

O-264-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2339794  
TO REGISTER A TRADE MARK IN CLASSES 29, 30, 37 AND 43  
BY SODEXHO EDUCATION UK LIMITED**

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### Background

On 5 August 2003, Sodexho Education UK Limited (now Sodexho Education Services Limited), Kenley House, Kenley Lane, Kenley, Surrey CR8 5ED, applied to register the following signs as a series of 3 trade marks in Classes 29, 30, 37 and 43:



The applicant claims the colours red, amber and green as elements of the second mark of the series.

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

**Class 29:**

Meat, fish, poultry and game; meat extracts; preserved dried and cooked fruits and vegetables; jellies, jams and fruit sauces; eggs, milk and milk products; edible oils and fats; products containing or consisting of meat, fish, poultry, game, fruit or vegetables.

**Class 30**

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices, honey; treacle; yeast, baking powder; salt; mustard; vinegar, sauces, spices, ice; prepared meals; snack foods, ingredients for making prepared meals and snack foods; ingredients for making beverages.

**Class 37:**

Cleaning services; housekeeping services; maintenance services; repair services.

**Class 43:**

Catering services; café restaurant and bar services.

In later correspondence the specification for Class 37 was amended by the applicant to delete “housekeeping services” as these were not proper to the Classes of services applied for.

3. Objection was taken to the marks under Section 41(2) in that the third mark did not form a series with marks 1 and 2. Objection was also taken against all three marks under Section 3(1)(b) of the Act that they are devoid of any distinctive character in that they consist essentially, in marks one and two, and exclusively in mark 3, of the words “FOR YOU” being non-distinctive slogans of a type often employed as a strapline in advertising and therefore devoid of any distinctive character. The three dots appearing after marks one and two were considered to be de minimis and not sufficient to add distinctiveness to the mark.

4. A hearing took place before me where the applicant was represented by Mr A Fiddes of Urquhart-Dykes & Lord LLP, Trade Mark Attorneys. The objections were maintained. A period of time was allowed for the applicant to submit evidence of distinctiveness acquired through use. No evidence of use was filed and therefore 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 Case For Registration**

7. In correspondence prior to the hearing and at the hearing itself Mr Fiddes argued that the mark FOR YOU is not a slogan but simply the combination of the words FOR and YOU and provided examples of the mark in use. It was argued that the exhibits showed use as a trade mark being part of an overall brand image and not as a strapline or slogan. An example of such an exhibit – a cover to an “Operations Manual” is shown as Annex A. It was also argued that the inclusion of the dots emphasises this. A CD-ROM was also provided which explained that “FOR YOU ...” was a scheme for providing better meals in educational establishments and showed eg a school restaurant labelled “FOR YOU ... the place to eat.”

### **Decision**

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

8. Section 3(1)(b) of the Act reads as follows:

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

(b) trade marks which are devoid of any distinctive character,”

9. The test to be applied in respect of this application is not whether the mark, in its totality, is a combination which is used in common parlance to describe the goods and services applied for but whether the mark, again in its totality, is devoid of any distinctive character. Section 3(1)(b) of the Act is intended to prohibit registration of signs which, although not

caught by the clear parameters set out by Section 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.

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

“37. It is to be noted at the outset 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*, 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 *Gut 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.”

11. Guidance on the examination of slogans is available in Chapter 6 of the Trade Mark Registry Work Manual at paragraph 32 where it states:

### “32 Slogans

Slogans are registrable 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 Principle of Comfort”] C-64/02 P, the ECJ stated that slogans serving a promotional 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 recognise 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 (e.g. 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).”

12. The distinctive character of a trade mark must, of course, be assessed in relation to the goods and services for which the applicant seeks registration. In the present case, the application covers a range of foodstuffs in Classes 29 and 30; cleaning, maintenance and repair services in Class 37 and catering, café, restaurant and bar services in Class 42.

13. The mark must also be assessed by how it is likely to be perceived by the average consumer which, in this case, I consider to be the general public (see below). I must also assume fair and notional use of the mark in relation to the provision of the goods and services applied for. Such use can include advertising, where the goods and services may be listed for the convenience of the customer, or on packaging for goods.

14. I acknowledge that the test for registering slogans is no different than for any other type of marks but, as noted in the above guidance, such use may not be so readily accepted by the general public as an indication of trade origin as would more traditional signs.

