

BLO-268-20

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NUMBER 3305386
BY SCHOOLBLAZER LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 18, 21, 25, 28, 35:**

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Background

1. On 20 April 2018, Schoolblazer Limited ('the applicant') applied to register the above trade mark for the following goods and services:

Class 18: Leather and imitations of leather; Animal skins and hides; Luggage and carrying bags; Umbrellas and parasols; Walking sticks; Whips, harness and saddlery; Collars, leashes and clothing for animals; all-purpose sports bags; all-purpose athletic bags; all-purpose carrying bags; backpacks; baggage; bags for sports clothing; bags for travel; belt pouches; belts (leather shoulder -); book bags; boot bags; brief cases; bumbags; canvas bags; card wallets; cases for keys; change purses; changing bags; clutch bags; conference folders; covers (umbrella -); document cases; drawstring bags; duffel bags; fitted protective covers for luggage; kit bags; music bags; music cases; outdoor umbrellas; pocket wallets; pouches; purses; rucksacks; satchels; shoulder straps; schoolbags; school knapsacks; school satchels; school backpacks; school book bags; umbrellas for children; children's shoulder bags; sport bags; sports packs; parts and fittings for all the aforesaid goods.

Class 21: Household or kitchen utensils and containers; Cookware and tableware, except forks, knives and spoons; Combs and sponges; Brushes, except paintbrushes; Brush-making materials; Articles for cleaning purposes; Unworked or semi-worked glass, except building glass; Glassware, porcelain and earthenware; bottles; sports bottles; water bottles; vacuum bottles; cleaning brushes for sports equipment; lunchboxes; food storage containers; heat retaining containers for food; flasks; vacuum flasks; parts and fittings for all the aforesaid goods.

Class 25: Clothing, footwear, headgear; menswear; womenswear; childrenswear; belts; money belts; boots; leather shoes; caps; berets; scarves; coats; collars; wristbands; dresses; ear muffs; gloves; hats; headbands; hoods; hosiery; inner soles; jackets; jerseys; knitwear; clothing of imitations of leather; clothing of leather; leggings; leg warmers; ready-made linings; mittens; muffs; outerclothing; overcoats; pants; pullovers; shoes; short-sleeve shirts; skirts; slippers; socks; soles for footwear; suits; swimsuits; sweaters; tee-shirts; tights; trousers; bathing trunks; underpants; underwear;

uniforms; costumes; aprons; football clothing; football kits (football uniform); base layer clothing; replica football kits; football boots [shoes]; studs for football boots [shoes]; socks for football; armbands [clothing]; ballet shoes; jazz shoes; tutus; leotards; swimming costumes; moisture-wicking sports pants; moisture-wicking sports shirts; moisture-wicking sports bras; school uniforms; children's footwear; children's headwear; children's outerclothing; infant's clothing; blazers; ties; blouses; shorts; sport bibs; sports overuniforms; sportswear; sports shirts; sports shoes; sports jackets; sports socks; sports garments; boots for sports; combative sports uniforms; articles of sports clothing; rugby jerseys; rugby tops; rugby boots; karate uniforms; athletic uniforms; martial arts uniforms; plimsolls; tracksuits; tracksuit tops; tracksuit bottoms; parts and fittings for all of the aforesaid goods.

Class 28: Games, toys and playthings; Video game apparatus; Gymnastic and sporting articles; Decorations for Christmas trees; apparatus for games; badminton sets; bags adapted for use with sporting equipment; balls for games; balls for racket sports; balls for sports; bar-bells; beanbags being playthings; boxing gloves; discuses for sports; educational toys; exercise balls; face masks for sports; fitness machines and apparatus; flippers for swimming; games; hoops for children; hoops for exercise; inflatable toys; machines for physical exercises; nets for ball games; nets for sports; outdoor play equipment; outdoor toys; playing balls; punching bags; protective paddings [parts of sports suits]; rackets; rugby balls; soccer balls; sports equipment; sporting articles; tables for table tennis; targets; tennis equipment; trampolines; footballs [soccer]; soccer goals; soccer goal nets; soccer goalkeepers' gloves; shin guards for soccer; football pads; football body protectors; appliances for gymnastics; ball pumps; parts and fittings for the aforesaid goods.

Class 35: Advertising; Business management; Business administration; Office functions; organisation, operation and supervision of loyalty schemes and incentive schemes; organisation, operation and supervision of sales incentive schemes; on-line administration and supervision of a discount, special offer and gift voucher schemes; organisation, operation and supervision of loyalty and incentive schemes via the internet and mobile devices; loyalty card services; advertising, marketing and promotional services; dissemination of advertising and promotional materials; direct mail advertising services; on-line advertising on a computer network; management of a retail store and or supermarket; rental of advertising space; presentation of goods on communication media, for retail purposes; distribution of samples; retail services and online retail services connected with the sale of Leather and imitations of leather, Animal skins and hides, Luggage and carrying bags, Umbrellas and parasols, Walking sticks, Whips, harness and saddlery, Collars, leashes and clothing for animals, all-purpose sports bags, all-purpose athletic bags, all-purpose carrying bags, backpacks, baggage, bags for sports clothing, bags for travel, belt pouches, belts (leather shoulder -), book bags, boot bags, brief cases, bumbags, canvas bags, card wallets, cases for keys, change purses, changing bags, clutch bags, conference folders, covers

(umbrella -), document cases, drawstring bags, duffel bags, fitted protective covers for luggage, kit bags, music bags, music cases, outdoor umbrellas, pocket wallets, pouches, purses, rucksacks, satchels, shoulder straps, schoolbags, school knapsacks, school satchels, school backpacks, school book bags, umbrellas for children, children's shoulder bags, sport bags, sports packs, Household or kitchen utensils and containers, Cookware and tableware, except forks, knives and spoons, Combs and sponges, Brushes, except paintbrushes, Brush-making materials, Articles for cleaning purposes, Unworked or semi-worked glass, except building glass, Glassware, porcelain and earthenware, bottles, sports bottles, water bottles, vacuum bottles, cleaning brushes for sports equipment, lunchboxes, food storage containers, heat retaining containers for food, flasks, vacuum flasks, Clothing, footwear, headgear, menswear, womenswear, childrenswear, belts, money belts, boots, leather shoes, caps, berets, scarves, coats, collars, wristbands, dresses, ear muffs, gloves, hats, headbands, hoods, hosiery, inner soles, jackets, jerseys, knitwear, clothing of imitations of leather, clothing of leather, leggings, leg warmers, ready-made linings, mittens, muffs, outerclothing, overcoats, pants, pullovers, shoes, short-sleeve shirts, skirts, slippers, socks, soles for footwear, suits, swimsuits, sweaters, tee-shirts, tights, trousers, bathing trunks, underpants, underwear, uniforms, costumes, aprons, football clothing, football kits (football uniform), base layer clothing, replica football kits, football boots [shoes], studs for football boots [shoes], socks for football, armbands [clothing], ballet shoes, jazz shoes, tutus, leotards, swimming costumes, moisture-wicking sports pants, moisture-wicking sports shirts, moisture-wicking sports bras, school uniforms, children's footwear, children's headwear, children's outerclothing, infant's clothing, blazers, ties, blouses, shorts, sport bibs, sports overuniforms, sportswear, sports shirts, sports shoes, sports jackets, sports socks, sports garments, boots for sports, combative sports uniforms, articles of sports clothing, rugby jerseys, rugby tops, rugby boots, karate uniforms, athletic uniforms, martial arts uniforms, plimsolls, tracksuits, tracksuit tops, tracksuit bottoms, Games, toys and playthings, Video game apparatus, Gymnastic and sporting articles, Decorations for Christmas trees, apparatus for games, badminton sets, bags adapted for use with sporting equipment, balls for games, balls for racket sports, balls for sports, bar-bells, beanbags being playthings, boxing gloves, discuses for sports, educational toys, exercise balls, face masks for sports, fitness machines and apparatus, flippers for swimming, games, hoops for children, hoops for exercise, inflatable toys, machines for physical exercises, nets for ball games, nets for sports, outdoor play equipment, outdoor toys, playing balls, punching bags, protective paddings [parts of sports suits], rackets, rugby balls, soccer balls, sports equipment, sporting articles, tables for table tennis, targets, tennis equipment, trampolines, footballs [soccer], soccer goals, soccer goal nets, soccer goalkeepers' gloves, shin guards for soccer, football pads, football body protectors, appliances for gymnastics, ball pumps; information, advisory and consultancy services relating to the aforesaid services.

