

TRADE MARKS ACT 1994

In the matter of

Application 2303659

By Strategic Real Estate Advisors Ltd

To register a Trade Mark in Classes 16, 35, 36, 41, 42

Background

On the 26th June 2002 Strategic Real Estate Advisors Limited of Suite 3C, Princess House, 38 Jermyn Street, London, SW1Y 6DN, United Kingdom applied under the Trade Marks Act 1994 to register the trade mark "STRATEGIC REAL ESTATE ADVISORS" in the following format:



STRATEGIC REAL ESTATE ADVISORS

In Classes 16, 35, 36, 41 and 42 for the following goods and services respectively:

Class 16 - Printed matter; promotional material; printed matter relating to business management, financial affairs, real estate affairs, legal services.

Class 35 - Business consultancy; provision of advice relating to business administration and business organisation and structure; management consultancy; provision of on-line advice and information in relation to the foregoing services.

Class 36 - Financial affairs; monetary affairs; real estate affairs; analysis of property market performance; advising on investment strategy, tax and financial structure, acquisition and disposal strategy and execution; asset management; performance monitoring and reporting in relation to financial and real estate affairs; advice in relation to overseas investment; provision of on-line information in relation to financial and real estate affairs; provision of on-line information in relation to the foregoing services.

Class 41 - Education; providing of training; cultural activities; the organisation and running of seminars, training days and lectures; the organisation and running of seminars, training days and lectures relating to business administration, business organisation and structure, financial affairs, monetary affairs, real estate affairs and the tax and legal structure of business and financial and real estate portfolios.

Class 42 - Legal services; provision of legal advice relating to tax and legal structure of businesses, financial and real estate portfolios; provision of on-line legal information; provision of on-line information in respect of the foregoing services.

Objection was taken under Section 3(1) (b) and (c) of the Act because the mark consists exclusively of the words “Strategic Real Estate Advisors” which describes the nature and purpose of the goods and services listed e.g. designed to support a business plan for real estate.

Also an objection was taken under Section 5(2) for classes 16 and 41 with earlier mark 2224392. The Agents subsequently made representations in a letter dated 15 October 2003 with regard to the Section 5 objection and it was waived. No further mention will be made of it in this decision.

The words are presented in a rectangle, which is considered to be a totally non-distinctive background element, which does not add the required surplus and will again form no further part in my considerations, which are on the words alone.

Evidence of Use of the mark was filed on 15 October 2003 with the purpose of showing that the mark had acquired a distinctive character. No Hearing was formerly requested .

The case for Registration

The Law

The objections to this mark were raised under Sections 3(1) (b) and (c) of the Act which 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,”

Relevant Authorities

There are a number of European Court of Justice judgements which deal with the scope of Article 3(1) (c) of First Council Directive 89/104 and Article 7(1) (c) of Council Regulation 40/94 (the Community Trade Mark 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:

(Wm Wrigley Jr & Company v OHIM – case 191/01P [2004] ETMR.9 (Doublemint) ref. para.30:-

-subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark-

ref. para.31 :-

-thus Article 7(1) (c) (Section 3(1) (c)) pursues an aim which is in the public interest that descriptive signs or indication may be freely used by all-

and ref. para. 32 :-

-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 and services in question. It is sufficient that it could be used for such purposes.

Koninklijke KPN Nederland NV and Benelux Merkenbureau, Case C-363/99 (Postkantoor), [2004] ETMR 57 ref. para. 57:-

-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 –

and ref. para. 99:-

-merely bringing together descriptive elements without any unusual variations as to, for instance, syntax or meaning, cannot result in a mark consisting of such elements escaping objection .

From the above, I am therefore aware that the mark’s distinctiveness must be assessed in relation to the goods/services sought by the applicant. I must also have regard to the perception of the average consumer (who is deemed to be reasonably well informed and reasonably observant and circumspect). However in my view this mark is, a mere “bringing together of descriptive elements”, the words - STRATEGIC REAL ESTATE ADVISOR , would do no more than designate the kind of goods and services on offer and that the goods and services on offer are designed to support a business plan for real estate. Indeed these words by their ordinary dictionary significance are descriptive.

The question is whether the mark would serve to indicate, when encountered by the average consumer, that the goods/services sold under the mark originate from a particular trader and, thus, distinguishes their goods/services from the goods/services of other traders. I feel that the words “STRATEGIC REAL ESTATE ADVISOR” sends a direct message and, therefore, the mark would not be taken by the average consumer as a sign of origin in one particular trader but as a descriptor and therefore Section 3(1)(c) is proved.

In relation to (b) it was held in *Postkantoor* 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 regard 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.”

On that basis the objection under Section 3(1)(b) will also have been made out without my needing to consider whether there is also an independent objection under this head though in my view approaching the matter from the perspective of the average consumer who encounters the mark is unlikely to produce a different result. That is to say the mark would lack the requisite degree of distinctive character to be relied on as an indicator of trade origin.

Applicant's Evidence

The evidence of Use was submitted 15 October 2003 with an accompanying letter.

The Agents state in the letter that they do not believe that “Strategic Real Estate Advisors” is the normal way of describing the goods or services claimed. That if it were such a descriptive and non-distinctive mark you would expect to find many hits on the Internet. The Agents believe this lack of hits reinforces the argument that this is not the natural language, and that this mark is associated to the applicant.

