

O-119-17

1 UK INTELLECTUAL PROPERTY OFFICE

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Tuesday, 7th March 2017

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ON APPEAL FROM DECISION OF MR. MARK KING, FOR THE
REGISTRAR, THE COMPTROLLER-GENERAL, DATED 12TH FEBRUARY 2016.

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Before:

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MR. GEOFFREY HOBBS QC
(Sitting as the Appointed Person)

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IN THE MATTER OF THE TRADE MARKS ACT 1994

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-and-

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IN THE MATTER OF UK TRADE MARK APPLICATION NO. 3003263
IN THE NAME OF ALASTAIR SWANWICK TO REGISTER THE
TRADE MARK INNOVATE - HELPING INVENTORS
IN CLASSES 35, 42 AND 45

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-and-

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IN THE MATTER OF AN OPPOSITION THERETO UNDER NO. 402701
BY THE TECHNOLOGY STRATEGY BOARD

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(Transcript of the Shorthand Notes of Marten Walsh Cherer Ltd,
1st Floor, Quality House, 6-9 Quality Court,
Chancery Lane, London WC2A 1HP.
Telephone: 020 7067 2900.
email: info@martenwalshcherer.com)

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MR. GWILYM HARBOTTLE appeared on behalf of the Appellant.

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MR. DAVID IVISON appeared on behalf of the Respondent.

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APPROVED DECISION

1 THE APPOINTED PERSON: On 23rd April 2013, Mr. Alastair Swanwick
2 applied under No. 3003263 to register the words INNOVATE -
3 HELPING INVENTORS as a trade mark for use in relation to the
4 following services in classes 35, 42 and 45.

5 "Class 35: Advertising and business management
6 consultancy; Business consultancy services relating to
7 marketing; Business consultancy, advisory, information and
8 research services; Business consultancy to individuals;
9 Business consultancy to individual inventors; Consultancy
10 services regarding business strategies; Marketing of
11 inventions; Marketing, marketing assistance and advertising
12 services in connection with inventions and products.

13 Class 42: Consumer product design; Design of industrial
14 products; Design of products; New product design; New products
15 (Design of -); Product design; Product design services;
16 Product design and development; Prototype services; Design
17 engineering; Advisory services relating to design; Advisory
18 services relating to inventions.

19 Class 45: Legal services; security services for the
20 protection of property and individuals; legal advice; legal
21 advice over the internet; legal advice relating to technology,
22 media and intellectual property; monitoring intellectual
23 property rights for legal advisory purposes; Legal services
24 relating to the acquisition of intellectual property;
25 Registration services (legal); Legal services relating to

1 intellectual property rights; Licensing of inventions."

2 The application for registration was subsequently
3 opposed by The Technology Strategy Board in a Notice of
4 Opposition and Statement of Grounds filed under No. 402701 on
5 15th August 2014. For present purposes, I need only refer to
6 the objection raised under section 3(1)(b) of the Trade Marks
7 Act 1994 upon the basis that the wording put forward for
8 registration was devoid, which is to say unpossessed, of any
9 distinctive character for services of the kind listed in the
10 application.

11 I should add that the applicant does not contend that
12 his application should be allowed to proceed to registration
13 under the proviso to section 3(1) of the 1994 Act by virtue of
14 distinctiveness acquired through use.

15 The opposition proceeded with the agreement of the
16 parties to a determination on the basis of the papers on file
17 without recourse to a hearing. The Registrar's Hearing
18 Officer, Mr. Mark King, upheld the objection to registration
19 under section 3(1)(b) for the reasons he gave in a decision
20 issued under reference BL O-081-16 on 12th February 2016.

21 The applicant appealed to an Appointed Person under
22 section 76 of the Act contending that the Hearing Officer
23 ought to have determined that the statement INNOVATE - HELPING
24 INVENTORS was apt to be perceived and remembered as an
25 indication of trade origin by the reasonably well informed and

1 reasonably observant and circumspect consumer of services of
2 the kind for which protection by registration was requested.
3 This contention was developed at some length in the grounds of
4 appeal and further developed and refined in argument at the
5 hearing before me.