1. On 4 May 2018, the Intellectual Property Office ('IPO') issued an examination report in response to the application. The examination report contained a partial objection under Section 3(1)(b) &(c) of the Trade Marks Act 1994 ('the Act'), in respect of Classes 25 and 35 only.
2. The objection under section 3(1)(b) &(c) was raised on the basis that the examiner considered, *the sign 'SCHOOLBLAZER' would merely serve in trade to designate the kind of goods and intended purpose of the retail service, for example, retail services connected with the sale of school blazers and associated items of school uniforms; clothing being school blazers for wear; school uniforms being a blazer style jacket; school blazers; ready-made linings for use in school blazers.* The terms objected to were:

Class 25: Clothing, menswear; womenswear; childrenswear; coats; jackets; clothing of imitations of leather; clothing of leather; ready-made linings; outerclothing; overcoats; suits; uniforms; football clothing; football kits (football uniform); school uniforms; children's outerclothing; infant's clothing; blazers; sports overuniforms; sportswear; sports jackets; combative sports uniforms; articles of sports clothing; karate uniforms; athletic uniforms; martial arts uniforms.

Class 35: Retail and online retail services connected with the sale of ... Clothing, menswear; womenswear; childrenswear; coats; jackets; clothing of imitations of leather; clothing of leather; ready-made linings; outerclothing; overcoats; suits; uniforms; football clothing; football kits (football uniform); school uniforms; children's outerclothing; infant's clothing; blazers; sports overuniforms; sportswear; sports jackets; combative sports uniforms; articles of sports clothing; karate uniforms; athletic uniforms; martial arts uniforms.

3. On 4 July 2018, Stobbs, ('the agent') requested an extension of time for 3 months because the applicant was gathering evidence of use to overcome the objection. This was granted until 4 October 2018.
4. On 4 October 2018 the agent relied upon the proviso to section 3(1), namely a plea of 'acquired distinctiveness'. That said, the prima facie case was very much contested. In the written correspondence, it was submitted that:
 - The objection should not have been raised against all of the terms referenced in the examination report and it was submitted that as an example, the term blazer does not designate the kind of goods and intended purpose of retail services in relation to football kits in classes 25 and 35.

- There is no item which may be considered a blazer and also an item of football kit, since there is no overlap between the two terms. The same may be said, for example, of a karate uniform, also in class 25.
- There are a large number of terms within the contested goods and services for which the objection ought not have been raised, based on the definition of the word blazer as supplied in the examination report. The terms for which the word blazer cannot be said to designate the kind of goods and intended purpose of the retail services are set out below:

Class 25

Football clothing, football kits (football uniform), combative sports uniforms, articles of sports clothing, karate uniforms, athletic uniforms, martial arts uniforms.

Class 35

Retail and online retail services connected with the sale of ...football clothing , football kits (football uniform), combative sports uniforms, articles of sports clothing, karate uniforms, athletic uniforms, martial arts uniforms.

- That the objection should be waived in as far as it is applied to the above terms, because the mark cannot be said to designate the kind and intended purpose of the retail services where these goods and services are concerned.
5. The examiner considered the submissions and evidence filed in support of the plea of acquired distinctiveness and on review of the objection, waived the objection in the prima facie against the following goods and services:

Class 25: football clothing; football kits (football uniform); sports overuniforms; sportswear; combative sports uniforms; articles of sports clothing; karate uniforms; athletic uniforms; martial arts uniforms.

Class 35: retail services and online retail services connected with the sale of football clothing, football kits (football uniform), sports overuniforms, sportswear, combative sports uniforms, articles of sports clothing, karate uniforms, athletic uniforms, martial arts uniforms.

6. The examiner was not persuaded that the objection should be waived in its entirety, nor did she consider that the evidence was sufficient to demonstrate acquired distinctiveness and maintained the objection against following goods and services:

Class 25: Clothing; menswear; womenswear; childrenswear; coats; jackets; clothing of imitations of leather; clothing of leather; ready-made linings; outerclothing; overcoats; suits; uniforms; school uniforms; sports jackets;

Class 35: Retail services and online retail services connected with the sale of Clothing, menswear, womenswear, childrenswear, coats, jackets, clothing of imitations of leather, clothing of leather, ready-made linings, outerclothing, overcoats, suits, uniforms, school uniforms, sports jackets.

7. On 28 November 2018, Form TM21B was filed, requesting that the specifications should be amended to:

*Class 25 :Clothing, footwear, headgear; menswear. womenswear; childrenswear; belts; money belts; boots; leather shoes; caps; berets; scarves; coats; collars; wristbands; dresses; ear muffs; gloves; hats; headbands; hoods; hosiery; Inner soles; jackets; jerseys; knitwear, clothing of imitations of leather; clothing of leather, leggings; leg warmers; ready-made linings; mittens; muffs: outerclothing; overcoats; pants; pullovers; shoes; short-sleeve shirts; skirts; slippers; socks; soles for footwear; suits: swimsuits; sweaters; tee-shirts; tights; trousers; bathing trunks; underpants; underwear; uniforms; costumes; aprons; football clothing; football kits (football uniform); base layer clothing; replica football kits; football boots [shoes]; studs for football boots [shoes]; socks for football; armbands [clothing]; ballet shoes; Jazz shoes; tutus; leotards; swimming costumes; moisture-wicking sports pants; moisture wicking sports shirts; moisture-wicking sports bras; school uniforms; children's footwear; children's headwear; children's outerclothing; Infant's clothing; blazers; ties; blouses; shorts; sport bibs; sports overuniforms; sportswear; sports shirts; sports shoes; sports Jackets; sports socks; sports garments; boots for sports; combative sports uniforms; articles of sports clothing; rugby jerseys; rugby tops; rugby boots; karate uniforms; athletic uniforms; martial arts uniforms; plimsolls; tracksuits; tracksuit tops; tracksuit bottoms; parts and fittings for all of the aforesaid goods; **none of the aforesaid goods being blazers.***

Class 35: Advertising; Business management Business administration; Office functions; organisation, operation and supervision of loyalty schemes and Incentive schemes; organisation, operation and supervision of sales incentive schemes; on-line administration and supervision of a discount, special offer and gift voucher schemes; organisation, operation and supervision of loyalty and Incentive schemes via the internet and mobile devices; loyalty card services; advertising, marketing and promotional services; dissemination of advertising and promotional materials; direct mail advertising services; on-line advertising on a computer network; management of a retail store and or supermarket; rental of advertising space: presentation of goods on communication media, for retail purposes; distribution of samples; retail services and online retail services connected with the sale of leather and imitations of leather, Animal skins and hides, Luggage and carrying bags, Umbrellas and parasols, Walking sticks, Whips, harness and saddlery, Collars, leashes and clothing for animals, all-purpose sports bags, all-purpose athletic bags, all-purpose carrying bags, backpacks, baggage, bags for

