

**TRADE MARKS ACT 1994
IN THE MATTER OF AN APPLICATION NO M924310
TO REGISTER A TRADE MARK
BY MAGNA Powertrain AG & Co KG
IN CLASSES 12 AND 42**

DECISION AND GROUNDS OF DECISION

Background

1. On 26 February 2007 MAGNA Powertrain AG & Co KG of Industriestraße 35, A-8502 Lannach, Austria, on the basis of International Registration 0924310, requested protection in the United Kingdom under the provisions of the Madrid Protocol of the following trade mark:

DRIVEN BY PASSION

2. Protection is sought for the following goods and services;

Class 12

Vehicles (land vehicles, automobiles, lorries, tractors, buses), their parts and spare parts, including motors and engines for land vehicles.

Class 42

Computer programming, maintenance and rental of computer software, in particular in the areas CAD/CAE/CAM/CIM and simulation; consultancy and trouble shooting in the aforesaid areas; development and engineering in the areas of vehicle design, vehicle planning, chassis design, drive systems, electronic systems, development of technology and components for aerospace; carrying out of checks and tests of vehicles and vehicle components in driving tests, on test benches and by dynamic simulation.

3. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and notice of refusal under Article 9(3) was given because the mark is excluded from registration by Sections 3(1)(b) of the Trade Marks Act 1994. This is because the mark is devoid of distinctive character because it would be seen as a value statement in that the goods and services are provided by a company who are driven by passion.

4. Following a hearing, which was held on 1 August 2008, at which the applicant was represented by Mr Morgan of James Garnet Morgan, their trade mark attorneys, the objection was maintained.

5. Notice of refusal was issued under Article 9(3) and I am now asked under Section 76 of the Act and Rule 69(2) of the Trade Mark Rules 2008 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 applicant's case for registration

5. Prior to the hearing, Mr Morgan provided written submissions in support of his claim that the mark is sufficiently distinctive for acceptance. In these submissions, Mr Morgan made reference to a number of earlier “passion” trade marks which he believed, should be taken as precedents in relation to the application-in-suit, which have been registered in the UK and also registered as Community trade marks. Some of these earlier marks covered goods similar to those claimed in his own application and which had been deemed acceptable in the *prima facie* case. Mr Morgan also made reference to the fact that the same mark had been accepted at other national offices including Austria, Germany and the U.S.

6. At the hearing, Mr Morgan reiterated those arguments already presented in his written submissions, and emphasised the fact that his own mark was unusual, clever and questioned what it actually meant in relation to the goods and services applied for. Mr Morgan stressed that the goods are highly specialised and as such the average consumer of these goods is sophisticated. Mr Morgan also proposed limiting the goods to “power trains” in order to overcome the objection.

7. Prior to setting out the Law in relation to section 3(1)(b) of the Act, I must emphasise that the following decision will set out my reasons for maintaining the objection by reviewing and assessing the mark applied for. I have noted Mr Morgan’s reference to earlier “passion” marks which have been accepted by the UK-IPO and by the Community Trade Mark Office, and note that much of his claim regarding alleged distinctiveness has been based upon relative comparisons with earlier marks and earlier acceptances. Whilst I acknowledge Mr Morgan’s submissions regarding certain material similarities between his own trade mark and those earlier marks he has quoted, I have maintained the objection by assessing the *mark applied for*, rather than by comparing its relative merits against earlier accepted marks.

8. As regards the earlier marks registered by the UK-IPO, I am unaware of the circumstances surrounding their acceptance, and consider them to be of little assistance in determining the outcome of this application. I draw support for this from the judgement of Jacob J in *British Sugar* [1996] RPC 281 at 305 where he stated the following:

"Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual enquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a

monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME* Trade Mark and the same must be true under the 1994 Act. I disregard the state of the register evidence."

9. Nor have I been swayed by reference to the Austrian, German and U.S.'s National Office's acceptance of the same mark. Notwithstanding Council Directive 89/104/EEC, the Registrar is not bound by the decisions of other national offices, as confirmed by the European Court of Justice ("the ECJ") in its judgement on *Henkel KGaA v Deutsches Patent und Markenamt* (C-218/01) where it was stated that:

"The fact that an identical trade mark has been registered in one Member State for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in a Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark application for registration of a similar mark for goods or services similar to those for which the first mark was registered."

I should point out that the decisions of the ECJ on points of law are, of course, binding in the UK.

The Law

10. 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,"

Decision

11. In assessing whether the mark applied for falls foul of section 3(1)(b), I refer to a judgement issued by the European Court of Justice in Joined Cases C-53/01 to C-55/01 *Linde AG, Windward Industries Inc and Rado Uhren AG* (8 April 2003) where, in paragraphs 37, 39 to 41, and 47, the following is stated:

"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 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 caselaw, 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 judgement 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 those distinguishing it from those of other undertakings."

12. On the basis of those comments presented above, it is clear that any assessment of a mark's distinctiveness pursuant to Section 3(1)(b) must take into account both the nature of the goods and services claimed, and the likely perception of the relevant consumer using those goods and services. By considering such factors, I will be able to determine the likelihood of any potential consumer perceiving the sign applied for as a distinctive indicator of origin, or simply as an origin-neutral sign.

13. In addition to this assessment of consumer perception, I must also be aware that the test is one of immediacy or first impression as confirmed by the European Court of First Instance which in its decision on *Sykes Enterprises v OHIM (REAL PEOPLE REAL SOLUTIONS)* [2002] ECR II-5179, stated the following:

"However, a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to

distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin."

