

O-007-08

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2335347  
BY MFI RETAIL LIMITED TO REGISTER THE  
TRADE MARK MFI MAKE IT HAPPEN IN  
CLASSES 20, 35 & 36**

**AND**

**IN THE MATTER OF OPPOSITION NO 93116  
BY THE ROYAL BANK OF SCOTLAND GROUP PLC**

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by the Royal Bank of Scotland Group plc**

### **DECISION**

1. On 19 June 2003 MFI Retail Limited (MFI) applied to register the mark MFI MAKE IT HAPPEN. The application was made in Classes 20, 35 and 36 for the following goods and services:

**Class 20:**

Furniture and parts and fittings therefor; pillows, bolsters and mattresses.

**Class 35:**

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a general store specialising in household furniture (including home office furniture), appliances, apparatus, textiles and security.

**Class 36:**

Financial services; sales credit financing; issuing of credit cards; leasing, especially of warehouse and retail store equipment; financial management of services and systems for accounting and cash management; insurance; mortgage services and remortgaging services.

2. On 18 January 2005 The Royal Bank of Scotland Group plc (RBS) filed notice of opposition to this application citing a single ground of opposition under Section 5(4)(a). The ground is based on RBS's use of the sign MAKE IT HAPPEN in relation to a range of financial services since at least April 2002. The objection is raised against the Class 36 services only.

3. MFI filed a counterstatement denying the above ground. The essence of its position is that the sign in question is a descriptive slogan and not one that can be monopolised by a single entity. It says that the relevant consumer is unlikely to perceive the sign as denoting trade origin as opposed to being a promotional or advertising slogan. Attached to the counterstatement is a copy of the Registry's Practice Amendment Notice (PAN 1/06) in relation to slogans. Also attached to the counterstatement are the results of a search showing other marks on the Trade Marks Register incorporating the words MAKE IT HAPPEN along with a Google search showing the sign in use as an advertisement slogan by a number of different commercial enterprises. MFI suggests that, even if the sign is found to be an unregistered trade mark, the opponent has not established common law rights

sufficient to sustain an action under Section 5(4)(a). The opponent is put to proof of its claim.

4. The parties were, as usual, offered the opportunity to be heard. Neither side indicated that it wished to be heard. Written submissions have been received from Murgitroyd & Company on behalf of the opponent (under cover of their letter of 27 December 2007).

**Evidence**

5. The evidence in this case is as follows:

**Opponent’s evidence in chief:**

Witness statement by Sinead Byers with Schedules 1-5

**Applicant’s evidence in support:**

Witness statement by Mark Roland Foreman (no exhibits)

**Opponent’s evidence in reply:**

Witness statement by Richard Curtin with exhibits RC6-RC8.

6. Mr Foreman and Mr Curtis’s evidence is mainly submissions. I will consider relevant parts of the evidence below.

**The Law**

7. The relevant part of the statute, Section 5(4)(a), reads as follows:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b) .....

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

8. The requirements for a passing off action can be summarised as being:

- (1) that the opponent’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponent; and

- (3) that the opponent has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

9. The relevant date in the absence of any competing earlier claim on the part of the applicant is 19 June 2003, the filing date of the application in suit. The earlier right must have been acquired prior to that date (Article 4.4(b) of First Council Directive 89/104).

### **General principles**

10. For RBS to get its case off the ground it has to show that by 19 June 2003 it had established goodwill in the sign MAKE IT HAPPEN. The case for that rests substantially on Ms Byers' evidence. But before considering that evidence in detail it is necessary to say something about how the parties' approach the sign. MFI's position is plain. It says that the sign is a slogan and it has not been shown to be distinctive of the opponent. I do not understand MFI to suggest that a slogan is incapable of being the focus of goodwill merely that on the facts of this case that state of affairs has not been shown to exist.

11. RBS's position is variously said to be that the mark is "not used as a slogan" (paragraph 2 of Mr Curtin's witness statement) and "not merely a descriptive slogan" (paragraph 5 of Ms Byers' witness statement with emphasis as per the original). The latter appears to acknowledge that the sign may be seen as a slogan albeit that the opponent does not concede that it is merely descriptive in nature.

