

O-406/12

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 2599449
BY NORTHWAY BROKER LTD
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 36:



**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NUMBER 2599449
BY NORTHWAY BROKER LTD
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 36:**



Background

1. On 28 October 2011, Northway Broker Ltd ('the applicant') applied to register trade mark application number 2599449 (for the mark shown above) in respect of the following services:

Class 36 Financial services; banking; financial services provided via the Internet; provision of financial information.

2. On 16 November 2011, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act') on the basis that the mark "*consists of a '£' symbol, in a coloured circle, followed by the words 'Pounds Till Payday', being a sign which, in its totality, may serve in trade to designate the kind of services e.g. the provision of pounds until payday. The stylised pound sign does not add any distinctiveness to the descriptive words*" (the aforementioned wording having been taken from the Examination Report).

3. On 16 January 2012, Lester Aldridge LLP (the agent), acting as the applicant's representative, submitted arguments in respect of *prima facie* acceptance of the mark. The examiner was not persuaded by the submissions and maintained the objection. On 20 March 2012, further arguments were submitted by the agent which again failed to persuade the examiner to waive the objection.

4. On 11 May 2012, a notice of refusal was sent to the agent. Following this, a form TM5 was received at IPO on 12 June 2012. 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.

The applicant's case for registration

5. Prior to setting out the law in relation to sections 3(1)(b) and (c) of the Act, I will first set out the applicant's case for *prima facie* acceptance of the mark. The agent, in his letter dated 16 January 2012 in response to the examination report, submitted that the stylised pound sign within the mark consists of "*original and unique and distinctive stylistic elements which contribute distinctive character to the totality of the stylised word/device mark*" and that "*...having regard to the totality of the distinctive stylistic elements specified above*", the mark could not be considered to be devoid of any distinctive character. The agent added that the

words 'POUNDS TILL PAYDAY' are "selected and juxtaposed in a manner which renders the mark resistant to natural descriptive uses" and that the words are "not ordinarily or commonly used by consumers or traders to describe the act of lending cash amounts for a term repayable on payments of salary". The agent conducted a Google search for the term 'Payday Loans', which, he alleges, is the most apt term for such loans in the loan industry, and included copies of Internet search results to support this claim. He also argued that "the configuration and positioning of the stylistic elements, and the stylistic elements themselves, do not appear to be commonplace within the industry". The agent also sent in details of previous marks accepted by IPO which, it was argued, are on a par with the application.

6. I agree that the mark does not consist *exclusively* of a sign or indication 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 services, or other characteristics of goods or services. The pound device in the circle cannot be ignored and therefore I do not consider the objection under Section 3(1)(c) to be valid. I have therefore waived this objection. In doing so, I have taken into account the comments of the Appointed Person, Mr R Arnold QC, in the *Sun Ripened Tobacco* decision (0-200-08):

"In Hormel Foods Corp. v Antilles Landscape Investments NV [2005] RPC 28, I held that a mark which would be objectionable under section 3(1)(c) if it was a pure word mark does not cease to be objectionable under section 3(1)(c) if it is presented in a fancy script. I expressed the view that the position would be different if, instead of being merely presented in a fancy script, the mark contained visual elements additional to the word, such as a device, and that in those circumstances the relevant objection to consider would be that under section 3(1)(b)."

7. Regarding the previous registrations which the agent considers to be on a par with the mark of this application, I must point out that the individual circumstances surrounding each application are paramount and precedents cannot be decisive. The Registrar's disinclination to be persuaded by previous registrations has already been confirmed in the MADAME case (1966) RPC page 545, as re-stated by Mr Justice Jacob in the TREAT trade mark case (1996) RPC page 25:

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

8. Having waived the objection under section 3(1)(c) I will now go on to consider the 3(1)(b) objection. 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 case for registration under section 3(1)(b) of the Act

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

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

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

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

11. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provision referred to above) the Court has held that "...the public interest... is, manifestly, indissociable from the essential function of a trade mark", SAT.1 *SatellitenFernsehen GmbH v OHIM*, C-329/02P. The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above-mentioned judgement). Marks which are devoid of distinctive character are incapable of fulfilling that essential function. Section 3(1)(c) on the other hand pursues an aim which reflects the public interest in ensuring that descriptive signs or indications may be freely used by all (*Wm Wrigley Jr v OHIM, Doublemint*, C-191/OP, paragraph 31).