sports clothing, bags for travel, belt pouches, belts (leather shoulder-), book bags, boot bags, brief cases, bumbags, canvas bags, card wallets. cases for keys, change purses, changing bags, clutch bags, conference folders, covers (umbrella-), document cases, drawstring bags, duffel bags, fitted protective covers for luggage, kit bags. music bags, music cases, outdoor umbrellas, pocket wallets, pouches, purses, rucksacks. satchels, shoulder straps, schoolbags, school knapsacks, school satchels, school backpacks, school book bags, umbrellas for: children, children's shoulder bags, sport bags, sports pecks, Household or kitchen utensils and containers, Cookware and tableware, except forks, knives and spoons, Combs and sponges, Brushes, except paintbrushes, Brush-making materials, Articles for cleaning purposes, Unworked or semi-worked glass, except building glass, Glassware, porcelain and earthenware, bottles, sports bottles, water bottles, vacuum bottles, cleaning brushes for sports equipment, lunchboxes, food storage containers, heat retaining containers for food, flasks, vacuum flasks, Clothing, footwear, headgear, menswear, womenswear, childrenswear, belts, money belts, boots, leather shoes, caps, berets, scarves, coats, collars, wristbands, dresses, ear muffs, gloves, hats, headbands, hoods, hosiery, Inner soles, jackets, jerseys, knitwear, clothing of Imitations of leather, clothing of leather, leggings, leg warmers, ready-made linings, mittens, muffs, outerclothing, overcoats, pants, pullovers, shoes, short- sleeve shirts, skirts, slippers, socks, soles for footwear, suits, swimsuits, sweaters, tee-shirts, tights, trousers, bathing trunks, underpants, underwear, uniforms, costumes, aprons, football clothing, football kits (football uniform), base layer clothing, replica football kits, football boots [shoes], studs for football boots [shoes], socks for football, armbands [clothing], ballet shoes, Jazz shoes, tutus, leotards, swimming costumes, moisture-wicking Sports pants, moisture-wicking sports shirts, moisture-wicking sports bras, school uniforms, children's footwear, children's headwear, children's outerclothing, infant's clothing, blazers, ties, blouses, shorts, sport bibs, sports overuniforms, sportswear, sports shirts, sports shoes, sports Jackets, sports socks, sports garments, boots for sports, combative sports uniforms, articles of sports clothing, rugby jerseys, rugby tops, rugby boots, karate uniforms, athletic uniforms, martial arts uniforms, plimsolls, tracksuits, tracksuit tops, tracksuit bottoms. Games, toys and playthings, Video game apparatus, Gymnastic and sporting articles, Decorations for Christmas trees, apparatus for games, badminton sets, bags adapted for use with sporting equipment, balls for games, balls for racket sports, balls for sports, bar-bells, beanbags being playthings, boxing gloves, discuses for sports, educational toys, exercise balls, face masks for sports, fitness machines and apparatus, flippers for swimming, games, hoops for children, hoops for exercise, inflatable toys, machines for physical exercises, nets for ball games, nets for sports, outdoor play equipment, outdoor toys, playing bells, punching bags, protective paddings [parts of sports suits], rackets, rugby balls, soccer balls, sports equipment, sporting articles, tables for table tennis, targets, tennis equipment, trampolines, footballs [soccer], soccer goals, soccer goal nets, soccer goalkeepers' gloves, shin guards for soccer, football pads, football body protectors, appliances for gymnastics, ball

*pumps; information, advisory and consultancy services relating to the aforesaid services; **none of the aforesaid services relating to blazers.***

8. On 4 January 2019, the examiner responded and maintained the objection despite the proposal to exclude 'blazers' from the specifications above. She explained that the proposal to amend the specification created legal uncertainty and was not in accordance with the decision of *Postkantoor* (see *C-363/99 KPN/BMB*). As the examiner did not believe the amendment was permissible, the request to amend was refused.
9. On 4 March 2019 the agent requested a hearing on behalf of the applicant resulting in a hearing being scheduled for 3 May 2019. The hearing came before me and was attended by Mr Julius Stobbs. Mr Stobbs made the following aural submissions in support of the application:
 - The examiner considered that the sign would not be perceived as distinctive in relation to school blazers and associated items and the retail of such goods. In this regard, the sign is inherently distinctive in respect of all other goods in the specification, for example in relation to flannel shirts, jeans, business suits, and in relation to non-school blazer items, the sign is unusual and distinctive.
 - The sign is being used as a trade mark and this is shown in the applicant's evidence.
 - The term is such a clear and specific term, it is inherently distinctive in relation to school trousers, school shirts and school skirts which are part of school uniform. The sign does not describe such goods, and would be unusual when used in relation to these goods.
 - School trousers and school skirts have no relationship with school blazers and regarding the limitation proposed, this is sufficient to overcome the objection. In respect of the retail of the goods and the actual goods themselves, there is a different consideration, for example the sign 'trouser' is distinctive in respect of 'skirts' and whilst consumers might think it is odd, this is what businesses do with their brands. This is perhaps why the applicant chose the brand because increasingly it is old fashioned to wear school blazers and as such, uniform is not likely to be a blazer and therefore the sign is unusual in relation to other items of school uniform.
 - The fact that goods might be closely linked is not a justification for an objection. If there is something striking or unusual about a mark that might be perceived as odd and where a sign isn't directly descriptive, this should result in a finding of distinctiveness. We need to be very careful with the definition of the term 'closely linked' and in this respect, the examiner waived the objection in respect of 'sportswear' which could be purchased

at the same time as a school blazer, in the same way that school skirts, or school trousers could be purchased.

- The evidence shows that the sign can function in respect of goods which aren't blazers. Given that the examiner refused to accept the mark on the basis that the limitation was not broad enough, the sign would be acceptable if the term 'none being school uniforms' was added to the specification. Alternatively, a positive limitation such as 'shirts, ties, trousers, skirts, leather jackets', would render the mark to be acceptable and similarly terms such as 'sweatpants' and 'jeans' would be acceptable.
- With regard to goods where the sign is less descriptive, for example in relation to school skirts, the amount of evidence needed to demonstrate acquired distinctiveness will be less.
- The market for school blazers for independent schools is a distinct market from blazers at large and the applicant has shown a significant market share in this respect.

10. At the hearing I maintained the objection as I was not persuaded that the sign is inherently distinctive in respect of the goods and services for which the examiner had objected to. Concerning Mr Stobbs submissions that the sign is distinctive for goods such as school skirts and school trousers, I explained that the fact that the sign might not serve to designate a characteristic of the goods and services, does not lead to an automatic finding of distinctiveness. Regarding the evidence of acquired distinctiveness, at the hearing I set out my reasons why I felt it was insufficient to demonstrate that the sign had acquired distinctive character through the use made of it. I also considered Mr Stobbs proposal made at the hearing to add an exclusion to the specifications, namely 'none being school uniform'. In this regard I maintained that this would not assist in overcoming the objection as it would lead to uncertainty in the market place. I was also mindful that the limitation could render the sign to be deceptive. On 24 May 2019, I issued the hearing report and a period of two months was granted to allow Mr Stobbs time to positively limit or restrict the application, as he indicated he might do so at the hearing.

11. On 21 June 2019, I was asked to clarify my final decision and was advised that for the time being, the applicant was not prepared to entertain an alternative specification amendment, to that which had already been filed and refused by the examiner. In response, on 25 July 2019, I wrote to Mr Stobbs setting set out my final decision having considered all the limitations and exclusions that had been raised and discussed. I maintained the objection against the following goods and services because of the difficulty in that the exclusions and limitations are not Postkantoor compliant and furthermore, they do not overcome the objection:

Class 25: Clothing, menswear; womenswear; childrenswear; coats; jackets; clothing of imitations of leather; clothing of leather; ready-made linings; outerclothing; overcoats; suits; uniforms; school uniforms; children's

outerclothing; infant's clothing; blazers; sports jackets; parts and fittings for all of the aforesaid goods.

