

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2294296A BY LAND
SECURITIES PLC TO REGISTER A TRADE MARK IN CLASSES 16, 20, 35,
36, 37, 38, 39, 41, 42, 43, 44 & 45**

DECISION

Introduction

1. This is an appeal against a written decision of Mr. Charles Hamilton, the Hearing Officer acting for the Registrar, dated the 12th day of January 2004. In his decision the Hearing Officer refused the application by Land Securities Plc (“the Applicant”) to register the trade mark MAKING PROPERTY WORK (“the Mark”).
2. Registration was sought in respect of the following specification of goods and services:

Class 16:

Printed publications relating to property, property portfolio management, property development, property services and urban regeneration.

Class 20:

Office furniture.

Class 35:

Management of commercial premises; management of retail premises; management of offices; facilities management; reception services and management; post-room services and management; the bringing together, for the benefit of others, a variety of retail outlets, entertainment, housing and business facilities, enabling customers to conveniently purchase goods and services in a built community environment; secretarial services; accounting; telephone answering; document reproduction, photocopying, word processing, typing, transcription; business information; office machines and equipment rental.

Class 36:

Property acquisition and sale; property management and administration; property portfolio management and administration; property and capital investment; property appraisals and valuations; property brokerage; estate management; advisory and information services all relating to the aforesaid; rental of property; rental of housing accommodation; rental of retail premises; rental of offices; rental of industrial premises; rental of retail warehouses; leasing of property; leasing of housing accommodation; leasing of retail premises; leasing of offices; leasing of industrial premises; leasing of retail warehouses; arranging leases for the aforesaid; rent collection services; provision of housing accommodation; provision of retail space; provision of office space; provision of industrial space; provision of retail warehouse space; billing services in relation to telecommunications service providers and meter reading.

Class 37:

Property development; development of sites for commercial and industrial purposes; infrastructure development; building construction; building construction services; construction management services; building construction supervision; construction advisory services; building project management; restoration, renovation and refurbishment of property and buildings; urban regeneration including any of the aforesaid services; maintenance, repair and installation services all relating to property, buildings and real estate; landscaping services; cleaning of buildings; maintenance, repair and installation services all relating to telecommunications apparatus and equipment; maintenance, repair and installation services all relating to office equipment and fitting; upholstery repair; dry cleaning; cleaning services; advisory services relating to asbestos removal; lift maintenance.

Class 38:

Telecommunications services; provision of telecommunication services enabling end-users to connect to providers of

telecommunication services and to application service providers; provision of user access to a global computer network; provision of telecommunication connections to a global computer network; electronic mail services; audio conferencing services; applications outsourcing services; communication services; voice, data and video communication services; voice-mail services; video conference services; video streaming services; video and audio content- based broadband services; Internet protocol telephony and facsimile services; virtual private network services; voice-mail services; telecommunication network services; organisation of telecommunication networks; provision of server co-location management services; provision of information relating to telecommunications; telecommunication services relating to the delivery of emergency messages; local and long distance telephone services; Internet directory services; high- speed Internet access services (dedicated and dial-up connections); high-speed data interconnect and access services; rental of telecommunication equipment.

Class 39:

Provision and management of car parking facilities; portering services; electrical supply services; gas supply services; gas distribution services.

Class 41:

Provision of sporting, entertainment and cultural facilities; provision of creche and nursery facilities; provision of exhibition and gallery facilities; provision of children's playgrounds; providing on-line electronic publications [not downloadable]; arranging and organising of conferences.

Class 42

Conducting feasibility studies; construction design services; architectural, engineering, survey and planning services all relating to property and property development; inspection of buildings; interior design services; advisory services relating to the aforesaid; development and management of a customer interface to manage outsourced computer and telecommunications resources; enterprise resource planning (erp) services; web-hosting (content housing); providing access time to a computer database; design and implementation of telecommunication network systems, wide area networks and local area networks, desktop management services; rental of computers; consultancy and information services, relating to health and safety.

Class 43:

Café, restaurant, bar and catering services; rental of office furniture.

Class 44:

Provision of beauty salon facilities.

Class 45:

Fire safety consultancy services; intruder detection; security guard services for buildings; security services; security surveillance; arranging security services for buildings; concierge services.

3. The application was refused under s.3(1)(c) of the Trade Marks Act 1994 in relation to the specified goods and services in classes 16, 35, 36, 37, 39, 41 and 42 and under s.3(1)(b) of the Act in relation to all the specified goods and services. On the 9th February 2004 the Applicant gave notice of appeal to an Appointed Person against that decision.

