

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 3876291

BY THE APPLICANT NEWS HUB LIMITED

TO REGISTER THE FOLLOWING MARK IN CLASSES 38 and 41.



## **Background**

1. On 9 February 2023, The News Hub Limited ‘the applicant’ applied to register the above mark for the following services:

### **Class 38**

*Telecommunications services.*

### **Class 41**

*Education; providing of training; entertainment; sporting and cultural activities; publishing and online publishing; news reporting.*

2. On 16 February 2023 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) and (c) of the Trade Marks Act 1994:

#### **Section 3(1)(b) and (c)**

*The application is not acceptable in Class 41. There is an objection under Section 3(1)(b) and (c) of the Act. This is because the mark consists exclusively of a sign which may serve in trade to designate the kind and intended purpose of the services e.g. a hub or centre that provides news and that also provides education services relating to the provision of news.*

*The word ‘Hub’ is defined by Collins dictionary as ‘the focal point’. The term would therefore be seen by the average consumer as a focal point (Hub) where one can access News. As such, the mark ‘The News Hub’ would be seen as*

*conveying nothing more than a descriptive message in relation to the services provided. It is considered that the average consumer would not perceive the sign 'The News Hub' as a trade mark guaranteeing commercial origin of the services but would instead view the sign as a description of a focal point or centre focusing on news where the services are being offered.*

*It is further considered that the stylisation of the sign does not imbue the mark with the requisite degree of distinctive character to overcome the descriptiveness of the mark. Also, the addition of the definitive article 'The' within the mark has little, if any effect, of the perception of the consumer. It merely suggests a laudatory connotation, that the mark is the preeminent, or the best News Hub.*

*As such, the mark would be seen as conveying nothing more than a descriptive message in relation to the services being offered. For a mark to be considered as distinctive and capable of distinguishing your services from those of another undertaking providing similar services, it should have an element that is unique to the applicant which sets them aside from others in the marketplace.*

*Unfortunately, this mark does not appear to be capable of carrying out this function.*

3. The mark was deemed to be inherently distinctive for the services in Class 38, namely, '*telecommunication services*' so no objection was raised against that class.
4. The examiner supported the objection against Class 41 by providing the dictionary definition of the word "HUB" and stated that 'The News Hub' would be seen as conveying nothing more than a descriptive message in relation to the services provided, namely a focal point or centre involved in the provision of news.
5. The examiner considered the stylisation within the mark but concluded that it did not imbue the mark with distinctive character such that the mark 'as a whole' would be capable of designating the services of a single undertaking. They considered the stylisation within the mark did not detract from the descriptiveness of the mark. They also commented that the addition of the definitive article 'The' within the mark had little, if any effect, on the perception of the consumer but merely suggests a laudatory connotation, that the mark is 'the' preeminent, or the best News Hub.
6. In line with standard IPO procedure, a period of two months was allowed for the applicant to respond.
7. On 17 April 2023 Beck Greener LLP, the attorney acting on behalf of the applicant, requested an extension of time to discuss the objection with the applicant further. The extension was granted by the examiner on 18 April 2023 and a new response date set at 19 June 2023. On 15 June 2023, the attorney provided the examiner with written submissions to address the objection and requested a hearing should the examiner be minded to maintain the objection. The examiner was not persuaded to waive the objection and responded on 20 June 2023. As per the attorney's request the application was then referred for the appointment of a hearing.