Class 35: Retail services and online retail services connected with the sale of clothing, menswear, womenswear, childrenswear, coats, jackets, clothing of imitations of leather, clothing of leather, ready-made linings, outerclothing, overcoats, suits, uniforms, school uniforms, children's outerclothing, infant's clothing, blazers, sports jackets.

12. Although the application had not been formally refused as the response date had not expired, a form TM5 was duly received on the 20 August 2019. As I had made it clear in my letter of 25 July 2019 that I was maintaining the objection in relation to the goods and services set out, to all intents and purposes this drew to a close further discussion on the issue. Having received a request for a statement of reasons for the registrar's decision, I am now obliged to set out the reasons for my decision.

The *prima facie* case for registration under Section 3

The Law

13. 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 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,

(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.

The relevant legal principles - section 3(1)(c)

14. There are a number of judgments of the Court of Justice of the European Union ('CJEU') which deal with the scope of Article 3(1)(c) of the Directive and Article 7(1)(c) of the Regulation, 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 and services are deemed incapable of fulfilling the indication of origin function of a trade mark (*WM Wrigley Jr & Company OHIM, C-191/01P (Doublemint), paragraph 30*);
- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest that the descriptive signs or indications may be freely used by all (*Doublemint, paragraph 31*);
- It is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes (*Doublemint, paragraph 32*);
- It is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘*exclusively*’ in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question (*Koninklijke KPN Nederland NV v Benelux Merkenbureau, C-363/99 (Postkantoor, paragraph 57)*);
- 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 and services 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*);
- A sign which fulfils functions other than that of a trade mark is only distinctive if it may be perceived immediately and on first impression as an indication of the commercial origin of the goods or services, so as to enable the relevant consumer to distinguish, without any possibility of confusion, the goods and services of the owner of the mark from those of a different commercial origin (*Sykes Enterprises v OHIM (Real People Real Solutions) [2002]. ECT 11-5179*).

15. I also have to take 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.

16. It is clear from the aforementioned case law that, assuming notional and fair use, I must determine whether or not the mark applied for will be viewed by the average consumer as a means of directly designating essential characteristics of the goods and services being provided. I therefore have to consider who the average consumer for the goods and services covered by the application is. The goods for which I have maintained the objection are essentially clothing at large, which would include school uniforms and blazers and regarding the services, these extend to the retail of such goods. As such, when considering the very broad term 'clothing', which would include items such as school blazers, the average consumer, I believe would include both the general public and it would also include schools who will employ the applicant's services to supply items of school uniform, specifically for their schools. The level of attention will therefore vary depending on the customer, however I consider that it is reasonable to assume that a prospective purchaser of the applicant's goods and services would apply at least a moderate to high level of attention and circumspection when considering whether or not to purchase.

17. In assessing the mark applied for, and how the average consumer will perceive the mark, I have taken into account the dictionary definitions of the individual words contained with the mark. The following definitions are taken from Oxford Dictionary of English:

School; noun 1 an institution for educating children: Ryder's children did not go to school at all | [as modifier] school books .

Blazer; noun a coloured jacket worn by schoolchildren or sports players as part of a uniform.

In my opinion, when viewed in the prima facie, the sign SCHOOLBLAZER, when used in respect of '*Clothing, menswear; womenswear; childrenswear; coats; jackets; clothing of imitations of leather; clothing of leather; ready-made linings; outerclothing; overcoats; suits; uniforms; school uniforms; children's outerclothing; infant's clothing; blazers; sports jackets; parts and fittings for all of the aforesaid goods.*' in Class 25 and '*Retail services and online retail services connected with the sale of clothing, menswear, womenswear, childrenswear, coats, jackets, clothing of imitations of leather, clothing of leather, ready-made linings, outerclothing, overcoats, suits, uniforms, school uniforms, children's outerclothing, infant's clothing, blazers, sports jackets.*' in Class 35, the sign would be understood to designate the kind of goods and the retail services of such, i.e. a school blazer and the retail of such goods, specifically intended to be worn as part of a school uniform. I do not believe that merely conjoining the words which are so clearly descriptive, can lay claim to any grammatical or linguistic imperfection or peculiarity such as might help to escape its inherent descriptiveness. The average consumer, whom I have identified above as being consumers seeking to purchase items of school clothing, and also consumers such as schools wishing

to commission bespoke uniforms, when faced with the sign SCHOOLBLAZER would perceive it as nothing more than a description of the kind of goods and the retail of such goods, i.e. a school blazer. In this respect I refer to comments made in *Koninklijke KPN Nederland NV and Benelux- Merkenbureau*, Case C-363/99 (*Postkantoor*) where the CJEU held that:

“98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.”

18. I would also add at this point that the terms objected to are so broad, that in my view they could encompass school blazers and as such I maintain that the objection is applicable to the goods and services referred to in paragraph 17. Throughout the proceedings, Mr Stobbs proposed to overcome the objection by means of limiting the specification both in written correspondence to the examiner and also at the hearing. In written correspondence to the examiner (see paragraph 7 above), it was requested that the specification should be limited to exclude goods being blazers and services relating to blazers. The examiner rejected this proposal as a means of overcoming the objection and stated that such an exclusion would create legal uncertainty and was not in accordance with the decision of *Postkantoor* (see C-363/99 *KPN/BMB*). In this respect I can only endorse the examiner's decision that it did not assist in overcoming the objection. In my view, the addition of the proposed exclusion, particularly when the specifications specifically include such terms as 'blazers' and 'school uniforms' would render the sign to be deceptive and therefore contrary to section 3(3)(b) of the Trade Marks Act 1994 which states:

A trade mark shall not be registered if it is –

- (a) ...
- (b) of such a nature as to deceive the public, (for instance as to the nature, quality or geographical origin of the goods or service)

Furthermore, the proposed exclusion would be contrary to what is stated in the decision of the CJEU *Postkantoor* Case C-363/99 where the Court stated:

112. Although an undertaking may apply for registration of a mark in respect of all the goods or services falling within such a class, nothing in the Directive prohibits it from seeking registration solely in respect of only some of those goods or services.

113 Likewise, when registration of a mark is sought in respect of an entire class within the Nice Agreement, the competent authority may, pursuant to Article 13 of the Directive, register the mark only in respect of some of the goods or services belonging to that class, if, for example, the mark is devoid of any distinctive character in relation to other goods or services mentioned in the application.

114. *By contrast, where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.*

115. *Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties — particularly competitors — would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods.*

The above case supports my decision to reject the exclusions being '**none of the aforesaid goods being blazers**' in Class 25 and '**none of the aforesaid services relating to blazers**' in Class 35 as a means of progressing the application. The same consideration applies to Mr Stobbs proposal at the hearing, to add the exclusion 'none being school uniform'. Having taken into account the limitations and exclusions, I maintained the objection in view of the fact that the rights conferred by the registration would extend beyond the actual goods and services specified. This is because in my view, the goods and services objected to are a homogenous group, as referred to in the decision of the CJEU, Case C-437/15P EUIPO v Deluxe Entertainment. The decision of Mr Geoffrey Hobbs Q.C. acting as the Appointed Person in decision BL O/069/19 MAKE GIVING COUNT and MAKING GIVING COUNT, specifically refers to this point at pages 11 and 12, where Mr Hobbs stated:

It is clear that the assessment of a sign for distinctiveness must be made in relation to each of the categories of goods or services for which registration is requested, without lumping together goods or services which are not interlinked in a sufficiently direct and specific way, to the point where they form a sufficiently homogenous category or group of goods or services: see the Judgment of the CJEU in Case C-437/15P EUIPO v Deluxe Entertainment Services Group Inc. at paragraphs 26 to 45.