The decision of the Hearing Officer

4. There was no evidence before the Hearing Officer of any use of the Mark and accordingly he had only the prima facie case to consider.
5. As to section 3(1)(c) of the Act, the Hearing Officer was of the view that the Mark comprised a slogan which was not an unusual way of describing the Applicant's goods and services and therefore it would not serve to distinguish those goods and services from those provided by other undertakings. Without any evidence to persuade him to the contrary, he believed that the Mark might serve in normal usage from a consumer's point of view to designate one of the essential characteristics of the goods and services in issue. He was also of the view that the Mark would be perceived by the relevant public as merely advertising or promotional material and was a phrase which should be kept free for use by others.

6. The Hearing Officer supported this conclusion by carrying out a search of the internet which revealed that the phrase MAKING PROPERTY WORK was used by other businesses both descriptively and as an advertising slogan. So, for example, a firm called Welburn & Co advertised its property and real estate business under the description “Building the future, considering the environment, making property work for you”. Similarly, a business called Piccadilly Estate Management advertised itself using the slogan “Making Property work for people”; and the property company Allied London Properties Plc described itself as “committed to making property work through innovation, dedication and partnership”.
7. In all the circumstances the Hearing Officer concluded that the Mark was a combination of words which might serve in trade to designate characteristics of the goods and services covered by the application and was therefore barred from registration by s.3(1)(c) of the Act.
8. For similar reasons, the Hearing Officer concluded that the mark was also barred from registration by section 3(1)(b) of the Act. He took the view that the Mark was likely to be perceived by the average consumer as an advertising pronouncement and that it would not function as an indication of trade origin.

The Appeal

9. On the appeal, Mr. Lowe of Nabarro Nathanson appeared on behalf of the Applicant and Mr. James appeared on behalf of the Registrar.

Section 3(1)(c)

10. It was submitted on behalf of the Applicant that the Hearing Officer fell into error in his analysis in that he failed to apply the right test. He ought to have considered whether the phrase MAKING PROPERTY WORK was the usual way of describing any of the specified goods or services or their characteristics. Had he done so then, it was submitted, he ought to have found the phrase had no natural or obvious meaning and was not the usual way of designating any of those goods and services. In support of these submissions Mr. Lowe relied, in particular, upon the decision of the European Court of Justice in Case C-383/99P *Procter & Gamble (BABY – DRY)* [2002] RPC 17.

The Court held:

"37. It is clear from those two previous 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 OHIM acknowledge, to prevent registration as trade marks of 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 needed for that function.

...

39. The signs and indications referred to in Article 7(1)(c) of Regulation No 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 signs 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.

...

42. In order to assess whether a word combination such as BABY-DRY is capable of distinctiveness, it is therefore necessary to put oneself in the shoes of an English-speaking consumer. From that point of view, and given that the goods concerned in this case are babies' nappies, the determination to be made depends on whether the word combination in question may be viewed as a normal way of referring to the goods or of representing their essential characteristics in common parlance."

11. These paragraphs make it clear that it must be determined whether or not the particular mark in issue may be viewed as a normal way of referring to the goods or services or representing their essential characteristics. This case must, however, now be seen in the context of the more recent decision of the European Court of Justice in case C-191/01P *OHIM v The Wm Wrigley Jr Company (DOUBLEMINT)* [2004] RPC 18. The Court held:

"31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) 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), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-0000, paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods and services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned."

12. So far as relevant to the present appeal, the following principles emerge from these paragraphs:

- (i) It is in the public interest that descriptive signs which relate to the characteristics of the goods or services in issue may be freely used by all.
- (ii) It is not necessary that the sign is actually used at the date of application in a descriptive manner; it is sufficient that the sign could be used for such a purpose.
- (iii) A sign must be refused registration if at least one of its proper meanings designates a characteristic of the goods and services concerned.

13. To my mind it is clear that the Hearing Officer had these principles well in mind in reaching his conclusion. Moreover, I believe that he came to the right conclusion in applying those principles in the present case. It was argued on behalf of the Applicant that the phrase MAKING PROPERTY WORK had no natural or obvious meaning because property itself cannot be said to work. I am unable to accept this submission which I believe involves an overly

restrictive interpretation of the word “work”. So, for example, it seems to me to be perfectly natural to describe an estate management service which produces an effective rate of return as one which is “making property work”. I believe it is an equally apt description of a business engaged in the rental or leasing of premises or the provision of accommodation or retail or office spaces. This conclusion is confirmed by the internet search carried out by the Hearing Officer. But even if it had not been shown that the phrase is in actual use as a description it is enough that it could be so used. Further, the fact that the phrase may be said to have a number of possible meanings does not avail the Applicant because at least one of those meanings is apt to designate a characteristic of the goods or services concerned. In my judgment, the Hearing Officer was right to conclude that the phrase is one which could be used to describe the goods or services in respect of which registration is sought in classes 16, 35, 36, 37, 39, 41 and 42.

