

O-362-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2335938  
IN THE NAME OF BRAND PROTECT LLP**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 93122 IN THE NAME OF  
BRIFFA BUSINESS DESIGN CENTRE**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF application No 2335938  
in the name of Brand Protect LLP**

**And**

**IN THE MATTER OF Opposition thereto under No. 93122  
in the name of Briffa Business Design Centre.**

**Background**

1. On 25 June 2003, Brand Protect LLP applied to register a series of two trade marks in Classes 35 and 42, in respect of the following specifications of services:

**Class 35** Business management and marketing consultancy services; business advice and market research services.

**Class 42** Legal services; establishment, maintenance and enforcement of intellectual property rights; professional, advisory and consultancy services relating to legal matters; searching, research and investigation searches; preparation of translations and drawings; preparation and provision of reports relating to all the aforesaid services; design of brand names, stationery, packaging material, publicity material, corporate identities, advertising, marketing and publicity materials; creation of brand names; company registration services; Internet domain name registration services.

2. The marks applied for are as follows:



The applicant claims the colours black and blue (Pantone 287) as an element of the first mark in the series.

3. On 21 January 2005, Briffa Business Design Centre filed notice of opposition against the application, the grounds being in summary:

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| <p><b>1. Under Section 3(1)(b)</b></p> | <p>because the marks are devoid of distinctive character.</p>   |
| <p><b>2. Under Section 3(1)(c)</b></p> | <p>because the marks consists exclusively of signs or indications which may serve in the trade to designate the kind, quality or other characteristics the services for which the marks have been filed, in that the services relate to the protection of businesses' brands.</p> |
| <p><b>3. Under Section 3(1)(d)</b></p> | <p>because the marks consist exclusively of signs or indications which have become customary in the current trade or in the bona fide and established practices of the trade in that the services covered by the application generally relate to the businesses' brands.</p>      |
- of
- protection of

4. The applicants filed a Counterstatement in which they deny the ground on which the opposition is based.

5. Both sides request that costs be awarded in their favour.

6. Both sides filed evidence in these proceedings, which insofar as it may be relevant, I have summarised below. Neither party took up the offer of an oral hearing, electing instead to file written submissions. Accordingly, after a careful study of the evidence and submissions on file, I issue my decision.

### **Opponents' evidence**

7. This consists of a Witness Statement dated 28 July 2005, from Amandeep Singh, a solicitor with the law firm Briffa Solicitors. Much of Mr Singh's Statement consists of submission rather than fact, and as such it is neither appropriate nor necessary that I summarise it in detail. I will, of course take all of the Statement fully into account in my determination of this case.

8. Mr Singh asserts that the dominant element of the mark is the words BRAND PROTECT in a non-stylised form, and that the device of the elephant contained within a circle is merely an artificial embellishment. He introduces Exhibit AJS1, which consists of a print from the applicants website ([www.bptm.co.uk](http://www.bptm.co.uk)), drawing attention to the way in which the applicants represent the trade mark. He goes on to submit that the elephant device does not feature in an analysis of the aural and conceptual elements of the mark, and that the average consumer would

not register any distinctiveness in the mark.

9. Mr Singh has undertaken research on the Internet to ascertain the nature and use of the words BRAND PROTECT, the results of which he shows as Exhibit AJS2. The Exhibit consists of 10 hits from the 983,000 returned, and shows BRAND PROTECT being used on the applicants' websites, and others that mention BRAND PROTECT. The other results show use of BRAND PROTECTION in combination, or the words BRAND and PROTECT separately and descriptively. Exhibit AJS3 consists of a print from the website of a company trading as Brand Intelligence, Mr Singh highlighting the use of "brand" and "protection" in the company's explanation of their services. Exhibit AJS4 consists of a further print taken from the website of an Internet Domain Name trader, who provides a service called BRAND PROTECT and BRAND PROTECT SAFER. The company appears to have three levels of service – SAFE, SAFER and SAFEST. Exhibit AJS5 consists of a print from the website of Light Impressions, an anti-counterfeiting organisation, Mr Singh highlighting the use of BRAND PROTECTION – WHEN 94% PROTECTION ISN'T ENOUGH", and the company's link to protecting goods from counterfeiting. Exhibit AJS6 is a print from the website of Addleshaws Goddard, Mr Singh highlighting the use of BRAND PROTECTION as the title for an article on the protection of brands. All of the extracts were printed on 28 July 2005.

