

O-114-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2595345  
IN THE NAME OF THE SELECT AND PROTECT PROGRAM  
FOR THE TRADE MARK



IN CLASS 36

AND

OPPOSITION THERETO  
UNDER NO 102899  
BY TOTEMIC LIMITED

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### IN CLASS 36 AND OPPOSITION THERETO UNDER NO 102899 BY TOTEMIC LIMITED

#### Background

1. On 22<sup>nd</sup> September 2011 The Select & Protect Program Limited Maitland House, Warrior Square, Southend on Sea, Essex, SS1 2AA applied for the following trade mark:



for the following services in class 36:

“Insurance services; domestic, buildings and contents insurance services; insurance brokerage services; insurance underwriting services; claim negotiation services; all of the above services being provided electronically, on-line, by telecommunications, through the Internet, by post, by personal placement or otherwise”.

2. The application was published in the Trade Marks Journal on 21 October 2011.
3. On 16<sup>th</sup> December 2011 Totemic Limited, Kempton House, Kempton Way, Dysart Road, Grantham, Lincolnshire NG31 7LE (“Totemic”) filed notice of opposition. The grounds were then set out as:
  - s. 3(1)(b) of the Trade Marks Act 1994 (as amended) (the “Act”) in that the mark was devoid of any distinctive character: the words “cover my world” are asserted to be completely descriptive in relation to insurance services and the device matter in the sign commonplace;

- s. 3(1)(c) in that the applicant's trade mark consists exclusively of a sign or indication which may serve in the trade to designate the kind, quality or other characteristics of the services for which the mark is filed. In particular, the mark indicates that the "cover" or "insurance" being provided is intended to deal with the potential risks in the policy holder's own world, whether home, vehicle, health or holiday. The inclusion of a circular device is insufficient to give the mark any identity beyond the bald statement of the services being provided;
- s. 3(1)(d) in that the mark consists exclusively of a sign or indication which has become customary in the current language or in the bona fide and established practices of the trade;
- s 5(2)(b) in that the mark applied for is similar to the opponent's Community Trade Marks:



No. E8905614



No. E9001629

and is sought to be registered in relation to services identical to those of the opponent, to the extent that there exists a likelihood of confusion on the part of the public.

All the services in class 36 are opposed, on the basis of identity with the applicant's service as specified with the above registrations, in Class 36: "Insurance; financial affairs; monetary affairs; real estate affairs".

4. The applicant denies all the grounds.
5. Both parties filed submissions and neither requested to be heard. This decision follows a careful consideration of all the submitted papers.

## Preliminary point

6. There was some confusion over the grounds eventually settled on as final pleadings in this case.
7. Following the exchange of statement and counterstatement, the opponent submitted a Witness Statement (dated 25<sup>th</sup> June 2012), sworn by Helen Barbara Thomas-Peter, a trade mark attorney, employed by Walker Morris Solicitors, the opponent's representative. This clearly states that the grounds of opposition under s. 3(1)(b) and (c) are withdrawn. However, a section of this Statement entitled "Section 3(1)(c)" includes arguments in relation to that ground.
8. The applicant responded in submissions dated (and received by the Office on) 28<sup>th</sup> August 2012. These noted the withdrawn grounds, stating that only s. 3(1)(d) and s. 5(2)(b) remained. It was also noted that "... the witness statement goes on apparently to discuss section 3(1)(c)" (though not the s. 3(1)(b) ground).
9. Following correspondence from the IPO, a "corrected" copy of the opponent's Witness Statement was received by the IPO on 5<sup>th</sup> September 2012, in which the mention of the withdrawal of s. 3(1)(b) was changed to section 3(1)(d) as being withdrawn. But the withdrawal of s. 3(1)(c) remained. This further error was corrected in a letter from the opponent dated 17<sup>th</sup> September 2012, which finally made the position clear: s. 3(1)(b) and (c) were maintained and s. 3(1)(d) withdrawn.
10. The applicant's view of this confusion is set out in their final written submissions, dated 1<sup>st</sup> November 2012 (¶4ff):

"The Registrar has expressed no view as to the admissibility of these alterations, nor which basis is to be considered. However, given the timing that the changes were made (i.e. after the Applicant's last opportunity for comment), it is the Applicant's view that it is wholly unacceptable for the Opponent to now expect the opposition to proceed on any Section 3 grounds other than 3(1)(d). They categorically withdrew the opposition based under Sections 3(1)(b) and 3(1)(c) thus requiring the Applicant to respond to the grounds under Section 3(1)(d). To then subsequently suggest that, in fact, the opposition is withdrawn under Section 3(1)(d) and remains in respect of 3(1)(b) and (c) is inappropriate. Such a position, if allowed, is diametrically opposed to the position as set out in the Opponent's witness statement, and a position upon which the Applicant has had no opportunity to respond or make proper submissions or submit evidence.

