

O-177-07

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2356798B

BY MR KEVIN SCRANAGE

TO REGISTER A TRADE MARK

IN CLASS 25

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DECISION AND GROUNDS OF DECISION

Background

1. On 26th February 2004 Mr Kevin Scranage of 2 Market Street, Edenfield, Bury, BL0 0JN applied under the Trade Marks Act 1994 to register the following trade mark:

THERE AIN'T NO F IN JUSTICE

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

Class 25

Tee shirts, sweat shirts, baseball caps.

3. Objection was taken against the application under Section 3(1)(b) of the Act because the mark consists exclusively of the words "THERE AIN'T NO F IN JUSTICE", being a sign which is likely to be taken by the public as a personal statement by the wearer rather than acting as an indicator of trade origin.

4. By way of explanation, it should be mentioned that the original application covered the following goods and services:

Class 25 – "Clothing, footwear, headgear."

Class 35 – "Advertising; business management; business administration; office functions."

Class 36 – "Insurance; financial affairs; monetary affairs; real estate affairs."

Objection had originally been taken under Section 3(1)(b) and 3(3)(a) of the Act but, after a hearing before a different hearing officer, all the objections had been waived except those referred to in paragraph 3. Mr Scranage appeared before me and, at the hearing, the remaining objection was maintained for the goods specified above. As a result, the application was divided and the other elements of the original application, on which the objections had been waived have proceeded to publication as Application No 2356798A. The remainder of the original application is included in this application on which a Notice of Final Refusal has subsequently been 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 of use has been put before me. I have, therefore, only the prima facie case to consider.

The Law

7. Section 3(1)(b) of the Act reads as follows:

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

(b) trade marks which are devoid of any distinctive character,”

The case for registration

8. In correspondence and at the hearing Mr Scranage argued that the mark was a slogan which had the capacity to be a trade mark. Mr Scranage further stated that he could not see a distinction between acceptance of the mark for other types of clothing such as a pullover, trilby or boater but not for the goods at issue. In a letter dated 12 April 2006 Mr Scranage stated ‘Initially, however, before the brand is established, it *may* be taken as a statement about the wearer but then again in all probability it may not. Personally I don’t think that the brand label on the inside of a T-shirt or sweater, for example, would be interpreted by the general public in the way suggested.’ Mr Scranage also made reference to the registrar’s guidance on practice relating to personal statements by the wearer of such items of clothing, which I will return to later in this decision.

Decision

9. The test to be applied in respect of this application is not whether the mark, in its totality, is a combination which is used in common parlance to describe the goods and services applied for but whether the mark, again in its totality, is devoid of any distinctive character. Section 3(1)(b) of the Act is intended to prohibit registration of signs which, although not caught by the clear parameters set out by Section 3(1)(c) and (d) of the Act are, nevertheless, incapable of distinguishing the goods and services of one undertaking from those of other undertakings.

10. 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 in 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."

11. Guidance on the examination of slogans is available in Chapter 3 of the Trade Mark Registry Work Manual at paragraph 32 where it states:

"32 Slogans

Slogans are registrable as trade marks provided that they have the capacity to individualise the goods or services of one undertaking because they are not comprised of signs or indications which directly describe the goods or services or their essential characteristics, and are not devoid of distinctive character for any other reason.

In 'Das Prinzip Der Bequemlichkeit' ["The Principle of Comfort"] C-64/02 P, the ECJ stated that slogans serving a promotional function which is not obviously secondary to any trade mark meaning will be objectionable because:

"...average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogans" (paragraph 35).

Whilst confirming that there is no justification for applying stricter examination criteria to slogan marks, the ECJ confirmed that slogans may fall alongside other non-conventional trade marks in being a category of mark that the relevant public is slower to recognise as indicating the product of a single undertaking.

However, that is not to say that a slogan has to contain an additional element of imagination or an additional element of originality to be acceptable; in fact, the ECJ expressly said such criteria should not form part of the assessment of a slogan's capacity to distinguish the goods of one undertaking from those of another.

Slogans are, by their very nature, adapted for use in advertising and examination should take full account of notional and fair use in that context. It should be borne in mind that the absence of use of the slogan (or similar) by unrelated parties (e.g. during a search of the Internet), does not, in itself, mean that the mark is acceptable (that would be the focus of 3(1)(d) , see the above decision, paragraph 46)."

12. The distinctive character of a trade mark must, of course, be assessed in relation to the goods and services for which the applicant seeks registration. In the present case, the application covers 'tee shirts, sweat shirts, baseball caps.'

13. The mark must also be assessed by how it is likely to be perceived by the average consumer which, in this case, I consider to be the general public. I must also assume fair and notional use of the mark in relation to the goods applied for.

