

# O-473-15

**IN THE MATTER OF THE TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER 2652075  
BY LEUKAEMIA AND LYMPHOMA RESEARCH  
TO REGISTER THE TRADE MARK 'BEATING BLOOD CANCERS'  
IN CLASSES 9, 16, 21, 25, 26, 35, 36, 41, 42 AND 45**

**IN THE MATTER OF AN APPEAL FROM THE DECISION OF  
MR EDWARD SMITH DATED 11 FEBRUARY 2013**

## DECISION

1. This is an appeal from an *ex parte* decision of Mr Edward Smith, the Hearing Officer for the Registrar, in which he rejected an application to register the mark BEATING BLOOD CANCERS on the basis of s 3(1)(b) of the Trade Marks Act 1994. The Applicant, Leukaemia and Lymphoma Research, appeals, asking me either to overturn the decision altogether or to remit the matter back to the Registry for further consideration. For the reasons given below, I do consider that this is a case which must be remitted to the Registry.

### **Background**

2. On 6 February 2013, the Applicant (a charity, as its name suggests) applied to register the phrase 'BEATING BLOOD CANCERS' as a trade mark for the extensive range of goods and services in classes 9, 16, 21, 25, 26, 35, 36, 41, 42 and 45 shown in Annex A to this decision.
3. The examiner at the IPO initially decided that the application might proceed to registration for the range of goods and services shown in Annex B to this decision. Objection was taken to the rest of the specification under s 3(1)(b) of the 1994 Act.
4. The Applicant requested a hearing, which was held before Mr Smith on 8 July 2013. He indicated his preliminary view at the hearing, and quickly produced a written report, which offered the Applicant an opportunity to consider its options. He was then asked for a full written decision, which is that now under appeal.

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5. The Hearing Officer considered that the examiner had “conflated and confused” the issues to be considered in relation to ss. 3(1)(b) and (c) and had been far too lenient. The essence of his decision was that an objection under section 3(1)(b) arises if a sign is “unpossessed of distinctive character” from the perspective of the average consumer and that may be the case even though the mark does not designate a particular characteristic, or even “vaguely reference” the goods and services in its specification. Mr Smith made clear in [11] of his decision that his refusal to register the mark BEATING BLOOD CANCERS was based only upon s 3(1)(b), and not upon s 3(1)(c) and in his view the objection applied to the whole of the specification.

6. The most salient points of Mr Smith’s decision are:

[11] He referred to the decision of the Appointed Person, Mr Geoffrey Hobbs QC, in ‘*Flying Scotsman*’ [2012] R.P.C. 7, BL O/313/11, as to the distinction between ss. 3(1)(b) and (c).

[12-13] He considered the guidance of the CJEU in Cases C-37/03 *BioID*, C-273/05 *Celltech* and C-329/02 *SAT.1* as to the general interest underlying a s 3 (1)(b) objection (that a mark devoid of distinctive character could not fulfil its essential function of indicating origin).

[15] In the light of Case C-363/99 *Postkantoor* he held that “the question of a mark being devoid of distinctive character is answered by reference to the goods and services applied for, and the perception of the average consumer for those goods or services.”

[17] He noted his obligation to consider whether the objection applied to all of the goods/services, if necessary breaking down the specifications into appropriate categories of goods/services, by reference to Case C-239/05, *BVBA*.

[18] He referred to the approach taken by the Appointed Person, Ms Anna Carboni, in *FeedbackMatters*, BL O/185/12, and said “If a view is taken that, linguistically, a phrase is likely to be ‘devoid’, that is to say ‘unpossessed of distinctive character’ or ‘origin neutral’ for my purposes, it is sometimes (as in this case) very hard to draw any meaningful line whereby it may be ‘origin specific’ in relation to certain (only) goods and services.”

[20] He identified the average consumers of the “huge” specification in issue as the general public, even if some of the services might also be accessed by other businesses, but added that “my final conclusion in this particular case does not turn

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in any event on the identity of the average consumer, and by extension any supposed and especially sensitised aptitude at detecting any trade mark message.”

[22] He said:

“In linguistic terms, the sign comprises three recognisable words, ‘BEATING BLOOD CANCERS’. The phrase comprises an easy to understand and grammatically correct, if slightly elliptical, narrative. Simply stated, the words express a laudable medical objective and nothing more. The words ‘blood cancers’ are plainly and objectively descriptive of a group of cancers affecting the blood. The word ‘beating’ has some informality about it, but nonetheless expresses a desire to, for example, ‘find a cure for’, ‘address the consequences of’, ‘fight’ or otherwise ‘combat’. In terms of the phrase’s inherent linguistic characteristics, in my opinion, it is hard to see exactly what about it as a whole, that could ever, conceivably perform the essential function of a trade mark in the prima facie. It is, to coin a well-known phrase in trade mark circles in the UK, entirely ‘origin neutral’.”

