

**TRADE MARKS ACT 1994
AND
THE TRADEMARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF
INTERNATIONAL REGISTRATION NO 758503
AND THE REQUEST BY “ZÜRICH” VERSICHERUNGS-GESELLSCHAFT
TO PROTECT A TRADE MARK
IN CLASSES 16 AND 36**

Background

1. On 15 May 2001, “Zürich” Versicherungs-Gesellschaft of Mythenquai 2, CH-8002 Zürich, Switzerland on the basis of International Registration No 758503, requested protection in the United Kingdom under the provisions of the Madrid Protocol of the following mark:

ZURICH PRIVATE BANKING

2. Protection is sought in respect of:

Class 16: Paper, cardboard and goods made thereof, included in this class; printed matter; bookbinding material; stationery; all the above goods are from Switzerland.

Class 36: Insurance underwriting; financial affairs.

3. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and notice of refusal under Article 9(3) was given because the mark is excluded from registration by Section 3(1)(b) and (c) of the Trade Marks Act 1994. This is because the mark consists exclusively of the place name “ZURICH” and the words “PRIVATE BANKING”, the whole being a sign which may serve in trade to designate the kind and geographical origin of the goods and services.

4. At a hearing, at which the applicants were represented by Mr Bruce Marsh of Wilson Gunn M’Caw, their trade mark attorneys, the objection under Section 3(1)(b) and (c) of the act was maintained. Notice of refusal was issued under Article 9(3) and 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.

5. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

The Law

6. The relevant part of Section 3 of the Act is as follows:

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

- (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,”

The case for registration

7. In support of the application, submissions were made by Mr Marsh in correspondence and at the hearing which may be summarised as follows:

- S the objection places undue emphasis on the ZURICH element of the mark, which has to be considered in its totality;
- S the mark ZURICH is registered in Switzerland and at OHIM (which operates under a parallel system);
- S the mark ZURICH PRIVATE BANKING was accepted by the Swiss Registry without the requirement of submitting evidence that it had acquired a distinctive character in its own right;
- S the services listed make no specific reference to “banking”;
- S other marks, such as M723965 ZURICH WORKSITE MARKETING, have been accepted in the United Kingdom.

Decision

8. The mark consists of the words ZURICH PRIVATE BANKING. Zurich is the largest city in Switzerland and enjoys an international reputation as a financial centre. In my view, the term “private banking”, which although not defined in dictionaries, clearly conveys the concept of banking which is conducted privately.

Section 3(1)(c)

9. Firstly, is ZURICH registrable per se in the United Kingdom for the goods and services? 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.”

10. 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.

11. Given that Zurich is well known as a financial centre, I am of the opinion that in the United Kingdom the average consumer would likely perceive it as an indication of the geographical origin of the goods and services and it is thus debarred from registration. However, as Mr Marsh correctly pointed out, the mark has to be considered in its totality as ZURICH PRIVATE BANKING. Mr Marsh conceded that “private banking” is a non-distinctive element but I have to now consider whether the addition of these words creates a mark that is *prima facie* distinctive.

12. 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, 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).

13. 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, the relevant public would not consider the mark to denote trade origin but their perception would likely be that the goods (eg publications) and services (eg banking) originate from Zurich and relate to private banking.

15. Mr Marsh criticized the construction of the objection because it placed undue emphasis on ZURICH. The objection which was set out by the examiner naturally mentions ZURICH first, since it appears at the beginning of the mark. However, the objection refers to the *whole* being a sign which may serve in trade to designate the kind and geographical origin of the goods and services. I therefore reject the assertion that the objection is only focussed on the geographical element of the mark.

16. Concerning acceptance or registration of the marks ZURICH and ZURICH PRIVATE BANKING in other jurisdictions, it would appear that neither proceeded on the basis that they were prima facie acceptable.

17. Regarding registration in Switzerland, the Swiss Federal Institute of Intellectual Property have provided the following information:

"The trademark ZURICH PRIVATE BANKING" has been rejected in a first step as a sign that belongs to the public domain (art. 2 a Swiss Trademark Law). In a second step, it has been accepted with reference to the trademark "ZURICH", which has been accepted in 1994 as a trademark on the basis of a "long and uninterrupted use".

