

O-070-18

TRADE MARKS ACT 1994

IN THE MATTER OF:

TRADE MARK APPLICATION 3123009

BY TRADESHIP PUBLICATIONS LTD

FOR THE FOLLOWING TRADE MARK IN CLASSES 35 & 41:

The Global Cement Report

AND

OPPOSITION THERETO (NO. 405584) BY

PRO GLOBAL MEDIA LIMITED

Background and pleadings

1. The details of the trade mark application the subject of these proceedings are as follows:

Mark: The Global Cement Report

Services: Class 35: Providing business information via a website; analysis of market research data and statistics; statistics (compilation of-); compilation of company information.

Class 41: Publication of texts, books, magazines and other printed matter; publication of electronic books and journals on-line.

Applicant: Tradeship Publications Ltd

Dates: Filed on 19 August 2015 and published for opposition purposes on 4 September 2015.

2. The opponent is Pro Global Media Limited. Its grounds of opposition were initially based on sections 5(2)(b), 3(1)(b), 3(1)(c) and 3(3)(b) of the Trade Marks Act 1994 ("the Act"). However, an issue arose during the course of the proceedings in relation to the earlier mark, UK registration 2609548, relied upon by the opponent under section 5(2)(b). More specifically, this was with regard to: i) the proper chain of title of the registration and ii) whether, if the chain of title was correct, the opponent had the locus to rely on the earlier mark as part of its opposition. Following a case management conference that took place before me on 25 April 2017, I directed that the parties provide written submissions on the locus point. In response, the opponent, instead of filing written submissions, abandoned its claim under section 5(2)(b). This, therefore, leaves only the various grounds under section 3 for consideration, grounds which can be summarised as:

- Section 3(1)(b) – That the mark is devoid of distinctiveness because it “is a natural way to refer to the services covered by the subject application”.
- Section 3(1)(c) – That the mark is descriptive of the services covered by the application “in that they relate to the provision of services relating to the global cement industry, all of which may be compiled and published in reports.”
- Section 3(3)(b) – That the mark would be deceptive if the services did not relate to the cement industry.

3. The applicant filed a counterstatement denying the grounds of opposition. It accepts that the mark is allusive, but in a way which allows it to function as a trade mark. It refers to prior use of the mark and, as an alternative to its primary denial of the grounds, relies on the acquisition of distinctive character through such use. It further denies that the mark is deceptive; it considers that whilst the mark is allusive, the consumer would not be deceived even if it were to be used in an allied field.

4. Both sides filed evidence. Both sides have been professionally represented throughout the proceedings, the applicant by Kilburn & Strode LLP, the opponent by Stevens Hewlett & Perkins LLP. A hearing took place before me on 28 October 2017 at which the applicant was represented by Mr Sam Carter, of counsel. The opponent did not attend the hearing, nor did it file written submissions in lieu.

The evidence

The opponent’s primary evidence

5. As its primary evidence, the opponent filed two witness statements. The first is from Dr Joachim Harder. Dr Harder is the director of a company called One Stone Consulting SL. His company provides assistance to businesses in the aggregate and cement industry. Dr Harder describes himself as an expert in the field. He states that he is aware of both the applicant and the opponent. He is aware of the opponent’s mark (a stylised version of the words GLOBAL CEMENT) which has been used since

2006 in relation to a monthly magazine covering all aspects of the cement industry. He believes that consumers identify that mark with the opponent. He is also aware that the applicant publishes a biennial report relating to the cement industry under the name THE GLOBAL CEMENT REPORT, but that this report carries the trade mark International Cement Review (stylised) on its front cover in a prominent position. He believes that if the mark INTERNATIONAL CEMENT REVIEW were not displayed, “consumers would not be able to identify the publisher of the publication”. He adds his belief that the words THE GLOBAL CEMENT REPORT are entirely descriptive of the publication and, also, descriptive of the services for which the applicant seeks registration.

6. The opponent’s second witness statement comes from Dr Robert McCaffrey, a director of the opponent. It is useful to record that Dr McCaffrey was employed by the applicant between 1992 and 1996 and that he was the editor of the applicant’s magazine title INTERNATIONAL CEMENT REVIEW. He states that he (and a fellow director of the opponent, who also used to work for the applicant, Mr Paul Brown) worked on early editions of the biennial publication called The Global Cement Report.

7. Dr McCaffrey begins by setting out some background detail relating to the opponent’s magazine, GLOBAL CEMENT, including its name development. I do not consider it necessary to detail this information in this summary of the evidence. In relation to the words The Global Cement Report, he states that this is a collection of words that could be used by anyone wishing to write a report on a variety of aspects about the global cement industry. He says about the publication itself, that the words are not rendered in an unusual font, nor does it have any additional graphical embellishments. He states that the words are common ones and the consumer would attach no trade mark significance to them. He states that the applicant has acknowledged that it has no proprietary rights over the words Global Cement Report. This is based on an email exchange between the parties dated July 2013 in which a director of the applicant, Mr David Hargreaves, states:

“The terms Global Cement, World Cement et al are terms to represent the cement industry as a whole and is no more your trade mark of “global cement magazine” than it is of our “Global Cement Report””.

