

O-259-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2446829
TO REGISTER A TRADE MARK
BY FITZGERALD BLAKE
IN CLASS 44**

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DECISION AND GROUNDS OF DECISION

Background

1. On 13th February 2007 Mr Fitzgerald Blake of Westfield House 12, Pound Way, Angmering, West Sussex BN16 4GW applied under the Trade Marks Act 1994 ("the Act") to register the following series of 22 marks:

Standard Management System
Standard Management system
Standard management system
standard management system
STANDARD MANAGEMENT SYSTEM
sTANDARD mANAGEMENT system
Standard-Management-System
Standard- Management-system
Standard-management-system
STANDARD-MANAGEMENT-SYSTEM
sTANDARD-mANAGEMENT-system
Standard_Management_System
Standard_Management_system
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STANDARD_MANAGEMENT_SYSTEM
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StandardManagementSystem
StandardManagementsystem
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STANDARDMANAGEMENTSYSTEM
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Registration is sought for the following services, all in Class 44:

Advice relating to allergies, advice relating to cosmetics, advice relating to dentistry, advice relating to immunology, advice relating to the medical needs of elderly people, advice relating to the personal welfare of elderly people [health], advisory services relating to beauty treatment, advisory services relating to degenerative diseases, advisory services relating to dental apparatus, advisory services relating to dental instruments, advisory services relating to dental preparations, advisory services relating to dental products, advisory services relating to diet, advisory services relating to health, advisory services relating to medical apparatus, advisory services relating to medical instruments, advisory services relating to medical preparations, advisory services relating to medical problems, advisory services relating to medical products, advisory services relating to medical services, advisory services relating to nutrition, advisory services relating to pharmaceutical preparations, advisory services relating to pharmaceutical products, advisory services relating to pharmaceuticals, advisory services relating to medical apparatus, advisory services relating to medical instruments, advisory services relating to medical preparations, advisory services relating to medical problems, advisory services relating to medical products, advisory services relating to medical services, advisory services

