

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. 2186298**

**TO REGISTER A
TRADE MARK IN CLASSES 9, 16, 35, 36, 41 & 42**

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IN THE MATTER OF APPLICATION NO. 2186298 BY ERNST & YOUNG (UK PARTNERSHIP) TO REGISTER A TRADE MARK IN CLASSES 9, 16, 35, 36, 41 & 42

DECISION AND GROUNDS OF DECISION

1. On 13th January 1999, Ernst & Young, a UK Partnership of Becket House, 1 Lambeth Palace Road, London SE1 7EU applied to register the trade mark CLIENT SERVICE FRAMEWORK in classes 9, 16, 35, 36, 41 and 42.

2. Objection was taken under Section 3(1)(b) and (c) of the Act because the mark consists exclusively of the words CLIENT SERVICE FRAMEWORK being a sign which may serve in trade to designate the kind of goods and services.

3. Objection was also taken under Section 3(6) of the Act because the specifications in Classes 9 and 41 are so wide that there is doubt about the accuracy of the statement on the application form that the applicant is using, or intends to use, the mark on all the services applied for.

4. A hearing was held on 7th December 1999 at which the applicants were represented by Mr Ian Bartlett of Beck Greener, Patent and Trade Mark Attorneys. Regarding the objection raised under Section 3(6) of the Act, it was agreed that if this application proceeds, its specifications should be restricted to those listed on registration no. 2009160 and therefore I make no further reference to this objection. The statements of goods and services for registration no. 2009160 are as follows:

Class 9:

Computer software, firmware and hardware; data-processing apparatus; apparatus and media for the recording, storage, carriage and retrieval of data and information; audio, video and cinematographic apparatus and recordings; teaching apparatus and instruments; non-printed publications; parts and fittings for the aforesaid goods; all relating to accountancy, taxation, auditing, finance and to business and management consulting and business and office administration.

Class 16:

Printed matter and publications; books, manuals, newspapers, newsletters, magazines, pamphlets, periodicals; posters and photographs; teaching and instructional materials; stationery; all relating to accountancy, taxation, auditing, finance and to business and management consulting and business and office administration.

Class 35:

Advertising and promotion; personnel services; all in the field of accountancy, taxation, auditing, finance and business and management consulting and business and office administration; business and management assistance advice, consultancy, information and research; accounting, bookkeeping and auditing; business systems advice.

Class 36:

Financial management, assistance, advice, consultancy, information and research; tax and duty services; insolvency services.

Class 41:

Education, teaching and training; organising and providing facilities for seminars, conferences and exhibitions; organising of competitions; publishing; all the aforesaid services relating to accountancy, taxation, auditing, finance and business and management consulting and business and office administration.

Class 42:

Consultancy, advice, assistance, analysis, design, evaluation and programming services relating to computer software, firmware and hardware; consultancy and advice relating to the evaluation, choosing and implementation of computer software, firmware, hardware and of dataprocessing systems; rental of computer software, firmware and hardware; legal services; all relating to accountancy, taxation, auditing, finance and to business and management consulting and to business and office administration.

5. In relation to the objection under Section 3(1)(b) and (c) of the Act, this was maintained and the application was subsequently refused on 17th October 2001 in accordance with Section 37(4) of the Act.

6. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

7. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

8. At the hearing held on 7th December 1999, Mr Bartlett contended that the mark meant nothing in relation to the services claimed and noted that the objection was not specific. It was not a term of art used in the industry and would not cause embarrassment to other traders. Mr Bartlett said that case law and opinions such as that in PHILIPS v REMINGTON (ECJ Case C-299/99) and WINDSURFING CHIEMSEE ([1999] ETMR 585) has swept away the old law. For instance, the comments made in AD2000 [1997] RPC 168 were no longer appropriate.

9. I said my initial impression of the mark was that it described a plan or strategy that was supplied to customers in order that they might provide services to their clients. I doubted that the mark would be perceived by the public as a badge of trade origin. However, in order to give the applicant the opportunity to show how the mark was being used (or proposed to be used), I formally requested information concerning use of the mark and suspended the application for a period of three months. This request was made under Rule 51 (as it was) which is now Rule 57 of the Trade Marks Rules 2000. Rule 57 reads as follows:

At any stage of any proceedings before the registrar, she may direct that such documents, information or evidence as she may reasonably require shall be filed within such period as she may specify.

10. Despite over 18 months elapsing from the date of the substantive hearing to the issue of the notice of refusal, no information was filed. Whilst I acknowledge that during this period there were organisational changes taking place in the applicants' business which inevitably led to delays, it is difficult to understand why it was not possible within this timescale to obtain any documentation showing the mark in use, or at least how it was proposed to be used.

