

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 2537918 IN THE  
NAME OF CROCODILIO LIMITED**

**AND IN THE MATTER OF THE APPLICANT'S APPEAL TO THE  
APPOINTED PERSON FROM THE DECISION OF MS LINDA SMITH DATED  
19 AUGUST 2010**

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**DECISION**

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**Introduction**

1. On 2 February 2010 the Applicant, Crocodilio Limited, applied to register the following series of three trade marks:

FeedbackMatters  
FEEDBACKMATTERS  
feedbackmatters

in respect of the following services in Class 35:

*“Advertising; business management; business administration; office functions; electronic data storage; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; opinion polling; data processing; provision of business information.”*

2. The application was refused by the Registrar, following a hearing before a hearing officer, Ms Linda Smith, on the grounds that the marks are devoid of any distinctive character and thus their registration would be contrary to section 3(1)(b) of the Trade Marks Act 1994 (“**the Act**”). The hearing officer’s reasons for the refusal are set out in a decision dated 19 August 2010 (“**the Decision**” - BL O-299-10).
3. The Applicant has appealed to the Appointed Person under section 76 of the Act, raising several procedural and substantive objections to the Decision. The Applicant has been represented throughout the proceedings by its director, Christopher Bates, without professional representation.
4. I shall refer to the series of three marks applied for collectively as “**the Mark**” since the three variants of “FEEDBACKMATTERS” differ only as to whether the letters used are upper case or lower case, which does not substantially affect the identity of the trade mark or the analysis that follows.

### Procedural history

5. Following an initial indication from the Registrar's examiner that the Mark was not eligible for registration, there followed some written correspondence between Mr Bates and the examiner in the early part of 2010, in which Mr Bates sought to persuade the examiner that he was mistaken.<sup>1</sup>
6. Having failed to persuade the examiner by these written submissions, Mr Bates was given the opportunity to present his case orally at an *ex parte* hearing that was held on 19 May 2010. The hearing officer suspended the hearing to consider the matter further. Later the same day, the hearing officer telephoned Mr Bates to notify him of her decision to maintain the objection to the Mark and refuse the application. Mr Bates told the hearing officer that he had already written and posted a letter to the Registrar with additional submissions which he hoped would persuade her to change her mind, in response to which the hearing officer agreed not to issue her record giving the outcome of the hearing until she had received and considered the letter.
7. By 27 May 2010, the Applicant's letter had not reached the hearing officer and so she went ahead and issued the hearing record, which confirmed that the application was refused pursuant to section 3(1)(b) of the Act, giving brief reasons.
8. It subsequently transpired that Mr Bates' letter had been received at the Intellectual Property Office ("IPO") on 20 May 2010 and forwarded to the Trade Marks Directorate on 24 May 2010, but that it had not been passed on to the hearing officer until after the hearing record had been issued. By the time this was discovered, Mr Bates had also written a letter (on 20 May 2010) to the IPO's Chief Executive, Mr John Alty, complaining about the manner in which his application had been conducted and alleging that there had been various procedural errors which might lead to the unfair rejection of the Mark. Mr Bates also gave notice in this letter that he had made requests of the IPO under the Freedom of Information Act 2000 ("**FOI requests**") in connection with the procedures that had been followed in relation to the Mark.
9. While correspondence ensued between Mr Alty and Mr Bates and the FOI requests were pursued (and refused by the IPO), no contact was made with the Applicant in relation to the late arrival of Mr Bates' letter of 19 May 2010. The refusal of the Mark therefore stood, and the Applicant went on to request a formal statement of reasons for the refusal, under section 76 of the Act and Rule 69(2) of the Trade Mark Rules 2008, by filing a Form TM5 on 2 July 2010. That led to the Decision being issued on 19 August 2010.

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<sup>1</sup> Mr Bates' submissions at this stage are summarised at paragraphs 7 to 9 of the Decision.

10. No express reference was made in the Decision to Mr Bates' letter of 19 May 2010, sent immediately after the hearing. There is a reference (at paragraph 26) to "Mr Bates' letter of 20 May 2010", which may have been a reference to his letter of that date to Mr Alty, or alternatively could have been a slip intended to refer to the letter of 19 May 2010, or even to an earlier letter from Mr Bates of 20 April 2010. Thus it is unclear whether Mr Bates' letter of 19 May 2010 was read and taken into account for the purpose of setting out the reasons for the refusal in the Decision.
11. The Applicant commenced the current appeal by filing a Form TM55 on 15 September 2010. The hearing of the appeal was postponed while Mr Bates pursued a complaint to the Information Commissioner in relation to the IPO's handling of his FOI requests. He explained in a letter to me concerning the adjournment of the appeal that his FOI requests related to internal checklists and process guides used by the IPO in the course of assessing specific trade mark applications (particularly for other "[X]MATTERS" marks, where [X] represents another word) so that he could be better prepared for the appeal hearing or alternatively decide to withdraw the appeal in the light of the information revealed.
12. Mr Bates informed me that his applications to the Information Commissioner had been partially successful, with the result that he obtained some information from the IPO. He did not submit any of that information as evidence in support of the application, but as I understand it he relied on it for the purpose of formulating his submissions at the appeal hearing, and he did make some references to it at the hearing itself.