12. Section 3(1)(b) must include within its scope those marks which, whilst not designating a characteristic of the relevant goods and services (i.e. not being necessarily descriptive), will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin. In terms of assessing distinctiveness under section 3(1)(b), the ECJ provided guidance in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (Postkantoor)* C-363/99) where, at paragraph 34, it stated:

"A trade mark's distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to 55/01 Linde and Others [2003] ECR I- 3161, paragraph 41, and C-104/01 Libertel [2003] ECR I-3793, paragraphs 46 and 75)."

13. 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. In relation to identifying the relevant consumer, it is reasonable to assume that the services claimed in this application will be used by the general public. Although the specification includes financial services and banking services *at large* (thereby incorporating certain services likely to be directed towards the business sector as well as the general public), the nature of the mark leads me to believe that the average consumer is likely to be fairly general i.e. a wage earner perhaps seeking some financial assistance in-between pay days. Therefore, the

services claimed by the applicant can reasonably be described as being directed towards a non-specialist general public, which would demonstrate an average level of attention when considering their purchase.

14. One must also be aware that the test is one of immediacy or first impression, as confirmed by the European Court of First Instance (now the General Court) which, in its decision on *Sykes Enterprises v OHIM*, T-130/01 (Real People Real Solutions), stated the following:

"...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."

15. When assessing a mark's distinctiveness it is necessary to consider the perception of that mark by the average consumer, who we have identified at paragraph 13 as being the public at large. I intend to approach the word elements presented within this mark from a semantic perspective in order to assess whether the phrase 'pounds till payday' is capable of performing the essential function of a trade mark, and which would therefore be free from objection under section 3(1)(b). Examining the mark from that perspective, I must reach the view that it conveys a clear message which would be understood by the relevant consumer of the services identified at paragraph 13 above. The Oxford Dictionary of English defines the word 'pound' as *'the basic monetary unit of the UK, equal to 100 pence'*; the word 'till' as being *'a less formal way of saying until'*; and the word 'payday' as being *'a day on which someone is paid their wages'*. It is therefore reasonable to assume that the average consumer, on seeing the phrase 'pounds till payday' will see it as indicating that the applicant provides monetary advances (i.e. in the form of 'pounds') until payday comes around.

16. The agent argued that the normal terminology for short-term loans provided in between paydays is 'payday loans', and a search of the Internet has indeed revealed this term to be in use. However I have carried out an Internet search which reveals that others are using the expression 'pounds till payday' in order to describe the same type of service. Annex A provides details of that research, which is briefly summarised below:

1. Print taken from the website at **www.moneytillpayday.org.uk** which states that *'Money till Payday is financial services [sic] that arrange you [sic] pounds till payday...'*
2. Print taken from website at **www.quickneaspayday.co.uk** which refers to *'my pounds till payday'*.
3. Print taken from the 'Article Bases' website at **www.articlesbase.com/loans-articles/laws-and-regulations-for-payday-loans-in-uk-5340123.html** which informs the reader that *'in life, some sudden expenses come up on the way and you realise that you need pounds till payday'*.
4. Print taken from website at **www.4cashnow.co.uk/pounds-till-payday.php** which asks the reader if he or she needs *'pounds till payday'*.

5. Print taken from website at www.cheap paydayloans.co.uk/pounds-till-payday.html which states that 'pounds till payday are useful for availing of cash.'

17. I believe that the message conveyed by the mark is so clear that the relevant consumer would not perceive it as something which would differentiate the services of one loan provider from another. I take this view, not only from the ordinary dictionary definitions of the words within the mark, but also from the fact that, as illustrated above, other loan providers are using the term 'pounds till payday' to describe such services.

18. This leaves an assessment of the figurative device element. The non-verbal element within the mark is that of a pound sign within a two-coloured circle. The device of a pound sign *per se* is very commonly used in connection with loan provision services and, although it appears within a circular device, there is little particular stylisation to the sign in totality, and it would be unlikely to denote trade origin in the *prima facie* case. To ensure that I am correct in making the assumption that this level of stylisation is unlikely to denote trade origin, I have carried out a search of other loan providers advertising on the Internet, and have found numerous instances where other similar devices are being used. At Annex B I have included copies of some of those sites - this list is not exhaustive, there are many loan services who utilize the pound sign. Therefore, the question is whether the words and the device element combine to create a mark that would be immediately perceived by the average consumers as a sign or badge of origin. The meaning of the words is clear i.e. the applicant provides money until payday. The question then to ask is – does the pound device give distinctive character to the mark *or* does it merely reinforce or supplement the meaning of the words? I believe it performs the latter function, rather than the former.

