TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION NO 2416194

TO REGISTER A TRADE MARK

BY ENABLING PROJECTS LIMITED AND

PETER DANIEL KYTE

IN CLASSES 36, 37 AND 42

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DECISION AND GROUNDS OF DECISION

Background

1. On 9th March 2006 Enabling Projects Limited and Peter Daniel Kyte of 40 Sandringham Road, London, NW11 9DP applied under the Trade Marks Act 1994 to register the following trade mark:

**ENABLING
PROJECTS**

2. Registration is sought for the following services:

Class 36

Real estate agency, management and appraisal services; rental of buildings and apartments; investment and funding of property developments; property portfolio, pension, financial and asset management and services; funding management relating to property development and investment services; mortgage and insurance brokering; information and advisory services relating to the aforesaid.

Class 37

Property development and project management; building construction and repairs; building renovation and conversion, site identification and land development (construction) services; property development consultancy services; information and advisory services relating to the aforesaid.

Class 42

Town planning, architectural and environmental consultancy services and technical studies; interior design services; technical project studies and assessments; information and advisory services relating to the aforesaid.

3. Objection was taken against the application under Section 3(1)(b) and (c) of the Act because the mark consists exclusively of the words ENABLING PROJECTS, being a sign which may serve in trade to designate the kind or intended purpose of the services e.g. real estate agency services relating to projects which do not deliver specific benefits of their own but which are essential to the successful completion of other major or lead projects (ENABLING PROJECTS).

4. Internet references showing use of the term "enabling projects" in the business field were identified and sent to the applicant. Copies of these are at Annex A.

5. A classification query was also raised against the term "site identification" in Class 37. Although the applicant has offered to delete this term if necessary (see applicant's letter of 8th August 2006) this issue remains unresolved.

6. A hearing was held on 23rd October 2006 at which the applicant was represented by Mr Kyte. At the hearing the objection was maintained and Notice of Final Refusal was subsequently issued.

7. 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.

The Law

8. Section 3(1) of the Act reads 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,
>
> (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."

The prima facie case for registration

9. In correspondence dated 7th June 2006 the applicant made a substantial number of points in support of this application. I have set out below extracts from this letter which provide a summary of the points that are made.

> "**ISSUE** 1: … In fact, **ENABLING PROJECTS** has proved to be a strong and distinctive trading name, and **we have secured the interests of some very significant investors and developers because of the strong brand image**. It is worth noting that previously we were a small business called **PETER D KYTE ASSOCIATES** – without the strong branding we had real problems in bringing work in. Now, with the **ENABLING PROJECTS** trading name we are enjoying a high level of interest… this is driven by the strong brand image

and a trading name with its own identity, which is certainly not devoid of any character.

ISSUE 2: ... When visitors first see our name on the internet – say in a Google search – it is only a short description which contains the company name **ENABLING PROJECTS** – yet we get many visitors. The distinctive and unique company name was chosen specifically to attract visitors in this way, and it has proven attractive **BECAUSE** of its distinctiveness.

ISSUE 3: … Apart from occasional usage on the internet, the mark "**ENABLING PROJECTS"** as a trading name is not to be seen. The many references on the internet that can now be seen by searching the internet are our company's…

ISSUE 4: … We have had a long association with the name, building it from nothing into a strong and growing (albeit it a small and expanding) company. The securing of the trade mark is **VITAL TO THE LONG TERM SUCCESS OF THE BUSINESS** and we thus feel it unfair to have an objection filed against our application on the basis of what is, with respect, a seemingly subjective assessment.

ISSUE 5: … The mark's near uniqueness in business use and uniqueness as a company name would suggest that it at least contains **SOME** character and is therefore not wholly devoid of **ANY** character.

ISSUE 6: … We wish to promote the case that **ENABLING PROJECTS** is not in any way used to describe goods or services within the property development sector like **ENABLING DEVELOPMENTS**, or the other more frequently used terms referred to above.

ISSUE 7: … We note that section 11(2) of the Trade Marks Act allows for the use of the term which might indicate the use of a service, the rendering of a service, and where it is necessary to indicate the intended purpose of a product or service, without infringing a registered trade mark.

Thus, if we were successful in our application for **ENABLING PROJECTS**, the term could still be used on an occasional basis in the property development sector to describe the rendering of goods and services.

…

It is also a material fact that we have proposed a **LIMITATION** under Section 13 of the Act.

