

O-093-08

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2462651D  
BY HAMMERSON PLC  
TO REGISTER A TRADE MARK IN CLASS 35**

## BACKGROUND

1. On 30 July 2007, Hammerson Plc of 10 Grosvenor Street, London W1K 4BJ (“the applicant”) applied to register trade mark number 2462651 under the provisions of the Trade Marks Act 1994. The mark applied for consists of the words “EDEN QUARTER”.

2. The mark was originally applied for in respect of a range of goods and services in classes 06, 16, 18, 25, 26, 27, 28, 35, 36, 37, 38, 39, 41, 42, 43, 44 and 45. The class 35 specification presented on the original application form listed the following services:

Class 35      Operation and administration of commercial premises, offices, retail and leisure units, retail and leisure complexes, shopping malls, shopping arcades, shopping centres and retail parks; the bringing together for the benefit of others of a variety of retail outlets, housing, business, entertainment, leisure and retail services, in a mixed-use development environment; the bringing together for the benefit of others, of a variety of retail outlets, entertainment, restaurant and other services, enabling customers to conveniently view and purchase goods and services and make use of such facilities in a shopping centre or mall; the bringing together for the benefit of others of a variety of retail outlets connected with one or more of the following types of goods, namely, beauty products, toiletries, medicines, health and healthcare products and equipment, household goods, homeware, pet products, car care products, machines for household use, hand tools, gardening tools and accessories, optical goods, cameras, domestic electrical and electronic equipment, including white goods, jewellery, clocks, watches, musical instruments, stationery, publications, artists' materials, CDs, DVDs, leather goods, luggage, travel accessories, furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headwear, haberdashery, toys and games, sports equipment, foodstuffs, drinks and tobacco products, and a variety of entertainment, restaurant and other services, enabling customers to conveniently view and purchase goods and services and make use of such facilities in a shopping centre or mall; the bringing together for the benefit of others, of a variety of goods, namely, beauty products, toiletries, medicines, health and healthcare products and equipment, household goods, homeware, pet products, car care products, machines for household use, hand tools, gardening tools and accessories, optical goods, cameras, domestic electrical and electronic equipment, including white goods, jewellery, clocks, watches, musical instruments, stationery, publications, artists' materials, CDs, DVDs, leather goods, luggage, travel accessories, furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headwear, haberdashery, toys and games, sports equipment, foodstuffs, drinks and tobacco products, enabling customers to conveniently view and purchase those goods within retail stores located in a shopping centre or mall; department store services in connection with the sale of beauty products, toiletries, medicines, health and healthcare products

and equipment, household goods, homeware, pet products, car care products, machines for household use, hand tools, gardening tools and accessories, optical goods, cameras, domestic electrical and electronic equipment, including white goods, jewellery, clocks, watches, musical instruments, stationery, publications, artists' materials, CDs, DVDs, leather goods, luggage, travel accessories, furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headwear, haberdashery, toys and games, sports equipment, foodstuffs, drinks and tobacco products and retail store services provided by stores connected with one or more of the foregoing types of goods; the bringing together, for the benefit of others, via the Internet, of a variety of goods, namely, beauty products, toiletries, medicines, health and healthcare products and equipment, household goods, homeware, pet products, car care products, machines for household use, hand tools, gardening tools and accessories, optical goods, cameras, domestic electrical and electronic equipment, including white goods, jewellery, clocks, watches, musical instruments, stationery, publications, artists' materials, CDs, DVDs, leather goods, luggage, travel accessories, furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headwear, haberdashery, toys and games, sports equipment, foodstuffs, drinks and tobacco products, and of a variety of services, namely, financial services and telecommunications services through a virtual shopping mall, enabling customers to conveniently view and purchase those goods and services by means of telecommunications; electronic shopping retail services connected with the sale of beauty products, toiletries, medicines, health and healthcare products and equipment, household goods, homeware, pet products, car care products, machines for household use, hand tools, gardening tools and accessories, optical goods, cameras, domestic electrical and electronic equipment, including white goods, jewellery, clocks, watches, musical instruments, stationery, publications, artists' materials, CDs, DVDs, leather goods, luggage, travel accessories, furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headwear, haberdashery, toys and games, sports equipment, foodstuffs, drinks and tobacco products; business administration; office functions; provision of a help desk services for managed premises in the nature of business administration to provide assistance in relation to fault reporting, enquiries, facility maintenance requests, pool car administration and management, security, contact management and other reception services; rental of office equipment; provision of information over the Internet about retail opportunities; advertising; public relations services; arranging commercial partnerships and sponsorships for advertising purposes; business consultancy; consultancy relating to sales promotions; rental of vending machines; personnel recruitment; employment counselling and recruitment; employment agency services; shop window dressing; the provision of information and advice to prospective purchasers of goods; advisory services in relation to customer services.