19. In reaching this conclusion, I take into account the comments of Mr R. Arnold QC (The Appointed Person) in the *Sun Ripened Tobacco* Decision [0-200-08]:

"14. I am mindful of the comment of Mr Hobbs QC sitting 7 as the Appointed Person in Quick Wash Action [BL 0/205/04]: 'I do not think that the hearing officer was guilty of excision or dismemberment in his assessment of the present mark. Devices can be distinctive or non distinctive, just like any other kind of sign. What matters are the perceptions and recollections that the sign in question is likely to trigger in the mind of the average consumer of the goods concerned and whether they would be origin specific or origin neutral. I think that the verbal elements of the mark I am considering speak loud and clear. It seems to me that the message they convey is origin neutral. The artistic presentation neatly and skilfully builds upon and reinforces the origin neutral message in a way that makes it even more effective than the words alone might have been for that purpose. I think that net result is a well-executed, artistically pleasing, origin neutral device.

15. Applying similar reasoning to the mark at issue here, it strikes me that the words SUN RIPENED TOBACCO also speak loud and clear and that they do so in a descriptive and therefore origin neutral manner. The presentation incumbent in the sun device (and the overall presentation of the words), despite having an element of artistic nature, merely build upon and re-enforces the message behind the mark. This all leads, in my judgment, to a mark that fails to strike the consumer as a badge of origin."

20. I believe the same to be true of this mark. As with the aforementioned comments made by the Appointed Person in respect of the phrase 'quick wash action', I consider the words 'pounds till payday' to speak equally as clear and equally as loud when used in respect of loan services. It appears clear to me that the pound sign, which appears in a prominent position at the beginning of the mark, is not something that has been chosen arbitrarily - a factor which is relevant to the assessment of the mark's distinctive character. It merely builds upon and reinforces the message of the words which follow it i.e. that the services in question provide loans until payday, payable in pounds sterling. I consider it highly unlikely that the average consumer of these services would, taking into account the descriptive nature of the words, isolate the circular pound sign device and attach commercial origin or trade mark significance to the whole mark because of it.

21. I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from *prima facie* acceptance under section 3(1)(b) of the Act. This refusal applies to the full range of class 36 services listed at paragraph (1) above.

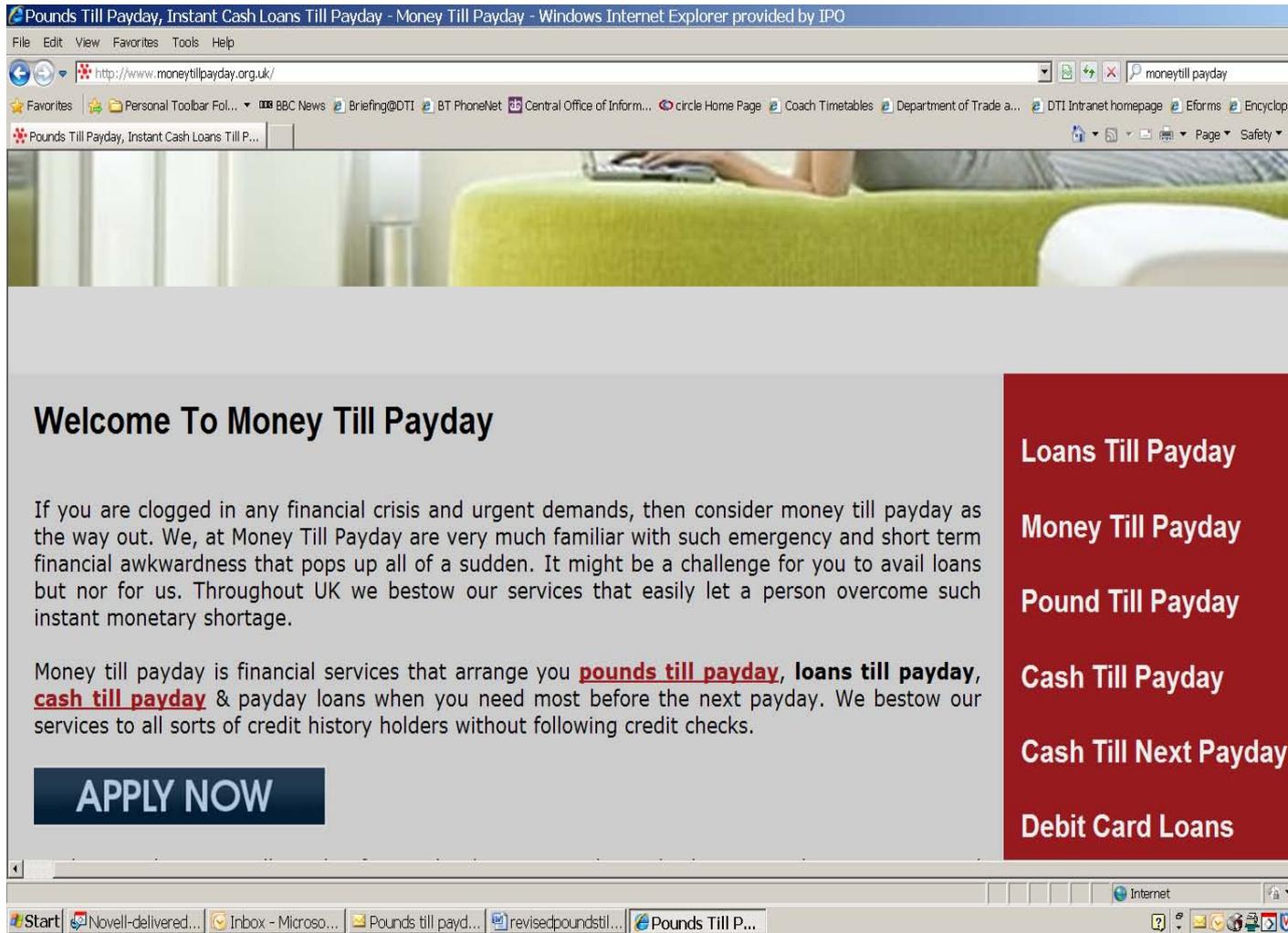
22. In reaching this decision, I have considered all the documents filed by the applicant, and all the arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is refused under the terms of section 37(4) of the Act because it fails to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

