

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2226371
IN THE NAME OF HOME SERVICE (GB) LIMITED
TO REGISTER A TRADE MARK IN CLASSES 36 AND 37 OF THE REGISTER**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 51442
BY CO-OPERATIVE INSURANCE SOCIETY LIMITED**

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in the name of Home Service (GB) Limited
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**IN THE MATTER OF Opposition thereto under No. 51442
By Co-operative Insurance Society Limited**

BACKGROUND

1. On 20 March 2000 Home Service (GB) Limited applied to register the following series of two trade marks in Classes 36 and 37 of the Register:



The applicant claims the colours blue, red and green as an element of the first mark in the series.

2. Registration was sought for the following specification of services:

Class: 36

Insurance services; insurance for maintenance and repair services.

Class: 37

Installation, maintenance and repair services relating to utilities and household appliances and installations; plumbing services, electrical services.

3. The application was accepted by the Registrar and published in the Trade Marks Journal.

4. On 21 September 2000 Wilson Gunn M'Caw filed Notice of Opposition on behalf of Home Service (GB) Limited.

In summary, the grounds of opposition were as follows:

(i) Under Section 3(1)(c) of the Act because the marks consist predominantly of the words HOME SERVICE which describe the provision of services to domestic residences and the marks therefore consist exclusively of signs or indications which may serve, in trade, to designate the kind, intended purpose or other characteristic of the services applied for.

(ii) Under Section 3(1)(d) of the Act because the marks consist exclusively of signs or indications which are customary in the current language or in the bona fide practices of trade in relation to the rendering of the services to domestic residences.

5. The applicant through its agent, Lawrence Shaw & Associates, filed a Counterstatement denying the above grounds. Both sides filed evidence and asked for an award of costs in their favour. Neither party requested a hearing but both forwarded written submissions for the Hearing Officer to assist in the making of the decision.

Opponent's Evidence

6. This consists of two witness statements, one each from Chris Newton and Leonard Roy James Cazalet dated 20 December 2001 and 21 December 2001 respectively.

7. Mr Newton is the Marketing Manger (Products and Channels) of Co-operative Insurance Society Limited (the opponent) which he states is a large organisation offering all kinds of financial services products to private individuals and companies. He adds that the opponent sells insurance and assurance policies through various channels, via the Internet, the telephone, via their office network but primarily through around 3,500 financial advisors calling at customer's houses. Mr Newton states that this last type of insurance selling is known as 'home service'.

8. Mr Newton explains that the term 'home service' is used extensively by his company to describe insurance which is provided to people in their homes and he goes on to say that the term is used by the industry as a whole. Mr Newton refers to Exhibits CN1 to CN6 to his statement which, he states, show descriptive use of the term 'home service'. The documents forming the Exhibits are as follows:

(i) Exhibit CN1 – an extract from "life 2000" report produced by Cazalet Financial Consulting;

(ii) Exhibit CN2 – an article from the Daily Mirror published on 21 March 2001;

(iii) Exhibit CN3 – an article from The Times published on 8 March 2001;

(iv) Exhibit CN4 – an article from the Post Magazine and Insurance Week published on 15 March 2001;

(v) Exhibit CN5 – the Social Accountability Report produced by the opponent in 1999;

(vi) Exhibit CN6 – the Social Accountability Report produced by the opponent in 2000.

9. Mr Cazalet is the principal of Cazalet Financial Consulting and is a market analyst specialising in the field of financial services. He explains that his company specialises in providing analysis of and commentary on critical business areas within the financial services market, such as product range, new business activity, distribution, expense base and investment management.

10. Mr Cazalet states that it is his belief that the term “home service” is a term which is in common usage in the financial services industry and particularly in the insurance sector. He explains that the term is used as a descriptor to denote the type of insurer, office customer or such like and Mr Cazalet recognises the term ‘home service’, when applied to the insurance business, as meaning insurance which is sold to people at their homes.

11. Mr Cazalet states that within the financial services and insurance industry the term “home service” is used by many different companies. He refers to Exhibit LC1 to his declaration which is a copy of a report produced by his company in 1998 for Co-operative Insurance Society, part of which focuses on the ‘home service’ sector. Mr Cazalet goes on to draw attention to Exhibit LC2 which comprises a copy of the ‘home service’ Chapter of the 2000 annual report entitled “Life”, which is an annual review of the UK life insurance sector produced by his company.

Applicant’s Evidence

12. This consists of a witness statement by James Cashmore dated 25 April 2002. Mr Cashmore is the Marketing Director of Home Service (GB) Limited (the applicant).

13. Mr Cashmore states that the marks applied for do not consist exclusively of the term HOME SERVICE as they also contain a distinctive ‘S element’, together with a ‘stylised house device’. He submits that on this basis alone, the opposition fails. Mr Cashmore adds that the distinctive ‘S device’ is registered alone (registration number 2209224) and in combination. Exhibit JC01 to his declaration details these trade mark registrations.

