

O/635/18

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF APPLICATION NUMBER 3260946**  
**BY CAF NOMINEES LTD**  
**TO REGISTER THE FOLLOWING TRADE MARK**  
**IN CLASSES 9, 16, 35, 36 AND 41:**  
**MAKE GIVING COUNT**

## Background

1. On 3 October 2017, CAF Nominees Ltd ('the applicant') applied to register trade mark application number 3260946, consisting of the phrase 'MAKE GIVING COUNT' for the following goods and services in classes 9, 16, 35, 36 and 41:

*9 Video and audio tapes and discs, educational software, electronic publications being downloadable from the Internet and CD Rom.*

*16 Printed matter.*

*35 Business research; provision of business information in the form of reports, statistics and accounts.*

*36 Charitable fundraising; financial advice and consultancy services; financial arrangements to facilitate charitable giving; investment trust services, preparation of financial reports and analyses; deposit taking services; debit card services; online financial services; grant making services; recovery of tax and payment of funds to the charity; financial research.*

*41 Arranging and conducting conferences, seminars and workshops; organising and arranging charity and financial awards; publication of books and texts.*

2. On 13 October 2017, the Intellectual Property office ('IPO') issued its examination report which raised an objection under section 3(1)(b) on the following basis:

### *Section 3(1)(b)*

*The application is not acceptable as there is an objection under Section 3(1)(b) of the Act as the mark consists exclusively of MAKE GIVING COUNT, being a sign which would not be seen as a trade mark as it is devoid of any distinctive character. It is an inspirational promotional statement which advises the consumer about the importance of giving to charity.*

*The purpose of a trade mark is to denote the goods/services of one undertaking from another and in this case the mark fails to distinguish the goods/services of one undertaking from another. Therefore the average consumer would not attach any trade mark significance to the sign.*

3. In written response, the applicant contended:

- The examiner had not explained why the mark was devoid of distinctive character.

- That the test is 'devoid of all distinctive character', and it cannot be said this mark is devoid of all distinctive character.
- The threshold for acceptance is relatively low.
- Applying case law, such as '*Vorsprung Durch Technik*'<sup>1</sup> and '*Wir Machen das besondere einfach*'<sup>2</sup>, it cannot be said that just because a slogan happens to be 'promotional' or 'inspirational' it would inevitably result in it being devoid of distinctive character.
- The case law suggests that, whilst it may not be mandatory, the possession of any or all of these linguistic characteristics:
  - o a number of meanings,
  - o a play on words,
  - o conceptual intrigue or surprise,
  - o originality or resonance,
  - o triggering a cognitive process, or
  - o having unusual syntactic structures

may result in a mark being registrable. In this case, the mark is possessed of almost all the above characteristics.

- That a slogan can confer an objective message and still not be devoid of distinctive character.
- That the consumer will ponder exactly how his or her giving may count, by what method they can give to charity, why is it important, when it is important or how much is required to 'make giving count'. It further provides no information on whether consumers would make existing contributions from others or that their own contributions count.
- That consumers would wonder how exactly, when they have already made contributions, they can make them count. Is the counting towards an end goal or must they make further contributions?
- That in relation to certain goods, it is impossible to see how the mark would be devoid since, in and of themselves, the goods do not relate to charitable giving such as, investment trust services, CD Roms etc.
- That similar marks such as, e.g. MAKE IT COUNT, WE ARE GIVING A HAND, MAKING DOING GOOD, DOABLE, MAKING LIFE A LITTLE EASIER, have all been registered, all of which are similarly allusive and therefore capable of registration.