12. Ms Byers, who is an Intellectual Property Manager with the opponent group, says of the sign:

"The Mark was coined to embody the Company's ethos that "actions speak louder than words", a message that is reinforced by our constant promotion of the Mark".

13. In keeping with that expressed intention, the sign does indeed serve to convey an inspirational or motivational message and, as such, has the characteristics of a slogan or strap line.

14. In the Law of Passing Off (Third Edition) by Christopher Wadlow it is said in relation to slogans (at 8-95):

"There is no reason in principle why a slogan should not be capable of being distinctive, and the proposition that the tort of passing-off is wide enough to protect distinctive slogans has been accepted by the Privy Council. The few cases in which slogans have been in issue have failed on the facts, with the equivocal exception of *United Biscuits v Asda* in which the plaintiffs' slogan *P ... P ... P ... Pick up a Penguin* had been transiently parodied by the defendants with *P ... P ... P ... Pick up a Puffin*, resulting in a finding of trade mark infringement (the slogan being registered) and the likelihood that this also constituted, or would have contributed to, passing off. The point seems not to have been separately argued."

15. The reference to the Privy Council is to *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] R.P.C. 429 where Lord Scarman held that:

“[Passing off] is wide enough to encompass other descriptive material, such as slogans or visual images, which radio, television or newspaper advertising campaigns can lead the market to associate with the plaintiff’s product, provided always that such descriptive material has become part of the goodwill of the product”.

16. The ‘equivocal exception’ referred to in the first of the above passages (*United Biscuits (UK) Limited v Asda Stores Limited*, [1997] R.P.C. 513), involved a slogan type sign that had been used continuously for more than 25 years (page 539 of the judgment). The sign also contained the distinctive element Penguin and it seems that the character of the sign rested in part on the presentational aspect of the repeated Ps in addition to the overall ‘slogany’ nature of the message.

17. The few cases subsequently discussed in paragraph 8-95 which involved slogans appear to have failed on their facts and circumstances. However, the principle still holds good that there is no bar against a slogan being capable of forming the basis of a passing off right.

18. The fundamental question is, therefore, whether MAKE IT HAPPEN has become distinctive of the opponent. In relation to the issue of distinctiveness, Wadlow’s explains at 8-4:

“Passing-off is relatively unconcerned with the distinction drawn in trade mark law between inherent capacity to distinguish and distinctiveness in fact. If factual distinctiveness exists, then it does not matter whether it was achieved with ease for a mark well adapted to distinguish or with difficulty for a mark of the opposite kind. If factual distinctiveness does not exist a traditional passing-off case must fail. Passing-off never has to deal with the common situation in trade mark law of deciding how readily a mark not yet in use may become distinctive: the question is always whether an existing mark is distinctive in fact. Because of this, and because there are few *a priori* restrictions on what may be considered distinctive, the supposed inherent capacity of a mark to distinguish is only one fact among many. If the claimant adopts a mark which is obviously descriptive or otherwise of low capacity to distinguish then the evidential burden on him becomes higher, but never impossible. The other effect of low inherent distinctiveness is that smaller differences will serve to differentiate the defendant’s goods when the claimant’s mark is only marginally distinctive, but this is true if the mark is weakly distinctive for whatever reason.”

19. The applicant claims that the sign MAKE IT HAPPEN is consistently used with the opponent’s name, the Royal Bank of Scotland, and logo (of four inwardly directed arrows). The opponent has countered that on the basis of Case C-353/03, [2006] F.S.R.2 (*Have a Break*) it is possible for a mark to have acquired distinctive character even if it has normally been used as part of a composite mark rather than

independently. The issue arose there in the context of registrability. In the context of distinctiveness for passing off purposes Wadlow's indicates at 8-14:

“Only use in a trade mark sense can contribute to a name, mark or get-up becoming distinctive. In particular, if a word mark is used in a descriptive or generic sense then no amount of such use can make it distinctive. On the contrary, it only contributes to its descriptive or generic quality. Whenever a word of undoubted distinctiveness is coupled with one which is apparently descriptive or generic, then the natural inference is that the former serves as a trade mark and the latter does not. Examples are *Parsons* Flaked Oat-meal, *Horlicks* Malted Milk, and *McCains* Oven Chips. It does not avail the plaintiff that the descriptive element in these name may receive as much use and publicity as the other.”

