

O-099-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 2488299

BY EASISTORE LIMITED TO REGISTER THE MARK

WE CREATE SPACE

IN CLASS 39

Background

1. On 23 March 2008, Easistore Limited of Block 7, Enterprise Way, Edenbridge, Kent, TN8 6HF ('the applicant') applied to register the trade mark application number 2488299 for the word mark 'WE CREATE SPACE' for the following services:

Class 39 – storage of goods in a warehouse or other building for their preservation or guarding; provision of storage of packaging materials and items including packaging boxes, adhesive tape, packaging paper and wrap; provision of storage facilities for use by others; advice concerning the removal and storage of goods.

2. On 23 June 2008 the Intellectual Property Office issued an Examination Report in response to the application, which deemed the mark open to objection under Section 3(1)(b) and (c) of the Trade Marks Act 1994 ('The Act') on the basis that it described the intended purpose of the services e.g. "a statement that uses plain descriptive language to state that the company/ individuals [*sic*] create space through efficient storage systems".

3. On 5 August 2008, the applicant's trade mark attorney, Mr Chris Morris of Haseltine Lake, made written submissions in response to the objection raised to argue that the mark did not describe a characteristic of the services claimed and that the mark merely alluded to "one possible consequence of the services".

4. On 12 August 2008, the examiner wrote to Mr Morris confirming that in his opinion, the objection was valid and the basis that the term 'we create space' was "plain descriptive language to describe the outcome of using [*the applicant's*] services".

5. Mr Morris thereafter requested two requests for extensions of time (Form TM9) on 1 October 2008 and 12 December 2009 to allow the applicant additional time to prepare evidence of use in relation to a claim for acquired distinctiveness. This evidence was submitted under cover of a Witness Statement from Simon Bidgway on behalf of the applicant, with supporting exhibits, on 23 January 2009.

6. This evidence was considered by the examiner, however it was deemed insufficient to prove that the mark had become distinctive by virtue of use because, inter alia, the length of use was insufficient, the turnover figures were inadequate and the mark was used in a different format than that filed i.e. with an 'EASISTORE' logo.

7. The applicant thereafter requested a hearing on 24 March 2009, which was held on 11 June 2009. The applicant was represented by Mr Martin Krause from Haseltine Lake. At hearing, the objection raised during examination was maintained for the reasons set out in the preceding paragraphs and also, as I considered that the mark failed to demonstrate a sufficiently wide geographical spread of use throughout the UK, thus failing the criteria set out in the *Bovemij Verzekeringen NV v Benelux Merkenbureau* Case C-108/05 (*EUROPOLIS*) decision.

8. On 7 August 2009, Mr Morris submitted a form TM5 to request a full Statement of Grounds to set out the reasons for refusal of the application.

Decision

9. Sections 3(1)(b) and (c) of the Act read as follows:

“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.

Relevant Authorities

10. Section 3(1)(c) of the Act has common roots to Art. 7(1)(c) of the CTMR and it is substantially identical to that provision. Accordingly, the ECJ's guidance with regard to provision maybe taken to apply equally to Section 3(1)(c) of the Act. The provision excludes signs which may serve, in trade, to designate the kind of services or other characteristics of the services. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristics of the services in question.

11. The European Court of Justice (ECJ) has repeatedly emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (Case C-37/03P, *Bio ID v OHIM*, paragraph 59 and the case law cited there and, more recently, Case C-273/05P *Celltech R&D Ltd v OHIM*).

12. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. Thus, in the case of the registration of colours *per se*, not spatially delimited, the Court has ruled that the public interest is aimed at the need not to restrict unduly the availability of colours for other traders in goods or services of the same type. Also, in relation to Section 3(1)(b) (and the equivalent provisions referred to above) the Court has held that “...the public interest ... is, manifestly, indissociable from the essential function of a trade mark” (Case C-329/02P, SAT.1 *SatellitenFernsehen GmbH v OHIM*).

13. The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function. Section 3(1)(c) on the other hand pursues an aim which reflects the public interest in ensuring that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM (Doublemint)*, C-191/0P paragraph

Section 3(1)(c)

14. There are now a number of judgments from the ECJ which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), whose provisions correspond to Section 3(1)(c) of the UK Act. In terms of the issues before me in this case I derive the following main guiding principles from the cases noted below:

- subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – *Wm Wrigley Jr & Company v OHIM – (Doublemint)* paragraph 30;
- there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics – *Ford Motor Co v OHIM, Case T-67/07*;
- a sign’s descriptiveness may only be assessed, first, in relation to the goods or services concerned and, secondly, in relation to the perception of the target public, which is composed of the consumers of those goods or services – *Ford Motor Co v OHIM*;
- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word “exclusively” in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question – *Koninklijke KPN Nederland NV and Benelux-Merkenbureau, Case C-363/99 (Postkantoor)*, paragraph 57;
- it is in principle irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary – *Postkantoor*, paragraph 102.

