

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NUMBER 3851494
BY UK GREETINGS LIMITED
TO PROTECT THE FOLLOWING TRADE MARK IN CLASSES 32 AND 33:

THINKING OF *You*

Background

1. On the 21st of November 2022, UK Greetings Limited ('the applicant') applied to register the above mark
2. Registration was sought in class 16 for the following goods:
Class 16: Greetings cards.
3. On the 28th of November 2022, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under section 3(1)(b) of the Trade Marks Act 1994 ('the Act') which reads as follows:

Absolute grounds for refusal

Section 3(1)(b)

The application is not acceptable in Class 16. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because the sign 'THINKING OF YOU' will be seen purely as an indication that the greeting cards are for sending to others to tell them that you are thinking of them.

Cards with the message 'THINKING OF YOU' are common in the greeting card market place, bought often in cases of illness, bereavement and other difficult times.

I note the figurative stylization of the wording in the sign in this application. However, this presentation is very much within the norms of

how this wording is used on greeting cards, and will therefore not help in informing the average consumer as to the origin of the greeting cards.

In order to function as a trade mark, a sign must be distinctive enough to distinguish your goods and services from those of another undertaking. As a usual message for greeting cards, presented in a normal way for such goods, your sign is unable to perform this essential function.

4. On the 09th of March 2022 the appointed representative of the applicant Taylor Wessing LLP, requested an extension of time to address the objection.
5. On the 30th of January 2023 the examiner sent a letter confirming that extension of time request had been granted.
6. On the 30th of March 2023 written submissions in favour of the application were received from the appointed representative.
7. On the 06th of April 2023 a letter maintaining the objection against class 16 was sent by the examiner.
8. On the 04th of May 2023 a hearing was requested.
9. On the 01st of June 2023 the hearing was held with Ms. Alison Cole of Taylor Wessing LLP, representing the Applicant. I attended as the hearing officer. Ms. Cole submitted that the examiner had based their objection on a worst-case scenario use of the mark, and that actually, if used in trade mark fashion, the sign is capable of indicating the trade origin of the goods. Ms. Cole added that the Applicant uses the sign on the back of their greeting cards in a position where the consumer would expect to see a trade mark.
10. Ms. Cole also referred to her written submissions and stated that in the *Unidoor* case (*Unidoor Limited v. Marks & Spencer plc [1998] RPC 275*) it was held that "COAST TO COAST" as a slogan on a T-shirt was non-infringing use vis-à-vis the registered trade mark "Coast to Coast", which would be seen on labels in the neck of the garment and on swing tickets etc. Ms. Cole argued that this confirms that if a sign is used as a trade mark then it has the capacity to indicate trade origin.
11. Next Ms. Cole submitted that the stylisation present in the sign imbues it with at least a minimum degree of distinctive character. She stated that the sign consists of two different fonts which would be considered unusual and striking by the average consumer as they are used to seeing descriptive words in one particular font. Ms. Cole also provided me with examples of how the applicant used the marks on their goods, as can be seen below:



12. Finally, Ms. Cole referred to a number of acceptances that were highlighted in her written submissions (see annex 1 below) that she felt were on a par with this application. She stated that the acceptance of these marks demonstrated that the office had a practice of accepting these kinds of marks previously.
13. I deferred my decision at the hearing and then on the 14th of June 2023 the hearing report was issued. In it I stated that in my view the mark may actually be objectionable under Section 3(1)(b) and (c) of the Act, rather than Section 3(1)(b) alone. I felt that the verbal elements in the sign exclusively designated the kind of goods being produced, and that the stylisation present in the sign was minimal, meaning it would not be paid any trade mark significance by the average consumer.
14. In my view it was evident from internet research that there exists a category of greetings cards known as 'thinking of you' cards. This is the reason I felt that the objection was better suited to Section 3(1)(b) and (c). I provided a 'snapshot' of the descriptive use of the phrase in the hearing report and explained that in my view the average consumer would understand the sign as a description of the goods. Additionally, I stated that the stylisation present in the sign does not

imbue it with the requisite level of distinctive character. At the end of the hearing report, I confirmed that a period of two months had been permitted in order for the applicant to consider my concerns. The Section 3(1)(b) objection was therefore maintained.

15. No further submissions were received from the agent. On the 10th of August 2023 a form TM5 was received. I am now asked under section 76 of the Trade Marks Act 1994 and rule 69 of the Trade Mark Rules 2008, to state in writing the grounds for my decision and the materials used in arriving at it. No formal evidence of use has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, in respect of the goods listed above, I only have the prima facie case to consider.