20. The examples given in the above passage relate to distinctive marks associated with words that are the names of the underlying goods or descriptive of characteristics of the goods. But the principle must surely hold good in relation to slogans used in association with house marks or other more obviously distinctive matter. The actual nature and extent of the use must be considered in each case along with the inherent qualities of the supporting slogan. However, I do not read the above passage from Wadlows and the examples given as suggesting that the presence of an undoubtedly distinctive element leads to an automatic inference that the supporting element cannot also be recognised as a distinctive sign in its own right. It may be more difficult to establish the status of the supporting element but in each case a factual enquiry is called for into the true position.

### **RBS's evidence of use**

21. The sign MAKE IT HAPPEN is used in relation to a range of financial and support services. Ms Byers says (paragraph 7) that it is used by the company as a corporate brand, both in conjunction with and independently of the company's name. Advertising is directed at the general public and financial market to raise awareness of the sign. The following sums are said to have been spent by the company in promoting products and services under the sign:

2001	£14 million
2002	£15 million
2003	£20 million

22. No breakdown of the 2003 figure has been given so it is not possible to say how much of the expenditure took place before the relevant date.

23. The sign has been used in the context of sponsoring sporting events. RBS is said to sponsor golf tournaments throughout the world and has what are referred to as MAKE IT HAPPEN ambassadors in the golfing fraternity including Jack Nicklaus and Luke Donald. The company is a patron of The Open Championship and a partner of Augusta National which course hosts the US Masters. The company also sponsors the RBS 6 Nations Rugby Tournament and the Williams Formula 1 Team. The sign is said to have been advertised in a wide variety of media such as on the company's

website, mail shots, trade journals, trade fairs, product brochures, newspapers, television, sponsorship banners and gantries in prominent positions.

24. Exhibited in support of these claims are the following:

- Schedule One - four copy advertisements from the Financial Times (2), Daily Telegraph and Glasgow Journal for dates in October and November 2000. The words MAKE IT HAPPEN feature very prominently in the body of the advertisement. The Royal Bank of Scotland name and logo is shown at the foot of the page along with references to 'Corporate Banking and Financial Markets' or 'Commercial Banking Centre' in the case of the Glasgow Journal advertisement. There is no indication that these advertisements were placed more widely or repeated.
- Schedule Two - eight photographs of a lightbox billboard, trilateral stand displays, exterior and interior illuminated signs at Edinburgh and Heathrow airports along with exterior signage on the Heathrow express train. The items are said to have been displayed on dates between 2001 and 2004. The Royal Bank of Scotland name and logo is present in those cases where detail on the sign is legible. The words MAKE IT HAPPEN are particularly prominent on the signage at the Heathrow tunnel entrances (sandwiched between the RBS name and logo) and on the Heathrow express less obviously so in the other displays though a number of the photographs are taken from a distance which makes detail difficult to discern.
- Schedule Three - posters for a (650) branch retail banking campaign in 2003 (dates shown are between January and May). These advertisements are mainly directed at personal customers and cover personal loans, credit cards, mortgages, savings, customers service reviews, student royalties and travel insurance. A number of the posters that are shown also refer to business services. MAKE IT HAPPEN is said to be the only trade mark appearing on the posters.
- Schedule Four - twelve examples of gift items such as bags, wallets, conference folders, pen sets and an umbrella. Typically a few hundred of such items are said to be given annually though larger numbers of pens, pen sets and conference folders were given out. The words MAKE IT HAPPEN are visible on some but not all of these items. The RBS name and logo is always present.

These promotional items have been available since 2002.

Schedule Five - five advertisements placed in the Daily Telegraph dated 15 February 2003 linked to RBS's sponsorship of the 6 Nations Rugby Tournament. In each case the RBS name and logo are also present.

