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The Rolls Building
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Fetter Lane
London EC4A 1NL
Thursday, 10th January 2019

Before:

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

In the matter of the Trade Marks Act 1994

- and -

In the matter of an appeal to the Appointed Person under
section 76

- and -

In the matter of UK Trade Mark Applications No. 3260946 and
No. 3260947 for MAKE GIVING COUNT and MAKING GIVING COUNT in the
name of CAF Nominees Ltd

In the Matter of an Appeal to the Appointed Person from the
decision of Mr. Edward Smith, acting on behalf of the
Registrar, Comptroller General, dated 10th October 2018

(Transcript of the Stenograph Notes of Marten Walsh Cherer
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Written submissions were provided by Ms. Gemma Kirkland of D.
Young & Co LLP on behalf of the Applicant.

Written submissions were provided by Ms. Bridget Rees on behalf of
the Registrar of Trade Marks.

1 THE APPOINTED PERSON: In parallel applications for registration,
2 filed under numbers 3260946 and 3260947 on 3rd October 2017,
3 CAF Nominees Limited sought to register the expressions MAKE
4 GIVING COUNT and MAKING GIVING COUNT as trade marks for use in
5 relation to the following services in Class 36:

6 "36 Charitable fundraising; financial advice and
7 consultancy services; financial arrangements to facilitate
8 charitable giving; investment trust services, preparation of
9 financial reports and analyses; deposit taking services;
10 recovery of tax and payment funds to the charity; financial
11 research."

12 No claim to distinctiveness acquired through use was
13 made in support of either application for registration. Both
14 applications for registration were refused for the same
15 substantive reasons in parallel decisions issued by Mr. Edward
16 Smith on behalf of the Registrar of Trade Marks under
17 reference BL 0/635/18 and reference BL 0/636/18 on 10th
18 October 2018. They were refused under section 3(1)(b) of the
19 Trade Marks Act 1994 on the basis that the expressions in
20 question were devoid, which is to say unpossessed, of a
21 distinctive character for Class 36 services of the kind
22 specified.

23 In paragraphs 12 to 20 of his decisions, the Hearing Officer
24 directed himself, correctly, by reference to the legal
25 principles established by the case law of the CJEU for

1 determining whether a sign is acceptable for registration
2 under section 3(1)(b).

3 In paragraphs 21 to 28 of his decisions, he assessed the
4 applications for registration in accordance with the
5 applicable legal principles and found them to be ineligible
6 for acceptance. His reasoning in relation to the expression
7 MAKE GIVING COUNT (which mirrors his reasoning in relation to
8 the expression MAKING GIVING COUNT) was as follows:

9 "Application of legal principles - section 3(1)(b)

10 21. The mark comprises the words 'MAKE GIVING COUNT'.

11 In the circumstances, as can be seen in my background account
12 above, the sticking point only arose in relation to the
13 services, specifically, of Class 36, which are as follows:

14 '36. Charitable fundraising; financial advice and
15 consultancy services; financial arrangements to facilitate
16 charitable giving; investment trust services, preparation of
17 financial reports and analyses; deposit taking services; debit
18 card services; online financial services; grant making
19 services; recovery of tax and payment of funds to the charity;
20 financial research.'

21 So, regarding all the other goods, I found myself unable
22 to conclude the mark would designate a characteristic of those
23 goods or services or be otherwise devoid of distinctive
24 character.

25 22. There is however clear difficulty in Class 36 which

1 comprises, in this case, services which may be classified,
2 broadly speaking, as being of a financial nature.

3 23. The relevant consumer in this case will be both
4 members of the public and businesses, primarily engaged in
5 programmes of social responsibility. This is fully explained
6 in the applicant's letter of 11 June 2018.

7 23. The words 'MAKE GIVING COUNT' comprise, in my
8 opinion, a plainly injunctive phrase or narrative directed to
9 the relevant consumer to, in some unspecified way, optimise
10 their giving. That is to say, the applicant is extending to
11 the consumer (whether business, charity or member of the
12 public) the offer that it will facilitate the action of
13 'giving' in such a way that everyone may optimally benefit. By
14 everyone, I mean the giver (be it a member of the public or a
15 business), and the charity to whom the gift or donation is
16 being made. As is clear from the applicant's own account of
17 its business, the act of charitable giving is not necessarily
18 a straightforward matter and the applicant adds value by, and
19 for example, tracking contributions and advising on
20 efficiencies that may accrue, such as that of tax.

21 24. The words 'MAKE GIVING COUNT' are based on a
22 well-known phrase, 'MAKE X COUNT'. This has a known linguistic
23 structure, as noted in the EUIPO decision which I have quoted
24 above. Whatever the 'x' is in the phrase, the term 'MAKE X
25 COUNT' will, in my opinion be readily understood and

1 recognised as being colloquially familiar.

