

1 THE PATENT OFFICE

2 Harmsworth House,
3 13-15 Bouverie Street,
4 London EC4Y 8DP

5 Monday, 19th March 2007

6 Before:

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

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9 In the Matter of: The Trade Marks Act 1994

10 and

11 In the Matter of: An appeal from the decision of
12 Mr. R.A. Jones to the Appointed Person
13 with respect to Trade Mark Application
Number 2339794 FOR YOU... (series of 3)
in the name of Sodexho Education Services
Limited.

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15 (Transcript of the Shorthand Notes of
16 Marten Walsh Cherer Limited,
6th Floor, 12-14 New Fetter Lane, London EC4A 1AG.
17 Tel: 020 7936 6000. Fax No: 020 7427 0093.
Email: info@martenwalshcherer.com

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19 MR. FIDDES (of Urquhart Dykes & Lord) appeared for the Appellant.

20 MR. ALLAN JAMES appeared on behalf of the Registrar of Trade
21 Marks.

22 In Attendance: MS. AMANDA MICHAELS.

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24 D E C I S I O N
(Approved by the Appointed Person)

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1 THE APPOINTED PERSON: On 5th August 2003 Sodexho Education UK
2 Limited applied under No. 2339794 to register a series of
3 three signs to be used as trade marks in relation to the
4 following goods and services in Classes 29, 30, 37 and 43:

5 Class 29:
6 Meat, fish, poultry and game, meat extracts; preserved
7 dried and cooked fruits and vegetables; jellies, jams
8 and fruit sauces; eggs, milk and milk products; edible
9 oils and fats; products containing or consisting of
10 meat, fish, poultry, game, fruit or vegetables.

11 Class 30:
12 Coffee, tea, cocoa, sugar, rice, tapioca, sago,
13 artificial coffee; flour and preparations made from
14 cereals, bread, pastry and confectionery, ices, honey;
15 treacle; yeast, baking powder; salt; mustard; vinegar,
16 sauces, spices, ice; prepared meals; snack foods,
17 ingredients for making prepared meals and snack foods;
18 ingredients for making beverages.

19 Class 37:
20 Cleaning services, housekeeping services, maintenance
21 services, repair services.

22 Class 43:
23 Catering services; cafe restaurant and bar services.

24 The signs graphically represented in the application
25 for registration were as follows:

for you.
for you ***
FOR YOU

26 The colours red, amber and green were claimed as
27 elements of the second sign.

28 The Registrar raised objections to registration,

29

1 firstly, on the basis that the third sign did not form a
2 series with the other two signs and, secondly, on the basis
3 that all three signs were devoid of distinctive character and,
4 therefore, excluded from registration by Section 3(1)(b) of
5 the Trade Marks Act 1994. I should at this point mention that
6 there was no claim to registration on the basis of
7 distinctiveness acquired through use.

8 The applicant requested a hearing at which to present
9 its case for registration. This took place before Mr. R.A.
10 Jones, acting on behalf of the Registrar of Trade Marks. The
11 objections to registration were maintained for the reasons
12 given in the written Decision issued by the Hearing Officer on
13 21st September 2005 under reference BL O-264-05.

14 The Hearing Officer proceeded upon the footing that the
15 signs in question should be assessed for registrability in
16 accordance with the Registrar's practice relating to slogans.
17 Having directed himself to the test for registrability under
18 Section 3(1)(b) in accordance with the guidance provided by
19 the ECJ in Joined Cases C-53/01 to C-55/01 Linde AG, Winward
20 Industries Inc and Rado Uhren AG, he assessed the signs in
21 issue in the following terms:

22 "12. The distinctive character of a trade mark must, of
23 course, be assessed in relation to the goods and services for
24 which the applicant seeks registration. In the present case,
25 the application covers a range of foodstuffs in Classes 29 and
30; cleaning, maintenance and repair services in Class 37 and
catering, cafe, restaurant and bar services in Class 43.

13. The mark must also be assessed by how it is likely to be

1 perceived by the average consumer which, in this case, I
2 consider to be the general public (see below). I must also
3 assume fair and notional use of the mark in relation to the
4 provision of goods and services applied for. Such use can
5 include advertising, where the goods and services may be
6 listed for the convenience of the customer, or on packaging
7 for goods.

8 14. I acknowledge that the test for registering slogans is no
9 different than for any other type of marks but, as noted in
10 the above guidance, such use may not be so readily accepted by
11 the general public as an indication of trade origin as would
12 more traditional signs.

13 15. The use shown in Annex A, for example, seems, to me,
14 unlikely to be taken as an indicator of trade origin, but
15 merely as an indication that the 'Operations Manual' is
16 intended to be the property of or for the use of the customer.
17 (The information provided appears to indicate that the goods
18 and services will be provided by the applicant, in cooperation
19 with educational establishments, as part of a healthy eating
20 programme aimed at students.) Also, use in advertising where
21 the words FOR YOU, especially if followed by a row of dots,
22 suggest to me that a series of items are likely to follow,
23 such as a list of goods or services. (See comments in
24 'CYCLING IS...' a decision by Geoffrey Hobbs QC, sitting in
25 his role as the Appointed Person, BL reference 0/561/01, at
paragraphs 67-70):

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.