### **Appraisal of the claim to goodwill**

25. On the basis of this evidence the opponent has been using the sign for just over two and a half years prior to the relevant date though some of the use (that shown in Schedules Three and Five) took place in the six months preceding the material date for these proceedings. Much of the use shown is by way of general corporate advertising rather than being directed at specific services. In this category falls the airport and train signage, the 6 Nations rugby sponsorship advertisements and the promotional items. These materials are intended to keep the bank's name in the public eye rather than constituting offers of particular services. Nevertheless, subject to other factors, such use may still contribute to the goodwill of the business in which the sign is used.

26. Certain of the exhibits, notably the Schedule Three branch posters, offer particular services and/or are directed at a particular segment of the customer base. In the latter category are the corporate banking advertisements in Schedule One which refer to e.g. sterling derivatives and leveraged loans.

27. The marketing spend figures referred to above appear at first glance to be impressive but it is not clear whether the expenditure relates entirely to the UK. In this respect it is noted that the company has registered the sign in a number of countries throughout the world and refers to sponsorship activity throughout the world. Mr Curtin confirms that the marketing spend relates to the sign MAKE IT HAPPEN but does not make it clear whether it was also under the RBS banner. If the exhibited material is typical it is clear that almost all advertising is in association with the bank's name and logo rather than the sign MAKE IT HAPPEN on its own.

28. Mr Curtin's evidence/submissions seek to differentiate between use 'in conjunction with' the company name and logo and the instances where the two elements are distanced from one another albeit appearing in the same advertisements, signage etc. I do not consider that this distinction makes a material difference. So, whilst I accept that RBS's use is not in the main of a composite mark (in the sense that the applicant's mark, MFI MAKE IT HAPPEN, is), it is still use of MAKE IT HAPPEN in a context in which other distinctive RBS branding is present even if the words are not placed directly alongside the RBS name and logo.

29. The exception to that pattern is the Schedule Three poster campaign. But, of course, for a customer or potential customer to encounter these posters they would have to be in an RBS branch. Thus, the context would already be known to the customer.



30. What effect has this use had on customers or potential customers? The initial tranche of newspaper advertising (Schedule One) was restricted to a two month period in October and November 2000. I am not convinced that the use of the words MAKE IT HAPPEN in the context and manner in which it was presented would have made any lasting impact. The words are presented in lower case lettering and would in my view be taken as an exhortation to the customer. There is no aspect of presentation or other obvious reason why they would be taken as being in themselves distinctive of RBS.

31. The airport and train signage (Schedule Two) was at prominent locations and may have been repeatedly viewed by frequent users of the airports and trains. The tunnel signage gave particular prominence to MAKE IT HAPPEN (more so than the light box displays and stands). The same was also true of the Heathrow express signage where the train itself was decked out in RBS livery. On the other hand, whilst members of the relevant public passing through busy airports or on trains may subliminally register main corporate brands in these contexts, such contacts are by their nature transient and do not involve commercial transactions so it is questionable whether a motivational message such as MAKE IT HAPPEN would make a material impact.

32. The branch posters (Schedule Three) gave primary prominence to the services being offered (mortgages, loans etc). The sign MAKE IT HAPPEN was not particularly prominent and in my view would have struggled to achieve consumer impact amongst anyone other than particularly attentive browsers.

33. The promotional items (Schedule Four) were only available from 2002. Their impact is difficult to gauge. The items were given out in modest but not negligible numbers and presumably went in the main to established customers.

34. The 6 Nations advertising (Schedule Five) was placed in the Daily Telegraph and appears to have been a one-off in February 2003 no doubt to coincide with the tournament itself. The main effect would have been reinforcement of the corporate message that RBS sponsors the event. (Ms Byers refers in general terms in her paragraph 9 to other forms of advertising but does not exhibit examples or identify specific events, publications etc or attribute dates etc to these other marketing efforts.)

35. Nevertheless, it is not enough to examine the individual exhibits. What matters is the overall effect of the opponent's advertising, the level of awareness it is likely to have achieved for the sign and the impact that the sign has had on consumers. Although Ms Byers claims that the sign has been used both in conjunction with, and independently of, the company's name, the overwhelming impression is that it is the former with in-branch use being the exception. There has, however, clearly been some exposure (including some repeat exposure) to the sign MAKE IT HAPPEN albeit primarily in conjunction with the RBS name and logo. The airport and train signage has been both prominent and present over a period of time. In my view this is more likely to have made some impact on the relevant public than the brief periods of press advertising shown in Schedules One and Five.