6 The opponent filed a respondent's notice under rule
7 71(4) of the Trade Marks Rules 2008 contending that the
8 Hearing Officer's decision should additionally or,
9 alternatively, be upheld on the basis of objections to
10 registration which it had raised under sections 3(1)(c) and
11 5(4) of the 1994 Act, notwithstanding that the Hearing Officer
12 had expressly declined to determine those objections.

13 As to the objection under section 3(1)(c), this cannot
14 succeed if the appeal succeeds under section 3(1)(b) and if
15 the appeal fails under section 3(1)(b) there is no point in
16 deciding for the first time on appeal whether registration
17 should also have been refused under section 3(1)(c).

18 With regard to the objection under section 5(4), it
19 would not be appropriate for this tribunal to determine de
20 novo on appeal whether the objection was or was not well-
21 founded. If it did so, it would effectively be eliminating
22 one of the two tiers prescribed by the 1994 Act for
23 decision-taking in relation to Registry proceedings. The most
24 that could properly be done by this tribunal, if the appeal
25 succeeded under section 3(1)(b), would be to remit the

1 application for registration to the Registry for further
2 processing with respect to the extant objection under section
3 5(4).

4 In paragraphs 23 to 33 of the decision under appeal the
5 Hearing Officer directed himself by reference to relevant and
6 applicable caselaw of the CJEU. In doing so he had regard, in
7 particular, to paragraphs 44 to 47 of the judgment of the CJEU
8 in Case C-398/08P Audi AG v OHIM, where the CJEU held that
9 "the mere fact that a mark is perceived by the relevant public
10 as a promotional formula and that, because of its laudatory
11 nature, it could in principle be used by other undertakings,
12 is not sufficient, in itself, to support the conclusion that
13 that mark is devoid of distinctive character" and went on to
14 affirm that it was not necessary for a sign to have a number
15 of meanings or constitute a play on words, or to be perceived
16 as imaginative, surprising, and unexpected, and in that way
17 easily remembered, in order for it to possess a distinctive
18 character.

19 At paragraph 26 of his decision, the Hearing Officer
20 identified the relevant public for the purposes of the
21 required assessment in the present case in the following
22 terms:

23 "In this instance the applied for services cover
24 3 classes and generally include class 35 advertising, business
25 management, marketing, class 42 product and prototype design

1 services, and class 45 legal services. In essence the
2 services are intended to provide businesses or individuals
3 with assistance on creating and developing an idea or product.
4 Once the product or idea has been developed, the applicant
5 provides services to assist with the marketing and promotion
6 thereof, and legal advice in order to protect the product
7 and/or business. Therefore, the relevant consumers are likely
8 to be new or existing businesses, though I also take into
9 account individuals. These consumers are reasonably
10 well-informed and reasonably observant and circumspect."

11 There is no challenge to the correctness of his approach
12 in that regard.

13 In paragraphs 28 to 33 he went on to decide as follows:

14 "28. Having considered who the relevant public are,
15 I must consider the effect and impression that the application
16 (INNOVATE - HELPING INVENTORS), in normal and fair use in
17 relation to the applied for services has on them.

18 29. The word INNOVATE is defined by the Collins English
19 dictionary as a verb which is 'to invent or begin to apply
20 (methods, ideas, etc.)' It is a word that would be easily
21 understood by the relevant consumer as an active exhortation
22 to inventors to do something, i.e. innovate. With regard to
23 the second element of the mark (- HELPING INVENTORS), this
24 will be viewed as a promotional slogan...