4. These arguments were rejected by the examiner who wrote as follows:

*"As stated in the Sykes Enterprises v OHIM (Real People Real Solutions, 2002), ECT II-5179case "a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Section 3(1)(b) if it may be perceived*

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<sup>1</sup> Audi AG v OHIM (Case C-398/08P) '*VORSPRUNG DURCH TECHNIC*'

<sup>2</sup> Smart Technologies ULC v OHIM (Case C 311/11P) '*WIR MACHEN DAS BESONDERE EINFACH*'

*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”.*

*The average consumer without further interpretation would, as stated in the examination report, would see the mark first and foremost as a non-distinctive inspirational promotional statement which advises the consumer about the importance of giving to charity and my view has not changed on this.*

*My assessment has been made firstly by reference to the goods and services listed in the specification, and secondly by reference to the perception of the mark in relation to such goods and services by the relevant public, which consists of average consumers of the goods and services in question, who are deemed to be reasonably well informed, observant and circumspect: Joined Cases C-53/01 to C- 55/01 Linde AG, Winward Industries Inc and Radio Uhren AG [2003] ETMR 78 at [41].*

*I note your comments regarding the fact the Registry has failed to provide a substantive explanation or evidence as to why the mark would not be seen as an indication of commercial origin.*

*In the ‘Eurolamb’ trade mark case (1997) RPC 279 Geoffrey Hobbs Q.C., acting as The Appointed Person, heard arguments about whether there is an onus on the registrar to justify objections to applications. He decided that:*

- a) section 37 is neutral and there is no presumption in favour of or against registration;*
- b) the combined effect of sections 37(4) and (5) is to eliminate the discretion that the Registrar previously had and to put him in a position of having to make a judgment, yes or no, upon the materials before him as to the registrability of a mark;*
- c) there is nothing in the nature of a burden for the Registrar to discharge in order to justify his decision to refuse an application.*

*Whilst I agree that slogans or statements are capable of performing the essential function of a trademark and the test should not be more stringent for these kinds of signs, it is still necessary to consider whether such marks satisfy the normal criteria and meet the requirement of distinctiveness.*

*Further as referred to in the Vorsprung Durch Technik (ECJC-398/08) case a mark should be a play on words or contain imaginative, surprise or unexpected*

*characteristics present to give any distinctiveness. It is my view that this mark does not contain any of these elements.*

*I note your comments about the earlier registered mark but the Registry is not bound by the decisions made on this or any other case. Whilst the Registry strives for consistency each application has to be examined individually on its own merits.”*

5. The applicant then asked to be heard and this came before me on 10 April 2018 at which the applicant was represented by Ms Gemma Kirkland of D Young and Co. I should mention that the case was heard at the same time as co-pending application 3260947, ‘MAKING GIVING COUNT’ as, and I do not believe it is a point of contention, both the key facts and legal principles are the same in both cases.

6. I should mention that, prior to the hearing a letter was sent by the examiner to the applicant as follows:

*“As regards the forthcoming hearing in respect of this mark, I am assuming that the applicant in this case is the Charities Aid Foundation (CAF).*

*If that is the case, and without prejudice to any conclusions the hearing officer may arrive at or any submissions you may make, I have noted the way that use is being made of the words ‘make or making giving count’ in relation to a CAF Company Account. At first sight this does not appear to be trade mark use and I understand that the hearing officer would like to discuss this, along with all other related matters at the hearing.*

*An extract from the CAF website, as at <https://www.cafonline.org/giving-as-a-company/corporate-responsibility/caf-company-account>, is shown below:*

**CAF COMPANY ACCOUNT**

A CAF Company Account **makes your giving count** and makes it easy to count your giving.

[Any questions? Contact us](#)

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**MAKE YOUR COMPANY GIVING COUNT**

*Your corporate giving will always make a difference to the causes you support.*

By giving through a CAF Company Account, **you can make your giving count to** both charities and your company in a simple, safe and strategic way.

A CAF Company Account allows you to be more efficient with the administration of your community investment budget; you are able to link it to our **CAF Matched Giving** and **CAF Give As You Earn** schemes.

*Apply today*

Manage your community investment budget more efficiently with a CAF Company Account.