In the present circumstances it is procedurally inappropriate for the Registrar to consider the opposition under Section 3(1)(b) or (c) as any other circumstances would place the Applicant under a procedural inequity that could only lead to a necessity to appeal".

11. I note that Tribunal Practice Notice (2/2011): “Case management of *inter partes* proceedings: efficient, fair and less costly resolution of disputes before the Trade Marks Tribunal”. This sets out the general principle that:

“There is a public interest in resolving disputes before the Tribunal efficiently and within a predictable timescale. Swift and effective determination of cases not only creates certainty for third parties but reduces the burden of litigation and the accompanying costs for the parties involved. Furthermore, drawn-out proceedings which become unnecessarily complicated or sidetracked affect the resources which the Tribunal is able fairly to allocate to other users”.

12. It seems to me that I have three choices:

1. Do not consider the grounds under s. 3(1)(b) and/or (c) as the applicant requests;
2. Consider that the opponent made an obvious error, allow in these grounds and give the applicant time to respond; or
3. Consider that the opponent made an obvious error, allow in these grounds, and go on to make a final determination without the benefit of the applicant’s fullest submissions.

13. I have no doubt that the starting point for the applicant would be that it was the opponent that initiated the opposition and they should have been crystal clear about the grounds on which it was based.

14. There is weight to this point: it is obvious that the opponent’s representatives were careless in making the error and then compounded it by repeating, more or less, the same mistake. Nevertheless, I don’t think the opponent should be punished by the sloppiness of its legal representation in this case, and I think I am being fairest to both parties by leaving the grounds in and following option (3) above, for the following reasons.

15. First, given that the opponent included a detailed discussion of s. 3(1)(c) in its submissions, the contradiction between the latter and the stated withdrawal should have raised possibility of a genuine error in the mind of the applicant whose response should have been write to the Office and the applicant for clarification. Or, alternatively “cover all bases” in its own submissions. This latter option seems to have been what the applicant did in practice, given that its reply to the opponent’s submissions contained some rather astute comments on the putative s. 3(1)(c) ground. In fact, there were no substantive submissions on the only s. 3 ground the applicant maintains remains – that under s. 3(1)(d).

16. Second, the applicant was aware of correspondence from the Registrar pointing out the error (in a letter sent to the opponent, but copied to applicant) dated 30<sup>th</sup> August 2012.

17. Next, were I to refuse to consider these grounds, it seems to me that this invites an appeal by the opponent, as I will have failed to consider two thirds of its entire extant case against registration, on the basis of an obvious error. To take such a course would, in my opinion, be to run the risk that such grounds would

be returned to in subsequent action, leading to increased cost and uncertainty for the parties and third parties. This would be counter to the overriding principle set out in TPN 2/2011 cited above.

18. Next, there is a wider interest than that of the opponent: the case law is clear, particularly in relation to s. 3(1)(c), that there is a public interest element in the refusal of trade marks that do not pass legal muster, and I think I must consider this, in the mix, in coming to a decision on this issue.
19. Finally, in following my chosen option I could be criticised for not allowing the applicant to make its case. In the light of my findings under these grounds, I suspect the applicant will be sanguine about that.
20. It might be argued that it would be fairer to allow in the deleted pleadings and give the applicant the opportunity to make fuller submissions on the s. 3(1)(b) and (c) grounds (option 2 above). Of course, it might be that the latter could have, given the opportunity, penned some “killer” point I missed, such that the opponent, unconvinced by my reasoning alone, and teetering on the verge of appeal, would have been stunned into non-appellant acquiescence. I think, in the context of procedural economy, I am prepared to take that risk. Anyhow, as I have already pointed out that the applicant has not been silent on the issues raised under s. 3(1)(b) and (c) (in, at least, its Counterstatement).
21. In summary, I am going to follow option (3) above, for the following reasons:
  1. the technical nature of the position adopted by the applicant;
  2. the absence of clearly identified prejudice suffered by either party in deciding the section 3(1)(b) and (c) grounds; and
  3. both parties positions regarding these grounds have been amply made clear in the Statement of Grounds, the Counterstatement and in the parties’ submissions.