This means that we do accept a sign that belongs to the public domain if it is verified that the sign has been used - in general - during the last ten years. We assume, that, on this condition, the sign has lost the character of public domain and has acquired distinctiveness by this use and is perceived by the consumer as a trademark. So, the sign "ZURICH PRIVATE BANKING" has not been accepted as a trademark as such, but only, because "ZURICH" has been accepted and registered (with the special remark "Durchgesetzte Marke" in the publication) and only for the services and goods for which the long and uninterrupted use has been proven (16: paper, cardboard and goods made from these materials; printed matter; bookbinding material; stationary, all these goods swiss made and 36: insurance, financial affairs)."

A copy of an extract from "swissreg", a database of the Swiss Federal Institute of Intellectual Property, gives details of registration no 429078 ZURICH and is shown at annex A.

18. With regard to the position at the Office for Harmonization in the Internal Market (OHIM), Mr Marsh asserted that the marks ZURICH and ZÜRICH were registered prima facie without the need for evidence of distinctiveness. However, both of these marks are shown on the OHIM database as proceeding on the basis of acquired distinctiveness (see attached annex B).

19. I put the above information to Mr Marsh and he confirmed that Swiss registration 429078 ZURICH was originally registered on the basis of acquired distinctiveness through use, but subsequent to its registration the Swiss Registry have accepted all other applications containing the words ZURICH plus non-distinctive elements (including Zurich Private Banking) without the need to file evidence of the use of those particular marks. As concerns the OHIM registrations, Mr Marsh said it was his understanding that OHIM accepted the marks upon consideration of certain information and documents that were filed referencing the circumstances in Switzerland and not on the basis of "classical" evidence of use in the nature of sales figures, advertising, third party recognition etc.

20. Guidance on prior acceptances by OHIM and in states outside the European Union is set out in Chapter 6 of the Registry Work Manual, which states:

"7.5.4 Prior acceptance or registration by OHIM

There is no requirement in articles 108-110 of Council regulation 40/94 for member states to accept or register a trade mark which has previously been accepted or registered as a Community Trade Mark. The Registrar is required to treat an admissible conversion as an application for registration in the UK (albeit with the filing date of the Community Trade Mark).

The harmonisation of trade mark law should, in practice, mean that most ex-Community marks will be acceptable for registration. However, if the Registrar's ex officio search reveals conflicting earlier trade marks the Registrar may raise an objection. Further, if the Registrar is clearly of the view that the trade mark is not registrable on absolute grounds he must refuse registration.

It follows that prima facie acceptance and/or registration(s) in the applicant's name of the same mark for the same goods or services by OHIM is not binding upon the Registrar who

must decide for himself whether the mark meets the requirements for registration set out in the Act. However, in a marginal case earlier acceptance, and particularly earlier registration, of the same trade mark for the same goods/services by OHIM may be of persuasive value. Registration of the same mark for the same goods/services by OHIM on the basis of evidence of acquired distinctiveness will likewise not be binding upon the Registrar. The Registrar will consider any evidence of use received against the usual criteria.

7.5.6 Prior registration outside the EU

Registration of the same mark outside the EU is, in principle, irrelevant to the question of registrability in the UK.”

21. The practice in relation to acceptance of marks in the EU has been confirmed in a number of cases including *Cycling IS...* Trade Marks [2002] RPC 37, in which Geoffrey Hobbs QC as Appointed Person made the following comments:

“61. As emphasised in paragraph 11 of the Judgment in *Lloyd Schuhfabrik*, it is for the national authorities to determine whether any given sign can in fact be said to possess enough of a distinctive character to be registrable when judged according to these criteria. The national authorities are entitled to assess the meaning and significance of the given sign according to the circumstances prevailing in their own territories, it being recognised and accepted that assessments of such matters are liable to vary as a result of linguistic, cultural and social differences between Member States: Case C-313/94 *Fratelli Graffione SNC v. Ditta Fransa* [1996] ECR I-6039 paragraph 22; Case C-317/91 *Deutsche Renault AG v. Audi AG* [1993] I-6227 paragraphs 20 et seq.; Case C-220/98 *Estee Lauder Cosmetics GmbH & Co OHG v. Lancaster Group GmbH* [2000] IP&T 380 paragraphs 29, 30.”