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7. At the hearing I reserved my final decision, allowing for further deliberation in regard, specifically, to the services of Class 36. On 11 April 2017, having set out the background as above, I wrote as follows:

***“Preliminary appraisal***

***Legal Principles***

*The broad legal principles in relation to section 3(1)(b) are well-established; that is to say the question of a mark being devoid of distinctive character must be answered by reference to the perceptions of the relevant consumer for the goods and services.*

*Certain clarifications are, however, needed at the outset as I think the examiner may have misconstrued ‘Vorsprung Durch Technic’ and over-emphasised, perhaps, the ‘Eurolamb’ case.*

*‘Vorsprung Durch Technic’ states:*

*38 While the Court has not excluded the possibility that that case-law may, in certain circumstances, be relevant to word marks consisting of advertising slogans, it has however stated that difficulties in establishing distinctiveness which may be associated with word marks consisting of advertising slogans because of their very nature – difficulties which it is legitimate to take into account – do not justify laying down specific criteria supplementing or derogating from the criterion of distinctiveness as*

*interpreted in the case-law referred to in paragraphs 33 to 34 of the present judgment (see OHIM v Erpo Möbelwerk, paragraphs 35 and 36).*

39 *The Court has therefore held, in particular, that an advertising slogan cannot be required to display ‘imaginativeness’ or even ‘conceptual tension which would create surprise and so make a striking impression’ in order to have the minimal level of distinctiveness required under Article 7(1)(b) of Regulation No 40/94 (OHIM v Erpo Möbelwerk, paragraphs 31 and 32; see also Case C-392/02 P SAT.1 v OHIM [2004] ECR I-8317, paragraph 41).*

40 *In the present case, the reasoning followed by the General Court derives from an erroneous interpretation of the principles set out in paragraphs 36 to 39 of the present judgment.*

41 *It must be held that, even though the General Court stated in paragraph 36 of the judgment under appeal that it is clear from the case-law that registration of a mark cannot be excluded because of that mark’s laudatory or advertising use, it went on to explain that the reason for its finding that the mark applied for lacks distinctive character was, in essence, the fact that that mark is perceived as a promotional formula: that is to say, its finding was made precisely on the basis of the mark’s laudatory or advertising use.*

42-46....

47 *As regards the General Court’s finding in paragraph 41 of the judgment under appeal that the mark Vorsprung durch Technik can have a number of meanings, or constitute a play on words or be perceived as imaginative, surprising and unexpected and, in that way, be easily remembered, it should be noted that, although the existence of such characteristics is not a necessary condition for establishing that an advertising slogan has distinctive character, as is apparent from paragraph 39 of the present judgment, the fact remains that, as a rule, the presence of those characteristics is likely to endow that mark with distinctive character.*

48 *As for the conclusion of the General Court in paragraph 46 of the judgment under appeal that ‘the mark Vorsprung durch Technik does not therefore contain elements which, beyond the obvious promotional message of the mark, could enable the relevant public to commit the expression to memory easily and immediately as a distinctive mark for the goods and services covered’, suffice it to state that not only is that finding wholly unsupported by the reasoning which precedes it but,*

*moreover, it is contradicted to a certain extent by the finding made in paragraph 41 of that judgment, as set out in paragraph 47 of the present judgment.*

*The above quote makes clear that merely because a mark can be said to be promotional, this, of itself, would not rule it out from registration.*

*Secondly, and the examiner may have misdirected herself here, it is not essential that a mark display characteristics such as ‘imaginativeness’, ‘conceptual tension’, ‘word play’ or ‘surprise’. The presence of any, or all these features may be likely to endow the mark with distinctive character but they are plainly not essential.*

*It should also be stated that ‘Vorsprung’ followed ‘Real People, real solutions’ and consequently is to be preferred in terms of it being an authority in relation to promotional or inspirational marks.*

