O/319/12

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 2558874
BY CONNECTION POINT TECHNOLOGY LTD
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 9:

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CONNECTION POINT

Background

1. On 16 September 2010, Connection Point Technology Ltd ('the applicant') applied to register the trade mark shown above for the following goods:

Class 9: Communication apparatus, equipment and accessories; telecommunications apparatus and equipment and accessories; computer hardware, computer software, computer firmware; electrical and electronic apparatus and instruments all for processing, logging, storing, transmission, retrieval or reception of data; parts and fittings for the aforesaid goods.

2. On 24 September 2010, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under section 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act'), on the basis that the mark consists exclusively of the words „connection point', being a sign which may serve in trade to designate the type of goods e.g. communication apparatus which have a locality (a point) where a connection can be made with other apparatus, be that using wires or other forms of connectivity.

3. On 4 October 2010, David Fry of Agile IP LLP („the agent'), requested that the following terms be deleted from the specification:

> Communication apparatus, equipment and accessories; telecommunications apparatus, equipment and accessories.

4. The amendment resulted in the specification shown below. It was submitted by Mr Fry, in his letter of 4 October 2010, that the mark is not descriptive of the remaining goods and that accordingly, the application should proceed to acceptance.

Class 9: Computer hardware, computer software, computer firmware; electrical and electronic apparatus and instruments all for processing, logging, storing, transmission, retrieval or reception of data; parts and fittings for the aforesaid goods.

5. In a letter dated 8 October 2010, the examiner responded to Mr Fry advising him that the specification had been amended as requested, but also confirming that he did not consider the amendment to overcome the objection. The examiner stated that goods such as „computer hardware' (including, for example, a computer keyboard), would still need some sort of connection point to enable them to be connected to other devices (in the case of a keyboard, connectivity might be to the computer „base'). The examiner also considered that this was the case in respect of the broad terms „electrical and electronic apparatus and

instruments' which may also have a connection point. The examiner similarly maintained that in relation to „computer software and firmware' the term would merely indicate that the software will function as a connection point between for example, two servers, enabling two computers to exchange information over a network. Given that the section 3(1) objection was maintained, a period of two months until 8 December 2010 was allowed for Mr Fry to respond.

6. On 20 December 2010, a request for retrospective extension of time was received resulting in a further two-month period being granted until 8 February 2011.

7. On 8 February 2011, Agile IP LLP requested an *ex parte* hearing to be attended by Mr David Fry and Mr Alan Fry. At the hearing, held on 7 September 2011, Mr David Fry advised me that the goods of interest to the applicant were computer software which did not, in his submission, have any relation to providing a connection.

8. In my hearing report I maintained that the sign was both descriptive and devoid of any distinctive character pursuant to sections 3(1)(b) and (c) in respect of all goods still covered by the application. I submitted that the relevant consumer would still understand the sign as being a denotation of type or characteristic i.e. goods which function as, contain, or facilitate, a connection point. I therefore suggested that in order to overcome the objection, a revised, positively limited specification should be submitted for further consideration.

9. Although a period of two months was provided in order for the applicant to provide a further revised specification, no more correspondence was received. This led to a formal notice of refusal which, in turn, led the applicant to file a form TM5 seeking a statement of reasons for the Registrar's decision. I am now asked under section 76 of the Trade Marks Act 1994 and rule 69 of the Trade Marks Rules 2008 to state in writing the grounds of my decision and the materials used in arriving at it. No formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, I have only the *prima facie* case to consider.

The applicant's case for registration

10. Prior to setting out the law in relation to section 3(1)(b) and (c) of the Act, I should emphasise that this decision will set out my reasons for maintaining the objection by reviewing and assessing the mark applied for. Prior to refusal of the application, the only arguments put forward in support of *prima facie* acceptance were those made in Mr Fry's letter of 4 October 2010, and then those presented orally at the *ex parte* hearing on 7 September 2011. The argument centred on the fact that the sign was not descriptive when considered in relation to the amended specification. At the hearing, Mr Fry submitted that the remaining goods covered by the application did *not* include any goods which would function as, or otherwise include, a connection point.

The Law in relation to section 3(1)(c)

11. Section 3(1)(c) of the Act reads as follows:

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

(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."

Decision - Section 3(1)(c)

12. In *JanSport Apparel Corp v Office for Harmonisation in the Internal Market* (Case T-80/07) the General Court ('GC') gave a helpful summary of the considerations to be taken into account in relation to Article 7(1)(c) of the regulation, the equivalent of section 3(1)(c) of the Act:

"18. Under Article 7(1)(c) of Regulation No 40/94, „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 or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service' are not to be registered. In addition, Article 7(2) of Regulation No 40/94 (now Article 7(2) of Regulation No. 207/2009) states that „paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community'.

19. By prohibiting the registration of such signs, that article pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (Case C-191/01 P *OHIM* v *Wrigley* [2003] ECR I-12447, paragraph 31).

