

1 PATENT OFFICE

2 Trade Marks Registry,  
3 Harmsworth House,  
4 13-15 Bouverie Street,  
5 London EC4Y 8DP

6 Friday, 11th May 2007

7 Before:

8 MR. GEOFFREY HOBBS Q.C.  
9 (Sitting as the Appointed Person)

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11 In the Matter of: **The Trade Marks Act 1994**

12 and

13 In the Matter of: An appeal from the decision of  
14 Mr. G. Ashworth to the Appointed  
15 Person with respect to the Trade Mark  
16 Application Number 2303659 **STRATEGIC REAL**  
17 **ESTATE ADVISORS** in the name of Strategic  
18 Real Estate Advisors Limited.

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20 (Transcript of the Shorthand Notes of  
21 Marten Walsh Cherer Limited,  
22 6th Floor, 12-14 New Fetter Lane, London EC4A 1AG.  
23 Tel: 020 7936 6000. Fax No: 020 7427 0093.  
24 Email: info@martenwalshcherer.com

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MR. J. STOBBS of Boulton Wade Tennant appeared for the Appellant.

MR. A. JAMES appeared on behalf of the Registrar of Trade Marks.

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DECISION  
(Approved by the Appointed Person)

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1 THE APPOINTED PERSON: On 26th June 2002 Strategic Real Estate  
2 Advisors Limited applied to register the following sign



STRATEGIC REAL ESTATE ADVISORS

9 as a trade mark for use in relation to the following goods and  
10 services:

11 Class 16 - Printed matter; promotional material; printed  
12 matter relating to business management, financial  
affairs, real estate affairs, legal services.

13 Class 35 - Business consultancy; provision of advice  
14 relating to business administration and business  
15 organisation and structure; management consultancy;  
provision of on-line advice and information in relation  
to the foregoing services.

16 Class 36 - Financial affairs; monetary affairs; real  
17 estate affairs; analysis of property market performance;  
18 advising on investment strategy, tax and financial  
19 structure, acquisition and disposal strategy and  
20 execution; asset management; performance monitoring and  
reporting in relation to financial and real estate  
affairs; advice in relation to overseas investment;  
provision of on-line information in relation to  
financial and real estate affairs; provision of on-line  
information in relation to the foregoing services.

21 Class 41 - Education; providing of training; cultural  
22 activities; the organisation and running of seminars,  
23 training days and lectures; the organisation and running  
24 of seminars, training days and lectures relating to  
25 business administration, business organisation and  
structure, financial affairs, monetary affairs, real  
estate affairs and the tax and legal structure of  
business and financial and real estate portfolios.

1           Class 42 - Legal services; provision of legal advice  
2           relating to tax and legal structure of businesses,  
3           financial and real estate portfolios; provision of  
          on-line legal information; provision of on-line  
          information in respect of the foregoing services.

4           The Registrar objected to the application on absolute  
5           grounds under sections 3(1)(b) and 3(1)(c) of the Trade Marks  
6           Act 1994. The Applicant resisted the objections. It also  
7           sought to overcome them on the basis of distinctiveness  
8           acquired through use. For that purpose it filed a witness  
9           statement of Pierre Rolin with two extensive exhibits dated  
10          28th July 2003.

11          Mr Rolin attested to use of the sign in question for  
12          the majority of the listed goods and services since October  
13          1998 and for education, training and conference services in  
14          Class 41 since 2000.

15          The objections to registration were nevertheless  
16          maintained for the reasons given in a written Decision issued  
17          under reference 0-284-06 on 3rd October 2006 by Ms. Gail  
18          Ashworth acting on behalf of the Registrar.

19          The Hearing Officer took the view that the non-verbal  
20          elements of the sign were too trivial to justify examination  
21          of it as a figurative or device mark. She said: "The words  
22          are presented in a rectangle, which is considered to be a  
23          totally non-distinctive background element, which does not add  
24          the required surplus and will again form no further part in my  
25          considerations, which are on the words alone."

