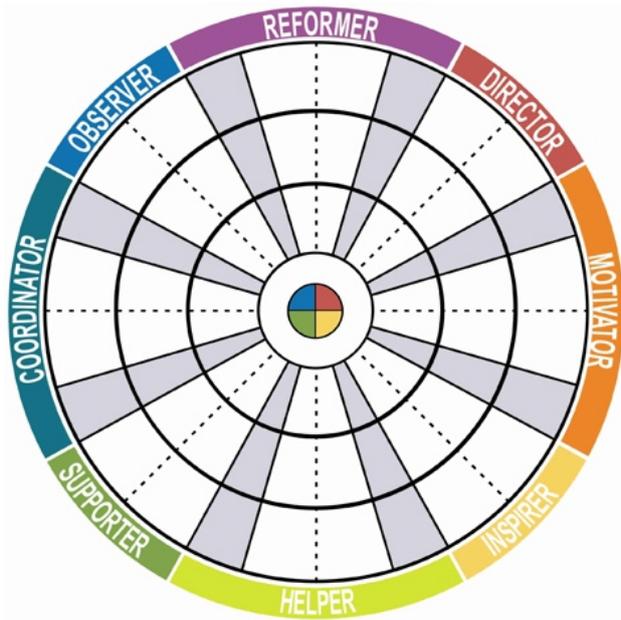


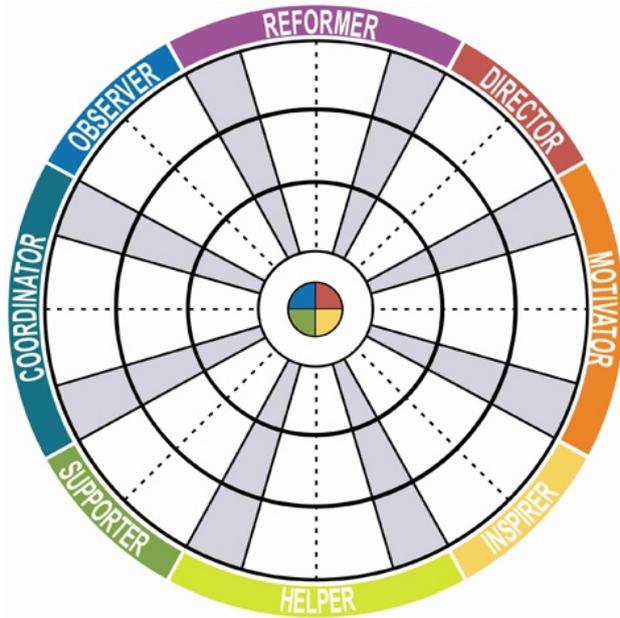
O-413-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 2576641
BY THE INSIGHTS GROUP LIMITED TO REGISTER THE FOLLOWING MARK IN
CLASSES 9, 16, 35 AND 41



**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NUMBER 2576641
BY THE INSIGHTS GROUP LIMITED
TO REGISTER THE FOLLOWING TRADE MARK
IN CLASSES 9, 16, 35 AND 41**



Background

1. On 28 March 2011 The Insights Group Limited ('the applicant') applied to register the above mark for a range of goods and services as follows:

Class 9

Electronic publications; computer software.

Class 16

Printed matter; periodical publications; magazines; books; notepads; all the aforementioned in the field of people (but not personal relationship) and organisational development; folders; catalogues; calendars; diaries; booklets; cards; stationary; office requisites; pens; pencils; erasers; pencil sharpeners; pencil cases; rulers; boxes for pens; book markers; drawing materials; instructional and teaching materials

Class 35

Psychometric testing for the selection, professional development and advising on staff or personnel; testing by psychological type theory for the selection, professional.

Class 41

Organisation and arranging of seminars, workshops, training sessions, conferences and symposiums, congresses and colloquiums; educational information; educational services; publication of books and texts; all of the aforementioned in the field of people (but not personal relationship) and organisational development; arranging training courses; training and seminars for personnel and business assessment, consultancy and development; presentation skills training; team building training; career consultancy; training service in relation to conflict and stress management; sales training

2. On 7 April 2011, the IPO issued its examination report which reads as follows:

Absolute Grounds for Refusal (Section 3)

The application is not acceptable in Classes 09, 16, 35 and 41 as there is an objection under Section 3(1)(b) of the Act. The mark consists of a circular device along with a list of character types/personalities, the whole being a sign which would not be seen as a trade mark as it is devoid of any distinctive character because it will merely be seen by the average consumer as a non distinctive evaluation and/or assessment and/or training tool used for the purposes of psychometric testing and training, along with the accompanying software and printed matter and it is therefore incapable of indicating trade origin.

When the mark is viewed in respect of the goods and services for which registration is sought, it will immediately be perceived as a chart used in evaluating individuals or groups in order to determine their strengths and weaknesses and then ultimately to enable the categorisation of the individuals or groups within the list of character types/personalities displayed in the mark.

For the above reasons the mark is incapable of individualising the goods and services of other traders from the goods and services of this application.

The application is acceptable in respect of the following goods in Class 16:

'folders; catalogues; calendars; diaries; booklets; cards; stationary; office requisites; pens; pencils; erasers; pencil sharpeners; pencil cases; rulers; boxes for pens; book markers; drawing materials'

3. The matter could not be resolved and at a telephone hearing held on 25 February 2013 between the attorney (Mr Clark of Ablett & Stebbing) for the applicant and I there were a number of outcomes which were confirmed in a letter of the same date. Firstly, I said I did not disagree with the examiner's assessment of the goods in respect of which no objection would apply and these are indicated above. I will, however, return to the prospect of partial refusal below in my decision.

4. Secondly, I allowed further time in which both to formalise existing evidence and to consider the filing of further evidence in order to establish acquired distinctiveness.

