

O-085-07

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION NO 2413833A

BY RETURN TO SENDER LIMITED

TO REGISTER A TRADE MARK

IN CLASS 16

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DECISION AND GROUNDS OF DECISION

Background

1. On 14th February 2006 Return to Sender Limited of Suite 66 Barleymow Centre, 10 Barleymow Passage, London, W4 4PH applied under the Trade Marks Act 1994 to register the following trade mark:

“Return to Sender”

2. Following division of the original application registration is now sought for the following goods:

Class 16

Printed matter; paper; articles made from paper; articles made from card; packing paper; paper packaging materials; plastic packaging materials; stationery; office requisites (except furniture); stamps; rubber stamps; postage stamps; postcards.

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 “RETURN TO SENDER”, being a sign which may serve in trade to designate the kind or intended purpose of the services e.g. postal materials where the mark would be seen as an instruction.

4. A hearing was held on 11 December 2006 at which the applicant was represented by Mr Houlihan of f J Cleveland, their trade mark attorneys. Following the hearing the objection was maintained and Notice of Final Refusal was subsequently issued.

5. 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.

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

The Law

8. Section 3(1)(b) and (c) 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,”

The case for registration

9. In correspondence prior to the hearing Mr Houlihan made several submissions in support of this application.

10. In his letter dated 20th June 2006 Mr Houlihan referred to the stylisation that is present in this mark. This amounts to the words being in Gothic script with all words being enclosed by inverted commas, thus giving the words the appearance of a quotation. Mr Houlihan also suggested that although the words may relate to a characteristic of some of the goods that meaning does not relate to an essential characteristic and compared the trade mark applied for with the phrases NON-SMUDGE INK or DURABLE RUBBER. He also states that in Gothic script the words are reminiscent of the styles and formats of the names of heavy rock bands in the 1980s. It was also suggested that the mark would be perceived as a reference to the song of the same name made famous by Elvis Presley. Mr Houlihan also referred to the words of the Advocate General of the ECJ in the DOUBLE MINT case, OHIM v WM Wrigley Co (CASE-191/01) which suggested the following criteria for judging distinctive character:

- “ 1 the way in which a term relates to a product or one of its characteristics – the more factual and objective that relationship the more likely it is to be precluded from registration;
- 2 the way in which a term is perceived (how immediately is the message conveyed) – the more ordinary, definite and down-to-earth the term is, the more quickly a consumer can apprehend a designation of a characteristic and the less likely the term is to qualify for registration; and
- 3 the significance of the characteristic in relation to the product – where the characteristic is essential then the case for refusing registration is stronger.”

11. In a telephone conversation with the examiner on 4th July 2006 Mr Houlihan asked if the objection would be waived if the words RETURN TO SENDER were disclaimed. He was subsequently advised that such a disclaimer would not allow the objection to be waived.

12. In his letter of 24th July 2006 wrote to enquire whether a limitation (rather than a disclaimer) would give sufficient certainty to third parties to allow the application to proceed to registration. In support of this proposal he referred to *Phones4U Ltd v Phone4U.co.uk Internet Limited* (EWCA Civ 244 paragraphs 60-81) where Lord Justice Jacob held that the registered proprietor of the registered trade mark “PHONES4U and fairly non-distinctive logo” could not assert rights in that registration against third party use of the domain name “phone4u.co.uk” because the registration was limited by the words “The mark is limited to the colours red, white and blue” on the registration certificate.

13. Mr Houlihan proposed the following limitation:

“The rights conferred by the registration of this mark are limited to the words in the particular stylisation and format represented”.

14. The examiner did not consider this to be sufficient to allow the objection to be waived and no limitation was actually entered on the form of application”.

Decision

15. 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.”

16. 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.

17. This objection does not relate to all goods remaining in Class 16. There is no objection in respect of the following goods:

Paper; articles made from card; packing paper; paper packaging materials; plastic packaging materials; postage stamps; postcards.

18. However, the objection is maintained against the remaining goods:

Printed matter; articles made from paper; stationery; office requisites (except furniture); stamps; rubber stamps.

