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UK INTELLECTUAL PROPERTY OFFICE

Harmsworth House  
13-15 Bouverie Street  
London, EC4Y 8DP

Tuesday, 18th September 2007

B e f o r e :

MR. RICHARD ARNOLD QC  
(Sitting as the Appointed Person)

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In the Matter of the TRADE MARKS ACT 1994

and

In the Matter of Trade Mark Application No. 2 418 442 for  
FRICTION MANAGEMENT SOLUTIONS inter alia in Class 37 by  
The Timken Company.

and

An appeal to the Appointed Person from the decision of  
MR. A. J. PIKE acting on behalf of the Registrar,  
dated 17th July 2007.

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(Computer-aided Transcript of the Stenograph Notes of  
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MR. JAMES ST. VILLE (instructed by Messrs. Jones Day) appeared on  
behalf for the Appellant Applicant.

MR. MORGAN appeared as the Registrar's representative.

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A P P R O V E D D E C I S I O N

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1 THE APPOINTED PERSON:

2 Introduction

3 1. On 3rd April 2006 The Timken Company applied to register  
4 the trade mark FRICTION MANAGEMENT SOLUTION. Subsequently the  
5 application was amended to clarify that the mark applied for  
6 was FRICTION MANAGEMENT SOLUTIONS. Priority was claimed from  
7 an application made in the United States of America on  
8 12th October 2005. The mark was sought to be registered in  
9 respect of the following specification of services in  
10 Class 37: "Design, selection and provision of services and  
11 products to lengthen the life of industrial equipment, namely  
12 machines and vehicles which use bearings and accessories  
13 therefore, and lubricants, and repair of the same."

14 2. In an examination report dated 9th May 2006 the examiner  
15 objected to the application on two grounds. The first ground  
16 was that the application was not acceptable as there was an  
17 objection under section 3(1)(b) and (c) of the Trade Marks Act  
18 1994. This objection was stated in the following terms: "This  
19 is because the mark consists exclusively of the words FRICTION  
20 MANAGEMENT SOLUTIONS, being a sign which may serve in trade to  
21 designate the intended purpose of the goods and services, e.g.  
22 to provide solutions to manage (or control) friction in  
23 industrial equipment." The second ground of objection was  
24 that the specification was unclear contrary to Rule 8 of the  
25 Trade Mark Rules 2000 and embraced services which were proper

1 to other classes and in particular Class 42.  
2 3. The applicant did not file any evidence in support of  
3 the application, but filed submissions arguing for registration  
4 on the basis of the inherent qualities of the mark. So far as  
5 the second objection taken by the examiner was concerned, the  
6 applicant requested that the specification be amended so as to  
7 seek registration in Class 37 in respect of "Repairing  
8 bearings used to lengthen the life of industrial equipment,  
9 namely machines and vehicles", in Class 40 in respect of  
10 "Custom manufacture of bearings to the order and specification  
11 of others to lengthen the life of industrial equipment, namely  
12 machines and vehicles", in Class 41 in respect of "Education  
13 services, namely conducting training in the use of bearings to  
14 lengthen the life of industrial equipment, namely machines and  
15 vehicles" and in Class 42 in respect of "Custom design for  
16 others of bearings to lengthen the life of industrial  
17 equipment, namely machines and vehicles".

18 4. Following a hearing the objection under section 3(1)(b)  
19 and (c) was maintained for reasons set out in a written decision  
20 of Mr. A. J. Pike acting for the Registrar dated 17th July 2007  
21 (O/207/07). The applicant now appeals against this decision.

22 The relevant provisions of the Trade Marks Act 1994

23 5. Sections 3(1)(b) and (c) of the 1994 Act provide as  
24 follows: "3(1) The following shall not be registered - (b) trade  
25 marks which are devoid of any distinctive character, (c) trade

1 marks which consist exclusively of signs or indications which  
2 may serve, in trade, to designate the kind, quality, quantity,  
3 intended purpose, value, geographical origin, the time of  
4 production of goods or of rendering of services or other  
5 characteristics of goods or services."

6 The hearing officer's decision

7 6. In his decision the hearing officer, having set out the  
8 background, the relevant provisions and the case for  
9 registration, directed himself so far as section 3(1)(c) is  
10 concerned in accordance with the decisions of the European  
11 Court of Justice in Case C-191/01 **OHIM v Wm. Wrigley Jr. Company**  
12 **(DOUBLEMINT)** [2003] ECR I-12447 at [28]-[32] and Case C-363/99  
13 **Koninklijke KPN Nederland BV v Benelux Merkenbureau**  
14 **(POSTKANTOOR)** [2004] ECR I-1619 at [96]-[100].