Dated this 17th day of October 2012

**Linda Smith
For the Registrar
The Comptroller-General**

ANNEX A - THIRD PARTY WEBSITES USING THE PHRASE 'POUNDS TILL PAYDAY'

1. Screen print taken from **www.moneytillpayday.org.uk**



2. Screen print taken from www.quickneaspayday.co.uk/My_Pounds_Till_Payday

Quickneaspayday.co.uk

Up To £ 1,000
GET FAST
ONLINE APPROVAL

My Pounds Till Payday
How Much do you **NEED!**

Instant Approval

Quickcashbox.Co.Uk
Accepted In Seconds. Get Money Up To £1000. No Credit Scores assessment.
Www.31Paydays.co.uk
Need £100-£1000 immediate & Easily Loans? Immediately

£100 loan £500 loan

http://www.quickneaspayday.co.uk/apply.php?c=quickneaspayday&g=ft38k=My Pounds Till Payday

Start Novell-delivered... Inbox - Microso... Pounds till payd... revisedpoundstil... My Pounds Til...

3. Screen print taken from www.articlesbase.com/loans-articles/laws-and-regulations-for-payday-loans-in-uk-5340123.html

The screenshot shows a Windows Internet Explorer browser window. The address bar displays the URL: <http://www.articlesbase.com/loans-articles/laws-and-regulations-for-payday-loans-in-uk-5340123.html>. The search bar contains the text "pounds till payday" and shows 9 matches. The main content area features a list of related articles on the left and a sidebar on the right. The sidebar includes a profile for "greghanss" with 34 articles online and a section titled "MORE FROM GREGHANSS" listing several articles.

RELATED ARTICLES

- How Your Future Could Be Bright with Payday Loans - Get Your **Pounds Till Payday** NOW!
- Pounds till payday** - A List of Payday Loans and Their Beneficial Aspects
- Pounds till payday** - Get Payday Loans despite Bad Credit
- Pounds Till Payday** At A Click Away - The Best Financial Solution

MORE FROM GREGHANSS

- Anti Aging: The Most Effective Product Of 2012**
in Skin Care
- Becoming Younger Is Not An Utopia: Now Is Possible!**
in Skin Care
- Everything Explained About What Is A Wage Day Advance**
in Loans
- How To Access The Cash Till Payday You Require**
in Loans

4. Screen print taken from www.4cashnow.co.uk/pounds-till-payday.php

The screenshot shows a Windows Internet Explorer browser window displaying the website <http://www.4cashnow.co.uk/pounds-till-payday.php>. The page features a large banner with a smiling blonde woman on the left and the text "Do you need Pounds till Payday?" in purple. Below this, it states "Over 90% of applicants are offered a loan" in orange. A prominent blue button on the right says "CLICK HERE TO APPLY NOW >>" with the subtext "All you need is a Debit Card".

