

O-011-04

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. 2294296A
TO REGISTER A TRADE MARK
IN CLASSES 16, 20, 35, 36, 37, 38, 39, 41, 42, 43, 44 & 45**

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BY LAND SECURITIES PLC**

DECISION AND GROUNDS OF DECISION

Background

1. On 1st March 2002, Land Securities Plc of 5 Strand London WC2N 5AF applied to register the trade marks MAKING PROPERTY WORK and LAND SECURITIES MAKING PROPERTY WORK (as application number 2294296) in classes 16, 20, 35, 36, 37, 38, 39, 41, 42, 43, 44 and 45.

2. Following the raising of various objections the application was divided into two parts, namely, 2294296A covering the mark MAKING PROPERTY WORK and 2294296B for the mark LAND SECURITIES MAKING PROPERTY WORK. Application no 2294296B subsequently proceeded to publication and therefore I do not make any further reference to it in this decision.

3. The goods and services for which registration is sought are as follows:

Class 16:

Printed publications relating to property, property portfolio management, property development, property services and urban regeneration.

Class 20:

Office furniture.

Class 35:

Management of commercial premises; management of retail premises; management of offices; facilities management; reception services and management; post-room services and management; the bringing together, for the benefit of others, a variety of retail outlets, entertainment, housing and business facilities, enabling customers to conveniently purchase goods and services in a built community environment; secretarial services; accounting; telephone answering; document reproduction, photocopying, word processing, typing, transcription; business information; office machines and equipment rental.

Class 36:

Property acquisition and sale; property management and administration; property portfolio management and administration; property and capital investment; property appraisals and valuations; property brokerage; estate management; advisory and information services all relating to the aforesaid; rental of property; rental of housing accommodation; rental of retail premises; rental of offices; rental of industrial premises; rental of retail warehouses; leasing of property;

leasing of housing accommodation; leasing of retail premises; leasing of offices; leasing of industrial premises; leasing of retail warehouses; arranging leases for the aforesaid; rent collection services; provision of housing accommodation; provision of retail space; provision of office space; provision of industrial space; provision of retail warehouse space; billing services in relation to telecommunications service providers and meter reading.

Class 37:

Property development; development of sites for commercial and industrial purposes; infrastructure development; building construction; building construction services; construction management services; building construction supervision; construction advisory services; building project management; restoration, renovation and refurbishment of property and buildings; urban regeneration including any of the aforesaid services; maintenance, repair and installation services all relating to property, buildings and real estate; landscaping services; cleaning of buildings; maintenance, repair and installation services all relating to telecommunications apparatus and equipment; maintenance, repair and installation services all relating to office equipment and fitting; upholstery repair; dry cleaning; cleaning services; advisory services relating to asbestos removal; lift maintenance.

Class 38:

Telecommunications services; provision of telecommunication services enabling end-users to connect to providers of telecommunication services and to application service providers; provision of user access to a global computer network; provision of telecommunication connections to a global computer network; electronic mail services; audio conferencing services; applications outsourcing services; communication services; voice, data and video communication services; voice-mail services; video conference services; video streaming services; video and audio content-based broadband services; Internet protocol telephony and facsimile services; virtual private network services; voice-mail services; telecommunication network services; organisation of telecommunication networks; provision of server co-location management services; provision of information relating to telecommunications; telecommunication services relating to the delivery of emergency messages; local and long distance telephone services; Internet directory services; high-speed Internet access services (dedicated and dial-up connections); high-speed data interconnect and access services; rental of telecommunication equipment.

Class 39:

Provision and management of car parking facilities; portering services; electrical supply services; gas supply services; gas distribution services.

Class 41:

Provision of sporting, entertainment and cultural facilities; provision of crèche and nursery facilities; provision of exhibition and gallery facilities; provision of children's playgrounds; providing on-line electronic publications [not downloadable]; arranging and organising of conferences.

Class 42:

Conducting feasibility studies; construction design services; architectural, engineering, survey and planning services all relating to property and property development; inspection of buildings; interior design services; advisory services relating to the aforesaid; development and management of a customer interface to manage outsourced computer and telecommunications resources; enterprise resource planning (erp) services; web-hosting (content hosting); providing access time to a computer database; design and implementation of telecommunication network systems, wide area networks and local area networks, desktop management services; rental of computers; consultancy and information services relating to health and safety.

Class 43:

Café, restaurant, bar and catering services; rental of office furniture.

