

O-223-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 2619100

BY FIELDWORK EDUCATION LIMITED TO REGISTER THE FOLLOWING MARK IN  
CLASSES 9, 16 AND 41

INTERNATIONAL PRIMARY CURRICULUM

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**Background**

1. On 26 April 2012, Fieldwork Education Limited ('the applicant') applied to register trade mark application number 2619100 consisting of the words 'INTERNATIONAL PRIMARY CURRICULUM' for the following goods and services in classes 9, 16 and 41:

Class 9: Educational electronic publications (downloadable), educational electronic study papers (downloadable), educational computer program.

Class 16: Educational materials (except apparatus), picture books, songbooks, books, booklets, newspapers, magazines, periodicals, printed publications, printed matter (except books and periodicals).

Class 41: Publication of texts, publication of teaching materials, publication of books, publication of electronic books and journals on-line, providing on-line electronic publications (not downloadable), electronic desktop publishing, boarding schools services, private tuition, teaching, educational examination, providing of education information, educational instruction, nursery schools/kindergarten and educational institute management, arranging and conducting of seminars, symposiums, workshops, conferences.

2. On 6 May 2012, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act'), on the basis that the mark consists exclusively of the words 'International Primary Curriculum' being a sign which may serve in trade to designate the kind and intended purpose of the goods and services e.g. goods and services relating to a curriculum adapted for primary-aged children undertaking education in an international school. A period of two months was granted for the agent to respond.

3. On 6 July 2012, Williams Powell ('the Agent') requested an *ex parte* hearing which took place on 28 February 2013 with Mr John Reddington. Prior to the hearing, on 14 February 2013, the agent submitted a statement completed by Mr Reddington, on their client's instructions, giving details of the use made of the mark. The exhibits referred to in that statement were *not* included as part of submission.

4. At the hearing with Mr Reddington, there was little consideration of the *prima facie* case for acceptance of the mark - the discussion mainly concerned the case for acceptance of the mark on the basis of acquired distinctiveness. I maintained the objection and in view of the descriptive nature of the mark I voiced my concern that it would be difficult to show that the mark had become distinctive through the use made of it. I allowed three months for Mr Reddington to submit any further evidence he thought might support the case for acquired distinctiveness.

5. On 28 May 2013, Mr Reddington submitted two further witness statements. One was from Dr Mary Hayden, head of the University of Bath's Department of Education, and the other from Mr Andrew Wigford, the director of a teacher recruitment consultancy. On 5 August 2013, I was sent a further Witness Statement completed by Mr Colin Edward Bell, executive director of the Council of British International Schools. I did not consider these statements to further the case for acquired distinctiveness, and so on 9 August 2013 I formally refused the application. On 9 September 2013, the agent submitted a form TM5 requesting a statement of reasons for the Registrar's decision.

6. 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.

### **The *prima facie* case for registration under Section 3**

7. 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,*

*(d) ...*

*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 Articles 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**

8. The Court of Justice of the European Union ('CJEU') 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 (subsequently codified as Council Regulation (EC) No 207/2009 of 26 February 2009) on the Community Trade Mark (the Regulation), 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).

9. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. For example, 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*” (*Satelliten Fernsehen 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)**

10. There are a number of CJEU judgments which deal with the scope of Article 3(1)(c) of the Directive and Article 7(1)(c) of the 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);
- 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);
- 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).

11. In *Matratzen Concord AG v Hukla Germany SA, C-421/04*, the CJEU stated that:

*"...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 Court of First Instance) in *Ford Motor Co v OHIM*, T-67/07 where it was stated that:

*"...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. I must also be aware that the test is one of immediacy or first impression, as confirmed by the General Court which, in its decision on *Sykes Enterprises v OHIM (Real People Real Solutions)* [2002] ECT II-5179) stated:

*"...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin."*

13. It is clear from the aforementioned case law that, assuming notional and fair use, I must determine whether or not the mark applied for will be viewed by the average consumer as a means of directly designating essential characteristics of the goods and services being provided. It is reasonable to assume that the average consumer is likely to consist of those working within the educational sector, including (but not limited to) teachers and head teachers of International primary schools, and also parents who are looking into the educational opportunities available for their child, all of whom would apply a reasonably high level of attention to the goods and services being sought out.