The Law

16. *Section 3(1) of the Act reads as follows:*

3(1) The following shall not be registered –

(a) ...

(b) trade marks which are devoid of 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,

(d) ...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

The relevant legal principles – section 3(1)(b)

17. There are a number of judgements of the Court of Justice of the European Union (“CJEU”) which deal with the scope of article 3(1)(b) of the Directive and Article 7(1)(b) of the Regulation, whose provisions correspond to Section 3(1)(b) of the UK Act. For the avoidance of doubt, it is noted that the Trade Marks Act 1994 is largely derived from EU law (Directive 2015/2436). In relation to the interpretation of such retained law, the case law of the Court of Justice of the European Union (CJEU) (including the General Court) issued before the end of the transition period continues to apply, and is binding, as retained EU case law under section 6 of the Withdrawal Act. I derive the following main guiding principles from the cases noted below:

- The European Court of Justice (ECJ) has repeatedly emphasised the need to interpret the grounds of 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).
- The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provision referred to above) the Court has held that "...the public interest... is, manifestly, indissociable from the essential function of a trade mark", *SAT.1 SatellitenFernsehen GmbH v OHIM*, C-329/02P. 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 abovementioned judgement). Marks which are devoid of distinctive character are incapable of fulfilling that essential function.
- 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*).

18. It is clear from the aforementioned case law that assuming notional and fair use, I must determine whether or not the mark applied for will be viewed by the relevant consumer as a sign capable of denoting a single source of trade origin when used in relation to the goods included in the application. In order to do this, I must assess who I consider the relevant consumer to be.

19. As mentioned above, the objection has been maintained against the following goods:

Class 16: Greetings cards.

20. When considering these goods, it is my view that the relevant consumer will be the general public. The goods are generally bought by consumers to give to others for different occasions or events, or to express gratitude or other sentiments. The level of attention will vary depending on the consumer; however, I consider that it is reasonable to assume that the prospective purchaser of the applicant's goods would apply at least a moderate level of attention and circumspection when considering whether or not to purchase.

21. Having established that the average consumer of greeting cards consists of the general public at large, I consider that when faced with words 'THINKING OF YOU', consumers would be unlikely to undertake a rigorous mental analysis of the sign; they would instead read the words, and applying their understanding of the normal rules of English grammar, take the words at face value, and perceive nothing more than a non-distinctive expression of sentiment. In my view the words are considered to be ordinary dictionary words, which make up an everyday expression, used to convey a message of sympathy, compassion or condolence, following a traumatic event such as an illness or bereavement. The words would merely convey the consumer's sense of feelings towards the recipient of the goods, demonstrating that the recipient is in their thoughts. The sign is therefore unlikely to indicate trade origin when considered in respect of the goods concerned. In that regard I am mindful of the comments made by Mr Geoffrey Hobbs KC in his decision O/086/07 'For You.':

16. In the present case, the ordinary dictionary words which make up the everyday expression 'FOR YOU' are, in my view, unlikely to be taken as 'origin specific' for any of the goods and services at issue by an average consumer who is 'reasonably well-informed and reasonably observant and circumspect'. They are more likely to be seen as an invitation to the consumer to look at a list of goods/services in advertising or indicate on packaging that the contents are for the benefit of the customer. All the more so, in my view when the statement is made with a row of dots to indicate there is something to follow. (The use of colour in the dots in the second mark add nothing, in my view, to the distinctiveness of the overall mark.

22. Turning to Ms. Cole's submission that the examiner had taken a 'worst case scenario' assessment of the sign, it is clear from case law that the Registrar must not take such an approach when assessing marks and must not apply a stricter criteria for registration. This is made clear in the

comments of Professor Ruth Annand in her decision O/094/08 THERE AIN'T NO F IN JUSTICE:

26. ... *Additionally, in my judgement, the Hearing Officer brought different/stricter criteria into his assessment of the distinctive character of the mark. First, his assessment was based on a "worst case" assumption of manner of use.*

27. *In assessing the distinctive character of a trade mark, it is appropriate to take account of practices in the marketplace including in the present case the well-known use of slogans as clothing brands ...*

However, whilst I agree with these principles, each case must be assessed on its own merits and in relation to the goods applied for. In my view the mark is considered to consist of three dictionary defined words which would be commonly used and widely understood by the UK consumer in respect of the goods concerned. I consider there to be no unusual variances as to grammar or syntax and, as such, no compelling arguments exist when the normal rules of English language are applied to support a claim of distinctiveness.