14. I acknowledge that the test for registering slogans is no different than for any other type of marks but, as noted in the above guidance, such use may not be so readily accepted by the general public as an indication of trade origin as would more traditional signs.

15. Furthermore, there is additional guidance in relation to the use of slogans on the goods applied for. Chapter 3 of the Office's Work Manual states at paragraph 32.1.11:

"Slogans such as 'I [heart device] My Boy Friend or 'Here Comes Trouble' are often used to decorate goods, particularly clothing – T-shirts, sweatshirts or baseball caps. In this context, consumers are unlikely to perceive this type of slogan as a sign of trade origin. When seen on the front of a T-shirt, a mug, a necklace or a key ring, for example, they are likely to be seen as a personal statement by/about the wearer/user rather than indicating the trade origin of the product. Slogans which are likely to be seen as such will therefore be open to objection under Section 3(1)(b) of the Act.

Where it is equally or more plausible that such a slogan is capable of being seen as a fancy trade mark, such as 'Lanky Bird', no objection should be raised on this ground. If the mark is not subsequently used as a trade mark it will become liable to revocation for non-use."

The decision on an application for the mark 'YOU WONT BELIEVE YOUR EYES' (BL O/010/06) by Professor Ruth Annand, acting in her capacity as an Appointed Person, provides a helpful summary of the case law on slogans and confirms that slogans should be rejected where the promotional function is not secondary to the trade mark function. At paragraph 11 of that decision the following quote is given from the ECJ decision on DAS PRINZIP DER BEQUEMLICHKEIT , ("The

Principle of Comfort”) Case C-64/02 P, (at paragraph 35) indicating that slogans may prove more difficult to establish distinctiveness:

“... if it were established, when assessing the distinctiveness of the trade mark in question, that it served a promotional function consisting, for example, of commending the quality of the product in question and that the importance of that function is not manifestly secondary to its purported function as a trade mark, namely that of guaranteeing the origin of the product.”

Given the combined effect of the guidance above, I must now consider how the average consumer is likely to perceive the mark at issue on the goods applied for.

16. Firstly, taking the slogan itself, it appears to be a statement about the justice system, arguing that there is no justice. The double entendre of ‘F IN’ in place of the somewhat allusively vulgar expression ‘effing’ is not particularly new. By way of example, from my own knowledge as a follower of football I became familiar, many years ago, with the fans’ chant ‘There’s only one F in Fulham’. I do not think there is, therefore, anything about the use of ‘F IN’ in this way which, of itself, is capable of sending the consumer the message that the mark is anything more than a moral statement. The message will be self evident to the average consumer who, as I indicated earlier, is likely to see it as a statement criticising the justice system.

17. Secondly, I must consider normal and fair use of the mark applied for on the goods at issue. If used on a label on the goods the reaction to the sign is, in my view, likely to be ambiguous since labels are often used to indicate trade origin. However, for the goods covered by the present application I consider normal and fair use would include placing the sign on the exterior of the goods. I consider it is a matter of public knowledge that this is standard practice in the trade. Some tee-shirts, sweat shirts and baseball caps carry the ‘designer’ name prominently. It is easy to recognise brands like Nike or Reebok as indicators of trade origin, even when used in this way. However, slogans used as trade marks are not always easy to identify as such when used as what appears to be decoration. This is because for many years the public has chosen to put personal statements on their tee-shirts, sweat shirts and baseball caps. ‘Ban the Bomb’, ‘Kiss me Quick’, ‘Stop the Iraq War’ have been seen across tee-shirts, sweat shirts and baseball caps on any high street and, in my view, are unlikely to be seen as indicators of trade origin by the average consumer. I consider the mark at issue to fall into the same category. The public are likely to see the slogan, when used in this way, as a statement by the wearer about the justice system, unless educated to the idea that it is an indicator of trade origin through use. Therefore, with reference to the guidance above, I do not consider it ‘equally or more plausible’ that this slogan is likely to be seen as a ‘fancy trade mark’.

18. I do not consider that other forms of clothing such as suits, dresses, trousers, pullovers and most headgear are usually decorated in the same way. Consequently, the public has not been educated to the probability that moral statements appearing on the goods are likely to be just decoration. Nor are they usually used as message carriers by the public. It is for this reason that the other items of clothing have been allowed to proceed to publication in the other divisional part of the original application.

19. Use in advertising is also likely to be seen as a moral statement on the goods, intending to attract those who wish to associate with the sentiments expressed. Therefore, the statement is, in my view, unlikely to be seen as an indicator of trade origin by the average consumer.

20. In my view, the mark applied for will not be seen as a trade mark without first educating the public that it is one. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from acceptance, prima facie, under Section 3(1)(b) of the Act .

Conclusion

21. In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to the 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) of the Act.

Dated this 21st day of June 2007

**R A Jones
For the Registrar
The Comptroller-General**