ISSUE 8: … We feel, with respect, that it is unreasonable to rely on highly occasional and almost unique internet based examples of the use of the mark occur to refuse our application, one of which is not British.

…

In fact, we would say that the Examiner's examples **REINFORCES** rather than weakens our case, as the examples presented are not property development related and/or represent highly occasional usage and/or represent grammatical uses within commentary text that would not have infringed our proposed mark.

ISSUE 9: … **ENABLING PROJECTS** has been in the public domain for over two years now and has seen planning permissions and other public documents as well as a high profile internet presence. This usage prior to the current application **HAS NOT BEEN OBJECTED TO BY OTHER PERSONS IN ANY WAY**.

ISSUE 10: … The **DOUBLE PORTAL** case suggests that the current case should be allowed to be published in the Trademarks Journal."

10. In support of the submissions referred to above the applicant's provided the following documents in support of their submissions:

DOC 1- A policy statement by English Heritage entitled Enabling Development and the Conservation of Heritage Assets.

DOC 2 – A report by the Director of Development Services for East Ayrshire Council entitled Enabling Development.

DOC 3 – A copy of an opposition decision concerning Honest Concurrent Use dated 6th October 2000.

DOC 4 – A briefing note on housing redevelopment by Enabling Projects.

DOC 5 – Details of residential and mixed use development schemes by Enabling Projects.

DOC 6 – A copy of a planning application incorporating a planning statement by Enabling Projects.

11. In correspondence dated 27th November 2006 the applicant provides further documentation in support of this application:

DOC 1 – Web page analysis of enablinguk.com.

DOC 2 – Web page analysis of development seekers .com

DOC 3 – Results of a Google search.

DOC 4 – Results of a Yahoo search.

DOC 5 – Links analysis.

12. Further reference is made to the guidance issued to trade mark examiners on the examination of evidence which is provided with the intention to demonstrate that a trade mark has acquired a distinctive character as a result of the use made of it.

Decision

13. In a judgement issued by the European Court of Justice on 23 October 2003, *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case - 191/01 P, (the DOUBLEMINT case), the Court 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). Paragraphs 28 - 32 of the judgement are reproduced below:

> "28. Under Article 4 of Regulation No 40/94, a Community trade mark may consist of any signs capable of being represented graphically, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.
>
> 29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or rendering of the service, or other characteristics of the goods or service are not to be registered.
>
> 30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.
>
> 31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73).
>
> 32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article

> actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned."

14. Section 3(1)(c) of the Act has common roots to Art. 7(1)(c) of the CTMR, and is substantially identical to that provision. Accordingly, the ECJ's guidance with regard to that provision may be taken to apply equally to Section 3(1)(c) of the Act. The provision excludes signs which may serve, in trade, to designate the kind of services or other characteristics of services. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the services in question.

15. Collins English Dictionary (5th. Edition first published 2000) provides *inter alia* the following definitions of the words ENABLE and PROJECT:

ENABLE – vb. Tr; 1. to provide (someone) with adequate power, means, opportunity, or authority (to do something). 2. to make possible.

PROJECT – n. 1. a proposal, scheme, or design.

16. I am aware that the trade mark in question incorporates the word ENABLING as opposed to ENABLE and in the context of the objection raised against this application the word ENABLING is a gerundive as it is an adjective formed from a verb thereby expressing the desirability of the activity denoted by the verb. This results in the word ENABLING being descriptive of any project which is referred to as an enabling project.

17. Internet reports which were considered to support the objection under Section 3(1)(b) and (c) of the Act were forwarded with the examination report. Copies of these together with a copy of one further Internet report sent to the applicant with the official letter dated 9th November 2006 are attached at Annex A. These reports appear to provide support to the dictionary definition of the trade mark applied for.

18. The first report states

> "Sometimes a project will not deliver benefits on its own, but instead enables other projects to deliver benefits. This is known as an "**enabling project**". The benefits delivered by the enabling project are likely to be "soft benefits" as there will be no cash-realising benefits for the Business Case.
>
> Occasionally IR has to introduce measures that may not bring the best value to IR business but may well contribute to the overall benefit of government. Again this would be considered an enabling project that delivers soft benefits."

19. The second report refers to a project to develop a new surgical centre (see page 5) and is in the section entitled Enabling Projects. The report explains what is meant by this term – "To support the option to build in front of the Old building, a number of enabling schemes will be required to reprovide either permanent or temporary accommodation ……. Work on these enabling schemes is being progressed in parallel with the Surgical Centre Design,…."

