

TRADE MARKS ACT 1994

IN THE MATTER OF:

TRADE MARK APPLICATION No. 2449033B

IN THE NAME OF NMSI TRADING LIMITED

DECISION

1. On 9 March 2007 NMSI Trading Ltd (*‘the Applicant’*) applied under number 2449033 to register the following sign as a trade mark for use in relation to a wide variety of goods and services in Classes 3, 4, 8, 9, 12, 14, 16, 18, 21, 24, 25, 28, 29, 30, 31, 32, 33, 39, 41 and 43:



2. The Registrar objected to the application under Sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994. Section 3(1)(b) prevents registration of *'trade marks which are devoid of any distinctive character'*. Section 3(1)(c) prevents registration of *'trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services'*. The corresponding provisions of the Trade Marks Directive (Directive 2008/95/EC of 22 October 2008) and the Community Trade Mark Regulation (Council Regulation 207/2009/EC of 26 February 2009) are Articles 3(1)(b) and 3(1)(c) and Articles 7(1)(b) and 7(1)(c) respectively.

3. Initially the Registrar maintained that registration of the sign shown above should be refused under these provisions in relation to all of the goods and services listed in the application. However, the objection was subsequently reconsidered and thereafter maintained only in respect of the following goods, which were (so as not to delay acceptance of the remainder of the application) allocated to divisional application number 2449033B:

Class 9

audio, video and data recordings; records, tapes, cassettes, DVDs, CDs; magnetic data media; electronic publications; pre-recorded films and TV programs.

Class 16

printed matter; books; posters; photographs; calendars.

Class 28

toys, games and playthings; model and replica trains and model railways and accessories.

That application was then refused for the reasons given by Mr. A.J. Pike in a decision issued on behalf of the Registrar of Trade Marks under reference BL O-176-09 on 24 June 2009.

4. The remainder of the application for registration was permitted to proceed as divisional application number 2449033A. Among the numerous different kinds of goods and services for which the sign in question was allowed to proceed to registration were:

Class 12

vehicles; trains; apparatus for locomotion by land and rail;
parts and fittings for all the aforesaid goods

Class 14

pin and lapel badges

Class 39

transport services; travel and transport arrangement services;
advisory and consultancy services relating to all the
aforesaid

Class 41

educational services; organisation of exhibitions,
competitions, meetings and events; museum services;
advisory and consultancy services relating to all the
aforesaid.

It is not clear from the Hearing Officer's decision why the objections to Application 2449033B were dropped in relation to goods and services such as these within the scope of Application 2449033A.

5. The Hearing Officer's reasons for upholding the objection under Section 3(1)(c) were as follows:

18. In relation to the goods for which the objection has been maintained the mark in question will be perceived as no more than subject matter in relation to a very famous locomotive and will not be perceived, by the relevant consumers, as a sign indicating that the goods are supplied by, or are under the control of, a single undertaking. I note that there are some broad terms remaining in the specifications, for example: “electronic publications” in class 9, “printed matter” in class 16 and “toys, games and playthings” in class 28. Although the objection may not be relevant for all goods covered by these broad terms such terms will all encompass goods for which the trade mark will be perceived as subject matter or the shape of the goods. For these reasons I consider the objection to be valid for all of the goods identified.

...

21. The trade mark consists of the words FLYING SCOTSMAN together with a device of the famous steam locomotive so named. There are to my knowledge many rail enthusiasts throughout the United Kingdom, especially in respect of famous and historic steam locomotives. This particular locomotive is very famous, and in respect of the goods identified it will do no more than indicate a characteristic of them. For these reasons I am satisfied that the objection must be maintained for all goods identified at paragraph 10 of this decision.

22. The only remaining question is whether this combination of words and device creates a whole greater than the sum of its parts and that it will overcome the descriptive nature of the word combination and the device of a steam locomotive. I do not see how they can. The device supports the meaning of the words, but adds nothing to them. There is a degree of stylisation to the device but it is clearly a steam locomotive and, in conjunction with the words, it will be perceived as a slightly stylised representation of the steam locomotive named FLYING SCOTSMAN.

