

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION Nos. 3096966 AND 3096964  
IN THE NAME OF NEWSKO INSIDER LIMITED**

**AND IN THE MATTER OF OPPOSITIONS Nos. 404402 AND 404403 THERETO  
BY BUSINESS INSIDER INC.**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON  
BY THE OPPONENT  
AGAINST A DECISION BY MR M. BRYANT DATED 24<sup>TH</sup> JANUARY 2017**

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**DECISION**

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**Introduction**

1. This is an appeal by Business Insider, Inc. of 150 Fifth Avenue, 8<sup>th</sup> Floor, New York, NY, USA (“the Opponent”) against a decision of Mr. Mark Bryant, the Hearing Officer for the Registrar, dated 24<sup>th</sup> January 2017, BL O/021/17. In that decision, Mr. Bryant dismissed the oppositions in their entirety against Applications numbers 3096966 and 3096964 standing in the name of Newsco Insider Limited of Boulton House, 17-21 Chorlton Street, Manchester, UK (“the Applicant”).

**Application Nos. 3096966 and 3096964**

2. Application numbers 3096966 and 3096964 were filed by the Applicant on 2<sup>nd</sup> March 2015 requesting registration of the designations BUSINESS INSIDER and INSIDER respectively for use as trade marks in the UK in relation to the following goods and services<sup>1</sup>:

Class 9

Software; computer software; application software; electronic publications; downloadable publications; downloadable audio-visual recordings; downloadable audio files; downloadable image files

Class 16

Paper; cardboard; printed matter; printed publications; newspapers; magazines; newsletters; supplements; periodicals; brochures; books; posters; photographs; pictures; calendars; diaries; stationery

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<sup>1</sup> Identical for both applications.

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### Class 35

Advertising services; publicity services; marketing services; promotional services; provision of advertising space in publications; compilation of directories; subscription services; commercial information; business information; arranging and conducting trade shows, exhibitions and events; information, advisory and consultancy services relating to the aforesaid services; all the aforesaid services also provided online from a computer database or via the internet

### Class 41

Publishing services; magazine publication; publication of printed matter; electronic publication; news reporting services; education and entertainment information services; arranging and conducting conferences, exhibitions, seminars and events; all the aforesaid services also provided online from a computer database or via the internet

### **Oppositions Nos. 404402 and 404403**

3. On 28<sup>th</sup> May 2015, the Opponent opposed the applications on absolute grounds under Section 3 of the Trade Marks Act 1994 (“the Act”):
  - 1) Application number 3096966, BUSINESS INSIDER, under Section 3(1)(b) and (c) (non-distinctive/descriptive) and Section 3(6) (application in bad faith).
  - 2) Application number 3096964, INSIDER, under Section 3(1)(a), (b), (c) and (d) (not capable of distinguishing/non-distinctive/descriptive/generic) and Section 3(6) (application in bad faith).
4. The Applicant took issue with the grounds for refusal, and to any necessary extent relied on acquired distinctiveness through use pursuant to the proviso to Section. 3(1).
5. The oppositions were consolidated by the UKIPO with both parties filing evidence and came to be heard by Mr. Bryant on 17<sup>th</sup> November 2016.

### **The Hearing Officer’s decision**

6. The main points of the Hearing Officer’s decision were as follows:
  - (a) The objection against INSIDER under Section 3(1)(a) was not pursued (para. 15).
  - (b) It was conceded by the Opponent that if the Section 3(1)(c)/(d) objections failed so too would the objections under Section 3(1)(b) (para. 17 citing the decision of Ms. Anna Carboni sitting as the Appointed Person in *COMBI STEAM Trade Mark*, BL O/363/09).
  - (c) The objections centred on news publications. The Hearing Officer would focus his considerations on those goods whilst bearing in mind the other goods and services listed (paras. 19, 24 and 27).

