

O-071-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 2517065

BY GREEN BULLION FINANCIAL SERVICES, LLC

TO REGISTER THE FOLLOWING TRADE MARK

IN CLASSES 35 AND 40:

CASH4GOLD

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION 2517065 TO REGISTER THE TRADE MARK 'CASH4GOLD' BY GREEN BULLION FINANCIAL SERVICES, LLC IN CLASSES 35 AND 40

DECISION AND GROUNDS OF DECISION

Background

1. On 28 May 2009, Green Bullion Financial Services, LLC applied to register trade mark application number 2517065, consisting of the mark 'CASH4GOLD'.
2. Registration was sought in respect of the following services:
 - Class 35: Scrap dealership, namely, purchase of scrap gold, silver, platinum.
 - Class 40: Precious metal recycling and refining services.
3. On 9 June 2009, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In the report, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act') on the basis that the mark was devoid of any distinctive character in relation to all of the services claimed. The examiner noted that the mark consists exclusively of the phrase CASH4GOLD being a sign which may serve in trade to designate a characteristic of the services, e.g. dealership and recycling services whereby gold products are exchanged for cash and may be subject to recycling or refinement.
4. A period of two months from the date of the examination report was given for reply (up to 9 August 2009), with IPO confirming that the application would be refused if there was no reply by the relevant date requested.
5. On 13 July 2009 a letter was submitted by Marks & Clerk LLP acting on behalf of the applicant requesting an *ex parte* hearing.
6. A telephone hearing was held on 10 December 2009 at which the applicant was represented by Mr Newell of Marks & Clerk. At the hearing, Mr Newell stated that the method of providing the services was unusual in as much as the consumer is selling gold to the provider in exchange for cash. He acknowledged that he was aware the term 'Cash for gold' is widely used in this field but felt that the addition of the numeral '4' in place of the word 'for' was not commonplace, and gave the

mark when viewed as a whole the minimum degree of distinctiveness as outlined in the decision of the General Court (formerly the Court of First Instance) *IVG Immobilien AG v OHIM*, T-441/105, paragraph 42. I was advised that the word-only mark 'CASH4GOLD' had been accepted in Canada, Japan and at the Community Trade Mark Office ('OHIM'), and that IPO had previously accepted the marks CASH4YOU, CASH4HEALTH and CALL4CASHDIRECT all with minimal stylisation.

7. In response to these submissions, I advised Mr Newell that the mark constitutes a clear reference to the services offered i.e. it describes the process of providing cash in return for gold. In addition to being objectionable for the scrap dealership services in class 35, I also confirmed that the sign denoted the recycling and refining services in class 40. I explained that use of the numeral '4' in place of the word 'for' is commonplace in advertising in a number of fields and is not sufficiently unusual to add the necessary spark of distinctiveness to the mark. Whilst acknowledging the previous acceptances quoted by the agent, I also emphasised that I was bound to consider this case on its own individual merits (*Madam* case (1966) RPC page 545 as re-stated by Mr Justice Jacob in the *Treat* case (1996) RPC page 25). The objection was consequently maintained at the hearing in relation to all of the services claimed under both classes 35 and 40.
8. An initial period of 2 months was given at the hearing for the agent to consider filing evidence in support of a claim to acquired distinctiveness. Further extensions of time were then granted until 10 April 2010 in order for the collation and compilation of such evidence.
9. In a letter dated 7 April 2010, the agent signalled his intention to appeal by requesting that the application be formally refused (no evidence was ever filed). Notice of refusal was issued on 9 April 2010 and a Request for a Statement of Reasons for Registrar's Decision was received from the agent on 6 May 2010.
10. I am now asked under section 76 of the Act and Rule 69(2) of the Trade Mark Rules (2008) to state in writing the grounds of my decision and the materials used in arriving at it. No formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, in respect of the services listed at paragraph 2 above, I have only the *prima facie* case to consider.

The applicant's case for registration

11. All arguments in support of *prima facie* acceptance were presented in the form of oral submissions made at the *ex parte* hearing on 10 December 2009. At the hearing, Mr Newell stated that the distinctive character of the mark must be assessed firstly by reference to the services for which registration is sought, and secondly by reference to the perception of the section of the public targeted,

which is composed of the consumers of those services (*Quick Restaurants SA v OHIM*, T-348/02, paragraphs 32 and 33 refer). He stated that the method of providing the services was unusual as the consumer is selling gold to the provider in exchange for cash. Mr Newell accepted that the term 'Cash for gold' is widely used and was likely to be objectionable. However he believes that the mark filed as 'CASH4GOLD' is not totally devoid of *any* distinctive character as the use of the numeral '4' in place of the word 'for' is unusual in this field, and is sufficient to give the mark when viewed as a whole the minimal degree of distinctiveness.