I am satisfied, having regard in particular to what he said in paragraphs 18 and 26 of the decisions under appeal, that the Hearing Officer did not do otherwise in the present case. It is confirmed in its accounts, publicly filed at Companies House, that the applicant was incorporated as a company limited by guarantee on 8th August 1975, and that it has, since incorporation, acted as nominee for the Trustees of 6 Charities Aid Foundation ("CAF", registered charity number 268369) and holds investments and other assets on their behalf. Some but not all of the Class 36 services for which registration was requested are listed in terms which relate them to activities of a charitable nature. Those which are not listed in such terms are nonetheless listed in terms which are broad enough to encompass such activities. It was incumbent on the applicant to limit the Class 36 services listed in its applications for registration, so as to confine them, if and so far as it could in accordance with the POSTKANTOOR principle and the requirement for legal certainty, to services with respect to which the expressions in question might possibly be found to possess a distinctive character: see FLYING SCOTSMAN Trade Mark (BL O/313/11; 31st August 2011) at paragraphs 12 and 13. It does not appear from the papers before me that the applicant has attempted to formulate any such limitations for adjudication

in relation to the Class 36 listings worded in general terms in its applications for registration.

19. Even if it could be argued that the proposed limitations are in accordance with the 'Postkantoor principle' and the requirement for legal certainty, they do not in my view overcome the objection to the extent that the limitation draws a clear dividing line between goods and services for which the sign is exclusively descriptive, and those for which it is not exclusively descriptive. In this regard, I draw support from the decision of Mr James Mellor QC, acting as the Appointed Person in decision BL O/085/18, BED BATH 'N' TABLE, where Mr Mellor stated the following:

44. That leaves the retail services connected with the sale of the following two categories of goods:

44.1. ornamental statues, sculptures and statuettes, artistic prints, photographs, busts (goods in this category could be for the dining room, as well as other rooms in the house and even outside (ornamental statues, sculptures)); and

44.2. medals, jewellery, gift bags, umbrellas, purses and bags, games and playthings.

45. It is not easy to draw a clear dividing line between those goods or retail services for which this mark is exclusively descriptive and those for which it is not exclusively descriptive, if one considers individual goods and the retail service connected with individual goods.

46. In my view, the assessment can be significantly affected by the context in which the average consumer considers particular goods. By way of example:

46.1. If I (using the viewpoint of the average consumer) consider the mark BED BATH N TABLE used in relation to the retail services connected with the sale of just statuettes or just medals or just jewellery, there is much to be said for finding that this sign for those specific services is not exclusively descriptive;

46.2. By contrast, if I consider the mark BED BATH 'N' TABLE used in relation to a whole range of goods (and the related retail services) all of which fall into the general category of bed bath and table goods plus statuettes or medals or jewellery, the context is different because the range of the goods other than statuettes or medals or jewellery reinforces the descriptive meaning of the mark. The fact that the mark is also used in relation to statuettes, or medals or jewellery does not instill in the mind of the average consumer a different (and allusive) meaning. They are just other goods sold under a descriptive mark, even though the descriptive meaning may not be entirely apt or sufficiently direct for statuettes, medals or jewellery (considered on their own) so as to render the sign exclusively descriptive.

47. Although the CJEU guidance directs me that 'the distinctive character of a mark must always be assessed specifically by reference to the goods or services designated', the fact that this assessment must also be undertaken using the viewpoint of the average consumer also signifies, to my mind, that the tribunal should take a commercially realistic approach and conversely need not and should not take a commercially unrealistic approach.

48. I can illustrate the distinction as follows:

48.1. To consider the mark *BED BATH N TABLE* used in relation to the retail services connected with the sale of just statuettes or just medals or just jewellery would be, in my view, commercially unrealistic;

48.2. By contrast, in my view, the far more commercially realistic approach in the context of the retail services in my category (ii), is to consider the mark *BED BATH 'N' TABLE* used in relation to a whole range of goods (and the related retail services) all of which fall into the general category of bed bath and table goods plus statuettes or medals or jewellery, indeed the entirety of category (ii).

49. In the context of this application, there are three particular reasons which in my view justify the commercially realistic approach I have just mentioned:

49.1. First, the mark itself tells the average consumer to expect a grouping of goods and retail services relating to those goods. The retail services may be (but need not be) provided in separate departments, as I indicated earlier.

49.2. Second, the average consumer expects a range of goods to be available and, if there are separate departments, in each of the three different departments.

49.3. Third, this expectation is the more pronounced in respect of the retail services of such goods.

50. I wish to point out that I am not rowing back on the criticism I made in paragraph 28 above. As I have explained, I do not consider the average consumer would think in terms of 'Ah, these are all household goods'. Instead, if the average consumer was to encounter *BED BATH N TABLE* being used in relation to the retail services of a department providing furniture and furnishings for a dining area, the mark does not suddenly cease to be exclusively descriptive if medals or statuettes are also on sale in that department. The same applies if 'canvas for tapestry or embroidery' or 'dish towels for drying' or 'embroidery fabric' are also on sale.

51. This analysis serves to confirm the utility and necessity of considering also the section 3(1)(b) ground. It may be noted that as I progressed through paragraphs 42-44 above, my reasoning reflected the descriptive meaning of this mark becoming slightly less easily recognizable to the average consumer, if one considers only retail services for the specific goods in question. One consequence of this may be that it will be easier to establish distinctive character through use of this mark if it is used in relation to those retail services for highly specific goods. Having said that, I have come to the conclusion that for the goods and retail services in the specification applied for, absent use in the UK, this mark is devoid of distinctive character. Before this mark can be said to be possessed of distinctive character for the goods and retail services in the specification and to be afforded the privilege of registration, I consider the average consumer needs to be educated to understand this sign as a mark of origin. This must occur through use since, absent use, I consider the mark does not signify origin and is devoid of distinctive character.

20. Much of Mr Stobbs submissions made at the hearing centred around the fact that the sign could not be said to designate a characteristic of goods such as school trousers or school skirts and that the sign would be unusual when used in relation to such goods. In response, in the hearing report I stated that:

Regarding Mr Stobbs laboured submissions that the sign is distinctive for goods such as school skirts and school trousers, in this respect the fact that the sign might not serve to designate a characteristic of the goods and services, does not lead to an automatic finding of distinctiveness. The mark must be assessed in relation to how the average consumer of the goods and services would perceive the sign. In this case, it is reasonable to assume that the average consumer of the goods and services is the general public. When faced with the sign in respect of goods specifically referred to being 'school skirts' and 'school trousers', I consider that the sign would be perceived as non distinctive and in this respect I referred Mr Stobbs to decision BL O/266/02 COMPUTER BOOKSHOPS particularly the following paragraphs:

19. This raises the question of whether the name of a type of retail establishment can be distinctive as a trade mark for the goods sold through that type of business.

*20. Before dealing with the specific, I observe that the Registrar has long been reluctant to register the name of one product as a trade mark for another product in a closely related sector of the market: see Portogram Radio Electrical Company Limited's Application 69 RPC [1952] 241 at 245. **I believe that it is self evident why the word "duvet", for example, would not be able to function as a trade mark for bed sheets, or why the word "shirt" would not function as a trade mark for ties. In use in relation to such goods these signs would be, at best, ambiguous as to their meaning, and would probably just result in confusion. A similar point arose in a recent decision dated 2 May 2002 of Mr G Hobbs QC as Appointed Person in Fourneaux de France Limited v The Range Cooker Co. plc, SRIS 0-240-02.***

21. Nor is the relationship between goods and services necessarily immune from this requirement for there to be a sufficient distinction between them so that a sign that is recognised as merely descriptive of the one will be perceived as distinctive of the other. For example, the words "express pizza" would plainly be seen as descriptive of a pizza delivery service. Given the seamless nature of the provision of the delivery service and the sale of the pizza, the average consumer would be unlikely to regard these words as a trade mark for the product even though, if the average consumer stopped and thought about it, he would realise that the words are only truly descriptive of the service.

