

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER: 3413390

IN THE NAME OF WEDRIVEANYCAR LIMITED

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 39:

WeDriveAnyCar

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Background:

1. On 11 July 2019 WEDRIVEANYCAR Limited (“the applicant”) applied to register the mark for the following services:

Class 39: Vehicle collection and delivery services; information and advice in relation to all the aforesaid services.

2. On 17 July 2019 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”). The examination report stated:

The application is not acceptable in Class 39. There is an objection under Section 3(1)(b) and (c) of the Act. This is because the mark consists exclusively of a sign which may serve in trade to designate the kind and intended purpose of the services e.g. vehicle delivery and collection services that are able to drive any car.

It is considered that the average consumer of these services would perceive the sign as nothing more than an indication of the services offered, namely, that the services are capable of collecting and delivering any type of car regardless of size, age, fuel type or worth.

When a sign is merely descriptive of a characteristic of the services it is considered that that it cannot function as a trade mark which guarantees the commercial origins of the services for which protection is sought.

3. On 31 July 2019 Trade Mark Direct (“the agent”) acting on behalf of the applicant requested an extension of time to submit evidence of acquired distinctiveness through use. An extension of time was granted on 1 August 2019 for two months. No response was received and on 10 October 2019 the application was refused. On 11 November 2019 the agent submitted a form TM5 request for a statement of reasons for the Registrar’s decision. I am now asked under Section 76 of the Trade Marks Act 1994, and Rule 69 of the Trade Marks Rule 2008, to state the grounds of the Registrar’s decision and the material used in arriving at it. No formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness, therefore I only have the *prima facie* case to consider.

Failure to comply - Section 37(4)

4. In both the examination report of 17 July 2019 and the 'extension of time - granted' letter of 1 August 2019, it was explained that failure to reply to the section 3(1)(b) and (c) objection by the set date would result in the application being refused in accordance with section 37(4) of the Act.
5. Section 37 of the Act sets out provisions which govern the examination of trade mark applications. Section 37(4) reads as follows:

“If the applicant fails to satisfy the registrar that those requirements are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse to accept the application.”
6. Although the applicant responded to the initial examination report within the specified time limit to request an extension of time, once this was granted the applicant failed to provide the Registrar with any subsequent instructions by the set date. The examiner's decision to refuse the application as a result of the applicant's failure to respond within a clearly-communicated time frame was therefore correct and in full accordance with section 37(4) of the Act.
7. Whilst I find the examiners refusal of the application correct and in accordance with section 37(4) of the Act, for the avoidance of any doubt, and in the interests of legal certainty, I have presented below a review and confirmation of the examiner's original objections taken under sections 3(1)(b) and (c).

The prima facie case for registration under Section 3**The Law**

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

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

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

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) ...

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

The relevant legal principles – Section 3(1)(c)

9. There are a number of judgements of the Court of Justice of the European Union (“CJEU”) which deal with the scope of Article 3(1)(c) of the Directive and Article

7(1)(c) of the Regulation, whose provisions correspond to Section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- Subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (*Wm Wrigley Jr & Company v OHIM*, C-191/01P ‘*Doublemint*’, paragraph 30);
- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all (*Doublemint*, paragraph 31);
- It is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes (*Doublemint*, paragraph 32);
- It is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in Paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question (*Koninklijke KPN Nederland NV v Benelux Merkenbureau*, C-363/99 ‘*Postkantoor*’, paragraph 57);
- An otherwise descriptive combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word trade mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark (*Postkantoor*, paragraph 99).

10. In *Matratzen Concord AG v Hukla Germany SA* (C-421/04), the CJEU stated that:

“...to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, who are reasonably well informed and reasonably observant and circumspect, in the territory in respect of which registration is applied...”

11. I am also mindful of the decision of the General Court (formerly the Court of First Instance) in *Ford Motor Co v OHIM*, T-67/07 where it was stated that:

“...there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics”.