8. Dr McCaffrey then refers to Exhibit RM3 which consists of what he says is an extract from the applicant's website showing the current version of The Global Cement Report. He states that the front cover contains the prominent words International Cement Review (stylised) and that this is the sign which is also used in conjunction with its monthly publication relating to the cement industry. Dr McCaffrey states that without this sign, the consumer would not be able to identify the source of the publication. The print provided is not very clear. But it does clearly depict the words THE GLOBAL CEMENT REPORT (identified as the 11th edition) in plain block capitals. There is a further sign in the bottom left of the cover which contains the word Cement, which could be the sign (INTERNATIONAL CEMENT REVIEW) referred to by Dr McCaffrey. I note from the exhibit that there are frequent references to the words THE GLOBAL CEMENT REPORT, for example, the first paragraph reads:

“Published by International Cement Review every two years, The Global Cement Report is the most comprehensive industry reference available, featuring key market information for over 170 countries.”

9. I also note a reference to “NEW – ONLINE DATABASE” with an indication that “The Global Cement Report is supplied with a companion database featuring a 25-year statistical database...”. The product summary reads: “Global Cement Report, 11th Edition, published by International Cement Review, pp386+ 25-year database (online access). I note that subscribers to International Cement Review benefit from discounts, as well as access to the “online Global Plant Database” – it is unclear if the Global Plant Database is the name of the companion database, or is a different database altogether. Although the print is not dated, later evidence shows that the 11th edition was published in June 2015.

10. Exhibit RM4 contains sample pages from The Global Cement Report. The point of this evidence is to show that the report relates to the global cement market. From the content of the pages, it clearly does.

11. Dr McCaffrey estimates that The Global Cement Report probably has a distribution of a few hundred each year, “perhaps 200-300 at most”. He highlights that it is sold, as opposed to being distributed for free.

12. Dr McCaffrey highlights that a previous application by the opponent for the words GLOBAL CEMENT in class 41 faced an objection, so he does not understand why the subject mark did not similarly face an objection. He also notes that the following marks received official objections: WORLD CITIES CULTURE REPORT, ALARM REPORT and THE AFRICA REPORT. The first mark is a UK application, the other two are EU trade mark applications.

13. Dr McCaffrey also notes that the applicant publishes a number of yearbooks/technical publications under the umbrella sign INTERNATIONAL CEMENT REVIEW, including: CEMENT PLANT ENVIRONMENTAL HANDBOOK, THE CEMENT PLANT OPERATIONS HANDBOOK, THE GLOBAL CEMENT REPORT, THE ICR HANDBOOK ON GLOBAL CEMENT TRADE AND DISTRIBUTION, THE GLOBAL WHITE CEMENT REPORT and ICR RESEARCH. These are shown in a page downloaded from the applicant's website. The text about the applicant indicates that its initial aim was to provide the global cement industry with a dedicated monthly magazine (INTERNATIONAL CEMENT REVIEW), that it then went into the field of organising conferences, and that it also produces various yearbooks and technical publications. Dr McCaffrey notes that other than the subject mark, the applicant has not sought to register these other names and he considers that it was filed to disrupt the legitimate activities of the opponent.

The applicant's primary evidence

14. The applicant filed seven witness statements. The first is from John Fraser-Andrews. He is a stockbroking analyst at HSBC. He has used the INTERNATIONAL CEMENT REVIEW and THE GLOBAL CEMENT REPORT for a number of years. This was firstly in 2000 when he moved into the building materials sector. He adds that he has used THE GLOBAL CEMENT REPORT in both printed and electronic form; in relation to the latter, he refers to a CD version being introduced many years ago. He also notes that in investor reports he produces he will sometimes quote the source of information he uses. He provides an example in Exhibit 1. Mr Fraser-Andrews says that he quotes THE GLOBAL CEMENT REPORT, but I note that the full entry is: "The Global Cement Report (11th Edition), International Cement Review". He considers THE GLOBAL CEMENT REPORT to be the most comprehensive review of the international

cement industry. He estimates that there are around 20 main stockbroking firms that specialise in this sector and that 15 would likely use THE GLOBAL CEMENT REPORT. He expects that anyone in this sector would instantly recognise the name and be aware of the product.

