

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
No. 2450206A BY EXPERIAN LIMITED
TO REGISTER A SERIES OF SIX TRADE MARKS**

**CreditExpert
creditexpert
CREDITEXPERT
Credit Expert
credit expert
CREDIT EXPERT**

IN CLASSES 9, 16, 25, 35, 38, 40, 41, 42, 43 & 45

**AND APPLICATION No.2450206B BY EXPERIAN LIMITED
TO REGISTER A SERIES OF SIX TRADE MARKS**

**CreditExpert
creditexpert
CREDITEXPERT
Credit Expert
credit expert
CREDIT EXPERT**

IN CLASS 36

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO
UNDER No. 96383 & 98308 BY
FAIR ISAAC COPORATION**

BACKGROUND

1) On 21 March 2007, Experian Limited (hereinafter the applicant), applied to register the following series of six trade marks:

CreditExpert
creditexpert
CREDITEXPERT
Credit Expert
credit expert
CREDIT EXPERT

2) The application was examined and following an objection by the Registry was split into two parts A & B. Both were ultimately accepted, prima facie in respect of 2450206A and, following evidence, through distinctiveness acquired through use in respect of 2450206B. The trade marks were subsequently published for opposition purposes on 23 November 2007 and 22 August 2008 respectively. The applications were for the following goods and services:

2450206A

Class 9: Calculators; cameras; cards (incorporating integrated circuits, microprocessors, programs or holograms); closed circuit television monitoring equipment; commercial information agency software; communication installations; communications software; computer databases and datasets; computer hardware; computer networking equipment; computer programs & software; credit bureau software; credit consultancy software; data handling apparatus; database management software; databases, data sets and software relating to account management (including credit accounts); databases, data sets and software relating to advertising; databases, data sets and software relating to bank accounts; databases, data sets and software relating to bank sort codes; databases, data sets and software relating to billing; databases, data sets and software relating to biometric data; databases, data sets and software relating to business research; databases, data sets and software relating to call centres; databases, data sets and software relating to candidate verification; databases, data sets and software relating to companies and unincorporated businesses; databases, data sets and software relating to comparisons of items (whether goods or services) by price and/or other attributes; databases, data sets and software relating to competitors; databases, data sets and software relating to consumer lifestyle information; databases, data sets and software relating to consumer values; databases, data sets and software relating to creating, managing and printing maps; databases, data sets and software relating to credit application processing; databases, data sets and software relating to credit assessment and credit screening; databases, data sets and software relating to credit scorecards; databases, data sets and software relating to credit strategy management; databases, data sets and software relating to customer profiling; databases, data sets and software relating to customer relationship management; databases, data sets and software relating to customers and potential customers; databases, data sets and software relating to data compression; databases, data sets and software relating to data processing and data cleansing; databases, data sets and software relating to data searching; databases, data sets and software relating to digital certificates; databases, data sets and software relating to employees; databases, data sets and software relating to financial asset management; databases, data sets and software

relating to financial information; databases, data sets and software relating to fraud prevention and detection; databases, data sets and software relating to geodemographic analysis and profiling; databases, data sets and software relating to health information; databases, data sets and software relating to identity documents; databases, data sets and software relating to identity verification and authentication; databases, data sets and software relating to image recognition; databases, data sets and software relating to insurance claims; databases, data sets and software relating to insurance perils; databases, data sets and software relating to known aliases used by individuals; databases, data sets and software relating to known associations between individuals; databases, data sets and software relating to loyalty schemes; databases, data sets and software relating to names of individuals and organisations; databases, data sets and software relating to passports; databases, data sets and software relating to pedestrian and vehicle traffic (including bicycles, cars, motorbikes, goods vehicles or aircraft); databases, data sets and software relating to petrol stations and their facilities; databases, data sets and software relating to postal codes and addresses; databases, data sets and software relating to project management; databases, data sets and software relating to property (whether real and/or intangible); databases, data sets and software relating to public record information; databases, data sets and software relating to retail site location; databases, data sets and software relating to risk management; databases, data sets and software relating to tax, benefits and grants; databases, data sets and software relating to tenants or prospective tenants; databases, data sets and software relating to travel; databases, data sets and software relating to vehicles and vehicle parts; databases, data sets and software relating to voters and registers of voters; databases, data sets and software relating to weather; databases, data sets, software and apparatus relating to image capture and image processing; databases, data sets, software and apparatus relating to payment processing; maps stored or viewed in electronic form; mats for use with a computer mouse; non-volatile media (including CDs, DVDs, tapes and video cassettes and other devices) for recording data, sound, images, text or other information; publications in electronic form; sunglasses; telecommunications equipment.

Class 16: Calendars; identity cards (not containing integrated circuits, microprocessors, programs or holograms); instructional and teaching material (other than apparatus) relating to databases, data sets, software and/or services; maps including maps of geographic, demographic and geodemographic distributions, retail site and property location maps; passport holders; passports; photographs; printed matter and printed publications; stationery.

Class 25: Clothing; footwear; headgear; belts (clothing).

Class 35: Advertising services; billing services; business administration; business continuity services; business information services, business management; business research services; operating of call centres; management of call centres; collection of data; commercial information agency services; company and non-corporate enterprise information services; comparisons of items (whether goods or services) by price and/or other attributes; competitor information services; compilation of information onto databases; computerised data storage services; computerised data verification; consultancy services relating to tax, benefits and grants; consumer lifestyle information services; consumer values information services; customer loyalty services; customer profiling services; customer relationship management services; customer targeting and marketing services; data analysis services; data cleansing services; data

compression services; data management services; data processing services; data retrieval services; data searching services; data storage services; database management services; employee record and employee history verification services; geodemographic analysis and profiling services; human resource consultancy services; human resource management services; identity authentication and verification services; list rental services; list screening services; local market planning services; market analysis bureau services; market penetration information services; market research services; postcode analysis services; project management services; promotional services; provision of information about companies and unincorporated businesses; provision of information about postal codes and addresses; public record information services; recruitment agency services; retail site location services; risk management services; telemarketing services; telephone call handling services; voters roll information services; opinion polling; economic consultancy services; economic research; provision of information about any of the aforementioned services.