Section 3(1)(b)

14. It is now well established that the central function of a trade mark is to guarantee the identity of the origin of the goods or services to the consumer by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see, for example, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, at paragraph 22). Moreover, a trade mark’s distinctiveness within the meaning of Article 3(1)(b) of Directive 89/104 must be assessed, first, by reference to the goods or services in issue and, second, by reference to the perception by the relevant public, which consists of average consumers of the goods or services in question and who

are considered to be reasonably well informed and reasonably observant and circumspect. Further, a mark can be devoid of distinctive character without also being unduly descriptive. See, for example, case C-363/99 *Koninklijke KPN Nederland NV v. Benelux-Merkenbureau (POSTKANTOOR)* [2004] ETMR 57, at paragraphs 34, 70.

15. In the present case the phrase MAKING PROPERTY WORK comprises a combination of words which may be used both as a description and as an advertising slogan. The fact that a mark comprises such words does not of itself mean that it is excluded from registration but it is nevertheless a consideration which must be taken into account in determining whether or not the mark will be perceived by the relevant public as an indication of origin. The Court of First Instance of the European Communities explained in Case T-281/02, *Norma Lebensmittelfilialbetrieb GmbH & Co KG v. OHIM, (Mehr für Ihr Geld)*, a decision of 30th June 2004:

"31. In that regard, the applicant's argument that the consumer is told nothing about the content or nature of the goods offered under that mark is irrelevant, because he does not know to what the word 'more' relates. For a finding that there is no distinctive character, it is sufficient to note that the semantic content of the word mark in question indicates to the consumer a characteristic of the product relating to its market value which, whilst not specific, comes from promotional or advertising information which the relevant public will perceive first and foremost as such, rather than as an indication of the commercial origin of the goods (see, to that effect, *REAL PEOPLE, REAL SOLUTIONS*, paragraphs 29 and 30). In addition, the mere fact that the work mark "Mehr für Ihr Geld" does not convey any information about the nature of the goods concerned is not sufficient to make that sign distinctive (see, to that effect, *BEST BUY*, paragraph 30).

32. Furthermore, there is nothing about the mark applied for "Mehr für Ihr Geld", that might, beyond its obvious promotional meaning, enable the relevant public to memorise it easily and

instantly as a distinctive trade mark for the goods designated. Even if the mark applied for were used alone, without any other sign or trade mark, the relevant public could not, in the absence of prior knowledge, perceive it otherwise than in its promotional sense (*REAL PEOPLE, REAL SOLUTIONS*, paragraph 28)."

16. To my mind the mark MAKING PROPERTY WORK is likely to be seen as a promotional or advertising slogan even when used in relation to goods or services for which it is not descriptive. I do not think there is anything about it which would enable the relevant public to keep it in mind or regard it as an indication of origin for any of the goods or services the subject of the application. It was argued on behalf of the Applicant that this slogan is rather different to many others in that it incorporates the gerund (the “-ing” word) which conveys an active meaning pointing to the person doing the “making” and so to the origin of the particular goods or services provided. I consider this is not a persuasive argument. The use of the word “making” in the context of the Mark does not suggest that the goods or services to which it is applied have a particular commercial origin, so as to enable the relevant public to distinguish those goods or services from those of different origins. On the contrary just the sort of slogan which might be used by a number of different commercial enterprises. Secondly, it was suggested that the phrase MAKING PROPERTY WORK has no inherent or trite meaning but is instead cryptic, teasing and suggestive. I do not accept this argument for the reasons which I have given in considering the objection under section 3(1)(c) of the Act. I believe that the phrase is an appropriate description to use in relation to many of the goods and services the subject of the application and does have an inherent meaning.

17. In all these circumstances I believe the Hearing Officer came to the correct conclusion in rejecting the application under section 3(1)(b) of the Act.

18. The appeal must be dismissed. In accordance with the wishes of the parties I will make no order as to costs.

David Kitchin QC

4th August 2004