Class 44:

Provision of beauty salon facilities.

Class 45:

Fire safety consultancy services; intruder detection; security guard services for buildings; security services; security surveillance; arranging security services for buildings; concierge services.

4. Objections were taken against the application under the following sections of the Act:

- (i) Sections 3(1)(b) and (c): because the mark consists exclusively of the words MAKING PROPERTY WORK, the whole being devoid of any distinctive character and a sign that may serve in trade to designate, for example, the characteristics or intended purpose of the goods or services, for example, printed matter relating to the subject of making property work or function effectively, or services designed to make property work (eg making it earn money for the owner).

and

- (ii) Section 3(1)(d): because the combination MAKING PROPERTY WORK is a sign that has become customary in the financial and property trades.

5. Following written submissions in support of the mark, the objection under Section 3(1)(d) was subsequently waived and I need not make any further reference to it in this decision. Regarding the objection under Section 3(1)(c) this was waived in relation to classes 20, 38, 43 and 44 and 45 but maintained in respect of the remaining goods and services. The Section 3(1)(b) objection applies to all the classes.

Decision

6. A hearing was held on 27th November 2002 at which the applicant was represented by Ms Eesheta Shah of Nabarro Nathanson. The objection under Section 3 (1)(b) and (c) of the Act was maintained and the application was subsequently refused on 1st August 2003 in accordance with Section 37(4) of the Act.

7. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

8. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

The law

9. The relevant part of Section 3 of the Act is as follows:

“Section 3(1):

The following shall not be registered-

- (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,”

The case for registration

10. In support of the application, submissions were made in correspondence and at the hearing by Ms Shah, whose principle arguments may be summarised as follows:

- It is necessary to make a distinction between mere use of the words “making”, “property” and “work” as part of an ordinary sentence, and use of the words as a slogan, in its own right, to indicate origin (see Annex A for example of mark in use);
- It is clear that the applicant has adopted the slogan as part of its corporate image in order to distinguish itself from other property companies;
- Adopting a slogan or strap line as part of a company’s corporate image is so common and MAKING PROPERTY WORK is no different from slogans such as JUST DO IT, THE PRINCIPLE OF COMFORT and THE WORLD’S FAVOURITE AIRLINE. All of these comprise three or four ordinary words of the English language, but are nevertheless on the register of trade marks;
- Taken out of a sentence and used as a slogan, the term MAKING PROPERTY WORK would be recognised and perceived by prospective consumers as being an indication of origin. This is particularly so given the nature of the goods and services in question and the potential market that the applicant is concerned with. The type of goods and services in question are not directed to the public at large but rather to a sophisticated market in

which buyers are discerning. The average consumer of the applicant's goods will be a purchaser or tenant of commercial space and related services who will see that the term is intended to be a slogan;

- A search of the internet revealed only six references to the term MAKING PROPERTY WORK (see Annex B). This alone shows that the term is relatively little used. On close inspection of the extracts supplied, five out of the six websites used the words "making property work" as part of a larger sentence, rather than as an indication of origin. One website shown, Teesland, could be said to use MAKING PROPERTY WORK to indicate origin, but that site is under construction and it is not certain it will be used in this manner again;
- The applicant is not trying to monopolise three ordinary words of the English language used in normal parlance, and Section 11 of the Trade Marks Act 1994 would in any event provide a complete defence to anyone wanting to use the term in a descriptive way or as part of a sentence. The purpose of rejecting exclusively descriptive marks is not to keep the register clear of words that other traders may want to use. In this regard, the Court of Appeal decision in *David West trading as Eastenders v Fuller Smith and Turner Plc* [2003] F.S.R. 44 dated 31 January 2003 is relevant. In that case, Mr Justice Pumfrey held (on page 826 at paragraph 23):

"it is now the law that the existence of the defence* is material to the scope of the prohibition on registration contained in sub-section 3(1)(c) of the Act."