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- (d) The relevant public constituted the general public and business to business users (para. 20).
- (e) The marks were allusive of the information (i.e., “inside” information/business information) contained in but did not describe the characteristics of the Applicant’s goods and services such as “downloadable publications” in Class 9, “periodicals” (such as news publications) in Class 16 or “news reporting services” in Class 41. That was also true in respect of the Applicant’s other goods and services where connections were remoter (paras. 21 – 27).
- (f) The Section 3(1)(c) ground failed in its entirety against BUSINESS INSIDER and INSIDER (para. 28).
- (g) The evidence failed to demonstrate that INSIDER was customary in the language and/or established practices of the trade within the meaning of Section 3(1)(d)<sup>2</sup> (para. 33).
- (h) There was no basis in the claim of bad faith under Section 3(6). To the contrary, the applications were legitimately made seeking to protect the Applicant’s claimed pre-existing rights in BUSINESS INSIDER/INSIDER against the Opponent’s entry into the UK market (paras. 40 – 43).
- (i) Subject to any appeal, the Opponent would be ordered to pay to the Applicant its costs in the oppositions in the sum of £1,900 (paras. 45 – 46).

### **The Appeal**

- 7. On 21<sup>st</sup> February 2017, the Opponent filed Notice of appeal to the Appointed Person against the Hearing Officer’s decision under Section 76 of the Act.
- 8. The grounds of appeal were directed against the Hearing Officer’s applications (or lack of them) of the grounds for refusal under Section 3(1)(c) and (b) (BUSINESS INSIDER and INSIDER) of the Act. There was no appeal against the Hearing Officer’s determinations under Section 3(1)(d) (INSIDER) or Section 3(6) (BUSINESS INSIDER and INSIDER) of the Act.
- 9. On 15<sup>th</sup> March 2017, the Applicant filed a Respondent’s notice under Rule 71(4) of the Trade Marks Rules 2008. The Applicant contended that:
  - (a) The Appointed Person should uphold the Hearing Officer’s decision for the reasons given in that decision.
  - (b) Alternatively, were the Appointed Person to overturn the Hearing Officer’s decision under Section 3(1)(c)/(b), the Appointed Person was invited to decide the question of acquired distinctiveness of the Applicant’s marks under the proviso to those sub-paragraphs of Section 3(1).

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<sup>2</sup> BUSINESS INSIDER was not opposed under Section 3(1)(d).

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10. It was accepted by both parties that the Applicant's evidence of acquired distinctiveness through use was not considered by the Hearing Officer in his decision beyond the mere mention of its filing. Nor was the Applicant's claim to have established acquired distinctiveness for its marks under the proviso to Section 3(1) dealt with, let alone determined by the Hearing Officer in his decision.
11. In correspondence directed through, and copied to me by the Government Legal Department, the Opponent strongly argued that in the event that the Opponent's appeal succeeded, the proper course of action would be for the Appointed Person to remit the question of acquired distinctiveness to the Registry for a first determination since otherwise the Opponent could be deprived of a right of appeal (*ONLINE PALLET Trade Mark*, BL O/427/11, para. 10).
12. It transpired that in a letter from the Applicant's representatives, Haseltine Lake, to the Opponent's representatives, Pillsbury, dated 13<sup>th</sup> July 2017 (copied to me only after the hearing) the Applicant agreed not to resist any order for remittance to the Registry should the issue of acquired distinctiveness arise for determination, and the Applicant confirmed to me at the hearing, sensibly in my view, that this continued to be the Applicant's position.

### Preliminary issue

13. At the hearing before the Hearing Officer, the parties were both represented by Queen's Counsel who were also appointed as the Appointed Person to hear and determine appeals from decisions of the Registrar under Section 77 of the Act.
14. The Opponent signified its intention newly to be represented by Mr. Guy Hollingworth of Counsel<sup>3</sup> instructed by Pillsbury at the appeal hearing.
15. Following the receipt of confirmation that the Applicant planned to continue to be represented at the appeal hearing by its original choice of Queen's Counsel, the Opponent objected to this continued representation.
16. After hearing the parties at a preliminary hearing, I issued a decision on this preliminary issue on 28<sup>th</sup> December 2017 under reference number BL O/004/18.
17. I decided that in the absence of the informed consent of the other party in accordance with the "*Munroe*" practice of the Appointed Person (*Munroe's Application*, BL O/220/08, [2009] RPC 16), it was not in accordance with Article 6 of the European Convention for the Protection of Human Rights and Fundamental Freedoms, 1950 for a party to be represented at an appeal hearing before the Appointed Person by an advocate who is himself/herself also appointed to sit as the Appointed Person.
18. As a separate matter, and irrespective of the outcome of this appeal, the Opponent now sought an order for costs in relation to the hearing of that preliminary issue.

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<sup>3</sup> Not an Appointed Person.