5. Thirdly, and in regard to the second point above, I indicated at the hearing that, in the prima facie, I felt these signs were not registrable. That is to say, the signs presented had the obvious appearance of 'psychometric testing models', whereby the user and others are able to assess a person's character. In the prima facie, such a model would, and without education, not serve the function of a trade mark. At the hearing I did not understand the attorney to demur from this assessment, but In a subsequent letter dated 28 May 2013

however, the attorney indicates that the applicant does not wholly accept that the trade marks are unregistrable in the prima facie, and that it had simply taken the decision to overcome the objections under section 3(1) with evidence of acquired distinctiveness as it had already made substantial use of the marks.

6. Fourthly, at the hearing I drew attention to the statement of the law in relation to acquired distinctiveness contained in, for example, case BL O/166/08 *Vibe Technologies Application* ('Vibe'), a decision of the appointed person at paras 60 – 65, and asked for any further legal submission in relation to that summary of law.

7. My points were addressed by further evidence of acquired distinctiveness and legal submission which were filed in May and June 2013. Having considered all the material in this case I issued formal refusal of the application in totality, together with a short decision, on 22 July 2013. The applicant has now requested a full statement of grounds for my refusal and this is what I now provide. In light of the applicant's stance as regards the prima facie case I will need to cover both that, and the position regarding acquired distinctiveness. But first I need to summarise the legal submissions and evidence filed.

Prima facie case

8. The applicant, through its attorney, says the signs fall the right side of the line for registration. It is said the verbal elements alone are possessed of distinctive character. This is demonstrated by the fact the signs are similar to trade marks and designs owned by the applicant which were registered as long ago as 1996. If however, the applicant is found to be wrong in this, it has filed evidence of acquired distinctiveness.

Evidence of acquired distinctiveness

Mr Buchan's evidence

9. Mr Vivien Buchan, the Finance Director of the applicant, has provided two witness statements; the first is dated 6 September 2011.

10. In this witness statement, he explains The Insights Discovery Wheel ('the wheel'), as it is referred to, comprises two applications, this one ('641') and co-pending application 2576642 ('642'). The witness statement differentiates between the two by reference to the 'Insights Discovery *Team* Wheel', which is the subject of a co-pending application, '642'. The difference between the two is that the team wheel is populated by numbers and circles, representing participants in an event. The wheel, the subject of this application, is described as the applicant's core mark. For the purposes of my evidence summary and decision, no distinction is made between the two applications, both being interchangeably and collectively referred to as 'the wheel', unless otherwise stated. The wheel is, in turn, instrumental in the Insights Discovery profiling and psychometric system. Whilst the evidence and submissions refer to the wheel as a 'trade mark' and I will adopt the same term, when I come to my decision I will refer to them as 'signs'.

11. The wheel is further described as incorporating 19 coloured circles at various positions within it. In practice, the number, position and colour of the circles may vary according to the number of people in the team that is participating in an Insights Discovery team event, and the personal profile of the members of that team, each circle, as I have said, being representative of a team member.

12. Mr Buchan says the wheel was first used in the UK in 2002.

13. The applicant is described as a holding company of the Insights group of companies and

O-413-13

does not trade itself. It owns the group's intellectual property in the wheel, which it licensed in the UK to Insights Learning and Development Ltd for its own use and for sub-licensing to distributors which are independent businesses licensed to promote and sell Insight's products to smaller organisations and Client Practitioners. Client Practitioners are employees of Insight's direct customers who are accredited to deliver the products under licence within their own organisation. The structure of the business, and in consequence the means by which the trade marks are exposed, is further explained below at para. 30 and following.

14. The intellectual property now owned by the applicant was originally owned by Andrew Lothian Snr and Andrew Lothian Jnr and then assigned to the applicant in July 2008. It has, at all times since 2002, been licensed to Insights Learning and Development Ltd and its sub-licenses as set out above.

15. Mr Buchan then sets out the goods and services, in respect of which he claims the mark has been used.

16. Exhibit 4 is a sample of a wheel mat as used at most Insights training events. It is a small version of a larger mat used at training events. The larger mat is placed in the centre of the room for the duration of the course (which can be a 4 day residential course), with seating around it. Delegates may be asked to stand in their wheel position for the purpose of aiding understanding and group interaction.

17. Exhibit 5 is a global sales POWERPOINT presentation used in the promotion of the applicant's business, explaining use of the wheel.

18. Exhibit 6 is a learning guide called 'Understanding the Insights Wheel'. This is intended to show that the wheel is regarded by the applicant as more than a:

'mere tool. They are central to the applicant's business, their distinctive aspects (including colours, ordering of colours, type names and 72 "positions" representing personality types) are unique to the applicant, synonymous with Insights in the market and a clear differentiator from competitors which attracts business.'

19. Exhibit 7 is a further Learning Guide about the 'Insights Discovery Personal Effectiveness Programme', of which the wheel is an integral part. This Guide contains some very useful information about the genesis of the wheel which can be found from pages 10-21 especially. The Guide explains that Hippocrates first observed that many people shared consistent behaviour patterns which he characterised as 'humours', being: melancholic (liking order), choleric (natural leader), phlegmatic (observing from sidelines) and sanguine (outgoing). Hippocrates attributed these temperaments to the effect of different bodily fluids, but with modern medical science the physical cause of the four temperaments has been displaced, but the identification of the temperaments has nonetheless survived and been further explained. Insights have allocated colours to the four temperaments: blue, red, green and yellow and these colours match each of the temperaments. The colours are called the 'Four Insights Colour Energies' and each colour codifies a behaviour:- blue for introverted thinking and reflection, green for support, yellow for articulated vision and inspiration and red for assertive action and direction. From this basis, the guide then goes on to explain the impact and application of the pioneering work of Dr C G Jung in his seminal analysis, 'Psychological Types', whereby people have a different perspective on situations, depending on their predisposition to 'introversion' or 'extraversion'. This, in turn, led people to absorbing information in different ways (sensing or intuition), and also taking decisions in different ways (thinking or feeling). Dr Jung related these four 'processes' to extraversion and introversion and in total, identified eight personality combinations as a result. These eight personality combinations were, according to the Guide, first presented in a wheel configuration in 1941/2

O-413-13

by Dr Jolande Jacobi, an associate of Dr Jung.