[24-25] The Hearing Officer dismissed the Applicant’s argument that it would be odd to use such a phrase in relation to some of the numerous goods in the specification:

“Even if there is no obvious connection between the phrase ‘BEATING BLOOD CANCERS’ and e.g. vending machines or calculators, this would not, of itself, have the effect of rendering the sign free from objection under section 3(1)(b). In other words, the average consumer would not necessarily reach the conclusion that, because a vending machine has no literal connection with ‘blood cancers’, the phrase must, or at least is apt to, function as a trade mark.

25. The common sense approach to this starts with the inherent linguistic analysis that I have already conducted, but also factors in, for example, recognised patterns of trade and current commercial and cultural mores, of which I can take judicial notice. The point here is that, more so than ever before, charitable and research concerns find themselves operating in a commercial sphere which involves fund raising via means such as e.g. catalogue-based retailing of goods, especially for occasions such as Christmas but also all year round. The average consumer will be very familiar with such practices which are likely to involve the linkage of a charitable message with physical goods. In the context of any such linkage, it is wholly possible that signs such as ‘OXFAM’ or ‘DIABETES RESEARCH UK’ would indicate the origin of goods sold via the mail order catalogue. In

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contrast, the phrase 'BEATING BLOOD CANCERS' would not, at least not in the prima facie case. All it does indicate is the narrative expression of a laudable medical objective. Insofar as the average consumer may see the words as possibly connected to a charitable concern, the words are not denominative of the name of such a concern, but rather the objective of any such charity which has blood cancers as its particular focus."

[26-27] He went on:

"26. The argument in relation to use of the term in connection with services (as distinct from goods) inevitably starts with the same linguistic analysis of the words. The words are, and I repeat, inherently 'origin neutral'. The fact that they may be used in relation to a service rather than a tangible 'good' is not apt to transform them into denoting trade origin. It may be true to say that in relation to the services of class 42, the phrase is especially apt. But even for the remainder of the services, all that the words convey is the narrative expression of a laudable medical objective. That objective could comprise the objective of the undertaking itself, as in the services of class 42, or it could be that a particular undertaking has apparently attached itself, or supports in some way, that objective; in either case, the sign would be non-distinctive. It is worthwhile in this context, taking judicial notice of the fact that many commercial undertakings place great store these days in their 'corporate responsibility', whether this takes the form of e.g. allowing their employees time off to do voluntary work, or allowing their names to be linked with a particular charity. Against this background, it would be far from unusual for an advertising firm, or any other service for that matter, to wish to be connected with a 'laudable medical objective' such as 'BEATING BLOOD CANCERS'.

27. The point I am making, in relation to both the goods and services of this application, is that the 'oddness' urged on me by Mr Stobbs, of seeing the words 'BEATING BLOOD CANCERS' used in a commercial context and in relation to goods of trade and services, would, in reality, and to the average consumer these days, not be perceived as being 'odd' at all, given the recognised patterns of trade and corporate mores to which I have referred."

[28] Finally, the Hearing Officer rejected an argument that a lower level of distinctive applies to charities, and whilst accepting that terms such as "Diabetes UK" could

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potentially operate as a trade mark, as appearing to be the name of charity, he considered that this Mark did not fall into that category but "could apply to any charity whose chief focus happens to be blood cancers."

### The appeal

7. The Grounds of Appeal raised in summary the following points:
  - a. The Hearing Officer had failed to take into account the fact that the nature of the average consumer would differ for some of the goods and services in the specification.
  - b. The Hearing Officer had failed to take into account the very high degree of care which would be taken in the choice of certain services within the specification, but
  - c. He had equally failed to take into account average consumers "at the other end of the spectrum."
  - d. The Hearing Officer had placed too much reliance on or misapplied dicta in *FeedbackMatters*, and should have considered whether the mark was objectionable in relation to separate categories of goods or individual goods or services such as vending machines, car mechanic services, etc.
  - e. The Hearing Officer was wrong to find that because charitable concerns find themselves operating in the commercial sphere, consumers would not see the Mark as indicating origin, even where the goods/services had nothing to do with medical research or blood cancer.
  - f. The Hearing Officer was wrong to draw a distinction between the names of charities and the Mark.
  
8. The Applicant's complaint was, therefore, that the Hearing Officer ought to have broken down his analysis specifically to take into account the different average consumers for different goods/services, the different perception consumers would have of various goods/ services and the differing levels of distinctive character which the Mark would have in relation to different goods/services. There was no suggestion that the Hearing Officer had misdirected himself, save in relation to his consideration of *FeedbackMatters*, but it was submitted that he had misapplied the requirements which he had identified in his decision.

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9. Section 3(1)(b) of the 1994 Act corresponds to Article 7(1)(b) of the Community Trade Mark Regulation. It provides that trade marks which are “devoid of any distinctive character” may not be registered, subject to a proviso which applies if the Mark has acquired distinctive character as a result of the use made of it. There is no claim of acquired distinctiveness in this case.