1
2 70. The relevant perspective is that of the average
3 consumer who does not know there is a question, but who
4 is otherwise reasonably well-informed and reasonably
5 observant and circumspect.'

6 16. In the present case, the ordinary dictionary words which
7 make up the everyday expression 'FOR YOU' are, in my view,
8 unlikely to be taken as 'origin specific' for any of the goods
9 and services at issue by an average consumer who is
10 'reasonably well-informed and reasonably observant and
11 circumspect'. They are more likely to be seen as an
12 invitation to the consumer to look at a list of goods/services
13 in advertising or indicate on packaging that the contents are
14 for the benefit of the customer. All the more so, in my view
15 when the statement is made with a row of dots to indicate
16 there is something to follow. (The use of colour in the dots
17 in the second mark add nothing, in my view, to the
18 distinctiveness of the overall mark.)

19 17. I am not persuaded that the mark FOR YOU or the marks
20 FOR YOU... (with or without the colour claim) in totality are
21 distinctive in that they would serve in trade to distinguish
22 the applicant's goods or services from those of other traders.
23 In my view, the marks applied for will not be seen as a trade
24 mark without first educating the public that it is one. I
25 therefore conclude that they mark applied for is devoid of any
26 distinctive character and is thus excluded from acceptance,
27 prima facie, under Section 3(1)(b) of the Act."

28 He then turned to consider Section 41 of the 1994 Act
29 which allows for the registration of trade marks in series if
30 they satisfy the qualifying requirements of the definition set
31 out in Section 41(2), which reads as follows:

32 "A series of trade marks means a number of trade marks
33 which resemble each other as to their material
34 particulars and differ only as to matters of a
35 non-distinctive character not substantially affecting
36 the identity of the trade mark."

37 He assessed the signs in issue under Section 41(2) in
38 the following terms:

39 "21. I consider the first two marks to constitute a series.
40 They only differ in respect of the colour claim made on the

1 second mark which, to my mind does not impact on the identity
2 of the marks taken as a whole. The third mark differs in that
3 it is in upper case and not lower case and does not include
4 the three dots. While I do not agree with the Examiner that
5 the dots are de minimis, otherwise it would indicate that no
6 account should be taken of them, I do consider they have a
7 visual impact on an otherwise simple mark consisting of a well
8 known phrase comprising two short words. Furthermore, they
9 change the identity from a complete statement to one which
10 indicates more is to follow. In my view the dots constitute a
11 part of the identity of the first two marks which is not
12 present in the third and serve to reinforce the
13 non-distinctive message of the words, alone, as indicated
14 above....

15 24. If there is a difference of substance between the marks,
16 either visually or phonetically they will not qualify as a
17 series.

18 25. For the reasons given above, I consider that the third
19 mark differs from the first two in its material particulars in
20 such a way that they do not satisfy the requirements of
21 Section 41(2) of the Act."

22 The applicant appealed to an Appointed Person under
23 Section 76 of the 1994 Act contending, in substance, that the
24 Hearing Officer's decision was clearly wrong in relation to
25 the refusal under Section 3(1)(b). The determination under
26 Section 41(2) was not challenged on appeal.

27 The appeal under Section 3(1)(b) was further developed
28 in argument at the hearing before me. Having listened with
29 care to the arguments advanced on behalf of the applicant, I
30 have to say that I remain unpersuaded that the Hearing Officer
31 was wrong in his decision. Indeed, I think he was entirely
32 right.

33 I do not find it necessary to dwell on the Registrar's
34 practice relating to the registrability of slogans. I am

1 content to ask myself the simple, straightforward question
2 whether the signs in issue can be said to possess the power to
3 individualise goods and services of the kind specified in the
4 application for registration to a single economic undertaking.

5 Approaching it from the perspective of the reasonably
6 well-informed and reasonably observant and circumspect
7 consumer of such goods and services, I am clear that the
8 answer to the question is no. The signs in issue are really
9 just origin neutral statements of commendation, broadly
10 related to purpose and suitability. I see no difference in
11 principle between the expression "for you" and other similar
12 expressions such as "for him", "for her", "for them", "for
13 us", "for anyone", "for all" and so on.

14 The impact of the ellipsis in the first two signs is, in
15 my view, negligible in terms of distinctiveness. It is a
16 punctuation device which invites the reader or listener to
17 think along lines related to the features or characteristics
18 of the goods or services that might or might not make them
19 suitable for his or her purposes. I cannot think that the
20 punctuation device has any impact on perceptions that may
21 properly be taken to endow the words FOR YOU with a
22 distinctive character.

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

25 In accordance with the usual practice on these

1 occasions, the appeal will be dismissed with no order for
2 costs. Thank you both very much.

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