3. An examination report was issued on 23 August 2007, in which objections under section 5(2) of the Trade Marks Act 1994 were raised against classes 16, 18, 25, 28, 35, 36, 37, 38, 41, 43 and 44. Additionally, objections under section 1(1) of the Trade Marks Act 1994 and rule 8(2)(b) of the Trade Marks Rules 2000 (as amended) were raised against some of the terms claimed in Class 35.

4. On 24 September 2007, the agent instructed the examiner to divide the application into two parts – the first (2462651A) covering all goods and services *except* those subject to the section 1(1) and rule 8(2)(b) objections, and the second (2462651B) limited solely to those class 35 terms which did face such objections.

5. The examiner responded by dividing the mark as requested. Having actioned this request and created two ‘new’ applications, the agent then submitted a letter dated 12 October 2007 requesting that application number 2462651B itself be divided into a further two applications.

6. As a result, application number 2462651D (which is the subject of this decision) was created in respect of the following specification:

Class 35        The bringing together for the benefit of others of a variety of retail outlets, entertainment, restaurant and other services, enabling customers to conveniently view and purchase goods and services and make use of such facilities in a shopping centre or mall; the bringing together for the benefit of others, of a variety of retail outlets connected with one or more of the following types of goods, namely, beauty products, toiletries, medicines, health and healthcare products and equipment, household goods, homeware, pet products, car care products, machines for household use, hand tools, gardening tools and accessories, optical goods, cameras, domestic electrical and electronic equipment, including white goods, jewellery, clocks, watches, musical instruments, stationery, publications, artists' materials, CDs, DVDs, leather goods, luggage, travel accessories, furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headwear, haberdashery, toys and games, sports equipment, foodstuffs, drinks and tobacco products, and a variety of entertainment, restaurant and other services, enabling customers to conveniently view and purchase goods and services and make use of such facilities in a shopping centre or mall; the bringing together, for the benefit of others, via the Internet, of a variety of goods, namely, beauty products, toiletries, medicines, health and healthcare products and equipment, household goods, homeware, pet products, car care products, machines for household use, hand tools, gardening tools and accessories, optical goods, cameras, domestic electrical and electronic equipment, including white goods, jewellery, clocks, watches, musical instruments, stationery, publications, artists materials, CDs, DVDs, leather goods, luggage, travel accessories, furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headwear, haberdashery, toys and games, sports equipment, foodstuffs, drinks and tobacco products, and a variety of services, namely, financial services and telecommunications services, through a virtual

shopping mall, enabling customers to conveniently view and purchase those goods and services by means of telecommunications.

7. Via a telephone conversation on 31 October 2007, the agent informed the examiner that she did not intend to address the section 1(1) and rule 8(2)(b) objections by way of further correspondence. She also confirmed her intention to submit a request for a statement of reasons for the Registrar's decision (form TM5) following formal refusal.

8. With the class 35 terms being deemed unacceptable pursuant to section 1(1) and rule 8(2), and with the agent confirming her decision *not* to provide any further clarification, the examiner was left with little option but to formally refuse the application under section 37(4) of the Trade Marks Act 1994.

9. A formal notice of refusal was issued on 31 October 2007. The Registrar then received a form TM5 dated 5 November 2007. As a result of accepting this form, I am now required under section 76 of the Act and rule 62(2) of the Rules to state in writing the grounds of the Registrar's decision and the materials used in arriving at it.

## **DECISION**

10. The agent did not present any written submissions on this case, so I have no counter argument to address. In making my decision, I shall seek to expand upon the office's reasons for raising objections under section 1(1) and rule 8(2)(b) with reference to relevant case law where appropriate.

11. The grounds for objection to the application are under the terms of rule 8(2) of the Trade Marks Rules 2000. If the objection raised under this section of the secondary legislation was not justified, then final refusal of the mark under section 37(4) of the Trade Marks Act 1994 should not have been issued.

12. Rule 8(2) of the Trade Marks Rules 2000 reads as follows:

8. – (2) Every application shall specify –

(a) the class in Schedule 4 to which it relates; and

(b) the goods or services which are appropriate to the class and they shall be described in such a way as to indicate clearly the nature of those goods or services and to allow them to be classified in the classes in Schedule 4.

13. In the context of rule 8(2), which confirms the obligation on the part of the applicant to provide specifications which clearly indicate and describe the goods and/or services intended for coverage, reference must also be made to section 37(4) of the Act which states the following:

37. - (4) If the applicant fails to satisfy the registrar that those requirements [for registration] are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse to accept the application.

