

O/443/11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER
2561413 BY THE BLUE CROSS (INCORPORATING
OUR DUMB FRIENDS LEAGUE) TO REGISTER THE
FOLLOWING TRADE MARK IN CLASS 14:**

HOOFPRIENTS

TRADE MARKS ACT 1994
IN THE MATTER OF Application Number 2561413
By The Blue Cross (Incorporating Our Dumb Friends League)
To register the following trade mark in class 14:

HOOFPRIENTS

Background

1. On 12 October 2010, The Blue Cross (Incorporating Our Dumb Friends League) ("the applicant") applied to register trade mark application number 2561413, consisting of the word "HOOFPRIENTS" for the following goods in class 14:

Precious metals and their alloys; jewellery, costume jewellery, imitation jewellery; precious stones; goods made of precious metals or coated therewith; horological and chronometric instruments, clocks and watches, parts and fittings for the aforesaid goods.
2. On 26 October 2010, the UK Intellectual Property Office issued an examination report in response to the application. In the report, an objection was raised under section 3(1)(b) and (c) of the Trade Marks Act 1994 ("the Act"), on the basis that the mark (and I quote from the report) "consists exclusively of the word "HOOFPRIENTS" being a sign which may serve in trade to designate a characteristic of the goods e.g. jewellery adorned with hoofprints or have a hoofprint design." To support the objection Internet references were sent with the examination report.
3. A period of two months from the date of the examination report was given for a reply (up to 26 December 2010) with the Registrar confirming that the application would be refused if the applicant did not respond by the relevant date requested.
4. On 22 December 2010, Mr Morgan of Beck Greener, acting as the applicant's representative ("the agent"), submitted arguments in respect of *prima facie* acceptance of the mark. The examiner was not persuaded by the submissions and maintained the objection.
5. On 4 March 2011, an *ex parte* hearing was requested which was attended by Mr Buehrien of Beck Greener. At that hearing, held on 15 April 2011, Mr Buehrien continued to press for *prima facie* acceptance of the mark. He pointed out that in order to purchase the jewellery, customers would request a print kit from the applicant and they would use this kit to obtain a print of their horse's hoof. They would then return the kit to the applicants who would make a piece

of jewellery from that print. The term “hoofprint” therefore relates to the print of the animal’s hoof and not the jewellery itself. He went on to contend that jewellery is referred to by *type* e.g. bracelets, earrings etc. and that the term “hoofprints” would not be seen as descriptive of a type of jewellery. I was not persuaded by these arguments and maintained the objection. Further time was granted for Mr Buehrien to make any further submissions he felt relevant.

6. Following receipt of a form TM5 on 8 June 2011 requesting a statement for the reasons for the decision, the application was formally refused.
7. I am now asked under section 76 of the Trade Marks Act 1994 and rule 69 of the Trade Marks Rules 2008 to state in writing the grounds of my decision and the materials used in arriving at it. No formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, I have only the *prima facie* case to consider.

Decision

8. Section 3(1) of the Act reads as follows:

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,

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.”

The above provisions mirror Article 3(1)(b) and (c) of First Council Directive 89/104 of 21 December 1988. The proviso to Section 3 is based on the equivalent provision of Article 3(3).

Relevant authorities – general considerations

9. The European Court of Justice (ECJ) has repeatedly emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (*Bio ID v OHIM*, C-37/03P, paragraph 59 and the case law cited there and, more recently, *Celltech R&D Ltd v OHIM*, C-273/05P).
10. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. Thus, in the case of the registration of colours *per se*, not spatially delimited, the Court has ruled that the public interest is aimed at the need not to restrict unduly the availability of colours for other traders in goods or services of the same type. Also, in relation to Section 3(1)(b) (and the equivalent provisions referred to above) the Court has held that “...the public interest... is, manifestly, indissociable from the essential function of a trade mark” *SatellitenFernsehen GmbH v OHIM* C329/02 (*SAT.1*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment).

Section 3(1)(c)

11. 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*, C-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 (*Doublemint*, 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 (*Doublemint*, 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*, 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 – (*Postkantoor*, 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 (*Postkantoor*, 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 (*Postkantoor*, paragraph 99).
- In *Matratzen Concord AG v Hukla Germany SA*, C-421/04 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 ...”
- I am also mindful of the decision of the General Court (formerly the CFI) in *Ford Motor Co v OHIM*, 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”.