### **Summary of evidence**

22. The only evidence is from the opponent, and this is contained in the Witness Statement (dated 25<sup>th</sup> June 2012), sworn by Helen Barbara Thomas-Peter, a trade mark attorney, employed by Walker Morris Solicitors. This is a mixture of submission and some material evidence. The former is considered in the text that follows; the latter I briefly summarise here.
23. Exhibit HTP01 includes definitions of the word “cover” and “world” from the Online Oxford Dictionary. These are discussed in paragraphs 31 below.
24. The opponent states that its trade marks are almost exclusively used on line by a subsidiary of the Opponent. Exhibit HTP02 shows “screenshots” of the websites [www.covermyboat.co.uk](http://www.covermyboat.co.uk) and [www.covermytravels.co.uk](http://www.covermytravels.co.uk) on which the Opponent’s marks are displayed. The latter is from the Internet Archive dated. There are no archive pages for the former. Finally, Exhibit HTP03 contains the search results of the FSA Register of companies trading under variants of COVER MY. This is evidence of the opponent’s notification to the FSA of its

“current and potential use of the COVER MY BOAT, COVER M BUSINESS, COVER MY HOME, COVER MY TRAVELS and COVER MY WHEELS.

## Decision

25. Opposition is based on grounds under the provisions of section 3 of the Act, the relevant sections of which state:

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

a)....

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 characteristic of goods or services,

d)...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b)(c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

## Section 3(1)(b) and (c) of the Act

26. The law on these sub-sections of the Act (that is, on the identical provisions mirrored in Council Regulation (EC) No 207/2009 on the Community trade mark, Art. 7(1)(c) and (b)) was recently set out in some detail in *Starbucks (HK) Limited v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch)<sup>1</sup>, a judgement of the High Court in the UK. I have cited this judgment in detail here, as it provides a comprehensive review of case law, not just on the relevant legal provisions, but on “mixed” device and word marks, which is particular pertinent to this case:

“90. The principles to be applied under Article 7(1)(b) of the CTM Regulation were conveniently summarised by the Court of Justice of the European Union in Case C-265/09 P *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* [2010] ECR I-8265 as follows:

„29. ... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v. OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

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<sup>1</sup> <http://www.bailii.org/ew/cases/EWHC/Ch/2012/3074.html>.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v. OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v. OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v. OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v. OHIM*, paragraph 25; *Henkel v. OHIM*, paragraph 35; and *Eurohypo v. OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v. OHIM* [2004] ECR I-10107, paragraph 78; *Storck v. OHIM*, paragraph 26; and *Audi v. OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P and C-474/01 P *Procter & Gamble v. OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v. Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v. OHIM*, paragraphs 36 and 38; and *Audi v. OHIM*, paragraph 37).

34. In that regard, the Court has already stated that difficulties in establishing distinctiveness which may be associated with certain categories of marks because of their very nature – difficulties which it is legitimate to take into account – do not justify laying down specific criteria supplementing or derogating from application of the criterion of distinctiveness as interpreted in the case-law (see *OHIM v. Erpo Möbelwerk*, paragraph 36, and *Audi v. OHIM*, paragraph 38).

...

37. ... it should be pointed out that, even though it is apparent from the case-law cited that the Court has recognised that there are certain categories of signs which are less likely prima facie to have distinctive character initially, the Court, nevertheless, has not exempted the trade mark authorities from having to carry out an examination of their distinctive character based on the facts.

...



45. As is clear from the case-law of the Court, the examination of trade mark applications must not be minimal, but must be stringent and full, in order to prevent trade marks from being improperly registered and, for reasons of legal certainty and good administration, to ensure that trade marks whose use could be successfully challenged before the courts are not registered (see, to that effect, *Libertel*, paragraph 59, and *OHIM v Erpo Möbelwerk*, paragraph 45).’