20. Furthermore, the signs covered by Article 7(1)(c) of Regulation No 40/94 are signs regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquired the product or service to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (Case T-219/00 *Ellos* v *OHIM (ELLOS)* [2002] ECR II-753, paragraph 28, and Case T-348/02 *Quick* v *OHIM (Quick)* [2003] ECR II-5071, paragraph 28).

21. The signs and indications referred to in Article 7(1)(c) of Regulation No 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 (see the judgment of 9 July 2008 in Case T-323/05 *Coffee Store* v *OHIM (THE COFFEE STORE)*, not published in the ECR, paragraph 31 and the case-law cited). Accordingly, a sign's descriptiveness can only be assessed by reference to the goods or services concerned and to the way in which it is understood by the relevant public (Case T-322/03 *Telefon & Buch* v *OHIM– Herold Business Data (WEISSE SEITEN)* [2006] ECR II-835, paragraph 90).

22. It follows that, for a sign to be caught by the prohibition set out in that provision, 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 goods and services in question or one of their characteristics (see Case T-19/04 *Metso Paper Automation* v *OHIM(PAPERLAB)* [2005] ECR II-2383, paragraph 25 and the case-law cited).

23. It must finally be pointed out that the criteria established by the case law for the purpose of determining whether a word mark composed of several word elements is descriptive or not are identical to those applied in the case of a word mark containing only a single element (Case T-28/06 *RheinfelsQuellen H. Hövelmann* v *OHIM (VOM URSPRUNG HER VOLLKOMMEN)* [2007] ECR II- 4413, paragraph 21)."

13. Furthermore, in Case C-363/99 *Koninklijke KPN Nederland NV and Benelux-Merkenbureau, C-363/99 (Postkantoor)*, the Court of Justice of the European Union („CJEU') stated:

"98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned…

…

102. It is also irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. The wording of Article 3(1)(c) of the Directive does not draw any distinction by reference to the characteristics which may be designated by the signs or indications of which the mark consists. In fact, in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially."

14. In order to determine whether or not the mark is excluded by section 3(1)(c) on account of it performing a descriptive function, the Registrar must consider both the goods and services intended for protection under the mark, and the perception of the average consumer for such products. The goods at issue are „computer hardware, computer software, computer firmware; electrical and electronic apparatus and instruments all for processing, logging, storing, transmission, retrieval or reception of data; parts and fittings for the aforesaid goods.' In my view this encompasses both terms which are fairly broad, some less so; some of the broad terms will encompass both highly technical electronic products, and other types of products more familiar to all of us as computer users; in most cases attention levels will be above average given likely unit price and in view of this I consider that the relevant consumer is likely to be both the specialist and non-specialist public.

15. Turning my assessment to the mark applied for, I refer to various dictionary entries for the words 'connection' and „point'. Hargrave's Communications Dictionary defines „connection' as:

> **Connection** 1. An electrical continuity between two conductors or devices; 2. A provision (physical or virtual path) for a signal to propagate from one communicating device to another, such as from one circuit, line, subassembly, or component to another. Examples of communicating devices include telephones, computers, and network nodes; 3. An association established between functional units for conveying information; 4. The point of attachment between devices or systems.

The Dictionary of Communications Technology: Terms, Definitions and Abbreviations, Wiley defines „Point' as:

> **Point** 1. An established data communications path; 2. The process of establishing that path; 3. A point of attachment for that path.

16. Having established that each word has a separate meaning, I am required to decide whether the *combination* of those words falls foul of the requirements set out in sections 3(1)(b) and (c). With that in mind, I do not believe the combination can lay claim to any grammatical or linguistic imperfection or peculiarity such as might help to escape its inherent descriptiveness. To my mind, the term „connection point' most commonly and obviously describes something which facilitates or acts as a communications path or point for a signal to propagate from one communicating device to another, where examples of communicating devices in this context might include, for example, computers and network nodes. Similarly, the term would be understood to mean the point of association established between functional units for conveying information.

17. The section 3(1)(c) objection is therefore based on the premise that the term 'connection point' used in respect of products such as computer hardware would be understood as a reference to a characteristic of the goods. For example, computer hardware may facilitate a connection point between a laptop and a television. Similarly „electronic apparatus and instruments for transmission of data' could incorporate a physical connection point for connecting to the internet enabling the user to send and receive data. It does appear that the term may have several meanings dependent on the actual product it is being used upon. However, this does not prevent or dilute the validity of the objection.

18. Research undertaken as part of the hearings process has further strengthened my belief that the sign would serve to designate a characteristic of the goods applied for. For example, it is helpful to consider how the term is used in trade in relation to goods which could be covered by terms listed in the specification. I therefore refer to the seven Internet pages attached as annexes to this decision. The first six references all show use of the term in relation to the provision of internet access via a connection point, whilst annex 7 shows use of the term in relation to a connection point for the exchange of electronic information. These are a small sample of references, illustrating how the term „connection point' is used to

describe goods that facilitate or function as a connection point and which support my view that the term designates a characteristic of the goods.