#### Section 3(1)(b) of the Act

13. Section 3(1)(b) of the Act provides that "*trade marks which are devoid of any distinctive character*" may not be registered, subject to a proviso that applies if the mark concerned has in fact acquired a distinctive character as a result of the use made of it. There was no claim of acquired distinctiveness in this case.
14. This provision reflects article 3(1)(b) of Directive 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trade marks ("**the Directive**") and corresponds to article 7(1)(b) of Council Regulation 207/2009/EC of 26 February 2009 on the Community trade mark ("**the Regulation**"). Guidance from the Court of Justice of the European Union ("**CJEU**") and the General Court in relation to the corresponding provisions under either of these pieces of European legislation should therefore be followed when it comes to interpreting section 3(1)(b) of the Act.

### Approach to this appeal

15. Usually appeals against hearing officers' decisions are dealt with by way of review rather than a rehearing, with the appellate tribunal (Appointed Person or High Court Judge) being reluctant to interfere with a decision unless the hearing officer has made an error of principle in reaching his or her conclusion: *REEF Trade Mark* [2003] RPC 5. My fellow Appointed Person, Mr Iain Purvis, has recently questioned the degree of reluctance that the appellate tribunal should have before overturning a hearing officer's decision under section 3(1)(b), in *Re PUTTERSCOPE* (BL O-096-11, 8 March 2011). Although I was encouraged by Dr Bill Trott who attended the appeal hearing on behalf of the Registrar to express a view on whether I agreed with this, I decline to do so because I believe that there is another reason to treat this case differently from the norm, based on the muddle over Mr Bates' letter of 19 May 2010.
16. In circumstances where Mr Bates took the trouble to make further written submissions when the hearing officer was still deliberating on the acceptability of the Mark, and where he was told that her decision would not be issued until those submissions had been considered, but because of a delay within the IPO the refusal of the Mark was issued without consideration of the submissions, he can be justifiably concerned that he has not been given a fair hearing. The absence of a clear reference to the 19 May letter in the fully reasoned Decision adds to this concern.
17. I have read the letter of 19 May, and I strongly suspect that the contents either were read and taken into account before the full Decision was issued or (if they were not) would not have made any difference if they had been, because they largely repeat what had been said in earlier correspondence and at the hearing. Indeed, at the appeal hearing, Mr Bates said that the letter was effectively a "topped and tailed" version of his "script" for the first instance hearing. However, in the circumstances outlined above, I cannot be sure that my suspicion is correct. I also have to bear in mind that justice should not only be done but should be seen to be done, and that a third party who reads the chronology set out above is likely to be concerned that the Applicant might not have been fairly treated. I therefore do not restrict myself to considering whether the hearing officer made any error of principle in deciding to refuse the Mark, but I also consider whether I agree with the outcome, regardless of the correctness of the reasoning given.
18. Although I do not need to review the text of the Decision in minute detail, given the approach that I have decided to take, I do think it is appropriate for me to consider the particular objections to the Decision raised by the Applicant in the Statement of Grounds of Appeal, to the extent that they are substantive.

19. The Statement of Grounds of Appeal was 16 pages long, with 25 pages of attachments referred to in the Grounds. For present purposes, I reproduce the summary set out at the front of the document in the Annex to this decision. As can be seen, some of the Grounds are in fact complaints about the process and procedure involved up to that point. I do not need to consider these in any detail since, to the extent that there were any such failings, they can now be remedied by this appeal if they resulted in the wrongful refusal of the Mark. Having said that, the only material procedural defect that I have identified from my review of the complaints and of the file is the failure to take into account the content of Mr Bates' letter of 19 May 2010. None of the other procedural points raised appear to me to have materially affected the outcome.
20. In fact, some of the Grounds that are identified by the Applicant as being procedural errors seem to me to be complaints about errors in the IPO's approach to the assessment of distinctiveness, which I shall treat as substantive complaints worthy of examination as I make my own assessment.
21. Based on the full Statement of Grounds and the summary of key points that Mr Bates presented at the hearing, the Applicant's substantive objections to the Decision can be summarised as follows:
- (1) The hearing officer did not properly take into account the services for which registration of the Mark was sought or the characteristics of the relevant consumer.
  - (2) Section 3(1)(b) only precludes registration of trade marks which are devoid of "any" distinctive character, whereas the IPO makes a common mistake of ignoring the existence of the word "any", with the result in this case that the hearing officer has set what I will call the "distinctiveness bar" too high.
  - (3) The joinder of FEEDBACK and MATTERS into a single mark without a space is plainly an unusual conjunction which passes the proper distinctiveness bar.
  - (4) The IPO wrongly concluded that "feedback matters" had been used by other traders, and/or wrongly determined that the Mark should be kept free for use by other traders.
  - (5) The hearing officer wrongly ignored the IPO's own (and CJEU) guidance relating to the use of domain names as business identifiers.
  - (6) The IPO should give equal treatment to applicants, which it has not in this case because it has accepted several other marks for services in Class 35 comprising an ordinary word followed by "MATTERS", many of which are plainly less distinctive than the Mark.

22. I have read and considered all of the papers in the Registry file relating to the Mark as well as re-reading the key papers and the transcript of the appeal hearing immediately before writing this Decision. The fact that I do not expressly refer to a particular argument should not be taken to indicate that I have ignored it. I have taken all the arguments raised into account and will particularly tackle those that were made most forcefully and/or appear most relevant to the analysis that I now have to carry out.