Class 38: Bulletin board services; communications services between computers; communications services; data broadcasting services; delivery of information by telecommunication; delivery of messages by telecommunications or communications networks; electronic communication services; electronic mail services; encryption and decryption services for communication purposes; information stored on computers; interactive telephone services; leasing of telecommunications installations or communications networks; operation of local area or wide area networks; provision of domain names; provision of internet access to vetted and selected web sites; text messaging services; video messaging services; provision of information about any of the aforementioned services.

Class 40: Printing of maps; management of maps in electronic format; image processing services; printing of mails and promotional items; recording, storing and management of images from cameras.

Class 41: Arranging and conducting award ceremonies; arranging and conducting competitions; arranging and conducting conferences; desktop publishing services; dissemination and distribution (other than transportation) of training and educational information; electronic magazine services; lecturing services; library services; lottery services; mentoring services; photography; press cuttings services; publishing services; production of television and radio programmes; training and education services; photography services; provision of information about any of the aforementioned services.

Class 42: Cartography services; computer analyst and programming services; computer database consultancy services; computer disaster recovery services; computerised analysis of data; conversion of data or documents from physical to electronic media; data security services; database design services; feasibility study services; forensic services relating to databases, data, electronic apparatus and/or computer software; geodemographic coding services; industrial research services; information systems design services; maintenance and updating of computer software; mathematical modelling services; recovery of computer data; rental of computer hardware and software; road surveying services; technical advice services; testing of databases, data, electronic apparatus and/or computer software; vehicle inspection services; weather forecasting services; web pages creation services; disaster recovery services; weather

information services; creation of maps; encryption and decryption services for communication purposes; provision of domain names; provision of information about any of the aforementioned services.

Class 43: Provision of accommodation; provision of facilities for conferences and training events; provision of food and drink; provision of information about any of the aforementioned services.

Class 45: Access control (for security) services; age verification services; biometric security services; electronic signature authentication and verification services; fraud detection and fraud prevention services; identity of individuals authentication and verification services; identity theft prevention and identity theft detection services; information security services; issuing digital identity certificates; passport authentication and verification services; providing background identification and verification of individuals check services; provision of information about criminals or suspected criminals; provision of information relating to vehicle verification, mileage and condition for fraud prevention and detection purposes; registration services for notification of loss; security consultancy services; services for providing information on aliases (assumed names) and third parties with whom they have an association; alias and association information services; candidate verification services; provision of information about names of individuals and/or organizations; vehicle (and vehicle parts) information services, namely identification of a vehicle's history, including details of ownership, vehicle identifiers (such as VIN numbers, engine numbers, parts numbers and other serial numbers); fraud prevention and detection services; digital image recognition services in particular identification of numbers and movements of people contained within images; legal services; licensing of computer programs, software; licensing of intellectual property; political lobbying services; provision of information about any of the aforementioned services.

2450206B

Class 36: Credit reference agency services; credit scoring; preparation of credit reports; consumer credit history services.

3) As the series of six marks are effectively identical, they are referred to as if they were a single mark. All references to “the mark in suit” or “CREDIT EXPERT” should be taken to refer to the series of six marks.

4) Fair Isaac Corporation (hereafter the opponent), filed a notice of opposition, subsequently amended, dated 20 February 2008. The grounds of opposition are in summary:

a) The mark CREDIT EXPERT is a combination of English words consistent with the usual use of English grammar. Neither of the words CREDIT or EXPERT is distinctive when considered independently and in relation to the goods and services covered by the applications. The combination of the words CREDIT and EXPERT does not create a distinctive mark which is greater than the sum of its two descriptive parts. The mark CREDIT EXPERT is devoid of distinctive character.

b) It is submitted that the mark CREDIT EXPERT is merely descriptive of characteristics of the provider of the goods and services applied for. A reasonably well-informed,

observant and circumspect consumer of such goods and services would not be able to ascertain the origins of the goods and services through the mark.

c) The mark CREDIT EXPERT would not serve to identify the goods and services in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish those goods and services from goods or services of other undertakings.

d) Further, or in the alternative, the application was originally refused on absolute grounds and is proceeding because of distinctiveness acquired through use. It is submitted that use of the mark CREDIT EXPERT for the services in Class 36 cannot render the mark capable of distinguishing the services of one undertaking from those of other undertakings.

5) On 29 May 2008 the applicant filed counterstatements which denied the opponent's claims.

6) Both sides filed evidence, and both parties seek an award of costs in their favour. The oppositions were consolidated late in the day and so there was duplication and cross-over of evidence. In my summary I have sought to simplify matters. The matter came to be heard on 11 May 2010. At the hearing, the opponent was represented by Mr Moody-Stuart of Counsel; the applicant was represented by Mr Poulter of Messrs Field Fisher Waterhouse LLP.

OPPONENT'S EVIDENCE

7) The opponent filed two witness statements, dated 16 December 2008 and 29 May 2009, from Allan Michael Poulter the opponent's Trade Mark Attorney. The first statement and exhibits are duplicated as part of the second statement. The second statement consists of exhibit AMP1 which has definitions of the words "credit" and "expert" from the New Oxford Dictionary of English and exhibits AMP2 and AMP3 which consist of copies of internet pages which contain the term "credit expert". I provide a summary below:

- Exhibit AMP1:

"Credit: the ability of a customer to obtain goods or services before payment, but on the trust that payment will be made in the future; the money lent or made available under such arrangement; an entry recording a sum received, listed on the right-hand side or column of an account; a payment received; public acknowledgement or praise typically that given or received when a person's responsibility for an action or idea becomes (unclear) made apparent." This was very badly photocopied and parts are very difficult or impossible to read.

"Expert: a person who has a comprehensive and authoritative knowledge of or skill in a particular area; having or involving such knowledge or skill."

- Exhibit AMP2:

The first article, dated 25.11.08, from The London Stock Exchange website refers to “Peter Harrison, moneysupermarket.com’s credit expert, remarked that shoppers planning to flex the plastic this Yultide should consider...”. The second and third articles are press releases for Californian companies and so their relevance is doubtful. The fourth article is from the Pittsburgh Tribune Review and so similar reservations arise.