...

24. Consequently, I have concluded that in respect of the goods identified at paragraph 10 the mark consists exclusively of a sign which may serve, in trade, to designate the kind of and is, therefore, excluded from registration by Section 3(1)(c) of the Act.

6. He considered that the application for registration was caught by Section 3(1)(b) for essentially the same reasons as it was caught by Section 3(1)(c):

27. I must determine whether the trade mark applied for is capable of enabling the relevant consumer of the goods in question to identify the origin of the goods and thereby to distinguish them from other undertakings.

28. For the same reasons for which I found the mark is to be excluded by the provisions of Section 3(1)(c) of the Act, I have concluded that the relevant consumer of the goods in question would not consider this mark to denote trade origin. The average consumer of these goods will, upon encountering the words FLYING SCOTSMAN, together with the slightly stylised representation of the steam locomotive named FLYING SCOTSMAN, perceive this sign as no more than an indication that the goods in question contain information about this locomotive, are replica or other representations of this locomotive or are recordings of the locomotive. The sign is likely to be taken as a reference to the subject matter of the goods thus branded. 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 goods of the applicant from those of other traders.

29. 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 face acceptance under Section 3(1)(b) of the Act.

7. The Hearing Officer supported his assessment by reference to the decision of Mr. Richard Arnold QC sitting as the Appointed Person in SUN RIPENED TOBACCO Trade Mark (BL O-200-08, 4 July 2008). He said:

23. I find support for this conclusion from the comments made by Richard Arnold QC, sitting as the Appointed Person, in an appeal of the decision to refuse application 2428182 by British American Tobacco (Brands) Inc. to register the mark SUN RIPENED TOBACCO with device (BL O/200/08). He said:

13. The impact of the words in the mark is clear, namely that of a reference to the goods as described above. It is also clear that the presence of the sun device has a relationship to these words and, to some extent, may reinforce or supplement their meaning; in other words, the sun device, in the context of the mark as a whole, is not an arbitrary or fanciful inclusion. Despite all this, will the overall impression, as the attorney would have me believe, strike the consumer as a badge of origin?

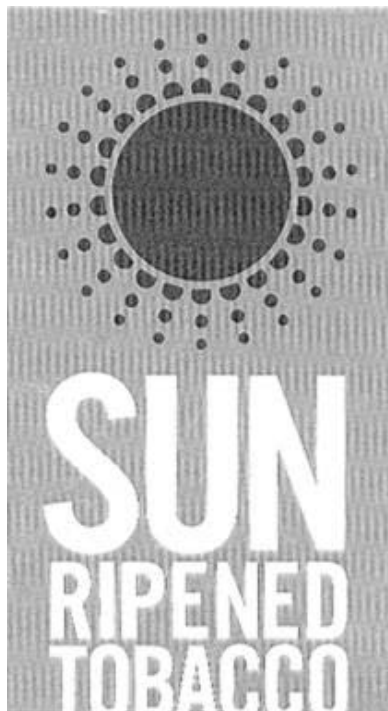
14. I am mindful of the comment of Mr. Hobbs QC sitting as the Appointed Person in Quick Wash Action [BL O/205/04]: 'I do not think that the hearing officer was guilty of excision or dismemberment in his assessment of the present mark. Devices can be distinctive or non-distinctive, just like any other kind of sign. What matters are the perceptions and recollections that the sign in question is likely to trigger in the mind of the average consumer of the goods concerned and whether they would be origin specific or origin neutral. I think that the verbal elements of the mark I am considering speak loud and clear. It seems to me that the message they convey is origin neutral. The artistic presentation neatly and skilfully builds upon and reinforces the origin neutral message in a way that makes it even more effective than the words alone might have been for that purpose. I think that the net result is a well-executive, artistically pleasing, origin neutral device.'

