

O-177-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2331926  
TO REGISTER A TRADE MARK IN  
CLASSES 5, 9, 16, 41 & 44  
BY NAPP PHARMACEUTICAL HOLDINGS LIMITED**

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by Napp Pharmaceutical Holdings Limited**

### **BACKGROUND**

1. On the 9 May 2003, Napp Pharmaceutical Holdings Limited, Cambridge Science Park, Milton Road, Cambridge, CB4 0GW applied to register the following sign as a trade mark in Classes 5, 9, 16, 41 and 44.

CONTROL PAIN LIVE LIFE

2. The application was made in respect of the following goods and services:

**Class 5:**

Pharmaceutical preparations and substances; all for the treatment, relief and prevention of pain.

**Class 9:**

Video and audio recordings; films; compact discs; DVDs; CD ROMs, computer software; computer software and publications in electronic form [downloadable]; all the aforesaid goods relating to medical, pharmaceutical, life-style and healthcare matters.

**Class 16:**

Printer matter, publications, instructional and teaching materials.

**Class 41:**

Educational, instructional and training services, all relating to pharmaceutical, life-style, medical and healthcare matters; publication of books, texts, and leaflets; production, distribution and rental of videos, films, audio recordings and compact discs.

**Class 44:**

Medical, pharmacy, pharmacology and healthcare services; advisory and consultancy services relating to pharmaceutical, medical and healthcare matters; information services relating to medical, pharmaceutical and healthcare matters.

3. Objection was taken against the mark under Sections 3(1)(b) and (c) of the Act because the mark consisted exclusively of the term "Control Pain Live Life", the

whole being a term which would be seen as no more than an advertising strap line rather than as a badge of trade origin.

4. A hearing was held on 26 January 2005 at which the applicant was represented by Ms K Cameron of Elkington and Fife, Trade Mark Attorneys. The objection was maintained and the application was subsequently refused in accordance with Section 37(4) of the Act.

5. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

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

### **The Law**

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

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

- (a) .....
- (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.”

### **The Case for Registration**

8. In correspondence prior to the hearing the agents requested the deletion of Class 5 from the application and that the specifications of the remaining classes be amended as follows:

#### **Class 9:**

Video and audio recordings; films; compact discs; DVDs; CD ROMs, computer software; computer software and publications in electronic form [downloadable]; all the aforesaid goods relating to medical, pharmaceutical, life-style and healthcare matters; all the aforesaid goods for distribution to and for the education, instruction and teaching of medical professionals and pharmacists.

**Class 16:**

Printer matter, publications, instructional and teaching materials; all the aforesaid goods for distribution to and for the education, instruction and teaching of medical professionals and pharmacists.

**Class 41:**

Educational, instructional and training services, all relating to pharmaceutical, life-style, medical and healthcare matters; publication of books, texts, and leaflets; production, distribution and rental of videos, films, audio recordings and compact discs; all the aforesaid services for the education, instruction and teaching of medical professionals and pharmacists.

**Class 44:**

Medical, pharmacy, pharmacology and healthcare services; advisory and consultancy services relating to pharmaceutical, medical and healthcare matters; information services relating to medical, pharmaceutical and healthcare matters; all the aforesaid services for the education, instruction and teaching of medical professionals and pharmacists.

9. In support of the application submissions were made in correspondence and at the hearing by Ms Cameron, whose principle arguments may be summarised as follows;

The target audience of the mark is now restricted so as to cover medical professionals and pharmacists only. They will not be suffering pain and therefore there is no connotational link between the mark and the goods and services covered. The absence of such a connotational link means that this mark is not devoid of any distinctive character.

An examination of the mark must be carried out in relation to the goods and services covered by the application and the mark CONTROL PAIN LIVE LIFE is not exclusively descriptive in relation to the remaining goods and services now covered.

In view of the restriction of the specification of the goods and services, so as to relate to medical professionals and pharmacists only, the mark is even less descriptive. The medical professionals or pharmacists will not be suffering from any pain and any controlling of pain will be carried out on the general public at large. The medical professionals and pharmacists are merely the conduit of that information and the mark cannot therefore be said to be exclusively descriptive in relation to the target audience of the goods.

## DECISION

10. The mark consists of the slogan CONTROL PAIN LIVE LIFE. The Registrar's practice in relation to such marks is set out in Section 32 of Chapter 6 of the Trade Mark Registry Work Manual and states:

Slogans are registerable as trade marks provided that they have the capacity to individualise the goods or services of one undertaking because they are not comprised of signs or indications which directly describe the goods or services or their essential characteristics, and are not devoid of distinctive character for any other reason.

In 'Das Prinzip Der Bequemlichkeit' ["The Principles of Comfort"] C-64/02 P, the ECJ stated that slogans serving a promotional function which is not obviously secondary to any trade mark meaning will be objectionable because:

*"..... average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogans"* (paragraph 35).

