

O-273-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 2531713

BY HAROLD COLE

TO REGISTER THE FOLLOWING MARK IN CLASS 16:

QLTS

Background

1. On 14 November 2009, Harold Cole (“the applicant”) applied to register application number 2531713, consisting of the letters “QLTS” for the following goods:

Class 16 Paper, printed materials, printed publications, brochures and printed marketing materials for the Qualified Lawyers Transfer Scheme (QLTS), which enables foreign lawyers to become English solicitors.

2. On 23 November 2009, the UK Intellectual Property Office issued an examination report in response to the application. In the report, an objection was raised under section 3(1)(b) and (c) of the Trade Mark Act 1994 (“the Act”), on the basis that the mark was devoid of any distinctive character, in that it “consists exclusively of the initialism ‘QLTS’, being a sign which may serve in trade to designate the subject matter of the goods e.g. printed publications about the qualified lawyers transfer scheme, which is often abbreviated to QLTS”.
3. A period of two months from the date of the examination report was given for reply (up to 23 January 2010), with the Registrar confirming that “...the application would be refused if the applicant did not reply by the relevant date requested”.
4. On 30 November 2009, a letter was received from the applicant requesting clarification of the objection raised in the examination report. Due to a typographical error the objection referred incorrectly to the letters “QTLT”. An amended examination report was issued on 11 December 2009 with a further period of two months from the date of the second examination report given for reply (up to 11 February 2010), with the Registrar confirming that “...the application would be refused if the applicant did not reply by the relevant date requested”.
5. As the Registrar did not receive any correspondence in that time, on 12 March 2010 a letter was issued refusing the mark in its totality under Section 37(4). A further period of one month (up to 12 April 2010) was provided for the applicant to request a written statement of the grounds of refusal.
6. On 1 April 2010, a Form TM5 was submitted requesting that the Registry issue a full statement of its reasons for refusing the application.

7. On 13 April 2010, a letter was issued offering the applicant a hearing with a senior officer of the Registry. Although not standard procedure, the Registrar was mindful that no substantive argument has been presented by the applicant in response to the Examination Report. As a result, the examiner ensured that the applicant was aware of the opportunity to be heard. In response, the applicant chose to again waive his right to a hearing, and insisted on a Statement of Grounds being issued.
8. No evidence of use or argument has been put before me. In particular no evidence has been supplied by the applicant to suggest that he has sought to exercise proprietary control over the mark. I have, therefore, only the *prima facie* case to consider.

Decision

The Law

9. “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,

...
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.”
10. The above provisions mirror Article 3(1)(b) and (c) of First Council Directive 89/104 of 21 December 1988. The proviso to Section 3 is based on the equivalent provision of Article 3(3).

Relevant authorities – general considerations

11. The European Court of Justice (ECJ) has repeatedly emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (Case C-37/03P, *Bio ID v OHIM*, paragraph 59 and the case law cited there and, more recently, Case C-273/05P *Celltech R&D Ltd v OHIM*).

12. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. For example, in the case of the registration of colours *per se*, not spatially delimited, the Court has ruled that the public interest is aimed at the need not to restrict unduly the availability of colours for other traders in goods or services of the same type. Also, in relation to Section 3(1)(b) (and the equivalent provisions referred to above) the Court has held that "...the public interest ... is, manifestly, indissociable from the essential function of a trade mark" (Case C-329/02P, *SAT.1 SatellitenFernsehen GmbH v OHIM*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function. Section 3(1)(c) on the other hand pursues an aim which reflects the public interest in ensuring that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM (Doublemint)*, C-191/0P paragraph 31

Section 3(1)(c)

13. There are now a number of judgments from the ECJ which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), whose provisions correspond to Section 3(1)(c) of the UK Act. In terms of the issues before me in this case I derive the following main guiding principles from the cases noted below:

- 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 – (Doublemint)* paragraph 30;
- there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics – *Ford Motor Co v OHIM*, Case T-67/07;
- a sign's descriptiveness may only be assessed, first, in relation to the goods or services concerned and, secondly, in relation to the

perception of the target public, which is composed of the consumers of those goods or services – *Ford Motor Co v OHIM*;

- 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 and Benelux-Merkenbureau, Case C-363/99 (Postkantoor)*, paragraph 57;
- it is in principle irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary – *Postkantoor*, paragraph 102.

14. Section 3(1)(c) of the Act excludes signs which may serve, in trade, to designate the kind of goods and/or services or other characteristics of the goods and/ or services claimed. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the goods in question. I shall concentrate on those goods supplied in the Class 16 specification i.e. “paper, printed materials, printed publications, brochures and printed marketing materials for the Qualified Lawyers Transfer Scheme (QLTS), which enables foreign lawyers, to become English solicitors.”

15. The applicant, Mr Cole, has in effect identified the average consumer of the goods via the wording used in the specification of goods claimed in Class 16: that is, overseas students who wish to practice law in this country and want to undergo the required training to do so. The average consumer base will also include all those who are likely to be engaged in such training. This is a legally qualified and sophisticated constituency of consumers. The goods are clearly not intended for the public at large nor, I would argue, for the vast variety of all legal professionals that practice law in the UK, largely because of the specialist nature of the goods.

