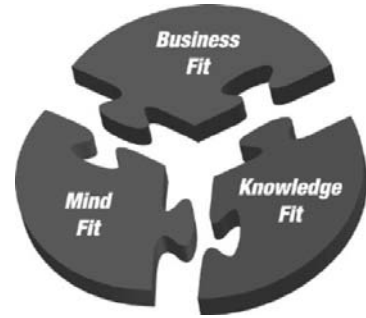


O/329/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2578057
BY GRAHAM JOHN WILLIAMS
TO REGISTER THE FOLLOWING TRADE MARKS IN CLASSES 35 AND 41:**



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Background

1. On 8 April 2011, Graham John Williams ('the applicant') applied to register the trade marks shown above for the following services:

Class 35: Business management; advisory services in the field of management.

Class 41: Counselling corporate executives in their personal development.

2. On 18 April 2011, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under section 3(1)(b) of the Trade Marks Act 1994 ('the Act') on the basis that the mark consists of the words 'business fit, mind fit, knowledge fit', each within a segment of a jigsaw piece, the whole being devoid of any distinctive character. The examiner stated that the sign would indicate that the company, through its services, will help bring together these three 'core sectors' for a business.

3. On 27 April 2011, Agile IP LLP acting as the applicant's representative ('the agent') requested a hearing. The hearing was held on 7 September 2011, with David Fry and Alan Fry of Agile LLP representing the applicant. At the hearing, the objection was maintained, and further time was granted for the agent to explore whether his client had any evidence which might be submitted in support of a claim to distinctiveness acquired through use.

4. On 16 November 2011, a formal notice of refusal was issued. In response, Mr Fry filed a form TM5 seeking a statement of reasons for the Registrar's decision.

5. I am now asked under section 76 of the Trade Marks Act 1994 and rule 69 of the Trade Marks Rules 2008 to state in writing the grounds of my decision and the materials used in arriving at it. No formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, I have only the *prima facie* case to consider.

The applicant's case for registration

6. Prior to setting out the law in relation to section 3(1)(b) of the Act, I must emphasise that the following decision will set out my reasons for maintaining the objection by reviewing and assessing the mark applied for. Prior to the refusal of the application, the only arguments put forward in support of *prima facie* acceptance were those made orally at the *ex parte* hearing on 7 September 2011. These arguments centred on the fact that the sign did not merely consist of words, but also contained a logo, the combination of which rendered the mark distinctive in its totality. It was submitted that the sign is being used as a trade mark, and that the allegedly distinctive 'jigsaw pieces' could not be ignored when assessing the mark.

The Law

7. Section 3(1) of the Act reads as follows:

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

(b) trade marks which are devoid of any distinctive character,

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

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

Decision - Section 3(1)(b)

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

"37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

39. Next, pursuant to rule 1 Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's 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 judgement makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and those distinguishing it from those of other undertakings."

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

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

"However, a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin."

11. This establishes the principle that the question of a mark being devoid of any distinctive character is answered by reference firstly, to the goods and services applied for, and secondly, to the perception of the average consumer for those goods or services.

12 The specifications cover 'business management; advisory services in the field of management' in Class 35, and 'counselling corporate executives in their personal development' in Class 41. When seeking to identify the relevant consumer, it is therefore reasonable to assume that the class 35 services claimed will be used primarily by those operating in the business field. With regard to the counselling services in class 41, these are specifically targeted at corporate executives seeking advice or direction in respect of personal development. The level of consumer attention may vary a little depending on both the customer and the type of business management services provided but, given their specialist nature, I consider it reasonable to assume that a prospective user of the applicant's services would apply a reasonably high level of attention to the services being purchased.

13. Having identified the average consumer of the services, and having noted that the corresponding levels of attention for anyone using the service would be reasonably high, I now turn to the mark itself.

14. As noted in the original examination report, both marks consist of two main elements; the first being the words 'Business Fit', 'Knowledge Fit' and 'Mind Fit'; the second being the figurative 'jigsaw pieces' presented in such a way as to give the impression that they fit together to form a circle. I also note that one of the two marks is presented in colour, but I do not consider this colouring to constitute a main element worthy of consideration or assessment in its own right, in relation to the distinctiveness issue.