14. In its introductory paragraphs under section 1(1), the Act confirms the minimum criteria required for a sign to be considered a trade mark by stating that it must be “capable of being represented graphically” and, more significantly in this case, that it must be “capable of distinguishing goods or services of one undertaking from those of other undertakings”. It is implicit in this statement that, in order for any mark to be capable of distinguishing goods or services, one must be aware of what those goods or services actually are. The examiner’s refusal of this application under section 37(4) (pursuant to section 1(1) and rule 8(2)) is based upon the Registrar’s belief that the class 35 terms listed at paragraph 6 do *not* constitute a description or clear indication of those services intended for coverage via registration of the trade mark application in suit. There is some doubt whether they are, in fact, services within the meaning of the Act.

15. In attempting to determine what actually constitutes a clear statement of service as required by section 1(1) and rule 8(2), I refer to the EC Treaty, where Article 4 defines a service as being “any self-employed economic activity, as referred to in Article 50 of the Treaty, consisting in the provision of a service for economic consideration”. Article 50 (previously Article 60) itself states the following:

“Services shall be considered to be ‘services’ within the meaning of this Treaty where they are normally provided for remuneration, insofar as they are not governed by the provisions relating to freedom of movement for goods, capital and persons. ‘Services’ shall in particular include:

- (a) activities of an industrial character;
- (b) activities of a commercial character;
- (c) activities of craftsmen;
- (d) activities of the professions.

Without prejudice to the provisions of the Chapter relating to the right of the establishment, the person providing a service may, in order to do so, temporarily pursue his activity in the State where the service is provided, under the same conditions as are imposed by that State on its own nationals .”

16. In further support of the office’s opinion that the terms filed are not sufficiently clear for the purposes of rule 8(2), I also make reference to a number of rulings from the European Court of Justice (ECJ). In Case C-157/99 *B.S.M. Geraets-Smits v Stichting Ziekenfonds VGZ and H.T.M. Peerbooms v Stichting CZ Groep Zorgverzekeringen*, the ECJ accepted that Article 50 of the Treaty “does not require that the service be paid for by those for whom it is performed”. However, in Case C-355/00, a reference to the ECJ under Article 234 EC by the Diikitiko Protodikio Thessalonikis (Greece) for a preliminary ruling in the proceedings between Freskot AE and Elliniko Dimosio, the ECJ stated:

“54. Furthermore, the concept of ‘services’ within the meaning of Article 60 of the Treaty implies that they are ordinarily provided for remuneration.

55. The Court has already held that the essential characteristic of remuneration lies in the fact that it constitutes consideration for the service in question, and is normally agreed upon between the provider and the recipient of the service (see Case 263/86 *Humbel and Edel* [1988] ECR 5365, paragraph 17, and Case C-109/92 *Wirth* [1993] ECR I-6447, paragraph 15).”

Additionally, in Case C-422/01, a reference to the ECJ under Article 234 EC by the Regeringsrätten (Sweden) for a preliminary ruling in the proceedings pending before that court between Försäkringsaktiebolaget Skandia (publ), Ola Ramstedt and Riksskatteverket on the interpretation of the EC Treaty and Article 49 EC in particular stated:

“Article 50 EC provides that services are to be considered to be services within the meaning of the Treaty where they are normally provided for remuneration. It has already been held that, for the purposes of that provision, the essential characteristic of remuneration lies in the fact that it constitutes consideration for the services in question (see Case 263/86 *Belgian State v Humbel* [1988] ECR 5365, paragraph 17).”

17. Although not explicitly descriptive, all of the terms under objection appear to indicate the physical or virtual ‘bringing together’ of various commercial enterprises and/or other service providers in the manner of, for example, a retail park or shopping complex. In order to determine whether or not the commercial activities suggested by these terms do constitute services within the meaning of section 1(1), I have considered comments made in the *Praktiker* case, both in respect of the opinion of the Advocate General (“AG”) dated 13 January 2005 and the ECJ’s judgement of 7 July 2005 (Case C-418/02 *Praktiker Bau- und Heimwerkermärkte AG*).

18. The Registrar considers that, for an activity to be considered a ‘service’ within the meaning of Article 50 of the Directive, it must be provided for remuneration. The wording of that Article and the relevant paragraphs from *Praktiker* make this absolutely clear. Furthermore, the Registrar also finds that, where a retailer’s services form part of a transaction relating to the sale of goods *not* involving any separate payment, the ECJ’s judgement does imply that there is no need for evidence of any separate charge agreed upon between the provider and the recipient. In such circumstances, the charge for the service will be recovered in the price of the goods, with the actual amount being unknown to the customer. In the context of the commercial activities suggested by the class 35 terms in question (i.e. that of a developer or operator of a shopping centre, retail park, or other retail environment), I accept that some element of remuneration must take place i.e. an individual or company responsible for managing and running a shopping centre must have *some* level of profit margin in order to continue operating.

