

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER: 3422836

IN THE NAME OF PHILLIPS 66 COMPANY

TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 4 AND 37:

MORE THAN FUEL

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Background:

1. On 21 August 2019 PHILLIPS 66 COMPANY (“the applicant”) applied to register the mark for the following goods and services:

Class 4: Oils and greases; fuel; gasoline, diesel, petrol; petrol ether; lubricants; motor fuel; fuel with alcoholic base; vaporised fuel mixtures; non-chemical additives to motor fuel; fuel gas; fuel oil; diesel oil; fuel alcohol.

Class 37: Vehicle service station services; vehicle fuelling services; vehicle lubrication, maintenance, cleaning and repair services; anti-rust treatment for vehicles; vehicle tyre fitting and repair; vehicle washing services.

2. On 30 August 2019 the Intellectual Property Office (“IPO”) issued an examination report in response to the application. In that report the following objection was raised under Sections 3(1)(b) and (c) of the Trade Marks Act 1994 (“the Act”):

Section 3(1)(b)

*The application is not acceptable in Classes 4 or 37. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because the mark consists of the phrase **MORE THAN FUEL**.*

It is considered that the relevant consumer, when greeted with the sign on fuels, fuel services and closely aligned goods and services would perceive it as a mere indication that the undertaking provided other goods and services in addition to fuel, or more than fuel.

Section 3(1)(b) and (c)

The application is not acceptable in Classes 4 or 37. 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 a characteristic of the goods and services e.g. fuels which are sold combined with other substances, or services incorporating fuel with other things.

The average consumer, when greeted with the sign 'more than fuel' would perceive it as a mere indication that the provider of the goods and/or services offered a larger range of goods or services than simply fuel.

3. On 9 September 2019 Sipara Limited (“the agent”) acting on behalf of the applicant requested a hearing. At the hearing, which was held on 23 October 2019 with Mr Nick Baker of the agents, Mr Baker argued that the sign was distinctive in relation to the goods and services applied for as it did not give an immediate and clear message about the goods and services and did not make sense in relation to those goods and services. Mr Baker submitted that the sign was ambiguous and did not convey a message about the goods or services included in the application. Mr Baker argued that the sign was an unusual syntax and was an imaginative and distinctive term. Mr Baker referred to the mark MORE THAN SCENTS (3217238) which had recently been accepted by the registry and argued that if MORE THAN SCENTS was considered distinctive for goods and services related to scents then MORE THAN FUEL should also be considered distinctive for goods and services related to fuel.
4. In my decision, I maintained the Section 3(1)(b) objection and waived the Section 3(1)(c) objection. This was because in my opinion, the sign does not designate a characteristic of the goods and services listed in the application however, I maintained that the sign was devoid of any distinctive character. The sign is one which I believe provides a message to consumers that the applicants goods and services offer more than fuel for example, fuels which incorporate other substances or services which provide fuel and other goods. I maintained that the sign is not vague or imprecise and it sends an immediate and clear message to consumers about the goods and services being provided. The sign sends a clear message in plain language that could apply to any undertaking offering the same or similar goods and services. For these reasons I maintained that the sign is not capable of individualising the good and services of one undertaking from another.
5. On 25 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 Mark Rules 2008, to state the grounds of my 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.

The prima facie case for registration under Section 3

The Law

6. 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)(b)

7. 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)(b) of the Directive and Article 7(1)(b) of the Regulation, whose provisions correspond to Section 3(1)(b) of the UK Act. I derive the following main guiding principles from the cases notes 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*).

8. In *Postkantoor* case C-363/99 in relation to section 3(1)(b) it stated 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.”

9. When considering whether a sign can function as a trade mark, it is important to consider the average consumers first impression of the sign when it is used in relation to the goods and services covered by the application. 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, where it states:

“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.”