- Exhibit AMP3:

Copies of articles, dated between 2 March 2003 and 1 December 2008, from newspapers and magazines such as, *inter alia*, The Guardian, Daily Mail, The Independent, The Observer, The Birmingham Post, Luton Today which provide 26 examples of the term “credit expert” being used to describe a person or persons within a company and sometimes the company itself. For example: “Credit expert Jim Hodgkins...”; “...a credit expert has warned.”; “...and offering advice will be credit expert James Thomas.”; “...warns credit expert Equifax”.

8) The opponent also filed a witness statement, dated 15 June 2009, by Georgina Harris the opponent’s Trade Mark Attorney. She files as exhibits GH1-GH3 two witness statements provided by the applicant in support of its application at the ex-parte stage and also one from the opposition stage.

- **Exhibit GH1:** This is a witness statement, dated 4 February 2008, by Darryl Bowman the Commercial Director of the CreditExpert service provided by Experian. His statement comes from his own knowledge and also from reports provided to him by media monitors engaged by his company. He provides an overview of his company’s activities and the bodies which regulate its activities. He states that in September 2003 his company launched its CreditExpert scheme so that subscribing members could become aware of identity theft. Initially it was low key but a major launch took place in January 2004. Although they have engaged in traditional advertising, Mr Bowman states that his company puts more effort into getting journalists to write about, and hopefully recommend, his company as this is more credible. Press reports from a variety of years are provided as exhibits which I shall summarise later.

Mr Bowman states that members of his company have appeared on television programmes with titles such as “Director of CreditExpert” showing under their image. They have also made radio appearances where they were introduced as being from CreditExpert. The company have received consumer service, personal finance and new product awards. They are also affiliated to a number of organisations and websites such as MSN, Card Protection Plan Ltd, Yahoo, Tiscali, NTL, Virgin, AOL, Orange, Channel 4, Exchange and Mart, HFC Bank, The Times, The Telegraph, Ebay, Argos and Autotrader. Some of these are amongst the most regularly visited websites in the UK and all of these help promote the CreditExpert service. The company has also registered a large number of domain names which contain the mark in suit.

DB2: This consists of two mock ups of the type of report that a subscriber to the service will receive. It first has a covering letter which is headed "CreditExpert from Experian". At the bottom of the letter it states that the term "CreditExpert" is a brand. The covering letter for the mock report is dated 20 April 2006. The second report does not have a covering letter, but does have "CreditExpert from Experian" printed at the bottom of the report. It is dated 24 January 2006.

DB3: Samples of press coverage from 2003: Pages 39-46. All of the articles mention the mark in suit.

DB4: Samples of press coverage from 2004: Pages 47-100. The vast majority of these pages either have print which is so small that it is almost impossible to read, are undated or it is unclear what publication they appeared in or a combination of all the above. Also quite often the reference is to creditexpert.co.uk.

DB5: Media analysis reports from January 2004, May 2004, and August 2007: Pages 101-145. The March 2004 report shows 38 stories in newspapers, six of which mention the mark in suit as part of the report summary on each story. The May 2004 media report mentions of the mark in suit or Experian and does not distinguish between them. Also quite often the reference is to creditexpert.co.uk.

DB6: Samples of press coverage from 2005: Pages 146-255. Most of the pages are undated and/or it is unclear what publication they were taken from. Those that are dated and identified are mostly websites such as Business Credit Management, MSN Money, Moneyextra, My Finances and The Personal Finance Society. No details are provided as to the popularity of these sites at the relevant time. Also quite often the reference is to creditexpert.co.uk.

DB7: Samples of press coverage from 2006: Pages 256-346. Most of the pages are undated and/or it is unclear what publication they were taken from. Those that are dated and identified include the Daily Mirror, The Guardian, London Stock Exchange, Manchester Evening News, Marie Claire and My Finances.co.uk. No details are provided as to the popularity of these sites, or circulation, at the relevant time. Also quite often the reference is to creditexpert.co.uk.

DB8: Samples of press coverage from 2007: Pages 347-379. A number of the pages are undated and/or it is unclear what publication they were taken from. Those that are dated and identified include the Western Mail, The Times, Which and Mirror.co.uk. No details are provided as to the popularity of these sites, or circulation, at the relevant time. Also quite often the reference is to creditexpert.co.uk.

DB9: Documents showing the company participating in National Fraud Identity Prevention Week: Pages 380-384. This has copies of various pages from newspapers but the copy is so small it cannot be read.

DB10: Documents from the Good Homes Show 2006 where the CreditExpert brand was promoted by handing out bags with promotional items and also getting the public to enter a competition which allowed the company to contact them by email promoting the CreditExpert service. Pages 385-386.

DB12: A selection of press releases by CreditExpert. Pages 392-453. A considerable number are on headed notepaper which shows “CreditExpert” with the words “from Experian” underneath in a small typeface. They refer to CreditExpert in the body of the press release, but the most numerous mentions are of the website by reference to the effectively identical identifiers “www.creditexpert.co.uk” and “creditexpert.co.uk”.

DB13: Pages 454-467: A selection of emails and text messages sent out to a customer, Andrew Mills, from his joining the service offered by the applicant in July 2006 to the date of the trade mark application. These all are on headed paper showing CreditExpert being used as a trade mark.

DB14: Details of television advertising in January 2007 on ITV3, Sky1, Sky2, Sky3 and Eurosport during the hours 9am-4pm. Pages 468- 498. These show an average of approximately 75 adverts shown on national television per day.

DB15: At pages 499-501: An internet monitoring report from December 2006- May 2007 which shows that the applicant receives more unique website hits than its competitors, achieving up to just under 80% of all traffic in early 2007. It also shows a large number of “unique” visitors. It shows it in third place in terms of financial information/advice sites.

DB16: At pages 502-537: Searches on Google for news articles between 1 September 2003 and 21 March 2007 shows 166 results for “CreditExpertExperian” and 74 results for “creditexpert.co.uk”. This exhibit also has a review of the service provided by the applicant by a shopping intelligence website www.ciao.co.uk. Lastly the exhibit shows that a search of Google blogs, using the same criteria, between 1 September 2003 and 21 March 2007 returned 59 results.

