

O-364-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
No. 2412715 BY UTILITY RETAIL LIMITED
TO REGISTER A SERIES OF TWO TRADE MARKS**



IN CLASS 35

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 95668 BY
NEXT RETAIL LIMITED**

BACKGROUND

1) On 2 February 2006, Utility Retail Limited (hereinafter the applicant), applied to register a series of two trade marks:



2) registration was sought in respect of the following services in Class 35: “Retail services connected with the sale of furniture, goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics, novelties, barware, articles made of glass, porcelain or earthenware, articles made of metal, household utensils and containers, candles, toys and games, hot water bottles, horological and chronological instruments, clocks and watches, jewellery, stationery and office requisites, desk organisers, notebooks, pencil cases, articles made of paper or cardboard, greetings cards, wrapping paper, action figures, data storage media (pre-recorded and blank), DVDs and CDs, storage jars, lighting, napkins, textile articles, grooming implements, crockery, cutlery, terrestrial globes, letter openers, articles for fancy dress, moneyboxes, cuddly toys, playing cards, cosmetics and toiletries and dispensers therefor, holders for household purposes, dressings for wounds, cold compresses, temporary tattoos, ornaments, handtools, skincare products, umbrellas, luggage and bags, bookends, footwear, clothing and headgear, handwarmers, tableware, telephones, doorchimes, electrical and electronic goods, weighing and measuring apparatus, timers, tea and coffee makers, kettles, heating and cooking apparatus, picture frames and mirrors, storage units and stands, shelving, hangers, vases, candle holders, bowls, dishes, decorative articles for display purposes, trays, cabinets, nail clippers, brushes, cleaning apparatus and instruments, cookware, juicers, storage boxes, knives, mills, grinders and graters, choppers, slicers and cutters, articles for the preparation of food, baskets, bins, canisters and containers, ladders, audio and/or visual equipment, apparatus for recording, transmission or reproduction of sound or images; magnetic data-carriers, recording discs, electric appliances for household purposes, lighting, furniture, upholstery, bathroom novelties including bath plugs, toothpaste caps and floss/cotton pad dispensers, bird feeders and garden ornaments, vases, fruit bowls, decorations, parts and fittings for all the aforesaid goods.”.

3) The application was examined and accepted following consent by UK Trade Mark No. 2108359 (6174,4994) and others.. The trade mark was subsequently published for opposition purposes on 17 August 2007 in Trade Marks Journal No.6697.

4) Next Retail Limited (hereinafter the opponent), filed a notice of opposition dated 19 November 2007. The grounds of opposition are in summary:

a) The mark applied for does not have sufficient distinctive character, when considered in relation to the services covered by the application, to act as a trade mark and distinguish the services of the applicant from other traders and the mark in suit therefore offends against Section 3(1)(b) of the Trade Marks Act 1994.

b) The word UTILITY is in common use and has various associations with the kind, quality, intended purpose, value of the services provided by the applicant and therefore offends against Section 3(1)(c) of the Trade Marks Act 1994.

c) The word UTILITY is a commonly used word within the retail trade and has become customary in the current language and established practices of the trade and therefore offends against Section 3(1)(d) of the Trade Marks Act 1994.

d) The opponent has built up a substantial reputation and goodwill in the mark UTILITY through use in the UK over a number of years on furniture, bathroom furniture, household goods, mirrors and bath linen. The instant application therefore offends against Section 5(4)(a) of the Trade Marks Act 1994.

5) On 25 February 2008 the applicant filed a counterstatement which denied the opponent's claim and put it to strict proof. It was also claimed that the applicant began using the mark applied for in the UK in 1999 prior to the opponent's use which is said to have begun in 2004.

6) Both sides filed evidence, and both parties seek an award of costs in their favour. The matter came to be heard on 21 September 2010. At the hearing, the opponent was represented by Mr Sherlock of Messrs Marks & Clerk, the applicant was represented by Ms McGrath of Messrs W P Thompson & Co.

OPPONENT'S EVIDENCE

7) The opponent filed a witness statement, dated October 2008, by Shaun Nicholas Sherlock the opponent's Trade Mark Attorney. At exhibit SNS1 he provides copies of pages from the Collins English Dictionary 21st Century Edition, which shows the following definition of the word utility:

“UTILITY: the quality of practical use; usefulness; serviceability. 1b: (as modifier); *a utility fabric*. 2: something useful. 3a: a public service, such as the bus system; public utility.”