### Analysis

23. The CJEU has repeatedly stated that the question of distinctiveness should be considered in the light of the underlying purpose behind article 3(1)(b) of the Directive / article 7(1)(b) CTMR (equating to section 3(1)(b) of the Act), which is to preclude registration of trade marks that are incapable of performing the essential function of guaranteeing the identity of the origin of the marked product 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: *SAT.1 v OHIM* at [23]; Case C-37/03 P *BioID AG v OHIM* [2005] ECR I-7975 (ECJ) at [27].

24. In accordance with that underlying purpose, it is now well settled through the cases that, for a trade mark to have distinctive character, it must serve to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish the goods or services from those of other undertakings. The CJEU has been remarkably consistent about this proposition over the years, as is evident from the following examples of the way in which the Court has put it in some of the leading cases:

Joined Cases C-53/01 to C-55/01 *Linde AG, Winward Industries Inc and Radio Uhren AG* [2003] ETMR 78 (cited by the hearing officer):

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).

...

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.

Case C-64/02 *OHIM v Erpo Möbelwerk GmbH (DAS PRINZIP DER BEQUEMLICHKEIT)* [2005] ETMR 58:

42. It is also clear from the case-law that the distinctiveness of a trade mark within the meaning of Article 7(1)(b) of Regulation No 40/94 means that the mark in

question makes it possible to identify the product for which registration is sought as originating from a given undertaking and therefore to distinguish the product from those of other undertakings and, therefore, is able to fulfil the essential function of the trade mark (see, to that effect, in particular *Procter & Gamble v OHIM*, paragraph 32, and the case-law there cited, and, in relation to the same provision contained in Article 3(1)(b) of Directive 89/104, *Merz & Krell*, paragraph 37, and *Linde and Others*, paragraph 40, and the case-law there cited).

Case C-238/06 P *Develey Holding GmbH & Co. Beteiligungs KG v OHIM* [2007] ECR I-09375:

79. According to consistent case-law, the distinctive character of a trade mark within the meaning of Article 7(1)(b) of Regulation No 40/94 means that the mark in question makes it possible 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 those of other undertakings (Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* [2004] ECR I-5173, paragraph 32, and Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 42)....

25. It is also well-established that the distinctive character of a mark must be assessed by reference to, first, the goods or services in respect of which registration is applied for and, second, the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect: Joined Cases C-53/01 to C-55/01 *Linde AG* (above) at [41]; Case C-24/05 P *August Storck v OHIM* at [23]; Case C-238/06 P *Develey* (above) at [79].
26. Where an applicant does not rely on the proviso to section 3(1) concerning acquired distinctiveness, section 3(1)(b) precludes registration of marks that are not inherently distinctive. In other words, to get past the test, the mark must be capable of immediately enabling relevant consumers to distinguish the goods or services bearing the mark from the goods or services of competing undertakings: Case C-136/02 *Mag Instrument* at [50]. This is not about whether the relevant consumers have ever (or never) seen the mark before, or whether they will recognise the mark again, but is about whether they will see the mark as denoting the origin of the goods or services without the need to be educated. (See, for example, *Yakult Honsha KK's Trade Mark Application* [2001] RPC 39, p.756 at pp.758-759.)
27. It is clear from the Decision that the hearing officer was well aware of these key principles involved in understanding and applying the distinctiveness test under section 3(1)(b). She referred to them at paragraphs 13 to 16 of the Decision and cited a number of the relevant authorities, ending as follows:

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

simply as a sign that is unlikely to be considered to be a “symbol” of a particular trader...

17. In relation to the average consumer of the services at issue, this will not be the general public, but those engaged in commerce. To such people, advice relating to the running and advertising of their business is essential.

28. Before applying the tests, she then set out some dictionary definitions:

18. The principle (sic.) dictionary definition of the word FEEDBACK is

“... information about reactions to a product, a person's performance of a task, etc. which is used as a basis for improvement”.

And the most relevant dictionary definitions of MATTER is:

“ ... a subject or situation under consideration: a great deal of work was done on this matter, financial matters.

To be of consequence or importance”.

19. Regarding the word MATTERS, it is merely the plural of the word MATTER. Both these meanings could equally apply to the mark i.e. that feedback is important or that the subject matter of the services is feedback.

29. The Applicant's Statement of Grounds complained that the source of these definitions was not given and listed some other definitions of “feedback” from the Shorter Oxford Dictionary, including one concerned with feedback in an electric circuit and another in the context of biology and psychology. He also pointed out that the SOED presents some 21 definitions of the word “matter” (18 as a noun, 3 as a verb). However, what the hearing officer was rightly trying to do was to set out some obvious meanings of the two words in question which were of relevance to the services applied for. The fact that there are other meanings in other contexts, or even in the same context, does not detract from this.

(1) Alleged failure to take account of the relevant services or type of consumer

30. In the Statement of Grounds of Appeal, Mr Bates asserted as follows:

**“Our product**

The FeedbackMatters product/service is a combination of physical and electronic tools for gathering and analysing the feedback of users of corporate services. It gathers highly specific information in a secure and structured manner that permits detailed analysis.

...