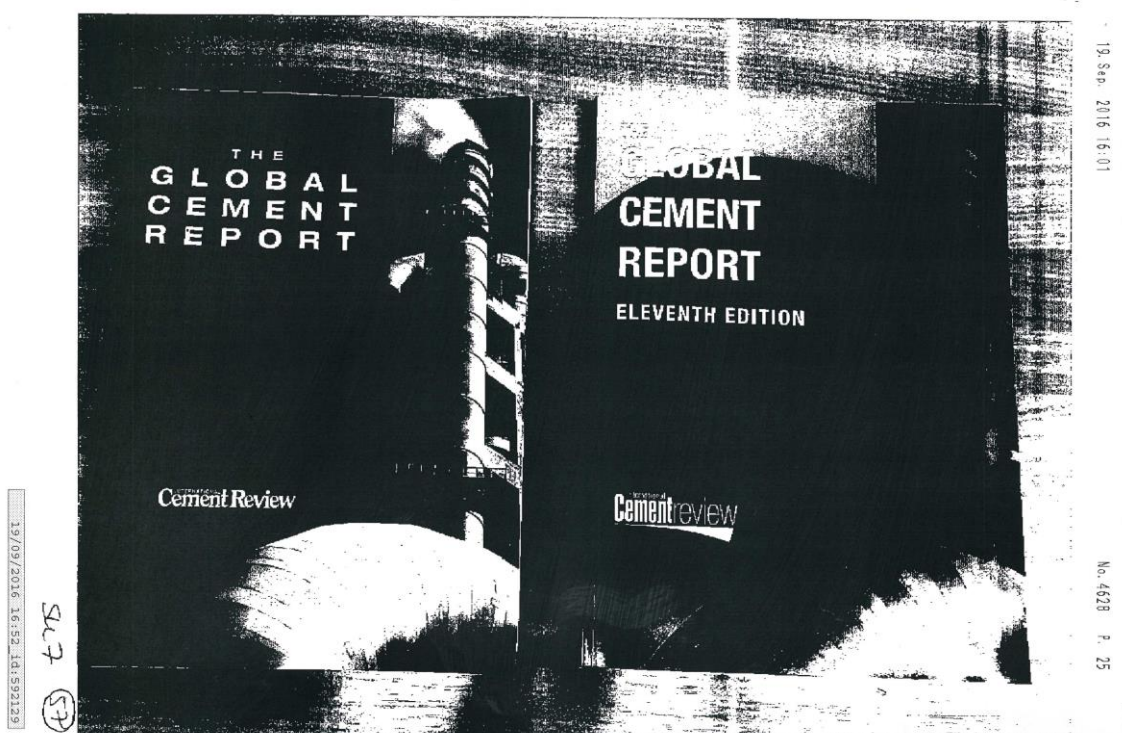
15. The next witness statement comes from Dr Michael Clark, a consultant in the international cement industry. His (relevant) career started in 1973. It should be noted that Dr Clark is a technical consultant for the applicant's INTERNATIONAL CEMENT REVIEW publication. He states that in his library he has several versions of The Global Cement Report, going back to the third edition. He generally uses the CD version more than the print version. He also regularly uses the applicant's website and he is aware of a version of THE GLOBAL CEMENT REPORT on this. He states that the primary reader of the publication would be those involved in the investment side of the cement industry. He adds that it could also be used by companies, including those involved in production and planning, looking to move into another country and to gain an understanding of the factories in that country. He lists a number of banks and investment groups who he would expect to have a copy. He considers THE GLOBAL CEMENT REPORT to be unique and the name associated with the biennial report. He adds that various publications in the field will often use the word CEMENT in their names, but other words differentiate between them. He states that he was asked (by who is not clear) if the name would be recognised as a publication of the applicant. He estimates that around 80% would know that the name was a publication of the applicant.

16. The next witness statement comes from Ms Sharon Kirby, a trade mark attorney working for the applicant. Some of her evidence relates to the chain of title of the earlier mark initially relied upon by the opponent - I need not comment upon this. Ms Kirby does, though, provide at Exhibit SK1, materials showing the use of THE GLOBAL CEMENT REPORT which were sent to her by the applicant when instruction to file the mark was received. This includes:

- i) A flyer for the tenth edition of THE GLOBAL CEMENT REPORT. The front page of the flyer contains these words in much the same way as the front cover of the publication itself (as described earlier), and which also features

the stylised words INTERNATIONAL CEMENT REVIEW towards the bottom. The flyer also depicts the hard copy and the CD version of the publication itself.

- ii) An advertisement for the second edition of the GLOBAL CEMENT REPORT which is described as “the NEW 1996 version”. The front page of the report is depicted, albeit, the representation is, again, unclear. The words THE GLOBAL CEMENT REPORT are used throughout the advertisement.
- iii) A photograph of an exhibition promoting the product. The words THE GLOBAL CEMENT REPORT (ELEVENTH EDITION) appear prominently on the display stand, but there are also other signs, to the right of those words, which, although again unclear, appear to include INTERNATIONAL CEMENT REVIEW.
- iv) A photograph of the front cover of the eleventh edition of THE GLOBAL CEMENT REPORT which again features the stylised words INTERNATIONAL CEMENT REVIEW. There is also a cover of the first edition. It is worthwhile at this stage reproducing these images:



17. The next witness statement comes from Mr David Hargreaves, a director of the applicant. Much of his evidence relates to Dr McCaffrey and Mr Brown leaving the applicant to set up the opponent and their choice of marks. This is not particularly pertinent to the issues before me so I say no more about it. The general point Mr Hargreaves makes amounts to an acceptance that the words GLOBAL CEMENT are descriptive, but that the additional words in the applicant's mark make the name overall more distinctive, such that it could be recognised as a particular product. This was the point, he says, he was trying to get over in the email exchange with Dr McCaffrey. He also highlights that the mark did not receive an initial objection from the IPO. Mr Hargreaves goes on to say that the publication is unique in the marketplace and that it has been used for a number of years. However, he gives little by way of additional detail. Mr Hargreaves refers to examples of confusion with the opponent's mark (or more accurately with reports it has issued called GLOBAL CEMENT REPORT and GLOBAL CEMENT DIRECTORY). He considers the only reason why the opposition was lodged was to disrupt the applicant's activities. He refers to the publication being in print form and then CD; he adds "but as with most publishing and information providers nowadays, it is expected that delivery would also be online".

18. The next witness statement comes from Mr Yuri Serov. Before moving to Singapore, he was an equity analyst, most recently working for Morgan Stanley & Co in the UK. Mr Serov has also used The Global Cement Report when compiling reports and presentations to investors, or to those with an interest in construction. He says there is nothing else like it in terms of depth and scope of coverage. He says that it is possible to use the statistics in the print version via online access and that he has used the website to access such information. He provides at Exhibit 1 the same information as I set out in paragraph 8 about the companion database. Mr Serov states that he has attended conferences where The Global Cement Report has been promoted and he associates the product with the "CemNet website, the CemTech Conferences, the International Cement Review and [the applicant]". Exhibit 2 contains a hand-out (dated 2012) he produced for a presentation which lists Global Cement Report as one of his data sources. Further hand-outs are shown in Exhibit 3, 4 and 5 with the same data source identified. I note that the presentations took place at CemNet conferences, which are clearly connected with the applicant. Mr Serov concludes by stating that The Global Cement Report is a high profile data resource in a specialised sector and would

expect analysts in this field to use the product. Indeed, when he moved to Singapore, his new employers had a print version.

19. The next witness statement comes from Mr Arthur Harrison, who has run his own consultancy firm since 2010. He works for a number of clients, including some in the UK. He states that he has considerable experience in the cement industry. He has been aware of THE GLOBAL CEMENT REPORT for a number of years. He knows that it is published every two years in print and CD form. He adds that some of the information is on the CemNet website and that “it is also possible to subscribe separately to a version of The Global Cement report product online via the CemNet website”. He expects users to include cement manufacturers and trading companies. He frequently attends conferences relating to the cement industry and would expect fellow attendees to know what The Global Cement Report was, and would understand that this is a publication of the applicant. He also comments on the opponent’s product, but I do not consider what he says to be pertinent to the issues before me.

20. The final witness statement comes from Mr Ian Cottam, another person with experience in the cement sector. He first used The Global Cement Report in 1996. He prefers the print version, but he is aware that it also comes on a CD and can be accessed online. He states that the product is more likely to be read by commercial people such as entrepreneurs and those in planning departments and investment, rather than operational people involved in the production of cement. He has been asked (by who is not clear) whether, if he met someone from the sector (say at a conference), whether they would know what he was talking about if he referred to The Global Cement Report – he believes they would recognise it as the report he has been discussing.

Opponent’s reply evidence

21. This comes from Dr McCaffrey. His witness statement in reply runs to some 13 pages. Some of the information is not pertinent. However, I consider the following to be worth noting here:

- Dr McCaffrey considers that the email exchange with Mr Hargreaves shows that he considers all the words of the mark to be descriptive, not just GLOBAL CEMENT.
- Contrary to Mr Hargreaves' comment that THE GLOBAL CEMENT REPORT is a suite of products, Dr McCaffrey states that it is a single publication printed every two years.
- That the online offering referred to by Mr Hargreaves is not branded with the subject mark, but, instead, as "The Global Plant Database". He provides text said to have come from a page on CemNet's website which reads: "Subscribers to The Global Cement Report, 12th Edition gain access to the fully updated Global Plant Online Database..."
- It is noted that Mr Hargreaves provided no turnover figures; Dr McCaffrey estimates that fewer than 20 copies per year are sold.
- Various witnesses refer to the publication as GLOBAL CEMENT REPORT instead of THE GLOBAL CEMENT REPORT.
- That Mr Fraser-Andrews mentions a publication called THE GLOBAL CEMENT REVIEW which, in fact, does not exist. Dr McCaffrey states that this shows that the subject mark does not have a strong standing in the market.
- That Mr Fraser-Andrews uses the words GLOBAL CEMENT descriptively in his presentations. He notes that other witnesses use similar words descriptively in their statements.
- That Mr Fraser-Andrews' estimates of user numbers, and the likely impact of the mark, are unsubstantiated/hearsay. Similar comments are made about the views of the other witnesses.
- That Mr Clark is biased as he has worked for the applicant – it is stated by Dr McCaffrey that Mr Clark and Mr Hargreaves are life-long friends.

