BLO/0428/23

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO.3753699

IN THE NAME OF THE HARWELL SCIENCE AND INNOVATION CAMPUS GENERAL PARTNER LIMITED

TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 36, 41 and 42: ADVANCED RESEARCH CLUSTERS

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF M. JEFFERISS (O/121/23) DATED 3 FEBRUARY 2023.

DECISION

Introduction

1. This is an appeal by The Harwell Science and Innovation Campus General Partner Limited ("**Harwell**") from decision O121/23 of Mr M. Jefferiss ("**Decision**") whereby he refused to allow Trade Mark Application No. 3753699 ("**Application**") to proceed to grant in respect of the services applied for in Classes 41 and 42, on the basis that the mark did not satisfy s. 3(1)(b) and (c) of the Trade Marks Act 1994 ("**the Act**"), in respect of the refused services.

2. The background is as follows. On 11 February 2022 Harwell applied to register the words 'ADVANCED RESEARCH CLUSTERS' for the following services:

   Class 36
   Real estate affairs; real estate management; leasing of real estate; rental of offices (real estate); leasing of office space; rental of offices for co-working; property management; rental of real estate; land leasing; leasing and rental of commercial premises; leasing of property; building leasing; providing information, advisory and consultancy services in relation to the aforesaid management.

   Class 41
   Education; providing of training; providing educational services; organisation of meetings and conferences; arranging and conducting of commercial, trade and business conferences; arranging and conducting conferences and seminars; arranging, conducting and organisation of conferences, seminars and symposiums; conference services. providing information, advisory and consultancy services in relation to the aforesaid management.

   Class 42
   Scientific advisory services; technical advice and consultancy services; technological advisory services; laboratory services; scientific laboratory services; research services; technological research; engineering research; scientific research; biological research; research laboratory services; planning [design] of buildings; providing information, advisory and consultancy services in relation to the aforesaid management.

3. The examiner objected to all the services under section 3(1)(b) and (c) of the Act 1994. Harwell requested an ex-parte hearing, which took place on 13 September 2022, following which the objection was waived against the Class 36 services, but maintained against all the Class 41 and 42 services.

4. On 21 December 2022, the representative filed a form TM5 requesting a full statement of reasons for the refusal of the application. The representative also requested to reduce the specification so that this appeal only relates to the following services:

Class 41
Education (other than university education); providing of commercial, trade and business training; providing educational services (other than university educational services); organisation of commercial, trade and business meetings ~~and conferences~~; arranging and conducting of commercial, trade and business conferences; arranging and conducting conferences and seminars; arranging, conducting and organisation of conferences, seminars and symposiums; conference services. providing information, advisory and consultancy services in relation to the aforesaid management.

Class 42
Scientific advisory services; technical advice and consultancy services; technological advisory services; laboratory services; scientific laboratory services; ~~research services; technological research; engineering research; scientific research; biological research~~; research laboratory services; planning [design] of buildings; providing information, advisory and consultancy services in relation to the aforesaid management.

5. The statement of reasons was provided on 3 February 2023. On 2 March 2023 Harwell filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

The Hearing Officer's decisions

6. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):

   a. Whereas RESEARCH CLUSTERS is not a term defined in any dictionary, a Google search reveals that RESEARCH CLUSTERS "is a known term which refers to a group of researchers that undertake research". In any case, the meaning of the words would be clear to the average consumer.

   b. ADVANCED means "being beyond the elementary or introductory". Accordingly, the average consumer would understand the application as a description that the services are provided by, or for research clusters which are advanced.

   c. In relation to class 36, the application does not designate any characteristic of these services in this class because a research cluster would not require any particular property and the services are not services associated with a research cluster.

   d. In relation to class 41, the average consumer would see the application as being "a description that the educational services are provided by research clusters which are more advanced than others".

e. In relation to class 42, all of the services incorporate research and "the average consumer would perceive the mark as a description that all the services in Class 42 are provided by research clusters which are advanced, rather than a badge of trade origin".