19. In view of the fact that the terms covered are extremely broad, it is necessary to assess the distinctiveness of the sign by reference to all of the terms claimed, however broad. If there are goods specified which are free of objection under section 3(1)(b) and (c), then they must be allowed to proceed. In the case of European Case of Justice Case C- 239/05 *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* the question being referred to the court was whether the Directive, on which the Act is based of course, must be interpreted as meaning that the competent authority is required to state its conclusion separately for each of the individual goods and services specified in the application. The court answered (para 38), saying that the competent authority was required to assess the application by reference to individual goods and services. However, where the same ground of refusal is given for a category or group of goods or services, the competent authority may use only general reasoning for all the goods and services concerned. In this case I regard most goods to be in the same category (computer related goods and electronic apparatus) falling in class 9, and thus rely on general reasoning in refusing the mark for the goods specified.

20. For the majority of goods claimed, paragraphs 15-18 above set out the Registrar's reasons for deeming the sign 'connection point' to be descriptive. However, in relation to „computer software' *per se* I think that the meaning derived from the mark is less clear, and so the objection is more difficult to substantiate. For section 3(1)(c) to apply, there must be a direct and specific link made by the average consumer between the goods or services and the sign applied for; in the recent case of the Court of Justice of the European Communities (Case T 165/11 „College'), the Court has said there must be a „specific image' or link between the sign and goods applied for, for section 3(1)(c) to bite (see para 26).

22. By „specific image', I assume the Court to mean that the words „connection point' must convey a shared and specific image as to what such goods would constitute. Although relatively easy to make such a link between the sign and the majority of goods intended for protection, it is less obvious to identify such a 'specific image' or 'link' for software. As a result, the section 3(1)(c) objection is therefore waived in relation to „computer software'.

24. In taking a reasonably broad objection against the goods claimed, it should be emphasised that the Registrar did provide the applicant with an opportunity to submit a revised limited specification for further consideration at the *ex parte* hearing (see paragraph 9 above). However, nothing was provided in response. As a result, the Registrar considers it prudent to now confirm that this refusal applies to all goods claimed apart from 'computer software'.

25. Having found the mark to be excluded from registration by section 3(1)(c) of the Act for everything apart from 'computer software', that effectively ends the matter. However, in case I am found to be wrong in that respect, I will go on to determine the matter under section 3(1)(b). I should at this point stress that since objection has been made under section 3(1)(c), this automatically engages section 3(1)(b). However, it can be useful to also consider section 3(1)(b) in its own right - the scope of the two provisions is not identical, and

marks which are not descriptive under section 3(1)(c) can nonetheless be devoid of any distinctive pursuant to section 3(1)(b).

Decision - Section 3(1)(b)

26. In relation to section 3(1)(b), the ECJ held in *Postkantoor* (cited above) 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 regards 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."

27. 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 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*).

23. The question arises whether the term may be „devoid of distinctive character' under section 3(1)(b) in relation to „computer software' even though it does not precisely „*designate*', a characteristic of the goods. In this respect the public interest underlying the provision for refusal of marks lacking distinctive character has been examined by the ECJ in Case C-104/01 *Libertel Groep BV v Benelux-Merkenbrau* [2003] (Libertel). In that case, the ECJ found that the public interest was "*not unduly restricting the availability*" of the given variety of mark for other traders. Advocate-General Jacobs in his opinion in SAT.2 gave further consideration and pointed out that this is distinct from the public interest behind CTMR Article 7(1)(c). He pointed out that "*there is no obvious reason why signs which simply lack any distinctive character– even if that lack is not absolute but relates only to the*

goods and services concerned – should be kept free for general use unless the signs themselves also have some close relationship with the relevant products".

28. In my opinion, even if the mark falls short of conveying the requisite level of specificity and objectivity to support an objection under section 3(1)(c), I would nevertheless hold that it would not be capable of performing the essential function of a trade mark without the relevant public being educated into seeing it that way. In my view, consumers would *not* consider the mark to be that of any particular manufacturer or supplier of computer hardware, or firmware (or any of the other goods listed in the application form with the exception of computer software), but rather, that the sign could properly be „at home' on the goods of any undertaking. The aforementioned Libertel judgement speaks not of keeping signs available to be "freely used by all" but rather of "not unduly restricting" their availability. I believe that these considerations are applicable to the application in suit and that there is no basis for maintaining the objection under section 3(1)(b) against computer software. On this basis the section 3(1)(b) objection is also made out.

29. I have concluded that the mark applied for will not be identified as an indicator of trade origin without the public being first educated to the fact. 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.

30. For reasons identical to those presented in respect of the objection under section 3(1)(c), the refusal under section 3(1)(b) applies to all goods with the exception of 'computer software'.

Conclusion

31. In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is partially refused under the terms of section 37(4) of the Act because it fails to qualify under sections 3(1)(b) and 3(1)(c) of the Act. In the absence of any appeal being filed, the application will therefore proceed to publication for the class 9 specification of 'computer software' only.