#### **Applicants' evidence**

10. This consists of a Witness Statement dated September 2005, from Bernard A. Whyatt, a partner in the firm of Brand Protect LLP. Mr Whyatt's Statement consists primarily of submission rather than fact, which it is neither appropriate nor necessary that I summarise. I will, of course take these submissions fully into account in my determination of this case.

11. Mr Whyatt states that his company has been using the sign in question since 2002 which is the date when the firm was registered. He refers to an extract taken from the opponents' website on 27 September 2005, shown as Exhibit BW1, highlighting the use of BRAND PROTECT. Exhibits BW2 and BW3 consists of a copy of the applicants stationery and a business card, and a print taken from their website, respectively, which Mr Whyatt says is illustrative of how they use the mark.

#### **Opponents' evidence in reply**

12. This consists of a Witness Statement dated 28 December 2005, from the same Amandeep Singh, as mentioned above. Mr Singh's Statement consists of submission on the evidence (and submissions) given by Mr Whyatt in his evidence. This being the case I do not consider it to be either necessary or appropriate that I summarise it here. I will, of course take the Statement fully into account in my determination of this case.

13. That concludes my review of the evidence insofar as it is relevant to these proceedings.

## Decision

13. The opposition is based on Section 3(1)(b), 3(1)(c) and 3(1)(d) of the Act, which reads as follows:

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

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- serve, (c) trade marks which consist exclusively of signs or indications which may  
or in trade, to designate the kind, quality, quantity, intended purpose, value,  
geographical origin, the time of production of goods or of rendering of services,  
other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have  
become customary in the current language or in the *bona fide* and established  
practices of the trade:

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.”

14. There is no claim that the mark has become distinctive by virtue of the use made of it, so the proviso is not relevant in these proceedings.

15. Turning first to the ground under Section 3(1)(d) of the Act, as that is most easily disposed of. The leading guidance from the European Court of Justice on Article 3(1)(d) (equivalent to Section 3(1)(d) of the UK Act) is contained in *Merz & Krell GmbH & Co*, [2002] ETMR 21:

“41. It follows that Article 3(1)(d) of the Directive must be interpreted as meaning that it subjects refusal to register a trade mark to the sole condition that the signs or indications of which the trade mark is exclusively composed have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought. It is immaterial, when that provision is applied, whether the signs or indication in question describe the properties or characteristics of those goods or services.”

16. As this case indicates, an objection based on this ground is not to be determined on the basis that the mark is in some way descriptive of the goods or services; that is a matter to be considered under the provisions of Sections 3(1)(b) and (c) of the Act. It would therefore follow that if the decision is not to be made on the basis of descriptive aptness, any assertion that a mark has become customary in the language and practices of the trade connected to the relevant goods

and services has to be supported by clear and cogent evidence. Apart from use shown by the applicants, there is no evidence from any other source, trade or otherwise. I do not, therefore, see on what basis I can conclude that the mark tendered for registration falls foul of Section 3(1)(d) of the Act, and the objection founded on that section is dismissed.

17. I turn next to consider the grounds under Section 3(1)(b) and (c) of the Act. In the *Cycling Is* decision [2002] RPC 37, it was stated that a the distinctiveness of a trade mark is not to be considered in the abstract, but rather by reference to the goods of services in respect of which registration is sought, and the relevant public's perception of that mark. In the judgment issued in respect of *Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003), paragraphs 37, 39 to 41 and 47, the European Court of Justice (ECJ) summarized the considerations in respect of assessing distinctiveness under Section 3(1)(b) in the following terms:

“37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods or services of one undertaking from those of other undertakings.