*On the question of ‘onus’, the examiner says that ‘Eurolamb’ gives her the authority, in effect, not to justify refusal. I think this is, perhaps, reading too much into the case. An applicant is entitled to a statement of grounds and reasons for refusal and from which they can appeal such a refusal. To that end, the examiner or I must explain, based on case law and practice, the reasons why, in their opinion, a mark is considered to be devoid of distinctive character. Once the legal principles are properly established, the examiner or I should characterise the mark as a whole and explain why, in our opinion, the relevant consumer would regard the mark as ‘origin neutral’ rather than ‘origin specific’. A simple declaration will not suffice.*

### **Application of the principles**

*At the outset I waived objection in relation to the goods and services of Classes 9, 16, 35 and 41. That is to say that I was unable to see that the words would necessarily be ‘devoid of distinctive character’ for those goods and services as no obvious link existed as between the words and these goods and services.*

*The services of Class 36 are a different matter, and it is fair to say that both Ms Kirkland and I felt that these potentially represented the high point of any possible objection under section 3(1)(b).*

*Amongst the submissions is the point that similar marks have been registered by either the EUIPO or ourselves. In particular, Ms Kirkland relied upon the case of ‘MAKE IT COUNT’, registered for charitable services in Class 36 in 2006.*



*Such registrations, even if they can be said to be reasonable comparators are not, in law, capable of binding (or even be persuasive in relation to) any further decisions such as this. This is a well-established principle of which Ms Kirkland and I are both aware. The question of comparators can also cut both ways.*

*As I mentioned at the hearing, my own research into such marks suggests that the EUIPO are, in general, sceptical of marks that contain the elements 'make' or 'making' 'x' 'count'. By way of reference, the applications for 'Making memories count' (Application 012296448), 'Make every cow count' and 'Make every plant count' (Application 013273537) have all been refused.*

*In the case of 'Make every cow count', the EUIPO Board of Appeal said (In case R 841/2014-4) the following:*

*9 The structure and meaning of the applied-for expression should indeed be taken at face value. The Board cannot but find that the expression 'MAKE EVERY COW COUNT', in particular when applied in the field of cattle (cow) breeding, is entirely straightforward, easy to understand and in conformity with the rules of English grammar.*

*10 Taken at face value the expression tells the farmer who has a number of cows that each and every of those cows 'counts', is valuable, and should be taken care of. In the specific context of insemination it implies that each of the cows available should be made best use of for the purposes of breeding more cows. In the specific context of preventive measures, e.g. veterinarian measures, it implies that each cow should receive the best health control measures. In the specific context of monitoring data on cows it implies that in so gathering the data no cow should be missed out. Each time the meaning is the same, namely that for the economic benefit of the farmer each cow 'counts' and has a value.*

*11 This meaning is indeed laudatory and promotional. In the context of the marketing and application of the claimed goods, the expression indicates that those goods secure an optimal treatment of each and 'every cow'. This means that the claimed goods are of a high quality and secure optimal results for the farmer.*

*12 Next, the Board is unable to see any play on words or otherwise fanciful or creative element in this expression. The examiner was correct to refer to like phrases used in common parlance, each time in the sense that one should make the most out of given opportunities or situations. This does not mean that use of the same or similar slogans must be demonstrated for the finding of non-distinctiveness. It merely means that the structure of the expression is absolutely normal and in no way*

*fanciful. Moreover, the fact that the last two words start with the sound 'COW' is merely incidental and does not convert the expression, taken as a whole, into a literary creation. (cf.: 9.7.2008, T-58/07, 'Substance for success', EU:T:2008:269, § 27)*

*13 It is therefore irrelevant what degree of such fancifulness might have been necessary to convince the Court in the 'Vorsprung durch Technik' case (21.1.2010, C-398/08 P, EU:C:2010:29) to conclude for distinctiveness. The relevance or degree of such factors is immaterial the moment when those factors are not present in the case at hand.*

*14 It is equally irrelevant whether the expression is phrased in the form of an imperative. When the relevant public, predominantly a farmer who owns a cow herd, will perceive the expression on or in relation to the claimed goods, he might indeed perceive it as an incitation to take care of his cattle herd and to buy the product. That only reinforces the promotional character of the expression.*

