

O-054-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2347817A  
TO REGISTER A TRADE MARK IN CLASSES 16, 35 AND 36  
BY GE CAPITAL BANK LIMITED**

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by G E Capital Bank Limited  
to register a Trade Mark in Classes 16, 35 and 36**

### Background

1. On the 5 November 2003, G E Capital Bank Limited, 6 Agar Street, London WC2N 4HR applied to register the following sign as a trade mark in Classes 16, 35 and 36:

DUAL CARD



Dual Card



Dual Card

2. The application was filed for a series of three marks and the colour blue claimed as an element of the second mark in the series.

3. The application was made in respect of the following goods and services:

#### **Class 16:**

Promotional material, brochures and pamphlets; credit cards; printed matter, stationery; printed publications; bank cards; cards; cards for use as credit, debit and charge cards; discount cards; holders in the nature of cases and for wallets for cards; value cards for financial purposes; magazines, newspapers, leaflets, publications and periodicals; instructional and teaching materials; cards for use in connection with promotion, incentive or loyalty schemes.

#### **Class 35:**

Accounting; compilation of information into computer databases; direct mail advertising; cost price analysis; business management assistance; sales promotion (for others); commercial management assistance; the organisation, operation and supervision of incentive schemes relating to in-house store cards and loyalty cards; provision of business information; promotional services; advertising services; business research; business

administration; data processing advisory, information and consultancy services relating to the aforesaid services.

**Class 36:**

Financial and insurance services; loan arranging; financing services; banking services; credit and credit card services; transfer of electronic funds; services relating to the issuing of tokens of value in relation to bonus and loyalty schemes; monetary affairs; financial and credit services provided via the Internet; debit card services; guarantee services; financial and credit information; advisory, information and consultancy services relating to all the aforesaid services.

4. Objection was taken against the first mark in the series under Section 3(1)(b) and (c) of the Act because the mark is a sign which may serve in trade to designate a characteristic of the goods/services e.g. goods/services in relation to cards that are able to perform more than one function.

5. Objection was also taken under Section 41(2) of the Act because the second and third marks contain an additional device element, this being a material particular which affects the identity of the mark. A form TM12 was filed on 10 February 2004 to divide the application and application 2347817B containing the two marks with a device has subsequently been registered. I therefore need make no further reference to the objection under Section 41(2).

6. A Hearing was held on 3 November 2004 at which the applicant was represented by Mr J Parker of Rouse and Co, Trade Mark Attorneys. The objection was maintained and the application was subsequently refused in accordance with Section 37(4) of the Act.

7. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

8. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

**The Law**

9. 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 case for registration**

10. In correspondence prior to the Hearing and at the Hearing itself Mr Parker maintained that the mark was not a natural or usual way of referring to the goods and services. He argued that a degree of mental agility was required before any meaning was obvious and that the mark applied for was not directly descriptive. He maintained it does not tell the customer what it is descriptive of and to do so would require it to be adapted to something like Dual Function Card.

11. Mr Parker also referred to previously registered marks which he considered to be more descriptive than the application and provided an indication of the level of distinctiveness required to be registrable.

## **Decision**

### **Section 3(1)(c)**

12. In a judgement issued by the European Court of Justice on 23 October 2003, *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case – 191/01 P, (the DOUBLEMINT case), the Court gave 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). Paragraphs 28 – 32 of the judgement are reproduced below:

- “28. Under Article 4 of Regulation No. 40/94, a Community trade mark may consist of signs capable of being represented graphically, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.
- 29. Article 7(1)(c) of Regulation No. 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or rendering of the service, or other characteristics of the goods or service are not to be registered.
- 30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No. 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No. 40/94.
- 31. By prohibiting the registration of 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 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 or 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.”

13. Section 3(1)(c) of the Act excludes signs which may serve, in trade, to designate the kind of goods and services or other characteristics of the goods and services. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the goods and services in question.

14. I am of the view that the term DUAL CARD is not an unusual way of describing the applicant’s goods and services and therefore the public could not distinguish them from those provided by other undertakings. Although the term DUAL CARD does not appear to be defined in any dictionary, in the context of the goods and services sold under the mark, it sends out an unequivocal message about the nature and purpose of these goods and services. These include credit cards, bank cards and discount cards in Class 16, the organisation, operation and supervision of incentive schemes relating to in-house store cards and loyalty cards in Class 35 and debit and credit card services in Class 36. It clearly conveys to customers that the cards sold and services provided under the mark and accessed via the card will have more than one purpose or function e.g. they could function as both a credit card and store card or possibly as a discount card and in-house loyalty store card.

15. Mr Parker contended that in combining the two words “DUAL” and “CARD” this creates a term which is not a natural way of referring to the goods and that a degree of mental agility is required before any meaning is obvious. He maintained that the apt term would be DUAL FUNCTION CARD. I reject this argument. It seems to me that the absence of a word such as “FUNCTION” does not alter the obvious message conveyed by the mark. I do not consider that DUAL CARD is a combination of two words which has a perceptible difference from the individual elements which make up the mark. Furthermore, this is the type of combination which other traders may wish to use in the course of the relevant trade for descriptive purposes.

16. I therefore reach the conclusion that the mark designates a characteristic of the goods and services and is debarred from registration under Section 3(1)(c) of the Act.

### **Section 3(1)(b)**

17. Having found that the mark fails to qualify under Section 3(1)(c) of the Act, I now go on to consider whether it is eligible for Registration under Section 3(1)(b). I approach this ground of objection on the basis of the following principles derived from the ECJ cases referred to below:

- an objection under Section 3(1)(b) operates independently of objections under Section 3(1)(c) – (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Journal Cases C-53/01 to C-55/01, paragraphs 67 to 68);

- for a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);

- a mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Koninklijke KPN Nederland v Benelux Merkenbureau*, paragraph 86);

- a trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);

- the relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

18. In addition to these cases, I take account of the comments under paragraph 20 of the Judgement in the COMPANYLINE decision (Case C-104/00) in which the ECJ held that there is no obligation to rule on the possible dividing line between the concept of lack of distinctiveness and that of minimum distinctiveness when considering whether a mark is "devoid of any distinctive character" within the meaning of Section 3(1)(b) (Article 7(1)(b) CTMR). It found (paragraphs 21 to 24) no error in the reasoning of the Court of First Instance to the effect that "Coupling the words "company" and "line" – both of which are customary in English speaking countries – 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 DKV's services from those of other undertakings." In paragraphs 31 to 36 of its Judgement the Court specifically rejected the appellant's contention that the mark at issue should not have been refused registration under Section 3(1)(b) (Article 7(1)(b) CTMR) without consideration of the question whether it was free of objection under Section 3(1)(c) (Article 7(1)(c) CTMR).

19. I must assess the marks distinctiveness in relation to the goods and services for which the applicant seeks registration, which includes credit cards, debit cards, discount cards and loyalty cards. I must also have regard to the perception of the relevant consumers of these goods and

services, which in my view are the general public. For the reasons already stated, I am of the view that DUAL CARD is not an unusual way of describing the applicant's goods and services and therefore the public would not distinguish them by reference to those words from those products provided by other undertakings. The mark does not create a combination which is anything more than the sum of its parts. I therefore find that the mark is devoid of any distinctive character under Section 3(1)(b) of the Act.

### **Conclusion**

20. In this decision I have considered all the arguments presented by the applicant's representative, and for the reasons given the application is refused under the terms of Section 37(4) of the Act because the mark fails to qualify under Sections 3(1)(b) and (c) of the Act.

**Dated this 4th day of March 2005**

**IAN PEGGIE**  
**For the Registrar**  
**the Comptroller-General**