Grounds of Appeal

7. In its Grounds of Appeal, Harwell made the following criticisms of the Decision:

   a. The Hearing Officer made an error of law and/or manifest error of fact in relation to (i) the identity and/or (ii) the perception of the average consumer;

   b. In doing so the Hearing Officer made an error of law and/or manifest error of fact as to the meaning and distinctiveness of ADVANCED RESEARCH CLUSTERS and showed clear confirmation bias;

   c. The Hearing Officer misapplied the test of distinctiveness making his decision on a broad brush, class by class, approach rather than on an item by item basis, as he should have.

   d. In all the circumstances, this is not a decision which a reasonable Hearing Officer could have reached.

8. Harwell's representative, Mr Wood, filed a skeleton argument in relation to the above, and expanded upon his arguments at the hearing. Natalie Morgan, on behalf of the Registrar, similarly filed a skeleton argument but did not attend the hearing. I set out below further details of the parties' arguments as are necessary to understand my overall conclusions. Both representatives made clear and helpful written and (in the case of Mr Wood) oral submissions, which were of considerable assistance to me.

Standard of review

9. The approach to be adopted in an appeal hearing has been laid down a number of times in case law, both in general terms (e.g. by the Supreme Court in *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671) and specifically in relation to appeals before the Appointed Person (Daniel Alexander Q.C. sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17), approved by Arnold J in *Apple Inc. v Arcadia Trading Limited* [2017] EWHC 440 (Ch)). These cases establish the following principles:

   - Appeals to the appointed person are by way of review, not re-hearing;
   - It is necessary for the appellant to satisfy the appeal tribunal that there was a distinct and material error of principle in the Hearing Officer's decision, or that the Hearing Officer was wrong;
   - The decision will be "wrong" if the Hearing Officer makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate tribunal would be justified in concluding that the decision of the Hearing Officer was wrong if the conclusion was "outside the bounds within which reasonable disagreement is possible";
   - In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a

misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it;

- In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation;

- Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be 'clearly' or 'plainly' wrong to warrant appellate interference but mere doubt about the decision will not suffice;

- The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account.

10. I shall bear all the above in mind when reviewing the Decision.

Discussion

11. Looking at the various grounds of appeal in turn, my analysis is as follows. I address grounds (a) and (b) together, for reasons which I will make clear.

Ground (a): The Hearing Officer made an error of law and/or manifest error of fact in relation to (i) the identity and/or (ii) the perception of the average consumer;

Ground (b): The Hearing Officer made an error of law and/or manifest error of fact as to the meaning and distinctiveness of the Application ADVANCED RESEARCH CLUSTERS and showed clear confirmation bias

12. The Hearing Officer reached the following conclusion at paragraph 23 of the Decision:

> "*In my view the three words would create an obvious meaning in the minds of consumers. The words are in a grammatically correct sequence. The term 'research cluster' is more than likely in my opinion to convey descriptive meaning, notwithstanding that the 'research cluster', in the eyes of the consumer, could be a group of individual researchers or bodies of some sort. The word 'cluster', on a purely linguistic level, would encompass both and also conveys the notion of being 'like-minded' or similar. The term 'advanced' does not have an individualising effect on the mark as a whole as, in my opinion, it is purely adjectival, describing the research clusters as being advanced.*"

13. The Hearing Officer had undertaken Google searches, which revealed that RESEARCH CLUSTER is a term used by a number of universities. It seems that he did not find any uses of the term ADVANCED RESEARCH CLUSTER. At paragraph 24, in relation to those searches, he said "*Based on my linguistic analysis alone above, the particular examples of use of the term 'research cluster' in the Annex are, in effect, purely illustrative. For the benefit of any doubt, even without them I would have arrived at the same conclusion through linguistic analysis alone*".

14. I agree with the Hearing Officer's approach and conclusion in this regard. Of course, a search to determine whether a phrase contained within an application is in common usage is an obvious step to take. However, in this specific instance, the results of such a search are not determinative, or even strictly necessary as regards distinctive character, which can be assessed on a purely linguistic basis.

15. The only issue on which I differ from the Hearing Officer is the precise meaning of the phrase ADVANCED RESEARCH CLUSTER. The Hearing Officer appears to conclude, at paragraph 23, that the word "ADVANCED" relates to the clusters themselves. I regard a more natural reading as being that the word "ADVANCED" relates to the research being conducted in the clusters.

16. In summary, therefore, the position is as follows:

- Each of the words ADVANCED, RESEARCH and CLUSTERS is an ordinary English word, with a clear meaning.
- The term ADVANCED RESEARCH CLUSTERS is an ordinary, grammatically correct phrase, in which each word bears its ordinary meaning.
- The phrase would be easily understood as pertaining to "advanced research provided by researchers working in groups [clusters]".

