

1 UK INTELLECTUAL PROPERTY OFFICE

2  
3 21 Bloomsbury Street,  
London WC1B 3HF

4 **Tuesday, 21st September 2010**

5 Before:

6 **MR. GEOFFREY HOBBS QC**  
7 **(Sitting as the Appointed Person)**

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9 In the matter of the Trade Marks Act 1994

10 and

11 In the matter of Application No. 2488299: **WE CREATE SPACE** in  
the name of Easistore Limited

12 and

13 In the matter of an Appeal to the Appointed Person by  
14 Easistore Limited against the Decision of the  
Comptroller-General dated 31st March 2010

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16 (Transcript of the shorthand notes of Marten Walsh Cherer Ltd.  
17 1st Floor, Quality House, 6-9 Quality Court,  
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20 **MR. KRAUSE** and **MR. CONWAY** (of Haseltine Lake) appeared o  
behalf of the Appellants.

21 **MR. ABRAHAM** appeared as the Registrar's Representative.

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23 **D E C I S I O N**  
24 **(As approved by the Appointed Person)**

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1 THE APPOINTED PERSON: On 23rd March 2008 Easistore Limited

2 applied under No. 2488299 to register the expression **WE CREATE**  
3 **SPACE** as a trade mark for use in relation to the following  
4 services in Class 39:

5 " - storage of goods in a warehouse or other building  
6 for their preservation or guarding; provision of storage  
7 of packaging materials and items including packaging  
8 boxes, adhesive tape, packaging paper and wrap;  
9 provision of storage facilities for use by others;  
10 advice concerning the removal and storage of goods."

11 Objections to registration were raised by the Registrar  
12 under Sections 3(1)(b) and 3(1)(c) of the Trade Marks Act  
13 1994. Section 3(1)(b) prevents registration in cases where  
14 the sign in question is "devoid of any distinctive character".  
15 Section 3(1)(c) prevents the registration of signs "which may  
16 serve, in trade, to designate the kind, quality, quantity,  
17 intended purpose, value, geographical origin, the time of  
18 production of goods or of rendering of services, or other  
19 characteristics of goods or services."

20 The Applicant maintained that the official objections to  
21 registration were unsound. It contended that they should in  
22 any event be withdrawn on the basis that the expression **WE**  
23 **CREATE SPACE** had acquired a distinctive character through use  
24 prior to March 2008, and therefore qualified for registration  
25 under the proviso to Section 3(1) of the Act.

In that regard the Applicant relied on a witness  
statement of its Finance Director, Simon Bidgway, dated 21st

1 January 2009. Mr. Bidgway gave evidence of use dating back to  
2 the beginning of 2005. The exhibits to his witness statement  
3 showed the expression **WE CREATE SPACE** being used as an epithet  
4 for his company's EASISTORE self storage operations. His  
5 evidence did not go so far as to demonstrate that people in  
6 the market for storage services actually perceived and  
7 remembered **WE CREATE SPACE** as a way of distinguishing his  
8 company's storage services from those of other undertakings.

9 The application for registration was refused for the  
10 reasons given by Ms. Jane Hallas, on behalf of the Registrar  
11 of Trade Marks, in a written decision issued under reference  
12 BL O-099-10 on 31st March 2010. Having reminded herself of  
13 the case law of the Court of Justice relating to the scope of  
14 the parallel provisions of Articles 3(1)(b) and (c) of the  
15 Trade Marks Directive, and Articles 7(1)(b) and (c) of the  
16 Community Trade Mark Regulation, she concluded that the  
17 information conveyed by the expression **WE CREATE SPACE** was  
18 explanatory to a degree which made it thoroughly descriptive  
19 and non-distinctive in relation to services of the kind  
20 specified, and therefore ineligible for registration under  
21 Sections 3(1)(b) and (c). She considered that the  
22 Applicant's evidence of use reinforced rather than displaced  
23 the objections to registration.