- That contrary to what Mr Clark states, there is no online version of The Global Cement Report. Similar comments are made about the similar references made by some of the other witnesses.
- That the similar language used by Mr Clark and Mr Fraser-Andrews (and others), shows collusion.

The applicant's further evidence

22. Shortly before the hearing, the applicant sought leave to admit further evidence in relation to the nature of the applicant's online offering and, also, whether the subject mark related to just a single product. The applicant considered that these issues had been raised by the opponent for the first time in its reply evidence. Given that I was already aware that the opponent was not planning on attending the hearing, I informed it that the admission of the late evidence would be dealt with as a preliminary matter at the hearing, but that they were still able to attend to discuss that matter, or, alternatively, it could provide written submissions for consideration. The opponent responded objecting to the admission of the further evidence on the basis that the applicant had already been given ample time to file evidence. It did not indicate any desire to file reply evidence if the further evidence was admitted, indeed, it specifically indicated that it wished its case to be considered upon the basis of the evidence it had filed thus far.

23. At the hearing, Mr Carter referred to the decision of The Hon Mr Justice Carr in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) (02 December 2016). At paragraph 34 of this decision it is stated:

“34. In my judgment, the Registrar should primarily consider the following factors when deciding on the admissibility of late evidence, although the weight to be attached to each of them will vary from case to case:

- i) The materiality of the evidence in question to the issues that the Registrar has to determine;
- ii) The justice and fairness of subjecting the opposite party to the burden of the evidence in question at the stage that the registry proceedings have reached, including the reasons why the evidence was not filed earlier;
- iii) Whether the admission of the further evidence would prejudice the opposite party in ways that cannot be compensated for in costs (e.g. excessive delays); and
- iv) The fairness to the applicant of excluding the evidence in question, including prejudice to the applicant if it is unable to rely on such evidence.”

24. Despite being given an opportunity to provide submissions on the matter, the opponent has not identified any specific injustice or unfairness it would face, or that it would be prejudiced in any way. On the other hand, the applicant may be prejudiced by having evidence which goes to an important aspect of its case from being excluded. The evidence relates to the nature of the product and, in particular, the online offering. As will become apparent, this is an important part of my consideration. Given that the evidence is material to the matters at hand, although not necessarily determinative, I admitted the evidence into the proceedings.

25. In terms of this evidence, it consists of a witness statement from Ms Philippa Malas, a trade mark attorney at Kilburn & Strode. It can be broken down as follows:

- An explanation that the CD offering of THE GLOBAL CEMENT REPORT has been provided alongside the print version since the 4th edition in 2000. An advertisement for the January 2002 edition, which depicts the CD alongside the print version, can be seen in Exhibit PM1.

- A statement that an online statistical database under the name THE GLOBAL CEMENT REPORT has been offered alongside the print version since the 11th Edition in June 2015. This is described by Ms Malas as an evolution of the CD offering. Exhibit PM2 contains an archive web print from 2 July 2015 headed Global Cement Report Database June 2015. It has a data export facility.

- A statement that an online complementary plant database under the name THE GLOBAL CEMENT REPORT has been offered since the 4th Edition in December 2000. To support this, the following exhibits are provided:
 - Exhibit PM3 contains archive web prints from 2001 and 2002. They both show that users can browse/explore a sample of data from 15 countries for free. The first print states that 10 years' worth of data may be sampled, with the full data being available to buy in The Global Cement Report. There is no suggestion that the full data is available online. The words GLOBAL CEMENT REPORT are clearly used, in this case below the stylised words INTERNATIONAL CEMENT REVIEW.

 - Exhibit PM4 contains archive prints showing what users of these sample pages obtain. GLOBAL CEMENT REPORT appears a number of times, the data provided includes information about individual plants.

 - Exhibit PM5 contains a current print of how the online offering is presented. However, as this is from well after the relevant date, I take no cognisance of this.

- Two other points are made (although I consider them to have little pertinence) about outdated versions of the print copy being available on Google Books since 2008 and that the applicant is the registrant of the domain name globalcementreport.com since 2004.

The sections 3(1)(b) and (c) grounds of opposition

26. I find it convenient to start with these two grounds of opposition, the provisions of which prevent, respectively, registration of trade marks which are “..devoid of any distinctive character” or “..consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services”.

27. Even if a mark falls foul of these grounds, there is a proviso to section 3(1) which means that a registration shall not be refused if the trade mark has acquired a distinctive character through use prior to the date of the application for registration. This is something relied upon by the applicant if I were to consider that the mark is not, *prima facie*, acceptable. I return to the acquired distinctiveness provisions shortly.