12. It is clear from the aforementioned case law that I must determine whether, assuming notional and fair use, the mark in suit will be viewed by the average consumer as a means of directly designating an essential characteristic, that is, in this matter, being the *kind* of goods for which registration is sought.
13. The goods at issue are “Precious metals and their alloys; jewellery, costume jewellery, imitation jewellery; precious stones; goods made of precious metals or coated therewith; horological and chronometric instruments, clocks and watches, parts and fittings for the aforesaid goods”. In relation to identifying the relevant consumer, it is reasonable to assume that the goods claimed will be purchased by the general public. The goods in question could include items such as costume jewellery and lower priced watches and clocks. It is reasonable to assume that those goods, given that their unit cost is likely to be low, would be purchased with only a moderate level of attention by the consumer. They are not specialist goods, the purchase of which would involve a particular level of knowledge or technical skill in their purchase. However, the specification could also cover jewellery, clocks and watches made of precious metal including those which could incorporate precious stones. If the purchaser is paying a considerable price for such goods it is reasonable to assume that they will pay a higher level of attention to their purchase than if purchasing a cheaper range of goods.
14. In determining the mark's suitability for acceptance and registration under section 3(1)(c), the Registrar is obliged to consider the semantic content of the sign and consider, in the context of the goods and/or services claimed, whether or not the relevant consumer is likely to perceive it as being descriptive of a particular characteristic of the goods. The mark consists of the words “hoof” and “prints” conjoined. The Concise Oxford Dictionary of English gives a definition of the word “hoof” as “(pl. hoofs or hooves) the horny part of the foot of an ungulate, especially a horse.” One of the Oxford Dictionary of English definitions of the word “print” is: “an indentation or mark made on a surface or soft substance”. From the dictionary definitions of the two words it is reasonable to assume that the average consumer would be aware of what is meant when those words are conjoined, i.e. the print of a hoof.
15. I do not consider the conjoining of the words “hoof” and “prints” gives any distinctive character to the sign. The words are coupled together without any graphic or semantic modification which may imbue them with additional characteristics such as to render the sign, when considered as a whole, to be

distinctive. I consider the average consumer would still see the sign as indicating hoof print jewellery and would not give the conjoining any trade mark significance. I note, in this context, paragraph 99 in *Postkantoor*, cited in the bullet points above.

16. When assessing the distinctive character of a mark the Registrar has an obligation to not only consider the semantic analysis of the mark, but he must take into account additional factors, such as the market place for such goods. At the time of the initial examination, in making his assessment, the examiner carried out Internet research and copies of the Internet findings were attached to the examination report. That research revealed that there is a market for jewellery either decorated with, or in the shape of, hoof prints. The first reference comes from 'www.dinkydrinkydesigns.com'. This website offers for sale 'dinky hand, foot or paw print charms' and states "*I can create your dinky hand print charm using both your children's and adults hand or foot prints. I can create a paw print charm from your pooch or puddy cat and any size horse or pony*". The second reference comes from 'www.babyrice.co.uk'. This states that "*We can put any loved one's fingerprint into a charm or pendant we can also put animal prints on too! Such as paw prints, hoof prints etc*". The third reference comes from 'www.misi.co.uk' and this site states "*..I make handmade silver pendants and charms with the imprint of hands, feet, lips, pawprints, hoofprints etc*". These references are by no means exhaustive.
17. Mr Buehrien's argument that the mark is not descriptive because the words "hoofprints" refer to the *print* taken by the customer rather than the jewellery itself does not assist the applicant's case for registration. It is from these prints that the jewellery is manufactured. Therefore, the average consumer would merely see the mark as being descriptive of jewellery in the shape of, or decorated with, hoof prints taken from those prints obtained by using the kit supplied by the applicant. When buying jewellery it is reasonable to assume that the consumer will refer to what they are purchasing by shape e.g. "a butterfly ring", "a pig bracelet", "a kitten bracelet", "charm bracelet" etc.
18. Taking into account the dictionary definitions of the words, the Internet research and the fact that the customer has to take a hoof print in order to obtain the jewellery, I believe the average consumer would see the sign as conveying a particular message relating to a characteristic of the goods i.e. goods in the shape of, or decorated with, hoof prints and they would not see the sign as indicating the trade origin of those goods. This designates a type of jewellery.
19. Consequently, I have concluded that the mark applied for consists exclusively of a sign which may serve, in trade, to designate the kind of goods i.e. those goods in the form of, or decorated with, hoof prints, and is therefore excluded from registration by section 3(1)(c) of the Act. Having found that to be the case,

it effectively ends the matter. However, in case I am found to be wrong in this decision, I will go on to determine the matter under section 3(1)(b) of the Act.

Section 3(1)(b)

- 20 Anna Carboni, sitting as the Appointed Person in *COMBI STEAM*, O-363-09, conveniently summarised the leading case law in respect of this part of the Act:

“7. It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs “a residual or sweeping-up function”, backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: *Procter & Gamble Ltd’s Trade Mark Application* [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): *Koninklijke KPN Nederland BV v Benelux-Merkenbureau* Case C-363/99 (POSTKANTOOR) [2004] ETMR 57 (ECJ) at [86]”.

21. For reasons already given, the Registrar considers the sign to be descriptive of specific characteristics of the goods. It is clear from the above guidance that if a mark is entirely descriptive of characteristics of goods or services, it will also be devoid of any distinctive character under section 3(1)(b). As I have found that the mark in question is open to objection under Section 3(1)(c) of the Act, it follows that it is also open to objection under Section 3(1)(b) of the Act.
23. I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is an indication of trade origin. 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. Having done so, and for the reasons given above, the application is refused under the terms of section 37(4) of the Act because it fails to qualify under sections 3(1)(b) and 3(1)(c) of the Act.

Dated this 9th day of December

**Linda Smith
For the Registrar
The Comptroller-General**