10. The CJEU held in Case C-329/02 P, ‘SAT.1’ at [23]:

“First, the essential function of a trade mark is to guarantee the identity of the origin of the marked product 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 ... Article 7(1)(b) of the regulation is thus intended to preclude registration of trade marks which are devoid of distinctive character which alone renders them capable of fulfilling that essential function.”

This passage suggests that distinctive character is vital to enable a sign to be a mark capable of fulfilling its essential function, but is not very helpful in identifying what gives a sign distinctive character.

11. The CJEU has consistently held that the test for distinctive character is the same for all of the various categories of signs. The question is whether consumers would identify goods or services marketed under the trade mark as originating from a particular undertaking. A mark must be capable of being “perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin.” (See e.g. Cases T-122/01, *Best Buy Concepts Inc v OHIM* [2004] ETMR 19 and T-130/01 *Sykes Enterprises v. OHIM* (*‘Real People Real Solutions’*) [2002] E.C.R. II-5179; [2003] E.T.M.R. 57 and more recently Case C-265/09 P *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* [2010] ECR I-8265). The inherent capacity of the mark to distinguish must be specifically assessed in any particular case.

12. In particular, in Case C-398/08, *Audi v OHIM* ECR, EU:C:2010:29, [2010] F.S.R. 24 at [34] the CJEU confirmed that the decision maker has a duty to examine each application on its own merits and to assess the distinctive character of such signs, first, by reference to the goods or services in respect of which registration has been applied for and, second, by

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reference to the relevant public's perception of the mark. As ever, the average consumer is deemed to be reasonably well-informed, reasonably observant and circumspect.

13. Further, Article 13 of the Trade Marks Directive provides that where grounds for refusal of registration of a mark exist in respect only of some of the goods or services for which it has been applied for, refusal must cover only those goods and services. Hence, in Case C-239/05, *BVBA* [2007] E.C.R. I-1455; [2007] E.T.M.R. 35, the CJEU said:

“34 ... an examination of the grounds for refusal listed in Art.3 of the Directive must be carried out in relation to each of the goods and services for which trade mark registration is sought and, secondly, that the decision of the competent authority refusing registration of a trade mark must, in principle, state reasons in respect of each of those goods or services.

35 That conclusion cannot be any different where an application to the competent authority for a range of goods or services does not contain a subsidiary application for registration of the mark concerned for specific classes of goods or services or for goods and services considered separately.

36 The duty upon the competent authority to state reasons for refusing to register a trade mark in relation to each of the goods or services for which such registration is sought also arises from the essential requirement for any decision of a national authority refusing the benefit of a right conferred by Community law to be subject to judicial review which is designed to secure effective protection for that right and which, accordingly, must cover the legality of the reasons for the decision ...

37 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 of the goods and services concerned.”

14. Whilst different sorts of signs should be treated in the same manner, the Court nevertheless recognised that it may be more difficult to establish that certain types of signs, including those consisting of advertising slogans, have distinctive character, because the public is unaccustomed to making assumptions about the origin of products based on those types of signs. This approach applies to slogans and laudatory epithets. In *Audi*, the CJEU held on the one hand:

“35 As regards marks made up of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or

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services covered by those marks, registration of such marks is not excluded as such by virtue of such use ...

36 As regards the assessment of the distinctive character of such marks, the Court has already held that it is inappropriate to apply to slogans criteria which are stricter than those applicable to other types of sign ...”

On the other hand, the Court went on:

“56 ... 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 [35] and [36] of the present judgment that those marks are not, by virtue of that fact alone, devoid of distinctive character.

57 Thus, insofar as those marks are not descriptive for the purposes of art.7(1)(c) of Regulation 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 causal 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,



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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.”

15. Composite word marks or slogans may, therefore, achieve registration if they may be perceived by the relevant public both as a promotional formula and as an indication of the commercial origin of goods or services (see [45] of *Audi v OHIM*). That may be the case if the verbal elements of the sign are combined with an element of imagination or wordplay, which may endow the phrase with distinctive character. In BL O/353/10, the Appointed Person, Mr Geoffrey Hobbs QC, upheld the Registrar’s refusal to register two slogans (‘Bring the World Closer’ and ‘No Wires, No Worries’) for a range of telecommunications services in Class 38 and (for the first mark only) for entertainment and information services in Class 41. Mr Hobbs QC said:

“Taken as a whole, the expression [Bring the World Closer] looks and sounds like a statement about an advantage flowing from the use of the services on offer. I agree that the advantage and the methodology or mechanism by which it is delivered are by explained. However, a narrative statement can be uninformative in relation to an aspect of the services to which it refers without necessarily or inevitably being apt to serve as an indication of trade origin. I think that is the position here.

The expression Bring the World Closer is caught by ... section 3(1)(b) because it is liable to be perceived and remembered by the relevant average consumer as nothing more than an origin-neutral statement about the services concerned. It appears to me to involve no verbal manipulation or engineering of the kind which in other cases has been recognised as sufficient to turn explanatory phraseology into a sign possessed of a distinctive character.”

Nevertheless, I note that the Registrar waived at the appeal an earlier objection to registration of the mark ‘Bring the World Closer’ for promotional, advertising and marketing services in Class 35.