22. In application of the above practice, I reach the conclusion that despite registration of the marks cited by Mr Marsh in other jurisdictions, this does not persuade me that *prima facie* acceptance of the mark ZURICH PRIVATE BANKING is justified in the United Kingdom.

23. Mr Marsh commented that his client’s specification under Class 36 made no specific reference to “banking”. I do not find this relevant since the list of services includes “financial affairs” of which “banking” is self-evidently a subset.

24. Mr Marsh referred to marks accepted in the United Kingdom, such as M723965 ZURICH WORKSITE MARKETING which he claimed supports the case for registration of the ZURICH PRIVATE BANKING. I am not aware of the circumstances surrounding the acceptance of these other marks and, in any event, each case must be dealt with on its own merits. In *British Sugar PLC and James Robertson and Sons Ltd* decision (1996) RPC 281, Mr Justice Jacob said:

“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 that 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 MADAME trade mark (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.”

25. Having found that the mark is debarred from registration under Section 3(1)(c) of the Act, I now have to consider whether the mark is devoid of any distinctive character under Section 3(1)(b).

Section 3(1)(b)

26. The Cycling Is... case [2002] R.P.C. 37 advanced the notion that section 3(1)(b) has separate and independent scope from section 3(1)(c), an approach since reinforced both in the European Court of Justice, in its judgement on *Companyline* [2003] E.T.M.R. 20 and by the English High Court in *Have A Break* [2002] EWHC 2533 (Ch). Mr Geoffrey Hobbs, Q.C. said, in *Cycling IS...*:

“66. That brings me to the question of whether the signs possess a distinctive character enabling them to fulfil the essential function of a trade mark in relation to goods and services of the kind specified in the application for registration. (*The goods and services comprise “clothing, footwear and headgear” in Class 25 and “advertising, all relating to the cycling industry” in Class 35*).

67. The case for allowing registration rests upon the proposition that the signs are cryptic to a degree which makes it more likely than not that they would carry connotations of trade origin (whatever other connotations they might also carry) in the minds of the relevant class of persons or at least a significant proportion thereof.

68. The case for refusing registration rests upon the proposition that the signs are visually and linguistically meaningful in a way which is more likely than not to relate the goods and services to the activity of cycling without also serving to identify trade origin in the minds of the relevant class of persons.

69. The difference between these two positions resides in the question whether the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin specific or origin neutral.

70. The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect.

71. I do not suppose that such a person would pause to construe the signs when encountering them in any of the different settings (including advertising and promotional settings) in which they might be used. Even so, the degree of attention required to take note of the signs in the first place would be sufficient, in my view, to leave a well-informed and reasonably observant and circumspect person with the clear impression that the signs were being used with reference to goods and services related to cycling.”

27. Mr Hobbs went on to observe:

“73. Doing the best I can on the materials before me, I think that the signs in question would be perceived by the relevant class of persons as pronouncements in identifying cycling as the *raison d’être* for the marketing of the goods and services to which they are related. That is a message that the members of a consortium of bicycle retailers might naturally be interested in putting across to customers and potential customers. I do not think that the nature of the pronouncement or its presentation can in either case be regarded as sufficiently striking to function as an indication of trade origin in relation to goods or services of the kind specified in the application for registration that is now before me.

74. It seems to me that the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin neutral (relating to the general commercial context of the relevant trading activities) rather than origin specific.”

28. In relation to the mark applied for, I take the view that it would likely be perceived by the average consumer as being origin neutral rather than origin specific. The mark cannot function in the *prima facie* as an indication of trade origin and therefore under Section 3(1)(b) of the Act I conclude that it is devoid of any distinctive character.

Conclusion

29. In this decision I have considered all documents filed by the agent, and for the reasons given the application is refused under the terms of Section 37(4) of the Act because the mark fails to qualify under Sections 3(1)(b) and (c) of the Act.

Dated this 15th day of October 2003.

Charles Hamilton
For the Registrar
the Comptroller General

(No Annexes Attached)