16. The mark itself is presented as an initialism i.e. a set of initial letters, each of which is pronounced separately (as opposed to an acronym, where the result can be enunciated, such as “Laser”). When assessing the distinctiveness of initialisms (or acronyms), one must take into account whether the mark is a clear and obvious abbreviation (for example, generally accepted term for goods or services such as 'PO Box', 'CV' and 'BSc'), or something which is less immediately obvious and which is defined only by the context in which it is used. An example of the latter might be where a hearing officer writing an *inter partes* decision abbreviates the name of one of the parties for the sole purposes of the decision – in such cases, the meaning of

the abbreviation would only be apparent to those with prior knowledge to this fact.

17. In my view, only the first category described above i.e. the clear and obvious abbreviations, would attract an objection under 3(1)(c): a composition of letters which, *alone*, are purely descriptive and have become so in the minds of the relevant public. In these cases, there are purely descriptive words which underlie the initialism, but the abbreviation is as commonly used and understood as much as the words it serves to abbreviate.

18. The refusal or acceptance of this application consequently turns on a matter of fact: it is necessary to demonstrate that there will be a close association in the mind of the average consumer between the initialism 'QLTS' and the words it serves to abbreviate i.e. 'Qualified Lawyer Training Scheme'. I have conducted research in relation to the initialism 'QLTS' which shows that it is used to denote a scheme provided in the context of new regulations approved by the Solicitors Regulation Authority (SRA), which is an independent regulatory body of the Law Society of England and Wales. The following extract is from the SRA website found at www.sra.org.uk/solicitors/qltt.page and demonstrates use of the term:

“The Legal Services Board has approved the Qualified Lawyers Transfer Scheme Regulations 2010. The Qualified Lawyers Transfer Regulations (QLTR) and Qualified Lawyers Transfer Test (QLTT) will be replaced by the Qualified Lawyers Transfer Scheme (QLTS) on 1 September 2010. From this date, we will only accept application forms for QLTS certificates of eligibility.”

19. The SRA state on their website that the purpose of the QLTS scheme is to allow qualified lawyers outside the UK to qualify as solicitors in England and Wales and is intended, from 1 September 2010 onwards, to replace the existing schemes, namely the Qualified Lawyers Transfer Regulations (QLTR) and the Qualified Lawyers Transfer Test (QLTT). *Inter alia* this new standard will mean that applicants will be assessed on their ability to apply their knowledge of the content of the law and practice pertaining to England and Wales.

20. The average consumer is therefore made fully aware of the meaning of the letters QLTS, being a clear and unambiguous initialism for the words “Qualified Lawyer Transfer Scheme” merely defining the content of the goods applied for: printed materials, publications, brochures and marketing information all relating to the QLTS (Qualified Lawyers Transfer Scheme).

21. My research has also shown that the initialism is being used descriptively by a variety of third parties including, for example:

- www.chambersstudent.co.uk/Content.aspx?SectionType=4&SectionID=11 which explains the procedures on how to qualify as a solicitor from another jurisdiction or converting from the Bar (see listing 1 in appendix);
- www.qitt.co.uk/new-qlts, which explains that the new Qualified Lawyer Transfer Scheme (QLTS) will replace the Qualified Lawyers Transfer Regulations (TLTR) and the Qualified Lawyers Transfer Test (QLTT) (see listing 2 in appendix);
- Further references can be found at www.lawgazette.co.uk and www.allaboutlaw.co.uk.

There are other examples on the Internet, but they all indicate that the initialism is being used interchangeably with the words Qualified Lawyer Transfer Scheme by an assorted mixture of legal undertakings. Even though the scheme has not yet been introduced, there is little doubt that a substantial number of the relevant consumer base would have heard of it.

22. It is, of course, commonplace to use initialisms (and acronyms) in education and training as an abbreviation for a particular level of qualification. Examples might include 'NVQ' (National Vocational Qualification), 'HND' (Higher National Diploma) and 'GCSE' (General Certificate of Secondary Education). The legal profession is no exception and such abbreviations abound (e.g. 'LLB', 'LLM', 'LPC' to name but a few). Indeed, the specification of goods claimed by the applicant refers to the scheme itself; "... printed materials...for the Qualified Lawyer Transfer Scheme (QLTS)". It seems to me obvious that these letters will have taken on a descriptive meaning: QLTS lends itself to a ready and easily enunciated alternative to the unwieldy title 'Qualified Lawyer Transfer Scheme'.

23. To summarise, I have taken heed of the meaning and initialism 'QLTS' (as set out in the above paragraphs herein), and the use of the term 'Qualified Lawyer Transfer Scheme' in the relevant trade by the relevant consumer, who understands the descriptive nature of the initialism 'QLTS' and would not afford the same any trade mark significance. I have therefore concluded that the mark applied for consists exclusively of a sign which may serve in trade to designate a characteristic of the goods and is therefore excluded from registration by Section 3(1)(c) of the Act.