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19. Mr. Jonathan Hill of Counsel<sup>4</sup>, instructed by Haseltine Lake, who appeared for the Applicant before me at the hearing of the substantive appeal, signified his client's agreement that the Opponent was entitled to the costs of the preliminary hearing but on the standard scale (not disputed by the Opponent).
20. I am grateful to the parties for avoiding any unnecessary argument at this stage on these 2 above-mentioned issues (remittance, if appropriate; costs of the preliminary hearing), and for their full and lucid arguments in the matter of the substantive appeal.

### Standard of review

21. Both parties were agreed that I should be guided by the summary of principles set out by Mr. Daniel Alexander Q.C. sitting as the Appointed Person in *TALK FOR LEARNING Trade Mark*, BL O/017/17<sup>5</sup>, para. 52 (cited with approval by Arnold J. in *Apple Inc. v. Arcadia Trading Limited* [2017] EWHC 440 (Ch), para. 11):

“(i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR 52.11). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong (Patents Act 1977, CPR 52.11).

(ii) The approach required depends on the nature of decision in question (*REEF*). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (*REEF, DuPont*).

(iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (*Re: B* and others).

(iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country* and others).

(v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong

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<sup>4</sup> Again, not an Appointed Person.

<sup>5</sup> [2017] RPC 17.

(c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be “clearly” or “plainly” wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (*Re: B*).

(vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF, Henderson* and others).

22. Mr. Hill additionally drew my attention to the observation of Lord Kerr in *DB v. Chief Constable of Northern Ireland (Northern Ireland)* [2017] UKSC 17, paragraph 80, that even when not based on oral evidence, a first instance decision:

“... should be seen as the "main event" rather than a "tryout on the road" ... A first instance judgment provides a template on which criticisms are focused and the assessment of factual issues by an appellate court can be a very different exercise in the appeal setting than during the [hearing]. Impressions formed by a judge approaching the matter for the first time may be more reliable than a concentration on the inevitable attack on the validity of conclusions that he or she has reached which is a feature of an appeal founded on a challenge to factual findings ...”

23. Whilst accepting that the Hearing Officer’s decision was not a “tryout”, Mr. Hollingworth urged on me sub-paragraphs (iv) and (v) of Mr. Alexander’s summary in *TALK FOR LEARNING*.

### **Grounds of appeal**

24. The grounds of appeal were three-fold. It was contended that the Hearing Officer erred in:
- (1) taking into account irrelevant matters by drawing inferences from evidence that was in principle irrelevant (para. 2, Grounds of appeal);
  - (2) adopting an impermissibly narrow approach to the scope of Section 3(1)(c) (para. 3, Grounds of appeal);
  - (3) failing to consider each of the goods and services in the applications (para. 4, Grounds of appeal).

**Section 3(1)(c)**

25. It is convenient at this point to remind oneself of the wording of Section 3(1)(c) (Article 3(1)(c) of Directive 2008/95/EC, Article 7(1)(c) of (at the time) Regulation (EC) 207/2009 (now Regulation (EU) 2017/1001) (“EUTMR”):

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

[ ... ]

(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 ...”

26. The Hearing Officer instructed himself by reference to Arnold J.’s comprehensive statement of applicable principles under Section 3(1)(c) (largely gleaned from the CJEU’s summary in Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z o.o. v. OHIM* [2011] ECR I-1541) in *Starbucks (HK) Limited v. British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) at paragraph 91 (restated by Arnold J. in *W3 Ltd v. easyGroup Ltd* [2018] EWHC 7, para. 154).
27. I do not intend to repeat that statement here since it is set out in full in the Hearing Officer’s decision (para. 18).
28. However, I will set out an equivalent statement by the General Court of the EU (“GCEU”) in Case T-804/16, *LG Electronics, Inc. v EUIPO* EU:T:2018:8, which as Mr. Hill commented, frequently appears in similar form in GCEU decisions concerning Article 7(1)(c) of the EUTMR:

“15. Article 7(1)(c) of Regulation No 207/2009 provides that 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 or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service are not to be registered ...

16. The Court recalls that the general interest underlying Article 7(1)(c) of Regulation No 207/2009 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (judgments of 23 October 2003, *OHIM v Wrigley*, C-191/01 P, EU C :2003 :579, paragraph 31, and of 10 March 2011, *Agencja Wydawnicza Technopol v OHIM*, C-51/10 P, EU C :2011 :139, paragraph 37).