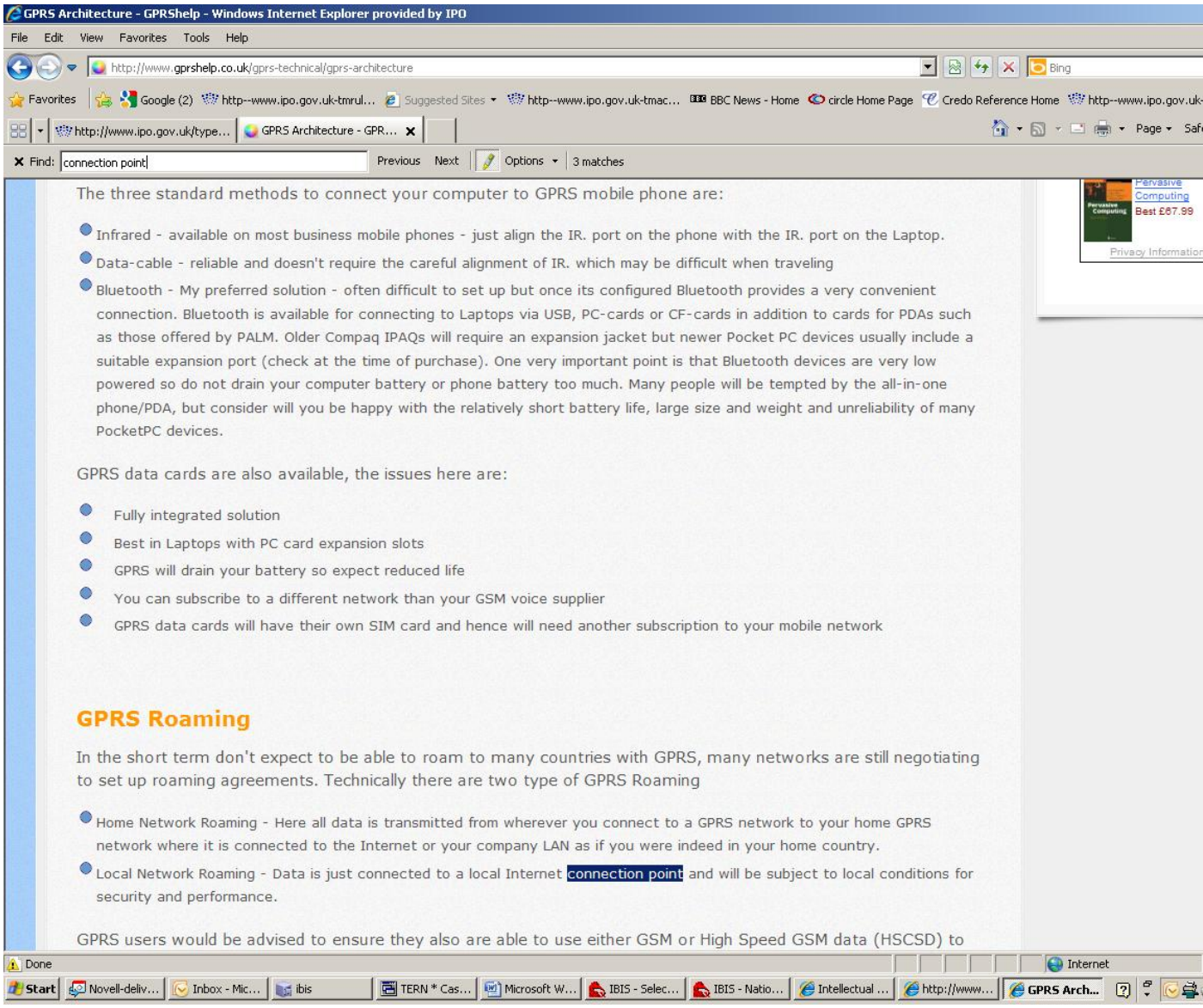
Dated the 22nd of August 2012

Bridget Whatmough
For the Registrar
The Comptroller-General

APPENDIX

Annex 1

Website found at **www.gprshelp.co.uk/gprs-technical/gprs-architecture**