16. Ms Anna Carboni sitting as the Appointed Person in *FeedbackMatters* (BL O/185/12) said at [26]:

“... section 3(1)(b) precludes registration of marks that are not inherently distinctive. In other words, to get past the test, the mark must be capable of immediately enabling relevant consumers to distinguish the goods or services bearing the mark

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from the goods or services of competing undertakings: Case C-136/02 *Mag Instruments* at [50]. This is not about whether the relevant consumers have ever (or never) seen the mark before, or whether they will recognise the mark again, but is about whether they will see the mark as denoting the origin of the goods or services without the need to be educated."

Ms Carboni agreed at [45] with the Hearing Officer's conclusion that the mark "FeedbackMatters" did not have "sufficient linguistic imperfection, peculiarity, inventiveness or creative application" to give it the capacity to function as a trade mark. It consisted simply of two ordinary everyday words joined together, whose combined meaning was a phrase easily understood, descriptive of some of the services in the specification and even when not directly descriptive it would not automatically be seen as an indication of origin for any of the services at issue.

### Grounds of Appeal

17. The over-arching point argued on the appeal was that the Hearing Officer was wrong to find that this mark would be seen as origin neutral in relation to all of the numerous goods and services in its specification. The Applicant submitted that the question of the distinctive character of the mark could differ depending upon the nature of the goods or services in relation to which it was applied. It submitted that "Beating Blood Cancer" would be seen as an indication of origin by the (more knowledgeable) average consumer of technical or healthcare services, despite its allusion to purpose, and that in relation to goods or services unrelated to charity, healthcare or cancer, the lack of a relationship between the meaning conveyed by the mark and the products would suffice again for it to be seen as an indication of origin.
  
18. The Hearing Officer considered that the phrase BEATING BLOOD CANCER expresses a 'laudable medical objective.' In more standard trade mark terms, he found this to be a laudatory epithet or slogan. That finding was not challenged on the appeal. Indeed, Mr Stobbs commented at the outset of the appeal that this mark is not on the highest scale of distinctiveness, but "is very much a mark which sits in the grey area around what is and what is not distinctive." Further, he of course accepted that the phrase is composed of ordinary words and (as he put it) "carries meaning" although his point was that it was not exclusively descriptive of any characteristics of the wide range of goods and services in the Applicant's specification.

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19. The fact the sign does not carry specific meaning and does not indicate a direct and specific relationship with the goods or services at issue without further thought is not, of course, enough for it to escape objection (see e.g. the rejection of the aspirational but essentially meaningless “Dream it, Do it!” in Case T-186/07, *Ashoka v OHIM* [2008] E.T.M.R. 70). I note that although the Hearing Officer did not refuse the mark under s 3(1)(c), neither did he accept that the mark was not objectionable on that ground. I do not think it appropriate for me to comment on whether an objection could also have been taken against some parts of the specification on the basis of s 3(1)(c).
20. Mr Stobbs sought to persuade me that BEATING BLOOD CANCERS is an idiosyncratic phrase, and that its ‘oddity’ suffices to endow it with inherent distinctiveness. I am not persuaded by that point. On the contrary, I agree with the Hearing Officer’s view that the phrase reflects the common imagery of doing battle with cancer. In my judgment the phrase would not be seen as imaginative, inventive or idiosyncratic. It is a simple statement of a laudable aim and I do not dissent from the Hearing Officer’s view that this mark comprises “an easy to understand and grammatically correct, if slightly elliptical, narrative.” I do not accept that the sign would immediately be seen as an indication of trade origin across the board. I therefore reject the over-arching general point and turn now to the more specific points which I have identified in the Grounds of Appeal.
- a) Failure to take into account the fact that the nature of the average consumer would differ for some of the goods and services in the specification**
21. It is right to say that the Hearing Officer dealt with this point only briefly in paragraph [20] of the decision. The Applicant accepted that it would not be practical to look at each and every term in the specification but submitted that when considering the average consumer of some of the more technical goods and services, the Hearing Officer could and should have taken into account the higher level of knowledge and care which would be taken in the choice of such goods/services. For example, it was suggested that the relevant average consumer for cancer research services, drug trials or medical trials would be extremely knowledgeable, and this would have an impact on the way in which such a consumer would perceive the sign. More particularly, the Applicant submitted that there would be a different assessment of the impact of the sign by such a consumer than for other services, such as charitable fundraising services.

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22. I accept that the guidance of the CJEU which I have set out above makes it plain that an examiner must consider the registrability of a sign in relation to particular goods or services by reference to the perception of the average consumer of the relevant goods or services or categories thereof. However, I do not accept that the Hearing Officer's decision on this point, however briefly worded, shows that he failed to follow this element of the Court's guidance. It seems to me that the Hearing Officer was right to say that even the specialist services identified by the Applicant could be accessed and used, albeit in a different manner, by members of the general public as well as by a more knowledgeable cohort of business or professional consumers. I therefore reject this first Ground of Appeal.