**Our market**

Within our primary target market, there currently operate no more than five competitors. It is our view that market awareness amongst buyers (the number of which is also small) is typically high, as is their level of general knowledge of technical system and organisations operating in this space. They are well informed.”



31. He was apparently frustrated that the hearing officer did not take account of similar information placed before her at first instance. However, she quite correctly considered the position by reference to the services listed in the specification of services for the Mark and the presumed average consumer of those services, rather than limiting herself to the very specific descriptions offered by Mr Bates.
32. The hearing officer first (at paragraph 17) determined that the average consumer of the services in issue would not be the general public, but “those engaged in commerce”. Mr Bates suggested that this was “pure (and misinformed) speculation” on her part and submitted that, since the average consumer was supposed to be “reasonably well informed” under the case law, she should have assumed that they would “already know about the nature of [the Applicant’s] product/service”.
33. This is not how the analysis works. When assessing inherent distinctiveness, the IPO has to take the mark applied for and take the services applied for, and then consider how the average consumer of those services (or each category of those services, if the average consumer for each is likely to be different) would be likely to perceive the mark if used in relation to those services. If the Applicant wanted the assessment to relate to a much narrower type of consumer in relation to one very specific service, then that is what it should have listed in the specification. For example, if the service provided by the Applicant could properly be described as “provision of feedback in relation to business performance”, the hearing officer would have had to consider the notional average consumer of a user of such a service. However, I do not suggest this as a way forward for the Applicant, since (a) that person would probably still not need to be defined more specifically than “a person engaged in commerce”; and (b) such a narrow description of the services would tend to reinforce the problems with distinctiveness that the Decision raises and might even result in problems under section 3(1)(c) which precludes the registration of descriptive trade marks.
34. The hearing officer considered the Mark in the light of the services in the specification and the relevant consumer in the following way:

20. It is clear to me that the messages conveyed by the marks are plain and simple: the applicant deals with opinions and reactions to something intended to provide useful information for future decisions and development – and that this process is important. To the average consumer – the businessman as referred to above – it is essential that they obtain information, i.e. feedback, about the performance of their companies and of its goods and services in order to provide a good service and remain competitive. This is certainly the significance given to the term by Mr Bates himself. In his letter of 20 April 2010 he states that “The group has commenced the development and launch of a novel system, called FeedbackMatters, which solicits feedback from a range of services users (within our clients’ marketplaces) for data mining and analysis purposes. The output of this enables improvements to business processes/services to be made by our clients ...”. I want to consider this shared understanding in relation to the various services the applicant has applied for.

- First, “business management, business administration services” and the “organisation, operation of loyalty and incentive schemes”. It would be common practice for businesses engaged in the latter to seek feedback from customers as part of an assessment as to how they are operating and developing. Any search on the Internet will reveal numerous companies inviting feedback from their customers, as a means of indicating the effectiveness of their operations.
- Next, “opinion polling”. It is facile to state that the latter is specifically all about “feedback” of some form or another. The “provision of business information” includes opinion polling.
- As for “advertising services” (internet or otherwise) this activity would routinely involve the assessments of the success of particular campaigns. There many examples of the latter on the Internet.
- Turning to “electronic data storage” and “data processing” services I consider the meaning of the sign to indicate that the subject matter of the data (or its analysis) is feedback – that is, the sign will be taken to indicate content and the importance thereof in a general sense, i.e. the analysis or storage of data will be concerned with, or a repository of, feedback information. Once again I do not consider the sign would be seen by the average consumer as indicating trade origin.

21. It is less clear whether the sign would be seen as a trademark for “office functions”. If the services provided by the applicant are specific office functions such as duplicating and photocopying services, the taking of telephone messages and the like, then it is likely that the term could “work as a trade mark” for such services. If the applicants can be more specific about the nature of the services in this context they are seeking to protect, it is possible that the objection here could be waived.

35. In the Statement of Grounds the Applicant objects that it did not have the “shared understanding” set out above and that the IPO had consistently made assumptions about and misunderstood the nature of its services and the market in which it operates. But, as stated above, the important thing is to look at the specification of services and consider how the average consumer of those services would regard the Mark when used in relation to those services. That is what the hearing officer did. While I or any other tribunal might have used different words or phrases to explain the analysis, the essential message is that for all of the services discussed in paragraph 20 of the Decision, there would be an obvious and everyday meaning of the term “feedback matters” which would be understood by the average consumer (the person engaged in commerce) as indicating either that feedback is important or that the service concerns matters of importance, and there is nothing in the term which would lead to an immediate assumption that it was intended to be an indication of origin. (I deal below with the question of the joinder of the two words into one.)

36. In relation to the comments at paragraph 21 about “office functions”, I would not have separated these services out from the rest of the specification as giving the

Mark more chance of being accepted. The power of the Mark to individualise office functions, even if restricted to something like photocopying services or phone answering services, as suggested by the hearing officer, seems to me to be no greater than for the other services. Although the Mark is less obviously potentially descriptive of what the services entail, it nevertheless remains lacking in the ability to denote origin without first being used in a way that would educate business people that this is its purpose.