14. In assessing the mark applied for, I have taken into account dictionary definitions of the individual words contained within the mark. The following definitions are taken from Collins English Dictionary:

**International** Of, concerning, or involving two or more nations or nationalities.,

**Primary** Of or relating to the education of children up to the age of 11.

**Curriculum** 1. A course of study in one subject at a school or college; 2. a list of all the courses of study offered by a school or college

Regarding 'International' being used in respect of primary curriculums, I consider it reasonable to assume that the word would be seen as indicating an International School. Internet research undertaken during the examination of this case has shown that there are

International Schools throughout the world. Such schools sometimes differ in their format, but they do all generally follow a national or International curriculum which is different from that of the 'host' country. They have mainly been developed in order to serve expatriate families who want their children to receive a transferrable education and/or one that bears some semblance to curriculums used in schools back in their own 'home' country. My research has also revealed a big increase in such International schools over the last ten years, with their number doubling across the globe during that time. Such schools exist in a number of locations within the UK including London, Taunton, Liverpool, Torquay, and Birmingham.

15. In the UK, most state schools follow the National Curriculum in order to ensure a consistency of approach and meet a national 'standard', whilst other school 'types' such as academies and private schools will set their own curriculums. International Schools fall into this latter category. They cater for the needs of students from around the world and, as such, will usually provide more 'tailored' curriculums. Given the prevalence of both International schools and, as direct consequence, international *curriculums*, I therefore have to establish whether the combination of the words 'International Primary Curriculum', used in respect of education-oriented goods and services, would function - whether in the *prima facie* case or as a result of sufficient exposure through use - as an indicator of commercial origin.

16. I do not believe the combination of these three words can lay claim to any grammatical or linguistic imperfection or peculiarity such as might help to escape its inherent descriptiveness. The average consumer, who we have identified as both those working in the educational sector and parents seeking a suitable education for their child, will need to source a curriculum suited to the needs of primary-aged children and/or young people studying in an international environment. The words clearly indicate that the goods and services relate to the provision of such curriculums and in this instance, I do not believe that the relevant consumer would see the sign as anything more than a reference to the *kind* of goods and services being provided. In this respect I refer to comments made in *Koninklijke KPN Nederland NV and Benelux- Merkenbureau, Case C-363/99 (Postkantoor)* where the CJEU held that:

*"98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned."*

17. My Internet research has also confirmed that the applicant is not the only provider of an international primary curriculum - to illustrate, both Edexcel and the University of Cambridge also provide such curriculums (see annex A). It is clear from such findings that the combination of words intended for protection are capable of application to goods and services provided by others, and are being used by at least two other organisations. Section 9(1) of the Trade Mark Act 1994 confirms that the proprietor of a registered trade mark "*has exclusive rights in the trade mark which are infringed by use of the trade mark in the United Kingdom without his consent*". I therefore have to take into account the consequences for

third parties of granting the applicant a monopoly in the sign 'International Primary Curriculum' . In *Linde A.G. v Rado Uhren A.G.* Case C-53/01 the following guidance was given at paragraphs 73 - 74:

*“73. According to the Court’s case-law “Article 3(1)(c) of the Directive 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 applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see to that effect, Windsurfing Chiemsee, paragraph 25).*

*74. The public interest underlying Article 3(1)(c) of the Directive implies that, subject to Article 3(3) any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all and not be registrable.”*

18. Taking all the above into account I have concluded that the mark applied for consists exclusively of signs which may serve, in trade, to designate the kind of goods and services, and are words that should be kept free for other providers of similar goods and services to use in describing those goods and services. They are therefore excluded from registration in the *prima facie* case by section 3(1)(c) of the Act.

19. Having found that to be the case, it effectively ends the matter. However, in case I am found to be wrong in this regard, I will go on to determine the matter under section 3(1)(b) of the Act. I should at this point stress that since an objection has been made under section 3(1)(c), this automatically engages section 3(1)(b). However, it can be useful to also consider section 3(1)(b) in its own right - the scope of the two provisions is not identical, and marks which are not descriptive under section 3(1)(c) can nonetheless be devoid of any distinctive character.

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

20. I approach this ground of objection on the basis of the following principles derived from the CJEU 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*, Joined 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 (*Postkantoor* 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*).

21. Furthermore, in relation to section 3(1)(b) it was held in *Postkantoor* that:

*"In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive."* (Paragraph 86)

22. I do not consider that an application should necessarily escape objection if it is considered too imprecise a term to indicate a direct and specific relationship with the goods or services at issue without further thought, but is, in some sense, more generally non-distinctive. I have indicated in paragraph 13 how I feel the average consumer will perceive the mark. I do not believe that the sign is capable of performing the essential function of a trade mark as I consider consumers would not consider the mark to be that of any particular provider of an educational curriculum aimed at primary aged children in International schools, it could properly be at home on any of them.

23. 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:

*"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]"*.