- b) The Hearing Officer had failed to take into account the very high degree of care which would be taken in the choice of certain services within the specification, but**
- c) He had equally failed to take into account average consumers “at the other end of the spectrum.”**

23. I reject Ground (b) on the same basis as I rejected Ground (a).

24. I did not understand the Applicant actively to pursue Ground (c) at the hearing of the appeal, other than as part of its overall argument that the Hearing Officer should have taken into account the way in which BEATING BLOOD CANCERS would strike the average consumer of those everyday goods and services within the specification which have either only a loose connection with charity or health care, or no such connection at all. To the extent that the specification includes goods which would be purchased with very little attention, it does not seem to me that the Hearing Officer's decision on the nature of the average consumer can be faulted.

25. The real thrust of points (a) to (c) was, in my view, wrapped up into the more general point that the Hearing Officer should have considered the possible objections to the mark in relation to various categories of goods or services, rather than differentiating only between all the goods on the one hand and all the services on the other.

- d. The Hearing Officer had placed too much reliance on or misapplied dicta in FeedbackMatters, and should have considered whether the mark was objectionable in**

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**relation to separate categories of goods or individual goods or services such as vending machines, car mechanic services, etc**

26. In *FeedbackMatters* the application related to a variety of services all within Class 35. The Hearing Officer had found that the mark conveyed a "plain and simple message" and then split up the specification of services into separate categories, and considered whether the mark would be seen as indicating trade origin in relation to each such category. She separated out one particular category of services, as she considered that it was possible that the mark might operate as a trade mark in relation to them. Ms Carboni commented in [36] of her judgment that she would not have separated out that category of services for that reason, as she considered that the mark had no more power to individualise those services than any other services in the specification. In my view, Ms Carboni was not laying down any rule as to the types of categories of goods or services in relation to which a section 3(1)(b) objection should be considered, but only commenting that she did not think that the particular category of services had any better merits than any other. In other words, I do not consider that Ms Carboni was intending in any way to derogate from *BVBA* or lay down any general rule to the effect that an examiner should apply s 3(1)(b) by reference to categories of any particular breadth or level of generality.
27. In my judgment, that the Hearing Officer in this case did not place too much reliance on *FeedbackMatters*, nor did he misapply it. On the contrary, he commented (rightly in my view) that the case did not establish a general proposition, but only illustrated the difficulty of considering a sign which might be seen as devoid of distinctive character in relation to some but not all goods and services. He commented on the difficulty in drawing a meaningful line between different categories of goods and services when faced with a phrase which might be taken as origin neutral and went on to refer to requirements of Article 13. Nothing in paragraphs [18]-[19] of his decision seems to me to reflect an error of law or principle.
28. However, that leaves the substantive issue of whether the Hearing Officer was right to analyse the potential of this sign to distinguish all of the goods and services applied for in the compendious manner seen in paragraphs [22] to [27] of the decision. The Hearing Officer correctly directed himself as to the manner in which he should decide if the sign was devoid of distinctive character, but the Applicant urged upon me that he had not applied that guidance correctly. As I have noted above, in *BVBA*, the CJEU decided that a

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decision refusing registration of a trade mark must, in principle, state reasons in respect of each of the goods or services in the specification applied for, but that general reasoning may be used where the same ground of refusal is given for a category or group of goods or services. This is plainly a practical approach, which is highly necessary where long specifications such as this one are concerned, since to require an examiner to give reasons for refusal in relation to each individual item of goods and services would impose an impossible burden on the Registry. The question here is whether the Hearing Officer went too far in his general reasoning and erred in failing to consider the goods and services in this lengthy specification in more specific or discrete categories of goods and services.

29. I broadly share the Hearing Officer's view that the sign BEATING BLOOD CANCERS is liable to be seen in some, possibly in many, contexts as no more than an origin neutral, laudatory phrase, and potentially for many, most or (possibly) all of the goods and services in this specification. The sign does not strike me as apt to be perceived immediately as an indication of the commercial origin of some categories of goods or services, even assuming use in relation to such goods or services in a manner commensurate with trade mark use. Nevertheless, in my view, signs which cannot operate as a mark of origin at all without 'educating the public' are relatively rare, and are likely to consist of simpler laudatory words or phrases, like PREMIER or BEST BUY. I note that even in *Best Buy* (supra, at [22]) the General Court reiterated the necessity to consider the inherent distinctiveness of the sign by reference to the goods and services in the specification.
30. The Hearing Officer thought the objection applied to the whole specification because he found that the mark indicated that the goods and services would somehow support the laudable aim of beating blood cancers. That was a message others might also wish to convey and would not immediately indicate the origin of any goods or services. However, in the light of *Audi*, the mere fact that a sign is perceived as a 'promotional' statement is insufficient to support the finding that the sign is devoid of distinctiveness. In my judgment, the Hearing Officer failed to substantiate his conclusion that the mark was devoid of any distinctive character for the entire breadth of services covered by the specification under section 3(1)(b). In particular, he went too far in deciding in effect that the phrase could not operate as a trade mark in relation to goods or services of any kind whatsoever, without carrying out the required exercise of examining the goods and (to a lesser extent) the services in the specification individually or in coherent categories.