relating to nutrition, advisory services relating to pharmaceutical preparations, advisory services relating to pharmaceutical products, advisory services relating to pharmaceuticals, advisory services relating to pharmacies, advisory services relating to pharmacological preparations, advisory services relating to pharmacological products, advisory services relating to pharmacology, advisory services relating to slimming, advisory services relating to surgical apparatus, advisory services relating to surgical instruments, advisory services relating to surgical preparations, advisory services relating to surgical products, advisory services relating to the care of animals, advisory services relating to the care of birds, advisory services relating to the care of fish, advisory services relating to the care of pet animals, advisory services relating to the design of gardens, advisory services relating to the treatment of degenerative diseases, advisory services relating to water gardening, advisory service relating to medical treatment, advisory service relating to dental treatment, agricultural information services, agricultural services relating to environmental conservation, analysis of human serum for medical treatment, analysis of human tissues for medical treatment, animal breeding, animal care, animal grooming, animal performance testing services, animals (artificial insemination of-), anti-smoking therapy, application of cosmetic products to the body, application of cosmetic products to the face, application of toiletry products to the body, application of toiletry products to the face, aromatherapy services, arranging of accommodation in convalescent homes, arranging of accommodation in rest homes, arranging of accommodation in sanatoria, arranging of medical treatment, artificial insemination of animals, artificial insemination services, artificial suntanning services, audiological testing services, audiology services, barber services, bath (public-) provision of facilities for personal hygiene, baths for hygiene purposes (public-), beautician services, beauticians (services of-), beautification services, beauty consultancy, beauty consultation, beauty counselling, beauty salon services, beauty salons, beauty therapy services, beauty therapy treatments, beauty treatment, behavioural analysis for medical purposes, blood bank services, breeding of animals, breeding of thoroughbred horses, cellulites treatment services, charitable services, namely providing medical services, chiropody, chiropractic services, chiropractics, chiropractitioner services, cholesterol testing, clinic services (medical-), clinics (medical-), collection of information relating to the use of pharmaceuticals, compilation of information relating to birds, compilation of information relating to patients, compilation of information relating to medical treatment, compilation of medical reports, conducting of medical examinations, consultancy relating to cosmetics, consultancy relating to health care, consultancy relating to nutrition, consultancy services related to nutrition, consultancy services relating to beauty, consultancy services relating to cosmetics, consultancy services relating to orthopaedic implants, consultancy services relating to personal behaviour, consultancy services relating to prosthetic implants, consultancy services relating to slimming, consultancy services relating to surgery, consultancy services relating to medical treatment, consultancy services relating to dental treatment, consultation services relating to beauty care, consultation services relating to skin care, consulting services relating to health care, consulting services relating to medical treatment, consulting services relating to dental treatment, convalescent home services, convalescent homes, cosmetic electrolysis, cosmetic electrolysis for the removal of hair, cosmetic make-up services, cosmetic treatment, cosmetic dental treatment, cosmetic treatment for the body, cosmetic treatment for the face, cosmetic treatment for the hair, counselling relating to diet, counselling relating to nutrition, counselling relating to the psychological relief of medical ailments, counselling relating to the psychological treatment of medical ailments, counselling relating to the social relief of medical ailments, counselling relating to the social treatment of medical ailments, cultivation advisory services relating to agriculture, cultivation advisory services relating to horticulture, cytological specimen analysis services, cytological specimen examination services, day care centres, dentistry, depilatory treatment, dietetic counselling services [medical], drug rehabilitation services, electro therapy services for physiotherapy, electrolysis for cosmetic purposes, exercise facilities for health rehabilitation purposes (provision of-), eyeglass-fitting, facial beauty treatment services, family planning, fitness testing, fitting of artificial limbs, fitting of contact lenses, fitting of orthopaedic devices, fitting of orthotic devices, fitting of prosthetic devices, fitting of dentures, floral arrangement design services, garden design services, garden maintenance, gardening, genetic testing for medical purposes, hair care services, hair colouring services, hair cutting services, hair dressing salon services, hair implantation, hair replacement, hair styling, hairdressing, hairdressing salons, health assessment surveys, health care, health care consultancy services [medical], health care relating to acupuncture, health care relating to chiropraxis, health care relating to fasting, health care relating to homeopathy, health care relating to hydrotherapy, health care relating to naturopathy, health care relating to osteopathy, health care relating to relaxation therapy, health care relating to remedial exercise, health care relating to therapeutic massage, health clinic services, health clinic services [medical], health farm services [medical], health hydro services, health resort services [medical], health risk assessment surveys, health screening, health spa services, healthcare, hearing aid services, hearing tests, heat therapy [medical], herbalism, hiring of dental apparatus, hiring of dental appliances, hiring of dental instruments, hiring of medical apparatus, hiring of medical appliances, hiring of medical instruments, hiring of plants, hiring of surgical apparatus, hiring of surgical appliances, hiring of surgical instruments, hiring of veterinary apparatus, hiring of veterinary appliances, hiring of veterinary instruments, holistic psychotherapy, homeopathic clinical services, homes (convalescent-) services, homes (nursing-), services, horse stud services, horticultural services, horticulture, hospices, hospital nursing home services, hospital services, hospitals, hydrotherapy, hydrotherapy home services, hypnotherapy,