8) Reference is also made to utility truck or 'ute' but as this is use from the Antipodes it is not relevant, also vehicles do not form part of the specification. Mr Sherlock states that the opponent has used the mark UTILITY for a number of years on a range of bathroom accessories and fittings. At exhibit SNS2 he provides photocopies of the opponent's use which he claims has meant that the opponent has built up goodwill in retail services connected with the sale of such

goods. The exhibit contains pages from a catalogue which shows the mark UTILITY being used on a free standing mirror, a pedal bin, bathroom scales and a toilet seat. None of the pages are dated.

APPLICANT'S EVIDENCE

9) The applicant filed a witness statement, dated 30 September 2009, by Joanne Elaine Goodchild the applicant's Trade Mark Attorney. She refers to the report by the trade mark examiner which is not binding on me and so I will not summarise it. At exhibit JEG2 she supplies a copy of the evidence filed at the application stage, which she states shows use of the mark in suit by the applicant prior to the filing date of 2 February 2006 which she claims shows that the mark applied for has enhanced distinctiveness and has acquired its own goodwill which pre-dates any rights claimed by the opponent.

- Exhibit JEG2: Consists of a statement, dated 8 February 2007, by Richard Skelton the Director of the applicant company a position he has held since November 1999. He states that:

“My company first used its trade mark as a trade mark in relation to paper, cardboard and goods made from these materials, printed matter, book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.”

After the full stop in the above paragraph he then adds the full specification applied for as shown in paragraph 2 above with these additional words:

“(hereinafter referred to as the “Specified Goods”) in the United Kingdom in 1999 or earlier. Since that date, the Trade Mark has been continuously so used throughout the United Kingdom and I am not aware of any incidences of confusion between the Trade Mark and any of the marks which are shown at exhibit RS2[*].”

[*] these were the marks raised by the trade mark examiner as possibly raising a 5(2) objection.

Mr Skelton then provides the following annual turnover and promotional figures for the specified retail services generated in the UK:

Year	Turnover £	Promotion £
1999/00	325,000	5,000
2000/01	450,000	10,000
2001/02	600,000	15,000
2002/03	750,000	20,000
2003/04	920,000	30,000
2004/05	1,000,000	18,000

2005/06	1,200,000	25,000
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Mr Skelton lists various towns and cities throughout the UK where his products have been sold. He also states that the advertising and promotion has been via trade magazines, leaflets, mailshots and local theatre advertising. At exhibit RS3 he provides copies of examples of the advertising carried out and also use of the mark in suit upon letterheads etc. A large number of the exhibits are not dated. However, there are examples dated from 2003, and one from this year refers to the time that the Liverpool store has been open which is stated as being since 1999. The exhibits include articles from newspapers such as the Times and the Independent, magazines as well as internet sites. The exhibits show use of the mark on most of the items within the specification.

OPPONENT’S EVIDENCE IN REPLY

10) This consists of a second witness statement by Mr Sherlock dated 14 April 2010. He offers a critique on the evidence of the applicant. He states that the claim that the mark has been used on items such as, inter alia, paper and cardboard is disproved as the specification has been amended to delete these goods. I do not accept that the only reason for the deletion of these goods from the specification is necessarily that which he proposes. He states that the turnover figures are not substantiated by company accounts, that no mention is made of market share and that the figures are quite low. He states that the applicant has only identified two stores, both in Liverpool, and has not stated how its goods are sold throughout the UK as claimed by Mr Skelton. He points out that no invoices from printers or marketing firms have been provided to support the advertising expenditure. He also points out that most of the promotional items offering a discount are from third parties based in Liverpool. He also provides the following exhibits:

- SNS1: The following definitions from the Compact Oxford English Dictionary. He states that the mark applied for does not have sufficient distinctive character to act as a trade mark for the services covered, or that it consists exclusively of indications which may serve in trade to designate various characteristics of the goods and services concerned. He contends that the words UTILITY and USEFUL “mean goods or services that can be used advantageously, beneficially or for several purposes”.