- **Exhibit GH2:** This consists of another witness statement, dated 13 May 2008, by Darryl Bowman. He states that from the launch of the service in September 2003 to 31 March 2007, turnover has amounted to £26.1million; 1,239,000 people have taken up the offer of a free 30 day trial (excluding those taking up a further trial period); 5,995,863 credit reports have been issued; 7,826,406 alerts have been sent to consumers informing them of credit file status changes; and £1.2million has been spent on television advertising.
- **Exhibit GH3:** This consists of another witness statement, dated 16 March 2009, by Darryl Bowman and exhibits. He points out that exhibit AMP2 of the applicant’s evidence includes one reference, from November 2008, to a person as a “credit expert”. Mr Bowman states that this is not evidence that the mark in suit is descriptive of the goods and services applied for. He points out that three of the other references are from

the USA. He states his view that the evidence filed would lead members of the UK public to believe that the goods and services of the instant application when used under the instant mark were of or from the applicant.

He states that his company provides services under the mark in suit to a range of organisations such as those in the card protection insurance (CPI) industry. His company provides them with the means for customers to check their credit reports under the branding of the CPI companies. At exhibit DB17 he provides details which show that three such companies are CPP, Affinion (which offers these services under its own brand of "Privacy Guard") and BT; he states that in the small print of the terms and conditions of Affinion his company is mentioned. He states that his company also offers a price comparison service. At exhibit DB18 there are prints of screens accessed by a member of staff at Experian. The personal details have been redacted but it can be seen that the screen allows users to compare quotes on items such as insurance of all types, credit cards, energy, loans and mortgages.

Mr Bowman states that in February 2009 his company launched another television advertising campaign. He also states that the opponent has struggled to find use of the mark in suit as a generic term. At exhibit DB20 he provides a report showing that the top five search engines for the four weeks ending 28 February 2009 were www.google.co.uk, www.google.com, uk.search.yahoo.com, www.live.com and www.uk.ask.com. He states that the first two provide essentially the same results. Therefore, www.google.com was not included in the search. The other four sites were searched for a) creditexpert; b) credit expert and c) "creditexpert". The results are provided at exhibits DB21-DB32. They show 460 search results, of which 382 (80%) refer to his company, and another eight refer to its USA group. There are twenty one entries where the terms "creditexpert" or "credit expert" are used together in a sentence or where they are used to describe someone as a "credit expert". The remainder are instances where one word comes at the end of one sentence and the other at the beginning of the next, or where there is no reference to the term "credit expert". Mr Bowman points out that in this search on 7 (1.6%) of the results show that a person is being called a "credit expert", and 14 (3.1%) where there is use of the term "credit expert" which does not refer to his company.

9) The opponent also filed submissions dated 29 May 2009 and 4 August 2009 regarding the evidence and the overall case. I will not summarise these here but will refer to them as and when relevant later in my decision.

APPLICANT'S EVIDENCE

10) In addition to the witness statements of the applicant filed by the opponent and summarised above the applicant also filed two further witness statements by Darryl Bowman who has already provided statements in this case. The first, dated 16 March 2009 is summarised under exhibit GH3 above. In his second statement, dated 12 October 2009, he refers to two television advertising campaigns offering the applicant's credit report service to the public. One campaign ran from 16 January 2006 until 1 March 2007 and was shown or aired 15,662 times. Another campaign ran from 8 January 2007 until 25 March 2007. It is estimated that this advertisement

was viewed by consumers over 77 million times. At exhibit DB36 he provides a report which shows the top UK search engines. He confirms that this was not obtained in the context of the applications. It shows that for the four weeks prior to 14 February 2009 the top search engines were as set out in exhibit GH3 above. He confirms that prior to filing the instant applications the applicant had seventy three relationships with third parties to promote the “CreditExpert” service. He lists these in his statement. I note that they include a considerable number of very well known high street brands as well as a number of high profile websites as well as newspapers. In addition these third parties promoted the brand via their affiliates which at the filing date numbered 1,239 third parties also with agreements to promote services under the mark in suit.

11) The applicant also filed a witness statement, dated 12 October 2009, by Andrew Mills a solicitor and Head of Intellectual Property at the applicant company. He states that the print out from the London Stock Exchange provided by the opponent in AMP2 is related to credit cards and shows that the person referred to is an expert on credit cards. He points out that this is a different service to those applied for under the instant application. He continues that even if “credit expert” could be used to refer to an individual the use by the applicant is for a corporate brand to refer to the applicant’s service. He states that as a result of the use made of the mark by his company the mark has a reputation amongst consumers and that consumers are able to distinguish between a person and a service. He states that the services provided to other businesses constitute use of the services applied for in classes 35, 42 and 45. With regard to use of “creditexpert.co.uk” he points to page 30 of the UK Examination Practice Manual which states: “Elements of the domain name such as “com” or “.co.uk” are considered to be totally non-distinctive. As a general rule, one should consider whether the remainder of the mark is descriptive or non-distinctive.” Mr Mills refers to the second statement of Mr Bowman which provides turnover and advertising expenditures and which was agreed as confidential by the Registry at the examination stage. This, the second statement of Mr Bowman, was not filed in these proceedings and so cannot be relied upon. However, at the hearing the opponent accepted that there had been steady growth in the turnover throughout the period 2003-2007.

12) Mr Mills states that even if the undated articles filed as part of Mr Bowman’s evidence are excluded this still leaves the following number of newspaper articles:

YEAR	
2003	3
2004	13
2005	24
2006	27
2007 (up to date of filing)	8
TOTAL	75

OPPONENT’S EVIDENCE IN REPLY

13) The opponent filed two witness statements in reply. The first, dated 15 June 2009, is by Allan Michael Poulter who provided a statement earlier in this case. This is identical to exhibit AMP3 described in the initial evidence of the opponent.

14) The second witness statement, dated 4 August 2009, is by Georgina Harris who has provided a statement earlier in this case. This is effectively a duplicate of her earlier statement.

15) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

16) At the hearing Mr Poulter agreed that the following items were not being opposed:

2450206A

Class 9: Calculators; cameras; closed circuit television monitoring equipment; communication installations; communications software; computer hardware; computer networking equipment; computer programs & software; credit bureau software; credit consultancy software; data handling apparatus; databases, data sets and software relating to advertising; databases, data sets and software relating to bank sort codes; databases, data sets and software relating to biometric data; databases, data sets and software relating to comparisons of items (whether goods or services) by price and/or other attributes; databases, data sets and software relating to passports; databases, data sets and software relating to pedestrian and vehicle traffic (including bicycles, cars, motorbikes, goods vehicles or aircraft); databases, data sets and software relating to property (whether real and/or intangible); databases, data sets and software relating to retail site location; databases, data sets and software relating to travel; databases, data sets and software relating to vehicles and vehicle parts; databases, data sets and software relating to weather; databases, data sets, software and apparatus relating to image capture and image processing; sunglasses; telecommunications equipment.

Class 16: Calendars; identity cards (not containing integrated circuits, microprocessors, programs or holograms); passport holders; passports; photographs; stationery.

Class 25: Clothing; footwear; headgear; belts (clothing).

Class 35: Advertising services; provision of information about any of the aforementioned services.

Class 40: Printing of maps; management of maps in electronic format; image processing services; printing of mails and promotional items; recording, storing and management of images from cameras; provision of information about any of the aforementioned services.

Class 42: Cartography services; database design services; recovery of computer data; road surveying services; technical advice services; vehicle inspection services; weather forecasting services; disaster recovery services; weather information services; encryption and decryption services for communication purposes; provision of domain names; provision of information about any of the aforementioned services.

Class 43: Provision of accommodation; provision of food and drink; provision of information about any of the aforementioned services.

Class 45: Licensing of intellectual property; political lobbying services; provision of information about any of the aforementioned services.

This leaves the following which are still subject to the opposition:

Class 9: Cards (incorporating integrated circuits, microprocessors, programs or holograms); commercial information agency software; computer databases and datasets; database management software; databases, data sets and software relating to account management (including credit accounts); databases, data sets and software relating to bank accounts; databases, data sets and software relating to billing; databases, data sets and software relating to business research; databases, data sets and software relating to call centres; databases, data sets and software relating to candidate verification; databases, data sets and software relating to companies and unincorporated businesses; databases, data sets and software relating to competitors; databases, data sets and software relating to consumer lifestyle information; databases, data sets and software relating to consumer values; databases, data sets and software relating to creating, managing and printing maps; databases, data sets and software relating to credit application processing; databases, data sets and software relating to credit assessment and credit screening; databases, data sets and software relating to credit scorecards; databases, data sets and software relating to credit strategy management; databases, data sets and software relating to customer profiling; databases, data sets and software relating to customer relationship management; databases, data sets and software relating to customers and potential customers; databases, data sets and software relating to data compression; databases, data sets and software relating to data processing and data cleansing; databases, data sets and software relating to data searching; databases, data sets and software relating to digital certificates; databases, data sets and software relating to employees; databases, data sets and software relating to financial asset management; databases, data sets and software relating to financial information; databases, data sets and software relating to fraud prevention and detection; databases, data sets and software relating to geodemographic analysis and profiling; databases, data sets and software relating to health information; databases, data sets and software relating to identity documents; databases, data sets and software relating to identity verification and authentication; databases, data sets and software relating to image recognition; databases, data sets and software relating to insurance claims; databases, data sets and software relating to insurance perils; databases, data sets and software relating to known aliases used by individuals; databases, data sets and software relating to known associations between individuals; databases, data sets and software relating to loyalty

schemes; databases, data sets and software relating to names of individuals and organisations; databases, data sets and software relating to petrol stations and their facilities; databases, data sets and software relating to postal codes and addresses; databases, data sets and software relating to project management; databases, data sets and software relating to public record information; databases, data sets and software relating to risk management; databases, data sets and software relating to tax, benefits and grants; databases, data sets and software relating to tenants or prospective tenants; databases, data sets and software relating to voters and registers of voters; databases, data sets, software and apparatus relating to payment processing; maps stored or viewed in electronic form; mats for use with a computer mouse; non-volatile media (including CDs, DVDs, tapes and video cassettes and other devices) for recording data, sound, images, text or other information; publications in electronic form;

Class 16: Instructional and teaching material (other than apparatus) relating to databases, data sets, software and/or services; maps including maps of geographic, demographic and geodemographic distributions, retail site and property location maps; printed matter and printed publications.

Class 35: Billing services; business administration; business continuity services; business information services, business management; business research services; operating of call centres; management of call centres; collection of data; commercial information agency services; company and non-corporate enterprise information services; comparisons of items (whether goods or services) by price and/or other attributes; competitor information services; compilation of information onto databases; computerised data storage services; computerised data verification; consultancy services relating to tax, benefits and grants; consumer lifestyle information services; consumer values information services; customer loyalty services; customer profiling services; customer relationship management services; customer targeting and marketing services; data analysis services; data cleansing services; data compression services; data management services; data processing services; data retrieval services; data searching services; data storage services; database management services; employee record and employee history verification services; geodemographic analysis and profiling services; human resource consultancy services; human resource management services; identity authentication and verification services; list rental services; list screening services; local market planning services; market analysis bureau services; market penetration information services; market research services; postcode analysis services; project management services; promotional services; provision of information about companies and unincorporated businesses; provision of information about postal codes and addresses; public record information services; recruitment agency services; retail site location services; risk management services; telemarketing services; telephone call handling services; voters roll information services; opinion polling; economic consultancy services; economic research; provision of information about any of the aforementioned services.

Class 38: Bulletin board services; communications services between computers; communications services; data broadcasting services; delivery of information by telecommunication; delivery of messages by telecommunications or communications

networks; electronic communication services; electronic mail services; encryption and decryption services for communication purposes; information stored on computers; interactive telephone services; leasing of telecommunications installations or communications networks; operation of local area or wide area networks; provision of domain names; provision of internet access to vetted and selected web sites; text messaging services; video messaging services; provision of information about any of the aforementioned services.