*referring to the defence in Section 11(2)(b);

- The BABY-DRY decision supports the case for registration. The term MAKING PROPERTY WORK is not the way in which the average consumer of the goods and services in question would usually describe the intended purpose of the goods and services. The usual way in which the average consumer would describe the intended purpose of, for example, printed publications relating to property, property portfolio management etc would be to say, for example, that they "inform consumers how to manage properties more efficiently and more cost-effectively". It is unlikely that the average consumer would describe the intended purpose as being to inform customers how to make property work. The term MAKING PROPERTY WORK is an unusual way of describing the intended purpose of the goods in question, partly because it has no inherent sense of meaning. Property does not "work" as people work or machines work. As such the term does have distinctive character and is capable of fulfilling the function of identifying one undertaking from another;
- The term when taken out of a sentence is not exclusively descriptive. Whilst the term MAKING PROPERTY WORK suggests that the goods and services offered under the mark relate to the property sector, it has an ambiguous meaning. It could either be taken to mean that the applicant will, by offering its goods and services make a property function smoothly on a day to day basis, or it could be taken to mean that the applicant will set the consumer up so that its property works for it. Alternatively, it could be taken

to mean that the applicant will provide the consumer with essential space needed to house, for example, employees of its business. This ambiguous meaning is relevant to the question of distinctiveness. MAKING PROPERTY WORK is neither a readily used or understood term and there is no clear inherent defined sense of what it means. It is imaginative and when used as a slogan serves to distinguish the applicant's goods and services;

- In the Judgement of the Court of First Instance concerning the trade mark EASYBANK, the court annulled the decision of OHIM's Board of Appeal which had refused registration. In relation to Article 7(1)(c) of Regulation No. 40/94 the Court held:

“...the link between the meaning of the term EASYBANK on the one hand and the services capable of being provided by an online bank on the other, appears to be too vague and indeterminate to confer a descriptive character on that term in relation to those services. Thus, the term in question does not as such enable potential customers to identify immediately and precisely either the specific banking services capable of being provided or, a fortiori, one or more of their characteristics”;

- Examples abound of slogans that consist of corporate branding, many of which have an active “-ing” element. Consumers have, through use of these slogans on all media of advertising products and packaging, been educated to see these as part of the brands concerned. Examples include:

MAKING LIFE TASTE BETTER – used by Sainsbury;
WORKING FOR A SAFER LONDON – used by the Metropolitan Police;
CONNECTING PEOPLE – used by Nokia;
DEFINING BEAUTY – used by Estee Lauder;
PUTTING THE FUN BACK INTO DRIVING – use by Corsa;
ALWAYS GIVING YOU EXTRA – used by Halifax;
BRINGING ENERGY TO LIFE – use by BG Plc.

- It is too simplistic (and plainly wrong) to distinguish in categorical fashion between slogans as forgettable advertising and traditional trade marks (word marks and device marks). Slogans of the kind listed above have an active quality about them which does, in practice, enable the relevant public to memorise the sign easily and instantly as a distinctive trade mark for the goods and services designate. What makes such slogans memorable is that the public know this kind of sign is used by corporates as a standing brand feature.

Decision

11. The mark consists of the slogan MAKING PROPERTY WORK. The Registrar's practice in relation to such marks is set out in Practice Amendment Notice No. 7/02, dated 18 June 2002. The opening paragraphs state:

“1. The Registrar’s practice on the registrability of slogan type marks has been reviewed in the light of the judgement of the European Court of Justice (ECJ) in the Baby-Dry case (C-383/99) and that of the Court of First Instance (CFI) in the case of Das Prinzip Der Bequemlichkeit (T-138/00).

2. It is plain from these cases that slogans are registrable as trade marks provided that they have the capacity to individualise the goods or services of one undertaking because they are not comprised of signs or indications which directly describe the goods or services or their essential characteristics, and are not devoid of distinctive character for any other reason.”

Although not a phrase that is defined in any dictionary, it is my view that MAKING PROPERTY WORK is a combination which may serve in trade to designate characteristics of the goods and services covered by the application and is therefore debarred from registration under Section 3(1)(c) of the Act. In relation to those goods and services where the mark does not designate their characteristics, I take the view that it is also debarred from registration under Section 3(1)(b) of the Act.

Section 3(1)(c)

12. On 20 September 2001, the European Court of Justice issued a judgement in *Proctor & Gamble Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case-383/99P for the mark *Baby-Dry*. This judgement gives useful guidance on the test for descriptiveness under Section 3(1)(c) of the Act.

13. I give below paragraphs 37, 39 and 40 of the judgement in full:

"37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Procter & Gamble and the OHIM acknowledge, to prevent registration as trade marks signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function."

"39. The signs and indications referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics."

"40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services of their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark."