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31. The Applicant had argued that the sign would be taken as an indication of origin in relation to at least some of the goods and services in the specification (e.g. vending machines, calculators, car mechanic services, dating services) because no connection would be assumed between those goods and the objective of beating blood cancers. The Hearing Officer rejected that point on two bases. First, at [24] he said that one could not simply test the issue by considering whether it would be odd to apply this phrase to particular goods – the fact that (say) a vending machine has no ‘literal connection’ with blood cancers in his view would not show that the sign would function as a mark. The issue I have with this analysis is that the Hearing Officer does not appear to have considered how the sign might be viewed if it were used in relation to the goods in normal and fair use and in the manner usual for trade mark use on such goods.
32. Secondly, he took judicial notice of the fundraising retail activities of charities, which, he considered are likely to lead consumers to link a charitable message with goods. He considered that use of signs such as Oxfam or Diabetes Research UK might indicate the origin of the goods, because such signs would be recognised as being the name of a particular charity. I accept that the Hearing Officer could take judicial notice of the common fund-raising activities of charities, and I also accept the distinction he made between a sign which is known to be, or appears to be, the name of a charity and one which is not. In my view, use of a sign of that kind might alternatively be taken as an indication of the provision of retail services by the charity.
33. However, the Hearing Officer thought that the consumer would see “Beating Blood Cancers” only as showing an objective, not as an indication of origin, regardless of the nature of the goods. In that respect, it seems to me that the Hearing Officer did err. He should have considered in more detail whether his objection applied to all of the goods in the specification and, in particular, whether a consumer, seeing the words on the goods, or used in a normal trade mark manner in relation to the goods, would or would not view the words to be a trade mark.
34. The Hearing Officer also dealt somewhat compendiously with the range of services in the specification in [26] of his decision. He did not consider whether, for instance, use of the sign in relation to any retail services (and the Class 35 specification is very wide) might be taken as indicating the provider of the retail services. In my judgment the general

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reasoning given in [26] does not suffice, for all of the reasons I have given above, to justify the objection taken to the huge range of services in the Applicant's specification.

35. For these reasons, I find that section 3(1)(b) of the Act has not been appropriately applied. In the light of my finding that section 3(1)(b) has not been appropriately considered I do not consider that, in this case, it would be appropriate for me to do anything other than remit the application to the Registry.
36. Both sides invited me to provide any guidance I thought appropriate to give to the Registrar in reconsidering the application, in particular as to the level of categorisation required. Mr Stobbs suggested that the specification could be divided into five categories of goods and services, namely:
  - a. Services that relate to charitable fundraising;
  - b. Technical services (which may have a very different consumer) that have some affiliation with healthcare and in particular cancer (such as the drug trials mentioned above);
  - c. Everyday goods or services that may have some loose connection with charity or health care;
  - d. More technical goods or services that may have a different consumer set, but do not have any connection with cancer; and
  - e. Goods and services that have no relationship whatsoever to cancer or charitable fundraising.
37. Category (a) includes many of the services in Class 36 of the specification, and category (b) covers many more of the services in Classes 35-45. The precise content of each category needs to be identified. Subject to that being done, I consider that those categories would reflect the right level of specificity for the assessment of distinctive character.
38. On the other hand, I do not find categories (c) to (e) helpful, on the one hand because they do not seem to me to be discrete categories, and on the other because it is not easy to see which category would apply to many of the goods and services in issue. The Applicant did not seek to take me through all of the goods and services in the specification in more detail than by reference to the categories mentioned above, although a few items were mentioned by way of illustration, e.g. vending machines, which would no doubt have been placed in (e). As a result, I do not know, for example, whether Mr Stobbs would



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suggest that his category (c) includes everyday goods of kinds which are frequently sold in order to raise money for charity, such as the greetings cards in Class 16 or some of the clothes in Class 25. If not, I am not clear into which of his other categories such goods would fall. The distinction between (d) and (e) is also unclear to me, as it seems that some of the "more technical goods" in (d) might include, say, nautical equipment in Class 9, but this might also fall into category (e). These categories therefore seem to me to be unhelpful in terms of the required examination process.

39. I do not consider that I should give case management directions for the remitted application. However, as the parties asked for any guidance which I felt I could give, I would suggest that in order to progress this application, it might be helpful for the Applicant (i) to identify a set of discrete sub-categories of its specification for consideration by the Registrar and (ii) to list those goods and services within its specification it says fall into each such category. In addition to Mr Stobbs' existing categories (a) and (b) perhaps the Applicant should identify categories of goods commonly sold in the course of charitable fundraising, and goods/services which the Applicant contends have no relationship to cancer, medical research or charitable fundraising. The Applicant may well consider that there is a need to break down the specification into smaller sub-categories. Although neither the categories nor the categorisation would bind the Registrar, this process may, I hope, provide a helpful basis for further consideration of the application.
40. As is usual, I will make no order as to the costs of the appeal.