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and *circumspect* (see *Case C- 210/96 Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

18. In a judgment issued in respect of *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case -191/01 P, the *Doublemint* case, the ECJ gave the following guidance on the scope and purpose of Article 7(1)(c) of the Community Trade Mark Regulation, equivalent to Section 3(1)(c) of the Trade Marks Act:

“28. Under Article 4 of Regulation No 40/94, a Community trade mark may consist of any signs capable of being represented graphically, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or of rendering of the service, or other characteristics of the goods or service are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.

31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 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 sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, *inter alia*, in relation to the identical provisions of article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-(3161), paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

19. From this it is clear that the prohibition to registration under Section 3(1)(c) of the Act

relates to signs that may not be being used as a designation of a characteristics of the relevant goods or services, but nonetheless could be apt for such use. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the services in question.

20. The mark consists of two elements; the device of an elephant contained within a circular border, and the words “BRAND PROTECT” placed to the right of the device. Being a composite mark, the question I must answer is whether the elements, either in their own right, or as part of a collective whole, create a mark that is likely to be seen by the consumer as origin specific. In Case C-383/99 P, *Procter & Gamble Company v OHIM*, the *Baby Dry* case, the issue of grammatically incorrect trade marks was considered:

“43. ... As it is, each of the two words in the combination may form part of expressions used in everyday speech to designate the function of babies' nappies, their syntactically unusual juxtaposition is not a familiar expression in the English language, either for designating babies' nappies or for describing their essential characteristics.

44. Word combinations like BABY-DRY cannot therefore be regarded as exhibiting, as a whole, descriptive character; they are lexical inventions bestowing distinctive power on the mark so formed and may not be refused registration under Article 7(1)(c) of Regulation No 40/94.”

21. The words BRAND and PROTECT are ordinary English words that individually, and collectively have a clear and obvious reference to services that relate to the “establishment, maintenance and enforcement of intellectual property rights”, or in other words, that involve “brand protection”. It must be noted that whilst the application covers such and similar services, it also encompasses services that would not involve any aspect of the protection of trade marks.

22. As can be seen from my use of “brand protection” rather than “brand protect”, the words require some grammatical correction to properly describe the services, and as such may be considered to be a “syntactically unusual juxtaposition” and a “lexical invention” that is not a familiar expression in the English language. However, as was stated in the appeal to the Appointed Person in the *Where all your favourites come together* case (BL 0/573/01), it is important to take account of distinctions between a trade mark and a description of the goods, or in this case services, arising from the omission of words or components that would be necessary for the sign to work as a description. Shortening a longer descriptive phrase will not necessarily achieve a trade mark free from objection under Section 3(1)(c), as the shortened version or an abbreviation of a longer descriptive term may serve in trade to designate the goods or their characteristics. Accordingly, if BRAND PROTECTION is devoid of distinctive character, a shortened version is not any more distinctive.

23. In his evidence, Mr Singh describes the “elephant” as “merely an artificial embellishment”, which seems to be saying that it is mere decoration rather than the image of an elephant is devoid of distinctive character when used in relation to the services for which registration is sought. Whilst the consumer will regard the words and figurative elements of the mark as a composite

whole, the figurative element is a clear and distinct part of the mark, and in its relative size and positioning is at least as prominent as the word elements. The words are not placed upon the figurative element so as to relegate it to a mere background, nor do they surround or connect to it. In my view the figurative element is clearly not some decorative feature subordinate to the word element. As far as I am aware, and there is no evidence or any argument to the contrary, the image of an elephant has no relevance for the services for which registration is sought, and is not used in the trade concerned to designate the services of the application or some characteristic of them. If the words are descriptive, the image does not reinforce that message. If the image of an elephant says anything it is one of imposing size, sturdiness, etc, which in relation to a trade mark are allusory rather than descriptive qualities. In my view the figurative element is a distinctive part of the mark and contributes in the creation of something that has a distinctive whole, and the grounds under Section 3(1)(b) and 3(1)(c) are also rejected.

24. The opposition having failed, the applicants are entitled to an award of costs. I order the opponents to pay the applicants the sum of £1,250 as a contribution towards their costs. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 13th day of December 2006**

**Mike Foley  
for the Registrar  
the Comptroller General**