25 31. In its counterstatement, the applicant denies the

1 claims made relying on the fact that the application was
2 accepted following an ex-parte hearing before a different
3 hearing officer. It claims that the reasons provided by the
4 hearing officer are a correct interpretation and analysis of
5 the law. In particular, the applicant quotes the following
6 from the post-hearing report:

7 '...based on the linguistic characteristics of this sign
8 alone [INNOVATE - HELPING INVENTORS] I feel able to waive the
9 objection. Taken literally, in other words, the collection of
10 words and in the order presented make no sense. The only way,
11 as the attorney submits, the words would make sense is if the
12 word "INNOVATE" actually indicates the name of the undertaking
13 providing the goods or services.'

14 32. Whilst I agree with the hearing officer that the way
15 in which the words are presented do not result in them having
16 a literal meaning this does not result in the words being
17 distinctive and not subject to refusal under section 3(1)(b).
18 The application consists of two elements, 'INNOVATE' and '-
19 HELPING INNOVATORS', which when considered together, and from
20 the perspective of the relevant consumer, it is not
21 distinctive or denote trade origin.

22 33. As previously stated, the word INNOVATE means 'to
23 invent or begin to apply (methods, ideas, etc.). In the
24 context of the applied for services, this would be easily
25 understood as will 'HELPING INVENTORS'. Taken as a whole I do

1 not consider the application, in the minds of the relevant
2 public, to be origin specific. Of course, in this instance
3 the two elements are separated by a hyphen which I believe
4 contributed to the application being initially accepted.
5 However, this does not overcome the fact that the application
6 would be viewed as an active exhortation to inventors to do
7 something together with a promotional statement. Accordingly,
8 it is devoid of distinctive character and should be refused
9 under section 3(1)(b) of the Act."

10 The applicant maintains that the Hearing officer erred
11 in deciding as he did in these paragraphs. It was submitted
12 that within the last two sentences of paragraph 33, where he
13 said: "However, this does not overcome the fact that the
14 application would be viewed as an active exhortation to
15 inventors to do something together with a promotional
16 statement. Accordingly, it is devoid of distinctive character
17 and should be refused under section 3(1)(b) of the Act." he
18 made essentially the same error of law as led to
19 reversal of the judgments of the General Court in the SAT.1
20 and Audi judgments of the CJEU, i.e. that he treated the
21 combination of an exhortation with a promotional statement as
22 necessarily resulting in exclusion from registration under
23 section 3(1)(b).

24 I do not accept that the Hearing Officer erred in the
25 manner suggested. When he used the word "accordingly" in the

1 last sentence of paragraph 33, he was not saying "ipso facto",
2 he was saying "for the reasons I have given" and I think it
3 is clear that his reasoning as expressed in paragraphs 23 to 33
4 as a whole shows that he was addressing himself to the correct
5 test in point of law and asking himself whether in point of
6 fact the sign in issue satisfied the test for registration
7 under section 3(1)(b).

8 Moving on from there, it was submitted that the Hearing
9 Officer ought to have held that the sign in issue satisfied
10 the applicable test for registration because it was
11 sufficiently odd in its semantic expression to qualify for
12 recognition as distinctive in the trade mark sense of the word
13 distinctive. The "oddity" of it was said to reside in it being an
14 intriguingly ambiguous or significantly unexpected form of
15 phraseology.

16 Having had the benefit of oral submissions that the
17 Hearing Officer did not have, I am of the view that the word
18 INNOVATE will not only or necessarily be understood in the
19 context of the sign in issue as an exhortation but may well be
20 understood additionally or alternatively in that context as
21 a reference to what the user of the sign itself does by way of
22 business.

23 However, this does not help the applicant to succeed on
24 this appeal. For my part, I do not accept that the Hearing
25 Officer erred in finding that the statement INNOVATE - HELPING

1 INVENTORS lacked distinctiveness. It juxtaposes the mundane
2 word INNOVATE with the mundane words HELPING INVENTORS to
3 produce a mundane totality which serves to identify to
4 consumers what the user of the sign does by way of business
5 within the areas of economic activity comprehended by the list
6 of services in classes 35, 42, and 45. It does not fail to
7 convey that message simply by being framed in terms which can be
8 regarded as terse or truncated.