1           On assessing the sign as a word mark, she found it to be  
2 wholly and solely descriptive in the context of the specified  
3 goods and services and, therefore, objectionable under  
4 sections 3(1)(b) and (c). She directed herself in that  
5 connection by reference to the judgments of the ECJ in the  
6 *Doublemint* and *Postkantoor* cases. She considered that the  
7 evidence filed on behalf of the Applicant was insufficient to  
8 substantiate a claim to distinctiveness acquired through use.  
9 Indeed, she thought that the evidence was in substance  
10 demonstrative of the ways in which the words in question could  
11 be used to communicate descriptively in the context in which  
12 they appeared. She directed herself in that connection by  
13 reference to the judgment of the ECJ in the *Windsurfing*  
14 *Chiemsee* case and the observation of Morritt L.J. in the *Bach*  
15 *Flower Remedies* case, where he said at page 530 lines 19-21:  
16 "First, use of a mark does not prove that the mark is  
17 distinctive. Increased use does not do so either. The use  
18 and increased use must be in a distinctive sense to have any  
19 materiality."

20           The Applicant gave notice of appeal to an Appointed  
21 Person under section 76 of the Act contending that the Hearing  
22 Officer had reached a conclusion that was flawed both in  
23 point of law and in point of fact.

24           In point of law it was contended that the Hearing  
25 Officer had erred by not assessing the sign as a whole and in

1 particular by not treating it as a composite mark akin to a  
2 logo. In point of fact, it was contended that the Hearing  
3 Officer had erred by not recognising that the sign was by  
4 nature and by nurture endowed with the capacity to indicate  
5 that the goods or services with reference to which it was to  
6 be used recurrently within the scope of the application for  
7 registration were those of a single economic undertaking.

8 The simple question is whether in June 2002 the sign in  
9 issue had the power, when used in relation to goods and  
10 services of the kind specified, to individualise them to a  
11 single undertaking. That question falls to be answered from  
12 the viewpoint of the average consumer of the goods and  
13 services concerned. The relevant average consumer is for that  
14 purpose taken to be reasonably well informed and reasonably  
15 observant and circumspect.

16 There is some force in the point that the Hearing  
17 Officer did not expressly recognise that the relevant average  
18 consumer could, for present purposes, be expected to be a  
19 financially aware person. However, I do not believe that  
20 that is a vitiating factor in her reasoning.

21 Approaching the matter from the correct perspective, I  
22 think it is clear that the expression **STRATEGIC REAL ESTATE**  
23 **ADVISORS** is wholly descriptive of the activity of providing  
24 goods or services of the kind specified, by or for real estate  
25 advisors who pride themselves on having the ability to act

1 strategically. That, in my view, involves a statement about  
2 the nature or characteristics of the goods and services  
3 concerned.

4 I can see no rational basis for treating this expression  
5 any differently from other expressions in the same idiom, such  
6 as Strategic Trade Mark Advisors, Strategic Legal Advisors,  
7 Strategic Property Advisors, Strategic Tax Advisors and so  
8 forth. I think the sign is meaningful and explanatory in a  
9 way that simply serves to identify a broad class or category  
10 of commercial activities in which any number of traders may  
11 and do legitimately engage.

12 Adding the non verbal matter which turns it into a  
13 composite sign does not, in my view, alter the analysis. It  
14 can fairly be said that the Hearing Officer should have  
15 proceeded upon the basis that the sign taken as a whole was a  
16 composite mark. That is true as a matter of form. As a  
17 matter of substance and reality, the sign consisted of a  
18 string of words presented in a relatively ordinary and  
19 insubstantial non-verbal setting. The addition of the  
20 non-verbal matter was rightly, in my view, treated as a matter  
21 of no real consequence.

22 So far as the claim to distinctiveness acquired through  
23 use is concerned, I think it is necessary to bear in mind  
24 that the task confronting the applicant for registration is  
25 proportionate to the magnitude of the problem relating to lack

1 of distinctiveness that he has to overcome.

2 In that respect the two main factors are the high degree  
3 of descriptiveness built into the mark and the many and  
4 various types of goods and services that can, in principle,  
5 fall within the scope of the language of the specification.

6 The extent of real world recognition and acceptance of  
7 the sign as a trade mark would have to be broad in terms of  
8 economic activity and strong in terms of audience perception  
9 in order to displace the outcome predicted by the application  
10 of the notional average consumer test.

11 The Hearing Officer considered the evidence and found it  
12 to be insufficient to establish the distinctiveness required  
13 for registration. I am not prepared to say that she was  
14 wrong. That conclusion was open to her on the evidence I have  
15 seen. I would, I think, have come to the same conclusion  
16 myself if I had been considering the matter in her position.

17 For these reasons shortly stated, the appeal will be  
18 dismissed.

19 In accordance with the usual practice in relation to  
20 appeals of this kind, it will be dismissed with no order for  
21 costs.

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