Amanda Michaels  
The Appointed Person  
7 October 2015

**MR JULIUS STOBBS of Stobbs IP Limited appeared for the Appellant/Applicant**

**MR NATHAN ABRAHAM appeared for the Registrar**

### **ANNEX A**

#### **The full specification applied for:**

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and

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instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment and computers; Fire-extinguishing apparatus; electronic, downloadable publications; computer software; podcasts; downloadable media files; data recorded electronically and in electronic form; electronic devices for displaying information; CDs, CD-ROMs, DVDs; scientific apparatus and instruments for medical research; downloadable teaching materials; downloadable publications on the subject of medical research, drug trials, medical trials and scientific trials; downloadable publications on the subject of health, diet, nutrition, cancer and cancer prevention; parts and fittings for the aforesaid goods.

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; Printed matter; Book binding material; Photographs; Stationery; Adhesives for stationery or household purposes; Artists' materials; Paint brushes; Typewriters and office requisites (except furniture); Instructional and teaching material (except apparatus); Plastic materials for packaging (not included in other classes); Printers' type; Printing blocks; printed publications; magazines; brochures; journals; leaflets; posters; information and promotional material; stationery; greetings cards; invitations; gift labels and tags; diaries; calendars; address books; organisers; notebooks; notelets; binders and folders; bags made from paper; adhesives for stationery; book pads; book ends; book markers; envelopes; paper bows; paper coasters; paper coffee filters; paper containers; paper face towels; paper handkerchiefs; toilet paper; luminous paper; paper table napkins; paper tablecloths; paper articles of stationery; cardboard articles; wrapping paper; photograph albums; pictures; prints; paintings; bookmarks; stickers and decalcomanias; table mats of paper; parts and fittings for the aforesaid goods.

Class 21: Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes; mugs; beer mugs; bottle openers; buckets; champagne buckets; ice buckets; coasters; cocktail stirrers; corkscrews; drinking glasses; shakers; tankards; toothbrushes; plastic water bottles; tableware; money boxes; parts and fittings for all the aforesaid goods.

Class 25: Clothing, footwear, headgear; sports clothing; sportswear; outer clothing; shirts; t-shirts; shorts; sweaters; skirts; jogging suits; trousers; jeans; pants; rainwear; blouses; jackets; coats; gloves; neckties; scarves; hats; caps; sunvisors; boots; shoes; sport shoes; sneakers; sandals; wristbands; parts and fittings for all the aforesaid goods.

Class 26: Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers; badges for wear; pins; rosettes; ribbons; arm bands; woggles; lanyards; hair pins and grips; parts and fittings for all the aforesaid goods.

Class 35: Advertising; business management; business administration; office functions; public relations services; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods, from stores, websites and stalls specialising in scientific, measuring, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, calculating machines, data processing equipment

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and computers, electronic downloadable publications, computer software, podcasts, downloadable media files, data recorded electronically and in electronic form, electronic devices for displaying information, CDs, CD-ROMs, DVDs, scientific apparatus and instruments for medical research, downloadable teaching materials, downloadable publications on the subject of medical research, downloadable publications on the subject of drug trials, downloadable publications on the subject of medical trials and scientific trials, downloadable publications on the subject of health, diet, nutrition, cancer and cancer prevention, paper and cardboard, printed matter, bookbinding material, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, office requisites (except furniture), instructional and teaching material (except apparatus), plastic materials for packaging (not included in other classes), printed publications, magazines, brochures, journals, leaflets, posters, information and promotional material, stationery, greetings cards, invitations, gift labels and tags, diaries, calendars, address books, organisers, notebooks, notelets, binders and folders, bags made from paper, adhesives for stationery, book pads, book ends, book markers, envelopes, paper bows, paper coasters, paper coffee filters, paper containers, paper face towels, paper handkerchiefs, toilet paper, luminous paper, paper table napkins, paper tablecloths, paper articles of stationery, wrapping paper, photograph albums, pictures, prints, paintings, bookmarks, stickers and decalcomanias, household or kitchen utensils and containers, combs and sponges, brushes, brush-making materials, articles for cleaning purposes, steelwool, unworked or semi-worked glass, glassware, porcelain and earthenware, table mats, mugs, beer mugs, bottle openers, buckets, champagne buckets, ice buckets, coasters, cocktail stirrers, corkscrews, drinking glasses, shakers, tankards, toothbrushes, plastic water bottles, tableware, money boxes, Clothing, footwear, headgear, sports clothing, sportswear, outer clothing, shirts, t-shirts, shorts, sweaters, skirts, jogging suits, trousers, jeans, pants, rainwear, blouses, jackets, coats, gloves, neckties, scarves, hats, caps, sunvisors, boots, shoes, sport shoes, sneakers, sandals, wristbands, Lace and embroidery, ribbons and braid, buttons, hooks and eyes, pins and needles, artificial flowers, badges for wear, pins, rosettes, ribbons, arm bands, woggles, lanyards, hair pins and grips; advertising and promotion services; business organisation services; business management services; co-ordination of organisations and individuals for the purposes of enabling scientific research; compilation of information into computer databases; systematization of information into computer databases; consultancy in the field of business organisation; data search in computer files for others; business management in the field of scientific management; marketing, conducting market research and marketing studies; market analysis; data analysis; opinion polling; converting information into a digital format; management, collection and dissemination of commercial, personal and charitable data; promoting public awareness of cancer prevention; information and advisory services relating to the aforesaid.

