

## TRADE MARKS ACT 1994

### IN THE MATTER OF APPLICATION NO 3225166 TO REGISTER THE SIGN 'CHECKYOURPAY' IN CLASS 35 IN THE NAME OF CHECKYOURPAY LIMITED

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#### DECISION

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#### Introduction

1. This is an appeal against the decision of Ms Helen Davies, acting for the Registrar, dated 20 November 2017 (O-579-17) in which she refused registration for the sign CHECKYOURPAY pursuant to section 3(1)(c) and section 3(1)(b) of the Trade Marks Act 1994 ("*the 1994 Act*").
2. At the hearing of the appeal Checkyourpay Limited ("*the Applicant*") did not appear and requested that the Form TM55 be considered as the written representations on behalf of the Applicant for the purposes of the appeal. Mr. Andrew Feldon appeared on behalf of the Registrar having previously submitted a skeleton of argument.

#### The Application

3. On 15 April 2017 the Applicant filed an application for the mark CHECKYOURPAY for the following services:  
  
Class 35: Payroll advisory services
4. On 24 April 2017, the Examiner, on behalf of the Registrar, issued an examination report in response to the application. In that report, an objection was raised under sections 3(1)(b) and (c) of the 1994 Act. The Examiner indicated that the basis for the refusal was that '*the mark consists exclusively of the conjoined words CHECKYOURPAY, being a sign which may serve in trade to designate the intended purpose of the services e.g. payroll advisory services that will "check your pay" to see if correct payments and/or adjustments have been made*'.
5. On 26 April 2017, Mr. Michael Boyle (the signatory on the application form) contacted the UKIPO by telephone. In the course of the conversation with a trade mark examiner Mr Boyle was informed *inter alia* about the option of requesting an *ex parte* hearing and was directed to the relevant part of the UKIPO website with regards to the preparation of evidence in support of a claim for acquired distinctiveness.
6. The Applicant made no further submissions, filed no evidence of use for the purposes of demonstrating acquired distinctiveness and did not request an *ex parte* hearing.

7. On 10 July 2017 the application was refused. On 18 July 2017 a Form TM5 requesting a full statement of reasons for the Registrar's decision was filed at the UKIPO. Pursuant to that request a Decision was issued by the Examiner on 20 November 2017.
8. Given the position as noted in paragraph 6 above and as the Examiner noted in paragraph 5 of her Decision it was only necessary for the Examiner to consider the *prima facie* position.
9. The key findings of the Examiner in relation to the mark applied for in relation to section 3(1)(c) of the 1994 Act were set out in paragraphs 8 to 13 of her Decision:

8. The services intended for protection under the mark are listed as being 'payroll advisory services', which are proper to class 35. In the course of determining the exact nature of services/activities provided by the applicant within the scope of this term, I have taken into consideration the following definition provided in Collins English Dictionary:

**payroll** *noun* a list of a company's employees and the amount of money they are to be paid: there are just three employees on the payroll; the total amount of wages paid by a company: small employers with a payroll of less than £45,000.

A company's 'payroll' would include the name of each employee, as well as details of their salary. It could also include information on employees' hourly rate of pay; any applicable allowances; the number of hours worked per week/month; payment dates; statutory sick payments; holiday payments; and pension contributions. It would also include the total amount of wages paid by the company.

9. I am aware that it is a criminal offence for employers to pay less than the National Minimum Wage (NMW) or the National Living Wage (NLW), meaning that businesses have an obligation to ensure they make the correct payments to their employees. At the same time, it is important that employees are aware of the payments they receive, so that they can ensure they are being fairly paid. With both employers and employees having sound reasons for checking payrolls and payments, it is reasonable to assume that providers would offer payroll advisory to both employers and employees. It is also reasonable to assume that the term 'Payroll advisory services' could encompass the provision of a broad range of payroll and pay information, including such information as listed at paragraph 8 above. Such services could also be provided in-person, or via remote means such as through the Internet or telephone.

10. In relation to identifying the relevant consumer, I have already stated that the term 'Payroll advisory services' refers, in my view, to activities which can be directed at both employer and employee. In respect of the former, the relevant consumer could be a professional within the payroll, human resources, finance and/or general administrative sector. And in respect of the latter, the relevant consumer would be anyone in employment who may utilise such services to seek advice about personal pay issues. Given the legal obligations on employers, and the obvious importance of salary payment to an employee, it is reasonable to believe that the consumers' attention levels when utilising such services would be reasonably high.