91. The principles to be applied under Article 7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in Case C-51/10P *Agencja Wydawnicza Technopol sp. z o.o. v OHIM* [2011] ECR I-0000, [2011] ETMR 34 as follows:

„33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), see, by analogy, Case C-265/00 *Campina Melkunie* [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 30, and the order in Case C-150/02 P *Streamserve v OHIM* [2004] ECR I-1461, paragraph 24).

...

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, *inter alia*, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 45, and Case C-48/09 P *Lego Juris v OHIM* [2010] ECR I-0000, paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in Case C-80/09 P *Mergel and Others v OHIM*, paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 58). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

...

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No 40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms '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', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily

recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).'

92. In addition, a sign is caught by the exclusion from registration in Article 7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see Case C-191/01 P *OHIM v Wm Wrigley Jr Co* [2003] ECR I-12447 at [32] and Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619 at [97].

93. Counsel for PCCW relied upon two other authorities. First, Case C-273/05 P *OHIM v Celltech R&D Ltd* [2007] ECR I-1912, in which the CJEU stated at [81]:

„In this case, it must be held that the Court of First Instance properly assessed the descriptive character of the mark CELLTECH considered as a whole and concluded that it was not established that the mark, even understood as meaning 'cell technology', was descriptive of the goods and services referred to in the application for registration. Therefore, it did not infringe Article 7(1)(c) of Regulation No 40/94.'

94. Secondly, Case T-207/06 *Europig SA v OHIM* [2007] ECR II-1961, in which the Court of First Instance (now General Court) said at [27]:

„It follows that, for a sign to be caught by the prohibition set out in [Article 7(1)(c)], 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 *PAPERLAB*, paragraph 25, and the case-law cited there).'

95. I do not see any real difference between these statements of principle and those in *Technopol*, in particular at [50], and if there is a real difference it is the latter that should be given effect to. Nevertheless, I am content to proceed on the basis urged upon me by counsel for PCCW, namely that *Celltech* emphasises the need for evidence except in clear cases and that *Europig* emphasises the need for a sufficiently direct and specific relationship between the sign and the goods or services concerned.

96. Questions can arise as to whether a sign contains visual content sufficient to prevent it from consisting “exclusively” of subject matter within the scope of Article 7(1)(c). Counsel for Sky reminded me that that the CJEU referred in its judgment in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH v. Boots- und Segelzubehör*

*Walter Huber* [1999] ECR I-2779 at [25] to the need to apply Article 7(1)(c) effectively so as to keep descriptive signs free for use by all “including as collective marks or as part of complex or graphic marks”. Accordingly, he submitted that a sign remains objectionable under Article 7(1)(c) if it is basically descriptive by reason of the visual (and hence aural and conceptual) dominance of the wording it contains, even if it contains some other visual content. An example of a case where this approach was adopted is *Hormel Foods Corp v Antilles Landscape Investments NV* [2005] EWHC 13 (Ch), [2005] RPC 28 where the following sign was held to be objectionable under the equivalent of Article 7(1)(c) in respect of “computer programming”:



97. As counsel for Sky acknowledged, however, an alternative approach which both European and national courts have frequently adopted is to say that such a sign is free from objection under Article 7(1)(c), but caught by Article 7(1)(b). Examples of cases where this approach was adopted include the following:

- i) “CYCLING IS...” *Trade Mark Applications* [2002] RPC 37, where the following signs were found to be unregistrable under the equivalent of Article 7(1)(b) for lack of distinctiveness in respect of goods related to cycling:

“Cycling IS ...”

“Cycling  
IS ...”