information services relating to contact lenses, information services relating to health care, information services relating to the veterinary pharmaceutical industry, information services relating to veterinary pharmaceuticals, insecticide spraying in agriculture, interpretation of electrocardiographic signals, location of emergency health care, location of medical facilities for emergency medical treatment, lymphodrainage services, make-up services, manicuring, manicuring services, massage, massage services, medical advisory services, medical analysis services, medical assistance, medical care services, medical clinic services, medical clinics, medical counselling, medical examination of individuals, medical examination of individuals (provision of reports relating to the-), medical health assessment services, medical information (provision of-), medical information retrieval services, medical screening, medical screening relating to the heart, medical services, medical services for the diagnosis of conditions of the human body, medical services for the treatment of conditions of the human body, medical services for the treatment of the skin, medical spa services, medical treatment services, meditation services, midwife services, monitoring of patients, mounting gemstones in dentures, narcotic rehabilitation, neuro linguistic programming smoking cessation, nursing (medical-), nursing care, nursing care (provision of-), nursing home services, nursing homes, nursing services (medical-), nutrition consultancy, nutritional advisory services, occupational psychology services, ophthalmological services, opticians' services, optometric services, optometry, osteopathy, paramedical services, pathology services, pedicurist services, personal hair removal services, personal therapeutic services relating to cellulite removal, personal therapeutic services relating to circulatory improvement, personal therapeutic services relating to fat dissolution, personal therapeutic services relating to hair regrowth, personal therapeutic services relating to muscle re-education, pest control in agriculture, pet grooming, pet grooming services, pharmaceutical advisory services, pharmacists' services to make up prescriptions, pharmacy advice, pharmacy advisory services, physical therapy, physicians' services, physiotherapy, plastic surgery, pregnancy testing, preparation of psychological profiles for medical purposes, preparation of reports relating to health care matters, preparation of reports relating to medical matters, preparing psychological profiles, private hospital services, professional consultancy relating to diet, professional consultancy relating to health, professional consultancy relating to health care, professional consultancy relating to nutrition, professional consultancy relating to medical treatment, professional consultancy relating to dental treatment, professional consultancy relating to pharmaceutical products, professional consultancy relating to the application of surgical apparatus, professional consultancy relating to the use of surgical apparatus, provision of dietetic advice, provision of health care services, provision of medical advice, provision of dental advice, provision of dental advice, provision of dental care services, provision of medical care services, provision of health care services in domestic homes, provision of information relating to behavioural modification, provision of information relating to development in the field of weight reduction, provision of information relating to medical practitioners, provision of information relating to dental practitioners, provision of information relating to medical specialists, provision of information relating to dental specialists, provision of information relating to medicine, provision of information relating to nutrition, provision of information relating to psychology, provision of information relating to vaccination for overseas travel, provision of medical assistance, provision of medical facilities, provision of dentist facilities, provision of medical information, provision of medical information relating to poisons, provision of medical services, provision of medical treatment, provision of nursing care, provision of pharmaceutical information, provision of public bath facilities, provision of sauna facilities, provision of solarium [sun tanning] facilities, provision of trial plots for crop testing, provision of trial plots for crop testing by chemical application, provision of washroom facilities, psychiatric services, psychiatry, psychological counselling, psychological examination, psychological profiles for medical purposes (preparation of-), psychological testing for medical purposes, psychologist (services of a-), psychometric testing for medical purposes, psychotherapy, public bath facilities (provision of-) for personal hygiene, public bath facilities [for hygienic purposes], Public baths for hygiene purposes, reflexology, rehabilitation (narcotic-), rehabilitation for substance abuse patients, reiki services, removal of body cellulite, removal of body cellulite, rental of dental apparatus, rental of equipment for medical purposes, rental of hospital equipment, rental of medical apparatus, rental of mobile sanitary facilities, rental of plants, rental of sanitation facilities, residential medical advice services, residential medical treatment services, residential dental advice services, residential dental treatment services, respite care (provision of), rest homes, salon services (beauty-), salon services (hairdressing-), salons (beauty-), salons (hairdressing-), sanatorium services, sanatoriums, sauna facilities (provision of-), sauna services, screening of microbial products, services for the care of pet animals, services for the care of pet birds, services for the care of pet fish, services for the care of the face, services for the care of the feet, services for the care of the hair, services for the care of the scalp, services for the care of the skin, services for the care of the mouth, services for the care of the eye, services for the planning of weight reduction programmes, services for the preparation of medical reports, services for the provision of medical care information, services for the provision of medical facilities, services for the provision of sauna facilities, services for the provision of solarium facilities, services for the testing of blood, services for the testing of sera, services for the testing of urine, shampooing of the hair, sight-testing [opticians'] services, slimming salon services, slimming treatment services, smoking (anti-) therapy, solarium facilities (provision of-), solarium services, speech therapy services, sperm-bank services, sports medicine services, stem cell storage, stud services (animal-), sun tanning salon services, supervision of weight reduction programmes, surgery (cosmetic-), surgery (plastic-), surgical diagnostic services,

surgical treatment services, tanning (sun-) salon services, tattooing, technical consultancy services relating to medical health, thalassotherapy, therapeutic treatment of the body, therapeutic treatment of the face, therapeutic treatment of the mouth, therapy (physical-), tonsorial services, treatment of allergies, tree nursery services, tree nurseryman services, tree surgeons' services, tree surgery, veterinary advisory services, veterinary assistance, veterinary services, veterinary services (professional consultancy relating to-), veterinary surgeons' services, veterinary surgical services, visagists' services, weight control evaluation, weight control treatment, weight-reduction programmes (planning of-), weight-reduction programmes (supervision of-), wreath making, x-ray services.