20. The third report is an executive summary relating to a strategic planning process within Government. It states "In support of these lead projects, various other projects will also be initiated, many of which are linked. These projects are not subordinate to the lead projects. Rather, the lead projects will depend heavily on the successful implementation of the enabling projects and are intended, quite literally, to lead the way in terms of providing models which can be adapted and used in different contexts and educational sectors. As this starts to happen, the enabling projects will need to grow in scope and reach in order to provide support to new projects.

21. The fourth report relates to Waterloo Quarter Business Alliance Projects which states "The current priorities encompass both visible and enabling projects. Waterloo Quarter Business Alliance's aim is to generate and implement a core of projects that demonstrate visible change and produce an overall vision with which all the businesses in the area can feel a sense of ownership for the area and for the partnership." The report then provides details of projects undertaken and those identified for the future and says "There will also be several enabling projects to facilitate the above projects."

22. The fifth report relates to estates and buildings at the University of Glasgow.In respect of the Bower Building it states "Completion of the reinstatement works to the Bower Building was achieved in November 2004, just over three years after it was destroyed by fire in October 2001. The project has comprised pf a number of enabling projects including the stripping out of the existing fabric and the stabilisation of the external facades.

23. The specification of services applied for contain a wide ranging list of services in classes 36, 37 and 42. In each class the services applied for relate to property and property developments. The services applied for in Class 36 covers a wide range of financial services relating to property and property developments. The services in Class 37 relate to project management, construction, consultancy services relating to property and property developments. The services in Class 42 planning and consultancy services, technical studies, projects and assessments, design, information and advisory services relating to property and property development.

24. The construction of each of these specifications of services is such that all services applied for relate to or broadly cover projects which would be encompassed by the term enabling projects. The relevant consumer of these services is broad ranging in that the services will be aimed at typically the general public, companies in the property and property development industries, housing associations and councils although I accept that for most of the services the relevant consumer is likely to be quite specialised.

25. It is clear from the dictionary definition of the words and the Internet reports identified by the examiner that the words enabling projects are used to describe projects which, although not the primary project in their own right, they are essential initial projects which are carried out in order to facilitate the lead project. These projects enable the lead project to be completed. This appears to be confirmed in statements on the applicant's own web site (see official letter dated 21st June 2006) where the following text appears:

> "WHY ENABLING PROJECTS?
>
> Quite simply, that is our function.
>
> For many years we have enabled development projects……
>
> We see ourselves as **"ENABLERS"** in a very broad context – hence the company name.

26. Having considered all of the submissions made by the applicant together with all of the information on file It is my view that the trade mark applied for is directly descriptive of a characteristic of the services applied for. Consequently, I have concluded that the mark applied for consists exclusively of signs which may serve, in trade, to designate the kind of services and is, therefore, excluded from prima facie acceptance by Section 3(1)(c) of the Act.

27. Having found that this mark is to be excluded from registration by Section 3(1)(c) of the Act, that effectively ends the matter, but in case I am found to be wrong in this decision, I will go on to determine the matter under Section 3(1)(b) of the Act.

28. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in *Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

> "37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.
>
> .....
>
> 39. Next, pursuant to the rule 1 Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.
>
> 40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).

> 41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).
>
> .....
>
> 47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings."

29. In order to achieve registration I acknowledge that there is no requirement for a trade mark to possess a specific level of linguistic or artistic creativity or imaginativeness. I must determine whether the trade mark applied for is capable of enabling the relevant consumer of the services in question to identify the origin of the services and thereby to distinguish them from other undertakings. In OHIM v SAT.1 (Case C-329/02) the European Court of Justice provided the following guidance at paragraph 41:

> "41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish then from those of other undertakings."

30. For the same reasons that I found this trade mark is to be excluded by the provisions of Section 3(1)(c) of the Act I have concluded that the relevant consumer of the services in question would not consider this mark to denote trade origin. The average consumer of these services will, upon encountering the words ENABLING PROJECTS, perceive them as no more than an indication that they relate to projects whose sole function is to enable the lead projects to be completed. That is why it will not be seen as a badge of origin. I am not persuaded that the trade mark applied for is sufficient, in terms of bestowing distinctive character on the sign as a whole, to conclude that it would serve, in trade, to distinguish the services of the applicant from those of other traders.