14. These paragraphs indicate that only marks which are no different from the usual way of designating the relevant goods or services or their characteristics are now debarred from registration by Section 3(1)(c). I am of the view that the phrase MAKING PROPERTY WORK comprises a slogan which is not an unusual way of describing the applicant's goods and services and therefore the public could not distinguish them from those provided by other undertakings. Without any evidence to persuade me to the contrary, I believe that the mark "may serve in normal usage from a consumer's point of view to designate" one of the essential characteristics of the goods and services. For example, a magazine titled MAKING PROPERTY WORK sends out an unequivocal message about its subject matter. It tells the potential reader that this will help you in making your property work. In relation to services such as property development, the mark is directly descriptive in that it clearly conveys to customers that these services assist in making property work for the owner. Therefore, I consider that the mark designates the intended purpose of goods and services covered by the application.

15. The assertion that because the slogan may be interpreted ambiguously and therefore have more than one meaning is not a relevant consideration when one of those meanings is descriptive. In the *DOUBLEMINT* decision of the European Court of Justice C191-01 (see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr* 2003 WL 101985) the ECJ confirmed the validity of the OHIM's approach that a word such as DOUBLEMINT does not cease to be descriptive simply because it can have several meanings and is therefore ambiguous. In the mind of the average consumer, DOUBLEMINT is spontaneously associated with certain potential characteristics of the goods in question, namely their mint-based composition and their mint flavour, so that the word is necessarily descriptive and cannot therefore be registered as a Community trade mark. The Court agreed and, further, stated:

"32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned."

16. The ECJ went on to say that the test under Art. 7(1)(c) was whether the word at issue was capable of being used by other economic operators to designate a characteristic of their goods and services, not whether it was exclusively descriptive of the goods or services in respect of which registration is sought, or of their characteristics, and therefore incapable of registration. This principle is echoed in the following passage from *Cycling IS...* [2002] R.P.C. 37:

“In the case of wholly descriptive signs and indications there is nothing for such protection to attach to or bite upon. Such signs and indications can be used with equal truth by traders those goods or services possess the relevant characteristic.”

17. I accept that the test for registering slogans is no different than for any other type of marks but as slogans are often used for advertising purposes they may not be so readily accepted by the general public as an indication of trade source as would more traditional signs such as words, brands, logos and figurative marks (See the Judgement of The Court of First Instance in “REAL PEOPLE, REAL SOLUTIONS” - Case T-130/01 5 December 2002). I also accept that lack of originality per se is not fatal to the outcome of the application for registration. Mr Simon Thorley QC sitting as the Appointed Person in “*Where All Your Favourites Come together*” – see BL 0/573/01 – said (at page 2, paragraph 23):

“Therefore I consider that the mark WHERE ALL YOUR FAVOURITES COME TOGETHER as a whole would be perceived by the relevant customer as no more than a promotional statement that the package contains a variety of confectionery items which sales or other research have identified as consumer favourites. On the basis of this, he (the Hearing Officer) concluded that the mark was excluded from registration under sections 3(1)(b) and (c) of the Act.

That decision was given in July of this year before the European Court of Justice gave judgment in the case of *Procter & Gamble Co. v The Office for Harmonisation in the Internal Market*, C38399, on 20th September 2001. That was the *BABY-DRY* case. It is not, on this appeal, necessary that I should go into details about the *BABY-DRY* CASE since it was common ground between Mr Chapple and Mr James, who appeared on behalf of the Registrar, that the correct approach to this case had not changed as a result of the *BABY-DRY* decision. It is sufficient, in those circumstances, that I refer to paragraph 42 of the judgment in the *BABY-DRY* case where the court stated the test under Article 7 of the Regulation (which equates to section 3 of the Act) is as follows: “The determination to be made depends on whether the word combination in question may be viewed as a normal way of referring to the goods or of representing their essential characteristics in common parlance.”

Of course, in *BABY-DRY*, the mark that was being considered was a plain word mark and not a slogan or strapline as in the present case. It was again common ground that this mark was of the nature of a slogan or strapline and that, therefore, consideration of its use in advertising was particularly appropriate.”

And at page 5, paragraph 2, Mr Thorley said:

“I turn then to consider the basic question: is the trade mark applied for a perfectly normal way of referring to the goods? “Is it a natural or normal way of referring to the goods? Is the appropriate way to look at the question before me? This is, I believe, the way that Mr Redmore approached the matter. He reached the conclusion that the expression would be perceived by the relevant customer as no more than a promotional statement that the package contains a variety of confectionery items.