15 7. The hearing officer's assessment of the mark was as  
16 follows:

17 "17. This is an application to register the trade mark  
18 FRICTION MANAGEMENT SOLUTIONS. Each of these words are well  
19 known dictionary words and there is no need for me to refer  
20 specifically to their individual dictionary meanings. I must,  
21 in any case, consider the mark in its entirety, bearing in  
22 mind the meaning of these individual elements in relation to  
23 the services applied for. In relation to such services I have  
24 concluded that the mark will be perceived in one way - a  
25 commercial activity that addresses friction related problems.

1 In his letter of 8 August 2006 Mr. Reddington conceded that  
2 '...the words 'friction management' may perhaps be considered  
3 purely descriptive and therefore non-distinctive in relation  
4 to the specific services...'. I would go further and say that  
5 it is not a case that they 'may perhaps' be so evaluated, they  
6 are directly descriptive.

7 18. Under cover of a letter dated 19 April 2006 Jones Day  
8 files a certified copy of the corresponding United States  
9 application in support of the priority claim. This bundle  
10 includes a brochure which provides details of the services  
11 provided by the applicant. I note the following statements  
12 made within that brochure which I have flagged for ease of  
13 reference:

14 'Friction isn't good for moving parts. And it's not  
15 good for business processes either. With Timken  
16 friction management solutions, you'll find less of  
17 both'.

18 'Complementing our core products is an ever-growing line  
19 of friction management solutions including lubricants,  
20 single-point lubricants, maintenance tools and safety  
21 equipment, condition monitoring systems and surface  
22 finishes that keep systems running smoothly'.

23 'By bringing together two world leaders in friction  
24 management technology, Timken is able to provide you  
25 with an expanding line of bearings or related

1 products...'.  
2

3 'From breadth of product to product quality, our  
4 friction management solutions satisfy a wide range of  
5 needs, giving you the ability to add lasting value for  
6 your customers'.  
7

8 'Here's a quick view of our friction management  
9 solutions'.  
10

11 19. Although this is use of this combination of orders by the  
12 applicant it does demonstrate how this combination may be, and  
13 in fact is, used as a direct description of the services in  
14 question.  
15

16 20. Turning to the services applied for, I have already notes  
17 that some of the terms are either not proper to Class 37 or  
18 are considered too vague for classification purposes;  
19 nevertheless the core services for which registration is  
20 sought are quite clear. The applicant appears to provide  
21 solutions for friction management which are individually  
22 tailored to meet individual needs. In a letter dated 8 August  
23 2006 the applicant sought to address these specification  
24 queries by adding classes 40,41 and 42 and by transferring the  
25 specific services from Class 37 to these classes. However,  
this proposal was dependent on the objections under Section  
3(1)(b) and (c) of the Act being waived. Accordingly no  
action has been taken in respect of these proposals.

21. It is also clear that such services will be directed

1 engineers and manufacturers of machines and vehicles which use  
2 bearings and lubricants. Furthermore I accept that such  
3 consumers are likely to be knowledgeable and perhaps even  
4 experts in this particular field and that such services would  
5 be considered carefully before any commercial decisions were  
6 made or contacts signed. The fact that the consumers are  
7 deemed to be knowledgeable or even perhaps expert in this  
8 particular field does not by itself render the objection under  
9 Section 3(1)(c) of the Act invalid. The applicant provides  
10 tailored solution to friction management problems. The  
11 applicant itself describes these services as friction  
12 management solutions and it appears to me that this is a  
13 perfectly apt term for other traders to use to describe the  
14 same services.

15 22. The specification of services is quite wide ranging but in  
16 my view the objection is equally valid in respect of all  
17 services applied for as the trade mark applied for is equally  
18 descriptive for each of them....

19 25. I am aware that the trade mark applied for is a  
20 combination of the three dictionary words FRICTION, MANAGEMENT  
21 and SOLUTIONS. In the context of the services applied for the  
22 meaning of each word will be clearly understood by the  
23 relevant consumer and their combination FRICTION MANAGEMENT  
24 SOLUTIONS will be perceived as a combination of words  
25 indicating that the services relate to the provision of

1 solutions for friction management problems.

