

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO.2188098**

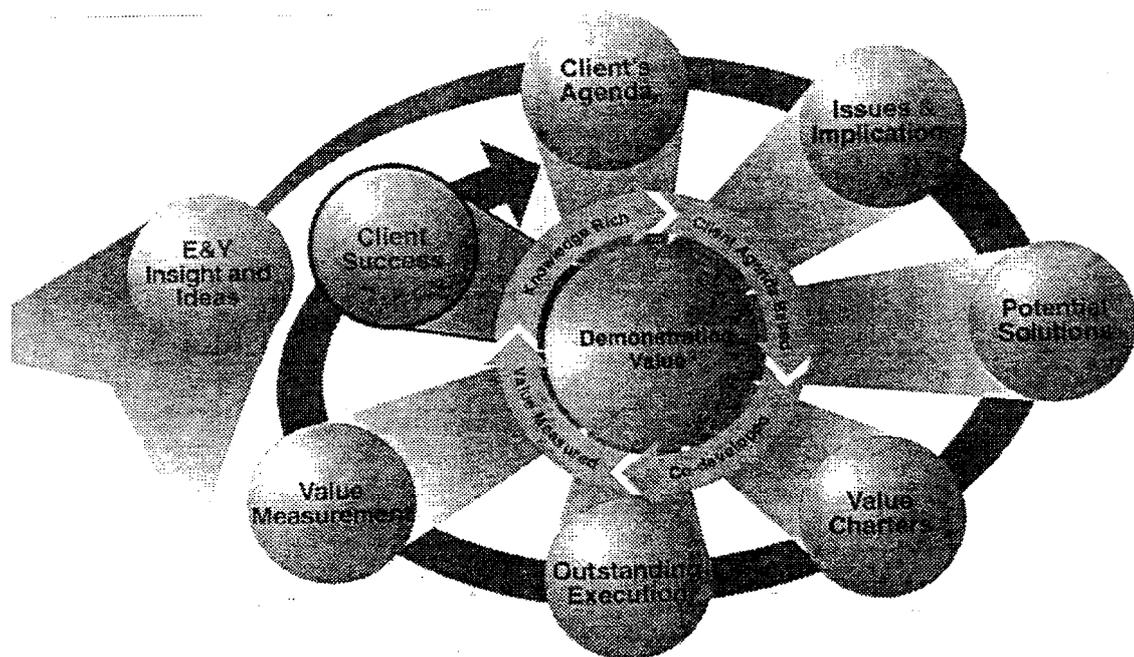
**TO REGISTER A
TRADE MARK IN CLASSES 9, 16, 35, 36, 41 & 42**

TRADE MARKS ACT

IN THE MATTER OF
APPLICATION NO. 2188098
BY ERNST & YOUNG (UK PARTNERSHIP)
TO REGISTER A TRADE MARK
IN CLASSES 9, 16, 35, 36, 41 & 42

DECISION AND GROUNDS OF DECISION

1. On 8th February 1999, Ernst & Young, a UK Partnership of Becket House, 1 Lambeth Palace Road, London SE1 7EU applied to register the trade mark shown below in classes 9, 16, 35, 36, 41 and 42.



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

Class 9:

Electrical, optical, magnetic and electronic apparatus and instruments; networking, surveying, scientific, measuring and checking apparatus and instruments; communications and security apparatus and instruments; computer hardware, software and firmware; computer software, firmware and hardware for use with computer networks; computer games software; apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting and retrieving publications, text, signals, software, information, data, code, sounds, and images; audio and video recordings; audio recordings, video recordings, music, sounds images, text, publications, signals, software, information, data and code provided via telecommunications networks, by online delivery and by way of the Internet and the world wide web; multimedia apparatus and instruments; non printed publications; educational and teaching apparatus and instruments; parts and fittings for all the aforesaid goods.

Class 16:

Printed matter and publications; books, manuals, magazines, newsletters, newspapers, pamphlets and brochures; educational and instructional materials; parts and fittings for all the aforesaid goods.

Class 35:

Advertising and promotional services; personnel and recruitment services; business and management advice, consultancy, information and research; accounting, auditing and bookkeeping; tax preparation and consulting services; data-processing services; business management consulting services in the field of information technology; provision of business information including that provided via telecommunications networks, by online delivery and by way of the Internet and the World Wide Web; advisory services in relation to all the aforesaid.

Class 36: Financial management, assistance, advice, consultancy, information and research services; tax and duty services; insolvency services; investment services; valuation services; real estate services; real estate agency and appraisal; real estate management; provision of financial information including that provided via telecommunications networks, by online delivery and by way of the Internet and the World Wide Web; advisory services in relation to all the aforesaid.