The Law

12. 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,

13. The above provisions mirror Article 3(1)(b) and (c) of the First Council Directive 89/104 of 21 December 1988. The proviso to section 3 is based on the equivalent provision of article 3(3).

Relevant authorities – general considerations

14. The European Court of Justice (ECJ) has repeatedly emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (*Bio ID v OHIM*, C-37/03P, paragraph 59 and the case law cited there and more recently, *Celltech R&D Ltd v OHIM*, C-273/05P).

15. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. Also, in relation to section 3(1)(b) (and the equivalent provisions referred to above) the Court has held that “...the public interest ... is, manifestly, indissociable from the essential function of a trade mark” (*SatellitenFernsehen GmbH v OHIM*, C-329/02P)).

16. The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function. Section 3(1)(c) on the other hand pursues an aim which reflects the public interest in ensuring that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM (Doublemint)*, C-191/01P, paragraph 31 refers.

17. In terms of the relationship as between sections 3(1)(b) and (c), a mark which is subject to objection under section 3(1)(c) as designating a characteristic of the relevant goods or services will, of necessity, also be devoid of distinctive character under section 3(1)(b) – see to that effect paragraph 86 of *Koninklijke KPN Nederland NV v Benelux – Merkenbureau (Postkantoor)*, C-363/99. But plainly, and given the public interest behind the two provisions, they must be assessed independently of each other as their scope is different, that is to say that section 3(1)(b) will include within its scope marks which, whilst not designating a characteristic of the relevant goods and services, will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin.

Section 3(1)(c)

18. There are now a number of judgements from the ECJ which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), whose provisions correspond to section 3(1)(c) of the UK Act. In terms of the issues before me in this case I derive the following main guiding principles from the case noted below:

- subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (*Doublemint*, paragraph 30);
- there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics (*Ford MotorCo v OHIM*, Case T-67/07);

- a sign's descriptiveness may only be assessed, first, in relation to the goods or services concerned and, secondly, in relation to the perception of the target public, which is composed of the consumers of those goods or services (*Ford Motor Co v OHIM*);
- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word "exclusively" in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question -(*Postkantoor*, paragraph 57);
- it is in principle irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary -(*Postkantoor*, paragraph 102).

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

20. In seeking to identify the relevant consumer in this case, it is reasonable to assume that the services, which are of a non-technical nature, will be used by the public at large. The provision of services relating to the exchange of gold for cash are likely to be offered through the means of advertisements on television, the internet, or by other means, and are likely to be targeted towards average householders who may have a small amount of jewellery in their possession. In such a context, the average consumer is likely to display only an average level of attention when considering the purchase. Similarly, the services of recycling and refining of precious metals are likely to be promoted by the same means as an additional aspect of the core services – namely that once the gold (or other metal) has been exchanged for cash, it will then be subject to recycling, refinement or re-sale.

21. In assessing the mark as filed, it is useful to first consider the phrase 'cash for gold' *without* the misspelling. By determining how descriptive or otherwise the phrase is when spelt conventionally, I will be better able to reasonably assess (i) the level of impact created by use of the numeral '4' as a replacement for the word 'for' (i.e. as occurs in the mark); and (ii) the mark's aural identity as filed (where the numeral '4' is phonetically identical to the word 'for'). The relevant consumer is likely to be aware of the current popularity for gold exchange pawnshop-type businesses, due to the increase in the price of gold, which are now advertised fairly extensively on national television, and are often found in the form of kiosk-type outlets in busy shopping malls. Assessed in that context, the

phrase 'cash for gold' directly describes a facility whereby gold is bought from an individual in exchange for cash - services such as those provided by the aforementioned outlets - and therefore in its normal/conventional spelling, I would have little doubt that the consumer would understand the descriptive message. I appreciate that gold may not be the only metal offered for sale, but as silver and platinum are so closely associated with gold the mark is equally as descriptive in relation to services associated with these metals. The remaining services of 'recycling and refining of precious metals' are likely to be provided in conjunction with the core services of exchanging 'cash for gold' and as such, the mark is likely to be as descriptive when used in relation to these closely allied services (*Fourneaux De France* BL O/240/02 refers).