24 The Applicant appealed to an Appointed Person under  
25 Section 76 of the Act contending, in substance, that **WE CREATE**

1       **SPACE** was a somewhat idiosyncratic expression which was  
2       sufficiently quirky to be intrinsically distinctive and  
3       therefore registrable as a trade mark for the Class 39  
4       services of interest to the Applicant.

5               The Applicant's evidence of use was put forward as being  
6       both supportive of that proposition and sufficient to prove  
7       the fact of acquired distinctiveness at the date of the  
8       application for registration. These contentions were  
9       developed in argument at the hearing before me. I was invited  
10      to accept that eligibility for registration under Section  
11      3(1)(b) followed on naturally from the reasons for freedom  
12      from objection under the more narrowly defined provisions of  
13      Section 3(1)(c) in the circumstances of the present case.

14             At this point I think it is necessary to emphasise the  
15      importance of establishing whether a sign is free from  
16      objection under Section 3(1)(b). In principle, it is possible  
17      for a sign to be (1) distinctive for the purposes of Section  
18      3(1)(b), with the result that it cannot be regarded as  
19      descriptive for the purposes of Section 3(1)(c) and must be  
20      unobjectionable on both bases; or (2) neither distinctive for  
21      the purposes of Section 3(1)(b), nor descriptive for the  
22      purposes of Section 3(1)(c), with the result that it is  
23      objectionable on the former but not the latter basis; or (3)  
24      descriptive for the purposes of Section 3(1)(c), with the  
25      result that it cannot be regarded as distinctive for the

1 purposes of Section 3(1)(b) and must be objectionable on both  
2 bases.

3           Against that background the main effect of interpreting  
4 Section 3(1)(c) restrictively is to shift the spotlight onto  
5 the question of how much further Section 3(1)(b) may go in  
6 preventing registration beyond the scope of Section 3(1)(c).  
7 Then large amounts of time and effort might be - as indeed  
8 they have been - spent puzzling over the second of the three  
9 situations I have identified. That is because the notion of a  
10 sign being simultaneously unpossessed of descriptiveness  
11 within the scope of Section 3(1)(c) and unpossessed of  
12 distinctiveness within the scope of Section 3(1)(b) operates  
13 as a bar to registration which is prone to be applied with  
14 differing degrees of enthusiasm, reflecting different legal  
15 traditions relating to the assessment of registrability within  
16 the European Union.

17           Fortunately, I have it on the authority of paragraph 20  
18 of the Judgment of the Court of Justice in the **COMPANYLINE**  
19 case (Case C-104/00 P *DKV Deutsche Krankenversicherung AG v*  
20 *OHIM* [2002] ECR I - 7561) that there is no obligation to rule  
21 on the possible dividing line between the concept of lack of  
22 distinctiveness and that of minimum distinctiveness when  
23 assessing the registrability of a sign under Section 3(1)(b).

24           For the reasons I have sought to explain, the importance  
25 of the objection under Section 3(1)(b) is such that at this

1 stage of the present proceedings I think it is appropriate to  
2 deal with it first.

3 The law relating to the scope and effect of Section  
4 3(1)(b) is conveniently summarised in paragraphs 28 to 37 and  
5 45 of the recent Judgment of the Court of Justice in  
6 Case C-265/09 P *OHIM v BORCO-Marken-Import Matthiesen GmbH &*  
7 *Co. KG*, 9 September 2010:

8 "Findings of the Court.

9 "28. As a preliminary point, it should be recalled  
10 that, according to Article 4 of Regulation No 40/94, letters  
11 are among the categories of signs of which a Community trade  
12 mark may consist, provided that they are capable of  
13 distinguishing the goods or services of one undertaking from  
14 those of other undertakings.

15 "29. However, the fact that a sign is, in general,  
16 capable of constituting a trade mark does not mean that the  
17 sign necessarily has distinctive character for the purposes of  
18 Article 7(1)(b) of the regulation in relation to a specific  
19 product or service (Joined Cases C-456/01 P and C-457/01 P  
20 *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

21 "30. Under that provision, marks which are devoid of  
22 any distinctive character are not to be registered.

