

**O-168-03**  
**TRADE MARKS ACT 1994**  
**IN THE MATTER OF APPLICATION**  
**No. 2276979 BY FOIA CENTRE TO**  
**REGISTER A TRADE MARK IN**  
**CLASS 35**

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**DECISION**

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1. On 2<sup>nd</sup> August 2001 FOIA Centre applied to register the trade mark **FOIA Centre** in Class 35 in relation to a specification of services which, after amendment reads as follows:

*“Provision of business research services, in particular retrieving information/data and records related thereto under The Freedom of Information Act 2000, Data Protection Act 1998, and other legal provisions in the U.K. and elsewhere.”*

2. The Registry refused to register the mark having regard to the provisions of Section 3(1)(b) and (c) of the Act on the ground that the mark consisted exclusively of the acronym FOIA (meaning Freedom of Information Act) and the word Centre, the whole being a sign which other traders may freely and legitimately wish to use in the course of their business to designate the nature of their services. There was a hearing before Mr. Pike, the officer acting for the Registrar, which resulted in a Decision of 12<sup>th</sup> December 2002. The FOIA Centre appealed against that Decision to the Appointed Person.

3. The reasoning underlying Mr. Pike’s Decision can be found in paragraph 11 where he refers to certain documents which had been found by the Registry on doing a search for the purpose of determining if the letters FOIA would be recognised in the United Kingdom as a acronym for Freedom of Information Act. He stated

*“... it is clear from these documents that, at the relevant date, the letters FOIA were in common use as an acronym for the Freedom of Information Act. The documents show the letters FOIA in use as an acronym for the Freedom of Information Act in press releases and on documents which are easily and readily available to the general public and professionals alike. Further I note that the document entitled “Access to Information in Local Government” makes it clear that The Freedom of Information Act 2000 has been given Royal Assent and, at*

*the relevant date, was in the process of being implemented across the public sector”.*

4. Mr. Watts who appeared on behalf of the Appellant before me contended that the documents unearthed by the Registry did not justify the conclusion that the letters FOIA were in common use as an acronym for the Freedom of Information Act as at the date of application. Indeed this submission underlay the whole of his Notice of Appeal and of his submissions in opening to me. He contended that the use of the acronym was far from common place, that the papers produced were directed to a specialist audience and even in those papers that the acronym did not stand on its own but was used only in circumstances where it was plainly an abbreviation for the Act itself.

5. In my judgment there is much to be said for Mr. Watts’ submissions on the evidential issues. Indeed, Mr. James, who appeared on behalf of the Registry, did not seek to defend the proposition that the acronym FOIA was in common usage as at the date of application.

6. He however contended that the law applicable to the considerations relevant to Section 3(1)(b) and (c) was not limited to the state of affairs which actually existed at the date of application. This he said was the focus of section 3(1)(d) of the Act which provides

*“(1) The following shall not be registered –  
(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”.*

7. He contended that Section 3(1)(c) was wider and in particular draw my attention to the word “may” which appears in that sub-section (3)(1)

*“(1) The following shall not be registered -  
(b) 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, .....*”

8. In support of this submission he draw my attention to the decision of Mr. Geoffrey Hobbs Q.C. sitting as the Appointed Person in Cycling IS Trade Mark Applications [2002] RPC 729 at 738 where in paragraphs 29 – 32 he stated as follows:

29. *The exclusion (of Article 3(1)(c)/section 3(1)(c)) was held in paragraphs 39 to 42 of the Judgment of the ECJ in Case G-383/99P Procter & Gamble v. OHIM (“BABY-DRY”) (September 20, 2001)<sup>1</sup> to be applicable to signs and indications which consist simply and solely of designations “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” (paragraph 39) and which may therefore be viewed as a way of referring to the goods or services or of representing their essential characteristics in common parlance (paragraph 42). In paragraphs 43 to 46 of its Judgment the Court held that the exclusion did not apply to signs or indications identifiable as “syntactically unusual juxtapositions” of words in the nature of “lexical inventions” (in that case BABY-DRY for disposable diapers made out of paper or cellulose and diapers made out of textile).*
30. *The ECJ had previously held in paragraph 35 of its Judgment in Windsurfing that it is not necessary for there to be “a real, current or serious need to leave a sign or indication free” in order for it to be excluded from registration as a sign or indication which “may” serve in trade to designate the characteristics of goods or services. Article 3(1)(c)/section 3(1)(c) was therefore held to be applicable to a geographical name when it “designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned or ... it is reasonable to assume that such an association may be established in the future”. (underlining added) (Windsurfing paragraphs 29 to 34).*
31. *This is an aspect of the Judgment in Windsurfing which was called into consideration by the approach adopted in paragraphs 75 to 81 of the Advocate General’s Opinion in the BABY-DRY case<sup>2</sup>. However, the Judgment of the Court of Justice does not appear to me to have gone so far as to reverse the decision (which formed part of the ruling) in Windsurfing that the words “may serve in trade to designate ... the characteristics of goods or services” allow for a degree of foreseeability in the application of the exclusion from registration contained in Article 3(1)(c)/section 3(1)(c). (underlining added).*
32. *There is a degree of foreseeability in the conclusion that a syntactically unusual juxtaposition of words in the nature of a lexical invention would not be understood purely descriptively by the relevant case of*

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<sup>1</sup> Now reported at [2002] R.P.C. 17.

<sup>2</sup> Reported at [2002] R.P.C. 16.

*persons. There is likewise a degree of foreseeability in the opposite conclusion that a sign or indication would simply be perceived by such persons as a new form of description. The latter conclusion points to unregistrability. I do not understand the Judgment of the Court in the BABY-DRY case to have decided otherwise and I can see no reason why the exclusion from registration contained in Article 3(1)(c)/section 3(1)(c) should make no allowance for the advent of new forms of descriptive expression.*

9. On the basis of this decision, Mr. James submitted that so far as Section 3(1)(c) was concerned, it was not limited merely to common usage at the date of registration but extended to a consideration of that which was reasonably foreseeable. Would, he asked, the mark be likely to come into descriptive use in the future in relation to the services in issue?

10. It is also plain from a recent decision of the Court of Justice (see Case C-53/01) Linde A.G. v. Rado Uhren A.G. (8<sup>th</sup> 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.

11. In my judgment therefore Mr. James' submissions as to the applicable law under Section 3(1)(c) are correct. It is not sufficient merely to take a snap shot of the appreciation of the relevant consumer as at the date of application. It is necessary, following the guidance in the Windsurfing case, to look ahead and look around in order to ensure that trade mark protection is not being given to a sign which may, (in the sense of being reasonably likely to), serve in trade to designate one of the descriptive aspects referred to in Section 3(1)(c).

12. It follows therefore that the hearing officer's legal approach was not wholly correct and that any error that he may have made in assessing the facts cannot of itself assist the Appellant.

13. It is therefore necessary for me to consider the facts on the basis of the legal approach I have identified above. I have concluded that the relevant evidence points in one direction.

14. It is common ground that the initials FOIA were, at the relevant date, commonly used as an abbreviation for Freedom of Information Act in the United States. Mr. Watts contended that this use did not amount to a wholesale usage but

he did concede that there was a reasonably common usage in the United States. To my mind this shows a propensity for expressions of the nature of “Freedom of Information Act” to be referred to by an acronym.

15. The documents unearthed by the Registry showed the same propensity in this country.

16. It is common knowledge that there is a propensity to abbreviate formal expressions to their initials. For example, in the field in which this application resides, the initials ECHR come readily to mind.

17. As at the date of application the Freedom of Information Act 2000 had been enacted. It was the subject of public comment. It was to be enacted in stages and the public comment was likely to increase. In my judgment, as at the date of application, it was inherently likely, if not probable, that the initials FOIA would be used to indicate the Freedom of Information Act and activities related thereto.

18. It is apparent from the specification of services for which the mark is sought to be registered that the initials FOIA are intended to refer to the Freedom of Information Act and would, in my judgment, be likely to be seen as being an acronym for the Act. Since Mr. Watts did not contend that the addition of the word **Centre** to the initials FOIA in the mark applied for made any difference to the question of registrability, it follows that registration of the mark would be contrary to section 3(1)(c) of the Act.

19. In these circumstances the Appeal must be dismissed. In accordance with the usual practice there will be no order as to costs.

Simon Thorley Q.C.  
19<sup>th</sup> June 2003