(2) Use of the word “any” and the bar being set too high

37. As pointed out by the Applicant, it is not necessary to show that a mark has a particular level of creativity or originality in order to establish distinctive character: Case C-329/02P *SAT.1 Satelliten Fernsehen GmbH v OHIM* [2005] ETMR 20 (ECJ) at [41].
38. On the other hand, the fact that a sign is capable of constituting a trade mark does not mean that it necessarily has inherent distinctive character in relation to particular goods or services: Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089 at [32]; Case C-265/09 P *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co. KG* at [29]. Words plainly are capable of constituting a trade mark, but many are too descriptive, everyday or ordinary, particularly when used in relation to certain goods or services, to have distinctive character without the benefit of prior use to teach consumers that they have trade mark significance.
39. Mr Bates stressed that the inclusion of the word “any” before “distinctive character” in section 3(1)(b) of the Act means that a minimal degree of distinctive character must be sufficient to get over the threshold of not having any distinctive character at all (though he did not concede that the Mark only had minimal distinctive character). He contended that the IPO appeared not to appreciate the importance of the inclusion of the word “any”. He explained that one of his FOI requests was aimed at seeking to quantify the extent to which the IPO used the terminology “devoid of distinctive character” rather than “devoid of any distinctive character”. The outcome was that in 2009 there were over 1,600 instances when communications went out from the IPO to trade mark applicants that used the phrase without inclusion of the word “any”. In his own case, the Applicant received a letter dated 26 February 2010 from the IPO’s examiner, Mr Benbow, which misquoted section 3(1)(b) as applying to signs which are “devoid of distinctive character”. All this led him to conclude that the IPO was mistakenly setting the threshold for registrability as being higher than “any” degree of distinctiveness and consequently too high.
40. The Applicant’s approach places too much emphasis on the literal meaning of the words of the provision. If an entirely literal approach were the right one to take, then in my view the failure of the IPO to use the word “any” when referring to

section 3(1)(b) ought not to matter because the word “devoid” conveys the meaning of a total absence of distinctiveness in any event. However, the words of a statute derived from European legislation are not to be taken literally but should be given a purposive construction so that they are applied in a way which achieves the purpose of the provision, i.e. the purpose set out at paragraph 23 above.

41. The Applicant’s argument here is frequently used by applicants whose marks are rejected under section 3(1)(b) and the equivalent European law provisions, though perhaps not always as imaginatively or tenaciously as it has been by Mr Bates in this case. It assumes that there is a specifically measurable point below which a mark will be distinctive and above which it will not. Unfortunately, assessing distinctiveness is an art and not a science or a mathematical calculation; it has to be done by judging the mark, the goods/services and the relevant consumers in issue in a way which ensures that only those marks which “step up out of the morass of non-distinctive material” (as it is put by the authors of *Kerly’s Law of Trade Marks and Trade Names*, 15<sup>th</sup> ed at para. 8-048) are accepted for registration.
42. The Applicant’s arguments might be fuelled by the references that the General Court has made in some cases to “a minimum degree of distinctive character” being sufficient to avoid article 7(1)(b) of the CTMR/article 3(1)(b) of the Directive: for example, Case T-34/00 *Eurocool Logistik GmbH & Co. KG v OHIM* (“EUROCOOL”) [2003] ETMR 4 at [39]; Case T-128/01 *Daimler Chrysler Corp v OHIM* [2003] ETMR 87 at [33]; Case T-320/03 *Citicorp v OHIM* (“LIVE RICHLY”) at [68]. However, the CJEU has studiously avoided such remarks and has stated that it is unnecessary to rule on the possible dividing line between the concept of lack of distinctiveness and that of minimum distinctiveness: Case C-104/00 P *DKV Deutsche Krankenversicherung AG v OHIM* (“COMPANYLINE”) [2002] ECR I-7561 at [20].
43. The way that the hearing officer put it was as follows:

16. ... In this sense, the word “any” in Section 3(1)(b) does not represent a measure of a minimum level of distinctiveness but rather corresponds to a test of the likely reaction of the average consumer, essentially: Is the sign in question a trade mark or not? I will return to this point further below.

And then:

27. The essence of the word ‘any’ (and the same principle applies to the word ‘exclusively’ in Section 3(1)(c)) is whether the marks amount to nothing more than a non-registerable sign within the perception of the average consumer. The phrase “any distinctive character” does not mean “something” or even “anything” that is nontypical. In other words, the provision in the Act and the Directive do not amount to precluding only the “least departure from the norm”. What it does amount to is a legal test as to whether something is devoid of any distinctive character, that is, a negative answer to the question “Does the sign have the capacity to act as a mark of

trade?”. The phrase is not designed to set a minimum standard; it is intended to exclude all those signs that cannot (sans use) perform this function.

44. In my view, this explanation shows that the hearing officer understood the relevant test and was not setting the bar too high.
45. I also agree with her conclusion (set out at paragraph 28) that the mark does not have “sufficient linguistic imperfection, peculiarity, inventiveness or other creative application which might help endow it with the necessary capability to function as a trade mark”. The mark simply consists of two ordinary and everyday words “feedback” and “matters” put together, the combined meaning of which is a phrase which is easily understood. It is descriptive of some of the services listed in the specification for the Mark and, even where not directly descriptive, would not automatically be seen as an indication of origin without something additional like being put into a distinctive logo format or being used in a trade mark sense for a period of time.