14. Turning to the evidence filed by the opponent, Mr Cashmore makes the following points:

“a) I am informed by our trade mark advisers that the relevant date in these proceedings is the date of filing of UK trade mark application No. 2226371 which is March 20, 2000. Much of the evidence filed in support of the Opponent’s claims is dated later than March 20, 2000 and is therefore inadmissible. I refer in particular to the following:

(i) Exhibit CN2 is dated March 21, 2001

(ii) Exhibit CN3 is dated March 8, 2001

(iii) Exhibit CN4 is dated March 15, 2001

I request that these Exhibits be deemed inadmissible.

- b) Chris Newton, in his Witness Statement dated December 20, 2001 contends that the term “home service” is used extensively in the financial services industry to describe products and services within a certain sector of the market. However, what the bulk of the evidence demonstrates is that the Opponent refers to its own activity of providing financial services to customers by calling at their houses as a home service. Furthermore, Mr Newton joined the company only two months before the relevant date and gives no indication of how he arrives at his conclusions. Mr Newton’s evidence refers only to his company’s activities, which are performed exclusively via the “home service” medium (Exhibit CN1).
- c) The evidence points to the fact that the Opponent uses the term “home service” to refer to its door step collection of life insurance policies. There is no evidence that the term is used generally within the insurance industry. Mr Cazelet’s evidence consists of a Report dated 1998, although there is no corroborative evidence for this date which was produced for the Opponent and seems to refer to the Opponent’s use of the phrase “home service”. It cannot therefore be seen as independent evidence. The report in Exhibit LC21, dated 2000, refers to home service offices and features the Co-operative Insurance Society Limited, about whom it is stated that its sole distribution channel is its home service sales force. Again, I submit that the references to “home service” in the report refer essentially to the Opponent’s internal description of its “boots on the beat” activities. Although it is claimed that this report has a wide circulation within the UK life assurance industry, investment banking, fund management and leading actuarial consultancies, there is no corroborative evidence to this effect.
- d) The evidence shows that since 1999 there have been isolated incidences of use of the term “home service” in relation to a means of collecting premiums by the Opponent. It does not show that the term is in widespread use by the industry.”

15. Mr Cashmore adds that the opponent has not produced any evidence to show that they have used the term ‘home service’ in relation to any of the Class 37 services.

16. Mr Cashmore states that HOME SERVICE has been used as a trade mark by his company in relation to the services claimed by the application in suit since at least 1994. He explains that HOME SERVICE is used in relation to an insurance scheme which covers policyholders in respect of a range of maintenance and repair services relating to utilities and household appliances. Exhibit JC02 to Mr Cashmore’s statement contains example material to show use of HOME SERVICE, namely copy pages from South Staffordshire Group Plc Annual Reports from 1996/97 to 2001, sample policy documents and sample marketing material. Mr Cashmore concludes by stating that as at March 2000, his company had 1.2 million policyholders holding HOME SERVICE documentation.

Opponent's Evidence in Reply

17. This consists of a witness statement by Karen Williams dated 26 July 2002.

18. Ms Williams is a solicitor at Co-operative Insurance Society Limited. Ms Williams agrees that the marks in suit contain matter in addition to the words HOME SERVICE, she submits that the additional matter is not distinctive enough to confer overall distinctiveness on to the marks in their entirety. Ms Williams adds that the applicants have not responded to correspondence from the opponent regarding the disclaimer of the words HOME SERVICE.

19. Turning to the statements by Mr Cashmore which are set out in paragraph 14 of this decision, Ms Williams states that the articles exhibited as exhibits CN2, CN3 and CN4 to Mr Newton's statement on behalf of the opponent all refer to 'home service' sales as well as established activity and are therefore relevant. She adds that the evidence demonstrates that her company and other companies use the term 'home service'.

20. Ms Williams explains that the opponent does not claim to use the term 'home service' in relation to any of the Class 37 services applied for. However, she submits that 'home service' is nevertheless descriptive in relation to such services.

21. In relation to the applicant's evidence of use of 'home service', Ms Williams submits that such use has been with the 'house device', or by a variety of different water companies, or after the relevant date. Finally, she states that as the opposition is based on absolute grounds under Section 3(1)(c) and Section 3(1)(d) and as the applicant has not sought to rely on the proviso to Section 3(1), the information relating to the applicant's use is irrelevant and should be disregarded.

Applicant's additional evidence (Rule 13 (11))

22. This consists of a witness statement by Ann Elizabeth Roome dated 5 September 2002. Ms Roome is a trade mark agent with Lawrence Shaw Associates Limited, the applicant's professional advisors in these proceedings. Ms Roome denies that the applicant did not respond to correspondence regarding the disclaimer of the term 'home service'. The applicant's reply stated that it did not wish to enter into any disclaimer.