20. On page 21 of this Learning Guide, it is explained:

‘The Insights Discovery Model is a faithful reproduction of the Jacobi-Jungian wheel created over 50 years ago.’

21. Exhibit 8 is a mock profile for ‘John Smith’. Everyone on an Insights event completes an ‘evaluator’ which is used to generate a profile, unique to the individual. The profile reproduces the wheel.

22. Exhibit 9 is a full circle profile for ‘John Smith’. This differs from the personal profile referred to above, since it takes into account feedback from other members of the team about ‘John Smith’. The marks are incorporated into all full circle profiles.

23. Exhibits 10 – 16 follow the pattern of showing use of the wheel in relation to various publications, materials, promotional and training materials.

24. Annual sales of the goods/services are stated as follows:

Dates	Amount	% of total revenues
2004/5	£2,798,761	90.5
2005/6	£3,249,418	84.3
2006/7	£3,887,404	83.6
2007/8	£4,432,362	82.2
2008/9	£3,817,195	75.9
2009/10	£4,040,266	80.6
2010/11	£5,341,637	81.2

25. These figures are said to be for sales of all items incorporating the wheel and/or team wheel since 2002 and for which figures are available. Various explanations are also provided as to how the accounting figures do not match the classes of goods and service appearing in the application.

26. Amounts spent on promotion are also provided as follows:

Dates	Marketing	Sales
2004/5	£3,098	£553,036
2005/6	£3,528	£499,003
2006/7	£41,669	£742,490
2007/8	£28,868	£766,501
2008/9	£32,603	£793,074
2009/10	£37,058	£613,689
2011/12	£41,585	£849,570

27. Mr Buchan says the mark has been used throughout the UK.

28. Finally, Mr Buchan concludes that as a result of the invention, development and use of the wheel, the marks are indicative of the origin of the applicant’s services and that they are distinctive marks and a key part of the applicant’s branding. The applicant is alone in dividing a wheel into 72 positions, splitting the wheel into 8 segments. The use of the 8 type names around the rim of the mark is also specific to the applicant and the combination of those words in this order is sufficiently different to be distinctive of the applicant. Following the hearing, Vivien Buchan submitted a second, supplementary witness statement dated 22

May 2013.

29. In his second witness statement, Mr Buchan explains that in the assignment of the trade marks in 2008, the trade marks were referred to collectively as unregistered trade marks but the registration and subsequent inclusion in the assignment document of other wheel type marks, shows that the company views their wheels as trade marks. The assignment is exhibited at VB1. I note that the assignment refers to a number of registered trade marks in many jurisdictions. The wheels have been already been registered in the UK under numbers 2171254 (3 July 1998), 2070130 (27 April 1996), 2238057 (1 July 2000).

30. Mr Buchan explains the company's customer network as being divided into 'direct' and 'indirect' channels. For direct channel customers the company deals directly with the end consumer and the relationship is managed by a member of the company's direct sales team. Direct channel customers are large employers who may have one or more of their own employees accredited in the use of the Insights Discovery System (by attending an Insights Discovery Accreditation). Those accredited in this way are known, as I have said above, as Client Practitioners.

31. Direct channel customers tend to run Insights Discovery courses and workshops for their employees, facilitated by one or a combination of a Client Practitioner, an employee of the company or a Licensed Practitioner who has been introduced to the direct channel customer by the company. In all cases, materials used bearing the trade marks are purchased from the company and will be used during the courses and workshops.

32. Indirect channel customers are described as those being dealt with through a distributor. The distributor will manage the relationship with the end consumer and the distributor is then managed, in turn, by the indirect sales team. The distributor has an agreement with Insights and tends to have one or more people accredited in the Insights Discovery System and these people are known as Licensed Practitioners. The distributors run Insights Discovery Courses and workshops for its customers, facilitated by a Licensed Practitioner and using materials bearing the trade marks and purchased from the company.

33. The company's end consumers are employers of all descriptions: public, private and not for profit, from the largest to the smallest.

34. Mr Buchan then describes the variety of workshops and courses. Central to these is the use and consumer understanding of the trade marks. In particular, the 4 day accreditation course trains attendees to coach and facilitate using the Insights Discovery psychometric testing model. The mat referred to in Mr Buchan's earlier witness statement is used frequently in this course. Participants must also complete a 'confirmation of learning' questionnaire to demonstrate their understanding and this is exhibited at VB2. This document contains a representation of the wheel.

35. Insights Discovery Workshops/Introductory Discovery Workshops also use the System enabling participants to gain awareness of different psychological preferences and thereby, enabling them to build better relationships. The trade marks are used to:

'...represent different preferences and both are displayed throughout the workshops, typically within POWERPOINT slides, in the Insights Discovery profiles and on a mat, which sits on the floor in the centre of the workshop space. Group interactions typically involve participants walking on and around the mat. They stand on a particular position on the mat and describe their behaviour based on the preferences in that position. The trade marks are central to discussions around team dynamics, where the delegates look at how their respective positions interact.'

O-413-13

36. The company has 5,092 active clients on its Customer Relationship Management Database and these are listed at Exhibit VB3. These clients include direct channel customers and Licensed Practitioners. Mr Buchan says, "I believe most if not all of the clients on our CRM databases have seen the trade marks".