14. As stated above it is well established that 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, who is deemed to be reasonably well informed, reasonably observant and circumspect. The specifications cover a wide range of goods and services from vehicles at large in Class 12 to more sophisticated services in Class 42 such as computer programming and engineering. As such with regard to the relevant public, I consider that this consists not only of the general public but in relation to certain goods and services, these would be targeted at more specialist consumers rather than just the general public.

15. In addition to the Linde case, we now have a body of case law in relation to slogan marks. It is necessary to refer also to leading authorities on this type of mark. I might add that at the hearing I referred the attorney to a number of cases, which are helpful. By 'helpful' I mean that an important legal principle is being set out. In my opinion the ECJ Case C-64/02P DAS PRINZIP DER BEQUEMLICHKEIT ('The Principles of Comfort'), provides us with the leading guidance on the subject of slogans. I shall accordingly rely on this case and its interpretation.

16. In case BL O-010-06 'YOU WON'T BELIEVE YOUR EYES', the Appointed Person sets out the guidance she sees as being confirmed by 'The Principles of Comfort' case. This guidance is as follows:

(i) Every trade mark including those comprising slogans must be capable of identifying the product as originating from a particular undertaking and thus distinguishing it from those of other undertakings (paragraphs 33, 42).

(ii) The criteria for assessing distinctiveness are the same for the various categories of marks (paragraph 32).

(iii) It is inappropriate to apply to slogans criteria for assessing distinctiveness (e.g. a requirement for "imaginativeness" or "conceptual tension which would create surprise and so make a striking impression") that are different/stricter than those applicable to other types of sign (paragraphs 31, 36).

(iv) Use in advertising may be taken into account (paragraphs 35, 38).

17. Based on this guidance I must address the question: how is this mark likely to be perceived by both the general public and also the relevant specialist consumer identified above.

18. The mark comprises three normal English dictionary words 'driven', "by" and 'passion' in that order. The attorney submits that the mark is "unusual and whilst it is a slogan which admittedly has some passing relationship to the goods and services involved, vehicles and their parts and associated services, such vehicles are normally driven by motors and transmissions, and not by passion." I cannot agree with this. I am unable to see any quirkiness in the combination. Whilst there is no requirement for semantic or syntactic tension to be registrable, we are nevertheless required to assess the mark in relation to the goods and services. The more apt the words are to be used to promote, including of course in advertising, a characteristic of the product or company responsible, the less capacity such words have to distinguish the goods of a single undertaking.

19. Being 'driven' is a desirable quality which any business would strive toward or claim. For many it would be more than a desirable quality, rather an essential attribute. To be 'driven by passion' simply emphasis the message to the average consumer that the undertaking concerned is motivated by their passion for the goods they produce and the services that they deliver. I see the phrase as a readily understandable combination such that in the context of advertising especially, would not be such as to convey distinctive character.

20. Even if I share the examiner's view that the message conveyed by the mark is that of mere value statement, either in relation to the company itself or to the goods and services, I must address the critical submission that such marks are nevertheless capable of 'dual' function. In other words, refusal under section 3(1)(b) cannot follow simply because a mark may be found to be 'promotional'. As I indicated at the hearing, in my opinion the case law teaches us that, in the prima facie, marks which are asserted to have dual function must be capable of being perceived immediately as an indication of origin of the goods/service. In other words, the essential 'origin' function is immediately recognisable alongside the other function of promotion (see para 35 of 'The Principles of Comfort').

21. In this particular case, I am unable to come to that conclusion. My assessment of the mark above places particular emphasis on the word 'driven' as being a quality desired of almost every business. It is hard therefore to see the words 'driven by passion', absent evidence, conveying anything but an emphatic statement that the undertaking using it is driven by zeal for what they do. I do not see the words as capable of simultaneously functioning as a trade mark. It merely conveys positive qualities about the undertaking and is not capable of indicating the origin of the goods and services.

22. Regarding Mr Morgan's argument that the consumer of these goods is sophisticated, I have considered how the mark would be perceived by both specialist consumers and also consumers of such goods as vehicles who are deemed to be the general public, but in order to further support my reasoning I refer to CFI Case T-130/01 Real People Real Solutions (paragraph 24) which states;

24. It must first of all be pointed out, with regard to the relevant public, that the services in question are aimed at a particular class of persons, namely users

of goods and services connected with information technology. Those persons' awareness will thus be relatively high in relation to signs, and in particular marks, likely to indicate a commercial origin guaranteeing the compatibility of the goods or service purchased with their computing equipment (see, to that effect, the judgment in Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 26). Their awareness is liable to be relatively low, on the other hand, when it comes to purely promotional indications, which well-informed consumers do not see as decisive.

23. Similarly regarding Mr. Morgan's statement that the term is unusual and that it had no clear meaning, again I draw support for my decision from CFI Case T-130/01 Real People Real Solutions paragraph 29 which states;

29. Since the relevant consumer is not very attentive if a sign does not immediately indicate to him the origin and/or intended use of the object of his intended purchase, but just gives him purely promotional, abstract information, he will not take the time either to enquire into the sign's various possible functions or mentally to register it as a trade mark.

24. It appears to me that the message of the designation, as thus understood, is essentially origin neutral. It is, as the examiner indicated in the early stages of the examination process, a straightforward value statement which could apply to any number of undertakings in the relevant field of commercial activity. It therefore lacks the singularity required to individualise goods and services of the kind specified to a single undertaking.

Conclusion

24. In this decision I have considered all the documents filed by the applicants 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) of the Act.

Dated this 8th day of July 2009

**Bridget Whatmough
For the registrar**