22. Coming back to the specific goods and services at issue, there has been a long debate, both in this country and abroad, as to whether trade marks can be protected in respect of retail services. See Kerly's Law of Trade Marks and Trade Names (13th Ed) at 2-81 to 2-87. Part of the reason for this long running uncertainty is that, according to one school of thought, a retailer is able to register his mark for the goods that he sells. According to this school of thought, the provision of a retail service is merely an adjunct to a trade in the goods. Whether a trader can validly register his mark for the goods he sells may depend upon the facts of each case and the perception

of the public as to the relationship between his mark and the goods offered for sale: see Jacob. J's comments in this regard in Euromarket Designs Inc v Peters and Crate & Barrel Ltd [2001] FSR 288.

23. Each case turns on own facts. One of the relevant factors may be that the average consumer is likely to perceive a closer connection between particular goods and a retailer who specialises in those type of goods, than would be the case between a product and a general retailer who is known to stock a wide range of products. In other contexts this may mean that an undertaking that has protected its trade mark for the services of a specialist retailer will be better placed to prevent the 7 subsequent registration and use of its trade mark, or similar marks, by other parties, as trade marks for the goods concerned: see the Registrar's Practice Amendment Circular 13/00.

24. In this case it seems to me that the perceived closeness between a retailer specialising in computer books and the publications themselves is sufficient to deprive the words COMPUTER BOOKSHOPS of any distinctive character as a trade mark for computer books. This is because, in my judgement, an average consumer encountering the words COMPUTER BOOKSHOPS on, or in relation to, a computer book would simply take those words as a reference to the type of retail establishment through which such goods are sold, and not as a mark that distinguished the computer books of one undertaking from those of other undertakings.

25. I therefore find that the application is debarred from registration by section 3(1)(b) of the Act because the trade mark is devoid of any distinctive character for computer books. The various descriptions of goods in Class 16 are all capable of being applied to a computer book. The term "books" is no longer limited to paper books as once was the case, as is made clear from the wording of the applicant's Class 41 specification. Consequently, I find that the objection extends to all the goods in Class 9 and the services in Class 41, which are all different ways of describing a trade in electronic book.

The above decision is particularly relevant and as Mr James has stated, it is self evident why the word 'shirt' would not function as a trade mark for 'ties' and it is for the same reason that I explained that the term 'SCHOOLBLAZER' would not function as a trade mark for 'school skirts' or 'school trousers'. Mr Stobbs' submissions that the sign would be perceived as distinctive and odd, does not persuade me that absent evidence, consumers would perceive the sign as indicating origin. The objection is maintained in respect of broad terms which could incorporate items of school clothing and the retail of such goods as the sign merely serves in trade to designate the kind of goods, or the retail of such goods. In respect of the close relationships between goods such as school blazers and other items of school clothing, the sign is devoid of any distinctive character. When used in relation to closely related goods and services the sign would be, at best, ambiguous as to its meaning, and would probably result in confusion. The same principle is confirmed in decision BL O-200-08 SUN RIPENED TOBACCO where Mr. Richard Arnold QC acting as The Appointed Person confirmed that the sign Sun Ripened Tobacco is objectionable in respect of non-tobacco goods:

17. Counsel for the Applicant also argued that the Hearing Officer's conclusion in respect of the non-tobacco goods was unsustainable in view of his acceptance that the words that appeared in the mark could not be said to be descriptive of this category of goods. She submitted that, given that his reasoning in relation to the tobacco goods was that the words were descriptive, and the device simply reinforced that message, it followed that that reasoning could not apply to the non-tobacco goods.

18. I do not accept this argument either. In paragraph 17 of his decision, the Hearing Officer, as I have already noted, accepted that the words that appear in the mark cannot be said to be descriptive of the non-tobacco goods. He nevertheless held that the mark was devoid of any distinctive character in relation to non-tobacco goods on the ground that lighters and matches are so closely related to tobacco and tobacco products that the mark, if used in relation to those goods, would not suddenly start to convey a message as to trade origin. I see no error of principle in that approach and I consider that the assessment is one that was open to him.

19. I explored with counsel two alternative bases upon which the Hearing Officer might have reached his conclusion. The first, in accordance with the reasoning of the Court of First Instance in *Case T-461/04 Imagination Technologies Ltd v 15 Office For Harmonisation in the Internal Market* (20 16 September 2007) at paragraph 42, is that a mark remains descriptive of goods and services even if it is misdescriptive in the sense that the goods and services in question do not in fact have the characteristics in question but could have.

20. The second, in accordance with the decisions of the Board of Appeal in *Case R 246/1991-1 Enotria Holdings 22 Ltd's Application* (27 March 2000) and the *Cancellation 23 Division in Decision 75 C000835728/1 Beiersdorf 24 AG's Application* [2001] E.T.M.R. 19, is that a mark which is partly descriptive for the goods specified and partly deceptive should be refused under a combination of section 3(1)(b) and section 3(3)(b).

21. However, I prefer to rest my decision on the ground that the Hearing Officer correctly considered whether the mark had a distinctive character in relation to the non-tobacco goods and concluded that it did not because it was origin neutral rather than origin specific, and I see no error of principle in that approach.

This further supports my decision that in respect of other items of school clothing, I maintain that the goods are so closely related to school blazers, that the sign would not suddenly start to convey a message as to trade origin, but rather it is origin neutral, as opposed to origin specific.

21. Taking all the above into account I have concluded that the mark applied for consists exclusively of a sign which may serve, in trade, to designate the kind of goods and services, and are words that should be kept free for other providers of similar goods and

services to use in describing those goods and services. They are therefore excluded from registration in the *prima facie* case by section 3(1)(c) of the Act.

22. Having found that to be the case, it effectively ends the matter in the *prima facie* assessment for the above goods and services. However, and in case I am found to be wrong regarding my finding under section 3(1)(c), I will go on to determine the matter under section 3(1)(b) of the Act. I should at this point stress that since an objection has been made under section 3(1)(c), this automatically engages section 3(1)(b).

23. However, it can be useful to also consider section 3(1)(b) in its own right - the scope of the two provisions is not identical, and marks which are not descriptive under section 3(1)(c) can nonetheless be devoid of any distinctive character.

Decision - Section 3(1)(b)

24. In relation to section 3(1)(b), the ECJ held in Case C-363/99 *Koninklijke KNP Nederland NV v Benelux-Merkenbureau* („Postkantoor”) [2004] that:

"86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regards to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive."

25. I approach this ground of objection on the basis of the following principles derived from the CJEU cases referred to below:

- An objection under section 3(1)(b) operates independently of objections under section 3(1)(c) - (*Linde AG (and others) v Deutsches Patent und Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);
- For a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- A mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86);
- A trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought, and by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau* Case C-104/01 paragraphs 72- 77);
- The relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

26. The question arises as to whether the term may still be devoid of any distinctive character under section 3(1)(b) in relation to the goods and services objected to under section 3(1)(c) and also whether the sign is devoid of distinctive character for the goods and

services as it does not precisely designate a characteristic as per section 3(1)(c). In this respect, the public interest underlying the provision for refusal of marks lacking distinctive character has been examined by the CJEU in Case C-104/01 *Libertel Groep BV v Benelux-Merkenbrau [2003] (Libertel)*. In that case, the Court found that the public interest was "not unduly restricting the availability" of the given variety of mark for other traders. Advocate-General Jacobs, in his opinion in *SAT.2*, gave this further consideration and pointed out that the policy underlining CTMR Article 7(1)(b) / UKTMA section 3(1)(b) is distinct from the public interest behind CTMR Article 7(1)(c) / UKTMA Section 3(1)(c). He pointed out that *"there is no obvious reason why signs which simply lack any distinctive character - even if that lack is not absolute but relates only to the goods and services concerned - should be kept free for general use unless the signs themselves also have some close relationship with the relevant products"*.