Class 41:

Education, teaching and training; organising and conducting classes, seminars, symposiums, conferences and exhibitions; publishing and electronic publishing; organising and operating games and competitions; granting of educational qualifications; educational examination services; education, teaching and training provided via telecommunications networks, by online delivery and by way of the Internet and the World Wide Web; advisory services in relation to the aforesaid.

Class 42:

Consultancy, advice, assistance, analysis, design, evaluation and programming services relating to computer software, firmware, hardware and information technology; consultancy and advice relating to the evaluation, choosing and implementation of computer software, firmware, hardware, information technology and of data-processing systems; rental and licensing of computer software, firmware and hardware; provision of information relating to technical matters, legal matters, information technology, and intellectual property, including that provided via telecommunications networks, by online delivery and by way of the Internet and the World Wide Web; legal services; legal and tax advice and representation of others in legal and tax matters; legal research; management of intellectual property; advisory services in relation to the aforesaid.

3. Objection was taken under Section 3(1)(b) of the Act because the mark consists, effectively, of a diagram such as is often used in connection with business organisation, known as an “organigram” (organisational chart).

4. A hearing was held on 3rd July 2000 at which the applicants were represented by Mr Ian Bartlett of Beck Greener, Patent and Trade Mark Attorneys. Following Mr Bartlett’s submission the objection was maintained. A further hearing was held on 30th August 2001 concerning an extension of time issue. The application was subsequently refused on 9th October 2001 in accordance with Section 37(4) of the Act.

5. 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.

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

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

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

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

8. The test for distinctiveness was laid down by Mr Justice Jacob in the British Sugar PLC and James Robertson and Sons Ltd (TREAT) decision (1996) RPC 281, in which he said:

“What does devoid of distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?”

9. At the hearing held on 30th August 2001, Mr Bartlett described the mark as a “medium complex logo”. Mr Bartlett observed that the objection against the mark being devoid of any distinctive character was difficult to reply to since it was so obviously distinctive. There were many marks accepted on a weekly basis by the registrar which were complex in design but were nevertheless distinctive.

4

10. I made it clear that I doubted that the mark would be recognised by the public as a badge

of trade origin and referred to the comments made by Justice Jacob as detailed under paragraph 8 above. However, in order to give the applicant the opportunity to show how the mark was being used (or proposed to be used), I suspended the application for a period of three months to allow time for the filing of evidence under Rule 57 of the Trade Marks Rules 2000. Rule 57 reads as follows:

At any stage of any proceedings before the registrar, she may direct that such documents, information or evidence as she may reasonably require shall be filed within such period as she may specify.

11. Despite over 14 months elapsing from the date of the substantive hearing to the issue of the notice of refusal, no evidence was filed. Whilst I acknowledge that during this period there were organisational changes taking place in the applicants' business which inevitably led to delays, it is difficult to understand why it was not possible within this timescale to obtain any documentation showing the mark in use, or at least how it was proposed to be used.

12. I have, therefore, to consider whether the mark tendered for registration is, assuming no use, a sign which cannot do the job of distinguishing without first educating the public that it is a trade mark.

13. The mark applied for consists of a logo device of an arrow combined with various phrases contained within or peripheral to circles. A spoke appears to radiate from a larger central circle. Except for the element "E & Y Insight and Ideas", it is clear that the remaining individual parts which make up the mark possess no distinctive character. Whilst the element "E & Y Insight and Ideas" might be registrable in itself (although being low in distinctive character), when placed in the context of this complex mark what trade mark impact it possesses is lost within the totality. Similarly the arrow, circles and spoke logos are overwhelmed by non-distinctive matter.

14. I am, of course, bound to consider the mark as a whole and whilst it is clear that a combination of non-distinctive elements may create a combination which is distinctive in totality, I do not accept that this is the position with this sign. As an unused mark, it merely depicts a complex chart or diagram which might be used to educate, inform or to promote business processes, aims, ideas and the like. From my own knowledge these sorts of diagrammatical signs are commonly used in the business field and the relevant public is accustomed to interpreting them as imparting a methodology or set of values. I do not see that there is anything in this sign which would serve to distinguish any of the applicants' goods or services from those of other traders.

15. Whilst it is not "incapable of distinguishing" in the sense of being debarred from registration under Section 3(1)(a) of the Act, before such a sign might become eligible for registration, it must not merely be distinguishable from other charts or diagrams but must also have to acquire a distinctive character as a trade mark. I therefore conclude that for the reasons stated above, the mark is debarred from prima facie acceptance by Section 3(1)(b) of the Act.

16. 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.

Dated this 8th day of February 2002.

Charles Hamilton
For the Registrar
the Comptroller General