

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO: 2220640A
TO REGISTER A TRADE MARK
IN CLASSES 6, 9, 19, 20, 35, 37 AND 42
BY CO-OPERATIVE INSURANCE SOCIETY LIMITED

DECISION

1. On the 31st January 2000, Co-operative Insurance Society Limited (“the Applicant”) applied to register the trade mark CO-OPERATIVE in respect of various goods and services in Classes 6, 9, 19, 20, 35, 36, 37 and 42. Following the raising of objections the application was divided into two parts, namely 2220640A covering Classes 6, 9, 19, 20, 35, 37 and 42 and 2220640B covering Class 36. Application number 2220640B proceeded to publication and is not in issue on this appeal.
2. Application number 2220640A was made in respect of the following goods and services:
 - 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.

3. So far as relevant on this appeal the Registry took objection to the application under section 3(1)(b) and (c) of the Trade Marks Act 1994 (“the Act”).
4. The matter proceeded to a hearing at which the objections under section 3(1)(b) and (c) of the Act were maintained and the application was subsequently refused. Mr Charles Hamilton, the Hearing Officer for the Registrar, issued a written decision dated the 16th of April 2002.
5. In relation to the objection under section 3(1)(c) he reasoned as follows:-

“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)”.

He then referred to the decision of the European Court of Justice (“the ECJ”) in *Procter & Gamble Company v OHIM (BABY DRY)* [2002] RPC 17 and cited paragraphs 37, 39 and 40 from the judgment. He continued:-

“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.”

6. In relation to the objection under section 3(1)(b), the Hearing Officer referred to the decision of Mr Jeffrey Hobbs QC in “*Cycling IS*” *Trade Mark*

Applications [2002] RPC 37. The Hearing Officer cited paragraphs 66 to 71 and 73 to 74 of that decision and concluded:-

“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.”

7. The Applicant gave Notice of Appeal to an Appointed Person under section 76 of the Act. On the hearing of the appeal Mr B. Marsh of Wilson Gunn M’Caw appeared on behalf of the Applicant and Mr S. Rowan appeared on behalf of the Registrar.

Section 3(1)(c) of the Act

8. In *BABY DRY*, the ECJ explained that the purpose of the exclusion under section 3(1)(c) is to prevent registration as trade marks of signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, cannot fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function (paragraph 37). Further, the signs and indications referred to are 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 (paragraph 39).
9. The Applicant submitted that the Hearing Officer fell into error in reaching his conclusion that the mark CO-OPERATIVE was not apt to distinguish the goods and services of the Applicant from those of other co-operative undertakings. In particular it was said that he wrongly focused on only one of the meanings of the word when in fact it is clear from the dictionaries that the word has several meanings. The Hearing Officer overlooked the fact that the word co-operative

also has the well known meanings “willing to co-operate”, “helpful”, “acting in conjunction with others” and “co-operating”. These meanings were not in any way descriptive of the goods or services the subject of the application and were certainly not normally used to designate any characteristic of any such goods or services.

10. I believe that this issue must be considered through the eyes of the average consumer of the goods and services in question. If the sign in issue is a usual way of designating the relevant goods or services or their characteristics then it is prohibited from registration by section 3(1)(c). The fact that the sign in issue may have other meanings which are not descriptive of the relevant goods or services does not, in my judgment, remove the objection. If the mark in question serves in normal usage to designate a characteristic of goods or services by virtue of one meaning which it has then, I believe, that remains the position even if it has other meanings which are not apposite to the relevant goods or services. I feel supported in this conclusion by the decision of the Court of First Instance of the European Communities of 27th February 2002 in *Streamserve Inc –v- OHIM*, Case T-106/00. The court there considered the mark STREAMSERVE and concluded, at paragraph 42:-

“As regards the meaning of the term STREAMSERVE, it is clear from paragraphs 12 and 13 of the contested decision and from the explanations given by the Office at the hearing that the term refers to a technique for transferring digital data from a server, enabling them to be processed as a steady and continuous stream. In that connection, the applicant’s arguments concerning the various possible meanings of the element “serve” are irrelevant. In view of the goods for which registration is sought, the meaning of the terms “stream” and “serve” adopted by the Office is correct. However, it must be borne in mind that, to be caught by Article 7(1)(c) of Regulation No. 40/94, it is sufficient if at least one of the potential meanings of a word sign designates a characteristic of the goods or services concerned.”

11. In the present case I have come to the conclusion that the decision of the Hearing Officer was correct. Absent any evidence to the contrary, I believe that the word CO-OPERATIVE is an entirely normal and usual way of indicating that goods or services, including those the subject of this application, have been produced or

provided by a co-operative organisation or have been produced or provided by co-operative means. This meaning of the sign in issue is well known and I believe that the word is used in this sense in common parlance. The fact that the word CO-OPERATIVE has other meanings which are not descriptive of the relevant goods or services does not alter the position. If the descriptive meaning of a word is obscure then it might well be the case that the word cannot be viewed as a normal way of referring to the goods or services in issue or of representing their essential characteristics in common parlance. But in my judgment this is not such a case. The mark must therefore be refused under section 3(1)(c) of the Act.

Section 3(1)(b)

12. Section 3(1)(b) of the Act prohibits the registration of trade marks which are devoid of any distinctive character. In the case of *Philips Electronics NV –v- Remington Consumer Products Ltd* [2003] RPC 2 the ECJ said, at paragraph 47:

“First, it is clear from Art.2 of the Directive that a trade mark has distinctive character if it serves to distinguish, according to their origin, the goods or services in respect of which registration has been applied for. It is sufficient, as is clear from paragraph 30 of this judgment, for the trade mark to enable the public concerned to distinguish the product or service from others which have another commercial origin, and to conclude that all the goods or services bearing it have originated under the control of the proprietor of the trade mark to whom responsibility for their quality can be attributed.”

13. I have come to the conclusion that the mark in issue is an entirely appropriate and normal way of indicating that the goods or services in issue have been produced or provided by a collective organisation or by co-operative means. To my mind this usage is so well known and so appropriate that it cannot be said that the mark would serve to distinguish goods or services in respect of which registration has been applied for, according to their origin. I do not think that the average consumer of goods or services the subject of this application would conclude that all such goods or services bearing the word CO-OPERATIVE had originated under the control of the Applicant.
14. Accordingly the mark must also be refused under section 3(1)(b) of the Act.

Conclusion

15. In the result the appeal against the refusal of the application by the Hearing Officer is dismissed.

David Kitchin QC

21st February 2003