17. By using, in Article 7(1)(c) of Regulation No 207/2009, the terms ‘the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’, the EU legislature made it clear, first, that those terms must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of

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goods or services may also be taken into account (judgment of 10 March 2011, *Agencja Wydawnicza Technopol v OHIM*, C-51/10 P, EU C :2011 :139, paragraph 49).

18. The fact that the EU legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 207/2009 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought (judgment of 10 March 2011, *Agencja Wydawnicza Technopol v OHIM*, C-51/10 P, EU C :2011 :139, paragraph 50). Thus, a sign may be refused registration on the basis of Article 7(1)(c) of Regulation No 207/2009 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see judgment of 10 July 2014, *BSH v OHIM*, C-126/13 P, not published, EU:C:2014:2065, paragraph 22 and the case-law cited).

19. The case-law has also stated that, for the purposes of applying Article 7(1)(c) of Regulation No 207/2009, it is necessary to consider whether, from the viewpoint of the relevant public, there is a sufficiently direct and specific relationship between the sign for which registration as a mark is sought and the goods or services concerned that enables that public immediately to perceive, without further thought, a description of those goods or services, or one of their characteristics (judgment of 19 April 2016, *Spirig Pharma v EUIPO (Daylong)*, T-261/15, not published, EU :T :2016 :220, paragraph 19; see also, to that effect, judgment of 28 June 2012, *XXXLutz Marken v OHIM*, C-306/11 P, not published, EU:C:2012:401, paragraph 79).

20. Furthermore, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive but it is sufficient that the sign could be used for such purposes for it to be caught by the absolute ground for refusal laid down in Article 7(1)(c) of Regulation No 207/2009 (see judgment of 14 June 2017, *LG Electronics v EUIPO (Second Display)*, T-659/16, not published, EU :T :2017 :387, paragraph 21 and the case-law cited).

21. Lastly, it should also be noted that the descriptiveness of a sign may be assessed only, first, by reference to the way in which it is understood by the relevant public and, secondly, by reference to the goods or services concerned (judgment of 30 September 2015, *Ecolab USA v OHIM (GREASECUTTER)*, T-610/13, EU :T :2015 :737, paragraph 19). ”

29. As this passage from the GCEU makes clear, to fall foul of Section 3(1)(c) the meaning(s) conveyed by the contested sign must be sufficiently concrete in order immediately and without further reflection to create a specific and direct link with a description of the goods and services in question or one of their characteristics in the minds of the relevant public.
30. I accept, therefore, Mr. Hill’s point that the test is a question of degree. It seems to me that this was recognised by AG Jacobs in his Opinion in Case C-191/01, *OHIM v. Wm. Wrigley Jr. Company* [2003 I-12447:

“57. There is clearly a line to be drawn between terms which may be used to *designate* products or their characteristics and those which are merely suggestive of such characteristics. The latter may be registered and are obviously of great value to the trade mark owner.

58. Exactly where that line is to be drawn is however less clear. In each case, there will come a point where an individual decision must be made.

[ ... ]

61. It seems obvious that there is no clear-cut distinction between indications which designate a characteristic and those which merely allude suggestively to it. There is no precise point at which a term suddenly switches from one category to the other, but rather a sliding scale between two extremes and an element of subjective judgment will often be required in order to determine to which extreme a term is closer ...”<sup>6</sup>

and also Mr. Geoffrey Hobbs QC sitting as the Appointed Person in relation to word and device marks in *FLYING SCOTSMAN Trade Mark*, BL O/313/11<sup>7</sup> (paras. 19 and 29).

31. For this reason, although the authorities referred to me provided interesting examples, like the Hearing Officer I found them of limited assistance. It is well established that each case must be decided on its facts, and none of the authorities mentioned were on all fours with the present cases.

### **Ground 1**

32. The allegation here was that the Hearing Officer took into account evidence that was irrelevant to the question of inherent descriptiveness in hand.
33. Mr. Hollingworth directed me to paragraph 23 of the decision where the Hearing Officer listed the arguments advanced by the Applicant in favour of its contention that the marks were insufficiently directly descriptive (I avoid use of the term “merely allusive” at this stage since so-called “allusion” was the subject of much debate among Counsel in connection with the second ground of appeal).
34. The first 4 of those arguments related to the Applicant’s own use and the uses by other traders including the Opponent of the designations BUSINESS INSIDER and INSIDER to indicate the source of their own respective goods and services shown in the parties’ evidence against and in support of the Applications.