23. At the hearing Ms. Cole submitted that the stylisation present in the sign imbues it with at least a minimum degree of distinctive character. She added that the combination of two different fonts in the mark would indicate to the consumer that the sign is not merely a non-distinctive or descriptive phrase but instead intended to convey trade origin. In this regard, if I maintain that the words themselves are inherently non-distinctive, I am obliged to consider the impact of the 'visual elements' upon the sign, and the perception of the mark by the relevant consumer. In my view the stylisation present in the sign is so minimal in nature that it does not endow the trade mark applied for as a whole with any distinctive character. Those elements do not possess any feature, in particular in terms of fancifulness or as regards the way in which they are combined, that allow the mark to fulfil its essential function in relation to the goods applied for.
24. Additionally, whilst not specifically relating to Section 3(1)(b) alone, I note the findings in '*Spambuster*' where it was held that in instances where words which are descriptive are presented in a format which encompasses elements of stylisation such as, for example, an unusual font, it may be considered that the sign merely represents those words '*in one particular manner*'. This makes it clear that if there are other graphic elements present, along with descriptive words, we must consider whether such elements are sufficient to divert the consumer's attention away from, or modify, the descriptive elements. I believe the principal to be the same when it comes to non-distinctive words presented in a stylised typeface. In my opinion the graphic elements do not divert or modify the non-distinctive nature of the words.
25. Further and taking into account my own research into the trade, it is not uncommon for greetings cards providers to utilise stylised fonts to portray non-distinctive sentiments such as those done so by the mark. In fact, it appears to be well established within the greetings card industry for cards to be adorned with words and phrases depicted in many different styles and fonts in order to

attract the consumer (this is demonstrated at Annex 2 below). It is therefore considered that the relevant consumer is accustomed to viewing stylised messages on the goods not as indications of commercial origin, but merely as non-distinctive phrases appearing in aesthetically pleasing typefaces.

26. As regards Ms. Cole's submission that if a sign is used as a trade mark, then it has the capacity to indicate trade origin, I do not agree. If that were the case, then there would be no requirement for the proviso to Section 3(1) that allows for a mark to acquire a distinctive character through the use made of it. Additionally, it is well established that the first line of protection is to refuse registration of signs which are excluded from registration by the provisions of Section 3. In this respect I refer to the comment of Geoffrey Hobbs KC in his capacity as the Appointed Person in relation to an appeal against the refusal of an application for the mark 'AD 2000' (1997) RPC 168.

"Although Section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse the registration of signs which are excluded from registration by the provisions of Section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacobs Esq. QC in his decision on behalf of the Secretary of State in Colorcoat TM (1990) RPC 511 at 517 in the following terms: 'That possible defences (and in particular that the use is merely as a bona fide description) should not be taken into account when considering registration is well settled, see e.g. Yorkshire TM (1954) RPC 150 at 154 lines 20-25 per Viscount Simonds LC. "Essentially the reason for this is that the privilege of a monopoly should not be conferred where it might require honest men to look for a defence."

27. I must take this opportunity to address the previous acceptances referred to by Ms. Cole which she considered to be on a par with the mark of this application (see Annex 1). I am bound to determine the marks acceptability in accordance with the relevant legal principles rather than assessing the mark based on the state of the register. This well-established principle in trade mark law was cited in the *Treat* case and has been summarised recently in *BREXIT O-262-18*, where the AP (James Mellor QC) stated:

'11. In addition, just because a mark is on the Register does not mean it will be held valid when challenged. Furthermore, if the touchstone for registration was to be a comparison with marks already on the register, then registration would come to depend on the lowest common denominator. In any event, it is quite clear that the application of the section 3(1)(b) ground requires an assessment not against other marks on the register, but against the standard laid down in that provision, as interpreted in the case law.'

'21. The Hearing Officer referred to the previous registrations as 'precedents'. Strictly they are not precedents for the reasons explained above, but I appreciate the desire to maintain consistency in approach.'

As I am not privy to the circumstances surrounding the acceptance of the previous registrations, I cannot comment further.

Considerations under Section 3(1)(c)

28. Whilst I stated in my hearing report that the objection may have been better suited under Section 3(1)(c) of the Act, no separate objection was formally raised under this Section. However, for completeness I make the following observations, taking into account that I am not making a separate or contingent finding but simply commenting on my thoughts from the hearing report. I reiterate that I am not relying on section 3(1)(c) or making any finding as a basis of objection; the only basis for refusal remains section 3(1)(b) exclusively.