15. The objection raised under Section 3(1)(c) is maintained against the following services:

Class 39 – storage of goods in a warehouse or other building for their preservation or guarding; provision of storage of packaging materials and items including packaging boxes, adhesive tape, packaging paper and wrap; provision of storage facilities for use by others; advice concerning the removal and storage of goods.

16. Prior to the hearing, Mr Morris submitted in correspondence that the mark was inherently distinctive under the provisions of Section 3(1)(b) and (c) of the Act, as it did not describe a characteristic of the goods.

17. This submission was repeated at the hearing by Mr Krause, specifically that an objection would only apply to the *removal* not the *storage* of goods. This argument was rejected, as in my view, the mark is equally objectionable for removal and storage services that effectively create space for the user of such.

18. The following extract is taken from the applicant's website (my emphasis in bold):

"We create space. Whether you're downsizing, up-sizing or just want to store away some of that clutter and **create some space at home**, Easistore offer tailor-made space suitable for everything from seasonal sports equipment to furniture storage at unbeatable prices backed by the best available customer service."

19. This promotional extract appears to substantiate the objection and demonstrates that the mark applied for is being used as a description for the intended purpose of the services by describing an essential feature of such. The applicant is supplying this exact service for the business or home consumer by creating space via the storage facilities offered for their non-essential, surplus or redundant possessions. The combination of words forms a perfectly clear, grammatically correct descriptive phrase using plain English, with no additional embellishments that would confer distinctive character.

20. In view, the applicant's own submissions support this finding. In several of the Exhibits forwarded with Mr Bidgeway's Witness Statement (Exhibit "SB2"), for example, on the front of promotional flyers and packaging supplies catalogues and leaflets for van rental services, crate rental services and wine storage the mark is descriptively employed. In particular, the positioning of the sign on these documents will lead the consumer to view the same as nothing more than an indication of the nature of the services the applicant is promoting.

21. Some of this evidence shows use as a secondary trade mark in conjunction with the 'EASISTORE' brand, however given that the term 'we create space' is also being utilised as an entirely descriptive phrase, any trade origin significance is diluted to the extent that the consumer will, in my view, not perceive the mark as indicating trade origin without some considerable education to that fact. In this context, it has already been established that the evidence of use filed simply does not demonstrate that the mark has acquired distinctive character.

22. Consequently, I conclude that the mark applied for consists exclusively of a sign or indication which describes a characteristic of the goods.

23. Having found that the mark is to be excluded from registration by Section 3(1)(c) of the Act, that effectively ends the matter, but in case I am found to be wrong in this, I will go on to determine the matter under Section 3(1)(b) of the Act.

Section 3(1)(b)

24. In relation to (b) it was held in *Postkantoor* that:

“86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

25. I approach this ground of objection on the basis of the following principles derived from the ECJ cases referred to below:

- an objection under Section 3(1)(b) operates independently of objections under Section 3(1)(c) – (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);
- for a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- a mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86);
- a trade mark’s distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public’s perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);
- the relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

26. Further, I do not consider that an application may escape objection if it is considered too imprecise a term and to indicate a direct and specific relationship with the goods or services at issue without further thought, but is, in some sense, more generally non-distinctive. In particular, I note that it was held in *Imperial Chemical Industries plc v OHIM*, case T-224/07:

“21 For a finding that there is no distinctive character, it is sufficient that the semantic content of the word mark in question indicate to the consumer a characteristic of the goods or service which, whilst not specific, represents promotional or advertising information which the relevant public will perceive first and foremost as such, rather than as an indication of the commercial origin of the goods or service (*REAL PEOPLE, REAL SOLUTIONS*, paragraphs 29 and 30, and Case T-128/07 *Suez v OHIM* (Delivering the essentials of life), not published in ECR, paragraph 20)”

27. I further take note the recent ECJ Case C-398/08P *Audi AG v OHIM* (“*Vorsprung Durch Technik*”), from which the selected paragraphs following are quoted:

“41 It must be held that, even though the General Court stated in paragraph 36 of the judgment under appeal that it is clear from the case-law that registration of a mark cannot be excluded because of that mark’s laudatory or advertising use, it went on to explain that the reason for its finding that the mark applied for lacks distinctive character was, in essence, the fact that that mark is perceived as a promotional formula: that is to say, its finding was made precisely on the basis of the mark’s laudatory or advertising use.

44 However, while it is true – as was pointed out in paragraph 33 of the present judgment – that a mark possesses distinctive character only in so far as it serves to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking, it must be held that the mere fact that a mark is perceived by the relevant public as a promotional formula, and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient, in itself, to support the conclusion that that mark is devoid of distinctive character.