9 HELPING INVENTORS qualifies INNOVATE and INNOVATE
10 qualifies HELPING INVENTORS. All that is left to the
11 imagination is the particular nature of the services which the
12 service provider is offering to provide in the course of doing
13 what the statement says it does.

14 In my judgment, the phraseology is too ordinary, too
15 general, and too plainly explanatory to enable the statement
16 to stand on its own two feet as an indication of trade origin
17 in the absence of distinctiveness acquired through use. I am
18 satisfied that the message conveyed to the relevant average
19 consumer by the statement INNOVATE - HELPING INVENTORS would
20 be origin neutral.

21 For the reasons I have given the appeal is dismissed.

22 Does anyone wish to say anything?

23 MR. HARBOTTLE: No.

24 MR. IVISON: We would ask for costs of the appeal on the scale.

25 THE APPOINTED PERSON: The award below was £1,100.

1 MR. IVISON: Yes.

2 THE APPOINTED PERSON: That was on the basis of written
3 submissions on one side and no attendance, no oral hearing.

4 MR. IVISON: Yes, on evidence.

5 THE APPOINTED PERSON: And on evidence we have not looked at
6 today.

7 MR. IVISON: One might have said that the evidence that was
8 submitted had something in the way of advocacy.

9 THE APPOINTED PERSON: It is true but that in a sense has been
10 covered by the costs award below. I have not looked at the
11 evidence because of what I read about there being no claim to
12 anything except the prima facie case. I do not think either
13 of you have looked at the evidence. Did either of you refer
14 to the evidence in the skeletons? You did?

15 MR. HARBOTTLE: I did, yes.

16 THE APPOINTED PERSON: On the other matters that have gone away.

17 MR. HARBOTTLE: On the other matters we did.

18 THE APPOINTED PERSON: That have gone away.

19 MR. HARBOTTLE: But the other matters were not dealt with.

20 THE APPOINTED PERSON: Okay. When you say the scale, give me a
21 clue. Give me a figure for quantum that you may wish to
22 suggest.

23 MR. IVISON: We say £1,100 again.

24 THE APPOINTED PERSON: The same again.

25 MR. IVISON: The same again.

1 THE APPOINTED PERSON: What do you say about that, Mr. Harbottle?

2 MR. HARBOTTLE: £1,100 obviously comprises different matters
3 entirely and ----

4 THE APPOINTED PERSON: Some different matters.

5 MR. HARBOTTLE: Preparing statements and preparing evidence,
6 commenting on the other side's evidence, I would say it should
7 be by reference to costs of attending the hearing. I accept
8 the scale is up to £1,500 per day.

9 THE APPOINTED PERSON: And we have had specialist counsel here
10 today.

11 MR. HARBOTTLE: We have had specialist counsel and we have been
12 here for two hours 20 minutes.

13 THE APPOINTED PERSON: Most of that is my fault.

14 MR. HARBOTTLE: I would not say that.

15 THE APPOINTED PERSON: I know but I say it for you.

16 MR. HARBOTTLE: It is less than half a day, less than £750.

17 THE APPOINTED PERSON: All right. Yes and no because you both had
18 to prepare for the case. The contact time in court is only
19 part of the story. I am aware because of the directions
20 I gave that this was not going to be adjourned and there was
21 some running around that had to be done, particularly on your
22 side. I think it would be fair and reasonable and not
23 disproportionate to say the same again on a swings and
24 roundabouts basis, so I will order that the unsuccessful party
25 on appeal pays to the successful party on appeal the sum of

1 £1,100 within 21 days of today's date, that sum to be paid in
2 addition to the award of £1,100 by the Hearing Officer below.

3 MR. IVISON: I am grateful.

4 THE APPOINTED PERSON: I think that concludes it.

5 MR. HARBOTTLE: It does. Thank you, sir.

6 THE APPOINTED PERSON: Thank you both very much for your
7 submissions. Thank you.

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