8. The hearing was held on 20 July 2023 with me and Mr Ian Bartlett from Beck Greener LLP representing the applicant.

9. In summary, Mr Bartlett's submissions in writing and reinforced at the hearing were as follows:

- *The use of the definite article in the mark THE NEWS HUB informs the consumer that there is only one such service and refers to a particular company's services and no others.*
- *THE NEWS HUB it is not a phrase in general use by the public. The services applied for are not described as THE NEWS HUB and are not likely to be, as that is not a form of words the public would naturally use to refer to the characteristics or purpose of such services.*
- *The mark THE NEWS HUB as filed, with the right-hand justification and two blue lines, does not consist exclusively of a sign which may serve in trade to designate a characteristic of the services objected to.*
- *There are a number of registrations on the UK Register which could also be said to send a message to the consumer similar to that considered in the present objection, including: UK00003892041 THE HUB; UK00003086664 THE GYM HUB; UK00003534759 THE ZEN HUB; UK00003178206 THE BABY HUB.*
- *In terms of Section 3(1)(b), a minimum degree of distinctive character is sufficient to render this ground of refusal inapplicable and to conclude that the subject mark falls foul of this section is to find that it is completely devoid of any distinctive character. It is submitted that this is not the case and whilst the mark contained in the application is not necessarily as highly distinctive as a wholly invented word may be, it is sufficiently distinctive so as not to be completely devoid of distinctive character and hence it crosses the necessary threshold.*
- *The phrase THE NEWS HUB and indeed the trade mark as filed with the stylisation and graphic element, is of unclear meaning. The public have to undergo a degree of mental effort to interpret the mark as a whole. This ambiguity is sufficient to overcome objections under Section 3(1) (b) and (c).*

10. When considering the mark in relation to 'education; providing of training; entertainment; sporting and cultural activities' it is my opinion that these services would not be offered via, or otherwise engage, a news hub so there is no direct and specific relationship with the relevant term such that the mark could be said to be descriptive of those services. For this reason, I was also of the view that there is no public interest

in keeping the words free for others to use in respect of these particular services. Consequently, at the hearing I waived the objection against the following:

*Education; providing of training; entertainment; sporting and cultural activities.*

11. As regards the remaining services, namely, ‘*Publishing and online publishing; news reporting*’, I considered the mark to be descriptive of these services and duly maintained the objection.

12. I had taken into consideration the earlier ‘Hub’ marks identified by Mr Bartlett. However, it is well-established principle in trade mark law as 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.*

13. At the hearing, I informed Mr Bartlett that I would allow two months for him to consult with the applicant and to consider the option of filing evidence to demonstrate acquired distinctiveness through use.

14. The hearing report was issued on 24 July 2023 but due to an oversight on my part, the accompanying letter indicated that the application was refused and a period of one month was allowed to appeal the decision by submitting Form TM5 (Request for a statement of reasons for registrar’s decision).

15. Before the response date had expired and before the application was formally refused for the services identified above, a form TM5 (Request for a statement of reasons for registrar’s decision) was received on 24 August 2023.

16. As mentioned at paragraph 14, I had allowed two months to respond to the hearing report but had indicated in my covering letter that the application was refused. This constituted a procedural irregularity, therefore, under the provisions of Rule 74 of the Trade Marks Rules 2008, on 10 October 2023 I wrote to Mr Bartlett to give notice of how the office proposed to rectify the irregularity. I informed Mr Bartlett that I intended to rescind the refusal of the application and to arrange a refund of the fee paid in respect of the Form TM5. I would then allow a period of two months for him to file evidence to demonstrate acquired distinctiveness through use. I also informed Mr Bartlett that if he did not intend filing evidence but would instead wish to proceed with his request for a Statement of Reasons he should let me know within seven days of the date of my letter.

17. On 12 October 2023 the attorney responded and informed me that they would not be filing evidence and requested that I proceed with their request for a Statement of Reasons.

18. I am now obliged to set out my reasons for my decision. As no evidence of acquired distinctiveness was actually filed, I only have the prima facie case to consider.

### **The Law**

19. 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.*

20. The objection was raised on the basis that the mark consists exclusively of a sign which may serve in trade to designate a characteristic of the services, the characteristic being their kind and intended purpose of the services e.g. a hub or centre that provides news and the publishing of news.

21. No separate objection had been raised under Section 3(1)(b) and the finding of non-distinctiveness was the automatic consequence of the sign being considered to be descriptive. Therefore, I will give no separate rationale as regards the objection under section 3(1)(b) but will instead treat the two objections as co-extensive and based on the same rationale.

### **The relevant legal principles – section 3(1)(b) and (c)**

22. 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)(c) of First Council Directive 89/104 (recorded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1)(c) of the Community Trade Mark Regulation (the CTMR), whose provisions correspond to Section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases 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 (*Wm Wrigley Jr & Company v OHIM*, C-191/01P ‘Doublemint’, paragraph 30).

- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest, namely that signs or indications relating to the categories of goods or services in respect of which registration is sought may be freely used by all. The provision therefore prevents such signs or indications from being reserved to one undertaking alone because they have been registered as trade marks (see judgment of 4 May 1999 in Joined cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots-und Segelzubehör Walter Huber and Franz Attenberger (Chiemsee)* [1999] ECR I-2779, at paragraph 25).
- It is also a well-established principle that the Registrar’s role is to engage in a full and stringent examination of the facts, underlying the Registrar’s frontline role in preventing the granting of undue monopolies, see to that effect CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z.o.o. v OHIM* [2011] ECR I-1541 (*Technopol*).
- When determining whether a sign is devoid of distinctive character or is descriptive of the goods or services in respect of which registration is sought, it is necessary to take into account the perception of the relevant consumer who is reasonably well-informed and reasonably observant and circumspect (*Matratzen Concord AG v Hukla Germany SA*, C-421/04);
- There must be a sufficiently direct and specific relationship between the sign and the goods in question to enable the relevant consumer immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics (*Ford Motor Co v OHIM*, T-67/07);

23. I have also taken into account the consequences for third parties of granting the applicant a monopoly. In *Linde A.G. v Rado Uhren A.G.* Case C-53/01 the following guidance was given at paragraphs 73 – 74:

*73. According to the Court’s case-law “Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see to that effect, Windsurfing Chiemsee, paragraph 25).*

*74. The public interest underlying Article 3(1)(c) of the Directive implies that, subject to Article 3(3) any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all and not be registrable.*

## Application of the case law

24. It is clear from the aforementioned case law that I must determine whether or not the mark applied for will be perceived by the relevant consumer as a means of directly designating the characteristic of the services being provided. In other words, could the mark as filed designate a characteristic of the services, in this case, the characteristic being the 'kind and intended purpose' of the services. In order to do this, I must assess what the services are and who I consider the relevant consumer of those services to be.

25. As mentioned above, the objection has been maintained against the following services:

*Class 41 - Publishing and online publishing; news reporting.*

26. The services for which I have maintained the objection are essentially "publishing and news reporting". Publishing is the activity of making information, literature, music, software, and other content available to both the public and commercial undertakings either for sale or free of charge. News reporting is the presenting of news via the media. When considering the publishing services, it is my view that the relevant consumer will be both the general public who seek to publish their own work and also professionals seeking publishing services for their business. The relevant consumer of news reporting services will be both the general public who are likely to use the services for their own personal interest, and those working in a professional capacity who may use the services for their business. The level of attention when considering these services may vary depending on the consumer, however, I consider that it is reasonable to assume that the prospective purchaser of the applicant's services would apply at least a moderate level of attention and circumspection when considering whether or not to purchase.

27. In assessing the mark applied for, the mark in question is composed of the three dictionary defined words which would be readily understood by the consumer.

Oxford Learner's Dictionary provides the following definition:

*the - definite article: used to refer to a thing in general rather than a particular example;*

Oxford Dictionary of English (3<sup>rd</sup> edition) provides the following definitions:

*news – noun: newly received or noteworthy information, especially about recent events*

*hub – noun: the effective centre of an activity, region, or network*

28. In my view, the combination of these words merely results in a descriptive whole that will be understood as meaning a general hub (centre) relating to all things connected with news. The mark has a direct and specific relationship with *news*

reporting services (*Ford Motor Co v OHIM, T-67/07*), and is therefore considered descriptive of news reporting services provided via the news hub. As regards publishing services, this is a broad term that covers a vast range of different publications which will also include those relating to news. I am therefore of the view that these publishing services also have a direct and specific relationship with the provision of news, and as such, they could be provided via the news hub. The inclusion of the definitive article 'The' within the mark adds no distinctive character to the mark and does not assist in indicating which news hub or who is providing the news hub.