11. Having considered the type of activities encompassed within the classification, identified the relevant consumer, and established the likely level of attention, I must now determine how the average consumer will perceive the mark when used in respect of the services claimed. The individual words included in the sign 'CHECKYOURPAY' are defined in the Oxford Dictionary as:

**check** *verb* examine (something) in order to determine its accuracy, quality, or condition, or to detect the presence of something; verify or establish to one's satisfaction; verify the accuracy of something by comparing it with (something else); look at, take notice of.

**your** *possessive determiner* belonging to or associated with the person or people that the speaker is addressing; belonging to or associated with any person in general.

**pay** *noun* the money paid to someone for regular work: an entitlement to sickness pay.

In my opinion, when viewed in the prima facie case, the sign 'CHECKYOURPAY' used in respect of payroll advisory services would be understood as a reference to that product's ability to check, cross reference, or verify a salary payment. By doing so, the sign would be perceived as nothing more than a readily comprehensible sign designating the services' intended purpose. From the perspective of the employer, the sign indicates that the product enables one to check salary payment amounts being allocated to employees. And from the perspective of the employee, it indicates that one can check that the correct amount of salary has been received via reference to the advisory service. Indeed, on encountering the sign for the first time, the consumer would expect that the service in respect of which it is used enables him/her to check their pay.

12. It is also my view that conjoining the three words does not add any inherent distinctiveness to the mark. The conjoined presentation would be perceived as nothing more than a minor (and inherently non-distinctive) presentational variation on the more conventionally-presented phrase ‘check your pay’.

13. In considering the relationship between the services claimed (‘payroll advisory services’), and the sign itself (‘CHECKYOURPAY’), the dictionary definition provided at paragraph 8 above confirms that a ‘payroll’ is a list of the company’s employees and the amount of money they are paid (their pay). It is therefore my view that there is a direct and specific correlation between the terms ‘payroll’ and ‘pay’ which, in turn, influences the extent to which the relevant consumer also identifies a direct relationship between the expression ‘CHECKYOURPAY’ and payroll advisory services. The relevant consumer will immediately perceive the mark, without further thought, as being a description of the intended purpose of those services i.e. payroll advisory services that enable you to check your pay.

10. Having gone on to consider the section 3(1)(b) objection the Examiner concluded in paragraph 19 of her Decision as follows:

For the reasons given above, I consider the sign to be descriptive of the intended purpose of the services pursuant to section 3(1)(c) and, by inference, also devoid of any distinctive character. In the event of it not being descriptive, I have also presented my reasons as to why the sign is objectionable under section 3(1)(b) in its own right. For the reasons given above, the application is therefore refused under the terms of section 37(4) of the Act because it fails to qualify under sections 3(1)(b) and 3(1)(c).

### **The appeal**

11. The Applicant filed a Form TM55, dated 28 November 2017, in which the reasons for appeal were stated to be as follows:

I consider that the application should be accepted on the same grounds as other similar applications.

The following similar applications have been accepted:

WEBUYANYCAR	UK00002541644
Webuyanycar.com	UK00002442651
checkyourcar	EU009240979
Check Your Cash	EU009305525

Objections are based on (i) description of a service and (ii) lack of distinctiveness. I note, for example, that ‘webuyanycar’ is clearly the description of a service and is not exclusively distinctive. There are many car dealers who ‘buy any car’. I see no difference to my application which should be similarly accepted.

Advertising of “checkyourpay” by the company, and also “checkyourpay.co.uk” which is a unique phrase and aligned to “checkyourpay”, serves to identify the distinctiveness of “checkyourpay” as distinct from payroll service providers who offer the provision of payroll services rather than the exercise of “checking your pay”.

12. No other material, whether in the form of written materials or otherwise, was filed in connection with the appeal.

### **Standard of Review**

13. An appeal against decisions taken by the Registrar is by way of review. Neither surprise at an Examiner’s conclusion, nor a belief that she has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Examiner was wrong. See Reef Trade Mark [2003] RPC 5; BUD Trade Mark [2003] RPC 25; and more recently the decision of Geoffrey Hobbs Q.C. sitting as the Appointed Person in ALTI Trade Mark (O-169-16) at paragraphs [19] to [20]; the decision of Daniel Alexander Q.C. sitting as the Appointed Person in Talk for Learning Trade Mark (O-017-17) referred to by Arnold J. in Apple Inc. v. Arcadia Trading Ltd [2017] EWHC 440 (Ch); and the judgment of Daniel Alexander Q.C. sitting as a Deputy Judge in the High Court in Abanka D.D. v. Abanca Corporación Bancaria S.A. [2017] EWHC 2428 (Ch).
14. It is necessary to bear these principles in mind on this appeal.