37. The 'Discovery Evaluator' is a questionnaire used to produce the Insights Discovery Profile and Mr Buchan estimates that 750,000 people completed this evaluator in the UK prior to 2011. He says, 'I believe that most of these people will then have had their profile plotted on one or both trade marks.'

38. Mr Buchan acknowledges that the mat at Exhibit 4 to his earlier witness statement is not identical to either of the trade marks, but it is nevertheless, '... built on the framework of the wheels shown in the trade marks.' The mat is used at almost all of the Insights Discovery accreditations and workshops.

39. The company has sold 848 Insights Discovery Mats and it is estimated that 75%, or 636, of these have remained in the UK.

40. Further information is then given on the exhibits to his earlier witness statement. He says Exhibit 5 to his earlier witness statement, being the POWERPOINT presentation, is shown to potential customers, typically face to face but also via e-mail. Exhibit 11, being the materials for the accreditation course, is said to have provided the basis of that course for the last 10 years, with further materials remaining available to practitioners to download. As far as Exhibit 6 is concerned, he explains that, for the period 2004-2011, approximately 27,900 copies of the 'Understanding the Insights Wheel Learning Guide' has been provided to course attendees. As regards Exhibit 7, 'A brief journey: Extracts from the Insights Discovery Personal Effectiveness Programme' for the period 2004-2011, it is estimated that 25,450 copies of this Learning Guide were distributed across 7,200 workshops.

41. The company's website, www.insights.com, was established in 1999 with the current version launched in early 2011. The trade marks are frequently used as images accompanying text and commentary. One example is shown at Exhibit VB4. During 2011 the website was visited by 84,098 unique users of which 36,630 were based in the UK.

42. The company launched its FACEBOOK page in 2009 and it has received over 2,300 'likes'. The trade marks appear periodically on the page. Exhibit VB5 comprise photos taken from the page, including one of a cake baked for Andrew Lothian Senior's birthday, iced with the wheel.

43. Since 2009 the company has also has presence on TWITTER, with 2,400 followers.

44. Finally, Mr Buchan acknowledges that circular graphics are used within other psychometric testing models but the trade marks can be distinguished from these representations in two important respects. No other wheels are visually alike to the wheel and furthermore, 'the fundamental and integral use of the trade marks as part of the Insights Discovery psychometric testing model is unique to the company's services..

45. It is estimated the company has '2.3% market share of UK based employer spending on training.' Mr Buchan explains this figure was calculated using figures provided in the UK Commission for Employment and Skill's report called 'UK Employer Skills Survey 2011' at Exhibit VB6. This report indicates that total UK expenditure on training is estimated at around £46 billion. Industry reports suggest that 40-42% of employer spending goes towards external suppliers. Our 'Customer Solutions Analysts', says Mr Buchan, estimate that size of the market 'available to the company' is approximately 10% of all training on external suppliers. The size of the market available to the company is thus £1.96bn, with the

company's revenue last year being £45.16 million.

Third party evidence

46. This is provided by Giles Miskin, Managing Director of The Colour Works International Ltd and his witness statement is dated 22 April 2013. He attended an accreditation course around 10 years ago and as a result became a Licensed Practitioner. He and his company uses the Insights personality profiling model to assist organisations develop their people. He tends to only use the Insights model. The beauty of the Insights model, he says, is that all participants can be great, wherever they are positioned on the wheels. The Insights wheels are a, 'wonderfully clear visual representation that allows teams to consider where their stresses and strains are, where their gaps are, where their challenges are.' The Insights wheels form part of every workshop and attendees profile; his company produces 3,500 – 4,000 profiles per year. His company has a wide range of customers, from large multi-national corporations to SMEs and start ups. Public sector clients are also catered for, such as the police and national government departments. He says his services are provided across the UK 'through a network of sub-contracted associates who are trained in the Insights model ... I think that once profiled using the Insights model, people remember the Insights wheels readily because of their visual impact, as opposed to the verbal impact of Motivator/Inspirer, for example.'

47. Mick Lightfoot is a director of Colourful Solutions Ltd and has provided a witness statement dated 28 April 2013. He delivers leadership and management solutions and training and exclusively uses the Insights Discovery Model. He has worked with other models but believes the Insights Discovery Model works better as it is simpler to understand and more efficient in the workplace. This is, in part, he says due to its visual appearance. He is also a Licensed Practitioner training clients himself and managing a network of Insights Discovery model accredited associates who conduct some of the training. His clients include ICELAND, ARGOS, SKY and others. It is difficult for him to say exactly how many people his company has trained using the Insights Discovery model but he believes it to be in excess of 2000. During training he uses the wheel as part of a POWERPOINT presentation and uses the mats. He gets participants to walk around the mat as a team so that they understand where each other fits in. Copies of the wheel are also given in personalised reports. Around 75% of his clients ask that he sends a slide of their Insights team wheel for display in their offices. He is convinced people would recognise the Insights team wheel as designating The Insights Group and Discovery Model. He says the Insights wheels are unique, highly effective and involve colours which people remember.

48. Dee Logan is a director of Synchronicity People Solutions Ltd and has provided a witness statement dated 21 February 2013. Prior to her current position she worked with the applicant company. She now works with her own company providing training to local councils and private sector companies in finance and retail. She offers psychometric testing including a number of different models: Belbin, Myers-Briggs, Mergerison-McCann Team Management Index. However, 90% of her training involves the Insights Discovery System which she first became aware of some 20 years ago whilst working for IBM. She says, 'It was a different form of wheel at that time [but] the process had an impact on me and I approached Insights Learning and Development Ltd to become involved in it'. The popularity of the Discovery System has increased she says, because, perhaps, of its interactive nature. Clients are able to see their personality type, where it falls on the wheel and how it interacts with and is opposite from other personality types. After a course she will always prepare and laminate a wall chart sized wheel for her clients. She says the wheel will be associated with Insights because of its integral nature in the training and visibility throughout the process, including in materials such as the mats.