Mr. Chapple sought to criticise this on the basis that Mr. Redmore was wrong in concluding that it was no more than a promotional statement. I see some force in Mr. Chapple's submission. What I have to consider is, I think, not the question of whether the customer would see it as no more than a promotional statement, but rather whether, in the course of trade, such a use would be a natural or normal way of referring to a quality of the goods. I have reached the conclusion in this case that when used in relation to confectionery as a whole, Mr. James's submission carries weight. I believe the average consumer would see the abbreviation for what it is, namely, an abbreviation for the expression, "This is where all your favourites come together in one box.”

18. I take the view that MAKING PROPERTY WORK would be perceived by the relevant public as merely advertising or promotional matter. Although the consumers of the goods and services may, perhaps, be more discerning than, for instance, shoppers buying products off the shelf in a supermarket, it is my view that their reaction to the phrase would be no different. In use, the phrase MAKING PROPERTY WORK appears to have no trade mark significance (see Annex A).

19. A search of the internet which revealed that the phrase is used by other parties does not support the case for registration. The extracts supplied to the applicant (see Annex B) demonstrate that there are other businesses in the UK which use the phrase to promote their products and in these circumstances, it would not be appropriate for one undertaking to monopolise this phrase. The internet extracts include:

Welburn & Co: Property/Real Estate:	Building the future, considering the environment, making property work for you.
Piccadilly Estate Management:	Making property work for people.
Allied London Properties PLC:	committed to making property work through innovation, dedication and partnership.
Teesland:	Making Property Work.

20. These references underline the importance that MAKING PROPERTY WORK is a phrase which should be kept free for use by others. Recent decisions and opinions make it clear that there remains a public interest in keeping free certain words or combinations of words which others wish to use. For example, in the Opinion of Advocate General Jacobs in the trade mark *DOUBLEMINT*, he said (on 10 April 2003):

“Availability for general use

91. That last consideration leads me to the question of the extent to which Article 7(1)(c) of the Trade Mark Regulation must be interpreted in the light of the aim referred to in the *Windsurfing Chiemsee* judgment, namely that descriptive signs and indications should be freely available to be used by all traders in relation to the relevant goods.

92. In my Opinion in *Baby-Dry*, (39) I took the approach that in the scheme of the Community Trade Mark Regulation a trade mark could include signs or indications designating product characteristics but could not consist exclusively of them. By virtue of Article 12(b), the trade mark cannot prevent other traders from using such signs for descriptive purposes. The aim of Article 7(1)(c) is to avoid the registration of descriptive brand names for which no protection could be available rather than to prevent any monopolising of ordinary descriptive terms. A very similar view was taken by the Court at paragraph 37 of its judgment.

93. In the present case, both the Office and the United Kingdom Government have expressed reservations about that approach, which has also been criticised in the literature. (40) It appears, they have pointed out, to represent a departure from the Courts statement in *Windsurfing Chiemsee* that Article 3(1)(c) of the Trade Marks Directive ‘pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all and that Article 6(1)(b) (which corresponds to Article 12(b) of the Regulation) does not have a decisive bearing on that interpretation.

94. It may be feared that the approach in question is liable to shift the balance of power in favour of a trade mark owner with monopolistic ambitions who may assert, or threaten to assert, his rights against an alleged ‘infringer who merely seeks to use descriptive terms descriptively and honestly’. In the real world, a defence under Article 12(b) might be worth rather less than its ostensible value in law.

95. That danger cannot be ignored. A trade mark owner wishing to monopolise not only his trade mark but the area around it may threaten unmeritorious proceedings against a competitor, who may capitulate rather than incur the costs of litigation as well as risk an adverse outcome.

96. However, for the reasons already given, I do not think that the *Baby-Dry* case, properly understood, does shift the balance in the way that has been suggested. And the danger mentioned will be obviated if the criterion of ‘perceptible difference’ in paragraph 40 of the *Baby-Dry* judgment is applied as I have suggested above, so that a mark is accepted for registration only when it is apparent to both traders and consumers that as a whole it is not suitable, in the ordinary language of trade, as a designation of characteristics of the product in question.

97. In any event, it seems clear that there was no intention, in the *Baby-Dry* judgment, to depart from the view in *Windsurfing Chiemsee* that it is in the public interest that descriptive signs may be freely used by all. Very recently, in *Linde*, (42) the Court has expressly reaffirmed that position.”