- ii) *QUICK WASH ACTION Trade Mark* (BL O/205/04, 30 April 2004), where the following sign was found to be unregistrable for various fabric and laundry-related chemicals and preparations in Classes 1 and 3 under the equivalent of Article 7(1)(b):



iii) Case C-37/03 P *BioID v OHIM* [2005] ECR I-7975, where the following sign was held to be unregistrable under Art 7(1)(b) for lack of distinctiveness in relation to goods and services of the kind specified by the applicant in Classes 9, 38 and 42:

**BioID<sup>®</sup>**

iv) *SUN RIPENED TOBACCO Trade Mark* (BL O-200-08, 4 July 2008) where the following sign was found to be unregistrable for 'Cigarettes, tobacco, tobacco products, smokers' articles, lighters, matches' in Class 34 under the national equivalent of Article 7(1)(b) because it was permeated by the message of the descriptive wording it contained:



v) Case C-92/10 P *Media-Saturn-Holding GmbH v OHIM* [2011] ECR I-0002, where the following sign was held to be unregistrable under Article 7(1)(b):



27. Based on this exposition, it is clear that in order for the application to succeed under section 3(1)(c) there must be a “sufficiently direct and specific relationship” between trade mark and the goods and services for which it is protected such as “to enable the public concerned immediately to perceive, without further thought, a description of the goods in question or one of their characteristics”.

28. For the application to succeed in respect of the objection brought under section 3(1)(b) I must find the mark to be non-distinctive (as in unpossessed of distinctive character) first, “by reference to the goods or services listed in the specification and, secondly, by reference to the perception of the mark in relation to such goods or services by the relevant public, which consists of average consumers of the goods or services in question.”

### **Section 3(1)(c)**

29. The mark is a mixed word and device mark that consists of a number of elements: the words COVER MY WORLD, with the latter two words imposed on a circle MY being above WORLD. There is a slight shadowing effect below the circle. Also superimposed in the circle is a large “mouse pointer” arrow between the L and D of WORLD. Though the mark is depicted in blue, I think this makes little difference to the distinctiveness of the sign: most trade marks are used in colours and blue is no more distinctive than red, green, yellow or any other colour.

30. The phrase MY WORLD is used in common parlance as a reference to the totality of the existential experience of an individual that might consist of a range of “things” of personal importance – family, career, possessions, interests, philosophy, religion – all of which add up to the “world” that individual knows and might wish to preserve.

31. The opponent establishes, via dictionary definitions, that the word “cover”, in the context of insurance, has the meaning to “protect against a liability, loss or accident involving financial consequences”. Consequently, the opponent submits that the phrase “cover my world” means nothing more than “protecting ones life and activities against liabilities, losses or accidents involving financial consequences”.

32. I think it is a moot point that this would be the conclusion the average consumer would come to “immediately ... without further thought”. Though I note the meaning “my world” indicated above, it seems to me that the phrase “cover my world” as a whole has a certain idiosyncrasy when used in relation to insurance. For example, not everything in “my world” can be insured. In my view, the meaning is sufficiently vague to be only allusive and therefore not caught by s. 3(1)(c).

33. However, there are also the figurative elements of the sign. The applicant refers to the Registry work manual:

“In determining whether a trade mark consists *exclusively* of a designation of the goods/services, differences of a kind which may go unnoticed by an average consumer, will be discounted entirely. The presentation of a descriptive trade mark in a graphical form which corresponds to common forms of presenting descriptions in trade, such as the use of a colour or a simple border, is unlikely of itself to be sufficient to resist an objection under section 3(1)(c)”.

That is, in the words of *STARBUCKS* cited above, a sign will attract a s. 3(1)(c) objection if it is "...basically descriptive by reason of the visual (and hence aural and conceptual) dominance of the wording it contains, even if it contains some other visual content". It seems to me that the figurative elements of the sign add up to more than the latter: the application is not "exclusively" a description, even if the words are taken to be more or less exactly that.