15. Although it is paramount that any assessment of distinctiveness takes into account the mark's totality, it is also useful to first analyse the mark by reference to its constituent parts. In relation to the terms 'Business Fit', 'Knowledge Fit' and 'Mind Fit' I am not persuaded that they contain any inherent distinctiveness in relation to the services claimed. With regards to syntactical construction, I accept that it is more common to place the word 'fit' at the beginning of a phrase in order for it to act as a qualifier i.e. one is more likely to use the phrase 'fit mind' as opposed to 'mind fit'. However, I do not consider that the structure of these terms substantially alters the distinctive character of the signs in totality. In my view, the phrase 'mind fit' still conveys the impression of a mind which is healthy and functioning as effectively as it can. In the context of the whole mark and its intended use in respect of the services claimed, the phrase would be perceived as nothing more than a desirable quality which ultimately may be attainable through utilising the services of the undertaking. With regard to the term 'knowledge fit' I equally consider that this would be perceived as meaning 'equipped with the requisite knowledge', thereby making a person more competent. For the third and final phrase 'business fit', I consider that it would be understood as being an alternative means of conveying the notion of a 'fit business' i.e. a business which is fit to compete (and succeed) in the marketplace.

16. In my view, these words are likely to do no more than inform the consumer that the services being provided equip consumers to be business fit, knowledge fit and mind fit. Further, they would be perceived as referring to the necessary skills, attributes or knowledge required to perform effectively; to maximise business potential; and to ensure customers are mentally fit and therefore equipped with the requisite knowledge for the task in hand. Consumers may perceive these phrases as being an indication that the undertaking offering the services possesses such characteristics or, as I think is more likely to be the case, that through utilising the services of the undertaking, consumers will be able to acquire these attributes. Which of these two readings is perceived by the potential customer has little effect upon the signs' inherent capacity to denote trade origin. Either way, the word elements would be perceived as nothing other than a desirable attributes.

17. This leads onto an assessment of the figurative elements within the mark i.e. the three jigsaw pieces. The first mark in the series contains pieces presented in the colours red, green and blue; the second mark is in greyscale. When viewed in conjunction with the words, I consider that the graphical arrangement of the three jigsaw pieces merely creates an impression that the three individual pieces fit together to form a whole. In fact, this notion

of different aspects of the applicant's training and development services 'fitting together' may be further reinforced by the presence of the word 'fit' in the mark's textual elements.

18. In relation to the services covered by the application, it is not unusual to employ graphics, flowcharts and other diagrammatical/figurative representations in order to visually demonstrate how different activities or elements fit together and/or to show a particular business, training or personal methodology. Some examples of such models can be found at www.google.co.uk/search?q=business+model&hl=en&prmd=imvnsb&tbm=isch&tbo=u&source=univ&sa=X&ei=CrOXT9PgNleh8gOEsvH1BQ&ved=0CEIQsAQ&biw=1024&bih=587.

19. It therefore follows that there is an interaction between the mark's word and device elements in as much as the jigsaw pieces, and their placement, creates an impression that the three desirable qualities fit together as part of the methodology utilised: there is a play on a double meaning of the word "fit".

20. I accept, of course, that the average consumer's perception of this sign as being a methodology or business/training model will not, by itself, automatically determine whether the sign possesses distinctiveness as a trade mark. In other words, it would not be correct to deny the mark registration simply on the basis that it would be perceived as a graphic representation of a business methodology. However, as my examples show, there is a vast range of models and methodologies represented in the form of pie charts, flowcharts, graphs or whatever graphical device comes to hand aided by the various presentational software tools available today. More importantly, most graphics of this type serve primarily to confer information, thoughts or concepts to the consumer and, as such, they are not generally used to designate the origin of the particular service which may utilise them. In my view, however, the sign applied for falls within the spectrum of a 'normal' such methodology and for that reason, simply stated, it does have the required distinctiveness to serve a trade mark function.