21. This opinion was confirmed by the European Court of Justice in Case C191-01 (*Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr* 2003 WL 101985) which said:

“31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.”

Section 3(1)(b)

22. Having found that the mark is debarred from registration under Section 3(1)(c) of the Act, I now have to consider whether the mark is devoid of any distinctive character under Section 3(1)(b).

23. The *Cycling IS...* case [2002] R.P.C. 37 advanced the notion that section 3(1)(b) has separate and independent scope from section 3(1)(c), an approach since reinforced both in the European Court of Justice, in its judgement on *Companyline* [2003] E.T.M.R. 20 and by the English High Court in *Have A Break* [2002] EWHC 2533 (Ch). Mr Geoffrey Hobbs, Q.C. said, in *Cycling IS...*:

“66. That brings me to the question of whether the signs possess a distinctive character enabling them to fulfil the essential function of a trade mark in relation to goods and services of the kind specified in the application for registration. (The goods and services comprise “clothing, footwear and headgear” in Class 25 and “advertising, all relating to the cycling industry” in Class 35).

67. The case for allowing registration rests upon the proposition that the signs are cryptic to a degree which makes it more likely than not that they would carry connotations of trade origin (whatever other connotations they might also carry) in the minds of the relevant class of persons or at least a significant proportion thereof.

68. The case for refusing registration rests upon the proposition that the signs are visually and linguistically meaningful in a way which is more likely than not to relate the goods and services to the activity of cycling without also serving to identify trade origin in the minds of the relevant class of persons.

69. The difference between these two positions resides in the question whether the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin specific or origin neutral.

70. The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect.

71. I do not suppose that such a person would pause to construe the signs when encountering them in any of the different settings (including advertising and promotional settings) in which they might be used. Even so, the degree of attention required to take note of the signs in the first place would be sufficient, in my view, to leave a well-informed and reasonably observant and circumspect person with the clear impression that the signs were being used with reference to goods and services related to cycling.”

24. Mr Hobbs went on to observe:

“73. Doing the best I can on the materials before me, I think that the signs in question would be perceived by the relevant class of persons as pronouncements in identifying cycling as the *raison d’être* for the marketing of the goods and services to which they are related. That is a message that the members of a consortium of bicycle retailers might naturally be interested in putting across to customers and potential customers. I do not think that the nature of the pronouncement or its presentation can in either case be regarded as sufficiently striking to function as an indication of trade origin in relation to goods or services of the kind specified in the application for registration that is now before me.

74. It seems to me that the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin neutral (relating to the general commercial context of the relevant trading activities) rather than origin specific.”

25. In relation to the phrase MAKING PROPERTY WORK, I take the view that it would likely be perceived by the average consumer as being origin neutral rather than origin specific. Moreover, when viewed in the context of all the goods or services contained in the application, the mark would be perceived merely as an advertising pronouncement relating to making property work.

26. This view is underscored by the Judgment of the Court of First Instance (Second Chamber) of 5 December 2002 in relation to the mark *Real People, Real Solutions* (Case T-130/01). The court made the following observations:

“28. Furthermore, there is nothing about the term REAL PEOPLE, REAL SOLUTIONS that might beyond its obvious promotional meaning, enable the relevant public to memorise the sign easily and instantly as a distinctive trade mark for the services designated. Even if the sign were used alone, without any other sign or trade mark, the relevant public could not, in the absence of prior knowledge, perceive it other than in its promotional sense.

29. Since the relevant consumer is not very attentive if a sign does not immediately indicate to him the origin and/or intended use of the object of his intended purpose, but just gives him purely promotional, abstract information, he will not take the time either to enquire into the sign’s various possible functions or mentally to register it as a trade mark.

30. The Court therefore concludes that the sign will be perceived by the relevant public primarily as a promotional slogan, based on its inherent meaning, rather than as a trade mark.”

The mark cannot function in the prima facie as an indication of trade origin and therefore under Section 3(1)(b) of the Act I conclude that it is devoid of any distinctive character.

Conclusion

27. In this decision I have considered all documents filed by the agent, and for the reasons given the application is refused under the terms of Section 37(4) of the Act because the mark fails to qualify under Sections 3(1)(b) and (c) of the Act.

Dated this 12th day of January 2004.

Charles Hamilton
For the Registrar
the Comptroller-General