2. The application was examined and objection taken under section 41(2) of the Act on the basis that the marks were not a series. I need say no more about this objection as it was not pursued or discussed in subsequent correspondence or at the hearing. In my opinion the examiner was not correct to raise this objection as the various versions would in my opinion, (a) all be pronounced in the same way, (b) have the same visual impact, and (c) convey the same idea, as per the test in *Neutrogena Corp v Golden Ltd [1996] RPC 473 at 488 1.52 – 489 1.3*. All variants would be seen as comprising three known dictionary words: standard, management and system, in a grammatically correct sequence.
3. Objection was also taken under section 3(1)(b) and (c) of the Act on the basis that, under section 3(1)(c), the words would serve in trade to designate the kind of services, eg those that conform to the standard management systems of the particular industry, and this was supported by reference to internet hits showing use of the words in different contexts. In relation specifically to section 3(1)(b), the examiner said that the words were devoid of distinctive character for any services that can conform to standard management systems and it is unlikely that such words would be seen as a trade mark by the average consumer.
4. The applicant asked to be heard and a hearing took place before me on the telephone on 27th June 2007. The applicant was unrepresented.
5. At the hearing I explained that the mark comprised three recognisable dictionary words which had been put together in a normal, grammatically correct way. I explained in relation to the services applied for the words could designate, eg advisory services which promote a standard management system or are offered by a company which adopts such a system. I made no reference to the internet hits which had been produced by the examiner as, in my opinion, such hits were, in the first instance, unnecessary to make the objection good under section 3(1)(c). Furthermore the selection of hits could in any event have been criticised for being either unrelated to the services in suit, or for being in an academic rather than trading context. I thus maintained the objection but, in so doing I advised the applicant that marks which on the fact of it are objectionable might nevertheless proceed to registration on the basis of acquired distinctiveness through use. I gave the example "British Airways" as an illustration of words which entirely designate a characteristic of the relevant services, but which through use, over the years, have come to designate the services of a single undertaking and thus perform the function of a registrable trade mark. In the course of the hearing and in the resulting report I drew attention to the guidance in our Work Manual regarding the

submission of proof of acquired distinctiveness. This guidance, including the fact that we require a witness statement setting out all the facts, can be found in section 45 of Chapter 3 (Examination) of the current Work Manual. I suspended the case to allow the applicant the opportunity to consider this guidance and, if he felt that he had a case on the issue of acquired distinctiveness, to provide the required evidence.

6. I also stressed at the hearing, as this formed a large part of the discussion, that use of the words in relation to patent applications (of which the applicant has two apparently, GB0515996.7 and PCTGB 2005004533) would not “meet the required standard”.
7. The applicant replied on 26th September 2007, conceding that the words could be contrived as a characteristic, but drawing my attention to four other marks, including “British Airways”, which also comprised designated characteristics but were registered. He also said that the words were used by him in relation to the title of his patent applications which had been accepted, and that this, collectively, this information should be taken as valid reasons for “an acquired distinctiveness of the trade mark”.
8. I replied on 12th February 2008 saying that in my opinion things had not changed since the hearing. The mark fell foul of section 3(1)(b) and (c); the fact that no-one else currently uses the term in trade (if that was the case) was immaterial, and furthermore, use in relation to a patent application or granted patent was, in effect, immaterial for the purposes of establishing acquired distinctiveness as a trade mark. No case had been made out in respect of acquired distinctiveness. I then gave the applicant the choice of appealing my decision which would follow formal refusal, or of providing proper evidence, again citing the relevant passages in the Work Manual, upon which a case of acquired distinctiveness could be assessed. In the event of no reply at all within the specified period of one month from the date of the letter, the application would be refused under section 37(4) of the Act. By letter of 7th March 2008 the applicant chose to appeal my decision which meant that formal refusal had to be take place as a necessary first step, following which the applicant could request a formal statement of grounds. The mark was formally refused on 17th July 2008 and the applicant has now requested a formal statement of grounds.

The law

9. Section 3(1)(b) and (c) and the proviso to section 3 of the Act reads:

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

(a)

(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).....

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 European Court of Justice (ECJ) has considered the relevant Article 7(1)(c) in the Trade Marks Regulation 40/94 which governs the Community Trade Mark, and Article 3(1)(c) of the Trade Marks Directive 89/104 EEC, and the following relevant legal propositions have resulted:

- subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – (*Wm Wrigley Jr & Company v OHIM* – Case 191/01P (“*Doublemint*”) paragraph 30;
- Art 7(1)(c) of the Regulation pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM*, paragraph 31;
- it is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes – *Wm Wrigley Jr v OHIM*, paragraph 32;
- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, Case C-363/99 (“*Postkantoor*”), paragraph 57.

Section 3(1)(c)

10. As I have already said, the words which form this mark are normal, dictionary words arranged in a grammatically correct way. These words could, in trade, be used by others to designate a characteristic of the services for which application is made. Such a characteristic might for example be the type, kind or subject matter of the advisory services on offer in relation to the various subjects identified in class 44. To take just one example at random, advisory services relating to medical treatments using a “standard management system”. In accordance with the propositions set out above, the fact that such a system does not exist at the time this application for registration has been made, or if it does, it has no commonly understood or consistent meaning

amongst traders is irrelevant. What matters for the purposes of section 3(1)(c) is whether the mark applied for may serve in trade to designate a characteristic of the goods or service (my emphasis). This is because, as the courts have confirmed, the public interest provision behind section 3(1)(c) is the need to keep free to enable other traders to use such words or signs.