45 On that point, it should be noted that the laudatory connotation of a word mark does not mean that it cannot be appropriate for the purposes of guaranteeing to consumers the origin of the goods or services which it covers. Thus, such a mark can be perceived by the relevant public both as a promotional formula and as an indication of the commercial origin of goods or services. It follows that, in so far as the public perceives the mark as an indication of that origin, the fact that the mark is at the same time understood – perhaps even primarily understood – as a promotional formula has no bearing on its distinctive character.

46 However, by the line of reasoning set out in paragraphs 42 and 43 of the present judgment, the General Court did not substantiate its finding to the effect that the mark applied for will not be perceived by the relevant public as an indication of the commercial origin of the goods and services in question; in essence, rather, it merely highlighted the fact that that mark consists of, and is understood as, a promotional formula.

47 As regards the General Court’s finding in paragraph 41 of the judgment under appeal that the mark ‘*Vorsprung durch Technik*’ can have a number of meanings, or constitute a play on words or be perceived as imaginative, surprising and unexpected and, in that way, be easily remembered, it should be noted that, although the existence of such characteristics is not a necessary condition for establishing that an advertising slogan has distinctive character, as is apparent from paragraph 39 of the present judgment, the fact remains that, as a rule, the presence of those characteristics is likely to endow that mark with distinctive character.

56 In that regard, it must be stated that all marks made up of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by those marks convey by definition, to a greater or lesser extent, an objective message. It is clear, however, from the case-law set out in paragraphs 35 and 36 of the

present judgment that those marks are not, by virtue of that fact alone, devoid of distinctive character.

57 Thus, in so far as those marks are not descriptive for the purposes of Article 7(1)(c) of Regulation No 40/94, they can express an objective message, even a simple one, and still be capable of indicating to the consumer the commercial origin of the goods or services in question. That can be the position, in particular, where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring little in the way of interpretation by the relevant public, or setting off a cognitive process in the minds of that public.

58 Even if it were to be supposed that the slogan 'Vorsprung durch Technik' conveys an objective message to the effect that technological superiority enables the manufacture and supply of better goods and services, that fact would not support the conclusion that the mark applied for is devoid of any inherently distinctive character. However simple such a message may be, it cannot be categorised as ordinary to the point of excluding, from the outset and without any further analysis, the possibility that that mark is capable of indicating to the consumer the commercial origin of the goods or services in question.

59 In that context, it should be pointed out that that message does not follow obviously from the slogan in question. As Audi observed, the combination of words '*Vorsprung durch Technik*' (meaning, inter alia, advance or advantage through technology) suggests, at first glance, only a casual link and accordingly requires a measure of interpretation on the part of the public. Furthermore, that slogan exhibits a certain originality and resonance which makes it easy to remember. Lastly, inasmuch as it is a widely known slogan which has been used by Audi for many years, it cannot be excluded that the fact that members of the relevant public are used to establishing the link between that slogan and the motor vehicles manufactured by that company also makes it easier for that public to identify the commercial origin of the goods or services covered."

28. The message from this case is, in my opinion, that an mark should not be deemed as devoid of any distinctive character because of an unqualified assertion that it would be seen as entirely, or even primarily, a 'promotional' message as far as the average consumer is concerned and also, that objective and simple messages may not necessarily be devoid of distinctive character solely by virtue of that characteristic. The issue for the ECJ seems to be that where such marks possess 'originality and resonance' capable of being remembered, which may result from, inter alia, word play, imagination and creativity, they are unlikely to be devoid of distinctive character. The impact of the Judgment is, in effect, to urge the relevant authorities to undertake a full semantic analysis of the mark in question (as I have undertaken in this case), without preconception or pre-emption, and also take into account known and relevant surrounding circumstances.

29. As regards the surrounding circumstances in the '*Vorsprung durch Technik*' case, in para 59 the ECJ factored into their analysis that Audi's use of the mark over

many years made it easier for the average consumer to identify the commercial origin of products sold under that slogan. I have noted that there is no equivalent evidence of use in this case and there are no other relevant surrounding circumstances that have been brought to my attention either by the examiner or the applicant.

30. As far as my semantic analysis is concerned, I have concluded that the mark herein cannot lay claim to any linguistic imperfection, peculiarity, inventiveness or other creative application which might help endow it with the necessary capability to function. As I have stated previously, the mark herein is a plain description in English therefore after applying the ECJ's guidance in '*Vorsprung durch Technik*', as well as those cases which have preceded it, I have no hesitation in upholding the refusal under section 3(1)(b) of the Act.

31. I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from *prima facie* acceptance under Section 3(1)(b) of the Act.

Conclusion

32. In this decision I have considered all of the arguments submitted in relation to the application and for the reasons given, it is refused under the terms of Section 37(4) of the Trade Marks Act because it fails to qualify under Section 3(1)(b) and (c) of the Act.

Dated this 31 March 2010

Jane Hallas
For the Registrar
The Comptroller-General