32. I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

Acquired distinctiveness: the applicant's evidence

33. With the letter of 8th August 2006 formal evidence was filed in order to demonstrate that by date of application the trade mark applied for had, in fact, acquired a distinctive character as a result of the use made of it. The evidence comprises Witness Statement by Mr Peter Kyte, Director of Enabling Projects Limited together with 25 exhibits.

34. At paragraph 4 Mr Kyte provides the factual information in relation to the first use of the trade mark in respect of various services.

35. In Class 36 the trade mark has been used since October 2004 in respect of the following services:

> Real estate agency, management and appraisal services; information and advisory services relating to the aforesaid.

36. In Class 37 the trade mark has been used since October 2003 in respect of the following services:

> Property development and project management; development land identification and land development services; information and advisory services relating to the aforesaid.

37. In Class 42 the trade mark has been used since November 2003 in respect of the following services:

> Town planning; architectural, environmental and property development consultancy services and studies; project studies and assessments; information and advisory services relating to the aforesaid.

38. Although Mr Kyte explains in paragraph 5 that in the property development sector it may take a considerable length of time before profitable trading is achieved. I note that the only indication of turnover relating to services provided under the trade mark is that the in the year 2005 – 2006 was £38,000. As I have already indicated there are 25 exhibits filed with this Witness Statement.

39. Exhibits EP1, EP2 and EP3. These are Certificates of Incorporation confirming the changes of company names from 1998 to 2001 and culminating in a change of name to Enabling Projects Limited.

40. Exhibit EP4. Copy of the applicant's Memorandum and Articles of Association.

41. Exhibit EP5. Copy of applicant's first contract agreed on 16th February 2004.

42. Exhibits EP6 and EP7. Sample of typical letter sent as part of a development site finding programme and the response form.

43. Exhibit EP8. List of all sites upon which the applicant has undertaken work.

44. Exhibits EP9, EP10, EP11 and EP12. Copies of planning applications dated 2004 and 2006 demonstrating the involvement of the applicant in the application process.

45. Exhibit EP13. Copy of Planning Permission Notice dated 12th May 2004.

46. Exhibit EP14. Copy of Planning Permission and Planning Application Drawings dated February 2005.

47 Exhibit EP15. Papers sent as part of a marketing scheme

48. Exhibit EP16. Records of number of visits to the web site www.enablinguk.com in the period 2004 – 2006.

49. Exhibit EP17. Sample web pages from the web site www.enablinguk.com.

50. Exhibit EP18. Sample web pages from the web site www.development-seekers.com.

51. Exhibit EP19. Details of residential and mixed use schemes.

52. Exhibit EP20. Sample of Briefing Note sent to homeowners.

53. Exhibits EP21 and EP22. Copies of two letters addressed to the Trade Marks Registry.

54. Exhibit EP23. Copy pf business card and company letterhead.

55. Exhibit EP24. Copies of five responses dated July 2006 from individuals who have dealt with the applicant. These are responses to a customer survey which was undertaken to establish whether, in the consumer's view, the trade mark applied for possesses any distinctive character.

56. Exhibit EP25. Copy of standard letter sent by applicant to the respondents of the customer survey.

Acquired distinctiveness: decision on the evidence.

57. It is clear from the Witness Statement that the mark has been in use for 17 months in respect of the services specified in Class 36, 29 months in respect of the services specified in Class 37 and 28 months in respect of the services specified in Class 42. This is not a particularly long period of trading and coupled with the low turnover figure (£38,000 in 2005 – 2006) does not paint a picture of the trade mark quickly establishing itself in this sector of activity.

58. However, I note at paragraph 7 that a total of 909 letters were sent to several locations between October 2003 and December 2005. However, there is no evidence in respect of the impact those letters had on the recipients if indeed it had any. It is clear from Exhibit EP8 that the applicant has been involved in thirty four projects between 2004 and 2006 although no details of the actual involvement by the applicant is provided. Exhibits EP9, EP10, EP11 and EP12 provide information regarding the

applicant's input into four planning applications. I note that one is dated after the date of application and there is nothing to indicate if these are the total number of planning applications in which the applicant was involved or if there are others.