27. In my opinion, even if the mark falls short of conveying the requisite level of specificity and objectivity to support an objection under section 3(1)(c), I would nevertheless hold that it is not capable of performing the essential function of a trade mark without the relevant public being educated into seeing it that way. In my view, consumers would not consider the mark to denote clothing items and the retail of such goods provided by any one specific provider. Rather, it would serve to provide a non-distinctive 'functional' purpose, likely to be used by any number of providers of clothing. The sign in my view is not capable of conveying a message as to trade origin, but rather it is origin neutral, as opposed to origin specific. On this basis I consider that the section 3(1)(b) objection is also made out.

The evidence of use

28. On 12 October 2018, the agent submitted evidence in support of a claim to acquired distinctiveness. This came in the form of a witness statement by Timothy John James who is the co-founder and a director of SchoolBlazer Limited, together with various exhibits. Mr James has held his position of director of the company since April 2006. The more detailed submissions contained within the Witness Statement and Exhibits can be summarised as follows:

- Mr James confirmed that the mark SCHOOLBLAZER has continuously been used in the UK since 2006 and has been applied for, to all manner of school uniform clothing items directly on labels, swing tags and the inner lining of many items, as well as in respect of the promotion, marketing and advertising of the goods. It is claimed that the product range for which the sign is used had grown since 2006 to include all aspects of uniform clothing, such as jackets, knitwear, shirts and blouses, trousers, skirts and accessories.
- Mr James stated that the Company offers a bespoke approach to uniform, tailored to the independent school market and it offers parents a bespoke service which is available through the website www.schoolblazer.com where the sign has featured in its present form since 2006.

- The goods sold by the undertaking are marketed directly to independent schools who enlist the applicant as an independent supplier and parents are then directed to the applicant's website to purchase school wear required by students of the independent schools.
- All the goods and services sold and provided by the undertaking bear the mark applied for, which appears on all point of sale marketing and advertising, as well on physical products. The mark is frequently presented as follows and in a non-stylised word form:

schoolblazer

- Exhibit 1 provides examples of the manner in which the mark is presented on the clothing, as well as on the website.
- The company's gross annual turnover for goods and services sold and provided in conjunction with the mark in the UK is shown below:

Year	Turnover
2011	£4.1m
2012	£5.4m
2013	£6.7m
2014	£7.9m
2015	£9.8m
2016	£10.8m
2017	£12.6m

- The quantities of goods sold under the mark are detailed below. The account of transactions shows that the undertaking made 148,824 transactions in 2017, selling 640,486 units. These units were sold to 45,497 customers, averaging 4.3 units per order.

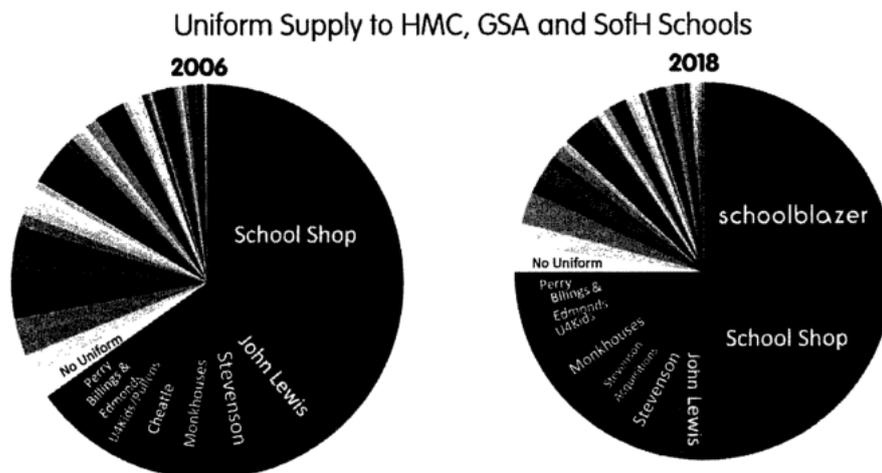
Year	# Of Transactions (orders)	# of Units Sold	# of Customers	Average units per order	Average sale price per unit	Average Orders per customer
2011	57,650	219,518	17,542	3.81	18.79	3.29
2012	73,609	292,445	23,832	3.97	18.51	3.09
2013	87,050	370,241	27,775	4.25	18.32	3.13
2014	98,960	422,013	31,463	4.26	18.94	3.15
2015	120,766	522,201	37,154	4.32	18.88	3.25
2016	137,904	590,635	41,065	4.28	18.42	3.36
2017	148,824	640,486	45,497	4.30	19.68	3.27

- The undertaking is the exclusive supplier to 180 independent schools in the UK, as detailed in Exhibit 10. Each of the schools receive an annual newsletter from the applicant which garners a readership of roughly 2000 people, all within the organisational framework of the schools. Copies of the newsletters are provided in Exhibit 2.
- The applicant has invested considerable spend in marketing and advertising his products and services. The spend on marketing and advertising was over £200,000 pounds in 2017. The marketing and advertising spend figures are shown below:

Year	Marketing and Advertising Spend
2011	£ 50,414
2012	£ 57,149
2013	£ 163,764
2014	£ 116,847
2015	£ 182,770
2016	£ 225,528
2017	£ 200,050

- Details of third-party publications in which the sign has been advertised are shown in Exhibit 3.
- Exhibit 4 includes images of publications where the undertaking has advertised on the back of magazines. The magazines include, but this is not an exhaustive list:
 - I. Private School Magazine: Summer 2018 edition
 - II. Private School Magazine: Spring 2017 edition
 - III. Conference Common Room: vol. 55 Autumn 2018
 - IV. Independent Education: Issue 92, September 2018 edition
 - V. Boarding School: Spring 2017 edition
 - VI. The Bursar’s Review: Spring 2017 edition

- A website address which provides distribution figures is shown, confirming that the Independent Schools Magazine was printed to the effect of 4,000 copies in January 2016 and that the Independent Education Today magazine reaches an estimated monthly readership of 11,250 people (as shown in Exhibit 5). This serves to further highlight the reach of advertising conducted by the applicant.
- Exhibit 6 features banners, stand designs and other marketing materials used for conferences at which the applicant advertises and promotes its goods and services. The following is a non-exhaustive list of conferences which the applicant attends and advertises at is provided below:
 - The Boarding School Association annual conference, My Company has attended every year since 2005
 - Head Masters Conference (HMC) annual conference, My Company has attended every year since 2006
 - Girls School Association (GSA) annual conference, My Company has attended every year since 2006
 - Bursars conference (ISBA) annual exhibition and conference, My Company has attended every year since 2008
 - Society of Heads conference (SoH) annual conference, My company has attended every year since 2007
 - HMC Deputies annual conference, My Company has attended every year since 2008
 - BSA Deputies annual conference, My Company has attended every year since 2008
- The applicant has been headline conference sponsor for the ISPA (Independent School Bursars Association) in 2018, 2016 and 2014, the GSA (Girls School Association) in 2018 and 2017, and the HMC (Headmistress Conference) in 2017. A non-exhaustive list of examples of the marketing materials at the conferences are shown in Exhibit 7.
- The mark has been the subject of many third-party journal/newspaper and other print articles. Exhibits 8 and 9 detail coverage published by Independent Education Today, a private education focused publication.
- SCHOOLBLAZER is now recognised as the leading premium school wear service in the UK. The applicant markets its service solely to independent schools and holds a significant share of the school uniform market, this share has increased dramatically since 2006. The applicant is the predominant shareholder in the market. The infographic below demonstrates the market share held by the applicant and also the market share of key competitors. The applicant enjoys a UK market share of 35% based on the number of independent schools for which it is exclusive supplier.



The case for registration based on acquired distinctiveness

29. The question to be determined is whether, through the use made of it, the sign applied for has acquired a distinctive character in respect of the goods and services for which registration is sought. In doing so, this question must be asked through the eyes of the average consumer who is reasonably well informed, observant, and circumspect (*Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel BV*, C-342/97[1999] ECR I-3830 para.26. In this case I have identified the average consumer as being both the general public and schools who commission the applicant to provide bespoke uniforms for their school.