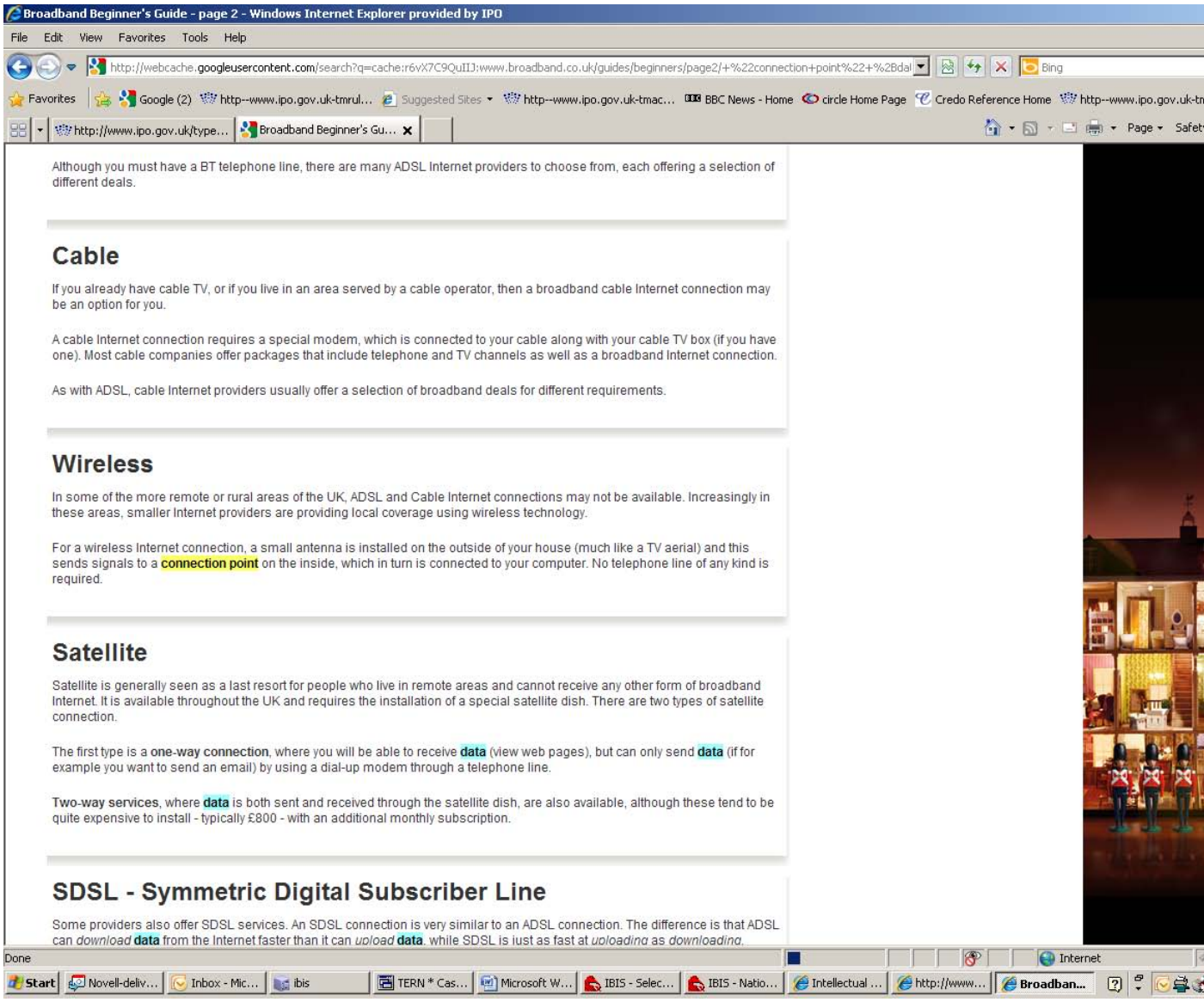


Annex 2

Website found at **www.orbital.net/hosting_services/colocation.php**

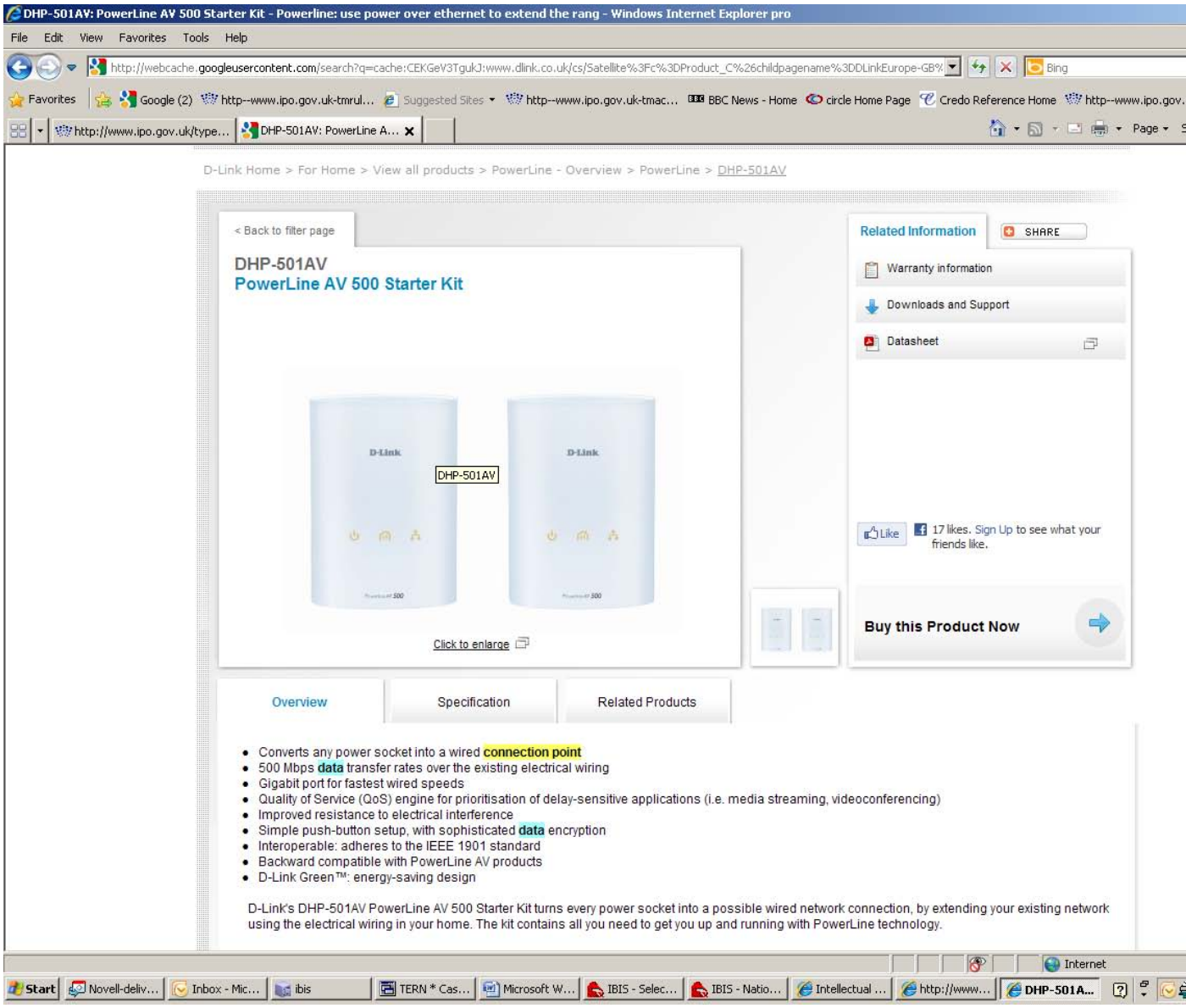
Annex 3

Website found at **www.broadband.co.uk/guides/beginners/page2/**