Whilst confirming that there is no justification for applying stricter examination criteria to slogan marks, the ECJ confirmed that slogans may fall alongside other non-conventional trade marks in being a category of mark that the relevant public is slower to recognize as indicating the product of a single undertaking.

However, that is not to say that a slogan has to contain an additional element of imagination or an additional element of originality to be acceptable; in fact, the ECJ expressly said such criteria should not form part of the assessment of a slogan's capacity to distinguish the goods of one undertaking from those of another.

Slogans are, by their very nature, adapted for use in advertising and examination should take full account of notional and fair use in that context. It should be borne in mind that the absence of use of the slogan (or similar) by unrelated parties (eg during a search of the Internet), does not, in itself, mean that the mark is acceptable (that would be the focus of 3(1)(d)) (see the above decision, paragraph 46).

### Sections 3(1)(c)

11. In a judgement issued by the European Court of Justice on 23 October 2003, *Wm. Wrigley Jr. Company v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case 191/01P, (the DOUBLEMINT) case), the Court gave guidance on the scope and purpose of Article 7(1)(c) of the Community Trade Mark Regulation (equivalent to Section 3(1)(c) of the Trade Marks Act). Paragraphs 28-32 of the judgement are reproduced below:

- “28. Under Article 4 of Regulation No. 40/94, a Community trade mark may consist of distinguishing the goods or services of one undertaking from those of other undertakings.
29. Article 7(1)(c) of Regulation No. 40/94 provides that trade marks which consist exclusively of signs or indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or rendering of the service, or other characteristics of the goods or service are not to be registered.
30. Accordingly, signs and indication which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No. 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No. 40/94.
31. By prohibiting the registration of Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No. 40/94 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 sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade mark (OJ 1989 L 40, p.1), *Windsurfing Chiemsee*, PARAGRAPH 25, AND Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECT 1-0000, paragraph 73).
32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No. 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

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

13. The mark consists of the phrase “CONTROL PAIN LIVE LIFE”. In my view the phrase conveys an obvious message in relation to the intended purpose of the goods and services. Control pain would simply be seen as an indication that the goods and services would limit or check any discomfort and live life that the intended purpose was to help the consumer live life to the full. The combination of these two phrases which both describe a characteristic of the goods and services would not give a trade mark message to the average consumer for these goods and services, because they simply convey the message that describes their intended purpose.

14. The trade mark applied for must be assessed by reference to how the mark is perceived by the relevant consumer. Ms Cameron’s argument is based on this point. It is accepted that medical personnel would be consumers of these goods and services but I see no reason why members of the public suffering pain, and their friends or relatives, should not also be consumers, particularly of the goods in Classes 9 and 16.

15. The mark at issue here consists of the two phrases, but there is no graphic or semantic modification employed in bringing these two phrases together which combines them with any additional characteristic to render the sign as a whole capable of distinguishing the applicants’ products from those of other traders.

16. I am of the view that the phrase “CONTROL PAIN LIVE LIFE” is not an unusual way of designating a characteristic of the applicant’s goods and services and therefore the public could not distinguish them from those provided by other undertakings. Although the phrase does not appear to be defined in any dictionary, in the context of the goods and services sold under the mark, it sends out an unequivocal message about the nature and purpose of these goods and services. This conclusion applies to video and audio recordings and publications in electronic format in Class 9, printed matter and publications in Class 16, educational and training services in Class 41, and medical and healthcare services in Class 44. The mark conveys to consumers of these goods and services that they are intended to help in the controlling of pain and thus in living life to the full.

17. Ms Cameron contended that the combination created was not the natural way of referring to the goods and services or a characteristic of them. I reject the argument. It seems to me that although arguably grammatically incomplete, an obvious message is conveyed by the mark and I therefore reach the conclusion that the mark designates a characteristic of the goods and services and is debarred from registration under Section 3(1)(c) of the Act

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

18. Having found that the mark fails to qualify under Section 3(1)(c) of the Act, I now go on to consider whether it is eligible for registration under Section 3(1)(b). The purpose of Section 3(1)(b) of the Act is to prohibit registration of signs which, although not caught by the parameters set out by Sections 3(1)(c) and (d) of the Act are, nevertheless, incapable of distinguishing the goods and services of one undertaking from those of other undertakings. Each of the grounds for refusal is to be examined independently, although they may overlap on occasions.

19. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act was summarized by the European Court of Justice in paragraph 37, 39 to 41 and 47 of its Judgment in Joined Cases C-53/01 to C-55/01 *Linde AHG, Windward Industries Inc and Rado Uhren AG* (8<sup>th</sup> April 2003) in the following terms:

“37. It must first of all be observed that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips* [2002] ECR I-5475, paragraph 35).

41. In addition, a trade mark’s distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second the perception of the relevant persons, namely the consumers of the goods or services. According to the Court’s case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *But Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings”.