30. The key authority for acquired distinctiveness is *Windsurfing Chiemsee Produktions Und Vertriebs GMBH v. Boots-Und Segelzubehor Wlater Huber*, C109/97 (*Windsurfing*); the relevant test being set out in paragraph 55:

“...the first sentence of Article 3(3) of the First Directive 89/104/EEC is to be interpreted as meaning that:

- A trade mark acquires distinctive character following the use which has been made of it where the mark has come 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 goods of other undertakings;
- In determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;
- If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied;
- Where the competent authority has particular difficulty in assessing the distinctive character of the mark in respect of which registration is applied for, Community law

does not preclude it from having recourse, under the conditions laid down by its national law, to an opinion poll as guidance for its judgment.”

31. I am also mindful of the CJEU decision in *Bovemj Verzekeringen NV v Benelux Merkenbureau (Europolis)*, C-108/05 where it was held that a trade mark may be registered on the basis of acquired distinctiveness “...only if it is proven that the trade mark has acquired distinctive character through use throughout the territory of a member state”.

32. In assessing the evidence it is customary to start with an appraisal of just how ‘weak’, in terms of registrability, the sign is in the *prima facie*. This exercise has the object of gauging just how much education, or re-education, on the part of the relevant consumer, is needed to find a successful plea of acquired distinctiveness.

33. In my opinion, the words ‘school blazer’ could, as I have said, objectively designate a characteristic of the goods and services, and inevitably then, I think there is a substantial burden to be discharged by the applicant in this case, particularly in respect of goods being school blazers. However, I would not say it was a hopeless case, in respect of certain goods and services, in the sense say, that the famous example of ‘soap’ for ‘soap’ was mentioned, but the evidence does need to be especially compelling.

34. Taking into account all of the information in the witness statement and exhibits, I do not consider that, at the time of the application the evidence as a totality shows that the mark has become distinctive because of the use made of it. It is clear from the information provided, that the applicant has a significant market share in providing school uniforms to independent schools, however this does not mean that the average consumer has come to recognise the sign SCHOOLBLAZER as only indicating goods and services provided by the applicant. At this point, it is also worth mentioning that the goods and services are not limited in any way in so much that they on relate to school blazers for the independent sector.

35. Although the turnover and advertising spend appear to be reasonable, the applicant only supplies school uniform to 180 independent schools in the UK. According to a report from the British Educational Suppliers Association ‘BESA’ <https://www.besa.org.uk/key-uk-education-statistics/>, which sources data from Department of Education, Welsh Government, Scottish Government and Northern Ireland Department of Education, in 2018 and 2019 it was confirmed that there were 32,770 schools in the UK, 2,408 of which are independent schools. As such the figure of 180 schools equates to 0.5% of the total number of schools within the UK. Whilst I acknowledge that not all schools wear uniform, the figure of 180 schools in my view is very low when considering exposure of the sign in the relevant market. The goods and services are not in any way limited to a more niche market for independent school uniforms, as such I need to consider whether a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking, because of the trade mark. The relevant class of persons in this case being all potential consumers of the items listed, including those purchasing items of clothing for independent schools, comprehensive schools, grammar schools and academies etc.

36. Paragraph 17 of the Witness Statement states that the 180 schools receive an annual newsletter which garners readership of roughly 2000 people. Exhibit 2 shows an example of the newsletter from Spring and Summer 2018 and the use of the sign is in the stylised form, shown in red. The newsletter provides information about recent sporting events within schools and about the company and is entitled ‘schoolblazernews’. The newsletter has a readership of roughly 2000 people all within the organisational framework of the 180 schools. This is comparatively low when taking into consideration the number of consumers of the applicant’s goods and services.

37. Exhibit 3 provides examples taken from third-party publications where the applicant's mark has been advertised between 2014 and 2017. Exhibit 4 similarly provides examples of the applicant's mark in publications listed in paragraph 19 of the Witness Statement. I would note that regarding Exhibit 4, out of the six examples of the publications provided, three postdate the date of application and what the evidence must demonstrate is that prior to the date of application the mark had acquired a distinctive character. Circulation figures have been provided in respect of two publications, namely the 'Independents Schools Magazine', totalling 4,000 copies in January 2016. In respect of the publication 'Independent Education Today', the readership is estimated at 11,250 people a month, as evidenced in Exhibit 5. Exhibit 5 refers to the fact that 'Independent Education Today' is uniquely targeted at headteachers, bursars and other key decision makers and spenders within the sector and as such, this publication carries little weight in demonstrating that the general public have received any exposure to the sign through adverts places in the publication. In respect of the other 17 publications, where the applicant has advertised the sign, readership figures have not been provided. Considering the publications and the reader of such publications it appears that the reach of the applicant's sign in the relevant market, is somewhat limited to the independent school sector.

38. Regarding Exhibit 6, this consists of examples of banners, stand designs and other marketing materials used at conferences at which the applicant promotes its goods and services. The Witness Statement supports the fact that the events are well attended by those responsible for sourcing of school uniform for independent schools and attendance at such events has dramatically increased the reach and recognition of the mark. However, taking into account the average consumers of the applicant's goods and services, whilst use of the sign, which is predominantly shown in the stylised version of the mark in colour, goes some way to demonstrating that those sourcing school uniform may recognise the applicant's sign as a badge of origin, the use does little to persuade me that the general public have been educated that the sign is a trade mark. The same consideration applies in respect of Exhibit 7, which relates to the applicant's use of the sign at conferences including Independent Bursars Association, The Girls School Association and the Headmasters Conference. These conferences similarly have a more limited reach and exposure of the sign when considering the consumer, who is the general public.

39. The Witness Statement at paragraph 25 states that the mark has been the subject of a large number of third-party journals, newspaper and other print articles. In this regard, Exhibits 8 and 9 show use of the applicant's sign in the publication 'Independent Education Today' and as I have already commented in paragraph 34, this publication is targeted at headteachers, bursars and other key decision makers and spenders within the sector, so has more limited reach regarding the general public at large. Details of the applicant's market share have been provided in the Witness Statement at paragraph 26 and also in supplementary correspondence. It is confirmed that the applicant holds 35% of the market share, based on the number of independent schools for which the applicant is exclusive supplier. Whilst the figure of 35% of the market share seems substantial, this only relates to the market share of the independent school sector and as such does not provide an indication of the applicant's market share for the entire range of goods and services claimed.

40. Overall, having considered the size of the relevant market within the UK for the goods and services objected to, I am left with the impression from the evidence that the applicant is reasonably prominent within the sector of those sourcing uniform in the independent school sector, however, this does not make the case for acquired distinctiveness.

41. For the reasons given, the evidence as a whole falls short of making the case for acquired distinctiveness and the application is thus partially refused.

Conclusion.

42. In this decision, I have considered all the papers filed and submissions made. For the reasons given above, the application is partially refused under sections 3(1)(b) and (c) in relation to the following goods and services:

Class 25: Clothing, menswear; womenswear; childrenswear; coats; jackets; clothing of imitations of leather; clothing of leather; ready-made linings; outerclothing; overcoats; suits; uniforms; school uniforms; children's outerclothing; infant's clothing; blazers; sports jackets; parts and fittings for all of the aforesaid goods.

Class 35: Retail services and online retail services connected with the sale of clothing, menswear, womenswear, childrenswear, coats, jackets, clothing of imitations of leather, clothing of leather, ready-made linings, outerclothing, overcoats, suits, uniforms, school uniforms, children's outerclothing, infant's clothing, blazers, sports jackets.

Dated this 1st day of May 2020

**Bridget Rees
For the Registrar
The Comptroller General**