11. In saying that I am aware that there is some debate on the precise legal test to be applied under section 3(1)(c). The nature of that debate is highlighted in the appointed person's decision in *Friction Management Solutions (BL O-278-07) para 15ff*. It may be contended that, instead of the *Doublemint* and *Postkantoor* cases to which I have referred, one should take the test from a lower Court – the CFI. In the *CFI Case T-87/00 Bank für Arbeit und Wirtschaft AG v OHIM ("Easybank")* it was said that registration was not precluded unless the mark designates objectively or specifically the kind, quality etc of the services in question, and the mark must be such as to enable the average consumer to identify immediately and precisely either the services in question or one or more of their characteristics. Even applying this, arguably less rigorous test, however, I would say that this mark is unregistrable, as both the general public and specialists, who would constitute the average consumer in this case, would, absent education, be lead to the view that a characteristic is being designated - even though they may not be familiar with what, objectively or specifically, a standard management system actually is. Unlike the word "easybank", the mark in suit can claim no 'advantage' of linguistic vagueness or imprecision.
12. Lastly under section 3(1)(c), it is worth noting that the applicant's own usage of the mark in the context of his patent application (published as GB 2428833, to which I have previously referred in para 6, is, itself, descriptive. For example, the Summary of Invention commences:

"The preferred embodiment of the present invention is directed to a standard management system (SMS) that overcomes the previously described methods and activities used by many dental patients, dental practices and dental practitioners."

and,

Claim 1 reads:

"1. A management system for standardising and sharing data from a plurality of data providers for a computer system, the method comprising

- sending data to a user; and
- receiving data from a user."

13. I conclude that the mark is objectionable under section 3(1)(c) of the Act.

Section 3(1)(b)

14. In the *Postkantoor* case, to which I have referred, it is accepted in para 86 that marks may be devoid of distinctive character for reasons other than the fact that they may be found to be descriptive. Thus the case against the mark under section 3(1)(b) needs also to be considered independently, as it is theoretically different in scope. In this case however I regard both 3(1)(b) and (c) to be the same in scope. The mark is devoid of distinctive character, and would be seen as such by the average consumer precisely because it describes or designates a characteristic of the services. **I conclude then that the mark also objectionable also under section 3(1)(b) of the Act, but that this finding requires no further analysis on my part in relation to the potentially different scope of the two sections (b) and (c).**

The services specified

15. Given the breadth of the specification I need to address the point whether the mark is objectionable for *all* the services specified. This is, after all, a very broad specification, albeit confined to one Class. This point was addressed in *ECJ Case C-239/05 BVBA Management, Training en Consultancy v Benelux-Merkenbureau*. The question being referred to the court was whether the Directive, on which the Act is based of course, must be interpreted as meaning that the competent authority is required to state its conclusion separately for each of the individual goods and services specified in the application. The court answered (para 38), saying that the competent authority was required to assess the application by reference to individual goods and services. However, where the same ground of refusal is given for a category or group of goods or services, the competent authority may use only general reasoning for all the goods and services concerned. In this case I regard the services all to be in the same category (mainly advisory and consultancy) falling in class 44, and thus rely on general reasoning in refusing the mark for all services.

Acquired distinctiveness

16. From my background above, it seems that following the hearing the applicant sought to rely on acquired distinctiveness to overcome the objections under section 3(1)(b) and (c). I should, for the sake of completeness, deal with this and I think it suffices to say that no case at all has been made out. Reference to other examples such as “British Airways” does not help the applicant, and nor does relying on his own use in the patent application. Specifically, use in relation to a patent application, of itself, does not assist in showing acquired distinctiveness as a trade mark. What matters is a demonstrable exposure and market share of the mark to the relevant consumer, and an education by the proprietor whereby that consumer comes to see the mark as a trade mark rather than a descriptor. In any event, I consider the applicant’s use in the patent application to be descriptive and not trade mark use. The applicant also failed to file the requisite witness statement to back his claim, and so in the circumstances I do not feel there is anything to be gained by allowing

further opportunity to remedy matters. The higher authorities support such a course, cf *Bongrain SA's Trade Mark Application [2005] RPC 14* and also *Vibe Technology's Trade Mark Application 2008 WL 2443182 (BL O/166/08)*, In both cases the registrar has been criticised for allowing repeated opportunity to provide suitable evidence of acquired distinctiveness.

Conclusion

17. 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 24th day of September 2008

EDWARD SMITH
For the registrar,
the Comptroller General