20. I must assess the mark’s distinctiveness in relation to the goods and services for which the applicant seeks registration and I must have regard to the perception of the average consumers of the goods and services. Even if the consumers could be regarded as being limited to healthcare professionals, and even if the agent is correct in stating that the “LIVE LIFE” part of the mark is not descriptive of the intended purpose of the goods and services as far as they are concerned, it does not follow that they will because of this regard the marks as a whole as conveying a trade mark message. Rather they will understand it as being a description of the intended purpose of the goods and services as far as their patients are concerned.

21. I must of course assume notional and fair use of the mark in relation to the goods applied for, which includes use on the packaging of the goods as well as use in advertising, wherein it is customary for advertisements to use abbreviated language, a notion endorsed by Mr Simon Thorley QC sitting as the Appointed Person in “*Where all your favourites come together*” (BL O/573/01).

22. Whether the applicant’s mark is used on the goods or services, the packaging or in advertising, it seems to me that the phrase “Control pain live life” gives a message that the goods and services are intended to provide advice on how to control pain and live life to the full. The combination describes the intended purpose of the goods and services would not give a trade mark message in relation to these goods and services.

23. In paragraphs 21-24 of its Judgement in the “*Companyline*” Decision (Case C-104/00) of the ECHJ found no error in the reasoning of the Court of First Instance to the effect that “Coupling the words “company” and “line” – both of which are customary in English speaking countries – together, without any graphic or semantic modification, does not imbue them with any additional characteristic such as to render the sign, taken as a whole, capable of distinguishing DKV’s services from those of other undertakings.” In paragraphs 31-36 of its Judgement the Court specifically rejected the appellant’s contention that the mark at issue should not have been refused registration under Section 3(1)(b) (Article 7(1)(b) CTMR) without consideration of the question whether it was free of objection under Section 3(1)(c) (Article 7(1)(c) CTMR).

24. The mark at issue here consists of two phrases rather than two words, but there is no graphic or semantic modification employed in bringing these two phrases together which imbues them with any additional characteristic to render the sign as a whole capable of distinguishing the applicant’s products from those of other traders.

25. The fact that the total combination of words in the mark may not be a grammatically complete description of the goods is not sufficient to avoid an objection under Section 3(1)(b), and this was endorsed by the Court of First Instance in *Best Buy Concepts v OHIM* [2004] ETMR 19:

“20..... the marks referred to in Article 7(1)(b) of Regulation No 40/94 [Section 3(1)(b) of the Act] are, in particular, those which do not enable the relevant public to repeat the experience of a purchase, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition of the goods or services concerned (Case T-79/00 *Rewe Zentral v OHIM (LITE)* [2002] ECR II-705, paragraph 26). Such is the case of *inter alia* signs which are commonly used in connection with the marketing of the goods or services concerned.

21. However, registration of a trade mark which consists of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark is not excluded as such by virtue of such use (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 40). A sign which fulfils functions other than that of a trade mark in the traditional sense of the term is only distinctive for the purposes of Article &(1)(b) of Regulation No 40/94

however, if it may be perceived immediately as an indication of the commercial origin of the goods or services of the owner of the mark from those of a different commercial origin.

.....

30. The argument presented by the applicant at the hearing which acknowledged the indubitable semantic content of the word mark in question but maintained that it tells the consumer nothing about the content or the nature of the services offered is irrelevant. For a finding that there is no distinctive character, it is sufficient to note that the semantic content of the word mark, the principal and dominant element of the mark in question, indicates to the consumer a characteristic of the services relating to its market value which, whilst not specific, comes from information designed to promote or advertise which the relevant public will perceive first and foremost as such rather than as an indication of the commercial origin of the services (see, to this effect, REAL PEOPLE REAL SOLUTIONS, paragraphs 29 and 30). In addition, the mere fact that the semantic content of the word mark **best buy** does not convey any information about the nature of the services concerned it's not sufficient to make that sign distinctive."

26. It seems to me unlikely that the relevant consumer would consider this mark to denote trade origin, because it will be seen simply as a slogan designed to promote or advertise the goods by reference to desirable characteristics of the contents of the goods and the results to be gained from using them. The elliptical nature of the mark does not make it any more likely to denote that the goods originate from one particular trader, because the public are used to seeing shorthand used in the promotion of goods.

27. The test for registering slogans is no different than for any other type of mark but as slogans are often used for advertising purposes they may not be so readily accepted by the general public as an indication of trade sources as would more traditional signs such as words, brands, logos and figurative marks (see the Judgement of the Court of First Instance in "REAL PEOPLE REAL SOLUTIONS" – Case T0130/01 5 December 2002).

28. I am not persuaded that the mark CONTROL PAIN LIVE LIFE in totality is distinctive in that it would serve in trade to distinguish the applicant's goods from those of other traders. In my view the mark applied for will not be identified as a trade mark without first educating the public that it is one. 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**

28. In this decision I have considered all the documents filed by the applicants and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because the mark fails to qualify under Sections 3(1)(b) and (c) of the Act.

**Dated this 24<sup>th</sup> day of June 2005**

**IAN PEGGIE  
For the Registrar  
the Comptroller-General**