*Ms Kirkland said that the EUIPO approach and decision quoted was, of course, not binding, based as it was on an autonomous EU wide regime. It is difficult, however, to disagree with the Board of Appeal that the phrase 'make 'x' count' is a phrase in common parlance and that the 'structure of the expression' is one that would be considered by the relevant consumer, to be normal and not fanciful. That is, notwithstanding the detailed written submissions made by the applicant in terms of the phrase being in some way, impenetrable.*

*In this case the 'x' of the expression is the word, 'giving'. My starting point would inevitably be that, in connection with charitable services, the word 'giving' must, by definition be problematic, in and of itself.*

*At the hearing we also discussed the matter raised by the examiner prior to the hearing, namely the applicant's own use which, to say the least, would be unlikely to be considered to be trade mark use. Ms Kirkland said that this was earlier use by the applicant and it has since tailored its approach towards seeking to indicate that it regards the words as a trade mark.*

*Having checked the applicant's website just minutes before the hearing, I was not even sure that its current use, shown below, sent an unambiguous message of trade mark use:*

### **Conclusion at the hearing**

*That said, I was not prepared to foreclose all further deliberation in relation to Class 36. It is fair to say I am, and remain very sceptical as regards the broad terms in that Class, such as e.g. 'charitable fundraising'. But I nonetheless agreed to allow further discussion by way of correspondence in relation to this Class. In particular, and on reflection, the applicant may consider exactly who the relevant consumer is, in relation to its services.*

*The applicant is, accordingly given two months from the date of this letter for its further submissions in relation to Class 36."*

8. By letter dated 11 June 2018, the applicant further submitted and contended, about the services of Class 36:

- The relevant consumer comprises both business to consumer and business to business.
- The applicant works with the consumer to help them donate money to charity, maximise their giving, e.g. make their contribution go further and to make giving more effective. It helps consumers manage their money to address adequate levels of giving and helps track that giving.
- From a corporation perspective, the applicant works with about 3,000 corporations in the UK helping with their social responsibility programmes, the purpose of which is to make the businesses' own giving more effective, to determine how it's spent and which charities the businesses support. Again the

applicant works with these businesses to track their giving and obtain tax efficiencies.

- In this sense the applicant says its marks possess a 'play on words' as 'COUNT is also used in a monetary sense as well as a social sense'.
- The applicant does not, of itself, directly engage in fundraising and instead, and in brief, acts as a facilitator between charities and donors.
- The marks are thus, allusive, in regard to: "financial advice and consultancy, financial arrangements to facilitate charitable giving, investment trust, preparation of financial reports and analyses, deposit taking services; debit card services; online financial services, grant making services; recovery of tax and payment of fund to the charity; financial research" *since such services are more about financial management than they are about the benefits of charitable giving.*
- That they would welcome my views on their submissions and hoped to engage in further discussion and resolution with the opportunity of a further hearing in the event my concerns in Class 36 remain.

9. On 25 June 2018 I replied as follows:

*"Thank you for your letter of 11 June 2018 and the explanation of the applicant's activities, in the field, broadly speaking, of facilitating charitable giving.*

*I am also grateful for the proposed limitation to make clear the applicant itself does not engage in charitable fundraising. I note, finally, the submission as regards the dual meaning of the word, 'count', having both a monetary and social meaning.*

*It is fair to say, however, that my initial scepticism as regards Class 36 has not been displaced, despite the further explanations, proposed limitation and submissions.*

*I have carefully considered each and every term in Class 36, including the offered limitation, and am of the view that, even with notionally narrower terms, such as 'preparation of financial reports and analyses', 'deposit taking services' and 'financial research', it is very hard to accept that the words would not be devoid also for these services. In other words, I think it is fair to group all the services of Class 36 'homogeneously', in the sense that 'the power of the mark to individualise these services appears to be no greater than in regard to the*

*other services' (see, by way of example, BL O/185/12 'FeedbackMatters', para 36).*