24. For reasons already given, the Registrar considers the sign to be descriptive of specific characteristics of the goods and services. The words comprising the mark are descriptive of curriculums designed for primary-aged pupils studying in an international environment (such as an international school), and are words that others are using to describe such curriculums. 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.

### Evidence of acquired distinctiveness

25. As stated above, on 14 February 2013 Mr Reddington submitted an unsigned statement giving details of the use made of the mark. In that statement it was claimed that there had been extensive use of the mark in 'logo' form as 'IPC INTERNATIONAL PRIMARY CURRICULUM' together with a device (the following is a representation taken from the applicant's website):



It was also claimed that there is use in plain word-only form as 'INTERNATIONAL PRIMARY CURRICULUM' and in the acronym form 'IPC'. The applicant claims that when used in logo form, the acronym 'IPC' is no more than a convenient abbreviation, while the graphic element is of minimal distinctive character. Further, the applicant argues that neither of these elements deflects attention from the dominant verbal element 'INTERNATIONAL PRIMARY CURRICULUM'.

26. The statement confirms that the curriculum was first sold to UK schools in 2004, and the following table shows the sales of the goods and services under the mark as presented in the Witness Statement:

Year	Sales
2008/9	£1,688,372
2009/10	£2,014,605
2010/11	£1,797,000
2011/12	£1,672,000

The table below shows the amount spent on promotion of the mark:

Year	Promotional Expenditure
2008/9	£166,135.78
2009/10	£210,389.26
2010/11	£303,000.00
2011/12	£207,567.29 [year to date to May 2012]
2012/13	£371,064.00 [forecast]

As the applicant has expanded its product range in recent years, this total expenditure does not relate solely to the goods and services provided under the 'INTERNATIONAL PRIMARY

CURRICULUM' mark. However, it is claimed by the agent that 65% of the amount relates directly to the mark, with the remaining 35% of expenditure having, in the agent's words, "an arguably indirect effect on promotion of the INTERNATIONAL PRIMARY CURRICULUM mark".

27. The statement goes on to list the exhibits which the applicant *intended* to file (but did not), such as advertisements from newspapers and magazines; references to recognition of the mark by educationalists such as Bath University and Ofsted reports; and samples of teaching materials bearing the mark. As I had voiced my concern at the hearing that, in view of the descriptive nature of the mark, it may be difficult to provide evidence to show the case for acquired distinctiveness, Mr Reddington did not follow up with a signed witness statement or the exhibits referred to in the unsigned statement.

28. The question to be determined is whether, through the use made of it, the sign applied for has acquired a distinctive character in respect of the goods for which registration is sought. In doing so, this question must be asked through the eyes of the average consumer who is reasonably well informed, observant, and circumspect (*Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel BV*, C-342/97[1999] ECR I-3830 para.26. In this case we have identified the average consumer as being those in the education industry and also parents seeking a suitable education for their child.

29. The key authority for acquired distinctiveness is *Windsurfing Chiemsee Produktions Und Vertriebs GMBH v. Boots-Und Segelzubehor Wlater Huber*, C109/97 (*Windsurfing*); the relevant test being set out in paragraph 55:

*"...the first sentence of Article 3(3) of the First Directive 89/104/EEC is to be interpreted as meaning that:*

*- A trade mark acquires distinctive character following the use which has been made of it where the mark has come 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 goods of other undertakings;*

*- In determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;*

*- If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied;*

*- Where the competent authority has particular difficulty in assessing the distinctive character of the mark in respect of which registration is applied for, Community law does not preclude it from having recourse, under the conditions laid down by its national law, to an opinion poll as guidance for its judgment."*

30. I am also mindful of the CJEU decision in *Bovemj Verzekeringen NV v Benelux Merkenbureau (Europolis)*, C-108/05 where it was held that a trade mark may be registered on the basis of acquired distinctiveness “...only if it is proven that the trade mark has acquired distinctive character through use throughout the territory of a member state”.

31. At the hearing I had expressed my concern that, as the mark is so descriptive and consists of words others are using to describe their goods and services, it would be difficult to provide evidence to show that the mark has acquired the necessary distinctive character. The turnover figures and the promotional figures are high, and paragraph 16 of the unsigned witness statement claims that, by April 2012, 501 schools in the UK had signed up to the International Primary Curriculum. However, this is not sufficient reason to allow the applicant to monopolise a term that others should be free to use in trade to describe their goods and services. It is possible that no amount of use by the applicant would indicate trade origin. I must bear in mind Morrith LJ's observation in *Bach and Bach Flower Remedies Trade Mark* [2000] RPC 513 at para 49, where it was stated that:

*“...use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have any materiality.”*