49. Joy Levesley is Head of People Development, Corporate with Marston's PLC and she

O-413-13

has provided a witness statement dated 25 April 2013. She became aware of the Insights Discovery profiling model in 2006. Marston's had previously been using Myers-Briggs but felt it was quite complex in terms of results. Insights profiling had the advantage of simplicity and its use of colours. Marston's then adopted Insights and she became an accredited Client Practitioner. The model has become part of:

'Marston's language and culture and has changed the way people communicate and interact with each other. In the corporate part of the business, of which there is about 1,100 staff, many of us have Insights bricks on our desk. These are used to represent the Insights profiles and so as you go around the business, people know what each others' communication preferences are.'

50. She says there are more people in Marston's who understand their Insights profile than do not. The model is also part of the induction process. Marston's run different workshops using the Insights model; an initial workshop understanding your profile, a second, using your profile and a third about team effectiveness. The wheel is visible in all workshops. A big floor mat is used which people step on and walk around. Based on their positions people can see how to use their personal style to influence somebody who is placed in a different wheel position. She would find it difficult to run an Insights model workshop without the wheel. The wheel is memorable because of the understanding it engenders of individual behaviour and team dynamics. Within Marston's, she says, many will associate the wheel with Insights and Regional Managers will often ask for their teams' wheel on taking up a new position. She also feels there will be wider recognition in the broader learning and development sector as demonstrated when she was taking to a Marston's supplier about sub-contracting presentation skills training and he knew of the Insights wheel.

51. Mark Moorton is UK Human Resources Director at Mercer. He uses psychometric testing profiling models in recruitment and for training and team building. He first became aware of the Insights model whilst working for SPECSAVERS. Around 1200 UK based staff at Mercer have been trained using the wheel. He says he has used them also for diversity training. He believes they are simple to use to understand, visual, and people just 'get' how they work.

52. Fay Goldsmith is Learning and Development Manager with Philips Electronics UK Ltd and has provided a witness statement dated 20 February 2013. She is qualified to use different testing models such as Myers-Briggs, SHL and Insights Discovery. She first became aware of the Insights Discovery Model in 2008 when two Insights Licensed Practitioners provided accredited training to staff at Philips. She says the wheels are widely recognised and used within the Learning and Development Sector; they are unique and immediately recognisable by their format, the specific colours and the way the colours are used which are central to the Discovery model. The wheels are central to Insights model, an Insight wheel appears on everyone's profile page which is what is taken away and referred to and shown to other people.

53. Suzanne Padovani is a Senior Director of Organisation Development and Effectiveness for Europe, the Middle East and Africa for a global pharmaceutical company Celgene. She has provided a witness statement dated 24 May 2013. She explains that she is aware of psychometric testing models and that following alignment of Celgene's US and European operations, it was decided that the Insights model could be used across the company and she became an Accredited Practitioner last year. All newcomers to the company have their profile done and there are a number of Learning and Development champions across the company who use the Insights model for coaching. She estimates that at least 100 people within Celgene's UK office have experience of the model. She says of the wheel,

'I have tried to think of what else might be associated with the Insights' workshops or their philosophy and content and, other than the colours, the only thing that I think

really denotes and characterises Insights and the Insights Discovery model is the Insights wheel. In fact, I think people are more likely to remember and recognise the Insights wheels than the name Insights, which they may not necessarily remember.'

54. Petra Hollick is Client Business manager at Expression For Growth, a bespoke training company delivering training to business in key areas such as leadership, commercial and self/team. She has provided a witness statement dated 30 May 2013 in which she explains she became aware of the Insights system and wheel in 2008. Her company is a distributor for Insights and has a range of clients from large blue chip companies to much smaller enterprises. She uses the wheel to introduce profiling into programmes and workshops and it is visible throughout some of the workshops. She believes people who have experienced a training day will immediately recognise the wheels and their colours as representing the goods and services of Insights and was surprised to learn of the objection raised to the registration of these marks.

55. I should finally also mention other third party evidence. This takes the form of pro-forma statements by various people, all signed on various dates in May 2012, saying they recognise the wheels, the subject of the trade mark applications,

'as being trade marks which are distinctive of the goods and services of The Insights Group Ltd'.

56. The following have given such evidence: Lynne Gregory (Retail Training, Development and Culture Manager) at Anglia Co-operative; Kirsty Bashforth (Group Head of Organisational Effectiveness) at BP plc; Patricia Webber (HR Director) at Mylan Generics UK Ltd; Fay Goldsmith, referred to already above; Hannelie Meintjies of Sykes Global Outsourcing; Jackie Watson (HR Director, Specialist and Activity) at TUI Travel plc; Ali Stewart of Ali Stewart & Co; Rex Harrison of Beyond Team Transformation; Mick Lightfoot, referred to already above; Rob Slade, Office Manager of The Colour Works International Ltd; Carole Barber of Full Potential Group and Paul Cook of Radius 360.

Legal submissions on acquired distinctiveness by the attorney

57. The attorney says the evidence shows that the trade marks covered by the applications identify the goods and services as originating from the applicant, distinguishing its goods and services from those of other undertakings. The evidence shows that the trade marks are exclusively associated with the applicant's personality profiling services and related products and that this assertion is based on their uniqueness. The attorney also notes the context in which the trade marks will be exposed as being in a professional context where levels of attentiveness are high and that this in turn leads to a greater likelihood of trade mark recognition. The attorney says the trade marks are two dimensional, circular representations containing distinctive words. They do not fall within a category of trade mark (e.g. colour, shape, personal names, advertising slogans or surface treatments) in respect of which the public do not as easily perceive trade mark use. The attorney says it has met the various ways of demonstrating acquired distinctiveness as set out in the case law, notably the *Windsurfing* case, referenced below.