UTILITY: the state of being useful, profitable or beneficial. An organization supplying electricity, gas water or sewage to the public.

USEFUL: Able to be used for a practical purpose or in several ways.

- SNS2: The results of an internet search for “utility shop”. The applicant appears in the first two results but there are over a million hits. Numbers three and five relate to “the Utility Warehouse Discount Club”. However, the fourth hit is referring to a “utility rose apron” available from the Victoria and Albert Museum. The sixth hit is from the BBC which has a “one-stop shop for utility complaints”. There are also references to “utility heaters”, “utility quads”[motorbikes], “lighting utility”, “utility/rescue clubs”[golf], “utility pouch”, “utility bag” [cycling], and “utility belt” [floating/rescue]

- SNS3: Consists of the results of a search of the UK and CTM Trade Marks registers for marks in class 35 which include the word UTILITY. There are a number such as “National Utility Services”; “Utility Warehouse”; “Value Chain Utility” and “Commercial Utility Brokers.Com”. There are also a number of abandoned and refused marks. Mr Sherlock contends that the refusal of such marks suggests that they were non-distinctive.
- SNS4: In this exhibit Mr Sherlock provides a print out of UK 2525276 UTILITY and device, registered for goods in classes 16,18,21,24 and 25, and retail services in Class 35. Mr Sherlock states that it is clear from the print out that a notification letter was sent out to the applicant. He states that the acceptance of this mark onto the register by the applicant “is further evidence that the Applicant accepts the vulnerability of their rights in the mark UTILITY. The Applicant’s acceptance of the co-existence of these two marks clearly shows that they accept the non-distinctive and descriptive nature of the mark.”

DECISION

11) At the hearing the opponent withdrew the ground of opposition under Section 5(4)(a).

12) I now turn to the grounds of opposition under section 3(1) which reads:

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

(a) ...

(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,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

13) The opponent has filed evidence, which is, for the most part, of little assistance to me in my determination. For instance exhibit SNS3 is what is usually termed state of the register evidence. In *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 28 Jacob J. said:

“It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME* Trade Mark [1966] RPC 541 and the same must be true under the 1994 Act.”

14) Exhibit SNS2 (from Mr Sherlock’s second statement) consists of an internet search which is said to show over one million hits for the words “UTILITY SHOP”. At first blush this seems

damning to the applicant, however the first two hits are references to the applicant. Numbers three and five relate to “the Utility Warehouse Discount Club”. However, the fourth hit is referring to a “utility rose apron” available from the Victoria and Albert Museum. The sixth hit refers to the BBC’s “one-stop shop for utility complaints”. There are also references to golf clubs and motorbikes which do not form part of the specification. To my mind this exhibit only serves to strengthen the applicant’s case by showing that the term utility is not used in relation to retail outlets. Indeed it even shows that the term is only sparingly used in relation to the goods that the applicant is selling.

18) Exhibit SNS4 is somewhat unusual. It shows that the applicant was made aware of the presence of another mark, UK 2525276, which consists of the device mark of a hand pointing with the word UTILITY. This was registered for goods in Classes 16, 18, 21, 24 and 25 and services in Class 35. It was contended that because the applicant in the instant case did not object to this registration that it was a tacit admission that the mark in suit is both non-distinctive and descriptive. I accept that one could place this interpretation upon the applicant’s inaction. However, there are a number of other interpretations that could also apply, such as, inter alia, the parties have reached an accommodation or are economically linked. The absence of action by the applicant cannot be used against them these proceedings.

19) I turn first to consider the ground of opposition under Section 3(1)(d). I take note of the comments of Professor Annand acting as the Appointed Person in *Stash* [O/281/04] where she said:

“30.On my reading, there are two separate limbs of section 3(1)(d). A mark must be refused registration if, in relation to the goods or services applied for, it has become customary:

(a) in the current language; or

(b) in the bona fide and established practices of the trade.