28. I bear in mind that these grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under section 3(1)(b) of the Act. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union (“CJEU”) stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

29. In terms of section 3(1)(c), this is the equivalent of Article 7(1)(c) of the Community Trade Mark Regulation, the case-law of which was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 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, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C- 191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. 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*, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , 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 Melkuniei*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), 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 38). 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).

and

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 art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

30. In terms of section 3(1)(b), this is the equivalent of article 7(1)(b) of the Regulation, the principles of which were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) 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.

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 *Proctor & 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)."

Analysis and *prima facie* findings

31. Mr Carter's skeleton argument appeared to accept that the mark was *prima facie* descriptive in respect of a narrow part of the specification. When I asked him for clarification of this, he indicated that what had been written was not well put and that what he really meant was that the words had some descriptive elements, but were not descriptive overall. He submitted that the addition of the definite article helped and that the mark was not descriptive in relation to other industries (beyond cement).

32. Registration of the mark is sought in relation to:

Class 35: Providing business information via a website; analysis of market research data and statistics; statistics (compilation of-); compilation of company information.

Class 41: Publication of texts, books, magazines and other printed matter; publication of electronic books and journals on-line.

33. The words THE GLOBAL CEMENT REPORT leave little to the imagination. A REPORT is a report. The word CEMENT clearly relates to the field of interest, a field which would be covered by the various information, analysis, statistical or publication services covered by the specification. The word GLOBAL indicates that the data relates to the international or global market. Indeed, it is accepted, at the very least, that GLOBAL CEMENT is descriptive in this context (as per Mr Hargreaves' email) and there are frequent uses in the evidence by those in the trade of the word global in this context. I come to the clear view that GLOBAL CEMENT REPORT merely describes a report about the global cement market. In terms of the definite article, its use does not stand out in any way and simply contributes to the overall descriptive message. All of the services could either consist of, make use of, or provide, such a report to a potential consumer. I conclude that the mark falls foul of section 3(1)(c) given its descriptive nature and, it follows, section 3(1)(b) due to the mark's consequential inability to function as a badge of trade origin. The point about uses in other industries does not assist. This is for two reasons: i) no fall-back position has been put forward upon which to make any other form of alternative assessment and, ii) the words encountered on anything covered by the specification, even if they ultimately do not relate to the field of cement (and thus not strictly descriptive) would still not strike the relevant public as a badge of trade origin and would still fall foul of section 3(1)(b).

Acquired distinctiveness

34. The CJEU provided guidance in *Windsurfing Chiemsee*, Joined cases C-108 & C-109/97 about the correct approach with regard to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a

particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37).”

35. I bear in mind that the application before the tribunal is not in respect of goods, i.e. the publication in print or CD form¹, but, rather, relates to a service which provides information/data in electronic form. Nevertheless, it is useful to assess the use that has been made in relation to the goods given that i) the service(s) are said, in part, to be an evolution of the goods offering and ii) to take account of Mr Carter’s submission (which I accept in principle) that distinctiveness may more easily be acquired on the back of an existing form of use.

36. In terms of the use in relation to the goods, there is major gap in the evidence. The applicant has not provided any evidence about the circulation of the print or CD version of the publication, it has provided no sales figures, no advertising figures, nor any market share data. The applicant leaves it to the trade witnesses to make various unsupported estimates and assumptions. In relation to such estimates and

¹ Such things are goods which fall in classes 16 and 9 respectively

assumptions, little weight can be given to them due to the speculative nature of the comments, and, further, one does not know how the witnesses were selected nor what they were asked to say. The opponent also gives its own estimate (placing it at a low level of sales/circulation), an estimate which itself lowered between its first and second witness statement. The true factual position could easily have been set out by Mr Hargreaves in his evidence on behalf of the applicant, but he gives little by way of objective detail. Furthermore, although the applicant sought leave to file additional evidence on certain points, it did not ask to file further evidence to clarify these points. These are matters that do not go in the applicant's favour.

37. Despite the above, I accept, in general terms, that The Global Cement Report does appear to be an important publication, particularly with individuals who need the data contained therein for the purposes of investment/stockbroking analysis in the cement field. This is the sense that one gets from the trade witnesses. I also accept that the publication has been going for a number of years (since around 1994), so its use is fairly longstanding. I also bear in mind that it is often the case that names of repeat publications are descriptive to varying degrees yet nevertheless appear to function as trade marks in their own right.

38. What is more difficult to assess is the significance that would be given to the name. The Court of Appeal in *Nestlé v Cadbury* [2017] EWCA Civ 358 summarised the CJEU's judgement on a reference that had been made in those proceedings as follows:

"41. As I have said, the CJEU gave judgment on 16 September 2015 (Case C-215/14). It summarised the issue concerning acquired distinctiveness as follows:

"24 Secondly, as regards the question of whether the trade mark at issue had acquired distinctive character through the use made of it prior to the relevant date, the referring court, after reviewing the relevant case-law, seeks to ascertain whether, in order to establish that a trade mark has acquired distinctive character, it is sufficient that, at the relevant date, a significant proportion of the relevant class of persons recognise the trade

mark and associate it with the trade mark applicant's goods. The referring court takes the view that the trade mark applicant must prove that a significant proportion of the relevant class of persons regard the trade mark (as opposed to any other trade mark which may also be present) as indicating the origin of the goods."

