows that the outcome of the opposition in respect of section 3(1)(b) will stand or fall with the section 3(1)(c) grounds because both are predicated upon a claim of descriptiveness. As a result, it is not necessary for me to consider the ground based upon section 3(1)(b) separately (see the comments of Anna Carboni, sitting as the Appointed Person in O-363-09 *COMBI STEAM Trade Mark*), and I will begin by considering the grounds based upon section 3(1)(c) of the Act.

Section 3(1)(c)

41) The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to

believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

42) Firstly, I point out to the parties that, to begin with, I must consider the question of whether the applicant’s mark is caught by the section 3(1)(c) provisions based upon a *prima facie* consideration rather than how the applicant is using the mark and I must keep in mind the general interest that lies behind this provision, namely that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services.

43) Therefore, when assessing the *prima facie* case, I keep in mind the above guidance and my comments in the previous paragraph. The opponent submits that the marks designate the kind and intended purpose of the services applied for. The applicant criticises the opponent’s evidence of descriptive use claiming that such use is merely an attempt to manipulate Internet searches for the applicant in such a way as to make mention to “Uni Baggage” will permit the opponent or third parties to appear on search results for the applicant. It is my view that whether this is correct or not, has little impact upon my analysis under these grounds. This is because it is well established that descriptiveness must be assessed through the perception of the relevant public, including those in the trade (*Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, para 24). Further, there is nothing before me to suggest that adwords must be limited to trade marks and a company may select descriptive words or phrases as adwords in order to manipulate its advertisement into results of searches for those descriptive words or phrases. Therefore, I find the

that the applicant's submission is irrelevant to my considerations in respect to section 3(1)(c) of the Act.

44) Mr Stewart states that, in online marketing, character limits often apply and, therefore, "shorthand or student style lingo" is used and that this explains why content sometimes does not make grammatical sense. He claims the examples of claimed descriptive use provided by the opponent fall into this category. He uses the example "Don't Book it, Thomas Cook it" to demonstrate such use. Mr Stewart claims that this example is analogous with "Uni Baggage it", "Book your Uni Baggage". I note Mr Stewart's statement that character limits may impact upon the text used by businesses and that marks may be worked into "snappy" promotional slogans, but neither of these points impact upon how the relevant public will perceive a sign when not placed within such a "snappy" promotional slogan. To illustrate the point, to take Mr Stewart's own examples of descriptive terms for the applicant's services – STUDENT SHIPPING and SENDING BAGGAGE, if they are incorporated into the sentence "I would use the company Student Shipping" or "I would use the company Sending Baggage" then the terms will be perceived as indications of origin. Any descriptive phrase can be placed into a context where it will take on an additional meaning such as an indication of trade origin, but this does not make the phrase, *per se*, any less descriptive. Taking all of this into account, I dismiss Mr Stewart's submissions that, firstly, character limits are relevant for my considerations or, secondly, it is not sufficient that a descriptive term can be placed in a context where it will be perceived as having an additional, trade specific meaning.

45) When using the terms STUDENT SHIPPING and SENDING BAGGAGE as examples of what would be descriptive of the applicant's services, Mr Stewart contrasts the applicant's mark to these terms, claiming that it does not fall into the same category. It is further submitted in the counterstatement that UNI BAGGAGE describes baggage of a university or baggage of a student but it is not descriptive of a courier service. I do not agree with Mr Stewart's conclusions. There are many characteristics of the applicant's services, one of them is the type and nature of goods that are being couriered. In this case, taking the ordinary dictionary definitions of "uni" and "baggage", the average consumer will, upon encountering the applicant's

mark, immediately understand it as designating the types of items that are being couriered.

46) Mr Stewart submits that the term UNI BAGGAGE is simply not used by students or the public to describe the personal belongings of someone at university. Even if this were correct, the absence of actual use is not fatal when considering whether a mark is caught by the section 3(1)(c) provisions. It is clear from the drafting of section 3(1)(c) that it is sufficient that “*it may serve*” in trade to designate a characteristic. Therefore, it is not necessary that the sign is actually used. That said there are numerous examples of the term being used in a descriptive fashion in the opponent’s evidence such as at Exhibit SMB3 and SMB6.