12. I must also be aware that the test is one of immediacy or first impression, as confirmed by the General Court which, in its decision on *Sykes Enterprises v OHIM 'Real People Real Solutions'* [2002], ECT II-5179, stated:
- "...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."*
13. It is clear from the aforementioned case law that assuming notional and fair use, I must determine whether or not the mark applied for will be viewed by the average consumer as a means of directly designating the essential characteristics of the services being provided. I therefore must consider who the average consumer of the services covered by the application is. The applicant has not provided any indication of who the average consumer of the services is however, given the nature of the services covered by the application, I believe that they could be intended for use by those who require collection or delivery of a vehicle, whether that be a service provided business to business or for the use of the general public. Vehicle collection or delivery services could be required for rental vehicles, newly purchased vehicles or vehicles which need to be delivered or collected to or from the owner or a garage for servicing, MOTs or other vehicle maintenance or repair services. Cars are expensive items and the consumer would be trusting the provider of the services to drive the car and deliver or collect it safely. It is therefore reasonable to believe that the consumers level of attention when deciding whether to purchase such services would be reasonably high.
14. Having considered the type of activity encompassed within the services on offer, also having identified the relevant consumer, and established the likely level of attention, I must now determine how the average consumer will perceive the sign when used in respect of the services claimed. The individual words included in the sign are 'We Drive Any Car'. The sign is comprised of English words which will be easily understood by the average consumer. The phrase as a whole is one which will give an immediate and clear message to the relevant public in the UK.
15. In my opinion, when viewed in the *prima facie* case, the sign 'WeDriveAnyCar' when used in respect of vehicle collection and delivery services would be understood as a reference to the provider of those services being able to drive any car. In relation to vehicle collection and delivery services, it would be important to consumers that the provider of those services would be capable of driving any or all types of cars. The phrase 'WeDriveAnyCar' is a clear and unambiguous way of stating that the provider of the services can drive any car whether that car is petrol, diesel, manual, automatic etc. This immediate descriptive message about the services would not be perceived as a trade mark by the average consumer.
16. It is also my view that conjoining the words does not add any inherent distinctiveness to the sign. The conjoined presentation would be perceived as nothing more than a minor and inherently non-distinctive presentational variation on the conventionally-presented phrase 'we drive any car'. The capitalisation of the first letter of each word means it would be immediately read as separate words by the average consumer.

17. In considering the relationship between the services claimed (vehicle collection and delivery services; information and advice in relation to the aforesaid services) and the sign itself (WeDriveAnyCar), it is my view that there is a direct and specific correlation between the sign and the services claimed. The relevant consumer will immediately perceive the mark, without further thought, as being a description of a characteristic of those services i.e. vehicle collection and delivery services where the provider can drive any car. The sign is not vague or imprecise and sends a clear descriptive message to consumers that the service provider for the vehicle collection and delivery services will be able to drive any car. The descriptive message conveyed by the sign could apply to any undertaking offering the same services and it is therefore incapable of individualising the services of one undertaking from those of another.
18. Whilst I am not bound by earlier decisions, I believe it worth noting that a similar application for the sign 'webuyanycar' (UK00002541644) was refused prima facie and only proceeded to registration on the basis of acquired distinctiveness through use. This reinforces my view that the sign is incapable of individualising the services of one undertaking from another without consumers having first been educated to perceive the sign as a trade mark.
19. Having found that the mark 'WeDriveAnyCar' is to be excluded from registration by section 3(1)(c) of the Act for the reasons stated above, that effectively ends the matter. However, in case I am found to be wrong in this decision, I'd make a separate finding under Section 3(1)(b), as an independent objection.

The relevant legal principles - Section 3(1)(b)

20. In relation to section 3(1)(b) it was held in *Postkantoor* case C-363/99 that:

“86. In particular, a word mark which is descriptive of characteristics of the goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may nonetheless be devoid of any distinctive character in relation to goods or service for reasons other than the fact that it may be descriptive.”

21. I approach this ground of objection on the basis of the following main guiding principles derived from ECJ cases noted below:
- an objection under Section 3(1)(b) operates independently of objections under section 3(1)(c) – (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);
 - for a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
 - a mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86);

- a trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 7277);
- the relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

22. It is important I consider whether the sign may still be devoid of any distinctive character under section 3(1)(b) in relation to the services included in the application, even though it may not precisely designate a characteristic of the services as per section 3(1)(c). In my opinion, even if the mark falls short of exclusively describing a characteristic of the services, I would nevertheless hold that it is not capable of performing the essential function of a trade mark without the relevant public being educated into seeing it that way. In my view, consumers would not consider the mark to denote that the services belong to any one specific provider because of the direct association with the services being offered. This is essentially the same objection set out under section 3(1)(c) however, given that the sign comprises of a positive statement about the nature of the applicant's business, I have given some consideration to whether an objection under section 3(1)(b) (as an independent ground) was more appropriate.

23. The test is one of immediacy or first impression, as confirmed in the decision *Sykes Enterprises v OHIM (Real People Real Solutions)* [2002] ECR II-5179, it was stated:

"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."

24. It is my opinion that given the signs direct association with the services included in the application, even if it were perceived as a positive statement about the nature of those services rather than a description of a characteristic of those services, I believe the average consumer would still perceive the sign as being origin neutral rather than origin specific. It is a narrative sign explaining the activities of the provider. As I have stated in paragraph 16 above, the conjoined presentation of the words does not add any distinctiveness to the sign as a whole and would be perceived as nothing more than a minor and inherently non-distinctive presentational variation on the conventionally-presented phrase 'we drive any car'.

Conclusion

25. I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is an indication of trade origin. In this decision

O/738/19

I have considered all the documents filed by the applicant, and all the arguments submitted in relation to the application. Having done so, and for the reasons given above, the application is refused under sections 3(1)(b) and 3(1)(c) of the Act for all services in Class 39.

Dated this 4th day of December 2019

**Rebecca Thomas
For the Registrar
The Comptroller-General**