36. What is more difficult to determine is whether, on the basis of this exposure, the relevant public or a sufficiently significant proportion of it had come to regard MAKE

IT HAPPEN as being distinctive of RBS. As the opponent itself acknowledges the sign was coined to embody the ethos that “actions speak louder than words”. In other words it is there to convey a message. As I have already said, in my judgment the words MAKE IT HAPPEN would primarily be seen as an inspirational or motivational statement. It may either be read as applying to the capabilities of the service provider or, perhaps more likely, an exhortation to the recipient to achieve some unstated goal with the sub-text that the service provider will help to achieve that goal. Either way it is a relatively banal expression and one that is likely to require considerable use and education of the public before it will be regarded as distinctive of one particular trader. I do not find it at all surprising that the applicant’s counterstatement gave examples of traders seeking to register marks incorporating the expression (or close variants) and that internet usage pointed to others using the expression. However, as this material was not filed in the evidence I do not rely on it in any formal sense.

37. Some of the opponent’s own advertising usage merely reinforces the inspirational/motivational message. Thus, from Schedule One, the words ‘make it happen’ (presented in lower case in each of the advertisements) is followed by e.g. “The right attitude gets things done” and “Swift analysis and action is essential”. Likewise, the in-branch posters have bold headings such as “3% discount until 1 January 2004” and “Could you consolidate and save with a Personal Loan?”. In each case the words ‘Make it happen’ appear beneath and would in my view be taken as little more than an invitation to benefit from the offered service. Moreover, there is nothing particularly striking about the manner or prominence of use that would alert the relevant public to the fact that RBS intended the words to be distinctive of its financial services.

38. In circumstances where the claimed sign is inherently of low distinctiveness and the use has mainly been in conjunction with other more obviously distinctive matter (the RBS name and logo) the burden of establishing that the words MAKE IT HAPPEN are in themselves distinctive of RBS is proportionately greater. Furthermore, the relevant public for the services in issue is a very broadly based body including both corporate and personal users of financial services. There is no evidence from either group or the trade at large that might help to validate the opponent’s claim.

39. Mr Curtin, RBS’s Head of Intellectual Property, has given evidence to the effect that the company’s trade mark application for the mark MAKE IT HAPPEN has since been accepted for publication on the basis of acquired distinctiveness. He suggests that it is apparent that the UKIPO appreciates that use in the UK prior to 25 June 2004 gave rise to common law rights.

40. Firstly, the evidence filed in support of the trade mark application has not been adduced in the opposition proceedings. Secondly, the filing date of 25 June 2004 was a year later than the material date in these proceedings. Thirdly, I note Mr Curtin concedes that the mark was initially used with other trade marks as a bridge to educate the public but that “Over time, once education was complete, the Mark was used as a stand alone Mark”.

41. The evidential basis for the claim that MAKE IT HAPPEN has functioned as a stand alone mark/sign is weak. The in-branch poster campaign material in Schedule Three from January, March and May 2003 is the main evidence of the words being used without the RBS housemark and logo in reasonable proximity but for the reasons already given this usage does not strike me as making a particular impact and was in any case in a context where the consumer would not have needed to look for other matter to identify the service provider. Whilst I accept that the claim to distinctiveness is not wholly dependent on it being a self-contained sign, its use even in loose association with other more distinctive matter, inevitably makes the opponent's task more difficult.

42. The outcome is that I accept that there may be some slight public association of the sign MAKE IT HAPPEN with the opponent. Most of the use shown has been linked to the main and distinctive corporate branding. Even accepting that use with other matter is not a bar to the relevant public coming to accept that MAKE IT HAPPEN is in its own right distinctive of the opponent, the evidence is not convincing in establishing that that state of affairs had come about by June 2003. The opponent has thus failed to establish the first leg of the passing off test and cannot succeed under Section 5(4)(a). In the circumstances I do not need to consider the issues of misrepresentation and damage.

43. The applicant has succeeded and is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of **£1000**. This sum is 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 10<sup>th</sup> day of January 2008**

**M Reynolds  
For the Registrar  
The Comptroller-General**