O-169-03

TRADE MARKS ACT 1994

IN THE MATTER OF
APPLICATION No 2296095
BY B & Q plc
TO REGISTER A TRADE MARK
IN CLASS 36

DECISION AND GROUNDS OF DECISION

Background

1. On 21 March 2002 B & Q plc of Portswood House, 1 Hampshire Corporate Park, Chandlers Ford, Eastleigh, Hampshire, SO5 3YX applied to register the trade mark **YOU CAN DO IT** for the following services:

Class 36 Leasing of real estate, real estate management, financial evaluation of real estate; financial services and services for the provision of credit; financial information; transfer of electronic funds; extended warranty insurance; services relating to insurance tokens of value and credit cards; credit card services; in-house store cards and loyalty cards; insurance services; insurance brokerage; reinsurance services; provision of life assurance services, home insurance services, and insurance services relating to motor vehicles; advisory information and consultancy services relating to the aforesaid goods.

2. Objection was taken under Section 3(1)(b) of the Act because the mark consists of the words **YOU CAN DO IT** the whole being devoid of any distinctive character and is considered to be the kind of mark that others may wish to use during the course of trade and should be free to do so.

3. Objection was also taken to the following terms contained within the specification applied for:

"services relating to insurance tokens of value"

"in house store cards and loyalty cards"

4. At a hearing at which the applicants were represented by Mr Furneaux of Rouse & Co International, their trade mark attorneys, 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) of the Act reads as follows:

> "3.-(1) The following shall not be registered-
>
> (b) trade marks which are devoid of any distinctive character,

The Case for Registration

8. In correspondence prior to the hearing Mr Furneaux made the following submissions in two letters dated 10 May 2002 and 7 August 2002.

9. In his letter of 10 May 2002 Mr Furneaux referred to the applicants' UK registration No 2196681B and Community application No 1973155, both of which are for the mark **YOU CAN DO IT WHEN YOU B & Q IT**. It was suggested by Mr Furneaux that these would enable the applicant to bring infringement action under Section 10(2) and/or 10(3) of the Act should a third party use the words **YOU CAN DO IT** in a trade mark sense. In support of his submissions that the trade mark applied for is distinctive Mr Furneaux referred me to the High Court judgement in West (trading as Eastenders) v Fuller Smith & Turner Plc - ESB and to the comments made by the Court of First Instance of the ECJ "The Principle of Comfort" [2002] ETMR 430. Mr Furneaux also attached a copy of the applicants' brochure entitled Outdoor Life 2002. This brochure provides details of a store card which is promoted as both the **B & Q You Can Do It** card and as the **You can Do It** card.

10. In his letter of 7 August 2002 Mr Furneaux referred me to the decision of the European Court of Justice in *Windsurfing Chiemsee* (CU108/97) and to a later decision by the same court in the *Baby-Dry* case [2002] ETMR 3. Mr Furneaux went on to provide me with the following quotations from the decision by the European Court of Justice in the *New Born Baby* case (ZAPF Creation v OHIM):

> *" the distinctive character of a sign must be assessed in relation to the goods or services in respect of whether registration was claimed"* and
>
> *"The lack of distinctiveness could not be found merely because a sign was said to be unimaginative."*

11. Finally Mr Furneaux provided extracts from a UK "Google search" which outlines hits of UK web pages for the trade mark **YOU CAN DO IT**. It was suggested that the results of this search indicate that there are no instances of financial firms making "common use" of the mark applied for in advertising.

12. At the hearing Mr Furneaux referred me to several registered trade marks which, it was suggested, are so similar to the trade mark applied for that I should waive the objection to this application. I advised Mr Furneaux that I am bound to consider the merits of this application and that I cannot be persuaded otherwise simply by reference to other registered marks.

Decision

13. The test to be applied in respect of this application is not whether the mark, in its totality, is a combination which is used in common parlance to describe the services applied for but whether the mark, again in its totality, is devoid of any distinctive character. The whole purpose of Section 3(1)(b) is to prohibit registration of signs which, although not caught by the clear parameters set out by Sections 3(1)(c) and (d) are, nevertheless, incapable of distinguishing the goods and services of one undertaking from those of other undertakings.

14. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 46 to 47 of its Judgment in Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG (8th April 2003) in the following terms:

> *"37. It must first of all be observed that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.*
>
> .....
>
> *39. Next, pursuant to the rule 1 Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.*
>
> *40. For a mark to possess distinctive character within the meaning 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 products of other undertakings (see Philips [2002] ECR I-5475, paragraph 35).*
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> *41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 Gut Springenheide and Tusky [1998] ECR I-4657, paragraph 31, and Philips, paragraph 63).*
>
> .....
>
> *47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.*

15. The Registrar's **Practice Amendment Notice (PAN) 7/02** on **Slogans** says, at paragraph 13, that:

> " a mark that is free from objection under Section 3(1)(c) may still be devoid of any distinctive character because it sends a message that could apply to any undertaking and is not therefore capable of individualising the goods or services of one undertaking."

16. This notice goes on to suggest areas where an objection under Section 3(1)(b) may be relevant but does not purport to give an exhaustive list.

17. It is essential that the distinctive character of a trade mark is assessed in relation to the services for which the applicant seeks registration. The specification for which registration is sought covers a very wide range of services in Class 36. However, the only example of the mark in use in relation to any of these services is the copy of the brochure entitled OUTDOOR LIFE 2002 which was attached to Mr Furneaux's letter of 10 May 2002. This provides an example of the trade mark in use in relation to what appears to be the facilitation of credit facilities by the provision of a store/charge card.

18. I must, of course, assume fair and notional use of the mark in relation to the provision of the services applied for. Such use includes use in advertising wherein it is customary for advertisements to use abbreviated language, a notion endorsed by Mr Simon Thorley QC sitting as the Appointed Person in "Where All Your Favourites Come together" - see BL 0/320/01.

19. I accept that the test for registering slogans is no different than for any other type of marks but as slogans are often used for advertising purposes they may not be so readily accepted by the general public as an indication of trade source as would more traditional signs such as words, brands, logos and figurative marks (See the Judgement of The Court of First Instance in "REAL PEOPLE, REAL SOLUTIONS" - Case T-130/01 5 December 2002. I also accept that lack of originality per se is not fatal to the outcome of the application for registration.

20. I bear in mind the suggestion by Mr Furneaux (paragraph 9 of this decision refers) that the applicant would be successful in an infringement action under Section 10(2) and/or 10(3) of the Act should a third party use the words **YOU CAN DO IT** in a trade mark sense. I understand this to be based on earlier registrations for the mark **YOU CAN DO IT WHEN YOU B&Q IT**. I do not accept that this assists the case for registration. I find support for this conclusion in the Judgement of Mr Rimer J in the HAVE A BREAK decision- [2002] EWHC 2533 (Ch)- where he found that the use and registration of the trade mark HAVE A BREAK, HAVE A KIT KAT is insufficient to justify the registration of the trade mark HAVE A BREAK even if t is considered to be a similar sign.

21. The trade mark applied for must be assessed by reference to how the mark is perceived by the relevant consumer who, in respect of the services contained within the specification applied for are, in my view, the general public. I should make it clear that although a copy of the applicants' brochure entitled Outdoor Life 2002 is on file (see paragraph 9 of this decision) I am not considering a case of acquired distinctiveness through use of the trade mark applied for.

22. In my view the relevant public, bearing in mind that financial services, including the provision of store/charge cards are services that are in common supply from a large number of sources, would not consider this mark to denote trade origin. In respect of the credit services contained within the specification applied for this sign will convey the simple, but direct and unmistakable message, that by taking advantage of the credit facilities available from the applicants **YOU**, ie ordinary members of the public, **CAN DO IT** i.e. you can obtain or achieve whatever it is you require or want. Furthermore, when considering the sign in relation to all of the services claimed, the sign will do no more than convey a similar if not identical message.

23. I am not persuaded that the words **YOU CAN DO IT** in combination are distinctive in that they would serve in trade to distinguish the goods and services of the applicant from those of other traders. In my view the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

Conclusion

24. 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 Section 3(1)(b) of the Act.

Dated this 23rd day of June 2003.

A J PIKE
For the Registrar
The Comptroller General