15. Applying similar reasoning to the mark at issue here, it strikes me that the words SUN RIPENED TOBACCO also speak loud and clear and that they do so in a descriptive and

therefore origin neutral manner. The presentation incumbent in the sun device (and the overall presentation of the words), despite having an element of artistic nature, merely builds upon and reinforces the message behind the mark. This all leads, in my judgment, to a mark that fails to strike the consumer as a badge of origin.”

8. It should be pointed out that the observations which the Hearing Officer attributed to Mr. Arnold were, in fact, observations made at first instance by the Registrar’s hearing officer (Mr. Oliver Morris) in the decision which Mr. Arnold subsequently considered to be correct in its overall conclusions and approach.

9. It should also be pointed out that in the SUN RIPENED TOBACCO case and also in the earlier QUICK WASH ACTION case the signs in question were held to be excluded from registration by Section 3(1)(b), not Section 3(1)(c) of the Act. This was the sign in issue in SUN RIPENED TOBACCO Trade Mark:



This was the sign in issue in QUICK WASH ACTION Trade Mark:



In each case it was decided that the sign as a whole was permeated by the message of the wording it contained, with the message thereby conveyed being non-distinctive in relation to the goods of interest to the applicant.

10. The Applicant in the present case appealed to an Appointed Person under Section 76 of the 1994 Act contending, in substance, that the Hearing Officer had wrongly characterised the sign in issue as a mark in which *'the device supports the meaning of the words, but adds nothing to them'* as stated in paragraph [22] of his decision. He had therefore not taken account of the overall capacity of the sign to serve as an indication of trade origin, as required for the correct application of Sections 3(1)(b) and 3(1)(c).

11. At the hearing of the appeal, the Applicant and the Registrar responded to my request for submissions upon the correctness or otherwise of imbuing the goods specified in the trade mark application with content or character linked to the celebrity of the historic steam locomotive Flying Scotsman when examining for registrability under Sections 3(1)(b) and 3(1)(c). I am grateful to them for their submissions. It can be seen

from my analysis below that I consider the correct approach to that matter to be an important aspect of the present appeal.

12. It is settled law that the registrability of a sign must be assessed in context '*first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the relevant public's perception of the mark*': Case C-398/08 P Audi AG v. OHIM (VORSPRUNG DURCH TECHNIK) [2010] ECR I-00000 at paragraph [34]. Article 13 of the Trade Marks Directive further requires that:

Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.

The assessment of a sign for registrability must accordingly be made with reference to each discrete category of goods or services covered by an application for registration: Case C-239/05 BVBA Management, Training en Consultancy v. Benelux-Merkenbureau [2007] ECR I-1455 at paragraphs [30] to [38]; Case C-282/09 P CFCMCEE v. OHIM [2010] ECR I-00000 at paragraphs [37] to [44].

13. In effect, Article 13 requires the list to be confined to goods or services for which the sign in question is fully registrable. Wide wording which encompasses goods or services within the scope of a well-founded objection to registration should therefore be narrowed by amendment so as to exclude such goods or services from the list: see, for example, Case T-462/05 JTEKT Corp v. OHIM (IFS) [2008] ECR II-307. Failing that, the over-broad wording is liable to be struck out. The case law is clear and consistent to

that effect: see, for example, Case T-359/99 DKV Deutsche Krankenversicherung AG v. OHIM (EUROHEALTH) [2001] ECR II-1645 at paragraphs [32], [33]; Case T-356/00 DaimlerChrysler AG v. OHIM (CARCARD) [2002] ECR II-1963 at paragraphs [33] and [36]; Case T-16/02 Audi AG v. OHIM (TDI) [2003] ECR II-5167 at paragraph [35] (appeal to the Court of Justice in Case C-82/04 P discontinued by order dated 19 January 2006); Case T-304/06 Paul Reber GmbH & Co. KG v. OHIM (MOZART) [2008] ECR II-1927 at paragraph [92]; Case T-405/05 Powerserv Personalservice GmbH v. OHIM (MANPOWER) [2008] ECR II-2883 at paragraphs [67], [68] (appeal to the Court of Justice dismissed by reasoned order dated 2 December 2009 in Case C-553/08 P); Case T-200/08 Interflon BV v. OHIM (FOODLUBE) [2010] ECR II-00000 at paragraphs [41], [42], [46] to [48] and [50]; Case T-466/08 Lancôme parfums et beauté & Cie v. OHIM [2011] ECR II-00000 at paragraph [58].