19. The objection under Section 3(1)(c) of the Act is maintained in respect of labels, including self-adhesive labels, and stamps which are used to return e.g. unwanted mail. This may be mail which is incorrectly addressed or unwanted mail, often referred to as junk mail. The unwanted mail remains unopened and is returned by entering the words RETURN TO SENDER onto the envelope. These words may, of

course be written, but they may also be entered by using a purpose built stamp or by the use of pre-printed labels. In use the message that the words RETURN TO SENDER sends to the consumer is clear and immediate – these are stamps and labels for use in returning unwanted mail to its sender.

20. The relevant consumer of such products is the general public who wish to return unwanted mail and other organisations who also wish to return such mail. If they are not entering the words by hand they will, of course, be required to purchase the stamp and/or labels and so, even at the point of sale, the trade mark will be perceived as a description of the intended purpose of such goods.

21. Mr Houlihan has, in his submissions in support of this application, referred to the stylisation of the mark. The mark is in what Mr Houlihan describes as Gothic script which is, in my view, a fair descriptive of the font used. The words are also enclosed by inverted commas. While this may be considered by some of the relevant consumers to be slightly unusual I consider it to be insufficient to remove the immediate descriptive message that the words provide. This descriptive message, in relation to the goods identified, removes any possibility of the mark being perceived as a reference to the song of the same name made famous by Elvis Presley.

22. In his letter of 20th June 2006 Mr Houlihan appears to concede that in relation to stamps and rubber stamps the words RETURN TO SENDER “may admittedly relate to a characteristic of the goods (in that for rubber stamps the phrase RETURN TO SENDER might have a clear meaning)” but goes on to argue that this meaning does not relate to an essential characteristic. I do not consider this to be crucial in deciding this issue. Although a trade mark will face an objection if it describes an essential characteristic of the goods or services it will face the same objection should it describe any characteristic of them; the Act does not require such characteristics to be essential. This was the view stated by the Appointed Person in an appeal relating to an opposition by Robin Levy against an application by Pembertons Group Plc. To register the word MEZZANINE (BL 0/044/04) in classes 41 and 42. This appears to be confirmed by the Opinion of AG Sharpson (C-273/05P) where, at paragraph 61 she states:

“ The Court has always given a great deal of weight to that public interest and has, on that basis, interpreted Article 3(1)(c) of the Directive broadly. Thus it has recently stated that the public interest underlying that provision requires that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods. The signs and indications composing the mark need not 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 that those signs and indications could be used for such purposes. A word mark must therefore be refused registration under Article 3(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned. It is also irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. No distinction is

drawn by reference to the characteristics which may be designated by the signs or indications of which the mark consists. Rather, in the light of the public interest underlying Article 3(1)(c), any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant that characteristic may be commercially.”

23. Mr Houlian has suggested that a disclaimer or a limitation should be entered on the form of application which should be sufficient to allow the application to proceed to registration. Both suggestions were considered to be insufficient to allow this and, in any case, I note that no disclaimer or limitation has been entered on the form of application so this is not an issue that I have to consider. However, I am of the view that should the disclaimer or limitation have been entered on the form of application it would have been of no assistance. A disclaimer on the register would not have made the mark look any more like a trade mark for the refused goods in the eyes of the average consumer.

24. The trade mark applied for consist of three ordinary well known words with a minimum degree of stylisation which I consider to be insufficient to detract from the immediate descriptive meaning of the words themselves when considered against the goods in question. The mark is descriptive of “stamps; rubber stamps” and of labels including self-adhesive labels. Insofar as the following terms cover these goods the mark is also descriptive of “printed matter; articles made from paper; stationery; office requisites (except furniture); stamps; rubber stamps”.

25. Consequently, I have concluded that the mark applied for consists exclusively of a sign which may serve, in trade, to designate the kind of services and is, therefore, excluded from registration by Section 3(1)(c) of the Act.

26. 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.

27. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has 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).
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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."

28. 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 them from those of other undertakings."

29. 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 goods in question would not consider this mark to denote trade origin. The average consumer of these goods will, upon encountering the words "RETURN TO SENDER", with the minimum degree of stylisation which is present in this mark, perceive them as no more than an indication that they relate to goods which enable the consumer to stamp or otherwise place these words upon e.g. unwanted mail in order for it to be returned to the person who originally sent it. 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 goods identified as emanating from a single undertaking.

30. 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.

Conclusion

31. 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 (c) of the Act.

Dated this 26th day of March 2007

**A J PIKE
For the Registrar
The Comptroller-General**