47) In its counterstatement, the applicant also submitted that the term UNI has multiple meanings and consequently, the mark UNI BAGGAGE also has other meanings, such as “in a combining form such as unilateral, unisexual”. However, whilst Mr Ewart acknowledges that UNI has these other meanings he correctly points out that the CJEU provided guidance in *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co (C-191/01 P) (DOUBLEMINT)* (in particular paragraph 32), and that for a mark to be caught by this provision, it is sufficient that “...at least one of its possible meanings designates a characteristic of the goods or services concerned”. In light of this guidance, I agree with Mr Ewart and dismiss the applicant’s submission.

48) The applicant also submitted that there are a number of other brands featuring the word “uni”, such as *Unilever*, *Uni Kiosk* and *Uni Travel*. I note this, but each case must be considered on its own merits and the mere existence of these marks is not persuasive. The impact of the presence of the “Uni” element may be different in each and/or one or more may have been registered because of there being evidence of acquired distinctive character.

49) Mr Ewart submits that the applicant’s criticism of opponent’s own pre-application descriptive use is irrelevant because it merely shows the situation at the time of filing. He adds that the opponent removal of the terms was done as part of the agreement between the parties as the applicant is well aware, but failed to mention. I

agree with the opponent in that such use is relevant for illustrating how the relevant public perceive the use of the term. It is not relevant to my considerations why such use was removed from the opponent's website.

50) Mr Stewart criticises the opponent's evidence showing the applicant's website providing information about "Uni Baggage Boxes". Firstly, he states that this is only one page of over a thousand on its website. I accept that many of the uses on UNI BAGGAGE on the applicant's website are in a form of trade mark use, but the question before me is whether others should be free to use it because it also designates a characteristic of courier services and whether the applicant should be granted monopoly rights in such a descriptive term. Secondly, he claims that the example here was used because "uni baggage boxes" is a common search term. If I were to accept this assertion, it raises the question as to why is it a common search term. The most plausible explanation, as put forward by the opponent, is that it is a descriptive reference to "boxes for your uni baggage". The relevant public is likely to perceive it as the words "uni baggage" being used as a descriptive qualifier of the word "boxes".

51) Mr Stewart also criticises the opponent's evidence obtained from *Twitter* but the examples provided illustrate how consumers and potential consumers of the applicant's services use the term "uni baggage" is a descriptive way. Whilst I note Mr Stewart's claim that due to short hand use on *Twitter* the language used is often not grammatically correct, there is nothing in the construction of "uni baggage" to suggest that, as a term, it is not grammatically correct. It follows the normal grammatical rules of English.

52) The opponent provides definitions for UNI being a noun, short for "university". It also provides dictionary references for the word BAGGAGE as being "personal belongings packed in a suitcase for travelling; luggage". The specification of services of the contested mark contains *courier services for the delivery of goods* that includes services of the delivery of student's baggage or luggage to or from university. When the two words are used together, as in the applicant's mark, there is nothing unusual about the combination. It is common for one noun to qualify a second noun in this way. With the ordinary meaning of the separate elements kept in

mind, the phrase, as a whole, will be understood as a description of luggage or baggage used to transport a student's belongings to or from university. It is a term that is easily and instantly recognisable to the relevant public in this way. When used in respect of *courier services for the delivery of goods*, it will be understood as designating the goods that are being couriered.

53) In summary, I find that, *prima facie*, when the words "Uni" and "Baggage" are used together, the resulting term will be understood as a description of a student's luggage that they are taking to or from university. It follows the same construction as the term "holiday baggage" or "sports baggage" and a provider of courier services that specialises in transporting a student's university luggage/baggage should be free to use the term in order to indicate this.

Acquired distinctive character

54) The above findings are not the end of the matter because the proviso to section 3(1) states that marks shall not be refused registration if, before the date of application, they have, in fact, acquired distinctive character as a result of the use made of it.