*In short, in my considered opinion and as things stand, I do not think there is a realistic way forward in Class 36.*

*It would not be usual to offer a further aural hearing on the remaining matters in that Class and also I am acutely aware of my duty to resolve this case as expeditiously as I can. In the circumstances, I am minded to formally refuse the application in Class 36 unless something new is submitted by way of argument. I intend to do this if nothing is heard within one month from the date of this letter."*

10. By letter dated 16 July 2018, the applicant indicated it had nothing further to add to its submissions and that in the circumstances I should proceed to refuse the application in Class 36, whereupon an appeal to the appointed person could be made following the provision of a full statement of grounds. I duly refused the application in Class 36 by letter dated 21 August 2018. In response the applicant filed a TM5 requesting a formal statement of grounds as well as a request to divide the application. The request to divide the application has been actioned and the goods and services in respect of which I waived the objection now form the subject matter of application 3335740, which has proceeded to publication. The remaining services in Class 36 form the subject matter of the decision to refuse.

### **Decision**

11. As stated, this case has been decided on a *prima facie* basis only, under the provisions of section 3(1)(b) of the Act, which reads:

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

*(a) ...*

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

*(c) ....*

*(d) ...*

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

### **The relevant legal principles - section 3(1)(b)**

12. The Court of Justice of the European Union ('CJEU') has emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) of Directive 2008/95/EC ('the Directive', being the codified version of the original Directive 89/104/EEC) and Article 7(1) of Council Regulation (EC) No 207/2009 ('the Regulation', being the codified version of original Council Regulation 40/94) in light of the general interest underlying each of them (Case C-37/03P, *Bio ID v OHIM*, paragraph 59 and the case law cited there, and e.g. Case C-273/05P *Celltech R&D Ltd v OHIM*).

13. The general interest to be considered 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 provisions referred to above upon which section 3(1)(b) is based) the Court has held that "...*the public interest... is, manifestly, indissociable from the essential function of a trade mark*" (Case C-329/02P '*SAT.1*' *Satelliten Fernsehen GmbH v OHIM*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him or her, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function. Moreover, the word 'devoid' has, in the UK at least, been paraphrased as meaning 'unpossessed of' from the perspective of the average consumer.

14. The question then arises as to how distinctiveness is assessed under section 3(1)(b). Paragraph 34 of the CJEU Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau ('Postkantoor')* reads as follows:

*"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 C-55/01 Linde and Others [2003] ECR I-3161, para 41, and Case C-104/01 Libertel [2003] ECR I-3793, paras 46 and 75)."*

15. So the question of a mark being devoid of distinctive character is answered by reference to the goods and services applied for and the perception of the average consumer for those goods or services.

16. It is also a well-established principle these days that the registrar's role is to engage in a full and stringent examination of the facts, underlining the Registrar's frontline role in preventing the granting of undue monopolies, see to that effect CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z.o.o. v. OHIM* [2011] ECR I-1541. Whilst that

case was, technically speaking, in relation only to section 3(1)(c) or its equivalent in European law, the principle about the 'prevention of undue monopolies' must hold good whether section 3(1)(b) and/or (c) applies.

17. In applying these principles to this case, it is nonetheless important I am convinced that the objection applies to *all* the goods and services applied for. If there are goods or services specified which are free of objection under section 3(1)(b) then they must be allowed to proceed. In the CJEU case C-239/05 *BVBA Management, Training en Consultancy v Benelux-Merkenbureau*, the question being referred to the Court was whether the Directive, on which the Act is based of course, must be interpreted as meaning that the competent authority is required to state its conclusion separately for each of the individual goods and services specified in the application. The Court answered, and in paragraph 38 said that the competent authority was required to assess the application by reference to individual goods and services. However, where the same ground of refusal is given for a category or group of goods or services, the Court also confirmed that the competent authority may use only general reasoning for all the goods and services concerned. It is plain from this judgment that the Court had in mind purely practical considerations which had to be balanced against a legal provision in the Trade Marks Directive which allows for refusal only in relation to goods and services where objections apply.