Class 36: Insurance; Financial affairs; Monetary affairs; Real estate affairs; charitable fund raising; financial services relating to charities and fund raising; charitable collections; organisation of collections; organisation of fund raising activities and events; financial grant services; provision of funding for medical research; provision of funding for charities; provision of funding for medical trials; provision of funding for educational and research posts; information and advisory services relating to the aforesaid.

Class 41: Education; Providing of training; Entertainment; Sporting and cultural activities; Organisation of sporting and cultural activities; organisation of sporting and cultural activities for charitable purposes; organisation, planning, arranging and conducting of discussions, study groups, workshops, lectures, conferences and seminars; education services in relation to alleviation, diagnosis, prevention and treatment of disease and medical conditions; the publication of books,

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records, reports, publications, newsletters, research material, journals, academic studies, briefing papers, catalogues, texts and magazines; publishing by electronic means, providing on-line electronic publications (not downloadable), publication of electronic books and journals on-line; library services; developing and conducting educational programs in the fields of health, diet, nutrition, cancer and cancer prevention; education and training in the field of medical trials and drug trials; provision of musical events; presentation of live performances; rental of music venues and stadiums; ticket agency services; information and advisory services relating to the aforesaid.

Class 42: Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software; Scientific and medical research services; providing medical and scientific research information and advice relating to alleviation, diagnosis, prevention and treatment of disease and medical conditions; research in the fields of health, diet, nutrition, cancer and cancer prevention; drug trials; medical trials; medical treatment trials; scientific trials; advisory services relating to scientific and medical research; providing a platform for online discussions on communications networks, in particular on the Internet; providing an online platform for forums and discussions, providing functions for personalising online forums and online discussions; design, creation, maintenance and hosting of websites; services information and advisory services relating to the aforesaid.

Class 45: Legal services; dating services; online dating services; Security services for the protection of property and individuals political lobbying; political campaigning, advocacy and policy; political campaigning, advocacy and policy in the fields of public affairs, medical research, scientific research, medical trials and drug trials.

### ANNEX B

#### Specification to which examiner took objection:

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; data processing equipment; electronic, downloadable publications; computer software; podcasts; downloadable media files; data recorded electronically and in electronic form; electronic devices for displaying information; CDs, CD-ROMs, DVDs; scientific apparatus and instruments for medical research; downloadable teaching materials; downloadable publications on the subject of medical research, drug trials, medical trials and scientific trials; downloadable publications on the subject of health, diet, nutrition, cancer and cancer prevention; parts and fittings for the aforesaid goods.

Class 16: Printed matter; Photographs; Instructional and teaching material (except apparatus); printed publications; magazines; brochures; journals; leaflets; posters; information and promotional material; pictures; prints; paintings; table mats of paper; parts and fittings for the aforesaid goods.

Class 35: public relations services; co-ordination of organisations and individuals for the purposes of enabling scientific research; compilation of information into computer databases; systematization of information into computer databases; data search in computer files for others; business

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management in the field of scientific management; marketing, conducting market research and marketing studies; market analysis; data analysis; opinion polling; converting information into a digital format; management, collection and dissemination of commercial, personal and charitable data; promoting public awareness of cancer prevention; information and advisory services relating to the aforesaid.

Class 41: Education; Providing of training; organisation, planning, arranging and conducting of discussions, study groups, workshops, lectures, conferences and seminars; education services in relation to alleviation, diagnosis, prevention and treatment of disease and medical conditions; the publication of books, records, reports, publications, newsletters, research material, journals, academic studies, briefing papers, catalogues, texts and magazines; publishing by electronic means, providing on-line electronic publications (not downloadable), publication of electronic books and journals on-line; library services; developing and conducting educational programs in the fields of health, diet, nutrition, cancer and cancer prevention; education and training in the field of medical trials and drug trials; information and advisory services relating to the aforesaid.

Class 42: Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Scientific and medical research services; providing medical and scientific research information and advice relating to alleviation, diagnosis, prevention and treatment of disease and medical conditions; research in the fields of health, diet, nutrition, cancer and cancer prevention; drug trials; medical trials; medical treatment trials; scientific trials; advisory services relating to scientific and medical research; services information and advisory services relating to the aforesaid.

Class 45: Political lobbying; political campaigning, advocacy and policy; political campaigning, advocacy and policy in the fields of public affairs, medical research, scientific research, medical trials and drug trials.