

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. 2220640A**

**TO REGISTER A
TRADE MARK IN CLASSES 6, 9, 19, 20, 35, 37 & 42**

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BY CO-OPERATIVE INSURANCE SOCIETY LIMITED**

DECISION AND GROUNDS OF DECISION

Background

1. On 31st January 2000, Co-operative Insurance Society Limited of Miller Street Manchester M60 0AL applied to register the trade mark CO-OPERATIVE (as application number 2220640) in classes 6, 9, 19, 20, 35, 36, 37 and 42.

2. Following the raising of various objections the application was divided into two parts, namely, 2220640A covering classes 6, 9, 19, 20, 35, 37 and 42 and 2220640B in class 36. Application no 2220640B subsequently proceeded to publication and therefore I do not make any further reference to it in this decision.

3. The goods and services for which registration is sought are as follows:

Class 6: Metal locks; metal doors; parts and fittings for the aforesaid goods.

Class 9: Alarms; electric locks; electric security devices; parts and fittings for the aforesaid goods.

Class 19: Windows; window fittings; parts and fittings for the aforesaid goods.

Class 20: Doors; door fittings; parts and fittings for the aforesaid goods.

Class 35: Sales promotion and marketing services; business advice and business administration services.

Class 37: Property construction services; vehicle repair services.

Class 42: Computer services; legal services; printing services; property management services.

4. Objections were raised against the application under the following sections of the Act:

(i) Sections 3(1)(b) and (c): because the mark consists exclusively of the word “co-operative” being a sign which may service in trade to designate the kind of goods/services, for example, in relation to a co-operative.

and

(ii) Section 5(2): because there is a likelihood of confusion with various marks under the ownership of The Co-operative Bank Plc. This objection was subsequently waived and I need not make any further reference to it in this decision.

Decision

5. A hearing was held on 24th May 2001 at which the applicants were represented by Mr Bruce Marsh of Wilson Gunn M'Caw, Trade Mark Attorneys.

6. The objection under Section 3 (1)(b) and (c) of the Act was maintained and the application was subsequently refused on 18th December 2001 in accordance with Section 37(4) of the Act.

7. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

8. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

The law

9. The relevant part of Section 3 of the Act is as follows:

Section 3(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.*

10. The mark consists of the ordinary word “co-operative” and the Collins English Dictionary (Millennium Edition) provides several definitions. The meanings which are of particular relevance are shown as follows:

cooperative or co-operative

3a (of an enterprise, farm, etc.) owned collectively and managed for joint economic benefit.

3b (of an economy or economic activity) based on collective ownership and cooperative use of the means of production and distribution.

4 a cooperative organisation.

11. I take the view that the mark CO-OPERATIVE conveys to the public that the goods or services supplied by the applicant originate from a co-operative or are produced and marketed by co-operative means. Because the mark clearly designates these characteristics of the goods or services, it is therefore excluded from registration under Section 3(1)(c).

12. On 20 September 2001, the European Court of Justice issued a judgement in *Procter & Gamble Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case-383/99P for the mark *Baby-Dry*. This judgement gives useful guidance on the test for descriptiveness under Section 3(1)(c) of the Act.

13. I give below paragraphs 37, 39 and 40 of the judgement in full:

"37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Procter & Gamble and the OHIM acknowledge, to prevent registration as trade marks signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function."

"39. The signs and indications referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics."

"40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services of their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark."

14. These paragraphs indicate that only marks which are no different from the usual way of designating the relevant goods or services or their characteristics are now debarred from registration by Section 3(1)(c). I have already taken the view that the mark at issue comprises a word which, prima facie, cannot distinguish the applicant's goods and services from those of other co-operative undertakings. Without any evidence to persuade me to the contrary, I believe that the mark "may serve in normal usage from a consumer's point of view to designate" one of the essential characteristics of the goods and services.

15. Having found that the mark is debarred from registration under Section 3(1)(c) of the Act, I now have to consider whether the mark is devoid of any distinctive character under Section 3(1)(b).

16. In the “Cycling IS...” decision (series of two marks), dated 28th November 2001 and as yet unreported, Geoffrey Hobbs QC as Appointed Person made the following comments:

“66. That brings me to the question of whether the signs possess a distinctive character enabling them to fulfil the essential function of a trade mark in relation to goods and services of the kind specified in the application for registration. (The goods and services comprise “clothing, footwear and headgear” in Class 25 and “advertising, all relating to the cycling industry” in Class 35).

67. The case for allowing registration rests upon the proposition that the signs are cryptic to a degree which makes it more likely than not that they would carry connotations of trade origin (whatever other connotations they might also carry) in the minds of the relevant class of persons or at least a significant proportion thereof.

68. The case for refusing registration rests upon the proposition that the signs are visually and linguistically meaningful in a way which is more likely than not to relate the goods and services to the activity of cycling without also serving to identify trade origin in the minds of the relevant class of persons.

69. The difference between these two positions resides in the question whether the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin specific or origin neutral.

70. The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect.

71. I do not suppose that such a person would pause to construe the signs when encountering them in any of the different settings (including advertising and promotional settings) in which they might be used. Even so, the degree of attention required to take note of the signs in the first place would be sufficient, in my view, to leave a well-informed and reasonably observant and circumspect person with the clear impression that the signs were being used with reference to goods and services related to cycling.”

17. Mr Hobbs went on to observe:

“73. Doing the best I can on the materials before me, I think that the signs in question would be perceived by the relevant class of persons as pronouncements in identifying cycling as the raison d’être for the marketing of the goods and services to which they are related. That is a message that the members of a consortium of bicycle retailers might naturally be interested in putting across to customers and potential customers. I do not think that the

nature of the pronouncement or its presentation can in either case be regarded as sufficiently striking to function as an indication of trade origin in relation to goods or services of the kind specified in the application for registration that is now before me.

74. It seems to me that the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin neutral (relating to the general commercial context of the relevant trading activities) rather than origin specific.”

18. In relation to the mark CO-OPERATIVE, I take the view that it would likely be perceived by the average consumer as being origin neutral rather than origin specific. Moreover, when viewed in the context of all the goods or services contained in the application, the mark would be perceived merely as a pronouncement relating to a co-operative organisation or to goods and services supplied by co-operative means. The mark cannot function in the prima facie as an indication of trade origin and therefore under Section 3(1)(b) of the Act I conclude that it is devoid of any distinctive character.

Conclusion

19. In this decision I have considered all documents filed by the agent, and for the reasons given the application is refused under the terms of Section 37(4) of the Act because the mark fails to qualify under Sections 3(1)(b) and (c) of the Act.

Dated this 16th day of April 2002.

Charles Hamilton
For the Registrar
the Comptroller General