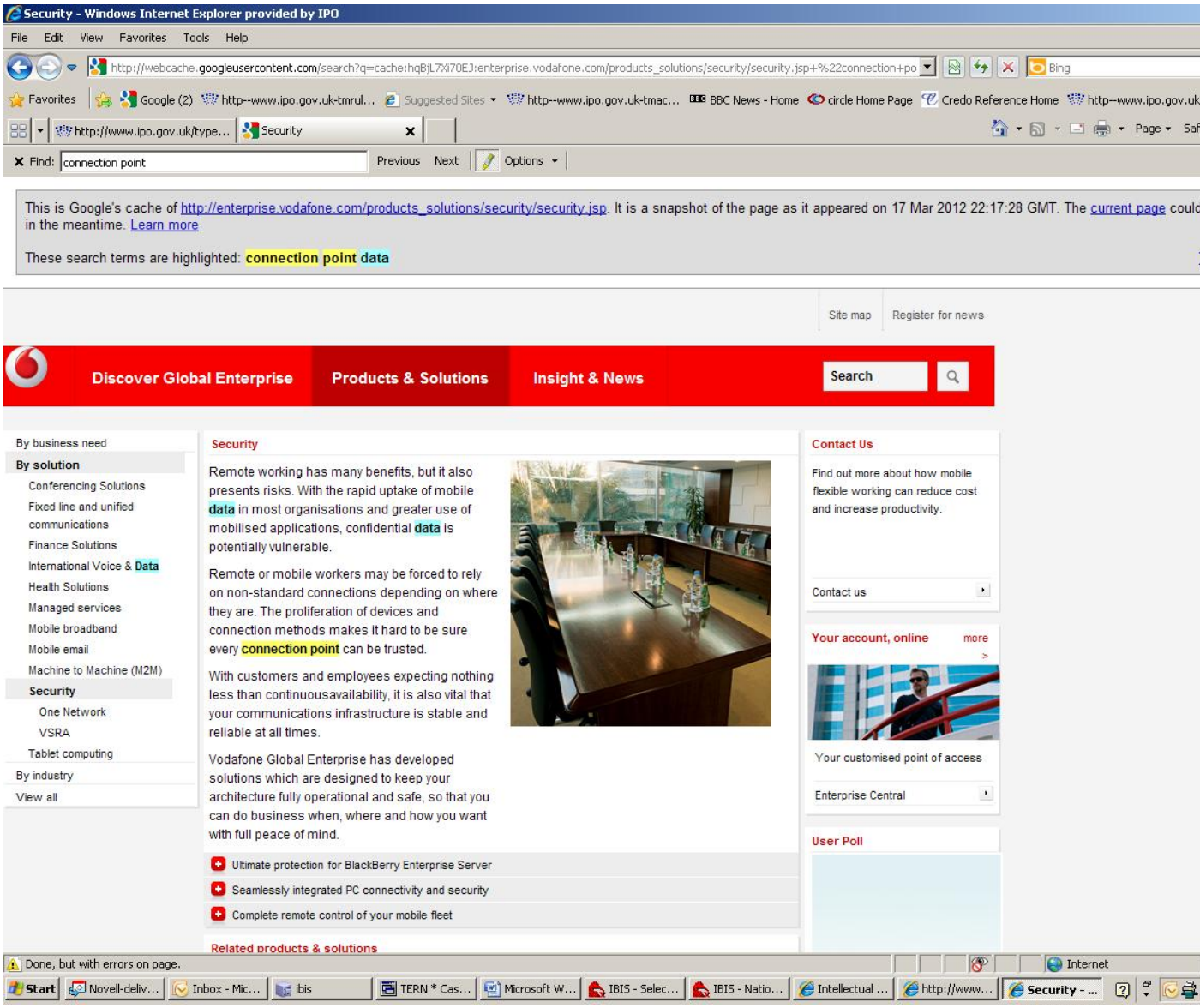
Annex 4

Website found at:
http://www.dlink.co.uk/cs/Satellite?c=Product_C&childpagename=DLinkEurope-GB%2FDLProductCarouselMultiple&cid=1197390818548&p=1197318962342