

O-023-05

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION NO 2321787

TO REGISTER A SERIES OF TWO TRADE MARKS

BY ENTIRE CONSULTANCY LIMITED

IN CLASSES 9, 16, 35, 38 AND 42

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DECISION AND GROUNDS OF DECISION

Background

1. On 24 January 2003 Entire Consultancy Limited of 2 Gayton Road, Harrow, Middlesex, HA1 2XU applied under the Trade Marks Act 1994 to register the following series of two trade marks:

SIMPLYCLICK
SimplyClick

2. Following a revision of the services in Class 35 registration is sought for the following services:

Class 09

Computer hardware and software; platform software for computer hardware; platform software for communications networks.

Class 16

Printed matter.

Class 35

Advertising; compilation of advertisements for use of web pages on the Internet; compilation directories for publishing on the Internet; provision of space on websites for advertising goods and services; on-line advisory and information services relating to the sale of professional products; the bringing together, for the benefit of others, of a variety of goods and services, enabling customers to conveniently view and purchase those goods from a general merchandise internet website; business administration services for the processing of sales made on the Internet; business information services provided on-line from a computer database or the Internet; auctioneering services.

Class 38

Telecommunication of information (including web pages), computer programs and any other data; providing user access to the Internet; providing user access to the Internet, extranets and intranets; providing user access to specially developed communication platforms, protected by secure log-ins, on the Internet; providing an on-line, interactive bulletin board for the posting, promotion, sale and resale of items via a global computer network; providing an on-line, interactive bulletin board for the collection and dissemination of statistical, quantitative and qualitative information regarding the sale and resale of items via a global computer network, extranets and intranets; telecommunications gateway services; provision of access to on-line commercial market places for conducting e-commerce; ISP services.

Class 42

Creating and maintaining websites; hosting the websites of others; creating and maintaining and on-line commercial market place for conducting e-commerce; Internet content subscription services; providing subscription access to platforms for communication on the Internet, extranets and intranets.

3. Objection was taken against the application under Sections 3(1)(b) and (c) of the Act because the mark consists of the words “Simply” and “Click” conjoined, the whole being a sign which may serve in trade to designate a characteristic of the goods and services e.g. computer software, programmes, services that are accessed by simply clicking to launch the given applications/services.

4. No objection was taken against the goods contained within the specification in Class 16. Furthermore, the objection was subsequently waived in respect of Class 9. This decision therefore relates only to the services contained within the specifications relating to Classes 35, 38 and 42.

5. A hearing was held on 21 November 2003 at which the applicant was represented by Mr Stobbs of Boult Wade Tennant, their trade mark attorneys. At the hearing the objection was maintained and Notice of Final Refusal was subsequently issued.

6. 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.

7. No evidence has been put before me. I have, therefore, only the *prima facie* case to consider.

The Law

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

“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

9. In correspondence prior to the hearing Mr Stobbs relied upon the judgement issued by the European Court of Justice 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*. In these submissions Mr Stobbs argued that as the words SIMPLY CLICK are not, in combination, the usual way of referring to the services in question then an objection under Section 3(1) of the Act is not appropriate. Following the hearing Mr Stobbs provided documentation used by the applicant showing the trade mark in use. Copies of these documents are attached at Annex A.

Decision

10. In a judgement issued by the European Court of Justice on 23 October 2003, *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM), Case - 191/01 P, (the DOUBLEMINT case), the Court gives guidance on the scope and purpose of Article 7(1)(c) of the Community Trade Mark Regulation (equivalent to Section 3(1)(c) of the Trade Marks Act). Paragraphs 28 - 32 of the judgement are reproduced below:

- “28. Under Article 4 of Regulation No 40/94, a Community trade mark may consist of signs capable of being represented graphically, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.
- 29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or rendering of the service, or other characteristics of the goods or service are not to be registered.
- 30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.

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 (see, *inter alia*, in relation to the identical provisions of article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-0000, paragraph 73).
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.”

11. Section 3(1)(c) of the Act excludes signs which may serve, in trade, to designate the kind of services or other characteristics of services. It follows that in order to decide this issue it must first be determined whether the marks designate a characteristic of the services in question.

12. In their publication entitled “Improving Communications in Education” the applicant describes the services provided under the trade marks applied for as:

“SimplyClick is a cost-effective, content management and communications system that provides the ability for schools/communities to collaborate and share information more efficiently and effectively.”

13. This publication provides information regarding the services provided by the applicant and a copy of this together with further information provided by the applicant in support of this application may be found at Annex A. Although these documents indicate that the services are focused in a particular area this is not reflected in the specifications applied for which are for services which are very wide ranging in their coverage. This application must therefore be considered in respect of all of the services applied for and not just the services reflected in these documents.

14. I must of course consider both of the marks applied for. One of these consists of the words SimplyClick where the capital letters at the start of each word defines each word quite clearly. However, the other mark is for the combination SIMPLYCLICK where all letters are in upper case and the two words are conjoined. In my view the

conjoining of the two words does little to disguise the two separate words. Both words are well known dictionary words which are in common use in the United Kingdom. This word breaks naturally into SimplyClick and this is the way that the mark would be perceived by the relevant consumer.