Class 41: Arranging and conducting award ceremonies; arranging and conducting competitions; arranging and conducting conferences; desktop publishing services; dissemination and distribution (other than transportation) of training and educational information; electronic magazine services; lecturing services; library services; lottery services; mentoring services; photography; press cuttings services; publishing services; production of television and radio programmes; training and education services; photography services; provision of information about any of the aforementioned services.

Class 42: Computer analyst and programming services; computer database consultancy services; computer disaster recovery services; computerised analysis of data; conversion of data or documents from physical to electronic media; data security services; feasibility study services; forensic services relating to databases, data, electronic apparatus and/or computer software; geodemographic coding services; industrial research services; information systems design services; maintenance and updating of computer software; mathematical modelling services; rental of computer hardware and software; testing of databases, data, electronic apparatus and/or computer software; web pages creation services; creation of maps; provision of information about any of the aforementioned services.

Class 43: provision of facilities for conferences and training events; provision of information about any of the aforementioned services.

Class 45: Access control (for security) services; age verification services; biometric security services; electronic signature authentication and verification services; fraud detection and fraud prevention services; identity of individuals authentication and verification services; identity theft prevention and identity theft detection services; information security services; issuing digital identity certificates; passport authentication and verification services; providing background identification and verification of individuals check services; provision of information about criminals or suspected criminals; provision of information relating to vehicle verification, mileage and condition for fraud prevention and detection purposes; registration services for notification of loss; security consultancy services; services for providing information on aliases (assumed names) and third parties with whom they have an association; alias and association information services; candidate verification services; provision of information about names of individuals and/or organizations; vehicle (and vehicle parts) information services, namely identification of a vehicle's history, including details of ownership, vehicle identifiers (such as VIN numbers, engine numbers, parts numbers and other serial numbers); fraud prevention and detection services; digital image recognition services in

particular identification of numbers and movements of people contained within images; legal services; licensing of computer programs, software; provision of information about any of the aforementioned services.

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Class36: Credit reference agency services; credit scoring; preparation of credit reports; consumer credit history services.

17) Both applications are opposed under Section 3(1)(b) and (c) which read:

“ 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.”

18) It is clear from the views expressed by the European Court of Justice (ECJ) in *Companyline* [2003] E.T.M.R. 20 and the High Court in *Have a Break* [2002] EWHC 2533 (Ch) that Section 3(1)(b) has separate and independent scope from Section 3(1)(c). Therefore, I have to consider each section separately.

19) I turn first to consider the position under Section 3(1)(c). There are a number of ECJ judgments 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. 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* – Case 191/01P (Doublemint) paragraph 30;

- thus Article 7(1)(c) (Section 3(1)(c)) 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;

- if a mark which consists of a word produced by a combination of elements is to be regarded as descriptive for the purposes of Article 3(1)(c) it is not sufficient that each of its components may be found to be descriptive, the word itself must be found to be so – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, paragraph 96;

- merely bringing together descriptive elements without any unusual variations as to, for instance, syntax or meaning, cannot result in a mark consisting exclusively of such elements escaping objection – *Koninklijke Nederland v Benelux Merkenbureau*, paragraph 98;

- an otherwise descriptive combination may not be descriptive within the meaning of Article 3(1) (c) of the Directive provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word trade mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark – *Koninklijke Nederland NV v Benelux Markenbureau*, (Postkantoor), paragraph 99.

20) I note the comments made in *Matratzen Concord AG v Hukla Germany SA* Case C-421/04) where the ECJ stated:

“In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, who are reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50)”.

21) I am also mindful of the decision of the General Court (formerly CFI) in *Ford Motor Co v OHIM*, Case T-67/07 where it was stated:

“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.”

22) The opponent also referred me to the decision of OHIM’s Board of Appeal in case R289/199-3 *PC EXPERT* where at paragraph 19 they said:

“The word “expert” per se is a common term without any originality or distinctiveness and any competitor or non-competitor is free to use that term. As regards the abbreviation “PC”, it is apparent that it belongs to the public domain and forms part of the store of terms available to all traders in the field of computer products and services. Used in connection with the claimed goods and services, the combination of those two words is no more than an obvious laudatory affirmation which indicates to the relevant public that the applicant’s products and services, since they are manufactured/supplied by or destined to PC experts, are done so well, that they could not possibly be done better (see decision of 27 July 1999 in Case R 230/1998-3-XPRT, paragraphs 15 and 16).”

23) Whilst I take note of this judgment, I take the view that it merely demonstrates that each case has to be determined on its own facts. The above case shows that the registrability of such marks depends upon whether the particular combination of words used in relation to the particular goods and services applied for may be seen as describing the goods and services or some quality of the goods and services.

24) It is clear from the above that I must determine whether, assuming notional and fair use, the mark in suit, will be viewed by the average consumer to directly designate the characteristics of the goods and services which remain opposed. Only if the mark is no different from the usual way of designating the relevant goods/services or their characteristics can it be debarred from registration.

25) In their submissions, dated 29 May 2009, the opponent stated:

“4. The sequential use of these words in the form applied for does not consist of an unusual juxtaposition of the two words but rather creates a combination which is readily identifiable as a normal usage of the two words to describe a person who has a comprehensive and authoritative knowledge in the area of credit. By way of example only, we refer to exhibit AMP 2 of the witness statement of Allan Poulter which includes printouts from various Internet sites where the term “credit expert” is used in a descriptive manner.”

And:

“9. We would submit that the term “credit expert” would be perceived by the relevant consumers of services covered by the application as indicating that such services were for use by someone who could be described as a “credit expert” or relate to goods or services provided by a “credit expert”. Clearly, the term “credit expert” describes someone who is

competent in performing the services in Class 36 of the application, namely “*Credit reference agency services; credit scoring; preparation of credit reports; consumer credit history services*”.”

26) At the hearing Mr Poulter, for the opponent, contended:

“The other side conceded to a certain extent that they can see -- they are not necessarily conceding we are right in the argument -- how we can manufacture an argument that for some of the goods in Class 9, the objection may be relevant. They specifically referred to those services which use "credit" after the description so "credit bureau software" and "credit consultancy software services".

I come back to when we were looking at the specification at the outset. If you can accept the argument in relation to those particular goods because they are credit-related then necessarily for any term which is broader than those terms, like computer software generally, it must necessarily incorporate those specific credit-related goods. You cannot have credit bureau software, but you can have computer software generally because that would cover credit bureau software. It would be nonsensical.