### **The ground under s. 3(1)(c) accordingly fails**

#### **Section 3(1)(b)**

34. *STARBUCKS* pointed out the alternative approach which both European and national courts have frequently adopted – that a sign is free from objection under Article 7(1)(c), but caught by Article 7(1)(b).
35. In my view, this is not a case in which the "... figurative figleaf of distinctiveness" (*STARBUCKS*, ¶117) is at work. All the signs cited in ¶97 of the latter judgment were refused registration. Key to those refusals was either the interaction between the words and the device elements (*QUICK WASH ACTION* and *SUN RIPENED TOBACCO*) or the figurative additions were of such simplicity as to be insufficient to overwhelm the message of the words (*BIOID* and *MEDIA-SATURN-HOLDING GMBH*) – such that they could not, "... take a step up out of the morass of non-distinctive material" (¶8-048, *Kerly's Law of Trade Marks and Trade Names*, 14<sup>th</sup> Edition).
36. I don't think that is the case here. The opponent's analysis of this sign refers to "... the device of a simple circle" as being "commonplace", and "... the faint shadow beneath the circle does not add anything to the character or identity of the mark". Then there is the arrow "computer mouse pointer". As to the latter, the opponent's representative, based on their own experience of using a computer and viewing the mark on a VDU, "... completely failed to see it was part of the Applicant's mark".
37. As the opponent pointed out, this is no evidence of how the average consumer would react and it seems to me that the "worst" one can say about the arrow is that it might be taken by the relevant consumer as an indication that the sign represents a hyperlink. Aside from the obvious comment that any use of the mark on anything other than a website distances the observer from this meaning, it also seems to me that even use on a website does not reduced the interaction of the consumer to one of "taking no mind" of this element of the mark.
38. Beyond that, the mark arrow might perceived to be "informational" in that it suggests the applicant's business is conducted on line. This amounts to something "allusional" and if I were the applicant I would be saying that this seems like a characteristic of a good, operative trade mark, and not a non-distinctive sign.
39. In my view, the opponent has carried out an excision of the applicant's sign and has failed to consider the impact of the sign as a whole. If one does this,

whatever debate one might have about the component parts, my first and lingering impression is that this sign maps back to a particular business, and thus passes muster under s. 3(1)(b).

### **The ground under s. 3(1)(b) accordingly fails**

#### **Section 5(2)(b)**

40. A decision of the Registrar (*Virgin Enterprises v Bodtrade* BL O/216/09) („Virgin Enterprises’), approved of by the Appointed person and High Court (see *La Chemise Lacoste SA v Baker Street Clothing Ltd* (BL O/333/10) and *Och-Ziff Management Europe Ltd v Och Capital LLP* [2010] EWHC 2599 (Ch)) cites the following case law on s. 5(2)(b):

*Sabel BV v Puma AG* C-251/95;  
*Canon Kabushiki v Metro-Goldwyn-Mayer* C-39/97;  
*Lloyd Schuhfabrik v Klijsen Handel B.V.* C-342/97;  
*Marca Mode CV v Adidas* C-102/07;  
*Matratzen Concord GmbH v OHIM* T-6/01;  
*Medion AG v. Thomson Multimedia Sales* C-120/04; and  
*Shaker di L. Laudato v OHIM* C-334/05.

41. Based on this case law, *Virgin Enterprises* sets out the following principles:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors (*Sabel BV v Puma AG*);
- (b) the matter must be judged through the eyes of the average consumer of the services in question; (*Sabel BV v Puma AG*), who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind (*Lloyd Schuhfabrik v Klijsen*);
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*);
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*), but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements (*Shaker v OHIM*);
- (e) nevertheless, the overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components (*Matratzen v OHIM*);
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark (*Medion v. Thomson*);



- (g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa (*Canon Kabushiki v Metro-Goldwyn-Mayer*);
- (h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it (*Sabel BV v Puma AG*);
- (i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2) (*Sabel BV v Puma AG*);
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense (*Marca Mode v Adidas AG*); and
- (k) if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section (*Canon Kabushiki v Metro-Goldwyn-Mayer*).

42. Some of the factors above are more relevant to the comparison of these particular marks than others. I will briefly consider these now.

### **Average Consumer**

43. The average consumer in this case is an ordinary member of the public who buys insurance – so this includes all of us. A subdivision of the latter - which I suspect these days forms a majority – will be those consumers that purchase insurance on line, probably using price comparison websites (point (b)). This is not a casual purchase, as insurance can cost hundreds of pounds, and thus attracts a reasonably high degree of attention on behalf of consumers.

### **Comparison of goods and services**

44. The opponent's marks specify, *inter alia*, "insurance" – this term would cover all the applicant's services and so the services are identical.