59. Exhibits EP16, EP17 and EP18 provide details of the applicant's web sites (www.enablinguk.com and www.development-seekersuk.com). These make it clear that from 2004 to 2006 some 15,524 visits were made to www.enablinguk.com. There is no equivalent data for the other web site but the exhibits do provide screen prints which provide a reasonable indication of the pages which are available on both of these web sites. In my view 15,000 visits to an Internet site is not a large number compared to the size of the market for these services (even assuming that the 15,000 visits were by 15,000 different visitors).

60. As Mr Kyte states in paragraph 16 of his Witness Statement the applicant conducted a customer survey which focused on a small number of important people that have dealt with the company. Exhibit EP24 provides copies of letters from five respondents while Exhibit EP 25 is a copy of the letter sent to Mr Goldstein, one of the five respondents, inviting them to respond. I note that the letter to Mr Goldstein, which Mr Kyte states at paragraph 17 is identical to the letters sent to the other four respondents, requests responses in the respondent's own words but sets out five questions for which the responses are required. Question 2 introduces the very idea of the distinctive character of the trade mark and invites an answer to a question which the respondents may not otherwise have asked themselves. In any case the responses at Exhibit EP24 do not produce a particularly clear representation of the views of the respondents.

61. The first respondent is Mr M Clarke who is a web site partner for the web site www.development-seekers.com which appears to be commercially linked to the applicant. The second respondent, Ms Robinson, is a site finder for the applicant as is Mr Jobson, the fifth respondent. Mr Halliday is a former client of the applicant. The final respondent, Mr Goldstein, appears to be independent from the applicant.

62. However, there is no information as to why these were selected for the customer survey. Four of them do not appear to be independent and none of them provide any justification for their views or offer any explanation as to how they are able to speak on behalf of the relevant consumer of the services in question. Additionally, in paragraph 2 of his letter Mr Halliday appears to be indicating that the trade mark "fits exactly" and, quoting dictionary definitions of the word ENABLING, also appears to be indicating that he judges the trade mark to be descriptive of the services in question. Mr Jobson also appears to provide contradictory evidence. Although he states that the trade mark has an unique identity and is very distinctive he also declares it to be self explanatory which I assume is a reference to it being descriptive of the services in question.

62. The test for acquired distinctiveness was set down by the ECJ in *Windsurfing Chiemsee (108&109/97 [1999] ETMR 585.* The court found that:

> "If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking

> because of the trade mark, it must hold the requirement for registering the mark to be satisfied."

63. I have already identified the relevant consumer as typically being the general public, companies in the property and property development industries, housing associations and councils. In order for this application to be successful the evidence filed must satisfy the proviso to Section 3(1)(b) and (c) of the Act. To be successful the evidence must demonstrate that as a result of the use made of the trade mark applied for, in relation to the services upon which it has been use, the trade mark has acquired a distinctive character in the opinions of a significant proportion of the relevant consumers.

64. In my view the evidence fails to demonstrate this. The length of use varies between 17, 28 and 29 months and the only indication of turnover is £38,000 for the period 2005 – 2006. This is by itself insufficient given the sheer size of the industry within which the services are provided. Although there is no indication of the applicant's market share within this industry, on the basis of the information provided I judge it to be very small. There is little evidence of the mark being actively promoted other than the sending of 909 speculative letters to landowners between October 2003 and December 2005 and no evidence to demonstrate what impact, in a trade mark sense, these had in the minds of the recipients.

Limitation

65. I note that the applicant has entered a limitation in Section 11 of the Form of Application which states:

> "The mark shall only be used as a trade mark and brandname".

66. This does no more than state the obvious. The question is how the use will be perceived and the effect of the exclusive right on third parties. In this latter connection, I note that it is well established that the limitations on the exclusive right set out in Section 11(2) of the Act are not reasons to register an otherwise unregistrable mark. I have therefore concluded that this particular limitation does not persuade me that the conclusion I have reached in this decision should be amended or changed in any way.

67. In my view this evidence does not prove that the mark applied for has acquired a distinctive character as a result of the use made of it and I conclude that the applicant has failed to satisfy the proviso to Section 3(1) of the Act.

Conclusion

68. The trade mark is not acceptable prima facie because it is debarred from registration by Section 3(1)(b) and (c) of the Act.

69. The evidence filed to substantiate the claim that the trade mark has acquired a distinctive character is not sufficient to satisfy the proviso to Section 3(1)(b) and (c) of the Act.

70. In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 3(1)(b) and 3(1)(c) of the Act.

Dated this 19th day of March 2007

A J PIKE
For the Registrar
The Comptroller-General

ANNEX A