15. I find support for this view in the recent judgment of the European Court of Justice in the *Postkantoor* case, C-363/99 where the following view was expressed:

“5. Article 3(1)(c) of Directive 89/104 must be interpreted as meaning that a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of the characteristics of those goods or services for the purpose of that provision, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that because of the unusual nature of the combination in relation to the goods or services the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that it is now independent of its components. In the latter case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purposes of the same provision.”

16. The services for which registration is sought are all services which are available through the Internet. I note that the specifications specifically refer to this method of delivering such services in the wording of the specifications. The advertising and subsequent provision of services through the Internet is a method of conducting business which is continuously increasing.

17. A popular method of identifying a range of different organisations and individuals who provide particular services is to conduct a search of the Internet by entering key terms into the section provided by an Internet search engine. By sending this search request one is likely to receive a list, perhaps running into many pages, of web sites where the search term appears. The examiner wrote to Boult Wade Tennant on 8 May 2003 enclosing the results of a search for the words “simply click” using the Google search engine. A copy of that search result is attached at Annex B. It is clear from this that the words “simply click” are in common use as an instruction to highlight and subsequently select, from a list, a particular abstract entry in order to gain access to the full web site. That web site may contain further choices, with different pages containing different information, and again one is likely to receive an instruction to “simply click” on a particular entry in order to receive further details of that particular page. If a full Internet address is known it is not necessary to access a web site through an Internet search engine. One may simply enter the address in the appropriate section in order to gain direct access to the site. However, once access has been gained, one is again likely to be instructed to “simply click” on a variety of options in order to access further pages.

18. Mr Stobbs contends that a consumer, encountering the words SIMPLY CLICK on a computer software or a communications platform, would identify this as use of the words as a trade mark. I have, of course, waived the objection in relation to the

computer software in Class 9. The objection remains only in respect of the services applied for in classes 35, 8 and 42. In support of this Mr Stobbs provided documentation used by the applicant showing the trade mark in use (Annex A). I must, of course, consider all fair and notional use of the words and not just the manner of use provided by Mr Stobbs. These services appear to revolve around the hosting of an information site which can be accessed through the Internet. All the services listed appear to be aspects of this activity. I consider this to be an example of normal and fair use of the words SIMPLY CLICK. This appears to be use of the words SIMPLY CLICK in the same area of trade as that identified and recorded at Annex B. The words SIMPLY CLICK are words in everyday use on a large number of web sites to indicate the ease with which access may be gained to particular information. I do not accept that the applicant is in a different position to every other provider of services through the Internet. The words in question are well known and their meaning is immediately apparent and understood. The applicant provides information which is easy to access. One simply has to "click" on a particular abstract entry, or other entry, in order to gain access to that and any subsequent information. In other words one has to "simply click" in order to gain access to any particular services.

19. Consequently, I have concluded that the marks applied for consist exclusively of signs which may serve, in trade, to designate the kind of services and are, therefore, excluded from registration by Section 3(1)(c) of the Act.

20. Having found that these marks are to be excluded from registration by Section 3(1)(c) of the Act, that effectively ends the matter, but in case I am found to be wrong in this decision, I will go on to determine the matter under section 3(1)(b) of the Act.

21. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in *Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

- "37. It must first of all be observed that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.
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39. Next, pursuant to the rule 1 Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.
40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see Philips, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and *circumspect* (*see Case C-210/96 Gut Springenheide and Tusky [1998] ECR I-4657*, paragraph 31, and *Philips*, paragraph 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

22. In order to achieve registration I acknowledge that there is no requirement for a trade mark to possess a specific level of linguistic or artistic creativity or imaginativeness. I must determine whether the trade marks applied for are capable of enabling the relevant consumer of the services in question to identify the origin of the services and thereby to distinguish them from other undertakings. In OHIM v SAT.1 (Case C-329/02) the European Court of Justice provided the following guidance at paragraph 41:

“41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings.”

23. For the same reasons that I found these trade marks to be excluded by the provisions of Section 3(1)(c) of the Act I have concluded that the relevant consumer of the services in question would not consider these marks to denote trade origin. The average consumer of web based services will, upon encountering the words SIMPLY CLICK on a web page, perceive them as no more than an invitation to use their mouse to navigate through the site. That is why it will not be seen as a badge of origin. I am not persuaded that the trade marks applied for are sufficient, in terms of bestowing distinctive character on the sign as a whole, to conclude that it would serve, in trade, to distinguish the services of the applicant from those of other traders.

24. I have concluded that the marks applied for will not be identified as trade marks without first educating the public that they are trade marks. I therefore conclude that the marks applied for are devoid of any distinctive character and are thus excluded from *prima facie* acceptance under Section 3(1)(b) of the Act.

Conclusion

25. In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) and 3(1)(c) of the Act.

Dated this 24th day of January 2005

**A J PIKE
For the Registrar
The Comptroller-General**

ANNEX A

ANNEX B