(3) FeedbackMatters is an unusual conjunction

46. The Applicant argued that the use of “FeedbackMatters” in conjoined form is grammatically incorrect because of the absence of the space between the two words, which inevitably gives the Mark some degree of distinctiveness. The underlying words are never used in this form in practice and therefore people are bound to recognise this as trade mark use.
47. As the CJEU said in Case C-363/99 *Koninklijke KPN Nederland NV and Benelux-Merkenbureau, (POSTKANTOOR)*, and as the hearing officer cited:

98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

99. However, such a 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 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.

100. Thus, a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that, because of the unusual nature

of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the second case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purpose of the same provision.

48. Although that case was considering the mark POSTKANTOOR under article 3(1)(c) of the Directive (the equivalent of section 3(1)(c) of the Act), the same approach is appropriate for article/section 3(1)(b). Does the bringing together of the two word elements of the Mark in this case turn what would be unregistrable as two words into a registrable mark because, for example, the combined form takes on its own new meaning? In this case, it does not. The relevant average consumer would still see and read the Mark as consisting of the two words “feedback” and “matters” and, while they would notice the absence of the space, this would not be enough to tell them that the Mark had trade mark significance in relation to the services concerned.

49. This conclusion accords with other similar cases decided by the General Court where applicants have failed in their attempts to persuade the Court that joining two words together without a space is sufficient to make the resultant mark registrable. For example, in Case T-19/99 *DKV v OHIM*, the General Court said of the mark COMPANYLINE, when considering its attributes in relation to article 7(1)(b) of the Regulation:

26. In this case, the sign is composed exclusively of the words ‘company’ and ‘line’, both of which are customary in English-speaking countries. The word ‘company’ suggests that what is in point are goods or services intended for companies or firms. The word ‘line’ has various meanings. In the insurance and financial services sector it denotes, amongst other things, a branch of insurance or a line or group of products. They are thus generic words which simply denote a line of goods or services for undertakings. Coupling them together without any graphic or semantic modification does not imbue them with any additional characteristic such as to render the sign, taken as a whole, capable of distinguishing the applicant's services from those of other undertakings. The fact that the word ‘Companyline’ as such does not appear in dictionaries whether as one word or otherwise does not in any way alter that finding.

50. The CJEU found this reasoning to be correct on appeal: Case C-104/00 P *DKV v OHIM* [2002] ECR I-7561 at [13] to [25].

51. Similarly, in Case T-360/99 *Community Concepts AG v OHIM*, the General Court said of the mark INVESTORWORLD:

22. In this case the sign is composed exclusively of the terms ‘investor’ and ‘world’ both of which are common in English speaking countries. ‘Investor’ implies that the services designated are aimed at investors and fall within class 36 (see paragraph 3 above). The addition to that word of ‘world’ does not add any further feature such as to render the sign capable of distinguishing the services of the applicant from those of other undertakings as a whole (BABY-DRY, paragraph 27, and

COMPANYLINE, paragraph 26). Constituted as it is, the sign merely refers to the ‘world of the investor’, meaning, as the Office rightly observes, that the services in question relate to anything which might be of some interest to an investor.

23. The fact that the word ‘Investorworld’ is not grammatically correct and therefore does not exist in English in no way alters the above findings (COMPANYLINE, paragraph 26).

52. And in Case T-270/02 *MLP Finanzdienstleistungen AG v OHIM*, the Court said of the mark BESTPARTNER:

26. Coupling the two terms [BEST and PARTNER] together without any graphic or semantic modification does not imbue them with any additional characteristic such as to render the sign, taken as a whole, capable for the relevant public of distinguishing the applicant’s services from those of other undertakings (see, to that effect, COMPANYLINE, cited in paragraph 24 above, paragraph 26). It is evident from the term ‘bestpartner’ that the meaning of the two terms comprising it is ‘best partner’, in the same way as the terms simply placed side by side. The fact that the term as such does not appear in dictionaries– whether as one word or otherwise – does not in any way alter that finding.

53. Every mark has to be considered on its own merits, and I do not conclude from this line of cases that every combination of two relatively common words with readily understandable meanings will not be distinctive. However, I agree with the hearing officer’s conclusion that this is the case for the Mark and with her conclusion as stated at paragraph 23 of the Decision:

23. ... I do not consider that the words FEEDBACK MATTERS have any distinctive character for the services provided and the conjoining of the words does not create a different impression from those words presented separately.

(4) Erroneous finding of use by other traders or need to keep free for use

54. Mr Bates was particularly unhappy with the following statement in the Decision:

27. ... In this case, the reason why FEEDBACKMATTERS cannot, without first educating consumers that it is the indicium of one trader, is because its meaning is obvious, and it is used with that meaning in a manner that is thoroughly and comprehensively ubiquitous. To illustrate this point, when the sign is entered into the search engine Bing on the Internet, 123,000,000 results were brought back. The following are just some of the examples found:

Engage Mutual Assurance – stating that “your feedback matters” -  
<http://www.engagemutual.com/contact-us/>

Peopleperhour.com – also stating that feedback matters -  
[http://www.peopleperhour.com/feedback\\_matters.php](http://www.peopleperhour.com/feedback_matters.php)

Gold City UK Sales – inviting feedback and stating that “your feedback matters” –  
. <http://www.goldcitysales.co.uk/>

These are just three of a vast number of examples that could be cited – and indicate just how important to businesses feedback is.