### **Decision**

15. The reasons for the Appeal are set out in full at paragraph 11 above. There is no suggestion in these reasons that the Examiner applied the wrong legal tests.
16. Instead, in substance, what the Applicant appears to rely upon on this appeal to challenge the Examiner’s findings are:
  - (1) Four trade other marks that have been accepted for registration in the UK and at the Community level;

- (2) That the advertisement of “checkyourpay” by the Applicant and the use of “checkyourpay.co.uk” serves to identify the distinctiveness of the mark; and
  - (3) That payroll services should not be equated with the exercise of “checking your pay”.
17. With regard to the first ground of appeal there are two points. First this was not a point that was raised before the Examiner. Second even had it been raised before the Examiner in my view it could not have provided a proper basis for the acceptance of the application.
18. This is because what is often referred to as ‘state of the register’ evidence is of no assistance i.e. is irrelevant to the assessment that the Examiner was required to make. The reason for this is as stated by Jacob J (as he then was) in British Sugar Plc v James Robertson & Sons Ltd [1996] RPC 281, 305:

In particular, the state of the Register does not tell you what is actually happening out in the market, and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the Register. It has long been held under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *Madame TM*, and the same must be true under the 1994 Act.”
19. That this is the correct approach is illustrated by the circumstances in the present case where as pointed out on behalf of the Registrar three of the four registrations relied upon by the Applicant are in fact registrations for device marks and not applications for word marks i.e. the circumstances of the applications are on the face of the registrations different.
20. Turning to the second ground of appeal, again this was not a point that was raised before the Examiner at any stage despite the Applicant being given every opportunity to both raise and provide evidence in support of a claim to acquired distinctiveness. The Examiner considered the *prima facie* position. On the material before her she was entirely right to do so.
21. In my view, the Applicant cannot at this late stage seek to raise and rely upon what appears to be a claim to acquired distinctiveness in support of the application. This is all the more the case in circumstances where: (1) there has been no attempt to provide any *evidence* to support a claim to acquired distinctiveness; and (2) no attempt has been made to make an application for permission to rely upon such evidence on appeal.

22. Finally as a preliminary point with regard to the third ground of appeal, that the exercise of checking your pay is not to be equated with i.e. is distinct from payroll services, I note that the Applicant did not take the opportunity after the issuance of the examination report to make any submissions, set out in paragraph 4 above, to overcome the objections under either section 3(1)(c) or section 3(1)(b) of the 1994 Act.
23. In reaching the decision that she did the Examiner found that:
- (1) *Prima facie* the sign 'CHECKYOURPAY' used in respect of payroll advisory services would be understood as a reference to that product's ability to check, cross reference, or verify a salary payment (paragraph 11 of the Decision);
  - (2) From the perspective of the employer, the sign indicates that the product enables one to check salary payment amounts being allocated to employees. And from the perspective of the employee, it indicates that one can check that the correct amount of salary has been received via reference to the advisory service (paragraph 11 of the Decision);
  - (3) The relevant consumer would immediately perceive the sign 'CHECKYOURPAY' as being a description of the intended purpose of the services namely payroll advisory services that enable you to check your pay (paragraphs 11, 13 and 17 of the Decision); and
  - (4) Conjoining the three words, 'check', 'your' and 'pay' does not add any inherent distinctiveness to the mark. The conjoined presentation would be perceived as nothing more than a minor (and inherently non-distinctive) presentational variation on the more conventionally-presented phrase 'check your pay' (paragraph 12 of the Decision).
24. It seems to me that these were findings that the Examiner was entitled to make. Nothing in the reasons for appeal provide any support for suggesting otherwise.

### **Conclusion**

25. In the end, it is in my view clear that each case must be determined on its own facts and in accordance with the law. The Applicant has not persuaded me that the Examiner was wrong to refuse the trade mark application. In my view it was open to the Examiner to come to the conclusion that she did on the materials that were before her.
26. In the circumstances, in the absence of any evidence of acquired distinctiveness the trade mark application should be refused pursuant to sections 3(1)(c) and 3(1)(b) of the 1994 Act.

27. The appeal from the Examiner's Decision is dismissed. In accordance with the usual practice, the appeal is dismissed with no order as to costs.

Emma Himsworth Q.C.  
Appointed Person

21 March 2018

The Applicant did not appear at the hearing of the Appeal  
Mr. Andrew Feldon appeared on behalf of the Registrar