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<sup>6</sup> AG Jacobs proposed (paras.62 – 64) a 3-points of view test to assess descriptiveness in any particular case: (i) the relationship between the sign and products; (ii) the public perception of the sign; and (iii) the significance of the characteristic in relation to the product in the consumer’s mind, but this was not applied by the CJEU who decided the case shortly on the meaning of “exclusively” descriptive in art. 7(1)(c).

<sup>7</sup> [2012] RPC 7.

35. Mr. Hollingworth referred me to a passage in the CJEU judgment in *Agencja* where the CJEU observed that it was “of no relevance to know the number of competitors who have an interest, or might have an interest, in using the sign in question” (para. 39).
36. However, that was in the context of whether it was necessary to show in order to justify the objection that other traders were using the sign descriptively<sup>8</sup>. It goes without saying that use by other traders of the designation as a trade mark cannot go to proving descriptive use (*Nude Brands Limited v. Stella McCartney Limited* [[2009] EWHC 2154 (Ch), para. 29).
37. Nevertheless, that does not mean that the reverse is untrue. In Case C- 329/02 P, *SAT.1 SatellitenFernsehen GmbH v. EUIPO* [2004] I-8317, the CJEU recognised that consumer perceptions can be shaped by other traders’ choices/uses of trade marks in the field (para. 44).
38. In any event, the Hearing Officer appears to have been swayed instead by arguments 5 and 6 in the Applicant’s list. First (argument 5), that the definition of “insider” put forward in attack by the Opponent (Exhibit MK2) referred to a person rather than goods or services, viz:
- “A person who is within some society, organization, etc; a person who is party to a secret, esp. so as to gain an unfair advantage ...”
39. Second (argument 6), that there was something oxymoronic about the marks in context, since they described a person in possession of secret information whereas to the contrary the goods of interest to the parties – news publications – divulged information.
40. Mr. Hollingworth took issue with the Hearing Officer’s final observation in connection with his assessment of the Section 3(1)(c) objection that (para. 26):
- “No doubt, both parties alighted upon the marks independently of each other, but for the same reason, namely that they function to identify trade origin whilst strongly alluding to the type of information the relevant public can expect to be included in the publications.”
41. I agree with Mr. Hollingworth that this choice of words especially the phrase “strongly alluding” was ill-advised, and that the relevant perceptions were those of the relevant consumer not those of the parties.
42. However, I also accept Mr. Hill’s point that by this time the Hearing Officer appeared unpersuaded that the relationship between the marks and the goods and services was concrete enough to be objectionable under Section 3(1)(c) (in the previous paragraph he had referred to the parties’ contesting viewpoints being that the marks were on the one hand, directly descriptive (Opponent) and on the other hand, “merely allusive” (Applicant)). Accordingly, the passage criticised by Mr. Hollingworth could be

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<sup>8</sup> At para. 38 the Court had repeated its previous statement that there was no need for a sign to be in descriptive use at the time of filing the application. It sufficed for refusal of registration if the sign could be used for such purposes.

viewed as purely confirmatory by the Hearing Officer of his prior assessment of the positions.

43. Whilst Mr. Hollingworth's submissions were attractive, I was not convinced that the Hearing Officer took account of impermissible evidence or that this led him to conclude that the marks were unobjectionable on descriptiveness grounds. Ground 1 of appeal therefore fails.

## Ground 2

44. The second ground of appeal largely revolved around the Hearing Officer's use of the term "allusive". The Opponent asserted that there is no such category of unobjectionable marks, and that by putting the marks in question into that "category" the Hearing Officer failed to recognise that allusive marks can be descriptive.
45. I was referred to several instances in the EU case law where the term "alludes" or "allusive" was used in the context of marks found to be descriptive of goods/services (e.g., *Agencja* in the GCEU at para. 26 quoted in the CJEU judgment at para. 16, Case T-633/13, *Reed Exhibitions Ltd v. OHIM* EU:T:2015:674, para. 41) or vice versa, unobjectionable (e.g., Case T-327/16, *Aldi Einkauf GmbH & Co. OHG v. EUIPO* EU:T:2017:439, para. 27).
46. I accept Mr. Hollingworth's observation that the Court of Justice itself has avoided using the term "allusive" in connection with suggestive<sup>9</sup> but unobjectionable signs.
47. Nevertheless, my own experience bears out Mr. Hill's comment that the distinction between on the one hand, allusion/suggestion and on the other hand, description to signify inherently permitted and unpermitted signs for registrability respectively is common in practice as indicated, for example, by the EUIPO Examination Guidelines which state (Part B, p. 3)<sup>10</sup>:
- "Article 7(1)(c) EUTMR does not apply to those terms that are only suggestive or allusive as regards certain characteristics of the goods and/or services (judgment 31/01/2001, T-135/99, *Cine Action*, EU:T:2001:30, § 29)".
48. I have already said I consider that the Hearing Officer's use of the words "strongly allusive" was unfortunate but again I am unpersuaded that this showed he had failed to appreciate what the law was.
49. I think it is clear from his citation of authorities and his comparisons with the case law cited before him that the Hearing Officer concluded having heard all the arguments that BUSINESS INSIDER and INSIDER fell on the right side of the inherent registrability line for Section 3(1)(c). Other minds may not have reached the same conclusions, but I am conscious that that does not mean that the Hearing Officer was wrong.