2 25. The applicant's case for registration in Class 36
3 can be distilled, in the main, to two contentions. The first
4 is that there is word play on the word 'COUNT', in the sense
5 that it would have both a 'social meaning and a monetary
6 meaning'. In my opinion, the case law makes no prescriptive
7 rule that the presence of any word play must inevitably lead
8 to the threshold for registration being met. In this case, and
9 given that the mark is comprised, structurally, from a
10 colloquially known phrase, my view is that whatever degree of
11 word play is involved here, it is not sufficient to pass the
12 test for inherent registration. The applicant's own use has
13 reinforced me in my view that such a phrase is more than
14 capable of explaining exactly what the applicant does or aims
15 to do in a purely promotional sense, without also, and at the
16 same time, acting as a trade mark.

17 26. The applicant's second main contention, in relation
18 to Class 36 only, is that certain terms within that Class
19 relate not to the benefits of charitable giving per se, or in
20 a limited sense, but to broader or alternative terms
21 encompassing 'financial management'. There is a clear
22 difference in the applicant's submission between the two. In
23 regard to 'financial management', the mark can be said to be
24 allusive only, rather than having any obviously descriptive
25 overtones. Because it is 'allusive', the applicant contends

1 the mark is inherently apt to function as a trade mark. My
2 response is that the objection is based on the mark being
3 devoid of all distinctive character (section 3(1)(b)) as
4 distinct from designating (describing) a characteristic of the
5 services (section 3(1)(c)). As is clear from the historical
6 background to the case I have given specific consideration to
7 whether the services in Class 36 are possessed of qualities
8 which enable their clear separation into terms which are free
9 from objection and those which are not. The applicant submits
10 there are such terms, specifically in the field of financial
11 management but, after considerable thought, I am not persuaded
12 this is the case. Even with services that may relate to
13 financial management, such as e.g. 'investment trust
14 services', 'preparation of financial reports and analyses',
15 'deposit taking services', 'debit card services' and
16 'financial research', it seems to me I cannot rule out the
17 probability that the term 'Make giving count' would have no
18 resonance whatsoever. Absent a clear reason to the contrary,
19 namely that the realms of financial management and charitable
20 giving are, in reality, entirely discrete, it seems to me that
21 part and parcel of 'financial management' could very feasibly
22 include consideration of the impact of charitable giving and
23 how, optimally, to undertake that. In short conclusion, this
24 is one of those cases where after careful consideration, I
25 have concluded that there is no clear dividing line that can

1 be drawn here, such that the mark would not be devoid of
2 distinctive character for certain services in Class 36.

3 27. As regards the argument that other similar marks
4 have been accepted for registration either by the EUIPO or
5 even the UK Registry, it is well established that such
6 acceptances create no binding precedent or even that they are
7 persuasive as far as this application is concerned. This
8 principle has been expressed as recently as BL O/262/18 BREXIT,
9 see paras 9 and following. Despite this I have considered the
10 marks cited by the applicant as being good comparators and I
11 do not believe they are on a par with this application.

12 Conclusion

13 28. In this decision I have considered all the papers
14 filed and submissions made. For the reasons given above, the
15 application is refused under section 3(1)(b) in relation to
16 all goods and services."

17 The applicant contends, on appeal under Section 76 of
18 the 1994 Act, that the Hearing Officer's decisions were wrong
19 and should be set aside for the reasons developed in written
20 submissions filed on its behalf on 8th January 2019. The
21 Registrar contends, in written submissions filed on his
22 behalf on 9th January 2019, that the Hearing Officer's
23 reasoning and conclusions were correct and his decisions
24 should be upheld.

25 The applicant's submissions are helpfully summarised in

1 paragraph 35 of its skeleton argument relating to application
2 number 3260946 MAKE GIVING COUNT, and in broadly the same
3 terms in paragraph 35 of its skeleton argument
4 relating to application number 3260947 MAKING GIVING COUNT.
5 It is sufficient for present purposes for me to set out the
6 summary contained in paragraph 35 of the skeleton argument
7 relating to application number 3260946:

8 "35. The Appellant submits that overall the Hearing
9 Office erred in reaching the conclusion that the MAKE GIVING
10 COUNT mark is non-distinctive in relation to the objected
11 services in Class 36 on the following bases:

12 • The Hearing Officer did not give due prominence to
13 the fact that the mark MAKE GIVING COUNT fulfils almost all
14 the qualities for an advertising slogan to be distinctive;

15 • The mark MAKE GIVING COUNT fulfils both a promotional
16 purpose and is capable of denoting trade origin;

17 • The mark MAKE GIVING COUNT is not a well-known phrase
18 and does feature word play and additional criteria including
19 imagination and intrigue that would imbue the mark with
20 distinctive character;

21 • The Hearing Officer erred by claiming the Class 36
22 services are a homogenous group;

23 • The Hearing Officer erred by giving undue prominence
24 to the public interest behind s.3(1)(c);

25 • The Hearing Officer erred by giving undue prominence

1 to the way in which the Appellant was using its mark;

2 • The mark MAKE GIVING COUNT is not wholly devoid of
3 any distinctive character when compared to the Class 36
4 services applied for."