15. The use shown in Annex A, for example, seems, to me, unlikely to be taken as an indicator of trade origin, but merely as an indication that the “Operations Manual” is intended to be the property of or for the use of the customer. (The information provided appears to indicate that the goods and services will be provided by the applicant, in cooperation with educational establishments, as part of a healthy eating programme aimed at students .) Also, use in advertising where the words FOR YOU, especially if followed by a row of dots, suggest to me that a series of items are likely to follow, such as a list of goods or services. (See comments in “CYCLING IS...” a decision by Geoffrey Hobbs QC, sitting in his role as the Appointed Person, BL reference O/561/01, at paragraphs 67-70) :

“67. The case for allowing registration rests upon the proposition that the signs are cryptic to a degree which makes it more likely than not that they would carry connotations of trade origin (whatever other connotations they might also carry) in the minds of the relevant class of persons or at least a significant proportion thereof.

68. The case for refusing registration rests upon the proposition that the signs are visually and linguistically meaningful in a way which is more likely than not to relate the goods and services to the activity of cycling without also serving to identify trade origin in the minds of the relevant class of persons.

69. The difference between these two positions resides in the question whether the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin specific or origin neutral.

70. The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect.”

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

17. I am not persuaded that the mark FOR YOU or the marks FOR YOU... (with or without the colour claim) in totality are distinctive in that they would serve in trade to distinguish the applicant’s goods or services from those of other traders. In my view, the marks applied for will not be seen 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 acceptance, prima facie, under Section 3(1)(b) of the Act .

## **Section 41(2)**

18. An objection was also taken under Section 41(2) of the Act that the marks do not constitute a series.

19. Section 41(2) of the Act reads as follows:

“41.-(2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.”

## Decision

20. In order to satisfy the requirements of Section 41(2) of the Act all three marks must resemble each other in their material particulars while differing from each other only in respect of matter of a non-distinctive character which does not substantially affect the identity of the others.

21. I consider the first two marks to constitute a series. They only differ in respect of the colour claim made on the second mark which, to my mind does not impact on the identity of the marks taken as a whole. The third mark differs in that it is in upper case and not lower case and does not include the three dots. While I do not agree with the Examiner that the dots are de minimis, otherwise it would indicate that no account should be taken of them, I do consider they have a visual impact on an otherwise simple mark consisting of a well known phrase comprising two short words. Furthermore, they change the identity from a complete statement to one which indicates more is to follow. In my view the dots constitute a part of the identity of the first two marks which is not present in the third and serve to reinforce the non-distinctive message of the words, alone , as indicated above.

22. In Logica's Trade Marks [BL O/068/03] Professor Ruth Annand sitting in her role as the Appointed Person established that Section 41(2) of the Act contains three conditions which must be met. In her decision Professor Annand stated:

- “38 I agree with Mr James that section 41(2) contains three conditions and not two but prefer to describe them according to their positive and negative aspects. First on the positive side, section 41(2) requires the trade marks for which series registration is sought to resemble each other in their material particulars. Second and third, the negative aspects are that any difference in the trade marks must not comprise matter, which when considered:
- (a) as a separate element of the trade mark would be regarded as having distinctive character; and
  - (b) in the context of the trade mark as a whole, substantially affects the identity of the trade mark.”

23. Turning to the meaning of “not substantially affecting the identity of the trade mark”, I note Jacob J's observation in *Neutrogena Corporation v Golden Limited* [1996] RPC 473, at 488-489 regarding, in effect, the identical phrase in Section 30(1) of the Trade Marks Act 1938:

“Not substantially affecting its identity” means what it says, both in this section and in other sections of the Act (e.g. section 35). An alteration which affects the way a mark is or may be pronounced, or its visual impact or the idea conveyed by the mark cannot satisfy the test.”

24. If there is a difference of substance between the marks, either visually or phonetically they will not qualify as a series.

25. For the reasons given above, I consider that the third mark differs from the first two in its material particulars in such a way that they do not satisfy the requirements of Section 41(2) of the Act.

**Conclusion**

26. In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to the application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) and 41(2) of the Act.

**Dated this 21<sup>st</sup> day of September 2005**

**R A JONES  
For the Registrar  
the Comptroller-General**

**for you**<sup>™</sup> ●●●

Operations manual

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