The Witness Statement is submitted by Pierre Norman Rolin of 45 Mont Pelier, London, SW1X 7RL. He is Chairman and Managing Director of Strategic Real Estate Advisors Limited, he has been associated with the company for five years.

Mr Rolin states that his company have been using this trade mark “STRATEGIC REAL ESTATE ADVISORS” in the United Kingdom for the majority of goods and services since October 1998. The education, training and conference services as listed in the class 41 specification have been provided since 2000, that is 4 years and 2 years use respectively, prior to the date of application.

He further states that his company has developed a significant reputation in this mark, due to the longevity of its use and the extent and the profile of that use. The turnover of goods and services under the “STRATEGIC REAL ESTATE ADVISORS” & device trade mark is as follows:

YEAR	TURNOVER/£
1Oct 98-31 Dec 99	4,832,135
Year end Dec 2000	4,135,254
Year end Dec 2001	4,344,455
Year to date for 2002	6,349,223

Mr Rolin makes the point that the company provides high level legal and financial advisory services relating to real estate transactions, involving large pieces of real estate and management services in respect of such real estate. There are therefore low numbers of transactions in terms of total number but they are high profile giving the company a very strong reputation in a relatively short period of time. A listing of the type of acquisitions is provided.

Mr Rolin states that when he decided to set up the company in October 1998, he aimed to capitalise on the growing demand for real estate investment advisory services from very wealthy to private clients. He has formed alliances with other companies to increase his companies profile in the market place.

We are then referred to exhibit PNR1 which demonstrates how the mark “STRATEGIC REAL ESTATE ADVISORS” is used.

Use of mark in advertising

We are now given the advertising and marketing expenditure in the United Kingdom for this trade mark:

YEAR	EXPENDITURE
2000	350,204 + (incomplete account)
2001	326,946
2002	422,921
2003	88,238 (estimated advertising only budget – not including other types of marketing)

Exhibit PNR2 is a document outlining the Company’s marketing budget for the years 2001 and 2002. It is difficult to ascertain from this document what, if any, of the proportion of this budget relates to the promotion of goods or services provided under the trade mark, “STRATEGIC REAL ESTATE ADVISORS”.

Mr Rolin goes on to state that this trade mark has been advertised in various publications e.g. the Financial Times. Exhibit PNR3 are examples of such publications from the years 1999 to 2002. These examples have problems on a number of levels, firstly there is a lot of paperwork provided but it is mostly extraneous to the case and it takes a while to find the trade mark in there. Secondly it again demonstrates use of “STRATEGIC REAL ESTATE ADVISORS” with other matter, such as “preserving capital for the next generation” These examples also show the mark appearing at the top of the pages of extracts from Newspapers such as The Observer or advertisements for seminars with little indication as to why it is there or the connection to the articles.

There is also included in this exhibit a portfolio for the company and a letter from their Chartered Accountants confirming their turnover figures and advertising. I note that here again the mark as applied for “STRATEGIC REAL ESTATE ADVISORS” floats at the top of the page and within some articles it refers to “SREAL” rather than the words STRATEGIC REAL ESTATE ADVISORS.

Acquired distinctiveness: decision on the evidence

Relevant Authorities

The test to be applied to demonstrate that a mark has become distinctive through use is clearly defined in *Windsurfing Chiemsee (C108 & 109/97) [1999] ETMR 585*, the ECJ provided guidance as to the conditions which should result in a finding that a trade mark has acquired a distinctive character through use. The court found that:

Windsurfing Chiemsee Produktions v Huber [1999] E.T.M.R. 585 ref.para. 51 :-

“In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and longstanding use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trader and professional associations.”

And ref. para. 52:-

“If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

Also as Morritt L.J. stated in *Bach Flower Remedies* [2000] RPC 513 at page 530 lines 19-21

“First, use of a mark does not prove that the mark is distinctive. Increased use does not do so either. The use and increased use must be in a distinctive sense to have any materiality. “

In my view the mark in use, as demonstrated by this evidence, is materially different to the mark as applied for and has a limited market of recognition.

Although the sales and advertising figures are quite high the mark appears to be used with other more dominant trade mark matter, such as the shortened form SREAL or as a descriptor of the services being provided. The use declared from October 1998 is claimed for a majority of goods and services, although some services appear to have been provided at a later date in 2000. The sales figures are not divided into areas of different use, so they cannot provide an accurate picture.

It is not possible to ascertain from the evidence that the relevant public would identify this trade mark as indicating source. It is this materiality of the use which raises concerns rather than precise turnover or advertising figures; if the use is not material then all other questions become secondary.

I have taken full account of all the evidence submitted, and of the information contained in the Agents letter and attached Internet references. In my view this evidence is insufficient to prove that the mark has acquired a distinctive character. In fact the way the mark is used emphasises the message it gives, that in use the mark has a descriptive facia which undermines any origin specific identity it may be striving for. The applicant has failed to bring himself within the proviso of Section 3(1).

Conclusion

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

Dated this day of 03rd of October 2006

**G ASHWORTH
For the Registrar
The Comptroller-General**