

O-329-07

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION NO 2432904

TO REGISTER A TRADE MARK

BY ROYAL & SUN ALLIANCE INSURANCE GROUP PLC

IN CLASS 36

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DECISION AND GROUNDS OF DECISION

Background

1. On 19 September 2006 Royal & Sun Alliance Insurance Group plc of 9th Floor, One Plantation Place, 30 Fenchurch Street, London, EC3M 3BD applied under the Trade Marks Act 1994 to register the following trade mark:

MORE THAN CAR INSURANCE

2. Registration is sought for the following services:

Class 36

Insurance and assurance services; financial services; monetary services; real estate services; consultancy, information and advisory services, all relating to the aforesaid services.

3. Objection was taken against the application under Section 3(1)(b) of the Act because the mark consists exclusively of the words MORE THAN CAR INSURANCE being a sign which would not be seen as a trade mark as it is devoid of any distinctive character for a company that offers services other than insurance services.

4. Following a hearing which was held on 02 July 2007 at which the applicant was represented by Mr Darlington of Brand Guardian, their trade mark attorneys, the objection was maintained and Notice of Final Refusal was subsequently issued.

5. 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.

6. For the sake of completeness I draw attention to the fact that at the hearing on this application I also maintained objections under Section 3(1)(b) of the Act in respect of the following trade marks:

2432905	MORETHAN HOME INSURANCE
2432906	MORE THAN HOME INSURANCE
2432907	MORETHAN CAR INSURANCE
2432908	MORE THAN PET INSURANCE
2432909	MORETHAN PET INSURANCE
2432910	MORE THAN MOTOR INSURANCE
2432911	MORETHAN MOTOR INSURANCE

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

The Law

8. Section 3(1)(b) of the Act reads as follows:

“3.-(1) The following shall not be registered-

(b) trade marks which are devoid of any distinctive character,

The case for registration

9. At the hearing and in subsequent correspondence Mr Darlington also referred to the fact that the applicant has already registered the trade marks MORE THAN, MORE-THAN and MORETHAN and that this is an application to register the same trade mark together with mere descriptive words.

10. In correspondence following the hearing Mr Darlington referred to four UK trade marks and three Community trade marks. For the sake of convenience details of all of these applications may be found at Annex A.

11. Mr Darlington also provided a photocopy of an advertisement placed in what appears to be a publication titled Audio Exchange & Mart which provides an example of the trade mark applied for in use.

Decision

12. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in *Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

“37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule 1 Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings."

13. I must determine whether the trade mark applied for is capable of enabling the relevant consumer of the services in question to identify the origin of the services and thereby to distinguish them from other undertakings. In *OHIM v SAT.1* (Case C-329/02) the European Court of Justice provided the following guidance at paragraph 41:

"41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings."

14. This is an application to register the trade mark MORE THAN CAR INSURANCE. Each of these words are well known dictionary words and there is no need for me to refer specifically to their individual dictionary meanings. I must, in any case, consider the mark in its entirety, bearing in mind the meaning of these individual elements, in relation to the services applied for. In relation to such services I have concluded that the mark will be perceived in one way – a commercial activity that not only provides car insurance but one which will provide additional services over and above just car insurance. The advertisement referred to above does not, in my view, demonstrate use of these words in a trade mark sense, they merely send a non-distinctive message. The words do no more than demonstrate how this combination of words may be used to indicate that the applicant provides car insurance services together with additional services.

15. Turning to the services applied for, I note that they are very wide in their coverage. Although car insurance services are covered by this specification it is quite clear that the coverage extends into all insurance and assurance, all financial and real estate services together with consultancy, information and advisory services relating to services. I consider the trademark applied for to be non-distinctive for all of these services as the trade mark clearly indicates that the applicant provides car insurance

services, as well as a range of other services, without specifically defining those services.

16. It is also clear that these services will be directed at commercial and public organisations as well as members of the general public, so the relevant consumer is wide ranging. I accept that many of these consumers are likely to be knowledgeable, perhaps even experts in their particular fields, and that such services may be carefully considered before any commercial decision is made or any contract signed. However, this by itself does not render the objection invalid. The applicant provides car insurance services as well as additional services and it appears to me that the trade mark applied for is a perfectly apt term for other traders to use in order to indicate the extent of the services that they provide.

17. The specification of services may be wide ranging, but in my view the objection is equally valid for all of the services applied for and the trade mark applied for is equally non-distinctive for all of the services in question.

18. Mr Darlington has referred me to the acceptance and registration of the trade marks MORE THAN, MORE-THAN and MORETHAN and appears to suggest that the MORE THAN element of this trade mark will be perceived as a house mark with the words CAR INSURANCE being perceived as additional descriptive words. I do not accept this. This can only come about by use; registration of marks does not educate consumers. On their own it is possible, if not likely, that the trade marks MORE THAN, MORE-THAN and MORETHAN may be perceived as signs denoting services from a single undertaking but I must judge this mark in its entirety. There is no evidence to support the contention that the words MORE THAN will be perceived as a distinctive element within the trade mark for which registration is sought. Any distinctive character present in these earlier trade marks is totally lost and overwhelmed by the addition of the words CAR INSURANCE. This removes any distinctive character that these earlier trade marks possess. Judging the trade mark applied for in its entirety, I am of the view that they will be perceived by the consumer as a reference indicating that the applicant provides car insurance services together with additional services. Because of this perception by the relevant consumer, the words fail to designate services from a single undertaking.

19. Mr Darlington has referred me to seven trade marks (see Annex A) which incorporate the words MORE THAN and MORETHAN and has suggested that these should influence the outcome of this application. I do not accept this.

20. I am unaware of the circumstances surrounding the acceptance of these marks and they are of little if any assistance in determining the outcome of this application. I draw support for this from the judgement of Jacob J in *British Sugar* [1996] R.P.C. 281 at 305 where he stated:

“Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual enquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the

circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

21. For the reasons set out above I have concluded that the relevant consumer of the services in question would not consider this mark to denote trade origin. The average consumer of these services will, upon encountering the words MORE THAN CAR INSURANCE, perceive them as no more than an indication that the applicant provides a commercial activity that not only provides car insurance services but that it is one which will provide additional services over and above just car insurance services. That is why it will not be seen as a sign which guarantees that the services emanate from a single undertaking. I am not persuaded that the trade mark applied for is sufficient, in terms of bestowing distinctive character on the sign as a whole, to conclude that it would serve, in trade, to distinguish the services of the applicant from those of other traders.

22. I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

Conclusion

23. In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) of the Act.

24. Consequently, I have concluded that the mark applied for consists exclusively of signs which may serve, in trade, to designate the kind of services and is, therefore, excluded from registration by Section 3(1)(b) of the Act.

Dated this 6th day of November 2007

**A J PIKE
For the Registrar
The Comptroller-General**

ANNEX A