5 The supporting contentions are set out in considerable
6 detail, and in essentially the same terms under the heading
7 "Errors of Principle" in paragraphs 22 to 34 of the skeletons of
8 argument filed in respect of each appeal. I have carefully
9 considered the points made in those paragraphs. Having done
10 so, I am not persuaded that the Hearing Officer's decisions
11 were wrong in terms of their reasoning or conclusions. There
12 is, in my view, no material difference between the expression
13 "MAKE GIVING COUNT" and the expression "MAKING GIVING COUNT"
14 for the purposes of the requirement for distinctiveness under
15 section 3(1)(b).

16 It is apparent from the proviso to section 3(1) of the
17 Act, which confirms that a trade mark shall not be refused
18 registration by virtue of sub-paragraphs (b), (c) or (d) of
19 that section, if, before the date of application for
20 registration, it has in fact acquired a distinctive character
21 as a result of the use made of it, that the word "devoid"
22 should be understood as meaning "unpossessed" in the context
23 of the phrase "devoid of any distinctive character", as used
24 in section 3(1)(b).

25 There is, as stated in paragraph 19 of the Judgment of

1 the CJEU in Case C-104/00 Deutsche Krankenversicherung AG v
2 Ohim (Companyline), no obligation to rule on the possible
3 dividing line between the concept of lack of distinctiveness
4 and that of minimum distinctiveness. If the sign in question
5 is found, on assessment, to be intrinsically origin neutral in
6 relation to services of the kind for which registration has
7 been requested, the application for registration stands to be
8 rejected for lack of distinctiveness under section 3(1)(b).

9 It has become fairly common in the case law of the
10 supervising courts in Luxembourg for lack of distinctiveness
11 to be attributed to the banality of the sign presented for
12 registration. I agree with the Hearing Officer in thinking
13 that the expressions in issue in the present case conform to
14 the structure of colloquially known phraseology and do so in
15 terms which are linguistically apt to explain what the
16 applicant does or aims to do, without also and at the same
17 time serving as an indication of trade origin, in relation to
18 Class 36 services of the kind specified.

19 I am willing to accept that "count" is a versatile term,
20 with nuances of meaning as part of the expressions at issue. It
21 does not follow that any of the possible shades of meaning it
22 might be taken to possess, when used as part of the
23 expressions at issue, is sufficient to lead to the conclusion
24 that the expressions as a whole possess a distinctive
25 character.

1 Taken as a whole, they look and sound like statements
2 about advantages flowing from use of the services on offer.
3 I accept that the advantages and the methodology or mechanisms
4 by which they are delivered are not thereby explained.
5 However, a narrative statement can be uninformative in
6 relation to aspects of the services to which it refers,
7 without necessarily being apt to serve as an indication of
8 trade origin. I think that is the position here. The
9 expressions in question appear to me to involve no verbal
10 manipulation or engineering or double entendre of the
11 kind which, in other cases, has been regarded as sufficient to
12 turn explanatory phraseology into a sign possessed of a
13 distinctive character.

14 It is clear that the assessment of a sign for
15 distinctiveness must be made in relation to each of the
16 categories of goods or services for which registration is
17 requested, without lumping together goods or services which
18 are not interlinked in a sufficiently direct and specific way,
19 to the point where they form a sufficiently homogenous
20 category or group of goods or services: see the Judgment of
21 the CJEU in Case C-437/15P EUIPO v Deluxe Entertainment
22 Services Group Inc. at paragraphs 26 to 45.

23 I am satisfied, having regard in particular to what he
24 said in paragraphs 18 and 26 of the decisions under appeal,

1 that the Hearing Officer did not do otherwise in the present
2 case. It is confirmed in its accounts, publicly filed at
3 Companies House, that the applicant was incorporated as a
4 company limited by guarantee on 8th August 1975, and that it
5 has, since incorporation, acted as nominee for the Trustees of
6 Charities Aid Foundation ("CAF", registered charity number
7 268369) and holds investments and other assets on their
8 behalf.

9 Some but not all of the Class 36 services for which
10 registration was requested are listed in terms which relate
11 them to activities of a charitable nature. Those which are
12 not listed in such terms are nonetheless listed in terms which
13 are broad enough to encompass such activities. It was
14 incumbent on the applicant to limit the Class 36 services
15 listed in its applications for registration, so as to confine
16 them, if and so far as it could in accordance with the
17 POSTKANTOOR principle and the requirement for legal certainty,
18 to services with respect to which the expressions in question
19 might possibly be found to possess a distinctive character:
20 see FLYING SCOTSMAN Trade Mark (BL O/313/11; 31st August 2011)
21 at paragraphs 12 and 13. It does not appear from the papers
22 before me that the applicant has attempted to formulate any
23 such limitations for adjudication in relation to the Class 36
24 listings worded in general terms in its applications for
25 registration.

