

TRADE MARKS ACT 1994

O-205-19

**IN THE MATTER OF APPLICATION NUMBER 3310478 BY BARKER BROOKS
COMMUNICATIONS LIMITED**

TO REGISTER THE FOLLOWING MARK IN CLASS 41

THE APPRENTICESHIP GUIDE

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THE APPRENTICESHIP GUIDE

Background

1. On 14 May 2018, Barker Brooks Communications Limited ('the applicant') applied to register trade mark application number 3310478 consisting of the words 'The Apprenticeship Guide' for the following services in class 41:

Publishing; Publishing and reporting; Publishing by electronic means; Publishing of books; Publishing of books, magazines; Publishing of documents; Publishing of educational material; Publishing of educational matter; Publishing of electronic books and journals on-line; Publishing of electronic books and journals online; Publishing of electronic publications; Publishing of printed matter; Publishing of web magazines; Publishing services; Publishing services (including electronic publishing services); Publishing services carried out by computerised means; Book publishing; Electronic publishing; Magazine publishing; Multimedia publishing; Multimedia publishing of magazines; Multimedia publishing of printed matter.

2. On the 23 May 2018 the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report the following objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act'):

"The application is not acceptable. There is an objection under Section 3(1)(b) and (c) of the Act. This is because the mark consists exclusively of a sign which may serve in trade to designate the kind/characteristic of the services, e.g. those providing guidance for new apprenticeships.

According to a recent report by the Office for National Statistics:

"Apprenticeship participation now stands at a record level - there were 491,300 apprenticeship starts in the 2016 to 2017 academic year of which 121,250 (24.6%) were under 19".

On this basis, it is felt that the words should remain free for others to use in the course of trade."

A period of two months was granted for the applicant to respond.

3. On 29 June 2018 the applicant responded contesting the objection. The examiner was not persuaded that the mark is inherently distinctive and on 29 June 2018 wrote to the applicant confirming this. On that same date the applicant requested an *ex parte* hearing.

4. At the hearing, which was held on 13 September 2018 with Mr Chapman of the applicants, we discussed the objection and I explained the purpose of a trade mark and the reason why the objection had been raised. At the hearing Mr Chapman did not make any further submissions to those submissions made in correspondence, which were:

- Their guide is the first, and to his knowledge, the only extensive guide to English and Welsh apprenticeships which is available online, in print and via an app.
- The Apprenticeship Guide is a 350-page yearly directory that is fully supported by the National Apprenticeship Service and is distributed to every secondary school in England and Wales by the Skills Funding Service.
- Hundreds of colleges subscribe to the guide and it has been supported by leading figures such as David Lammy MP, Sir Alan Sugar and Sue Husband the director of the National Apprenticeship Service.
- The brand has been well established for 14 years and the website attracts over 40,000 visitors every month.
- On their website they use a logo with 6 colours but rotate the same 6 colours every year so as to be distinctive.

Although Mr Chapman stated, in correspondence, that to his knowledge theirs is the only extensive guide to apprenticeships, a search of the Internet had revealed that the applicant is not the only publisher of apprenticeship guides and in the circumstances, it is unlikely that consumers would see these apprenticeship guides as coming from any one particular source. I considered the mark to be descriptive of the services being provided and I therefore maintained the objection.

5. Although I maintained the objection, at the hearing I explained that it may be possible for a mark to proceed on the basis of acquired distinctiveness if there has been sufficient use of the mark. I explained this in more detail in the hearing report. I added that Mr Chapman may consider resubmitting the mark with a distinctive element and I also gave more details concerning this in the hearing report. I also informed Mr Chapman that, as there is no legal requirement to register a mark in the UK, he could continue to use his mark and put the letters TM after it, although he should not use the registration symbol ® with the mark as it is an offence to portray that a mark is registered when it is not. As the applicant had been using the mark for a number of years I allowed two months for Mr Chapman to decide whether he wished to submit evidence of acquired distinctiveness. I provided details of how to do this in the hearing report. These two months also gave Mr Chapman the opportunity to comment on the Internet hits included with the hearing report, should he wish to do so. As Mr Chapman did not respond to the hearing report, I formally refused the application on 28 November 2018 under Section 37(4) of the Trade Marks Act 1994. On 20 December 2018 the applicant 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 Mark Rules 2008, to state in writing the grounds of my decision and the material used in arriving at it. As stated in the above paragraph, no formal evidence

has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, I only have the *prima facie* case to consider.

The *prima facie* case for registration under Section 3

The Law

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 relevant legal principles - section 3(1)(c)

8. There are a number of judgments of the Court of Justice of the European Union ('CJEU') 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 and services are deemed incapable of fulfilling the indication of origin function of a trade mark (*WM Wrigley Jr & Company 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 the 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)*);
- When determining whether a sign is devoid of distinctive character or is descriptive of the goods or services in respect of which registration is sought, it is necessary to take into account the perception of the relevant consumer who is reasonably well-informed and reasonably observant and circumspect (*Matratzen Concord AG v Hukla Germany SA, C-421/04*);
- There must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the relevant consumer immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics (*Ford Motor Co v OHIM, T-67/07*);
- A sign which fulfils functions other than that of a trade mark is only distinctive if it may be perceived immediately and on first impression as an indication of the commercial origin of the goods or services, so as to enable the relevant consumer to distinguish, without any possibility of confusion, the goods and services of the owner of the mark from those of a different commercial origin (*Sykes Enterprises v OHIM (Real People Real Solutions) [2002]. ECT 11-5179*).