23 "31. According to settled case-law, for a trade mark to  
24 possess distinctive character for the purposes of that  
25 provision, it must serve to identify the product in respect of  
26 which registration is applied for as originating from a  
27 particular undertaking, and thus to distinguish that product  
28 from those of other undertakings (*Henkel v. OHIM*, paragraph  
29 34; Case C-0304/06 P *Eurohypo v. OHIM* [2008] ECR I-3297,  
30 paragraph 66; and Case C-398/08 P *Audi v. OHIM* [2010] ECR  
31 I-0000, paragraph 33).

32 "32. It is settled case-law that that distinctive  
33 character must be assessed, first, by reference to the goods  
34 or services in respect of which registration has been applied  
35 for and, second, by reference to the perception of them by the  
36 relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*,  
37 paragraph 35; and *Eurohypo v OHIM*, paragraph 67).  
38 Furthermore, the Court has held, as OHIM points out in its

1 appeal, that that method of assessment is also applicable to  
2 an analysis of the distinctive character of signs consisting  
3 solely of a colour per se, three-dimensional marks and slogans  
4 (see, to that effect, respectively, Case C-447/02 P *KWS Saat v*  
5 *OHIM* [2004] ECR I-10107, paragraph 78; *Storck v. OHIM*,  
6 paragraph 26; and *Audi v. OHIM*, paragraphs 35 and 36).

7 "33. However, while the criteria for the assessment of  
8 distinctive character are the same for different categories of  
9 marks, it may be that, for the purposes of applying those  
10 criteria, the relevant public's perception is not necessarily  
11 the same in relation to each of those categories and it could  
12 therefore prove more difficult to establish distinctiveness in  
13 relation to marks of certain categories as compared with marks  
14 of other categories (see Joined Cases C-473/01 P and C-474/01  
15 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36;  
16 Case C-64/02 P *OHIM v. Erpo Möbelwerk* [2004] ECR I-10031,  
17 paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v.*  
18 *OHIM*, paragraph 37).

19 "34. In that regard, the Court has already stated that  
20 difficulties in establishing distinctiveness which may be  
21 associated with certain categories of marks because of their  
22 very nature - difficulties which it is legitimate to take into  
23 account - do not justify laying down specific criteria  
24 supplementing or derogating from application of the criterion  
25 of distinctiveness as interpreted in the case-law (see *OHIM v*  
*Erpo Möbelwerk*, paragraph 36, and *Audi v OHIM*, paragraph 38).

"35. It is apparent from the case-law of the Court on  
Article 3 of Council Directive 89/104/EEC of 21 December 1988  
to approximate the laws of the Member States relating to trade  
marks (OJ 1989 L 40, p.1), the wording of which is identical  
to that in Article 7 of Regulation No 40/94, that the  
distinctive character of a mark must always be assessed  
specifically by reference to the goods or services designated  
(see, to that effect, *Libertel*, paragraph 76, and Case  
C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619,  
paragraphs 31 and 33).

"36. As the Advocate General observed at point 47 of  
his Opinion, the requirement of an examination as to whether,  
on the facts, the sign in question is capable of  
distinguishing the goods or services designated from those of  
other undertakings, allows for the accommodation of the ground  
for refusal laid down in Article 7(1)(b) of Regulation No  
40/94 with the general capacity of a sign to constitute a  
trade mark recognised in Article 4 thereof.