42. It can be seen that the Court here regarded the judge's preliminary view as being that the applicant for the trade mark must establish that a significant proportion of the relevant class of persons regard the trade mark (as opposed to any other trade mark which may also be present) as indicating the origin of the goods.

43. The Court began its substantive consideration of the referred question a little later at [58], and did so by recasting it:

"58 By its first question the referring court asks, in essence, whether an applicant to register a trade mark which has acquired a distinctive character following the use which has been made of it within the meaning of Article 3(3) of Directive 2008/95 must prove that the relevant class of persons perceive the goods or services designated exclusively by that mark, as opposed to any other mark which might also be present, as originating from a particular company, or whether it is sufficient for that applicant to prove that a significant proportion of the relevant class of persons recognise that mark and associate it with the applicant's goods."

44. In this formulation the Court has drawn a distinction between, on the one hand, an applicant proving that as a result of the use he has made of the mark, the relevant class of persons perceive the goods designated exclusively by that mark, as opposed to any other mark which might also be present, as originating from a particular source and, on the other hand, an applicant proving only that a significant proportion of the relevant class of persons recognise the mark and associate it with the applicant's goods.

45. In answering the question, the Court began by reiterating that the essential function of a trade mark is to guarantee the identity of the origin of the designated goods and to enable the consumer to distinguish the goods from those which have another origin without any possibility of confusion:

"59 It must be recalled at the outset in this connection that the essential function of a trade mark is to guarantee the identity of the origin of the designated goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from those which have another origin (judgment in *Philips*, C-299/99, [EU:C:2002:377](#), paragraph 30).

60 Through its distinctive character, a trade mark must serve to identify the goods or services covered by that mark as originating from a particular undertaking, and thus to distinguish the goods or services in question from those of other undertakings (see, to that effect, judgments in *Windsurfing Chiemsee*, C-108/97 and C-109/97, [EU:C:1999:230](#), paragraph 46; *Philips*, C-299/99, [EU:C:2002:377](#), paragraph 35, and *Oberbank*, C-217/13 and C-218/13, [EU:C:2014:2012](#), paragraph 38)."

46. There followed a restatement of how distinctive character must be assessed and that it may be intrinsic or acquired:

"61 That distinctive character must be assessed in relation, on the one hand, to the goods or services covered by that mark and, on the other, to the presumed expectations of the relevant class of persons, that is to say, an average consumer of the category of goods or services in question, who is reasonably well-informed and reasonably observant and circumspect (see, to that effect, judgments in *Koninklijke KPN Nederland*, C-363/99, [EU:C:2004:86](#), paragraph 34 and the case-law cited therein; *Nestlé*, C-353/03, [EU:C:2005:432](#), paragraph 25, and *Oberbank*, C-217/13 and C-218/13, [EU:C:2014:2012](#), paragraph 39).

62 A sign's distinctive character, which thus constitutes one of the general conditions to be met before that sign can be registered as a trade mark, may be intrinsic, as provided for in Article 3(1)(b) of Directive 2008/95, or may have been acquired by the use made of that sign, as provided for in Article 3(3) of that directive."

47. Against this background, the Court turned to the acquisition of distinctive character and explained that it must be as a result of the use of the mark as a trade mark, that is to say for the purposes of the identification of the goods as originating from a particular undertaking:

"63 So far as, specifically, the acquisition of distinctive character in accordance with Article 3(3) of Directive 2008/95 is concerned, the expression 'use of the mark as a trade mark' must be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the goods or services as originating from a given undertaking (judgment in *Nestlé*, C-353/03, [EU:C:2005:432](#), paragraph 29).

48. The Court acknowledged that a mark may acquire distinctive character as a result of its use in conjunction with another mark but explained that the use must have been such that consumers actually perceive the goods, designated exclusively by the mark applied for, as originating from a particular undertaking:

"64 Admittedly, the Court has acknowledged that such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. However, it has added that in both cases it is important that, in consequence of such use, the relevant class of persons actually perceive the goods or services, designated exclusively by the mark applied for, as originating from a given undertaking (judgment in *Nestlé*, C-353/03, [EU:C:2005:432](#), paragraph 30, and, in connection with Regulation No 40/94, Article 7(3) of which corresponds, in essence, to

Article 3(3) of Directive 2008/95, the judgment in *Colloseum Holding*, C-12/12, EU:C:2013:253, paragraph 27).

65. Therefore, regardless of whether the sign is used as part of a registered trade mark or in conjunction with the registered trade mark, the fundamental condition is that, as a consequence of that use, the sign for which registration as a trade mark is sought may serve to identify, in the minds of the relevant class of persons, the goods to which it relates as originating from a particular undertaking (see, to that effect, judgment in *Colloseum Holding*, C-12/12, EU:C:2013:253, paragraph 28).