24. Having found that this mark is to be excluded from registration by Section 3(1)(c) of the Act, that effectively ends the matter. However, 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.

Section 3(1)(b)

25. I approach this ground of objection on the basis of the following principles derived from the ECJ cases referred to below:

- an objection under Section 3(1)(b) operates independently of objections under Section 3(1)(c) – (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);
- for a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- a trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);
- the relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

26. Even if it were found that the mark falls short of conveying the requisite level of specificity to support an objection under Section 3(1)(c), I would nevertheless hold that it would not be capable of performing the essential function of a trade mark. The information that I have previously referred to clearly shows the initialism QLTS being used by a range of different organisations to denote the Qualified Lawyer Transfer Scheme. The descriptive content of this initialism would be apparent to the relevant consumer, and consequently, it is my view that the latter would not consider the mark to be indicative of any particular manufacturer of printed publications, at least not without first educating them to this fact. On that basis, the Section 3(1)(b) objection is also made out..

27. I conclude 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 determine 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

28. As stated in paragraph 8, no evidence of use or arguments have been put before me therefore, I had only the *prima facie* case to consider 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 Sections 3(1)(b) and 3(1)(c) of the Act.

Dated this 29 day of July 2010

**Natalie Morgan & Jane Hallas
For the Registrar
The Comptroller-General**

APPENDIX

This appendix consists of two website extracts referred to at paragraph 21 of the decision above. Those extracts are as follows:

- (i) Information taken from 'The Chambers Student Guide' website at **www.chambersstudent.co.uk/Content.aspx?SectionType=4&SectionID=11**. In the pages published under "Getting started in the Law" > "Qualifying from overseas", clear reference is made to QLTS.
- (ii) Information taken from the 'Qualified Lawyers Transfer Test' website at **[www.qltt.co.uk/new-qlts](http://www qltt.co.uk/new-qlts)**.

Taken from:

www.chambersstudent.co.uk/Content.aspx?SectionType=4&SectionID=11

Qualifying as a solicitor from another jurisdiction or converting from the Bar.

The Solicitors Regulation Authority (SRA) runs a system whereby lawyers who have qualified in certain approved jurisdictions outside England and Wales, or those who have qualified as barristers in England and Wales, can obtain alternate qualifications which permit them to practise as a solicitor in the UK. With a growing number of new solicitors coming from overseas or the Bar, the SRA wants to ensure that those who qualify under the Qualified Lawyers Transfer Regulations (QLTR) have the knowledge and skills required to practice as a solicitor in England and Wales. As a result, the system has been under review for a number of years, but more about that later as the changes are still undergoing approval.

Under the current system, prospective applicants must apply to the SRA for a Certificate of Eligibility that states which elements of the Qualified Lawyers Training Test (QLTT) they must pass and any requirements for further training. Applicants must also undertake a Criminal Records Bureau check. The QLTT comprises four papers: depending on past experience and the jurisdiction in which they are already qualified, certain individuals may be exempt from having to take one, more or even all four papers.

But what about those forthcoming changes we mentioned? In September 2009, after launching an initial consultation in November 2008, the SRA approved a new Qualified Lawyers Transfer Scheme (QLTS). The new system will be put to the SRA board at its 2009 meeting in November and will then be sent to the Legal Services Board for consideration in early 2010. If approved the new regulations are expected to be implemented from September 2010

....

What will the new system entail?

> The SRA claims that the new QLTS is “*designed to ensure that all solicitors in England and Wales have achieved the same standards of skills and knowledge, as those who have qualified via the domestic route.*”

> The new QLTS will be open to lawyers from a larger number of jurisdictions than before.

> The current experience requirement will be removed and practical exercises will be used instead as an objective way of assessing applicants’ experience of practice in the law of England and Wales.

> A separate English language test will be introduced for international applicants, which must be passed before an applicant is eligible to take the QLTS assessments.

We advise you to keep an eye on the SRA website to see how the QLTS develops and to check for any further changes.

Taken from:

www.chambersstudent.co.uk/Content.aspx?SectionType=4&SectionID=11



New Qualified Lawyers Transfer Scheme

The new Qualified Lawyers Transfer Scheme (QLTS) will replace the Qualified Lawyers Transfer Regulations (QLTR) and the Qualified Lawyers Transfer Test (QLTT).

What's new?

- More rigorous assessments.
- Applicants will also be assessed on their ability to apply their knowledge and skills in the content of English/Welsh law and legal practice.
- Applications will be open to a larger number and wider jurisdiction than previously offered on the QLTT.
- The standard eligibility requirement will now apply to barristers.
- No route will be made for distinguished specialist practitioners and academic lawyers in the new QLTS.

A further explanation of the above points follows.

Assessments

There will be three different assessments; one for International lawyers, one for European lawyers and one for UK lawyers.

Qualified Lawyers who will be eligible to apply for the new scheme will have to demonstrate the core knowledge and skills needed of all lawyers.