### **Comparison of marks and Likelihood of Confusion**

45. Placing side by side the marks at issue:



46. A summary of the opponent's contentions are as follows:

- The opponent's marks are used "... almost exclusively on line by Payplan Financial Services Ltd which is a subsidiary of the Opponent" (Statement Thomas-Peter, ¶10);
- There are websites addressed: [www.covermyboat.co.uk](http://www.covermyboat.co.uk) and [www.covermytravels.co.uk](http://www.covermytravels.co.uk);

- An extract from the FSA register (Statement Thomas-Peter, Exhibit HTP03) where Payplan Financial Services Ltd have notified the FSA of its “current or potential use” of Cover My Boat, Cover My Business, Cover My Home, Cover My Travels, Cover My Travels, Cover My Wheels;
- The opponent states that the marks applied for are visually, phonetically and conceptually similar and that “... the average consumer who searches the internet comparing quotes for insurance policies is likely to assume that COVERMYWORLD is part of the same family of marks as COVERMYBOAT; and
- Finally, the opponent cites much the same case law as above and some of the same principles.

47. There is no actual comparison of the marks themselves in the Witness Statement, but the opponent argued in its Notice of Threaten Opposition that by:

“Virtue of the identity of the initial two words “COVER MY” and because the non-distinctive final words, “WORLD” and “BOAT”/“TRAVELS” respectively, serve only to indicate what is being insured or covered and visually the marks have the prominent words COVER MY in common and share the colour blue. Conceptually both marks mean the same”.

48. When considered as a whole (point (c), page 16) the marks actually share little similarity. As the applicant states: “... the opponent’s case rests on ignoring all the differences that exist between the marks and pretending that the common element is all that matters in this case”. I note and re-quote point (d) above:

“... the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*), but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements (*Shaker v OHIM*)”.

49. In this context, I refer to the figurative elements in the respective signs, which are entirely different. Indeed, it seems to me that the registrability of the opponent’s marks depends on those figurative elements. This statement is based on my belief that the words “cover my” *solus* have no trade mark value *per se*. One could argue that they retain a certain eccentricity given that they create an element of disruption in “processing fluency” by virtue of ellipsis and because the cover is possessively the insured (“MY cover”) as opposed to that provide by the insurer (“your cover”). If this was case, the opponent’s contentions might be strengthened – bringing into consideration “indirect confusion”, as set out (for example) in *LA SUGAR* (see BL O/375/10, ¶15ff).

50. However, I don’t think this arises, largely because the words “cover my” are additionally conceptually defined by the word(s) to which they are joined. The independent quirkiness of “cover my” changes meaning when prefacing words like “boat” or “travels” as compared to “world”. This conceptually distances the latter from the words in the opponent’s marks. And this aside from the figurative differences already mentioned.

51. In summary, the marks may share certain words, but those words are negligible in a trade mark sense – a consumer will not take them as an indication of commercial origin in context, but commercial offering – relying on the impression of the marks as a whole, and the effect of that bespeaks difference not similarity.

52. I have given some thought to the principle in point (k) above, given that the opponent refers to both its registrations and states that the average consumer is likely to assume that the applicant's mark is: "... part of the same family of marks as COVERMYBOAT and COVERMYTRAVELS". I note the following from of // *Ponte Finanziaria SpA v OHIM Case 234/06*, ¶64:

"As the Advocate General stated in point 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family or series', the earlier trade marks which are part of that 'family' or series' must be present on the market".

There must be use of a sufficient number of trade marks to elicit the family of trade marks effect on consumers. The evidence set out by the opponent and summarised previously (¶22ff and ¶46) does not show this. The only material showing marketplace presence before the filing date applies to the mark COVER MY TRAVELS and even this does not indicate the extent to which the that sign came to the attention of the relevant public. I cannot find there is a family of trade marks effect in this case.

53. Finally, I think my finding in relation to a lack of confusion between these rights is strengthened by the fact that the services at issue are not cheap, which means consumers will give them a fair degree of scrutiny before parting with their hard earned cash, increasing the level of attention the marks will draw. This scrutiny is likely to be increased by the process of establishing the extent of cover purchase of insurance attracts.

### **The ground under s. 5(2)(b) fails**

#### **Summary**

54. The opposition fails.

**Costs**

55. As the applicant has been successful in defending its application, it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£400
Submissions	£400
TOTAL	£800

56. I order Totemic Limited to pay The Select & Protect Program Limited the sum of £800. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 12<sup>th</sup> day of March 2013

Bill Trott  
For the Registrar  
The Comptroller-General