It is clear from the proviso to section 3(1), that the general objection to marks which fall within section 3(1)(b) – (d) is that they are lacking in distinctive character (Case C-299/99 *Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd* [2002] ECR I-5475, para. 58) . If the relevant public has come to view a sign in current language use as a generic name for the goods or services in question, then the objection is satisfied because the mark is prima facie lacking in distinctive character. An added requirement that the name must have become customary also in the current language of the trade is superfluous. I note that the District Court of The Hague, Civil Section D, expressed a similar view on parallel legislation in *Healing Herbs Limited v. Bach Flower Remedies Limited*, Case 02/244, 30 June 2004.

31. Mr. Malynicz based his argument on the ECJ decision in *Merz & Krell*, supra., concerning the equivalent Article 3(1)(d) of Council Directive 89/104/EEC (“the Directive”) and, in particular, paragraph 35 where the ECJ said:

“... marks covered by Article 3(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which marks are sought to be registered.”

But, it is important to realise that, here, the ECJ was considering the overlap between Article 3(1)(c) and (d) of the Directive (section 3(1)(c) and (d) TMA) in the context of the second part of the referred question, whether to fall within Article 3(1)(d) a mark must describe the properties or characteristics of the goods or services concerned. Paragraph 35 on the one hand is to be compared with paragraph 26 on the other hand where the ECJ, in the course of deciding the first part of the referred question to the effect that Article 3(1)(d) must be assessed in relation to the goods or services applied for, said:

“Under Article 3(1)(d) of the Directive, trade marks which consist exclusively of signs or indications which have become customary in the current language or trade practices are to be refused registration.”

32. I was also referred to the Opinion of AG Léger (13 November 2003) and the decision of the ECJ (29 April 2004) in Case C-371/02 *Björnekulla Fruktindustrier AB v. Procordia Food AB*. But I do not believe either support the interpretation that the Applicant seeks to advance. *Björnekulla* involved Article 12(2)(a) of the Directive (section 46(1)(c) TMA), the English and Finnish (but not other language) versions of which state that a trade mark is liable to revocation if:

“in consequence of acts or inactivity of the proprietor, it has become the common name *in the trade* for a product or service in respect of which it is registered.” (emphasis added)

The ECJ followed the Advocate General in construing Article 12(2)(a) in the light of the general scheme and objectives of the Directive, particularly Article 3. Thus construed, Article 12(2)(a) could not be confined only to where the trade uses a mark generically. Instead, the relevant circles comprise principally consumers and end users and, depending on the market concerned, all those in trade who deal with the product in question commercially.

33. In the event, I do not believe this issue of the interpretation of section 3(1)(d) is central to the outcome of the appeal. “Customary” is defined in the Oxford English Reference Dictionary, 1995 as: “usual; in accordance with custom”. In my judgment, the Opponent has failed on the evidence to prove that at the relevant date STASH contravened section 3(1)(d) as consisting exclusively of signs or indications which have become customary either in the current language or in trade practices for the goods concerned.”

20) The opponent contends that the word UTILITY “has become a term customary in the current language of the trade, being the sale of furniture and household goods”. This contention is not supported by the evidence. **The ground of opposition under Section 3(1)(d) fails.**

21) I next turn to consider the position under Section 3(1)(c). There are a number of ECJ judgments which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), whose provisions correspond to Section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – (*Wm Wrigley Jr & Company v OHIM* – Case 191/01P (Doublemint) paragraph 30;
- thus Article 7(1)(c) (Section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM*, paragraph 31;
- it is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes – *Wm Wrigley Jr v OHIM*, paragraph 32;
- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, Case C-363/99 (Postkantoor), paragraph 57;
- if a mark which consists of a word produced by a combination of elements is to be regarded as descriptive for the purposes of Article 3(1)(c) it is not sufficient that each of its components may be found to be descriptive, the word itself must be found to be so – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, paragraph 96;
- merely bringing together descriptive elements without any unusual variations as to, for instance, syntax or meaning, cannot result in a mark consisting exclusively of such elements escaping objection – *Koninklijke Nederland v Benelux Merkenbureau*, paragraph 98;
- an otherwise descriptive combination may not be descriptive within the meaning of Article 3(1) (c) of the Directive provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word trade mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark – *Koninklijke Nederland NV v Benelux Markenbureau*, (*Postkantoor*), paragraph 99.

22) I note the comments made in *Matratzen Concord AG v Hukla Germany SA* Case C-421/04) where the ECJ stated:

“In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, who are reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50)”.