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 sign capable of denoting a single source of trade origin when used in relation to the goods and services included in the application. I therefore must consider who the average consumer of the services covered by the application is. The goods included in the application are oils and greases, fuel, gasoline, petrol, motor fuel and fuel additives. These can be purchased for use in personal vehicles by the general public or possibly purchased by businesses to fuel a fleet of vehicles or even perhaps supplied to the end consumer (the public) in the servicing or repair of their vehicles. The services are vehicle service station services, vehicle fuelling services, vehicle lubrication maintenance, cleaning and repair services. In my opinion, these services are more likely to be purchased by the general public for their own personal vehicles. I cannot rule out the possibility that businesses may also access such services, but my general view is that the services are more apt to be accessed by the general public. I should clarify that the net result of this analysis does not materially impact on my final decision in this case as I have not, and for example, identified the goods or services as being exclusively sold through specialist, professional networks whereby consumer perception may be different to the general public. In this case, whether the consumer is the public or trade, their levels of perception are likely to be normal or reasonable.

10. Having considered the type of activity encompassed within the goods and 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 goods and services claimed. The individual words included in the sign are ‘more than fuel’. The sign is comprised of English words which will be easily understood by the average consumer. The phrase as a whole, although slightly elliptical, is nonetheless one which in my opinion, gives an immediate and clear message to the relevant public in the UK.
11. In relation to the goods included in the application, the sign is merely a message that the goods are more than just fuel. The goods are fuel, and additives and extras which could help engines cleanliness and performance. In relation to these goods, the sign has a dual meaning, neither which would be perceived as a trade mark in my opinion. In relation to fuel which includes additives and extras, the phrase has a literal meaning that the goods are more than fuel however, in relation to goods which are just fuel, the phrase is merely advertising hyperbole which implies in a laudatory sense that the goods are more than fuel. The services applied for in the application are vehicle service station services and vehicle fuelling station services. It is usual for service stations and other undertakings where fuel is sold to sell more than fuel. The message to consumers in relation to these services is clear in that they provide more than fuel for example, snacks, drinks, magazines or newspapers. The immediate non-distinctive message conveyed by the words ‘more than fuel’ means consumers are unlikely to award the sign any trade mark significance. The sign conveys a clear message in plain language that could apply to any undertaking offering the same

services and it is therefore not capable of individualising the services of one undertaking from another.

12. In my opinion, when viewed in the *prima facie case*, the sign 'more than fuel' when used in respect of fuel and associated additives and fuelling and vehicle service stations and associated services, would be understood merely as a laudatory message about the goods and services being provided namely, the goods and services are more than just simply fuel. The immediate non-distinctive positive message referring to the goods and services is one which is not capable of performing the essential function of a trade mark without the relevant public first being educated into seeing it that way. In my view, consumers would not consider the mark to denote that the goods and services belong to any one specific provider because of the direct association with the goods and services being offered.
13. The initial examination report raised a separate objection under section 3(1)(c) as well as an objection under section 3(1)(b). This was because the examiner felt the mark consists exclusively of a sign which may serve in trade to designate a characteristic of the goods and services e.g. fuels which are sold combined with other substances, or services incorporating fuel with other things. As I have said I have carefully considered whether a separate objection under section 3(1)(c) is appropriate however, it is my opinion that the sign cannot be said to be directly and exclusively descriptive of the goods and services covered by the application. The sign's direct association with the goods and services included in the application whilst not necessarily being exclusively descriptive is still nonetheless non-distinctive. I believe the average consumer would perceive the sign as being origin neutral rather than origin specific. It is merely a positive statement informing consumers that the provider of the services offers more than fuel and that the goods are more than fuel.
14. Regarding the precedent cited by the agent, referred to in paragraph 3, the legal position with such marks raised as comparators has been recently clarified in relation to the mark BREXIT BLO-262-18 see paras [46-48].

Conclusion

15. 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, 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) of the Act for all the goods and services applied for in Classes 4 and 37.

Dated 31st day of December 2019

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