58. The attorney notes from the *Vibe* case that for a mark to acquired distinctiveness through use, the identification by the relevant class or persons, of the product or service, as originating from a given undertaking must be as a result of the use of the mark as a trade mark. In *Vibe*, the hearing officer acknowledges the law as it stands in unclear as to what exactly is required in addition to 'association', for a sign to have acquired distinctiveness. The hearing officer in *Vibe* agrees with the approach taken in other cases, such as *Unilever plc's Trade mark Application* [2003] RPC 35 and *Bongrain S.A' Application* [2005] R.P.C 14, which say that what must be shown is that a significant proportion of the relevant class of

persons rely upon the sign in question on its own as indicating the origin of the goods. It is not essential for the applicant to have explicitly promoted the sign as a trade mark. It is sufficient for the applicant to have used the sign in such a way that consumers have in fact come to rely on it as indicating the origin of the goods. The evidence of, e.g. Suzanne Padovani (who has said the trade marks are more memorable than the word 'Insights') and Mick Lightfoot demonstrates this to be the case.

59. The attorney notes that in the CJEU *Storck 1* case it was recognised that distinctive character may be acquired, inter alia, 'after the normal process of familiarising the relevant public has taken place'. The attorney says this is relevant to the present case; the relevant public would come to recognise the trade marks whilst taking part in the training services provided by Client Practitioners and Licensed Practitioners connected to the applicant. Notwithstanding that the trade marks are predominantly used during a training process, the evidence shows use also on the applicant's website and in social media, when consumers may view the trade marks prior to making a decision as to whether or not to purchase the applicant's personality profiling services and related products.

60. Reliance on the proviso to section 3(1) is, in sum, the applicant's fallback position if the signs are not considered the right side of the line, prima facie. As regards acquired distinctiveness, the applicant contends, in critical summary, it need not have used the signs as trade marks. Indeed, the applicant's submission apparently goes so far as to acknowledge use only as a training tool and it is worth quoting its position accurately and without paraphrase. The following is taken from a letter dated 28 May 2013:

'As stated above, it is not necessary for the applicant's evidence to show use of the trade marks as trade marks. In this instance although the trade marks are used as training tools, it is nevertheless possible for them to acquire a distinctive character after the normal process of familiarising the relevant public has taken place.'

Decision

61. The relevant sections of the Act read as follows:

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

(a) ...

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

(c)

(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."

Legal principles – section 3(1)(b)

62. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) the Court has held that '... the public interest ... is, manifestly, indissociable from the essential function of a trade mark' (Case C-329/02P, SAT.1 *Satelliten Fernsehen GmbH v*

OHIM). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see Para 23 of the above mentioned Judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function.

63. It is also well established that the words 'devoid of distinctive character' are interpreted as meaning 'unpossessed' of distinctive character¹, based on the perceptions of the average consumer and in relation to the goods and services applied for.

64. It is noted in this case that objection under section 3(1)(b) only has been taken and not 3(1)(c). Although it may be said that, in respect of many goods and services, the signs act as 'subject matter', and may thus be susceptible to a section 3(1)(c) objection, this has not been taken and I do not intend to focus on section 3(1)(c) at all.

The prima facie case based on inherent characteristics

65. Both signs are figurative and have the appearance of dart boards, being circular and comprising a number of segmented concentric circles, the 'bull's eye' comprises another circle which is also segmented into quarters, each being a different colour. Colour is a feature of both signs; there are the colours: purple, brown, orange, yellow, green and blue used. Some of these are differing shades. Around the edge of the circles are the words: 'REFORMER', 'DIRECTOR', 'MOTIVATOR', 'INSPIRER', 'HELPER', 'SUPPORTER', 'COORDINATOR' and 'OBSERVER'. From the applicant's own evidence (Exhibit 7 to Mr Buchan's first witness statement summarised above), these eight personality types were first identified by Dr Jung.

66. As I have said above, the difference between the two signs is that the 'team wheel' ('642) is populated with numbers and circles, whereas the core wheel ('641) is not. In practice, the number, position and colour of the circles, depicted in the team wheel, will vary according to the number of people in the team participating in an Insights Discovery team event, and the personal profile of the members of that team, each circle being representative of a team member. This may raise a question as to the scope of the rights in the 'team wheel', as being limited to the representation filed but this was not the subject of any objection or debate and I prefer to say no more on this question.

67. The applicant notes that earlier versions of the wheel have already been registered by various authorities, including in the UK, and as in some cases, as registered designs. This is, however, not a fact which binds my present decision. The applicant's submissions regarding the words are, however, apparently undermined by its own evidence, which plainly attributes the wheel depiction of the eight personality types to the work of Dr Jolande Jacobi in the early 1940s (see Exhibit 7 to the first witness statement of Vivien Buchan).

68. Despite pleas as to their 'uniqueness' by the applicant, and even if one was unfamiliar with the work of Drs Jung and Jacobi, both signs, to the professional trainer, have the undoubted appearance of psychometric testing models; the words used in both purport to characterise users' personality types. The average consumer in this case, which I agree to be professional and engaged in the field especially of training and development (whether 'in house' or for others) will, most likely, be familiar with a variety of psychometric testing models as the evidence shows (such as, e.g. Myers-Briggs), and even models of a circular appearance. Absent use and education, I do not believe the average consumer will see

¹ See, e.g. *Colgate-Palmolive Co's Trade Mark Application* [2002] RPC 25 at Paras 15 and 16 and cited case *Reemtsma Cigarettenfabriken GmbH's* applications to register a 3-Dimensional shape of a cigarette packet (Applications 2031898 and 2031899 dated 25th August 1995) unreported.