23. This completes my summary of the evidence filed in this case.

24. Both parties have forwarded written submissions to assist the making of the decision and I give these submissions full consideration in reaching my conclusions. In essence, both sets of submissions largely relate to the issue of whether the mark in suit contains sufficient additional matter to the words HOME SERVICE to justify acceptance of the mark in its totality under Section 3(1)(c) and 3(1)(d) of the Act. The applicant's submissions make it clear that there is no attempt to rely upon the proviso of Section 3(1). I now turn to the decision.

DECISION

25. The relevant parts of Section 3(1) of the Act read as follows:

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

- (a)
- (b)
- (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,
- (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.”

26. In the present case I must consider whether, on a prima facie basis, the mark in suit meets the requirements of Section 3(1) (c) and (d) of the Act. The proprietor has not submitted that the mark has acquired a distinctive character as a result of the use made of it.

27. It is common ground that the marks in suit must be considered in their totality but, in essence, the opponent takes the view that the dominant element of the marks consist of the descriptive words HOME SERVICE and the remaining elements are insufficient to enable the marks as a whole to function as trade marks and indicate the origin of the services at issue. The applicant submits that the relevant issue is whether the marks in their totality meet the requirements of the Act.

28. In order to determine whether or not the marks in suit in their totality meet Section 3(1)(c) and 3(1)(d) requirements, it seems to me that a full and proper approach involves a consideration of the individual elements comprised in the marks including the dominant components, the descriptive elements and the distinctive elements and then, taking into account the services and the particular customer for the relevant services, undertaking a global appreciation as to whether in totality the marks meet the requirements laid down in the Act.

29. Turning firstly to Section 3(1)(c), I find the recent judgement of the European Court of Justice (ECJ) in case C-383/99P (Procter and Gamble v OHIM) – the “BABY-DRY” case to be of particular assistance and I give below paragraphs 37 and 39 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 indication which, because they are not 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 indication 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 or designating the goods or services concerned or their essential characteristics."

30. 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 virtue of Section 3(1)(c).

31. In my deliberations of the Section 3(1)(c) ground I firstly consider the words HOME SERVICE which I believe the opponent to be correct in submitting is the dominant element within the marks applied for.

32. The opponent has submitted evidence in relation to the Class 36 specification with the objective of demonstrating that the words HOME SERVICE are widely used in the insurance industry to describe the selling of insurance to customers in their homes. The applicant has been critical of much of this evidence, stating that much of it illustrates use by the opponent or falls after the relevant date for these proceedings. Nevertheless, there are items to which weight may be given e.g. the statement of Mr Cazalet, an experienced expert in the field (see paragraphs 9 to 11 of this decision).

33. While the opponent's evidence is of limited assistance, it seems to me that the words HOME SERVICE are directly descriptive of any service which could or would be provided in the customers home. The words have an obvious meaning in relation to services where the potential customer is the general public and where the product or service can be discussed and purchased in the comfort and convenience of the customers residence or where goods and appliances are maintained or repaired in the customers home as opposed to e.g. the repair centre or workshop owned by the seller or manufacturer.

34. In relation to the Class 36 services specified by the applicant, my own knowledge and experience tells me that many 'insurers' representatives are keen to discuss insurance requirements at individual's home. Turning to the services contained in the applicant's Class 37 specification, I am aware that it is common in trade for businesses to offer a service whereby they will service, repair or install goods, in particular electrical goods and household appliances, in the customer's home. On this basis, I have no hesitation in concluding that the words HOME SERVICE are, in themselves, descriptive where these words serve in trade to designate services provided in the customer's home and such services are encompassed within the services specified by the application in suit.

35. My above finding on the words HOME SERVICE is, of course, by no means the end of the matter, in that the marks in suit also contain a device (comprising two “crescent shapes”) to the left, or before, the words HOME SERVICE, and an “inverted letter V device” above the letter H in HOME SERVICE, with the letter H underlined.

36. Taking the marks in suit as a whole, it seems to me that the additional elements to the words suffice to provide the marks with distinctive character. Having regard to the positioning and prominence of the “crescent shape device elements” and the “inverted V device”, it appears to me that the marks applied for, in their totality, are presented in a manner which distinguishes the resultant whole from the usual way of designating the services concerned or their essential characteristics. The opposition under Section 3(1)(c) fails.

37. Turning to the Section 3(1)(d) ground, the opposition must fail in light of my earlier findings in relation to the presence in the marks of the “crescent shaped device element” and the “inverted letter V device” and their impact upon the perception of the marks in their totality. The marks as a whole contain sufficient surplus or capricious addition to the words HOME SERVICE to justify registration.

COSTS

38. As the opposition to the application has failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £950. This sum 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 20th day of November 2002

**JOHN MacGILLIVRAY
For the Registrar
The Comptroller-General**