55. Mr Bates pointed out that the way the Bing search engine works, searching for “FeedbackMatters” automatically captures results for the words in their non-conjoined form. Therefore the search and the conclusion therefrom were both flawed. The correct search should have been for “Feedback + Matters”, which results in 207 ‘hits’ using the Bing search engine (or 779 hits using Google), with the numbers relating to the UK going down to just 14 (or 203).
56. Dr Trott for the IPO conceded that the hearing officer had made an error in the reporting of the Bing search result and admitted that the force of the actual use of the phrase “feedback matters” is much less than indicated in the Decision. But he contended that internet searches nevertheless showed that the expression is widely used and understood in the UK in trade as a reference to the importance of feedback. Further the absence of actual evidence of such use this did not detract from the essential position that relevant consumers would not see the Mark as an indicator of origin.
57. I agree. Indeed the three examples highlighted by the hearing officer in paragraph 27 show that three very different service providers (insurance, a provider of an online marketplace for various business skills and a holiday company) all seek feedback from their customers by reference to the phrase “feedback matters”.
58. Although point 8 in the summary of the Applicant’s Statement of Grounds of Appeal set out in the Annex complains that “the examining officer sought to arbitrarily reserve those words comprising the proposed mark for use by other traders”, the only reference to this concept in the Decision itself is at paragraph 14, where the hearing officer mentions the purpose behind section 3(1)(c) of the Act. She did not rely on this as a reason for her decision under section 3(1)(b) and I do not rely on it as a reason for agreeing with her conclusion under that section. I therefore do not consider that point any further.

(5) Failure to follow guidelines concerning use of domain names as business identifiers

59. The Hearing Officer dealt with Mr Bates’ contentions in relation to domain names as follows:

30. Mr Bates pointed out that the words FEEDBACKMATTERS and variations thereof have been accepted as domain names. As I explained in my hearing report, the criteria for acceptance of domain names are different to that of trade marks. It appears that Mr Bates, because our Examination Guide states that we do accept domain names as trade marks, is under the misapprehension that all domain names are acceptable as registrable trade marks. However, the Guide clearly states “... the Registrar will, subject to the usual criteria of the Act, permit domain names to be registered as trade marks”. In order for a domain name to be acceptable it must pass the usual tests for distinctiveness and other matters that we apply to all trade mark applications.



60. I agree with both the essential points here, that: (1) acceptance of a name as a domain name is no indication of its acceptability for registration as a trade mark, since there is no test of distinctiveness for domain name registration; and (2) while some domain names may also be registered as trade marks, they must pass the usual tests in order to do so.
61. Mr Bates objected to the suggestion that he was under the misapprehension referred to above. He said he had never suggested that all domain names are acceptable as registered trade marks. He explained that his point was that the Applicant's services were delivered via its registered domain names and that this should have been taken into account in the light of both IPO and CJEU guidance that domain names or web addresses can be taken as indicators of origin.
62. That being the only remaining point in relation to domain names, it clearly does not undermine the Decision, since it was an argument to support acquired distinctiveness of the Mark, which the Applicant had not relied on and the hearing officer did not decide upon.

(6) Breach of principle of equal treatment of applicants and applications

63. Before the hearing officer, Mr Bates pointed out that several other marks comprising MATTERS plus another ordinary word had been accepted for registration, including for services in Class 35. One of the purposes of Mr Bates' subsequent FOI requests was to find out more about the process of examination of those marks. He took me to a couple of these during the hearing, though without going into detail as to their examination. These were SPEED MATTERS, registered under no. 2323394 in respect of *inter alia* "advertising services" including expressly, "advertising services provided on the Internet in relation to automobiles"; and WILDLIFE MATTERS, registered under no. 2524740 in respect of "advertising; business administration; advertising services provided via the Internet; production of television and radio advertisements".
64. It is well-settled that the principle of equal treatment does not apply to the examination of trade marks if and to the extent that an examining body has erred in applying the law to a previous case. The hearing officer correctly cited Case T-230/05 *Golf USA, Inc. v OHIM* at [57] to [61] in support of this. In particular:

60. ... if, by accepting, in a previous case, the registrability of a sign as a Community mark, the Board of Appeal erred in law and, in a later case, comparable to the previous one, the Board of Appeal adopted a contrary decision, the first decision cannot be successfully relied on to support an application for the annulment of the latter decision. It is clear from the case-law that observance of the principle of equal treatment must be reconciled with observance of the principle of legality, according to which no person may rely, in support of his claim, on unlawful acts committed in favour of another. In this second hypothesis, the plea alleging breach

of the principle of equal treatment is therefore also ineffective (*STREAMSERVE*, cited in paragraph 28 above, paragraph 67; *SAT.2*, cited in paragraph 59 above, paragraph 61; and *CARGO PARTNER*, cited in paragraph 58 above, paragraph 70)..

