

## **TRADE MARKS ACT 1994**

### **IN THE MATTER OF APPLICATION No 2276979 BY FOIA CENTRE TO REGISTER A TRADE MARK IN CLASS 35**

#### **DECISION AND GROUNDS OF DECISION**

##### **Background**

1. On 2<sup>nd</sup> of August 2001 FOIA Centre of 274 Hither Green Lane, London, SE13 6TT applied to register the trade mark **FOIA Centre** in Class 35.
2. Objection was taken under Section 3(1)(b) and (c) of the Act because the mark consists exclusively of the acronym FOIA (meaning Freedom of Information Act) and the word Centre, the whole being a sign which other traders may freely and legitimately wish to use in the course of their business to designate the nature of their services, eg information and advisory services in respect of the Freedom of Information Act being provided from a specific place.
3. It was subsequently agreed that the specification of goods be amended to read as follows:  
  
Class 35      Provision of business research services, in particular retrieving information/data and records related thereto under the Freedom of Information Act 2000, Data Protection Act 1998 and other legal provisions in the UK and elsewhere.
4. At a hearing, at which the applicants were represented by Mr Watts, the objection was maintained.
5. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.
6. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

##### **The Law**

7. Section 3(1)(b) and (c) of the Act reads as follows:

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

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade,

to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,”

## **The Decision**

8. At the hearing Mr Watts submitted that the letters FOIA are not to be found in any dictionary in the United Kingdom. Mr Watts accepted that the letters FOIA are recognised in the USA as an acronym for Freedom of Information Act but submitted that it would not be so recognised in the United Kingdom. In a further submission Mr Watts suggested that the combination of the letters FOIA with the word CENTRE creates a distinctive mark.

9. I did not issue a decision at the hearing. Instead, further research was conducted with the purpose of determining if the letters FOIA would be recognised in the United Kingdom as an acronym for Freedom of Information Act. The results of that research were forwarded to Mr Watts on 9<sup>th</sup> May 2002 and the objection was maintained. Copies of those documents are at Annex A.

10. In subsequent correspondence Mr Watts made further submissions that the documents forwarded in support of the objection were inconclusive in that they referred to papers which were aimed at highly specialised audiences and repeated his claim that the letters FOIA would not be recognised in the UK as an acronym for the Freedom of Information Act.

11. In my view these documents clearly demonstrate the very opposite. It is clear from these documents that, at the relevant date, the letters FOIA were in common use as an acronym for the Freedom of Information Act. The documents show the letters FOIA in use as an acronym for the Freedom of Information Act in press releases and on documents which are easily and readily available to the general public and professionals alike. Furthermore, I note that the document entitled “Access to Information in Local Government” makes it clear that the Freedom of Information Act 2000 has been given Royal Assent and, at the relevant date, was in the process of being implemented across the public sector.

12. Having determined that the letters FOIA would, at the relevant date, be recognised within the United Kingdom as an acronym for the Freedom of Information Act I must now consider if the mark applied for, the letters FOIA in combination with the word CENTRE create a combination which is not descriptive of any characteristic of the services applied for and is distinctive in that it is capable of denoting the trade origin of the services provided under that sign. Two of the definitions attributed to the word CENTRE in Collins English Dictionary (Third Edition Updated 1994) are:

- “4. A place at which some specified activity is concentrated: a shopping centre.
- 6. a place of activity or influence: a centre of power.”

13. In my view the word CENTRE when used in combination with the letters FOIA do no more than describe a place where services relating to the Freedom of Information Act are provided.

14. In a judgement issued by the European Court of Justice on 20 September 2001, *Procter & Gamble Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case - 383/99P, (the BABY-DRY case), the Court gives guidance on the scope and purpose of Article 7(1)(c) of the community Trade Mark Regulation (equivalent to Section 3(1)(c) of the Trade Marks Act).

