

BEFORE:

MR S THORLEY QC

IN THE MATTER OF THE TRADE MARKS ACT 1994

AND

**IN THE MATTER OF APPLICATION NO 2131104
OF SAINSBURY'S BANK PLC TO REGISTER THE
MARK FRESH BANKING IN CLASSES 9, 16 & 36**

**APPEAL OF APPLICANT FROM THE DECISION OF THE
HEARING OFFICER (MR A J PIKE) DATED 2ND OCTOBER 1997**

**MR A HUME (of Messrs Fitzpatricks, Glasgow) appeared as Agent
on behalf of Appellant**

MR A JAMES appeared for the Comptroller-General of Patents etc

D E C I S I O N

(as approved by the Appointed Person)

This is an appeal to the Appointed Person from a decision of Mr Pike, the Officer acting for the Registrar dated 2 October 1997. In that decision he refused the application by Sainsbury's Bank Plc to register the trade mark FRESH BANKING as a trade mark in Classes 9, 16 and 36 in respect of various goods and services relating to a banking business. Mr Pike refused registration on the ground that the mark failed to qualify by virtue of Section 3(1)(b) and Section 3(1)(c) of the Act. Sainsbury's have appealed. They have been represented on this appeal by Mr Hume of Fitzpatrick's.

He indicated to me that he was taking four grounds in support of the appeal. First, he was contending that the mark was not devoid of distinctive character and therefore could be registered pursuant to Section 3(1)(b). Second, he said that it was not a sign which fell foul of Section 3(1)(b). Third, he drew my attention to the fact that his clients had entered a voluntary disclaimer and contended that assisted, if necessary, the eligibility for registration. Finally, he invited me, if necessary, to have regard to some informal evidence which was before the Registrar.

It is common ground that the objections under Section 3(1)(b) and 3(1)(c) stand or fall together. There are, therefore, three subjects that I must consider and I propose to consider first the question of the disclaimer. The disclaimer that has been proposed is in the following form.

“Registration of this device shall give no right to the exclusive use separately of the words FRESH and BANKING”.

In his decision, Mr Pike set out the Registrar's practice on disclaimers in full and I do not propose to repeat it in this decision. It is sufficient that I quote only the relevant conclusion, which is that:

“It follows that the offer of a disclaimer will not, in itself, influence the decision on the acceptability of a mark, and a disclaimer should only be accepted if volunteered by an application or an agent”.

I do not believe it is proper in this decision that I should give blanket appellant approval to the Registrar's practice. It is, however, plainly, I believe, appropriate guidance in this case. The trade mark applied for consists of two ordinary English words FRESH and BANKING and the disclaimer thus does no more than state the obvious that Sainsbury's could have no
5 monopoly by this registration in the use of the word FRESH or the word BANKING when taken separately. I, therefore, believe the Hearing Officer was correct in holding that the use of the disclaimer cannot assist this application.

Next I propose to deal with the question of informal evidence. I do not believe that it could
10 ever be proper for a trade mark to be accepted on the basis of informal evidence. I do not for a moment suggest that the registrar and his Hearing Officers should not have flexibility in the material that they take into account when accepting or rejecting trade marks. But it cannot be right that material before the Registrar is not therefore made the subject of a proper affidavit or statutory declaration because otherwise the task of any appellant tribunal is going to be
15 made difficult, if not impossible, since it will not know with certainty what was before the Hearing Officer, particularly in the present case, what the date of the document was and what its nature of distribution was. I, therefore, do not propose to take into account on this appeal any evidence of an informal nature.

That leads me to consider the fundamental question: does the trade mark FRESH BANKING
20 when used in relation to goods and services relating to a banking fall foul of Section 3(1)(b) or Section 3(1)(c)? Section 3(1)(b) and (c) are both subject to the proviso to Section 3 which permits registration if the trade mark has in fact acquired a distinctive character as a result of the use made of it. This is not, however, a case where evidence of use was before the Hearing
25 Officer or is before this Appeal Tribunal. The Hearing Officer had to consider, and I have to consider, the prima facie case. The way in which Mr Hume put his case before me is, I think, encapsulated in Paragraph 5 of his grounds of appeal with (as amended) reads as follows:

30 "The combination of the word "FRESH" with the word "BANKING" creates an unusual and novel combination "FRESH BANKING". It is submitted that this is not a term which other traders, without improper notice, should need to use. The term

“FRESH” is not one which one would normally associate with banking products or services. The terms “FRESH” conjures up the image of “recently made” or “newly grown”, as in the terms fresh coffee or fresh vegetables.”

5 It is submitted that the ordinary man in the street will immediately recognise the fanciful connotation of the mark.

In quoting from Paragraph 5 I have omitted a sentence which drew attention to the nature of an associate of the applicant J Sainsbury’s Plc, the well-known supermarket. Both Mr James
10 and Mr Hume were content that I should proceed on the basis that the nature of the applicant was irrelevant when considering a prima facie case. I am sure that this is correct.

Mr Pike expressed his decision on the important question as follows: He said:

15 “If the word FRESH is used in conjunction with the word BANKING, as in this trade mark, I am in no doubt that the majority of people would take it to mean novel or original banking goods or services. With that definition in mind I consider the mark consists of words that others may wish to use to describe their goods or services. Others should be free to use words such as “FRESH BANKING IDEAS” or “A
20 FRESH BANKING APPROACH”. It is also important that I consider whether the words FRESH and BANKING in combination produce a fanciful whole. I conclude that they do not. The words in combination do no more than describe the goods or services as being FRESH, ie novel or original goods or services provided by a bank.”

Before Mr James sought to amplify those thoughts by suggesting FRESH BANKING IDEAS,
25 FRESH BANKING STYLE, FRESH BANKING CONCEPT and also reminded me that it is proper to consider not only use on the goods or services themselves, but also in advertising.

Mr Hume said that the mark FRESH BANKING hits you as a trade mark at first sight. He said “it looks like a trade mark”. It did not so hit me when I first read these papers and
30 nothing that has been said in the course of this hearing has caused me to change my mind.

Mr James said FRESH was an apt word to use to describe a new or novel service. I agree. I think lying behind Mr Hume's submission was a feeling that perhaps banking was regarded by the public as being old-fashioned, not new or novel. That may be, but that does not mean that somebody setting up a new banking system or an old bank setting up a new way of banking
5 should not be entitled to draw attention to that novelty by use of the natural word FRESH.

For all these reasons, I agree with the conclusion of Mr Pike and this appeal will be dismissed. I presume in accordance with the usual practice there will be no order as to costs.