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<sup>9</sup> Another term perhaps better avoided?

<sup>10</sup> See also e.g. Case T-56/15, *Raimund Schmitt Verpachtungsgesellschaft mbH & Co. KG v. EUIPO* EU:T:2016:618, para. 69.

50. A related point taken by the Opponent under this second ground was that the Hearing Officer failed to have sufficient regard to the public interest in keeping free descriptive terms. This harped back to the Opponent's contention that the marks were descriptive of the subject matter or thematic content of the goods and services as indicating the audience for or writer/provider of (or, presumably, as submitted below the nature of the information in) the goods and services applied for, which was not accepted by the Hearing Officer.
51. The argument that the Hearing Officer failed adequately to consider the public interest accordingly strikes me as circular given that in my view the Hearing Officer had not been shown to fall into error in his assessment of the subject signs.
52. Ground 2 of appeal therefore also fails.

### **Ground 3**

53. The third ground of appeal was that the Hearing Officer wrongly considered the objections to the marks only in relation to news publications and failed to consider them in relation to the other goods and services.
54. First, it seems to me that this criticism sits uneasily with the way in which the Opponent pleaded its objections which were clearly directed to news publications and services<sup>11</sup>.
55. Second, the criticism represents an incorrect reading of the decision since the Hearing Officer at paragraph 27 concluded his determinations under Section 3(1)(c) with reference to Classes 9, 16 and 41 giving downloadable publications, periodicals and news reporting services as examples of unobjectionable goods and services respectively. The Hearing Officer then went on to say that the other goods and services were further away and in so far as I understood, Mr. Hollingworth agreed with this at least in relation to: *advertising services; publicity services; marketing services; promotional services; provision of advertising space in publications* (Class 41).
56. Mr. Hollingworth's main point here was in respect of *commercial information; business information* services in Class 35. Mr. Hill commented that in any event news publications consist of the provision of commercial/business information.
57. I do not think that this answers Mr. Hollingworth's point. However, as AG Jacobs observed in *Wrigley*, there comes a stage at which the line between objectionable and unobjectionable signs for the purposes of Section 3(1)(c) becomes difficult to draw and must be the subject of individual decision.

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<sup>11</sup> The grounds of opposition under Section 3(1)(c) to BUSINESS INSIDER and INSIDER claimed in identical terms that the marks were: "... designed to indicate the kind, quality, quantity and intended purpose of the product, in this case a news publication available in print and electronically/online, which may be considered a source of 'insider' information or news available to 'inside' sources. The mark is therefore likely to be used by other economic operators to designate a characteristic of their goods or services i.e. news publications, whether in print or electronic/online, and which offer advertising services or provide advertising space".

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58. In my judgment the present applications presented such a case.
59. Thus, even though reasonable minds might have differed as to the outcome, I was not convinced in either instance (i.e., BUSINESS INSIDER or INSIDER) that the Hearing Officer's multifactorial evaluation was wrong.
60. I therefore reject the third and final ground of appeal.

**Conclusion**

61. The appeal has been unsuccessful.
62. Given that the parties enjoyed roughly equal success at the preliminary hearing and the appeal hearing respectively, I will make no order as to costs.

Professor Ruth Annand, 16 April 2018

Mr. Guy Hollingworth of Counsel instructed by Pillsbury Winthrop Shaw Pittman LLP appeared for the Opponent/Appellant

Mr. Jonathan Hill of Counsel instructed by Haseltine Lake LLP appeared for the Applicant/Respondent