23) I am also mindful of the decision of the General Court (formerly the CFI) in *Ford Motor Co v OHIM*, Case T-67/07 where it was stated:

“there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics.”

24) It is clear from the above that I must determine whether, assuming notional and fair use, the mark in suit, will be viewed by the average consumer to directly designate the essential characteristics, “kind” and “intended purpose”, of the services for which registration is sought. Only if the mark is no different from the usual way of designating the relevant services or their characteristics can it be debarred from registration.

25) In the instant case the specification is for retail services in connection with, broadly, household goods, furniture, jewellery, clocks, watches, toys, games, office stationery, cosmetics, toiletries, DVDs, CDs, footwear, clothing, headgear, luggage, electrical and electronic goods and garden ornaments. The opponent has provided definitions of the word UTILITY as well as the word USEFUL. It is contended that these words “mean goods or services that can be used advantageously, beneficially or for several purposes”. The definitions provided are as follows:

UTILITY: the quality of practical use; usefulness; serviceability. 1b: (as modifier); *a utility fabric*. 2: something useful. 3a: a public service, such as the bus system; public utility.

UTILITY: the state of being useful, profitable or beneficial. An organization supplying electricity, gas, water or sewage to the public.

USEFUL: Able to be used for a practical purpose or in several ways.

26) I accept that the word UTILITY is a common English word and would be known to the majority of the population. However, it is more usually associated with suppliers of water, electricity and gas. These industries are commonly known as utilities. When describing an item such as a piece of clothing as being practical or useful it is more usual to refer to it being utilitarian, indeed Mr Sherlock did precisely this at the hearing. It was contended that the mark in suit would be seen as an indication of the service i.e. the sale of utility goods. I was also reminded that utility goods were common in World War II. I accept that historically this was the

case as raw materials were so scarce, during and shortly after the war, that all goods were pared down to the bare essentials. However, I believe that I should hesitate to rely upon the state of the market seventy years ago. To my mind the modern average consumer would not immediately consider the mark in suit to describe either the goods sold or the retail services or one of their characteristics. **The ground of opposition under Section 3(1)(c) therefore fails.**

27) When considering the issue of distinctiveness under Section 3(1) (b) of the Act I adopt the approach summarised by the ECJ in its judgment in *Linde AG, Windward Industries Inc and Rado Uhren AG* Joined Cases C-53/01 to C- 55/01:

“37. It is to be noted at the outset 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 in 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*, paragraph 35).

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.”

28) I must determine whether the trade mark applied for is capable of enabling the relevant consumer of the services in question to identify the origin of the retail services and thereby to distinguish them from other undertakings. In *SAT.1 Satelliten Fernsehen GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-329/02 the ECJ provided the following guidance:

“41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin

of the goods or services protected thereby and to distinguish them from those of other undertakings.”

29) In *Cycling Is... Trade Mark*, [2002] R.P.C. 37, Mr Hobbs QC acting as the Appointed Person stated:

“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 reasonably observant and circumspect.”

30) It is clear from the above that I must assess the mark’s distinctiveness in relation to the services for which the applicant seeks registration. I must therefore consider the issue from the perspective of someone who encounters the mark “UTILITY” used in relation to the retailing of, broadly, household goods, furniture, jewellery, clocks, watches, toys, games, office stationery, cosmetics, toiletries, DVDs, CDs, footwear, clothing, headgear, luggage, electrical and electronic goods and garden ornaments and determine how that person would react.

32) The evidence shows that the word “UTILITY” is a recognised word used in the English language and found in any dictionary. I have already set out in paragraph 26 above how I consider the average consumer would view the mark in suit.

33) To my mind the average consumer “who does not know there is a question” would consider UTILITY to be distinctive for retail services. It may allude to goods which would be utilitarian or those which put function before form, but without a form of qualification before or after the word UTILITY the average consumer would consider that it functioned as an indication of origin when used on retail services. As such, **I find that the ground based upon Section 3(1) (b) of the Act must fail.**

COSTS

34) As the applicant has been successful it is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £1,600. This sum to be paid within seven days of the

expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21 day of October 2010

**George W Salthouse
For the Registrar,
the Comptroller-General**