19. It is important to note that the *Praktiker* judgement and opinion both addressed the terms “retail trade in building, home improvement, gardening and other consumer goods for the do-it-yourself sector”. In that case, the issue of remuneration was considered clearly in the context of a specification denoting services provided in connection with retail trade in goods. The judgement also described the relevant services as being, in addition to the sales transactions, “all activity carried out by the

trader for the purpose of encouraging the conclusion” of the sale. The AG mentioned specific activities such as the selection of goods, bringing them together and displaying them, the quality of the service and advice provided by the staff, or the location and accessibility of the shop (AG’s opinion, paragraph 49). He specifically excluded services such as the provision of finance, insurance or repair which are offered in connection with the sale, but which “form the subject-matter of a contract separate from the sale itself” (AG’s opinion, paragraph 48).

20. By comparison to the *Praktiker* case, the specifications claimed by application number 2462651D appear to have far less of a direct connection with the selection or purchasing of goods. Although qualified as being for the purpose of enabling customers to conveniently view and purchase goods and services, the specifications *primarily* describe the bringing together of retail outlets, entertainment, restaurants, financial services, telecommunications services and ‘other’ services.

21. Also in its judgement on *Praktiker*, the ECJ was absolutely clear that there must not only be remuneration, but that the remuneration must take place specifically in relation to the service said to be being provided. I am aware that, for the purposes of providing a so-called ‘mixed-use’ environment, a shopping centre may now incorporate a number of additional features such as restaurants, cinemas, creche facilities and even housing developments, all of which will be provided in order to make that environment more attractive to a potential customer. I am also aware that remuneration takes place in respect of such services, largely in the form of direct transactions *either* between the service provider and the customer (for example, the bill for food and drink paid by the user of a restaurant situated within a shopping mall) *or* between the leaseholder and the business service provider (for example, rents paid by that restaurant to its landlord with responsibility for the shopping mall). In both cases ‘remunerations’ are received specifically in relation to services provided i.e. the provision of food and drink in class 43, and real estate leasing proper to class 36.

22. In this case, where the specifications in question appear to simply describe the ‘placement’ or ‘arrangement’ of third-party service providers within a physical or virtual environment, I cannot see how those specifications reflect the provision of a service where remuneration would actually take place. This is not to say that the provider of a shopping mall facility would not receive remuneration for the business it undertakes. Having reviewed the office’s classification database, there are a range of terms which describe services provided by the operator of a shopping centre such as, for example, ‘commercial retail property development services’ in class 37, ‘shopping centre planning (design) services’ in class 42, and ‘arranging of leases for the rental of commercial property’ in class 36. The same logic applies to the applicant’s use of terms such as “the bringing together of financial services through a virtual shopping mall”, where an appropriate term might simply be “the provision of financial services” *per se*. In this case, the electronic medium used to provide a service does not serve to define that service’s classification. A financial service provided through an electronic platform such as a “virtual shopping mall” is still a financial service. However, the fact that the Registrar is unable to understand or identify the services actually intended for coverage on the basis of such terms reflects upon the objection raised. The applicant’s terms such as “the bringing together of a variety of retail outlets... and other services enabling customers to conveniently view and purchase

goods and services and make use of such facilities” fall well short of being clearly defined.

23. The fact that I am unable to see how remuneration will be offered in response to those activities claimed in class 35 reflects on the specification’s inability to meet the criteria set out by rule 8(2)(b). I accept that operators and developers do engage in specific commercial activities such as the provision of ancillary functions such as car parks and creches, along with the provision and arrangement of secondary services such as restaurants and cinemas). I also accept that payment is likely to be received in the form of rentals from leaseholders, revenues from car park charges etc.) However, such services are provided in their own right and receive remuneration accordingly. Furthermore, if such services are intended for coverage by way of a trade mark registration, then there are clear terms (including, but not limited to, those contained within the World Intellectual Property Organisation’s published list of goods and services for classification) which an applicant may use.

24. In this case, the terms which have been applied for (and which are listed at paragraph 6 above) do not clearly indicate the nature of any service being provided. To meet the criteria set out in rule 8(2)(b), reworded terms should have been submitted as part of the examination process (had that been the case, it is also likely that some of those terms would have then described services proper to other classes). Additionally, from the perspective of an interested third party, the lack of clarity in the terms applied for would have a detrimental effect on one’s ability to assess the scope of protection offered by the registration (with possible implications on any future infringement action).

25. For those reasons, I conclude that the class 35 specification listed in 2462651D does not comply with the requirements of rule 8(2)(b) of the Trade Marks Rules 2000 (as amended) as it fails to provide a clear indication of the nature of those services intended for coverage. The application also therefore fails to meet the requirements set out in section 1(1) of the Trade Marks Act 1994 and is hereby refused under section 37(4).

**Dated this 31<sup>st</sup> day of March 2008**

**Nathan Abraham  
For the Registrar  
The Comptroller-General**