these signs as trade marks when their function is, based on inherent characteristics, plainly that of being psychometric testing models or aids to psychometric testing. I would simply add at this point, though the mark applied for had no obvious connection with psychometric testing, a similar approach in relation to a 'business methodology' was taken by the hearing officer in a previous decision, BL O/329/12. That is to say, in its inherent graphical characteristics the sign applied for in this earlier matter resembled no more than what would be seen as the figurative expression of a business methodology. I am further aware of another case involving psychometric or personality testing signs, that of General Court Case T-507/08 *Psytech International Ltd v OHIM ('Psytech')*, which can be distinguished on the basis that the average consumer was considered unable to perceive immediately what the sign '16PF' actually meant (16 personality factors). In the cases before me, the signs can be clearly seen to be visual psychometric testing models, based only on their inherent characteristics. On that basis, objection under section 3(1)(b) in the prima facie is upheld.

69. A further legal principle which I need to apply addresses the question whether the grounds of refusal apply to all the goods and services specified. In this respect, I am absolved from giving detailed reasons for the refusal of each and every item or service individually; the relevant case law allows me to group goods and services together which may be susceptible to the same, general, reasoning². In this case I concede that my starting position at the hearing was that the examiner's identification of goods in respect of which the application could be accepted was correct. Upon further reflection, at the stage of formal refusal and in this, my final assessment however, I am not convinced the objection can be waived for those italicized goods identified by the examiner and referred to in Para 2 above. As I say the signs are devoid of distinctive character in my assessment in relation to core goods and services, related to or encompassing training or psychometric testing, they will not then avoid being devoid for certain other, but related goods and services.³ By 'related' in this context, I mean that the italicized goods could well be sold, for example, as mementoes, and thus linked inextricably to the core goods and services.

The law on acquired distinctiveness

70. It is beyond dispute that the test of acquired distinctiveness is an onerous one to pass, involving the education of a significant proportion of the relevant persons⁴.

71. There are several fundamental legal principles in relation to acquired distinctiveness :

- mere evidence of use, even if substantial, does not make the case for acquired distinctiveness;
- if, to a real or hypothetical individual, a word or mark is ambiguous in the sense that it may be distinctive or descriptive then it cannot comply with the requirements of the Act for it will not provide the necessary distinction or guarantee. It is in that sense that common or descriptive meaning must be displaced⁵;
- it follows that, with regard to the acquisition of distinctive character through use, the identification by the relevant class of persons of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark. The expression 'use of the mark as a trade mark' in section 3 refers solely to use of the mark for the purposes of the identification, by the relevant class of person, of the

² See CJEU Case C-239/05 *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* [2007] ECR I-1455 at paras. 30 to 38.

³ See, e.g. the approach taken in BL O/185/12 *FEEDBACKMATTERS* at Para 36, a decision of the Appointed Person.

⁴ See *Windsurfing Chiemsee* (C108&109/97) [1999] E.T.M.R 585 ('*Windsurfing*')

⁵ Both the first two principles are stated in *Bach and Bach Flower Remedies Trade Marks* [2000] RPC 513, paras. 49 and 45 respectively

- product as originating from a given undertaking⁶;
- the mark must have acquired distinctiveness through use throughout the territory of the UK;
- in assessing whether a trade mark has acquired a distinctive character the competent authority must make an overall assessment of the relevant evidence, which in addition to the nature of the mark may include (i) the market share held by goods bearing the mark, (ii) how intensive, geographically widespread and long-standing the use of the mark has been, (iii) the amount invested by the proprietor in promoting the mark, (iv) the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor, (v) evidence from trade and professional associations and (vi) (where the competent authority has particular difficulty in assessing the distinctive character) an opinion poll. If the relevant class of persons, or at least a significant proportion of them, identifies goods or services as originating from a particular undertaking because of the trade mark, it has acquired a distinctive character;⁷
- the position must be assessed at the dates of application, being 28 March 2011.

72. In my opinion, these cases fall at the primary hurdles identified at the first three bullet points, namely that the applicant has used the signs as 'training tools', *but not as trade marks*. I concede that in legal principle a training tool may come to be regarded by both user and provider as a trade mark also, but I do not see it demonstrated in this case.

73. Specifically, as regards the third party pro-forma statements, at best these can be given little weight. It is far from clear what understanding, beyond the very superficial, the deponents have as regards the nature of a trade mark and, in particular, its essential function in a legal context. As well as not saying how they are qualified to give such evidence they provide no basis for their stated view that the signs are trade marks.

74. As for the other third party material, certain unique and advantageous features of the Insights profiling system (and by definition, the wheel also) are highlighted, such as its simplicity, the colours used and the interactivity, but it is not safe to conclude, or infer from this, that consumers actually regard the signs as being trade marks, as distinct from psychometric modelling tools. Being an advantageous profiling model, even to the point in the Marston's or Celgene evidence, where such a model finds itself embedded in corporate culture, does not mean it is distinctive as a trade mark, as distinct from, or in addition to, a useful training and development tool.

75. Significantly, the applicant's own evidence concedes, firstly, the genesis of the wheel is not entirely its own intellectual effort, attributing it, or at least placing it in the historical context of the work of Drs Jung and Jolande and prior to that, Hippocrates. The wheel therefore has clear historical antecedent with the work of Drs Jung and Jolande, although the applicant may have taken its own steps to, for example, adapt it to a modern training experience by use of colours and linking it to individual and team profiles.

⁶ See, e.g. *Societe des produits Nestlé SA v Mars UK Ltd*, (C-353/03 ('Nestlé')); *Philips Electronics NV v Remington Consumer Products Ltd* (C-299/99); *Henkel KGaA v Deutsches Patent – und Markenamt* (C-218/01) and also see Case BL O/166/08 *Vibe Technologies* to which I drew attention at the hearing (Para 60 onwards).