&packedargs=locale%3D1195806691854&pagename=DLinkEurope-GB%2FDLWrapper



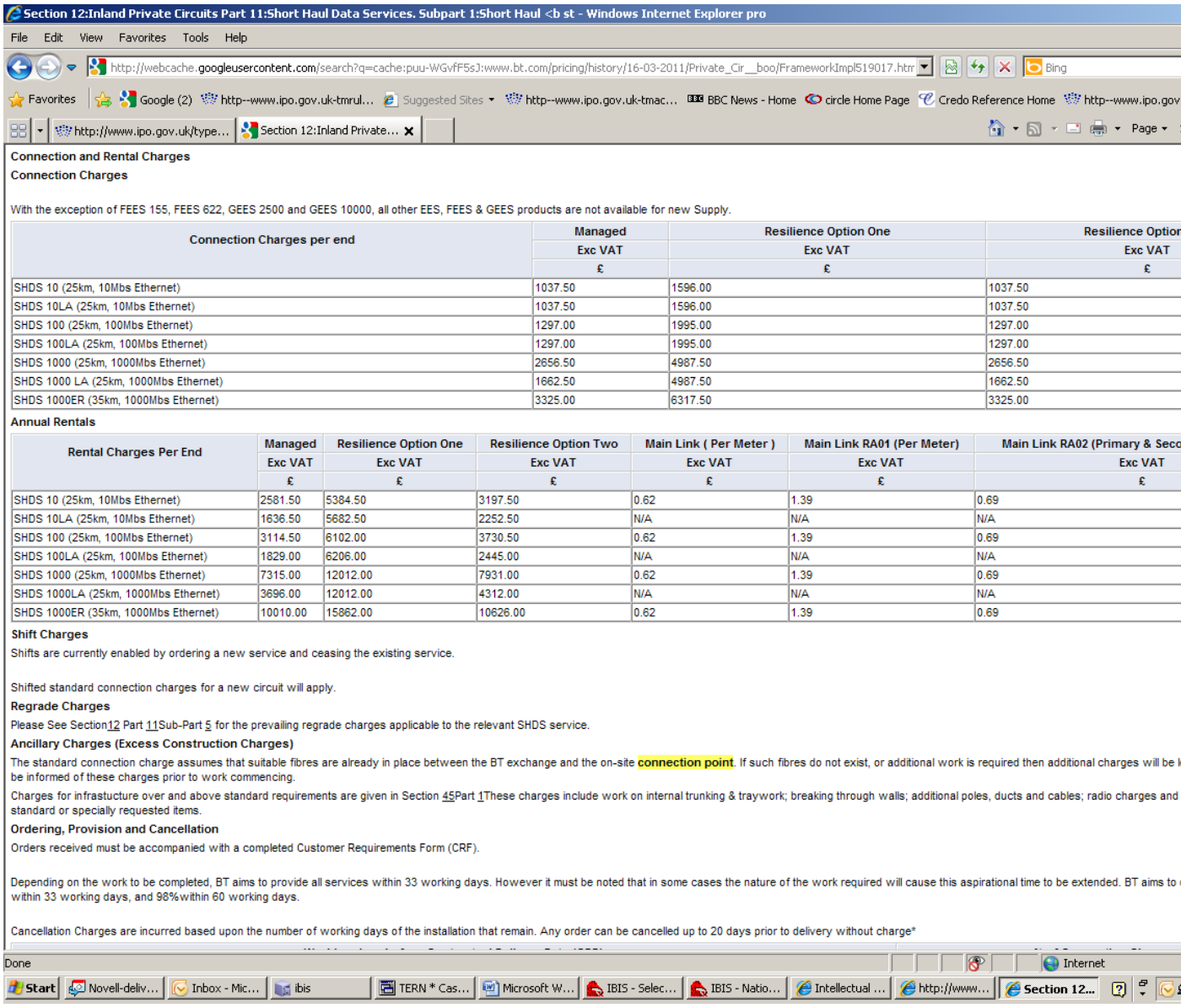
Annex 5

Website found at:
www.enterprise.vodafone.com/products_solutions/security/security.jsp#expander1