32. The question therefore is not just the amount of use made by the applicant, but also whether that use generates customer recognition of the sign as an indicator of trade origin. I have also considered comments made in the case of *British Sugar PLC and James Robertson and Sons Ltd* decision (1996) RPC 281 (*The Treat decision*, page 302, line 22):

*“I have already described the evidence used to support the original registration. It was really no more than evidence of use. Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that “use equals distinctiveness”. The illogicality can be seen from an example: no matter how much use a manufacturer made of the word “Soap” as a purported trade mark for soap the word would not be distinctive of his goods. He could use fancy lettering as much as he liked whatever he did would not turn the word into a trade mark. Again, a manufacturer may coin a new word for a new product and be able to show massive use by him and him alone of that word for the product. Nonetheless the word is apt to be the name of the product not a trade mark. Examples from old well known cases of this sort of thing abound. The Shredded Wheat saga is a good example. Lord Russell said: “A word or words to be really distinctive of a person's goods must generally speaking be incapable of application to the goods of anyone else”.*

33. It is clear that the words INTERNATIONAL PRIMARY CURRICULUM are words that are capable of application to the goods and services of others, with the demonstrated use by Edexcell and Cambridge showing this to be the case. Therefore, taking into account guidance set out in the *Treat* case, these words cannot be distinctive of any one provider of goods and services relating to curriculums aimed at primary-aged pupils in an International environment.

34. Another concern is that Internet research shows the applicant to be using the mark not as filed, but rather as a composite sign complete with the letters ‘IPC’ presented within an

oval device (see mark representation as presented at paragraph 24 above). In *Societe des produits Nestle SA v Mars UK Ltd* (Case C-353/03), the CJEU determined that a mark may acquire a distinctive character as a result of it being used as part of, or in conjunction with, another mark. There is therefore no requirement for a non-distinctive mark to have been used alone before it can be registered on the basis of acquired distinctiveness. However, where such a mark is used alongside another distinctive sign, the burden on the applicant to show that the non-distinctive mark has come to be seen as a secondary trade mark will be greater. In this case, the 'ipc' logo element presented in a white oval on a green background is distinctive, and it is this element, rather than the words 'International Primary Curriculum', which is likely to be seen as the indicator of trade origin.

35. At the hearing, we discussed what further evidence could be supplied. I was doubtful that any evidence would demonstrate acquired distinctiveness for such a descriptive mark, particularly when the applicant does not appear to be using the sign as filed, but rather with a distinctive logo. However, I did agree that I was prepared to consider any trade evidence submitted, whilst also pointing out that Witness Statements from any schools which are using the applicant's services are unlikely to assist on the grounds of vested interest. I suggested that statements from education authorities might assist, but emphasised that any such testimonials would need to ensure relevance to the mark as filed.

36. Following the hearing, Mr Reddington submitted Witness Statements from Mr Colin Edward Bell, Executive Director of the Council of British International Schools; Mr Andrew Wigford, an educational recruitment consultant; and Dr Mary Hayden, a senior lecturer in the Department of Education at the University of Bath. I did not consider that these witness statements showed that the average consumer would recognise the words 'International Primary Curriculum' as relating to any one particular provider of such curriculums.

37. Regarding Mr Bell's statement, it is reasonable to expect - given his role and position - that he would be aware of the organisation which appears to be the largest provider of International Primary Curriculums. He confirms that he "...associate(s) the term *INTERNATIONAL PRIMARY CURRICULUM* uniquely with the goods and/or services provided by *Fieldwork International Ltd*..." and that this is, in part, because his company "...formally recognises the *INTERNATIONAL PRIMARY CURRICULUM* product, and a significant number of schools affiliated to (his) company access this quality curriculum". I do not consider this statement sufficient to indicate that the average consumer would recognise the goods and services as being those of Fieldwork International. Mr Bell goes on to say that any competitor of the applicant choosing to use the sign in a descriptive manner would be "*trading on the strength of a pre-existing and well-established brand*". I believe this statement gives weight to my view that the phrase seeking protection is descriptive, and that others may naturally seek to use it for descriptive purposes. It is hard to imagine how other providers of an International Primary Curriculum would describe their goods and services, other than using the expression 'International Primary Curriculum'.

38. The statement by Mr Wigford confirms that he had been a Director of International Primary Curriculum with Fieldwork Education Ltd from April 2002 to September 2005, and presents his claim that professionals and parents within the education sector would uniquely associate the sign with the applicant. Mr Wigford also states his belief that, because there is no standardised curriculum for International primary education, the sign has "no firm

meaning” other than as a trade mark of the applicant. I do not find these comments to assist the applicant’s case for acquired distinctiveness. Firstly, I would be surprised if anyone working for the applicant company did not recognise the sign as being one of their employer’s trademarks. And secondly, even if there is no generally accepted generic curriculum for primary-aged children in International Schools, this does not mean that the words do not still describe any of what could be a number of curriculums aimed at primary aged children in International Schools.