To the extent that any of these terms within Class 9 incorporates a broad enough description to encompass goods which are credit-related or relevant to the provision of credit expert advice, then it is relevant and the broad terms should not be allowed. You cannot just say, "Yes, okay you can do it, but then you should take out credit bureau software and leave in computer software." That applies throughout these various general terms that are in there where there are databases and data sets which are not specified.

They referred specifically to the dictionary definition of "credit" and tried to explain that therefore that is how you have to assess the word combination of "Credit Expert". Of course, you do not just look at the dictionary definition. Yes, that gives you the broad meaning of the term, but there is a general awareness of what "CreditExpert" might include. What does a credit expert advise on? It can be any aspects of these services covered by the Class 36 specification. There are credit reference agency services, credit scoring, preparation of credit reports, consumer credit histories, any services relating to credit in any shape or form. If you are an expert in it then you will be referred to as a "credit expert". We have seen that in many of the descriptive references to individuals who are giving commentary on credit-related matters where they are referred to as "credit experts". You do not just take the dictionary definition and say, "You have to bring it within that specific term."

27) The opponent has filed evidence which shows use by others of the words “credit expert” in relation to individuals and also companies who are experts in the field of credit. It is claimed that these words are not only entirely descriptive and non-distinctive, but serve in the trade to indicate the kind of service being offered i.e. advice on credit from an expert. However, the evidence does not show any use upon goods, only people who may then offer a service. Also the use is not use by the trade but by the media. It does not refer to the goods or services offered by these individuals or companies but is merely a way of identifying that the individual or company is an authority in the field of credit and as such is a credible commentator.

28) The range of goods still opposed in Class 9 are, broadly speaking, computer databases and software. The opponent did not make any specific arguments regarding the mark in suit being used on such goods other than to state that the goods might relate to the credit industry in some way, such as processing applications for credit. Similarly, when referring to the Class 16 goods it was stated that these might be used to create maps of credit worthiness perhaps by postcode which would correlate to income or value of homes. Whilst I accept that software will be used for credit rating and that maps such as those suggested by the opponent do exist and will be used they have not shown that such goods are referred to as “credit expert” by the trade, nor do I believe that the mark in suit designates the kind, quality etc of the goods in question. Therefore, the opposition under Section 3(1)(c) in relation to the goods in Classes 9 & 16 must fail.

29) I accept that the majority of the services covered by Classes 35, 36, 38, 41, 42, 43 & 45 may be offered in relation to obtaining credit, credit rating or advice regarding credit. This is explicitly stated in regard to the class 36 services. However, the opponent has failed to provide any evidence that the mark in suit is used in trade in relation to such services, nor do I believe that the mark in suit designates the kind, quality etc of the services in question. The only use is as set out in paragraph 27 above. Therefore the opposition under Section 3(1)(c) in relation to the services in Classes 35, 36, 38, 41, 42, 43 & 45 must fail.

30) I now turn to consider the issue of distinctiveness under Section 3(1) (b) of the Act. In doing so I adopt the approach summarised by the ECJ in its judgment in *Linde AG, Windward Industries Inc and Rado Uhren AG* Joined Cases C-53/01 to C- 55/01:

“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).

.....

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.”

31) I must determine whether the trade mark applied for is capable of enabling the relevant consumer of the goods and services in question to identify the origin of the goods and services and thereby to distinguish them from other undertakings. In *SAT.1 Satelliten Fernsehen GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-329/02* the ECJ provided the following guidance:

“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.”

32) In *Cycling Is... Trade Mark*, [2002] R.P.C. 37, Mr Hobbs QC stated:

“67. The case for allowing registration rests upon the proposition that the signs are cryptic to a degree which makes it more likely than not that they would carry connotations of trade origin (whatever other connotations they might also carry) in the minds of the relevant class of persons or at least a significant proportion thereof.

68. The case for refusing registration rests upon the proposition that the signs are visually and linguistically meaningful in a way which is more likely than not to relate the goods and services to the activity of cycling without also serving to identify trade origin in the minds of the relevant class of persons.

69. The difference between these two positions resides in the question whether the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin specific or origin neutral.

70. The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect.”

33) It is clear from the above that I must assess the mark’s distinctiveness in relation to the goods and services which remain opposed. I must also take into account the perception of the relevant consumer of the goods and services which, to my mind, means the general public as well as businesses.

34) In their submissions, dated 29 May 2009, the opponent stated:

“7. As far as the claim under Section 3(1)(b) is concerned, clearly the term “credit expert” will be perceived purely as a description of a particular type of financial professional and would not be perceived as a badge of origin for the services covered by the application.”

35) I must therefore consider the issue from the perspective of someone who encounters the mark “Credit Expert” used in relation to the goods and services opposed and determine how that person would react. The evidence shows that the words “Credit” and “Expert” are both recognised words used in the English language and found in any dictionary. The definitions provided in the evidence are reproduced below for ease of reference.

“Credit: the ability of a customer to obtain goods or services before payment, but on the trust that payment will be made in the future; the money lent or made available under such arrangement; an entry recording a sum received, listed on the right-hand side or column of an account; a payment received; public acknowledgement or praise typically that given or received when a person’s responsibility for an action or idea becomes (unclear) made apparent.”

This definition was very badly photocopied and parts are very difficult or impossible to read.

“Expert: a person who has a comprehensive and authoritative knowledge of or skill in a particular area; having or involving such knowledge or skill.”

36) Earlier in this decision at paragraph 27 I stated that the evidence shows that the words “credit expert” are used by the media in a specific manner. I stated:

“It does not refer to the goods or services offered by these individuals or companies but is merely a way of identifying that the individual or company is an authority in the field of credit and as such is a credible commentator.”

37) I note that the opponent seems to agree with my view in its written submissions as stated in paragraph 34 above. At the hearing the opponent did not make a case against each of the goods and services but relied upon an overall view that the mark in suit was descriptive. The nearest the opponent got to a specific contention was with regard to “Databases, data sets and software relating to creating, managing and printing maps”. It was contended:

“Is it not descriptive, therefore, of those services or descriptive of a product which can be used by CreditExpert to provide his opinion on particular areas, creditworthiness or fraud in particular geographical areas? It is a tool that he would want to use maybe. It is non-distinctive. It could describe an element of the services that are being provided by reference to those products.”