Below the main banner, there is a section titled "Pounds Till Payday" with the text: "Would you like pounds till payday with no credit checks? Our pounds till payday are repayable on your next payday, the minimum repayment is required of £100. You". To the right of this text is a smaller image of a smiling woman with the text "SAME DAY LOANS NOW AVAILABLE" in orange.

The browser's taskbar at the bottom shows several open applications: Start, Novell-delivered..., Inbox - Microso..., Pounds till payd..., revisedpoundstil..., and Pounds till Pa... The system tray on the right indicates the browser is on the Internet.

5. Screen print taken from www.cheap paydayloans.co.uk/pounds-till-payday.html

The screenshot shows a Windows Internet Explorer browser window displaying the website <http://www.cheap paydayloans.co.uk/pounds-till-payday.html>. The browser's address bar and search box both contain the text "pounds till payday".

The website header features the logo for "CHEAP PAYDAY LOANS" with the URL www.cheap paydayloans.co.uk and a search bar labeled "Search this site...". Navigation tabs for "Home", "Contact Us", and "Sitemap" are visible.

The main content area has a background image of a family walking on a beach. The text on the page reads: "LOOKING FOR Cash at Cheap Rates? Yes!" followed by "Select Any Amount According to Your Needs!" and "Cheap Payday Loans Offers Easy & Flexible Options....". A sidebar on the right is titled "Pounds till Payday" and contains the text: "Pounds till payday are useful for availing of cash in the same day without any hassles and impediments. Our services at Cheap Payday Loans are meant to let you know about the low rate best deals of pounds till payday so that you can borrow an amount of loan without any burden on your earnings. [Readmore](#)".

The Windows taskbar at the bottom shows the Start button and several open applications, including "Novell-delivered...", "Inbox - Micro...", "Pounds till payd...", "revisedpoundstil...", and "Pound till Pay...".

ANNEX B - THIRD PARTY WEBSITE USING 'POUND' DEVICES SIMILAR TO THOSE DISPLAYED IN THE MARK

1. Screen print taken from <http://bcloanbrokerts.co.uk/apply.html>

Cash Loan Application - Windows Internet Explorer provided by IPO

File Edit View Favorites Tools Help

http://bcloanbrokers.co.uk/apply.html

bc loan brokers

Cash Loan Application

Applying for a loan

Your Application Request

Before we can process your application you must confirm the following:

- I am over the age of 21
- I am a homeowner, tenant or live with my parents.
- I have a working phone (landline or mobile)
- I am not bankrupt
- I do not have an IVA (individual voluntary agreement)

If you answered yes to all these questions please use the button below to make a loan request or simply call 07837 604701 and speak to an advisor.

Apply Now 

[Back to Top](#)

Loans



Loans

BC Loan Brokers

Done

Start Novell-delivered... Inbox - Micro... latestpoundstill ... Cash Loan Ap...

Internet

2. Screen print taken from www.moneysolutionsuk.com/payday.html

Payday Loans | Wageday loans, Payday advance, loan until payday - Windows Internet Explorer provided by IPO

File Edit View Favorites Tools Help

http://www.moneysolutionsuk.com/payday.html

Payday Loans | Wageday loans, Payday adva...

How do I get a payday loan?

Borrowing from one of our **Payday loan** partners is quick and easy! We give instant online decisions, without the need for faxes or post. You are just a few minutes away from getting your payday loan!!

How much can I borrow?

You can borrow from £100-1000 with a **wageday loan** depending on your circumstances.

To qualify for a **loan until payday**, you need to:

- Be over 18 years old.
- Be employed or self employed full time.
- Take home more than £500 per month.
- Have a bank account with a valid debit card.

• Be paid monthly.

What do I do next to get my payday loan?

All you need to do is complete the application form below and we will search our panel of **payday loan** lenders and brokers to see who has the best deal for you. In most cases you will find out straight away if you have been approved. Your loan agreement will be displayed online for you to complete and sign and the funds will be transferred to your

- ✓ 1 Application, Multiple Lenders
- ✓ Quick Approval
- ✓ Cash in your Account same day
- Use your payday loan for any purpose!
- ✓ Short Term Cashflow
- ✓ Unexpected Expenses
- ✓ Car Repair

Talk To Us.....

SHARE

Payday Loans

Borrow between £80 and

Error on page.

Start Novell-delivered... Inbox - Microso... latestpoundstill ... Payday Loans...