29. Internet research potentially demonstrates that there exists a category of greetings cards known as 'thinking of you' cards (see Annex 3 below). It is therefore considered that the verbal elements in the sign merely describe the kind of goods being provided and may be perceived as such by the relevant consumer. As referenced above, I am obliged to consider the impact of the 'visual elements' upon the sign, and the perception of the mark by the relevant consumer. Only then, can I establish if the mark exclusively designates a characteristic of the goods. I have already referred to '*Spambuster*' in paragraph 24 of this decision however it is useful when assessing marks under Section 3(1)(c) alone. As stated above, where words which are descriptive are presented in a format which encompasses elements of stylisation such as, for example, an unusual font, it may be considered that the sign merely represents those words '*in one particular manner*'. It was noted by Mr Richard Arnold KC sitting as the Appointed Person that to allow such a registration would be to '*drive a coach and horses through Section 3(1)(c)*' and he went on to note that:

150. Under section 3(1)(c) the question is whether the mark propounded for registration consists exclusively 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 realm of section 3(1)(c). For the reasons I have given, I consider that this depends on whether the visual elements include something additional to the word as opposed to a representation of the word.

30. This approach was also noted in '*Sun Ripened Tobacco*' (*British American Tobacco (brands) Inc – BL O/200/08*) where Mr Arnold KC, again sitting as the Appointed Person commented that:

10. ... In Hormel Foods Corp. v Antilles Landscape Investments NV [2005] RPC 28, I held that a mark which would be objectionable under section 3(1)(c) if it was a pure word mark does not cease to be objectionable under section 3(1)(c) if it is presented in a fancy script. I

expressed the view that the position would be different if, instead of being merely presented in a fancy script, the mark contained visual elements additional to the word, such as a device, and that in those circumstances the relevant objection to consider would be that under section 3(1)(b)

31. This is further referenced in the case of 'The Cannabis Clinic' (BL O/777/21). At paragraph 57 Emma Himsworth KC says:

"In the context of an assessment of an application that is comprised of several elements where one or more of such elements are such as to designate a characteristic of the goods or services it is necessary for the decision taker to consider whether the other elements are such as to divert the average consumer's attention away from or to modify the descriptive element or elements of the mark. That this is appropriate is confirmed both in the judgment of Arnold J. as he then was in Starbucks (HK) Ltd v. British Sky Broadcasting Group Plc [2013] FSR 29; and Case T-223/17 Adapta Color, SL v. EUIPO which were cited by the Hearing Officer. Any suggestion that the Hearing Officer should not have referred to the judgment of Arnold J. in this context is in my view unfounded."

Conclusion


32. Having considered the relevant case law, as well as the submissions made, it is my view that the sign would be perceived as nothing more than an origin neutral phrase, presented in a relatively plain font that would not be capable of indicating the origin of the goods concerned. I therefore do not believe that the relevant consumer would understand the sign as having the distinctive character required for it to function as a trade mark.
33. For the reasons given above I do not consider the mark to be distinctive or capable of functioning as an indicator of trade origin and the application is hereby refused under Section 3(1)(b) of the Trade Marks Act 1994.

Dated this 31st day of October 2023

Oliver Rose'Meyer

Annex 1

TRADE MARK	stylistisation	UK Registration No.
Love and Blessings		UK00003643321
JUST FOR YOU		UK00003760935
PERSONALLY YOURS		UK00003692892
THOUGHTS AND WISHES		UK00003106367
P.S. WITH LOVE		UK00003579548
I love you but		UK00003013774
I love you this much		UK00003321774
I Love YOU This Much		UK00003548522
UNIQUE & LOVED		UK00003662475
LOVE LOVE		UK00002503510
LOVE		UK00002612054
LOVE		UK0002500143A
LOVE ALL		UK00003256410
ilylots - i love you, lots		UK00003302721
LOZZA LOVE		UK00003524822
ONLY LOVE CAN SET YOU FREE		UK00003213395
PUPPY LOVE		UK00003206305
CHOOSE LOVE		UK00003671997
MUCHOS LOVE		UK00003009576
WORDS OF LOVE		UK00002489002
KISSES OF LOVE		UK00003766049
WHISPERS OF LOVE		UK00002434217
GIVE A LITTLE LOVE		UK00003661555
LITTLE LOVE LETTER		UK00003114972
THINKIN BOUT YOU		UK00003494072
ME TO YOU		UK00002278291
TRULY GIFTING FROM ME TO YOU		UK00003131681