66 It must therefore be concluded, as indicated in points 48 to 52 of the Advocate General's Opinion, that although the trade mark for which registration is sought may have been used as part of a registered trade mark or in conjunction with such a mark, the fact remains that, for the purposes of the registration of the mark itself, the trade mark applicant must prove that that mark alone, as opposed to any other trade mark which may also be present, identifies the particular undertaking from which the goods originate."

49. Finally, the Court answered the question:

"67 Having regard to those considerations, the answer to the first question is that, in order to obtain registration of a trade mark which has acquired a distinctive character following the use which has been made of it within the meaning of Article 3(3) of Directive 2008/95, regardless of whether that use is as part of another registered trade mark or in conjunction with such a mark, the trade mark applicant must prove that the relevant class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company.'"

39. The issue that arises in these proceedings is that the use of the mark is accompanied by the stylised words INTERNATIONAL CEMENT REVIEW. Indeed, it

is clear from the evidence as a whole that The Global Cement Report is simply a report (about the global cement industry) published by the producers of the INTERNATIONAL CEMENT REVIEW. Given the nature of such use, and also given what I regard as the very descriptive nature of the subject mark, there is a clear risk that the name The Global Cement Report alone does not designate an exclusive trade origin. Some of the applicant's trade witnesses talk of recognition. However, it does not follow that recognition equates to the mark itself designating an exclusive trade origin. Furthermore, my observations about the selection of the witnesses apply in equal measure here. Further again, it is clear that the witnesses were asked for opinions on certain matters, but the tribunal does not know exactly what was asked. For example, Mr Clark stated that he was asked if the name would be recognised as a publication of the applicant with him then estimating that around 80% would know that the name was a publication of the applicant. Even if Mr Clark has recounted what he was asked with sufficient precision, what he was asked appears to have been leading and, in response, his answer smacks solely of recognition. I accept that some of the other witnesses put matters in slightly different ways, but, overall, the evidence is weak in showing, even in respect of the printed and CD version of the goods, that the trade perceive the mark alone as a designation of an exclusive trade origin. The strength of the evidence is further undermined by the absence of anything to show how statistically representative the witnesses are. In reaching these views, I have placed little weight on the opponent's evidential statements that if INTERNATIONAL CEMENT REVIEW were not displayed "consumers would not be able to identify the publisher of the publication". This is because the consumer does not need to be able to identify the undertaking responsible for the goods, the test is simply whether the sign designates an exclusive commercial origin.

40. With all of the above in mind, I now turn to the services for which the mark has been applied. What I have said about the circulation/sales figures applies in equal measure in relation to the services. There is no evidence showing how many times users have assessed the claimed online offering.

41. A further issue between the parties relates to what has actually been provided by way of the services. The applicant states that what the opponent describes as the

“companion database” is actually named The Global Plant Database. In my summary of the evidence, I highlighted that the position was not clear (see paragraph 8 above). None of the applicant’s trade witnesses provide sufficient objective detail to shed any light on the matter. However, what I do note is that the applicant’s further evidence, which was intended to clarify such matters, shows not what the witness describes as a companion database, but, instead, the provision, online, of sample extracts from The Global Cement Report, presumably with the intention of enticing users to purchase the print/CD version itself. It was only much later (not long before the relevant date) that the offering really “evolved” (using Ms Malas’s own words) into an online version.

42. Given a combination of: i) the lack of any turnover/sales figures for the publication itself, ii) the doubts over the significance of the name itself as designating trade origin, iii) that this is an off-shoot of a monthly publication with a different name (with that name also appearing on the off-shoot), iv) what I regard as the highly descriptive nature of the subject mark, v) that other than the short period of time before the relevant date, any use online was in respect of sample extracts, vi) any true online offering has been for only a period of little more than six weeks², and vii) no access figures for either the sample facility or the online offering have been given, it has not been shown that a significant proportion of the relevant public identify the services as originating from a particular undertaking because of the use of the mark.

Section 3(3)(b)

43. I do not consider it necessary or proportionate to discuss this final ground of opposition. This is because: i) the opponent has already succeeded, and, ii) even if my decision is overturned on appeal and that, in fact, the mark had acquired a distinctive character through use, some form of limited specification would need to be crafted to reflect the use made, a specification which would then likely remove any argument under this ground.

² Even if the first publication to appear as part of the online offering was from June 2015, the archive print itself is dated 2 July 2015.

Conclusion

44. The opposition succeeds and, subject to appeal, the application for registration is refused.

Costs

45. Although the opponent has succeeded, I decline to award costs due to the wasted time expended in dealing with its initial claim under section 5(2). Neither side is to be favoured with an award of costs.

Dated this 31st day of January 2018

Oliver Morris

For the Registrar,

The Comptroller-General