29. Furthermore, the test under section 3(1)(c) is not that a particular phrase is in current or general use at the time, but that '*it could be*' in the future. The words 'may serve in trade' can be paraphrased as, '*could the sign in question serve in trade to designate the characteristics of the goods/services*'. To support this, in *Windsurfing Chiemsee (C-108/97 and C-109/07)* it was found not to be necessary for a sign to be in current use as a description before it is susceptible to an objection under Article 7(1)(c). It is sufficient that the sign is capable of being used as a designation of the goods/services. Article 7(1)(c) of the Community Trade Mark Regulation corresponds to Section 3(1)(c) of the Trade Marks Act 1994 and the court's findings must therefore be taken to apply equally to the national law.

30. I am of the view that the words 'The News Hub' could be used in trade to describe a hub from which the consumer can access news.

31. It is my opinion that *Publishing and online publishing; news reporting* services are services that consumers would expect to be provided by a news hub. Consequently, I consider there to be a need to keep the term free for others to use in the course of trade. The mark is not capable of identifying the services of a single undertaking or distinguishing them from those of other undertakings.

30. Having established that the words within the mark combine to create a descriptive whole, I must consider whether the stylisation of the marks adds sufficient distinctive character to the mark such that it would result in a sign which '*in its totality*' is capable of designating single trade origin. The stylisation in the mark includes two blue lines positioned one above and one below the column of words, the position of which being justified to the right.

32. In my assessment, I refer to the judgment in *Starbucks (UK) Ltd v British Sky Broadcasting Group Plc & Others* [2012] EWHC 3074 (Ch) where Mr Justice Arnold stated the following 117:

117. "*I would comment that it appears to me that PCCW only succeeded in obtaining registration of the CTM because it included figurative elements. Yet PCCW is seeking to enforce the CTM against signs which do not include the figurative elements or anything like them. That was an entirely foreseeable consequence of permitting registration of the CTM. Trade mark registries should be astute to this consequence of registering descriptive marks under the cover of a figurative figleaf of distinctiveness and refuse registration of such marks in the first place*".

33. In that case, the mark consisted of the word NOW at the centre of a simple 'starburst' figurative element. The judge held that the mark was descriptive and/or non-distinctive and declared the registration invalid. It is clear from his decision that the figurative element within the mark was insufficiently distinctive in that case to render the mark as a whole registrable.

34. In the present case, the parallel blue lines appearing above and below the column of words have little visual impact in my opinion and would simply frame the words. Similarly, the position of the words being presented one below adds little visual impact or distinctive character. I am therefore of the view that the stylisation within the mark could also be said to be a 'figleaf of distinctiveness' which does not imbue the mark with distinctive character, as a totality, to enable it to carry out the functions of a trade mark.

35. The above has been reinforced in the case of The Cannabis Clinic BL O/777/21 where at paragraph 57 the AP 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."*

36. It is abundantly clear from the above that if there are other graphic elements present, along with descriptive words, I must consider whether such elements are sufficient to divert the consumer's attention away from or modify the descriptive elements. In my opinion, the descriptive message afforded by the words 'THE NEWS HUB' speak loud and clear within the mark. The graphic elements appearing in the mark, and the way in which the words are presented one below the other, does not divert the consumers attention away from the descriptive message, nor does it modify the descriptive element.

37. In summary, I am of the view that there is nothing at all in the mark 'THE NEWS HUB' that would serve to identify the services of a single undertaking or to distinguish them for any other news hub also providing news reporting and publishing services of a different undertaking.

## **Conclusion**

38. I have taken into account the guidance set out in relevant case law and I consider that the average consumer of the relevant services will not perceive the sign as

indicating trade origin of the services. I therefore conclude that the mark consists exclusively of a sign which may serve, in trade, to designate a characteristic of the services, being the kind and intended purpose of the services and which are therefore excluded from registration by section 3(1)(c) of the Act. Any mark found to be unacceptable under 3(1)(c) will automatically be found to be non-distinctive. The objection taken under 3(1)(b) is solely on the basis that the mark designates a characteristic of the services and for no other reason. In other words, the objection under section 3(1)(b) and (c) in this case are co-extensive; there is no independent, contingent or separate rationale required under section 3(1)(b).

39. In this decision, for the reasons given above, the application is refused under the provisions of section 37(4) of the Act for the services identified above because it fails to qualify under section 3(1)(b) and (c) of the Act.

**Dated 9 November 2023**

***Melanie Oliver***

**For the Registrar**

**The Comptroller-General**