

O-0121-23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 3753699

BY THE HARWELL SCIENCE AND INNOVATION CAMPUS GENERAL PARTNER LIMITED

TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 36, 41 and 42:

ADVANCED RESEARCH CLUSTERS

Background

1. On 11 February 2022 The Harwell Science and Innovation Campus General Partner Limited (“the applicant”) applied to register the words ‘ADVANCED RESEARCH CLUSTERS’ for the following services:

Class 36

Real estate affairs; real estate management; leasing of real estate; rental of offices (real estate); leasing of office space; rental of offices for co-working; property management; rental of real estate; land leasing; leasing and rental of commercial premises; leasing of property; building leasing; providing information, advisory and consultancy services in relation to the aforesaid management.

Class 41

Education; providing of training; providing educational services; organisation of meetings and conferences; arranging and conducting of commercial, trade and business conferences; arranging and conducting conferences and seminars; arranging, conducting and organisation of conferences, seminars and symposiums; conference services. providing information, advisory and consultancy services in relation to the aforesaid management.

Class 42

Scientific advisory services; technical advice and consultancy services; technological advisory services; laboratory services; scientific laboratory services; research services; technological research; engineering research; scientific research; biological research; research laboratory services; planning [design] of buildings; providing information, advisory and consultancy services in relation to the aforesaid management.

2. On 25 February 2022, the Intellectual Property Office (“the IPO”) issued an examination report in response to the application. In that report, an objection was raised under section 3(1)(b) and (c) of the Trade Marks Act 1994 (“The Act”) as follows:

The application is not acceptable in Classes 36,41 and 42. 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 of the services e.g. Education and Scientific advisory services in ‘Advanced Research Clusters’.

A Research Cluster is a formally recognised group of researchers whose research expertise is applied either to a common area, field, or theme, or who are involved in a collaborative research project, or set of related projects.

It is therefore considered that when presented to the relevant consumer, they would not perceive the sign as one that indicates the commercial origin of the services offered but merely as a sign that denotes the kind of services offered. As such the term is incapable of functioning as trade mark.

3. In line with standard IPO procedure a period of two months was allowed for the applicant to respond.
4. On 25 April 2022, Brandsmiths SL Limited (“the representative”), acting on behalf of the applicant provided submissions in favour of acceptance of the mark. In the examiner’s letter of 23 June 2022, the objection was maintained.
5. On 23 August 2022, the representative requested an ex-parte hearing in relation to the objection. The hearing was scheduled for 13 September 2022.
6. The hearing was attended by Mr Barry of Brandsmiths SL Limited who made the following submissions for the acceptance of the mark:
 - It was not accepted that the term *research cluster* is a term of art and no references had been provided to demonstrate that it is. Mr Barry noted that the objection is based on the term ‘research cluster’ being understood. Even if it was, or

could be construed, he argued that the word 'advanced' changes the significance of the mark.

- Based on the examiner's original objection, a 'research cluster' is, in any event, not a commercial enterprise and instead refers to individuals under a banner or structure.

- The mark should be considered through the eyes of the average consumer.

- The mark has been applied for in three classes and only one of those relates to research per se. The mark has no meaning in relation to Class 36 and in respect of Class 41 those services are provided by organisations rather than individual researchers.

- The average consumer would not perceive the mark as a description and if the examiner is correct the objection could only bite in Class 42 for research related services.

- As stated, Mr Barry was not sure that 'advanced research cluster' is a 'term of art' and his Google search found that the first four pages related to the applicant. On the fourth page he found a reference to 'research cluster', but a single use does not show that the term is known.

- Even though 'advanced' is an adjective it does not follow that this makes the mark descriptive. The words 'large research cluster' would be descriptive but 'blue research cluster' is arbitrary and would be acceptable. The mark of this application is between those extremes and has an unusual impact and lexical inventiveness, referring to the *Baby Dry* decision (C-383/99P).

- As the examiner's view is that the mark relates to a highly specialised group of researchers and not businesses or traders. Mr Barry submitted that the average consumer would be circumspect and pay a great deal of attention when accessing the services. The highly specialised consumer would be aware that there is no such thing as a research cluster.

- The words contained in the mark are unusual and lift the mark above the required level of distinctiveness

7. In response at the hearing I explained that I had completed Internet research and found that the term 'research cluster' is a known term which relates to groups who conduct research in relation to any given subject. I stated that I found lots of evidence of universities having research clusters for various subjects. I referred to the Merriam Webster dictionary definition of 'advanced' namely, being beyond the elementary or

introductory and stated that the average consumer would understand the mark as a description that the services are provided by, or for research clusters which are advanced.