17. Harwell relies upon the decision of Geoffrey Hobbs KC, sitting as the Appointed Person in *Automotive Network Exchange* [1998] RPC 885, in which Mr Hobbs said:

> "*That brings me to the question whether the designation 'Automotive Network exchange' is too descriptive to be registrable as an unused mark. The words 'Automotive', 'Network' and 'Exchange' are individually well-adapted to describe different aspects of the operation of a private communications system providing business information for the automotive industry. Taking them one by one they appear to be clearly unregistrable for lack of the required capacity to distinguish the services of interest to the applicant from those of other suppliers. I would regard them as equally unregistrable for use in combination if I thought that people seeing and hearing the expression 'Automotive Network Exchange' would understand it to be referring to the nature or characteristics of the specified services irrespective of their trade origin. However, the expression as a whole seems to me to succeed in saying nothing in particular about business information provided by means of a private communications system. The words in question are somewhat ungrammatical (and not entirely easy to assimilate) in combination. I think that the degree of effort and analysis required to interpret them merely as a statement about the nature or characteristics of the relevant services is greater than people would normally devote to such matters when going about their everyday business.*"

18. In my view, it cannot be said that any "effort or analysis" is required to interpret the meaning of ADVANCED RESEARCH CLUSTERS. Nor are any of the words, or the overall phrase, technical, such that specialist knowledge is required to understand them. Whereas Harwell may well be

correct in saying that the average consumer is "someone with expertise in specialist University scientific research", such a person would understand the application in precisely the same way as the average member of the public.

19. Accordingly, although my conclusion as to the precise meaning of the Application differs from that of the Hearing Officer, I do not accept that the Hearing Officer erred in relation to the descriptiveness of the Application, nor do I accept that he made any error in relation to the identity and perception of the average consumer.

Ground (c): The Hearing Officer misapplied the test of distinctiveness making his decision on a broad brush, class by class, approach rather than on an item by item basis, as he should have

20. Harwell relies on the decision of the Court of Appeal in *J.W. Spear v Zynga* [2015] FSR 19, in which Floyd LJ (with whom Patten and Tomlinson LJJ agreed) analysed the law on descriptiveness and gave approval to the analysis of the Advocate General in his opinion in DOUBLEMINT [2003] ECR I-12447 at [61]–[64], in which he identified the following as the relevant question for determining whether a mark is descriptive in relation to a specific product:

> "(i) how factual and objective is the relationship between an indication and the product or one of its characteristics? (ii) how readily is the message of the indication conveyed? and (iii) how significant or central to the product is the characteristic? Asking these questions will assist a fact-finding tribunal to determine whether it is likely that a particular indication may be used in trade to designate a characteristic of goods."

21. That approach necessitates a product by product (or service by service) analysis. Looking at the services in Classes 41 and 42, it seems to me that the Hearing Officer may well have failed to look at each service individually, as is contended by Harwell. Whereas it is clear that the term ADVANCED RESEARCH CLUSTERS designates a characteristic of, say, "research services" (which has now been abandoned by Harwell in this appeal), it is not descriptive of, or even alludes to any aspect of, say, "planning [design] of buildings". The Hearing Officer should have considered each service against the meaning of the Application and made his findings accordingly.

22. Looked at another way, the Hearing Officer (correctly) decided that the Application has no meaning in relation to any of the Class 36 services (e.g. real estate affairs), but evidently decided that it did have meaning in relation to "planning [design] of buildings" in Class 42. Given that "planning [design] of buildings" has no more relevance to ADVANCED RESEARCH CLUSTERS than does "real estate affairs", I regard his decision as inconsistent in that regard.

23. Accordingly, therefore, in my view the Hearing Officer did make an error of principle in his consideration of distinctiveness against each of the services in Classes 41 and 42, which entitles me to revisit his analysis.

24. My analysis of each of the three factors in *Zynga* against each of the services in Classes 41 and 42 is summarised below.