21. The CJEU has provided guidance to the effect that where the dominant element of a mark is non-distinctive (as are the textual elements 'Business Fit', 'Knowledge Fit' and 'Mind Fit' in the current mark), and where additional figurative elements do not possess features which would allow the mark to fulfil its essential function, then the mark when considered as a whole is devoid of any distinctive character (see Case C-37/03 P, *BioID AG v Office for Harmonisation in the Internal Market*). I consider that the marks' figurative elements would be seen by the relevant public as no more than stylistic embellishments, which are *not* unusual in the marketplace, and which would have no more than a minimal impact in the provision of the services covered by the application. To support my decision I make reference to the decision of the ECJ, *BioID AG v. OHIM* (Case C- 37/03P) where the ECJ's analysis was as follows:

"69. The trade mark applied for contains the abbreviation BioID and figurative elements, namely the typographical characteristics of that abbreviation, and two graphic elements placed after the abbreviation BioID, namely a full stop (.) and a sign (®).

71. In addition, in the light of the recurrent nature of the typographical features of the abbreviation BioID and the absence of any particular distinctive element, the characters in 'Arial' typeface and characters of different boldness do not enable the trade mark applied for to guarantee, to the relevant public, the identity of the origin of the goods and services covered by the trade mark application.

72. Furthermore, the two graphic elements placed after the abbreviation BioID, namely a full stop (.) and a sign (®), do nothing to enable the relevant public to distinguish, without any possibility of confusion, the products or services covered by the trade mark application from others which have another origin. It follows that those graphic elements are not capable of fulfilling the essential function of a trade mark, as described in paragraph 25 of the present judgment, in relation to the relevant goods and services.

73. As pointed out by the Advocate General in point 105 of his Opinion, when the overall impression conveyed by the trade mark applied for to the relevant public is examined, the abbreviation BioID, which is devoid of any distinctive character, is the dominant element of that mark.

74. Moreover, as OHIM observed in paragraph 21 of the contested decision, the figurative and graphic elements are so minimal in nature that they do not endow the trade mark applied for as a whole with any distinctive character. Those elements do not possess any feature, in particular in terms of fancifulness or as regards the way in which they are combined, allowing that mark to fulfil its essential function in relation to the goods and services covered by the trade mark application”.

22. The device elements of the jigsaw pieces merely reinforce the fact that the desirable attributes of being 'business fit', 'knowledge fit' and 'mind fit', are compatible and interconnected in the context of the services being provided. The decision of the CJEU presented above provides support that the addition to descriptive words of common fonts, colours and stylistic elements will not necessarily be sufficient to imbue distinctiveness: this is a matter of judgment in each case, bearing in mind the goods or services concerned, the average consumers, and other factors such as frequency of use of the elements at issue in the marketplace. Considering all these factors in the round, I am not convinced that the 'surplus' in the sign provided by the non-verbal components is sufficient to individualise the sign as being from a single undertaking.

23. In my view, this mark provides the consumer with information about the services provided which, although presented in an artistic fashion, is typical of those providing inter alia management and corporate advisory services. The figurative and stylistic elements do not combine or interact to such an extent that the relevant consumer would, without first being educated to such effect, perceive the sign applied for as an indicator of trade origin.

24. I have assessed the mark as applied for, and must conclude that as a whole, it cannot lay claim to any linguistic imperfection, peculiarity, inventiveness or other creative element which might endow it with the necessary capability to function as an indicator of trade origin - at least, not in respect of those services which are likely to be provided utilising a simplistic business methodology. Applying the CJEU's guidance in 'BioID' as well as those cases

referenced elsewhere in the decision, I must maintain the objection under section 3(1)(b) of the Act.

Conclusion

25. In this decision, I have considered all documents filed by the applicant/agent, and all arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is refused under section 37(4) of the Act because it fails to qualify under section 3(1)(b) of the Act.

Dated this 29th day of August 2012

**Bridget Whatmough
For the Registrar
The Comptroller-General**