8. I issued the hearing report on 21 September 2022, confirming that the objection had been waived against the Class 36 services, however the 3(1)(b) &(c) objection was maintained against all of the services in Classes 41 and 42. I allowed the applicant a period of two months to respond, as I had deferred my decision at the hearing, and I had also provided Internet references with the hearing report, which Mr Barry did not have sight of prior to the hearing. (see Annex A for Internet references)
9. On 18 November 2022, the representative responded to the hearing report, stating that the applicant wishes to appeal the decision to the Appointed Person and requested confirmation of the appeal deadlines.
10. On 21 November 2022, I issued the refusal letter giving the applicant a month to submit a TM5
11. On 21 December 2022, the representative filed a form TM5 requesting a full statement of reasons for the refusal of the application. The representative also requested to reduce the specification so that the appeal only relates to the following services:

Class 41

Education (other than university education); providing of commercial, trade and business training; providing educational services (other than university educational services); organisation of commercial, trade and business meetings; arranging and conducting of commercial, trade and business conferences; arranging and conducting conferences and seminars; arranging, conducting and organisation of conferences, seminars and symposiums; conference services. providing information, advisory and consultancy services in relation to the aforesaid management.

Class 42

Scientific advisory services; technical advice and consultancy services; technological advisory services; laboratory services; scientific laboratory services; research laboratory services; planning [design] of buildings; providing information, advisory and consultancy services in relation to the aforesaid management.

12. Having received that Form TM5, I am now required to set out the reasons for refusal. No formal evidence has been put before me for the purpose of demonstrating acquired distinctiveness, so I have only the prima facie case to consider.

The Law

13. Section 3(1)(b) and (c) of the Act reads as follows:

(1) The following shall not be registered—

(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,

The relevant legal principles – Section 3(1)(c)

14. There are a number of judgements 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. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts. 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 and 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 and services. The word 'exclusively' in Paragraph (c) is not intended 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 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 (Decision of the General Court in *Ford Motor Co v OHIM*, Case T-67/07);
- Article 3(1)(c) [Trade Mark Directive] must be interpreted as meaning that a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of the characteristics of those goods or services for the purposes of that provision, unless there is a perceptible difference between the word and the mere sum of its part (see judgement of the ECJ *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (Postkantoor)* C-363/99 paragraph 104).

Application of the legal principles

15. The mark consists of the three words 'ADVANCED RESEARCH CLUSTERS'. The Merriam-Webster Dictionary defines advanced as:

b : being beyond the elementary or introductory

| *advanced* chemistry

c : greatly developed beyond an initial stage

| the most *advanced* scientific methods

| *advanced* weapons systems

16. I note that the term 'research cluster' is not dictionary defined, however it is certainly a term being used by others, especially by universities to refer to groups who undertake research. See Annex A for further information.

17. It is clear from the aforementioned case law that I must consider who the relevant consumer of the services would be and how the relevant consumer is likely to perceive the mark.

18. In relation to all the Class 41 services, I consider the average consumer to consist of both the general public and businesspeople, who would pay various levels of attention when accessing the services. Although some of the general public may not typically encounter, or be aware of research clusters, based on the natural meaning of the words they are likely to understand the term as referring to a group of researchers.

19. In respect of the Class 42 services, I consider the average consumer to consist of professionals, who would pay a high level of attention when accessing the applicant's services and in my opinion would be aware that "research clusters" is a recognised term. However, for technical advice and consultancy services, these services could be used by a broad spectrum of consumers.

20. In my opinion the relevant consumer, whether professional or not, would perceive the sign as merely designating that the services are provided by an 'advanced research cluster'. That is to say, ANY 'advanced research cluster', not a single undertaking. In terms of section 3(1)(c) of the Act this would be a designation of the 'type' or 'kind' of

undertaking offering the service, or it may be even subject matter of the services. As such though, in my view the words would constitute a characteristic of the services.

21. Much of the argument from the applicant relates to the fact that the term has not been shown to be a known term of art in the first place or, even if it were, the phrase as a whole, including the word 'advanced', means it has a degree of vagueness, sufficient to evade the section 3(1)(c) objection. That is, especially when a rather sophisticated consumer is factored into the equation.
22. It is very important in a case such as this to refer back to the case law guiding principles set out above. As such, there is no obligation on the registrar to prove that a particular phrase or collection of words is a 'term of art' or that it is otherwise in current use, to make good a section 3(1)(c) objection. Nor is there any obligation to establish any common dictionary definition or that a particular term has a necessarily uniform and exact meaning. If it does so then fine, but the registrar is not bound to prove such a meaning for the objection to bite. As has been repeatedly stated the legal test for the registrar is whether a particular application, taken as a totality, could designate a characteristic of the goods or services. This starts with a purely linguistic analysis of the words constituting the mark and the likely impact of those words as a totality, in normal and fair use.
23. In my view the three words would create an obvious meaning in the minds of consumers. The words are in a grammatically correct sequence. The term 'research cluster' is more than likely in my opinion to convey descriptive meaning, notwithstanding that the 'research cluster', in the eyes of the consumer, could be a group of individual researchers or bodies of some sort. The word 'cluster', on a purely linguistic level, would encompass both and also conveys the notion of being 'like-minded' or similar. The term 'advanced' does not have an individualising effect on the mark as a whole as, in my opinion, it is purely adjectival, describing the research clusters as being advanced.
24. Based on my linguistic analysis alone above, the particular examples of use of the term 'research cluster' in the Annex are, in effect, purely illustrative. For the benefit of any doubt, even without them I would have arrived at the same conclusion through linguistic analysis alone.
25. I would like finally however to consider why the objection applies across the board to all the objected to services. This question comes down to whether the services can