⁷ *Windsurfing*; Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-1318 at [23], *Philips v Remington* at [60]-[62], *Libertel v Benelux-Merkenbureau* at [67], *Nestlé v Mars* at [31] and C-25/05P *August Storck KG v Office for Harmonisation in the Internal Market (Storck II)* [2006] ECR I-5719 at [75].

76. Secondly, the applicant appears to concede it has used the signs only as 'training tools', (see the quote above from the legal submissions at para 60), but it submits it is not necessary to show use as a trade mark. This is because, it says, it is possible to acquire distinctiveness, after the normal process of familiarising the relevant public has taken place". This phrase is taken from the CJEU case C-24/05P *August Storck KG v Office for Harmonisation in the Internal Market (Storck I)* [2006] ECR I-5677 and has also been used in the CJEU Case C-104/01 *Libertel* [2003] ECR I-3793, para 67.

77. In legal terms, what the applicant appears to be saying here, is that the 'normal process of familiarising the relevant public' is fulfilled by, in this case, simple use of the wheel as a training tool. I should clarify that the words 'training tool' are not intended to infer that the wheel is only used in the context of actual training. I accept from the evidence that exposure of the wheel occurs in other contexts such as promotional material, the website, social media and post training materials. But significantly, in my opinion, not in a manner that would be seen as a trade mark. The *Bach Flowers* case tells me there is no room for ambivalence as far as consumer perception is concerned. The consumer must see the sign as a trade mark and nothing else, and this, in turn, is dependent, in my opinion, on its unambivalent use as a trade mark (see, *Societe des produits Nestlé SA v Mars UK Ltd*, Case C-353/03 at paras. 28-30). This would not necessarily mean that a clear and obvious indication must, in all cases, be provided to the consumer that a sign is regarded as a trade mark, but it does mean something more, in my opinion, than what the applicant has done in this case. I would just add that it is especially problematic to rely upon a 'normal process of familiarising the public', when the wheel's function and purpose is, self-evidently, as a training tool. This is not a situation where one is talking about an arbitrary shape or colour which, after sufficient exposure there may be said to be recognition or association (assuming that to be sufficient), by the relevant public. This is a situation where the signs in question are, in fact, being used in a primarily functional context and one which would be understood to be functional.

78. Thirdly, I should not lose sight of the fact that it cannot be assumed that the fact that people who have attended Insights training events may remember the wheel does not equate to its use, still less, reliance upon as a trade mark. The average consumer in this case is, in fact, the people directly or indirectly delivering training (para. 68 above), rather than the recipient or participant, unless that recipient or participant is in a position to make or recommend further purchases or offer train themselves as Accredited Practitioners. I can well understand that after an event many will remember their personal or team profile and the use of the wheel and even have a lasting memento of that, such as a wall chart or mat. But this does not mean they ever consciously, or unconsciously even, understood the wheel was regarded by the applicant as a trade mark and that they in turn would see, still less, rely upon it as such.

79. Fourthly, in the *Vibe* case, the Appointed Person was concerned with the theoretical question in relation to acquired distinctiveness: is association enough or is something more required? But in this case, I find myself asking in this case, is even *association* demonstrated? I remind myself that to show acquired distinctiveness a significant proportion of the relevant public must have been educated to use as a trade mark. The fact is, that of the 6 illustrative means of showing acquired distinctiveness set out in the *Windsurfing* case, only 3 have purportedly been addressed. I say 'purportedly' as the information regarding 'market share' provided by Vivien Buchan, summarised at para. 45 above, is obscure to say the least. I am simply not sure on what basis a market worth £46 billion, based on apparently official figures, is contracted to £1.96 billion. The evidence at this point loses any transparency, and thus also any persuasiveness; I simply do not know who the 'Customer Solutions Analysts' are, that estimate that size of the market 'available to the company' is approximately 10% of all training on external suppliers, and on what basis.

80. Taking the *Windsurfing* means again, the applicant has significantly not filed any

evidence which addresses: the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor; evidence from trade and professional associations; or an opinion poll. Instead, the applicant selects a few individuals, many with whom it apparently already has a commercial relationship, and asks me to infer that the signs are indeed widely regarded as indicating origin, rather than as training tools.

81. Fifthly, the nature of the applicant's business model has presented it with difficulties in demonstrating acquired distinctiveness; that is to say the differences between 'direct' and 'indirect' channel customers. This has meant, in my opinion, that use of the signs, in terms of 'control' by the applicant, is obscure to say the least. By 'control' I mean the existence of, for example, guidelines to be adhered to when using the sign which in turn may be taken to be indicative, at least of its own view, that the wheel is regarded as a trade mark. It can only be concluded that, partially at least, as a consequence of the applicant's own business model any potential potency of the signs to be regarded as trade marks may have been diluted. I would add however, that my primary difficulty with these applications is as stated above and not the applicant's preferred business model and in any event, exactly how the applicant may view its wheel, cannot be determinative of the perceptions of the average consumer.

83. Sixthly, there is more forensic criticism I can make of the evidence. Mr Buchan acknowledges that Exhibit 4 (being the mat) is not identical to the signs applied for. This raises the possible question about constancy of usage over the years. Based on the applicant's own prior trade mark and design registrations, I strongly suspect the signs applied for have been the subject of a number of iterations and refinement over the years. This being the case, it raises doubt in my mind that exposure of the actual signs applied for has not, in fact, been constant over the years. This rather more detailed criticism ought not, however, be allowed to obscure the fundamental concerns I have raised above.

Conclusion

84. In light of my grounds and reasoning above the application is refused in its entirety. I have considered all documents filed by the applicant/agent and all arguments submitted to me in relation to this application.

Dated this 17th day of October 2013

**Edward Smith
For the Registrar
The Comptroller-General**