"37. In that regard, it should be pointed out that,

1 even though it is apparent from the case-law cited that the  
2 Court has recognised that there are certain categories of  
3 signs which are less likely prima facie to have distinctive  
4 character initially, the Court, nevertheless, has not exempted  
5 the trade mark authorities from having to carry out an  
6 examination of their distinctive character based on the  
7 facts",

8 and: "45. As is clear from the case-law of the Court, the  
9 examination of trade mark applications must not be minimal,  
10 but must be stringent and full, in order to prevent trade  
11 marks from being improperly registered and, for reasons of  
12 legal certainty and good administration, to ensure that trade  
13 marks whose use could be successfully challenged before the  
14 courts are not registered (see, to that effect, *Libertel*,  
15 paragraph 59, and *OHIM v Erpo Möbelwerk*, paragraph 45)."

16 As noted in paragraph [34], it is not permissible to  
17 assess the registrability of a sign by reference to criteria  
18 supplementing or derogating from the criterion of  
19 distinctiveness as interpreted in the case law of the Court.  
20 The fact that it may be more difficult to establish  
21 distinctiveness in relation to marks in certain categories as  
22 compared with marks in other categories does not relieve the  
23 decision-taker of his or her duty to examine each application  
24 for registration individually on its own merits. The  
25 examination should, as stated in paragraph [45], be stringent  
and full in order to prevent trade marks from being improperly  
registered. In substance, what matters for the purposes of  
the required assessment is whether, from the perspective of  
the relevant average consumer, the sign in question would  
serve to individualise goods or services of the kind specified  
to a single economic undertaking.

1           On turning to consider the expression **WE CREATE SPACE** in  
2 accordance with the criteria identified by the Court of  
3 Justice, I find it impossible to disagree with the Hearing  
4 Officer's assessment of it as a statement which would not  
5 normally or naturally be perceived and remembered as an  
6 indication of trade origin by the relevant average consumer of  
7 services of the kind specified by the Applicant. I think that  
8 the wording in question would clearly be regarded as a  
9 statement about creating space for the benefit of users of the  
10 service provider's storage facilities. It is in the same  
11 idiom of expression as "We create working space"; "We create  
12 living space"; "We create sleeping space"; "We create parking  
13 space". In this case, it is referring to the activity of  
14 creating storage space. The expression does not cease to be  
15 a statement about the activities of the service provider  
16 merely because the way in which space creation occurs - that  
17 is to say, the mechanism or the methodology of it - is not  
18 thereby explained in any detail. A terse explanation is none  
19 the less an explanation. There is, in the present case, no  
20 verbal manipulation or engineering of the kind which has in  
21 other cases been recognised as sufficient to turn explanatory  
22 phraseology into a sign possessed of a distinctive character.  
23 For these reasons, I determine that the appeal should be  
24 dismissed under Section 3(1)(b).

25           It is not strictly necessary to consider whether the

1 appeal should succeed or fail under Section 3(1)(c). However,  
2 the point has been fully argued before me and I will consider  
3 the appeal further in that connection.

4 I have already quoted the wording of Section 3(1)(c).  
5 That wording is derived with slight variation, as prescribed  
6 by Article 3(1)(c) of the Trade Marks Directive, from  
7 paragraph B.2 of Article 6 quinquies of the Paris Convention  
8 of March 20, 1883 (last amended on 28 September 1979). The  
9 words "or other characteristics of goods or services" were  
10 added by the Community legislator and they are evidently  
11 intended to ensure that the wording derived from the Paris  
12 Convention is regarded as illustrative and not exhaustive of  
13 the bases upon which descriptiveness can be held to disqualify  
14 a sign from registration.

15 Consistently with that approach, it appears, to me, to  
16 be necessary to interpret the word "characteristics" in the  
17 expression or "any other characteristics" as applicable not  
18 only to what a trader may be willing to supply, but also to  
19 when, where, why and how it may be supplied. Such matters -  
20 and suitable ways of designating them - are liable to vary  
21 according to the context or manner in which goods or services  
22 of the kind specified for registration may actually be  
23 provided. I think it follows that a mark can be objectionable  
24 under sub-para.(c) without being descriptive in every context  
25 or manner in which it could be used with reference to goods or

1 services of the kind specified.