Service	**How factual and objective is the relationship between an indication and the product or one of its characteristics?**	**How readily is the message of the indication conveyed?**	**How significant or central to the product is the characteristic?**

Education (other than university education);	Not at all.	Not at all.	Not at all.
providing of commercial, trade and business training;	Not at all.	Not at all.	Not at all.
providing educational services (other than university educational services);	Not at all.	Not at all.	Not at all.
organisation of commercial, trade and business meetings;	Not at all.	Not at all.	Not at all.
arranging and conducting of commercial, trade and business conferences;	Not at all.	Not at all.	Not at all.
arranging and conducting conferences and seminars;	Some link.	Readily.	Peripheral.
arranging, conducting and organisation of conferences, seminars and symposiums;	Some link.	Readily.	Peripheral.
conference services;	Some link.	Readily.	Peripheral.
providing information, advisory and consultancy services in relation to the aforesaid management.	Not at all.	Not at all.	Not at all.
Scientific advisory services;	Some link.	Readily.	Fairly significant and central.
technical advice and consultancy services;	Some link.	Readily.	Fairly significant and central.
technological advisory services;	Some link.	Readily.	Fairly significant and central.
laboratory services;	Strong link.	Very readily.	Very significant.

scientific laboratory services;	Strong link.	Very readily.	Very significant.
research laboratory services;	Strong link.	Very readily.	Very significant.
planning [design] of buildings;	Not at all.	Not at all.	Not at all.
providing information, advisory and consultancy services in relation to the aforesaid management.	Not at all.	Not at all.	Not at all.

25. For services such as "Education (other than university education)", the position is clear cut – the Application is not descriptive. For services such as "research laboratory services", the position is also clear, insofar as the Application is clearly descriptive.

26. For "arranging and conducting conferences and seminars", "arranging, conducting and organisation of conferences, seminars and symposiums" and "conference services", the Application has a degree of distinctiveness, insofar as the average consumer might expect that a research cluster would organise (or be involved in the organisation of) conferences and seminars. That message is readily conveyed. However, the organisation of conferences and seminars is no more than peripheral to the central activities of a research cluster. Accordingly, my conclusion is that the Application is not descriptive of these services.

27. For "Scientific advisory services", "technical advice and consultancy services" and "technological advisory services", again the average consumer might expect that a research cluster would be involved in the provision of such services. The message is readily conveyed. Furthermore, the provision of such services is at least fairly central to the normal activities of a research cluster. My conclusion is that the Application is descriptive of these services.

28. Finally, I observe that "providing information, advisory and consultancy services in relation to the aforesaid management" in Class 41, and "providing information, advisory and consultancy services in relation to the aforesaid management" in Class 42 do not appear to relate to any of the aforesaid services, in that none of them are management services. It appears to me that the use of the word "management" is an obvious mistake, and the word "services" should have been used in its place. Furthermore, if corrected, I consider that those services would be admissible in light of my conclusions as to registrability set out above. I invite Harwell to apply to amend the Application in this regard.

<u>Ground (d): In all the circumstances, this is not a decision which a reasonable Hearing Officer could have reached</u>

29. In light of the above, I have concluded that the Hearing Officer was entitled to reach his decision in respect of some but not all of the Class 42 services, but not in relation to the Class 41 services as sought to be amended.

Conclusion

30. In addition to the Class 36 services, the Application should proceed to registration in respect of:

    Class 41
    Education (other than university education); providing of commercial, trade and business training; providing educational services (other than university educational services); organisation of commercial, trade and business meetings; arranging and conducting of commercial, trade and business conferences; arranging and conducting conferences and seminars; arranging, conducting and organisation of conferences, seminars and symposiums; conference services. providing information, advisory and consultancy services in relation to the aforesaid management.

    Class 42
    Planning [design] of buildings; providing information, advisory and consultancy services in relation to the aforesaid management.

31. The Application is refused in respect of "Scientific advisory services; technical advice and consultancy services; technological advisory services; laboratory services; scientific laboratory services; research laboratory services" in Class 42.

Costs

32. It is customary in this type of case for no order as to costs to be made where an applicant's appeal is dismissed. In principle, where an appeal has succeeded at least in part, an order for costs could be made in favour of the applicant. However, in my view the fairest position is for challenges to registrability to be a costs-free forum, and accordingly I make no order as to costs.

Dr. Brian Whitehead

7 May 2023

Representation

Mr Aaron Wood of Brandsmiths for the Applicant / Appellant

Ms Natalie Morgan on behalf of the Registrar