I love you there I said it.		UK00003247075
WISH		UK00003256453
WISH		UK00003854770
WISHES		UK0002374685A
SIMPLY THANK YOU		UK00003041823

Annex 2

Examples of cards taken from the online card retailer 'Moonpig'.
<https://www.moonpig.com/uk/>



Examples of cards taken from the online card retailer 'FunkyPigeon'.
<https://www.funkypigeon.com>



Examples of cards taken from greetings card retailer 'Hallmark'.
<https://www.hallmark.co.uk/>



Annex 3

Example demonstrating 'Thinking of You' is a category or type of card taken from online card retailer 'thortful'. <https://www.thortful.com/>

The screenshot shows the thortful website interface. At the top, there is a search bar with the text "Search Cards" and a magnifying glass icon. To the right of the search bar are icons for "Sign in", "Reminders", "Saved", and "Basket". Below the search bar, there is a navigation menu with categories: "Birthday", "Anniversary", "Christmas", "Card & Gift", "Personalised Cards", "All Occasions", and "Our Creators". On the far right of the navigation menu, it says "Get £5 01".

Thinking Of You Cards

Whether you know someone who's going through a bit of a difficult time, or you just want to say hi if you haven't caught up in a while, our range of thinking of you cards is like a big hug in paper form.

With thousands of options to choose from, you're bound to find something that will brighten their day. And if you know someone who's recently lost a loved one, our range of **sympathy cards** is a great way to show that they're in your thoughts.

Buy Thinking of You Cards Online

Let your loved one know just how much you're missing them with our range of 'thinking of you' and 'miss you' cards. Whether you're looking for the perfect design for your best friend, parents, grandparents or children, our cards come in a range of styles, from funny and naughty, to simple and sweet. Designed by our talented illustrators, our cards are the perfect way to let your loved one know you're thinking of them.

[Check Out Our Other Cards](#) | [Birthday Cards](#) | [Anniversary Cards](#) | [Personalised Photo Cards](#) | [Sympathy Cards](#)
[Show less](#)

Showing 2,072 cards Rude Cards

Occasions Gender Style

Thinking of you

Example demonstrating 'Thinking of You' is a category or type of card taken from online card retailer 'FunkyPigeon'. <https://www.funkypigeon.com>

The screenshot shows the FunkyPigeon website interface. At the top, there is a search bar with the text "I'm looking for..." and a magnifying glass icon. To the right of the search bar are icons for "Account", "Reminders", and "Basket". Below the search bar, there is a navigation menu with categories: "Birthday Cards", "Cards", "Flowers & Plants", "Personalised Gifts", "Gifts", "Calendars", "Christmas", "Offers", and "Where is my order?".

All Thinking Of You Cards 494 results

Let a loved one know that you're thinking of them with a heartfelt card. Explore a large selection of cute, sentimental and personalised card designs and find the perfect card that says "I'm here for you". Add your message inside and create your card to their door.

Welcome :) for the next hour get 20% off any card with code NEWCUST20 time remaining 00:59:43

Sort

Example demonstrating 'Thinking of You' is a category or type of card taken from online card retailer 'Moonpig'. <https://www.moonpig.com/uk>

The screenshot shows the Moonpig website interface. At the top, there is a search bar with the text "Search...", a "Reminders" icon, an "Account" icon, and a "Basket" icon. Below the search bar, there are navigation links for "Birthday Cards", "Cards", "Flowers & Plants", "Gifts", "Balloons", "Chocolates", "Moonpig Plus", and "Group Cards". A "Deliver to UK" button is also visible.

The main content area is titled "Thinking of You Cards (1755)". Below the title, there is a horizontal menu of filter buttons: "Filters", "For Her", "For Him", "Best friend", "Friend", "Colleague", "Sister", "Mum", "Daughter", "Girlfriend", "Boyfriend", "Grandma", "Auntie", "Dad", "Son", "Brother", "Wife", "Godson", "Couple", and "Sister In La".

On the right side, there is a "Sort by:" dropdown menu set to "Popularity".

The card grid displays six cards:

- Card 1: "Sending you a **BIG HUG** to brighten your day" with a rainbow illustration.
- Card 2: "Now in" badge, "SENDING YOU POSITIVE RAYS" with a sun illustration.
- Card 3: "Just to say... Thinking of you" with a floral illustration.
- Card 4: "I don't know what to say or what to do, but I just want you to know that I'm thinking of you" with three hearts.
- Card 5: "THINKING of You" with a floral wreath illustration.
- Card 6: "Thinking of you Xx" in a cursive font.