22. Consideration must also be given to the impact on the average consumer of replacing the word 'for' in 'cash for gold' with the numeral '4' to read the mark as filed i.e. CASH4GOLD. In order to make the mark as filed distinctive the addition of the surplus element (i.e. the numeral '4') would have to be sufficiently unusual to give the mark in its entirety the required degree of distinctiveness. However, use of the numeral '4' in place of the word 'for' is commonplace in a number of closely related fields including the provision of cash, mortgages and insurance in order to advertise/promote the services (see annexes 1 to 3 attached to this statement, all of which use the numeral 4 in this manner). Therefore, its presence in the mark does nothing more than inform the average consumer of the same descriptive message as the words 'cash for gold'. It does not serve to mask, disguise or dilute the descriptive message likely to be perceived by the average consumer of such services.

23. The criteria for accepting this mark seem equitable to those conditions set out in *Hormel Foods Corp v Antilles Landscape Investments NV (Spambuster 2005 RPC 28)* where Richard Arnold QC stated at paragraph 148 that 'despite the fact that a mark may consist of a particular visual representation of the prohibited sign out of the many possible visual representations that mark still remains wholly descriptive'. At paragraph 150 of the decision, Mr Arnold went on to say that 'the test under section 3(1)(c) is whether the mark propounded for registration consists of one or more descriptive signs. If it does then registration is precluded in the public interest. If the mark is not a word *per se* then the question is whether or not the visual elements take the sign out of the realms of section 3(1)(c)'. I appreciate that the mark as filed has a particular visual presentation, with the numeral '4' being placed between the words 'cash' and 'gold' to replace the word 'for' but find this element of visual presentation has such little effect that the mark in totality is unlikely to be seen as anything other than a wholly descriptive message. It must therefore fall foul of Section 3(1)(c).

24. Having found that this mark is to be excluded from registration by section 3(1)(c) of the Act, that effectively ends the matter. However, in case I am found to be wrong in this decision, I will go on to determine the matter under section 3(1)(b).

Section 3(1)(b)

25. In relation to section 3(1)(b) it was held in *Postkantoor* that:

“86. In particular, a word mark which is descriptive of characteristics of 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 services for reasons other than the fact that it may be descriptive.”

26. I approach this ground of objection on the basis of the following principles derived from the ECJ cases referred to 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 72-77);
- 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*).

27. The specific services in Class 35 are ‘Scrap dealership namely purchase of scrap gold, silver, platinum’ and the mark when used in relation to these services gives

a direct message to the average consumer that gold, silver, platinum is exchanged for cash. I do not feel that the mark possesses the inherent capability to distinguish one traders services from another as required under section 3(1)(b) of the Act because it is unlikely to be perceived as originating from a single undertaking because of its direct association with the services being offered.

28. The specific services claimed in class 40 are 'precious metal recycling and refining services' and the mark when used in relation to the services is likely to indicate to the average consumer that the gold exchanged for cash is to be recycled or refined. I do not feel that the mark possesses the inherent capability to distinguish one traders services from another as required under section 3(1)(b) of the Act because it is unlikely to be perceived as originating from a single undertaking because of its direct association with the services being offered.

29. I believe that the mark would not be capable of performing the essential function of a trade mark without the relevant public being educated into seeing it that way. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from *prima facie* acceptance under Section 3(1)(b) of the Act.

Conclusion

30. In this decision I have considered all of the documents filed by the applicants, and all of the arguments submitted to me in relation to this application. 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 24 day of February 2011

**Dave Evans
For the Registrar
The Comptroller-General**

ANNEX 1 - SPARE CASH 4 YOU

<http://www.sparecash4you.com/>

ANNEX 2 – MORTGAGE 4U

<http://mortgage4u.co.uk>

ANNEX 3 – EASY INSURANCE 4 YOU

<http://www.easyinsurance4you.co.uk/about.htm>

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Mortgages - The actual rate available will depend upon your circumstances ask for a personalised illustration. The overall cost for comparison is 8.6% APR subject to plan chosen.

Annex 3

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- Car & Bike
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If you have any queries please contact:-
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