55) Mr Stewart claims that the Registry examiner correctly accepted the application based upon prior use and the brand is known by tens of thousands of students in the UK. Mr Ewart submits that I should disregard Mr Stewart's claims that:

- the applicant has 40,000 customers because it is unstated whether these are from the UK, how many existed prior to the relevant date in these proceedings (the filing date) or whether the figure includes repeat customers.
- it has 100,000 unique visits to the applicant's blog for similar reasons;
- there are over 4,100 mentions of its brand on *Twitter*. He identifies the tension between the claim and his own evidence of, what he submits, is descriptive use on *Twitter*;
- it receives over 100,000 unique visits a month to its website from students in higher education. He submits that to claim students in higher education is just

fancifully because there is no explanation of how Mr Stewart knows this and it is counter claimed that it is not possible to verify who such visitors are.

56) In addition to Mr Stewart's claims identified above, I also note that:

- the applicant has been operating since at least 2010, that it has a web site consisting of 1000 pages;
- the applicant has received some press coverage in both national and regional publications.

57) Mr Ewart's criticisms of the applicant's evidence of its scale of use are not without merit. The figures claimed by Mr Stewart suffer from a lack of preciseness and are not supported by documentary evidence such as copies of invoices and there is no information regarding the applicant's turnover.

58) I draw the parties' attention to section 100 of the Act that states:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

59) The applicant has provided some evidence, from which I am able to conclude that it has been trading under the contested mark since 2010, that it operates a web site that receives 100,000 unique visits per month (albeit, not obviously all students in higher education, but as that is the target market of the applicant, it is reasonable to expect that a good proportion fit that description) and has received national and regional press coverage. The business also has a presence on social media such as *Twitter* and *Facebook*. As the opponent has pointed out, there are uncertainties regarding the number of customers the applicant had up to the relevant date of 20 October 2015 and the size of its presence on *Twitter*. Certainly the applicant could have marshalled its evidence in a better way to support the statements made by Mr Stewart regarding its activities under the mark, however, when taking all of its evidence of use into account, the overall impression created is of a business

identified by the mark that has at least a reasonably sized presence in the courier services market targeted at students. I conclude that the evidence is sufficient to illustrate that the descriptive term UNI BAGGAGE has acquired a secondary meaning in this market as the name of a courier services provider.

60) In light of this, I find that the applicant's mark has acquired distinctive character through use and the opponent's grounds based upon section 3(1)(b) and section 3(1)(c) of the Act fails.

Section 3(1)(d)

61) In light of my findings above, it follows that the opponent's grounds based upon this section of the Act must also fail on the basis that my finding of acquired distinctive character being achieved through use will also defeat a *prima facie* objection under section 3(1)(d).

Section 3(6)

62) The law in relation to section 3(6) of the Act ("bad faith") was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch):

"130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C- 529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a

Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

63) The opponent's case is two-fold. Firstly, it claims that the application was made after mediation between the parties where the applicant claimed the opponent's use of UNI BAGGAGE was descriptive. Secondly (and as an extension to the first pleading), the application was an attempt to stifle descriptive use of the term "uni baggage" and "university baggage" by other couriers.

64) I dismiss both arguments. I have found that the term "uni baggage" is descriptive (of the goods being couriered) but that it has also taken on a secondary meaning as an indicator of origin for the applicant because of the use it has made of it. Insofar as a registration for the mark can be enforced, it is only against other use that conveys trade origin (being other than the applicant). A registration does not entitle the applicant to prevent legitimate descriptive use. In light of the applicant's use of the term "Uni Baggage", Mr Stewart's claim that the applicant filed the mark in order to protect its legitimate interest in it as a trade mark is a reason I accept. The applicant has been using it as a trade mark and it is a reasonable action to protect such a mark by registration. As such, I find that both pleadings fail and I accept that, on balance, the applicant was not acting in bad faith when making its application.

65) In summary, I reject the opponent's claim that the applications were made in bad faith.

Summary

66) The opposition fails and the application can proceed to registration.

COSTS

67) The applicant has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. I take account that both sides filed evidence/submissions and that the applicant was unrepresented and therefore did not accrue any legal costs. With this in mind, I award costs as follows:

Considering statement and preparing counterstatement	£150
Evidence and submissions	£400
Total:	£550

68) I order Sendmybag (NI) Ltd to pay Uni Baggage Ltd the sum of £550 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

Dated this 6th day of April 2017

Mark Bryant
For the Registrar,
The Comptroller-General