9. I also have to take into account the consequences for third parties of granting the applicant a monopoly. 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."

10. 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 services being provided. I therefore have to consider who the average consumers for

the services covered by the application are. The services are exclusively publishing services and reporting services. In the High Court decision of *British American Group v Gap* [2016 EWCH 599 (CH)] an appeal was allowed against a decision of a UK IPO Hearing Officer who considered that the average consumers of publishing services were generally businesses who required the publication of material. The opponent argued that, because the applicant was using the mark applied for on its magazines, the average consumer of those magazines was the general public. In the decision, it was considered that there was a high degree of correspondence between the carrying out of that service and the magazines which are the end product of that service and the Hearing Officer was wrong to conclude that the average consumer would generally be a business. I believe the same principle to apply here. From the information supplied by the applicant, the words 'The Apprenticeship Guide' are used on the guides they publish and I therefore consider the average consumer could include businesses, such as educational establishments and maybe job centres, who may wish to distribute the guides to those wishing to apply for an apprenticeship, those who wish to advise those seeking an apprenticeship, such as teachers, lecturers and career guidance counsellors, those who are considering taking on apprentices, and of course could also include individuals themselves who are looking to apply for an apprenticeship. Regarding the term 'reporting services', as reporting is the activity or job of producing written reports or broadcasts about items in the news or of interest, I assume that the reporting services would cover the reporting of news to be included in the guides, and therefore the average consumer for these services would be the same consumers as those of the guides themselves.

11. In assessing the mark applied for, and how the average consumer will perceive the mark, I have taken into account the dictionary definitions of the individual words contained within the mark. The following definitions are taken from Collins English Dictionary (Online version):

Apprenticeship - *Someone who has an apprenticeship works for a fixed period of time for a person who has a particular skill in order to learn the skill. Apprenticeship is the system of learning a skill like this.*

Guide – *a guide is a book that gives you information or instructions to help you do or understand something.*

In my opinion, when viewed in the *prima facie*, the sign THE APPRENTICESHIP GUIDE, used in respect of publishing and reporting services, would be understood as the publishing of guides providing information for apprentices and those wishing to employ them. I do not believe the combination of the words can lay claim to any grammatical or linguistic imperfection or peculiarity such as might help to escape its inherent descriptiveness. The average consumer, whom I have identified above as consumers seeking an apprenticeship, those giving guidance to individuals interested in obtaining an apprenticeship and consumers who are considering employing apprentices, who may want to consult a guide which provides information about apprenticeships. The words 'the apprenticeship guide' would be perceived by consumers as nothing more than an indication that the publishing services provide guides which contain information relating to apprenticeships. 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.”

12. Whilst I am able to arrive at my conclusion based on the meaning of the words alone, I am reinforced in my view by the fact that my Internet research has confirmed that the applicant is not the only publisher to provide apprenticeship guides (see Annex A) and details of these were provided with the hearing report. It is clear from such findings that the combination of the words ‘the apprenticeship guide’ are capable of application to goods and services provided by others and are being used by others, as Annex A indicates.

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

14. 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)

15. I have fully considered in this case whether there is a separate or independent objection under section 3(1)(b). In the circumstances I do not consider that there is; the objection under 3(1)(b) co-exists and is co-extensive with the objection under section 3(1)(c). In other words, the mark is devoid of all distinctive character by virtue only of it designating a characteristic under section 3(1)(c)

16. 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. The applicant had informed the Registry that the guide is on its 13th edition and at the hearing, and in the hearing report, I explained to Mr Chapman that it may be possible for the application to proceed on the basis of distinctiveness acquired through use, if that use indicates that the mark has become recognised as a badge of origin of the applicant. Details of how to submit that use were given in the hearing report which includes the fact that evidence in support of acquired distinctiveness must be filed by way of

statutory declaration or witness statement which has not been the case here. I allowed two months for Mr Chapman to decide whether or not to submit evidence of use of the mark. He did not do, so or comment on the Internet hits sent with the examination report. As I have said above, this means I only have the *prima facie* case to consider.

17. 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 17 April 2019

Linda Smith

**For the Registrar
The Comptroller-General**

Annex A

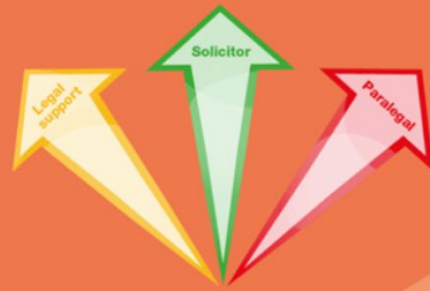
Guidance

A guide to apprenticeships

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The Law Apprenticeships Guide



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Welcome

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The Apprenticeship Guide

'Earn while you learn' has always been a popular option for young people when leaving school, and now with University fees quickly becoming more expensive, turning to apprenticeships is the best option for a lot of people. Apprenticeships are also ideal for those who spend the later years of school frustrated with schoolwork, as they'd rather be out working in the 'real world' in employment, learning skills and knowledge to help climb the career ladder.

Higher and degree apprenticeships guide

By Kelly Fenn (Editor, Which? University) | 05 March 2018

The Small Business Guide To Apprenticeships

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