

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

TRADE MARKS REGISTRY

Room A2
Harmsworth House
13-15 Bouverie Street
London, EC4Y 8DP

Monday, 24th May 2004

B e f o r e:

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

In the Matter of the TRADE MARKS ACT 1994

and

In the Matter of International Trade Mark Registration 758503
ZURICH PRIVATE BANKING and the request by
ZURICH VERSICHERUNGS-GELSELLSCHAFT to protect a Trade Mark in
Classes 16 and 36

(Computer-aided Transcript of the Stenograph Notes of
Marten Walsh Cherer Ltd., Midway House,
27/29 Cursitor Street, London, EC4A 1LT.
Telephone No: 0207 405 5010. Fax No: 0207 405 5026.)

MR. B. MARSH (of Messrs. Wilson Gunn M'Caw) appeared on behalf of
the Applicant.

THE OPPONENT did not appear and was not represented.

MR. ALLEN JAMES appeared on behalf of The Trade Marks Registry
via videolink.

D E C I S I O N

1 THE APPOINTED PERSON: On 15th May 2001, Zurich
2 Versicherungs-Gesellschaft applied on the basis of
3 International Registration No. 758503 for protection of the
4 designation **ZURICH PRIVATE BANKING** as a trade mark for use in
5 relation to "*paper, cardboard and goods made thereof, included*
6 *in this class; printed matter; bookbinding material;*
7 *stationery; all the above goods are from Switzerland*", in
8 class 16, and "*insurance underwriting; financial affairs*" in
9 class 36. The applicant did not attempt to establish by
10 evidence that the designation had acquired a distinctive
11 character through use in the United Kingdom prior to the date
12 of the application for registration.

13 The request for protection was refused under
14 sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994 for
15 the reasons given in a written decision issued by
16 Mr. Charles Hamilton on behalf of the Registrar of
17 Trade Marks on 15th October 2003.

18 In paragraphs 11 and 15 of his decision, the hearing
19 officer specifically confirmed that his deliberations were
20 directed to the registrability of the designation
21 **ZURICH PRIVATE BANKING** in its totality. He took the view
22 that Zurich is well known as a financial centre, that the
23 average consumer would be likely to perceive and remember the
24 designation as an indication of the geographical origin of
25 the goods and services concerned and that he or she would not

1 be likely to perceive and remember it as an indication of
2 trade origin. He was not persuaded otherwise by the fact
3 that the word **ZURICH** had been accepted for registration in
4 respect of the same or similar goods and services in
5 Switzerland and in the Community Trade Marks Office.

6 As noted in his decision, the Swiss acceptance was on
7 the basis that the word **ZURICH** had been shown to the
8 satisfaction of the Swiss registration authorities to have
9 acquired a distinctive character through use; and the
10 acceptance in the Community Trade Marks Office was based on
11 some evidence or other as to distinctiveness, even if only in
12 relation to Switzerland.

13 The hearing officer was equally unpersuaded by the
14 existence of earlier acceptances in the United Kingdom of
15 marks in which the word **ZURICH** was a prominent feature. In
16 this connection, he adhered to the long established and
17 well-known principle that applications for registration must
18 always be considered on their own merits.

19 Having held that the designation was excluded from
20 registration for descriptiveness under section 3(1)(c), he
21 went on to hold that it was also excluded from registration
22 for lack of distinctiveness under section 3(1)(b).

23 The applicant gave notice of appeal to an
24 Appointed Person under section 76 of the Act contending, in
25 substance, that the hearing officer had erred, first, by not

1 concentrating on the designation **ZURICH PRIVATE BANKING** as a
2 whole when examining it for registrability; and, secondly, by
3 not giving due weight to other acceptances of the same or
4 analogous designations for registration in respect of the same
5 or analogous goods and services in the UK and elsewhere. These
6 contentions were developed in argument before me.

7 As to the first of them, it is of course correct that
8 designations must be examined without excision or
9 dismemberment, but the hearing officer did not say or do
10 otherwise in his assessment of the designation
11 **ZURICH PRIVATE BANKING**. It does not follow from the
12 proposition that there should be no excision or dismemberment
13 that all elements of a designation must be taken to
14 contribute equally to the perceptions and recollections that
15 it would be likely to trigger in the mind of the average
16 consumer. It may or may not be the case that meaning and
17 significance are evenly dispersed throughout the elements
18 of a mark. In observing that the word **ZURICH** was the closest
19 that the present designation got to individualising or
20 localising the message it conveyed and also in observing that
21 Zurich was well known as an international financial centre,
22 the hearing officer was simply stating the obvious and cannot
23 be criticised for doing so.

24 So far as the second ground of appeal is concerned, it
25 is necessary to bear in mind that the Registrar is not only

1 permitted but required to apply the provisions of the
2 Trade Marks Act 1994 with full regard for circumstances
3 prevailing in the United Kingdom. In addition, it is clearly
4 recognised and accepted in Community law that the meaning and
5 significance of a designation may vary from one member state
6 to another as a result of linguistic, cultural and social
7 differences between their populations.

8 Finally, it must be appreciated that all assertions of
9 inconsistency between acceptances and refusals within a
10 national Registry and all assertions of inconsistency between
11 acceptances and refusals in different registries are, by
12 their very nature, question-begging as to the correctness of
13 each of the various acceptances and refusals that are brought
14 into contention.

15 However, the position as between different national
16 registries and the Community Trade Marks Office is that they
17 are not competent to adjudicate on the correctness of each
18 other's determinations and, as a corollary of that, not
19 required to treat each other's determinations as binding upon
20 them in the independent exercise of their own powers. That
21 is not to say that each of them should or will simply ignore
22 determinations of the others. The general principle is that
23 each of them should give determinations of the others such
24 weight (if any) as they might fairly and properly be said to
25 bear in the decision-taking processes they are required to under

1 undertake independently of one another. I take this to have
2 been affirmed in paragraphs 59 to 65 of the recent judgment of
3 the European Court of Justice in case C-218/01 **Henkel KGaA v.**
4 **Deutsches Patent-und Markenamt** 12th February 2004. More
5 particularly, at the national level in the United Kingdom, it
6 cannot be right that the Registrar should be deflected from
7 reaching the decision he considers to be correct in a given case
8 by the decision reached in another case on another occasion.
9 I see no basis on which the hearing officer could rightly be
10 said to have departed from these principles in the present case
11 and even if he had, I would still want to know why it was said
12 that his decision to refuse registration was wrong on the
13 merits. As to that, the applicant wishes to maintain that a
14 different view on registrability should be adopted on appeal.
15 However, the decision under appeal would need to have been
16 flawed by reason of a clear error of assessment or serious
17 procedural irregularity before I could be justified in setting
18 it aside on appeal. I do not think it was flawed in either of
19 these respects.

20 For these reasons, shortly stated, the appeal will be dismissed.

21 MR. JAMES: Thank you, sir.

22 THE APPOINTED PERSON: I think that concludes this afternoon's
23 business. Thank you very much.

1 MR. JAMES: Sir, you have not mentioned anything about costs as
2 of yet.

3 THE APPOINTED PERSON: Does anybody want to apply for costs?

4 MR. JAMES: No. I wanted to make it clear that we were not going
5 to apply for costs.

6 THE APPOINTED PERSON: All right. I wondered what the
7 Registrar's position might be. I inferred from your silence
8 that you were not applying but the record will show that to
9 be the case.

10 MR. JAMES: Thank you, sir.

11 THE APPOINTED PERSON: Thank you very much.

12 -----

13

14

15

16

17

18

19

20

21

22

23

24

25