39. Dr. Mary Hayden, in her statement, claims that the applicant has effectively developed and marketed the brand, and confirms her belief that descriptive use of the words ‘International Primary Curriculum’ by competitors of the applicant would mislead potential customers. As is also the case with Mr Bell’s statement, there is a clear indication by Dr Hayden that the words INTERNATIONAL PRIMARY CURRICULUM could be used in a descriptive manner. If that is the case, then the words cannot function as an indicator of trade origin by any one supplier of such goods and services. Dr Hayden refers to the brand being recognised through, amongst other things, promotional materials, the website and advertising activities. On looking at the applicant’s website, the mark is being used within a logo and the letters IPC, and I so consider it probable that it is the composite figurative mark which is recognised as an indicator of the applicant’s ‘brand’, as referred to by Dr Hayden.

40. I do not dispute that the applicant is probably the largest provider of goods and services relating to curriculums for primary-aged pupils in an international environment in the UK. However, this is not sufficient reason to register the expression ‘INTERNATIONAL PRIMARY CURRICULUM’ as a trade mark. As Morritt LJ stated in *Bach and Bach Flower Remedies*, “*use of a mark does not prove that a mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have materiality*” (see paragraph 29 above). The words forming the mark are purely descriptive and in use appear mainly with a logo with the initials IPC, whilst the statements by Mr Bell and Dr Hayden do not dispute that others could wish to use those words in a descriptive manner.

## **Conclusion**

41. Taking into account guidance set out in relevant case law and the documents and exhibits filed, I consider the evidence has failed to show that, at the date of application, the average consumer had been educated into seeing the sign as indicating the trade origin of the good and services. The mark is therefore excluded from acceptance because it fails to qualify under sections 3(1)(b) and (c) of the Act.

Dated this 22nd day of May 2014

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

## Annex A

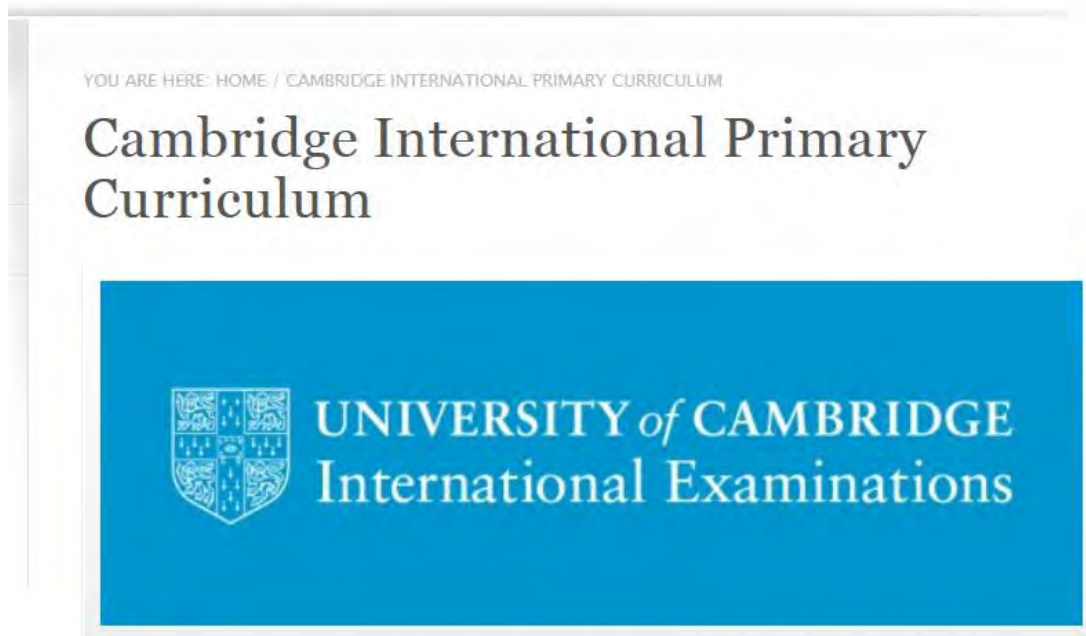
Example of third-party use taken from:

<http://www.edexcel.com/international/aboutus/Documents/International%20Primary%20Curriculum%20brochure.pdf>



Example of third-party use taken from:

<http://semarangis.or.id/portfolio-post/cambridge-international-primary-curriculum/>



Semarang Internatinal School implements the Cambridge International Curriculum for primary years.