65. However, that does not mean that one should not pay any regard to previous decisions of the IPO in relation to what appear to be analogous marks. As Dr Trott said at the hearing, “we are not bound by previous acceptances, but we are guided by them”. There was some discussion as to whether the IPO might have tightened up its examination process or raised the bar to distinctiveness over time, which might explain a difference between previously accepted and newly rejected marks. Mr Bates said that he would fully understand if that had been the case, but that did not appear to be the case here since other [X] MATTERS marks had been accepted after the rejection of the Mark in this case.
66. In order to assist me in my own assessment of whether the IPO had raised the bar higher in this case compared to the bulk of other analogous cases, before and after, I asked Mr Bates to send me the list of the marks that he relied on as indicating that the decision in this case was inconsistent and thus should tend to persuade me that the Mark should be regarded as distinctive in accordance with the usual tests. He did so, from which I see that, in addition to the marks I have already mentioned, RISKMATTERS, PRESCRIBING MATTERS, YOGAMATTERS, PRINT MATTERS and others had all achieved registration for different services in Class 35 prior to rejection of the Mark. On the other hand, MARKET MATTERS has been refused by the IPO, though apparently accepted as a Community trade mark by OHIM. Since the Mark’s rejection, WILDLIFE MATTERS (see above) and KIT MATTERS (including for retail services in respect of the sale of sunglasses, handbags and other items) had been accepted, among others, while EVERYTHING MATTERS (for lobbying services and various media advisory services) had been withdrawn.
67. Although I agreed to review the list, the job of doing so reinforced to me the sense that there is in the general rule that each mark has to be assessed independently against the relevant legal criteria and to stand or fall on its own merits. While it is possible to reach a broad view that two marks are of a similar type and therefore should be treated similarly, that can only be so if the relevant goods and services and their respective average consumers are identical. And, of course, the marks themselves all mean different things and may or may not be the same or similar to phrases in regular use, or have particular connotations. Also, some may have been accepted as a result of evidence of acquired distinctiveness through use. So, what may appear to be dissimilar treatment may be wholly justified by these differences.
68. Having considered Mr Bates’ list, I have concluded that I might be able to point to a particular mark that has been accepted for particular services in Class 35 and say that

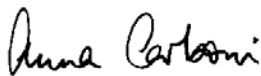
to my mind it is not distinctive for those services, but I am unable to say from reviewing the list that the IPO has materially raised the bar in this case as against others from before or after, or that the Decision was obviously wrong.

69. Taking all of the above matters into account, I agree with the Hearing Officer's assessment that the Mark (and each of the marks within the series) is devoid of any distinctive character within the meaning of section 3(1)(b) of the Act.

Conclusion

70. I dismiss the appeal and direct that the Mark should be refused pursuant to section 3(1)(b) of the Act. Unless asked to do so, I do not intend to issue a formal Order to this effect.

71. As is the usual practice on costs in ex parte appeals, I make no order as to costs.



ANNA CARBONI

20 April 2012

Mr Chris Bates (a director of the Applicant) appeared in person for the Applicant (Appellant).

Dr Bill Trott appeared for the Registrar.

**Annex**  
**Extract from the Applicant's Statement of Grounds of Appeal**

**1) Invalidity of objections raised in the Statement of Grounds**

1. Multiple errors exist in the process, and findings, of analysis of our proposed mark (as outlined in the statement of grounds for refusal). These relate primarily, but not exclusively, to repeated failures to follow internal and ECJ guidance in connection with:
  - a) The origin of goods and services, especially those delivered principally via the internet;
  - b) The characteristics of the relevant consumer.
2. Flawed assessment of the extent to which the proposed mark has been subject to prior use by other traders.

**2) Procedural and analytic errors throughout the IPO's wider assessment process**

3. That the Intellectual Property Office as a whole has failed to consider the context of the proposed mark, particularly with respect to the goods and services to be provided — thus breaching its own assessment protocols
4. That the IPO has consistently sought to identify use of the mark by other traders, repeatedly relying on such use to demonstrate a lack of distinctiveness — to date, in spite of requests for same, *not one single example of commercial use of our proposed mark has been identified by the IPO*. Furthermore, not one single use of the words “Feedback” and “Matters” in their conventional, non-conjoined, form has been identified by the IPO *in connection with any good or service*.
5. That the Intellectual Property Office has failed to consider internal and ECJ guidance relating to the use of internet domain names as business identifiers — again breaching assessment protocols.
6. That communications from the IPO have, in correspondence to the applicant, misquoted legislation and omitted information — representing procedural breaches with the effect of misleading the applicant as to process and statute.

**3) Procedural errors at time of initial examination**

7. That the examining officer identified a level of distinctiveness within the proposed mark but failed to put forth said mark for opposition — thus acting *ultra-vires* in applying a higher threshold than that laid out in the 1994 Act.
8. That the examining officer sought to arbitrarily reserve those words comprising the proposed mark for use by other traders (in spite of them not falling within [section]), and used this decision to prevent registration of the proposed mark — thus acting *ultra-vires*.

**4) Procedural errors at the time of Ex-Parte Hearing**

9. That, in the process of formal Hearings, the Hearing Officer stated that refusal was solely due to distinctiveness, yet following defence of same states grounds relating to the use of the mark by other traders as contributing to its refusal — thus denying the opportunity for defence to be made against this possible objection.

5) Inconsistent application of case law within the IPO

10. That the IPO has relied on ECJ rulings in seeking to defend its decision (whilst ignoring the guidance of the European Court), yet the Chief Executive of same asserts ONLY the 1994 Trade Mark Act is of relevance in reaching its decision.