2 The Applicant points to the fact that the use of the  
3 word **WE** in the expression **WE CREATE SPACE** is apt to refer to  
4 the service provider. I agree. I also agree that a  
5 designation can be descriptive of the qualities or  
6 characteristics of a service provider without also being  
7 descriptive of his services and vice-versa. Even so, it is  
8 possible for a designation to straddle the dividing line  
9 between the two types of descriptiveness. I think that is the  
10 position here. The expression **WE CREATE SPACE** is, as I have  
11 already said, a statement that the relevant average consumer  
12 would take to be about creating space for the benefit of users  
13 of the service provider's storage facilities.

14 However the words "consists exclusively" as used in  
15 Section 3(1)(c) continue to give rise to a degree of  
16 discomfort in terms of their practical application. In  
17 context, they confine the exclusion in Section 3(1)(c) to  
18 designations which are simply and solely descriptive. Beyond  
19 that there is a steady stream of judgments from the General  
20 Court affirming that there can only be descriptiveness for the  
21 purposes of that prohibition when there is a direct and  
22 specific relationship between the designation in question and  
23 one or more characteristics of the relevant goods or services.

24 I was referred, in particular, to the judgment in Case  
25 T-67/07 *Ford Motor Company v OHIM*. Many other judgments could

1 be cited for the same proposition. The Applicant relies on  
2 that line of case law in support of its contention that the  
3 expression **WE CREATE SPACE** is too vague and elliptical to be  
4 caught by the exclusion from registration contained in Section  
5 3(1)(c).

6 I have to say that I have considerable misgivings as to  
7 the appropriateness of an interpretation that would render  
8 Section 3(1)(c) inapplicable to designations such as, for  
9 example, "Best Ever" or "Seriously Good" on the ground that  
10 they lack specificity as to one or more characteristics of  
11 goods or services. However, I do not think it is either  
12 necessary or appropriate to explore those misgivings further  
13 on this occasion.

14 Taking the case law of the General Court as I find it, I  
15 think that the expression **WE CREATE SPACE** is sufficiently  
16 direct and specific to be classed as a statement about the  
17 kind of services the service provider is providing, and is  
18 therefore caught by the exclusion from registration in Section  
19 3(1)(c).

20 I would therefore reject the appeal under that section  
21 of the Act.

22 Having considered Mr. Bidgway's witness statement and  
23 the information provided by his exhibits, I do not think there  
24 is any sufficient basis in the evidence for a finding of  
25 distinctiveness acquired through use so as to render the sign

1 in question eligible for registration under the proviso to  
2 Section 3(1) of the Act.

3 My conclusion overall is, therefore, that the appeal  
4 should be dismissed. I would add one further point. In  
5 paragraph 18 of her Decision, the Hearing Officer referred to  
6 an extract from the Applicant's website which she quoted with  
7 emphasis in support of her reasoning upholding the objections  
8 to registration. I think it would have been more appropriate  
9 for her to have given the Applicant for registration an  
10 opportunity to comment in relation to the extract in question  
11 before she introduced it into her reasons for refusing the  
12 application for registration. My own view of her use of that  
13 extract is that she was relying upon it as illustrative of the  
14 reasoning that she was already intent upon adopting in support  
15 of her Decision. In the circumstances, I do not think that  
16 anything seriously wrong has occurred as a result of her  
17 inclusion of that extract in her Decision. However, as I say,  
18 the better practice would have been not to include it without  
19 giving the Applicant an opportunity to comment in that  
20 connection.

21 Does anybody want to say anything?

22 MR. KRAUS: No, Sir.

23 MR. ABRAHAM: No, Sir.

24 THE APPOINTED PERSON: I think this is a suitable case for adhering  
25 to the usual practice on costs in ex-parte appeals, which is

1 to say that there is no order for costs on the basis that it  
2 is considered to be a continuation of the procedure under an  
3 application for registration.

4 Thank you both for your submissions. That concludes it  
5 for today.

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