18. In my view, the approach taken by the Appointed Person in '*FeedbackMatters*' is correct as (or at least indicative of) a general proposition. Even if it is not, and was never intended as a general proposition *per se*, it is certainly indicative of the inherent problems in handling a sign which may be considered 'devoid' in relation to certain goods and services but not others. The fact the Appointed Person was limited in her application of the proposition to services in Class 36 does nothing to undermine the practical problems involved. If a view is taken that, linguistically, a phrase is likely to be 'devoid', that is to say, 'unpossessed of distinctive character' or 'origin neutral' for my purposes, it is sometimes (as in this case) very hard to draw any meaningful line whereby it may be 'origin specific' in relation to certain (only) goods and services. Despite the potentially complex nature of the question, I am also aware that, consistent with the BVBA decision mentioned above, I need to avoid a compendious approach<sup>3</sup> whereby, based upon linguistic analysis alone or predominantly, I omit to consider the fact that it is incumbent upon me to consider carefully whether the goods and services are capable of treatment as a homogeneous group in terms of likely consumer perception. It will be seen that my approach in this case has been to allow the mark to be published in various Classes, other than Class 36 for the very reason that I did not think a compendious approach could be adopted in this case. In other words, the goods and services were not homogenous as originally filed. That said, having arrived at Class 36 I found, as will be made clear, that I could no longer divide the case; as specified, the services of Class 36 stand to me as a homogenous group.

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<sup>3</sup> See e.g. BL 0/473/15 '*Beating Blood Cancer*' at paras 26 and following.

19. In saying this, I am of course, familiar with, and bound by, the application of 'partial refusal' based upon Art 13 of the Trade Marks Directive, namely that refusal can only be based on those goods and services in respect of which the objection is effective, and by definition, for other goods and services, the application can be accepted. I will simply reiterate at this stage, however, this is a somewhat easier principle to apply where the objection is based only on section 3(1)(c), where objective characteristics such as *types* and *kinds* are often at play, rather than signs or marks which are simply, in the registrar's view, 'devoid' under section 3(1)(b) only.

20. Finally, in the context of the legal principles to be applied in a case such as this, it is impossible to ignore the case of *Audi AG v OHIM* (Case C-398/08P) '*VORSPRUNG DURCH TECHNIC*', already referred to. This is a case which is easily capable of misconstruing, hence my lengthy quote as above. Importantly, for my purposes it is necessary to recognise that a 'slogan type' mark such as this can, in theory, be possessed of both promotional or inspirational capacity and, at one and the same time, the capacity to function as a trade mark. By way of example only, the analysis in the case of BL O/449/16, A DOG IS FOR LIFE NOT JUST FOR CHRISTMAS at paras 25 and following, highlights the possibility of this duality. When I come to explaining my decision, I need to be careful therefore to make a clear finding that the mark, in its inherent characteristics, is, in my opinion, apt only to be regarded as, and for example, a promotional or narrative injunction which is not likely to be seen also as a trade mark.

#### **Application of legal principles - section 3(1)(b)**

21. The mark comprises the words 'MAKE GIVING COUNT'. In the circumstances, as can be seen in my background account above, the sticking point only arose in relation to the services, specifically, of Class 36, which are as follows:

*36 Charitable fundraising; financial advice and consultancy services; financial arrangements to facilitate charitable giving; investment trust services, preparation of financial reports and analyses; deposit taking services; debit card services; online financial services; grant making services; recovery of tax and payment of funds to the charity; financial research.*

So, regarding all the other goods, I found myself unable to conclude the mark would designate a characteristic of those goods or services or that it was otherwise devoid of distinctive character.

22. There is however clear difficulty in Class 36 which comprises, in this case, services which may be classified, broadly speaking, as being of a financial nature.