Annex 6

Website found at **www.bt.com/pricing/history/16-03-2011/PrivateCirboo/FrameworkImpl519017.htm**



Section 12:Inland Private Circuits Part 11:Short Haul Data Services. Subpart 1:Short Haul <b st - Windows Internet Explorer pro

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http://webcache.googleusercontent.com/search?q=cache:puu-WGvFF5sJ:www.bt.com/pricing/history/16-03-2011/Private_Cir__boo/FrameworkImpl519017.htm

Favorites Google (2) http--www.ipo.gov.uk-tmrul... Suggested Sites http--www.ipo.gov.uk-tmac... BBC News - Home circle Home Page Credo Reference Home http--www.ipo.gov

http://www.ipo.gov.uk/type... Section 12:Inland Private...

Page

Connection and Rental Charges

Connection Charges

With the exception of FEES 155, FEES 622, GEES 2500 and GEES 10000, all other EES, FEES & GEES products are not available for new Supply.

Connection Charges per end	Managed	Resilience Option One	Resilience Option
	Exc VAT	Exc VAT	Exc VAT
	£	£	£
SHDS 10 (25km, 10Mbs Ethernet)	1037.50	1596.00	1037.50
SHDS 10LA (25km, 10Mbs Ethernet)	1037.50	1596.00	1037.50
SHDS 100 (25km, 100Mbs Ethernet)	1297.00	1995.00	1297.00
SHDS 100LA (25km, 100Mbs Ethernet)	1297.00	1995.00	1297.00
SHDS 1000 (25km, 1000Mbs Ethernet)	2656.50	4987.50	2656.50
SHDS 1000 LA (25km, 1000Mbs Ethernet)	1662.50	4987.50	1662.50
SHDS 1000ER (35km, 1000Mbs Ethernet)	3325.00	6317.50	3325.00

Annual Rentals

Rental Charges Per End	Managed	Resilience Option One	Resilience Option Two	Main Link (Per Meter)	Main Link RA01 (Per Meter)	Main Link RA02 (Primary & Seco
	Exc VAT	Exc VAT	Exc VAT	Exc VAT	Exc VAT	Exc VAT
	£	£	£	£	£	£
SHDS 10 (25km, 10Mbs Ethernet)	2581.50	5384.50	3197.50	0.62	1.39	0.69
SHDS 10LA (25km, 10Mbs Ethernet)	1636.50	5682.50	2252.50	N/A	N/A	N/A
SHDS 100 (25km, 100Mbs Ethernet)	3114.50	6102.00	3730.50	0.62	1.39	0.69
SHDS 100LA (25km, 100Mbs Ethernet)	1829.00	6206.00	2445.00	N/A	N/A	N/A
SHDS 1000 (25km, 1000Mbs Ethernet)	7315.00	12012.00	7931.00	0.62	1.39	0.69
SHDS 1000LA (25km, 1000Mbs Ethernet)	3696.00	12012.00	4312.00	N/A	N/A	N/A
SHDS 1000ER (35km, 1000Mbs Ethernet)	10010.00	15862.00	10626.00	0.62	1.39	0.69

Shift Charges

Shifts are currently enabled by ordering a new service and ceasing the existing service.

Shifted standard connection charges for a new circuit will apply.

Regrade Charges

Please See Section12 Part 11Sub-Part 5 for the prevailing regrade charges applicable to the relevant SHDS service.

Ancillary Charges (Excess Construction Charges)

The standard connection charge assumes that suitable fibres are already in place between the BT exchange and the on-site connection point. If such fibres do not exist, or additional work is required then additional charges will be l be informed of these charges prior to work commencing.

Charges for infrastucture over and above standard requirements are given in Section 45Part 1These charges include work on internal trunking & traywork; breaking through walls; additional poles, ducts and cables; radio charges and standard or specially requested items.

Ordering, Provision and Cancellation

Orders received must be accompanied with a completed Customer Requirements Form (CRF).

Depending on the work to be completed, BT aims to provide all services within 33 working days. However it must be noted that in some cases the nature of the work required will cause this aspirational time to be extended. BT aims to within 33 working days, and 98%within 60 working days.

Cancellation Charges are incurred based upon the number of working days of the installation that remain. Any order can be cancelled up to 20 days prior to delivery without charge*

Done Internet

Start Novell-deliv... Inbox - Mic... ibis TERN * Cas... Microsoft W... IBIS - Selec... IBIS - Natio... Intellectual ... http://www... Section 12...

Annex 7

Website found at **www.lloyds.com/The-Market/Operating-at-Lloyds/Exchange/What-is-the-Exchange**