38) Whilst I accept that such mapping may be carried out by an expert in credit, the use of the mark in suit upon such a database would be not be seen as descriptive by the average consumer who would be the actual expert in credit. Having reviewed the Class 9 and 16 goods that are being opposed I believe that the mark in suit is not descriptive of the goods. Nor do I accept the contention that the mark is non-distinctive for these goods. The opposition under section 3(1)(b) therefore fails with regard to these goods.

39) It is clear that the mark in suit refers to a person or company who have considerable knowledge of credit issues. Therefore, in reviewing all of the services claimed under both applications it is my view that they are all acceptable with the following exceptions where I believe the mark can be said to be devoid of distinctive character for the services offered.

“Class 35: Business information services; business management; business research services; commercial information agency services; consumer lifestyle information services; customer profiling services; customer targeting and marketing services; data analysis services; data searching services; identity authentication and verification services; postcode analysis services; provision of information about companies and unincorporated businesses; provision of information about postal codes and addresses.

Class 36: Credit reference agency services; credit scoring; preparation of credit reports; consumer credit history services.”

40) To my mind, the mark in suit merely conveys the meaning of an individual or establishment highly experienced in credit issues providing advice or a service in relation to credit issues, it does not act as an indicator of origin. In my view, the average consumer “who does not know there is a question” would consider CREDIT EXPERT or CREDITEXPERT to be devoid of any distinctive character for the services listed at paragraph 39 above. They would not find that it functioned as an indication of origin, but merely as indicating that the person or company offering the service had a level of expertise. As such, I find that the ground based upon Section 3(1) (b) of the Act must fail in relation to all of the goods and services which remain opposed other than those listed at paragraph 39 where the ground of opposition is successful.

41) Having made this finding I now turn to consider the issue of whether the applicant’s mark has acquired distinctiveness through use. In the *Windsurfing Chiemsee* case [1999] ETMR 585, the ECJ set out the test to be applied in order to determine whether a trade mark has acquired a distinctive character under Article 3(3) of the Directive (Section 3(1) proviso). It held that the national courts may take into account evidence from a variety of sources, but a finding that the mark has come to denote the goods as coming from a particular undertaking must necessarily mean that the provisions of Article 3(3) are met. The Court held that:

“In determining whether a mark has acquired distinctive character following the use made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from the goods of other undertakings” (paragraph 49).

“In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from Chambers of Commerce and industry or other trade and professional associations” (paragraph 51).

“If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify the goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances on which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general abstract data such as predetermined percentages” (paragraph 52).

42) I also take into account the comments in *British Sugar Plc v James Robertson & Sons Ltd* (TREAT) RPC 281.

“There is an unspoken and illogical assumption that use equals distinctiveness. The illogicality can be seen from an example. No matter how much use a manufacturer made of the word “soap” as a purported trade mark for soap, the word would not be distinctive of his goods.”

43) Further, I note the comment in *Bach Flower Remedies*:

“Use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either.”

44) At the ex-parte stage the application for the Class 36 services was accepted only after evidence of distinctiveness acquired through use had been filed by the applicant. Much of the evidence of use was in regard to the website of the applicant and referred to either as www.creditexpert.co.uk or “creditexpert.co.uk”. The applicant contended that the “www”, “.co” and “.uk” aspects were non-distinctive elements and should be disregarded, thus leaving just the mark in suit. Whilst I would agree that the “www”, “.co” and “.uk” aspects are non-distinctive I do not agree that they can be completely disregarded.

45) The applicant contended, in relation to the services in Class 36, that:

“It is accepted that each of these services is described in the specification using the term “credit”. However, the services in question are not the provision of credit; they are advisory and reporting services concerning the credit history of consumers. Furthermore, the addition of the term “expert” to make the neologism “creditexpert” results in a word which means far more than the sum of its parts.

As set out above, if the term credit expert had a natural meaning, it is that of “a person which has a comprehensive and authoritative knowledge of or a particular skill in the ability of a customer to obtain goods or services before payment”. A credit expert would be a person who is expert in obtaining credit. That meaning does not describe the services for which application B is applied.”

46) I do not accept this contention. To my mind it is far too narrow a definition. The term “credit expert” would refer to a person or company who is an expert in the field of credit. This might be

obtaining credit, granting credit or advising on any aspect of credit. This is precisely how the term is used by the press when they use the term to describe individuals or companies who are not connected to the applicant but are proffering advice or opinions on credit issues.

47) A considerable amount of the evidence provided is undated or it is unclear what publication it appeared in. Whilst there is evidence of use it is not put into perspective. There is no evidence from the trade or from the public to show how the mark is regarded. The turnover figures are substantial as are the number of people receiving reports, but as most of these would appear to be on-line reports it is unclear if these can be linked to the mark as applied for rather than the marks www.creditexpert.co.uk or "creditexpert.co.uk" which could be general sites offering advice or links to providers of such services. I do not consider that the evidence proves the mark applied for has acquired a distinctive character as a result of the use made of it and I conclude that the applicant has failed to satisfy the proviso of section 3(1) of the Act. The opposition under Section 3(1)(b) with regard to the following succeeds.

"Class 35: Business information services; business management; business research services; commercial information agency services; consumer lifestyle information services; customer profiling services; customer targeting and marketing services; data analysis services; data searching services; identity authentication and verification services; postcode analysis services; provision of information about companies and unincorporated businesses; provision of information about postal codes and addresses; provision of information about any of the aforementioned services.

Class 36: Credit reference agency services; credit scoring; preparation of credit reports; consumer credit history services; provision of information about any of the aforementioned services."

COSTS

48) The opponent has only been partly successful and for the most part it failed in its opposition which was completely unfocussed, even in its skeleton arguments and contentions at the hearing. I order the opponent to pay the applicant the sum of £1,000. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27 day of October 2010

**George W Salthouse
For the Registrar,
the Comptroller-General**