23. The relevant consumer in this case will be both members of the public and businesses, primarily engaged in programmes of social responsibility. This is fully explained in the applicant's letter of 11 June 2018.

23. The words 'MAKE GIVING COUNT' comprise, in my opinion, a plainly injunctive phrase or narrative directed to the relevant consumer to, in some unspecified way, optimise their giving. That is to say, the applicant is extending to the consumer (whether business, charity or member of the public) the offer that it will facilitate the action of 'giving' in such a way that everyone may optimally benefit. By everyone, I mean the giver (be it a member of the public or a business), and the charity to whom the gift or donation is being made. As is clear from the applicant's own account of its business, the act of charitable giving is not necessarily a straightforward matter and the applicant adds value by, and for example, tracking contributions and advising on efficiencies that may accrue, such as that of tax.

24. The words 'MAKE GIVING COUNT' are based on a well-known phrase, 'MAKE X COUNT'. This has a known linguistic structure, as noted in the EUIPO decision which I have quoted above. Whatever the 'x' is in the phrase, the term 'MAKE X COUNT' will, in my opinion be readily understood and recognised as being colloquially familiar.

25. The applicant's case for registration in Class 36 can be distilled, in the main, to two contentions. The first is that there is word play on the word 'COUNT', in the sense that it would have both a 'social meaning and a monetary meaning'. In my opinion, the case law makes no prescriptive rule that the presence of any word play must inevitably lead to the threshold for registration being met. In this case, and given that the mark is comprised, structurally, from a colloquially known phrase, my view is that whatever degree of word play is involved here, it is not sufficient to pass the test for inherent registration. The applicant's own use has reinforced me in my view that such a phrase is more than capable of explaining exactly what the applicant does or aims to do in a purely promotional sense, without also, and at the same time, acting as a trade mark.

26. The applicant's second main contention, in relation to Class 36 only, is that certain terms within that Class relate not to the benefits of charitable giving *per se*, or in a limited sense, but to broader or alternative terms encompassing 'financial management'. There is a clear difference in the applicant's submission between the two. In regard to 'financial management', the mark can be said to be allusive only, rather than having any obviously descriptive overtones. Because it is 'allusive', the applicant contends the mark is inherently apt to function as a trade mark. My response is that the objection is based on the mark being devoid of all distinctive character (section 3(1)(b)) as distinct from designating (describing) a characteristic of the services (section 3(1)(c)). As is clear from the historical background to the case I have given specific consideration to whether the services in Class 36 are possessed of qualities which enable their clear separation into terms which are free from objection

and those which are not. The applicant submits there are such terms, specifically in the field of financial management but, after considerable thought, I am not persuaded this is the case. Even with services that may relate to financial management such as e.g. 'investment trust services', 'preparation of financial reports and analyses', 'deposit taking services', 'debit card services' and 'financial research'. It seems to me I cannot rule out the probability that the term 'Make giving count' would have no resonance whatsoever. Absent a clear reason to the contrary, namely that the realms of financial management and charitable giving are, in reality, entirely discrete, it seems to me that part and parcel of 'financial management' could very feasibly include consideration of the impact of charitable giving and how, optimally, to undertake that. In short conclusion, this is one of those cases where after careful consideration, I have concluded that there is no clear dividing line that can be drawn here, such that the mark would not be devoid of distinctive character for certain services in Class 36.

27. As regards the argument that other similar marks have been accepted for registration either by the EUIPO or even the UK Registry, it is well established that such acceptances create no binding precedent or even that they are persuasive as far as this application is concerned. This principle has been expressed as recently as BL O/262/18 BREXIT, see paras 9 and following. Despite this I have considered the marks cited by the applicant as being good comparators and I do not believe they are on a par with this application.

### **Conclusion**

28. In this decision I have considered all the papers filed and submissions made. For the reasons given above, the application is refused under section 3(1)(b) in relation to all goods and services.

Dated this 10<sup>th</sup> day of October 2018

**Edward Smith**  
Acting for the Registrar  
The Comptroller General