11. The relevant part of the Act under which the objection was maintained is as follows:

Section 3(1):

The following shall not be registered-

- (b) trade marks which are devoid of any distinctive character,*
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services.*

12. The mark consists of the ordinary words "client", "service" and "framework", which, individually, are so well known that I believe I do not need to set out full separate dictionary references for each word. However, it is noteworthy that a particular meaning of the word "framework" is given in Collins English Dictionary (Millennium Edition) as:

1. a structural plan or basis of a project

13. The three individual words making up the mark are without any distinctive character but I am, of course, bound to consider the mark as a whole. Whilst it is clear that a combination of non-distinctive elements can create a combination which is distinctive in totality, I do not accept that this is the position with this sign. Despite the assertion by Mr Bartlett that CLIENT SERVICE FRAMEWORK is not meaningful and not a term of art, I take the view that the phrase as a totality, clearly conveys the idea of a structural plan within which client service is provided.

14. On 20 September 2001, the European Court of Justice issued a judgement in *Procter & Gamble Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case-383/99P for the mark *Baby-Dry*. This judgement gives useful guidance on the test for descriptiveness under Section 3(1)(c) of the Act.

15. I give below paragraphs 37, 39 and 40 of the judgement in full:

"37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Procter & Gamble and the OHIM acknowledge, to prevent registration as trade marks signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function."

"39. The signs and indications referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics."

"40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services of their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark."

16. These paragraphs indicate that only marks which are no different from the usual way of designating the relevant goods or services or their characteristics are now debarred from registration by Section 3(1)(c). I have already taken the view that the mark at issue comprises a phrase made up from three non-distinctive words, and they are not configured in a manner which cannot distinguish the resultant whole from the usual way. Without any evidence to persuade me to the contrary, I believe that the mark "may serve in normal usage from a consumer's point of view to designate" one of the essential characteristics of the goods and services.

17. In reaching this conclusion I accept that the registrar has not presented any evidence that the

term CLIENT SERVICE FRAMEWORK is already in normal usage. I do not believe that this is necessary. It is implicit from the words "may serve" that an element of futurity is to be considered. The dictionary meanings of the words concerned are sufficient to confirm that the mark consists exclusively of a natural way of designating a characteristic of the goods or services. In relation to the goods and services specified in the application this could mean, for example, computer software, reports, business or financial advice, training and legal services, all of which could relate to a client service framework.

18. Having found that the mark is debarred from registration under Section 3(1)(c) of the Act, I now have to consider whether the mark is devoid of any distinctive character under Section 3(1)(b).

19. In the "Cycling IS..." decision (series of two marks), dated 28th November 2001 and as yet unreported, Geoffrey Hobbs QC as Appointed Person made the following comments:

"66. That brings me to the question of whether the signs possess a distinctive character enabling them to fulfil the essential function of a trade mark in relation to goods and services of the kind specified in the application for registration. (The goods and services comprise "clothing, footwear and headgear" in Class 25 and "advertising, all relating to the cycling industry" in Class 35).

67. The case for allowing registration rests upon the proposition that the signs are cryptic to a degree which makes it more likely than not that they would carry connotations of trade origin (whatever other connotations they might also carry) in the minds of the relevant class of persons or at least a significant proportion thereof.

68. The case for refusing registration rests upon the proposition that the signs are visually and linguistically meaningful in a way which is more likely than not to relate the goods and services to the activity of cycling without also serving to identify trade origin in the minds of the relevant class of persons.

69. The difference between these two positions resides in the question whether the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin specific or origin neutral.

70. The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect.

71. I do not suppose that such a person would pause to construe the signs when encountering them in any of the different settings (including advertising and promotional settings) in which they might be used. Even so, the degree of attention required to take note of the signs in the first place would be sufficient, in my view, to leave a well-informed and reasonably observant and circumspect person with the clear impression that the signs were being used with reference to goods and services related to cycling."

20. Mr Hobbs went on to observe:

“73. Doing the best I can on the materials before me, I think that the signs in question would be perceived by the relevant class of persons as pronouncements in identifying cycling as the raison d’être for the marketing of the goods and services to which they are related. That is a message that the members of a consortium of bicycle retailers might naturally be interested in putting across to customers and potential customers. I do not think that the nature of the pronouncement or its presentation can in either case be regarded as sufficiently striking to function as an indication of trade origin in relation to goods or services of the kind specified in the application for registration that is now before me.

74. It seems to me that the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin neutral (relating to the general commercial context of the relevant trading activities) rather than origin specific.”

21. In relation to the mark CLIENT SERVICE FRAMEWORK, I take the view that it would likely be perceived by the average consumer as being origin neutral rather than origin specific. Moreover, when viewed in the context of the all the goods or services contained in the application, some of which may not be subject to objection under Section 3(1)(c) of the Act, the mark would be perceived merely as a pronouncement relating to a “client service framework”. The mark cannot function in the prima facie as an indication of trade origin and therefore under Section 3(1)(b) of the Act I conclude that it is devoid of any distinctive character

22. In this decision I have considered all documents filed by the agent, and for the reasons given the application is refused under the terms of Section 37(4) of the Act because the mark fails to qualify under Sections 3(1)(b) and (c) of the Act.

Dated this 15th day of February 2002.

Charles Hamilton
For the Registrar
the Comptroller General