2 26. Consequently, I have concluded that the mark applied for  
3 consists exclusively of signs which may serve, in trade, to  
4 designate the kind of services and is, therefore, excluded  
5 from registration by Section 3(1)(c) of the Act."

6 8. So far as section 3(1)(b) is concerned, the hearing  
7 officer directed himself in accordance with the decisions of  
8 the ECJ in Joined Cases C-53/01 to C-55/01 **Linde AG, Windward**  
9 **Industries Inc. and Rado Uhren AG** [2003] ECR I-3161 at [37],  
10 [39]-[41],[47] and Case C-329/02 **SAT.1 Satellitenfernsehen GmbH**  
11 **v OHIM** [2004] ECR I-8317 at [41]. His analysis was as follows:  
12 "30. For the same reasons that I found this trade mark is to  
13 be excluded by the provisions of Section 3(1)(c) of the Act  
14 I have concluded that the relevant consumer of the services in  
15 question would not consider this mark to denote trade origin.  
16 The average consumer of these services will, upon encountering  
17 the words FRICTION MANAGEMENT SOLUTIONS, perceive them as no  
18 more than an indication that they relate to the provision of  
19 solutions to friction management problems. That is why it  
20 will not be seen as a badge of origin. I am not persuaded  
21 that the trade mark applied for is sufficient, in terms of  
22 bestowing distinctive character on the sign as a whole, to  
23 conclude that it would serve, in trade, to distinguish the  
24 services of the applicant from those of other traders.

25 31. I have concluded that the mark applied for will not be



1 identified as a trade mark without first educating the public  
2 that it is a trade mark. I therefore conclude that the mark  
3 applied for is devoid of any distinctive character and is thus  
4 excluded from prima facie acceptance under Section 3(1)(b) of  
5 the Act."

6 Standard of review

7 9. Counsel for the applicant accepted that, since the  
8 appeal is a review of the hearing officer's decision, the degree  
9 of respect to be given to the decision was that set out by  
10 Robert Walker LJ in **REEF Trade Mark** [2002] EWCA Civ 763, [2003]  
11 RPC 5 at [28] as follows: "In such circumstances an  
12 appellate court should in my view show a real reluctance, but  
13 not the very highest degree of reluctance, to interfere in the  
14 absence of a distinct and material error of principle."

15 The appeal

16 10. The applicant contends that the hearing officer erred  
17 in principle in two main respects: first, that he failed to  
18 assess the mark as a whole; and secondly, that he failed to  
19 assess the mark in relation to the specific services in issue.  
20 In the course of his submissions counsel for the applicant  
21 also argued that the hearing officer had not applied the  
22 correct legal test under section 3(1)(c) and that he had  
23 wrongly assessed the use of the mark in the applicant's brochure  
24 referred to in paragraph 18 of the decision.

25 11. So far as the first ground of appeal is concerned,

1           counsel for the applicant argued that in paragraph 17 of the  
2           decision the hearing officer dissected the mark into "friction  
3           management" on the one hand and "solutions" on the other hand  
4           and, having reached the (erroneous) conclusion that "friction  
5           management" was descriptive of the services in issue, failed to  
6           assess the impact of the composite word mark FRICTION  
7           MANAGEMENT SOLUTIONS as a whole.

8           12.       I do not accept that argument. The hearing officer  
9           began his assessment by stating at paragraph 17 that he had to  
10          consider the mark in its entirety bearing in mind the meaning  
11          of the individual elements. He concluded his assessment at  
12          paragraph 25 by stating that the combination FRICTION  
13          MANAGEMENT SOLUTIONS would be perceived as a combination  
14          of words indicating that the services related to the provision  
15          of solutions for friction management problems.

16          13.       So far as the second point is concerned, counsel for the  
17          applicant pointed out that in paragraph 20 of the decision the  
18          hearing officer referred to the fact that the specification  
19          included terms that were either not proper to Class 37 or were  
20          vague, but went on to say that nevertheless the core services  
21          for which registration was sought were clear and expressed  
22          those as being solutions for friction management which are  
23          individually tailored to meet individual needs. Counsel  
24          argued that by paraphrasing the specification in that way the  
25          hearing officer had effectively pre-empted the decision as to

1 the distinctive character of the mark.

2 14. I do not accept that argument either. I agree with the  
3 hearing officer that the services specified in the application  
4 can be epitomised as solutions for friction management  
5 problems. In any event, even if one takes the applicant's own  
6 proposed amended specification, which I quoted earlier, it  
7 seems to me that the hearing officer's reasoning remains  
8 equally applicable to each of the services specified in it.