15. Paragraphs 37, 39 and 40 of the judgement are reproduced below:

*“37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Procter & Gamble and the OHIM acknowledge, to prevent registration as trade marks signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character deeded for that function.”*

*“39. The signs and indications referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other sign or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.”*

*“40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”*

16. In my view the combination of the letters FOIA with the word CENTRE do not create a sign which is in any way different from the usual way of describing the services in question. I conclude that the relevant public would, upon encountering the term FOIA CENTRE in relation to the services for which registration is sought, see the term as a description of the nature of the services provided. Therefore I consider the mark to consist exclusively of signs which may serve in trade to designate the kind of services and it is, therefore, excluded from registration by Section 3(1)(c) of the Act.

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

18. In the “Companyline” decision (C-104/00 ECJ) the following comments were made:

*“26. In this case, the sign is composed exclusively of the words ‘company’ and ‘line’, both of which are customary in English-speaking countries. The word ‘company’ suggests that what is in point are goods or services intended for companies or firms. The word ‘line’ has various meanings. In the insurance and financial services sector it denotes, amongst other things, a branch of insurance or a line or group of products. They are thus generic words which simply denote a line of goods or services for undertakings. Coupling them together without any graphic or semantic modification does not imbue them with any additional characteristic such as to render the sign, taken as a whole, capable of distinguishing the applicant’s services from those of other undertakings. The fact that the word ‘Companyline’ as such does not appear in dictionaries - whether as one word or otherwise - does not in any way alter that finding.*

*27. Consequently, the sign ‘Companyline’ is devoid of any distinctive character.”*

19. Further support is to be found in the “Cycling IS...” decision (series of two marks), dated 28<sup>th</sup> November 2001 and as yet unreported, Geoffrey Hobbs QC, acting in his capacity as the Appointed Person made the following comments:

*“66. That brings me to the question of whether the signs possess a distinctive character enabling them to fulfil the essential function of a trade mark in relation to goods and services of the kind specified in the application for registration. (The goods and services comprise “clothing, footwear and headgear” in Class 25 and “advertising, all relating to the cycling industry” in class 35).*

*67. The case for allowing registration rests upon the proposition that the signs are cryptic to a degree which makes it more likely than not that they would carry connotations of trade origin (whatever other connotations they might also carry) in the minds of the relevant class of persons or at least a significant proportion thereof.*

*68. The case for refusing registration rests upon the proposition that the signs are visually and linguistically meaningful in a way which is more likely than not to relate the goods and services to the activity of cycling without also serving to identify trade origin in the minds of the relevant class of persons.*

*69. The difference between these two positions resides in the question whether the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin specific or origin neutral.*

*70. The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonable observant and circumspect.*

*71. I do not suppose that such a person would pause to construe the signs when*

*encountering them in any of the different settings (including advertising and promotional settings) in which they might be used. Even so, the degree of attention required to take note of the signs in the first place would be sufficient, in my view, to leave a well-informed and reasonably observant and circumspect person with the clear impression that the signs were being used with reference to goods and services related to cycling.”*

20. Mr Hobbs went on to observe:

*“73. Doing the best I can on the materials before me, I think that the signs in question would be perceived by the relevant class of persons as pronouncements in identifying cycling as the raison d’être for the marketing of the goods and services to which they are related. That is a message that the members of a consortium of bicycle retailers might naturally be interested in putting across to customers and potential customers. I do not think that the nature of the pronouncement or its presentation can in either case be regarded as sufficiently striking to function as an indication of trade origin in relation to goods or services of the kind specified in the application for registration that is now before me.*

*74. It seems to me that the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin neutral (relating to the general commercial context of the relevant trading activities) rather than origin specific.”*

21. It is my view that even if the mark is not a description of a characteristic of the services, it is a combination of such a term FOIA and a description of a place where such services would naturally be provided (centre). Because the average consumer would not expect all centres providing services relating to the Freedom of Information Act (FOIA) to be conducted by economically linked undertakings, the mark is devoid of distinctive character.

## **Conclusion**

22. In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) and (c) of the Act.

**Dated this 12<sup>th</sup> day of December 2002.**

**A J PIKE  
For the Registrar  
The Comptroller General**

Annex A: Available as ‘order a copy’.