reasonably be regarded as all being part of a homogenous group. That is to say, they are so closely related that no meaningful distinction can be made whereby the mark would clearly be acceptable for certain services but not others. I consider all of the services listed in Class 42 to relate to or incorporate research and can see no reason why 'advanced research clusters' would not be providing these services. Whilst I can see the applicant's argument that in Class 41 it may be a little more arguable, having given the matter careful thought however, I am struggling to conclude, from the submissions alone, that an 'advanced research cluster' would inevitably not provide the services listed in Class 41. To do so may be to create a wholly artificial divide between broad 'research services' and the commercial sector. Such a divide does not in my opinion exist in today's world and it would be unwise to assume it does. For these reasons I am applying the objection across the board in this case.

26. I have taken into account the guidance set out in relevant case law and I consider that the average consumer of the relevant services will not perceive the sign as indicating trade origin of the objectionable services. I therefore conclude that the mark consists exclusively of a sign which may serve, in trade, to designate a characteristic of the services, and are therefore excluded from registration by section 3(1)(c) of the Act.

27. Any mark found to be unacceptable under section 3(1)(c) will automatically be found to be non-distinctive. The objection taken under section 3(1)(b) is solely on the basis that the mark designates a characteristic of the services and for no other reason. In other words, the objection under section 3(1)(b) and (c) in this case is co-extensive; there is no independent, contingent or separate rationale required under section 3(1)(b).

Conclusion

28. In this decision, for the reasons given above, the application is refused in Classes 41 and 42 under section 37(4) of the Act because it fails to qualify under Section 3(1)(b) and (c) of the Act.

Dated this 3rd day of February 2023

**Martyn Jefferiss
For the Registrar
Comptroller-General**

[Research clusters | Middlesex University London \(mdx.ac.uk\)](https://www.mdx.ac.uk/research-clusters)

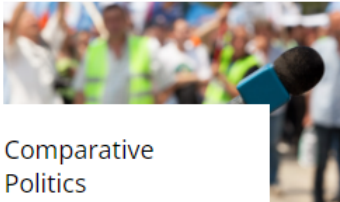
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Research clusters at Middlesex are interdisciplinary groups of researchers addressing research problems that demand novel approaches. They reflect the excitement of research at the University where discipline boundaries are permeable and research traditions may collide to find new ways of understanding our world and its problems.

[Research clusters - School of Social Sciences - The University of Manchester](https://www.manchester.ac.uk/research-clusters)

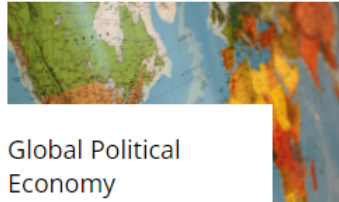
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[Research Clusters | Wolfson College, Oxford](#)



Wolfson is home to a number of renowned research clusters, who are pushing the boundaries of knowledge on topics ranging from Quantum Physics to Life Writing.

The Research Clusters epitomize the interdisciplinary, egalitarian community that can be found at Wolfson. The Clusters, the first of which was founded in 2010, offer spaces for members working in related areas of research in different disciplines to collaborate, debate issues, and discuss mutual interests.

Cluster members organize events from small discussion groups up to international conferences, and all members at whatever stage in their careers are encouraged to be involved. Some Clusters offer grants, others support workshop proposals, and a number of studentships are also sponsored. Follow the links below to find out more.

[Student-led Activity | SWWDTP Studentship : SWWDTP Studentship \(sww-ahdtp.ac.uk\)](#)

Research Clusters

SWW DTP students participate in cross-disciplinary research clusters to extend their research development and training beyond each programme's immediate research field. The clusters have been developed around themes and questions of wide resonance that will enable cross-disciplinary dialogue and knowledge exchange.

How the research clusters work:

- SWW DTP research clusters are student-led, with academic support and advice.
- Students can get involved with multiple clusters.
- The clusters are adaptive to the needs of each cohort and we encourage students to set up new interdisciplinary clusters based on their research interests. The DTP is currently supporting the following student-designed clusters: 'Understanding Change', 'Memory Studies', 'Gender and Sexuality', 'Figures in the Landscape', 'Rethinking Community', 'Creativity in Research' and 'Space, Community and Culture'.
- Students engage in discussion and debate across institutional boundaries using the SWW DTP's research cluster Facebook group and at the biannual cohort days.
- Students organise and run research cluster activities and events, with academic and DTP admin support where needed.
- The cross-disciplinary activities bring together students, academics and representatives from our external partners to interrogate topics and resources of common interest.

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- Engaging with key research users and maximising impact;
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