9 15. So far as the legal test to be applied is concerned,  
10 counsel for the applicant argued that the objection under  
11 section 3(1)(c) is only applicable where the signs in question  
12 **designate** the kind, quality, etcetera of the services and that  
13 in order to **designate** it is not sufficient that the signs  
14 allude to some characteristics of the services in question.  
15 He submitted that the correct test is that set out in the  
16 judgment of the Court of First Instance in Case T-87/00  
17 **Bank für Arbeit und Wirtschaft AG v OHIM (EASYBANK)** [2001] ECR  
18 II-1259 at [29]-[31]. Specifically, he submitted that  
19 registration is not precluded unless the sign designates  
20 objectively or specifically the kind, quality, etcetera  
21 of the services in question and that the sign must be such as  
22 to enable the average consumer to identify immediately and  
23 precisely either the services in question or one or more of  
24 their characteristics. He also argued that this test was  
25 supported by the decision of the ECJ in Case C-273/05 **OHIM v**

1           **Celltech R&D Ltd** [2007] ETMR 52.

2           16.       I have some hesitation as to whether the test applied by  
3           the CFI in the **Bank für Arbeit** case is still good in law,  
4           having regard to the fact that the CFI's judgment in that case  
5           was before the subsequent decisions of the ECJ in the  
6           **DOUBLEMINT** and **POSTKANTOOR** cases.

7           17.       Furthermore, I consider that the essence of the decision  
8           of the ECJ in the **CELLTECH** case was that the CFI had decided  
9           that the Board of Appeal had wrongly held that the meaning  
10          of the expression "cell technology" was a well-known fact  
11          and that accordingly the Board of Appeal had not been  
12          entitled to find that it was descriptive of the goods and  
13          services in question without supporting evidence to justify  
14          that conclusion, and that that was not a matter that was  
15          subject to review by the ECJ on appeal: see paragraph [45].  
16          So far as the legal test is concerned, the Court  
17          reiterated its established case law at [73]-[79].

18          18.       Even if one assumes, however, that the test to be  
19          applied is that stated by the CFI in **Bank für Arbeit**,  
20          I consider that the hearing officer was correct to conclude  
21          that registration of the mark applied for was precluded by  
22          section 3(1)(c). Contrary to the applicant's argument,  
23          I consider that the mark does objectively and specifically  
24          designate the kind and intended purpose of the services in  
25

1 question and does so in a way which enables the average  
2 consumer to identify immediately and precisely those  
3 characteristics.

4 19. So far as the last point is concerned, I consider that  
5 the hearing officer was entirely justified in concluding that  
6 the brochure issued by the applicant, which formed part of the  
7 US priority application, supports the assessment that the mark  
8 is descriptive. In my judgment the brochure uses the  
9 expression "friction management solutions", spelt in every  
10 instance bar one entirely in lower case, in a descriptive  
11 manner. It is sufficient to refer to the following examples.  
12 On the first internal page of the brochure, the text begins  
13 with the following statement: "*Less Friction More Solutions*  
14 defines our approach to becoming your preferred partner for  
15 friction management solutions." Lower down the same column is  
16 the following passage: "Friction isn't good for moving parts.  
17 And it's not good for business processes either. With Timken  
18 friction management solutions, you'll find less of both. *Less*  
19 *Friction* isn't just a slogan. It's our way of doing business.  
20 We promise." Later in the brochure there is a heading,  
21 "Here's a quick view of our friction management solutions",  
22 which introduces several pages describing specific products  
23 and services supplied by the applicant including those in issue.  
24 20. I agree with the hearing officer that this demonstrates  
25 use of the expression "friction management solutions" to

1 describe *inter alia* the services covered by the application,  
2 and in particular the nature of those services as being  
3 solutions for friction management problems.

4 21. In summary, I consider that the hearing officer reached  
5 the right conclusion for the right reasons so far as section  
6 3(1)(c) is concerned. Since I am satisfied that registration  
7 of the mark in respect of the services applied for is  
8 precluded by section 3(1)(c), it is unnecessary for me to  
9 reach any conclusion in respect of 3(1)(b).

10 Conclusion

11 22. The appeal is dismissed.

12 Costs

13 23. In accordance with the usual practice I shall make no  
14 order as to costs.

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