14. In the present case, the Hearing Officer concluded that the goods covered by Application 2449033B were listed in terms which encompassed goods designed or adapted to provide consumers with imagery or information pertaining to the Flying Scotsman locomotive and that the sign in issue was therefore unregistrable for descriptiveness, hence lack of distinctiveness, in relation to all such goods. The question raised by the appeal is whether he applied the provisions of Sections 3(1)(b) and 3(1)(c) correctly within the parameters set by Article 13 of the Directive.

15. It is clearly appropriate to examine a sign for registrability with due regard for the characteristics that goods or services of the kind specified in an application for

registration may optionally possess. A few examples will serve to demonstrate the force of this point:

- (1) An application covering '*brochures, periodicals including periodicals containing crossword puzzles and rebus puzzles, newspapers*' in Class 16 was refused on the ground that the listings encompassed goods for which the sign **1000** was not registrable: Case C-51/10 P Agencja Wydawnicza Technopol sp. zo. o v. OHIM [2011] ECR I-00000. The Court of Justice endorsed the view of the General Court that the listings covered goods identifiable by reference to the number of pages or works they contained, the amount of data they provided or the ranking of items referred to in them. It was noted that brochures, periodicals and magazines frequently publish ranking lists and collections.

- (2) In Case C-533/08 P Powerserv Personalservice GmbH v. OHIM (MANPOWER) [2009] ECR I-00000 the Court of Justice dismissed an appeal from the judgment of the General Court in Case T-405/05 [2008] ECR II-2883. The General Court had endorsed the view of the Fourth Board of Appeal at OHIM that evidence of distinctiveness acquired through use was necessary in order to overcome an objection to registration of the sign **MANPOWER** inter alia for '*audio cassettes; audio-visual teaching apparatus; audio compact discs; video compact discs; computer software; computer programs; tape recorders; video tapes; video recorders; parts and fittings for all the aforesaid goods*' in Class 9 and '*books; printed matter; handbooks; manuals; magazines; printed publications; transparencies; instructional materials; teaching materials; parts and fittings for*

all the aforesaid goods' in Class 16. Registration would otherwise have been refused on the ground that the listings encompassed goods identifiable for use in connection with employment agency services and the sign **MANPOWER** would merely have been understood as indicating the content of goods of that kind.

- (3) An application covering '*beers*' in Class 32 and '*wine, spirits, liqueurs, sparkling beverages, sparkling wine, champagne*' in Class 33 was refused on the ground that the listings encompassed goods for which the sign **CANNABIS** was not registrable: Case T-234/06 Giampietro Torresan v. OHIM [2009] ECR II-4185. The General Court considered that the listings covered goods identifiable by reference to cannabis as an ingredient used for flavouring them. It was noted that cannabis is habitually used in the manufacture of numerous foodstuffs, including beer and certain beverages. The applicant's appeal to the Court of Justice was dismissed by reasoned order dated 16 May 2011 in Case C-5/10 P.

16. Just as a particular flavour may be regarded as an optional characteristic of goods which are apt to be flavoured, so may a particular theme or subject be regarded as an optional characteristic of goods or services which are apt to convey imagery or information. For example, in Case T-435/05 Danjaq LLC v. OHIM [2009] ECR II-2097 the General Court rejected a claim for protection of the signs **Dr No** and **Dr NO** as well-known trade marks on the basis that they had simply been used descriptively with reference to the content and character of the goods identified in the evidence on file:

[27] In the case of comic books, music recordings, books and posters, the signs Dr. No and Dr. NO are likewise not used as trade marks, but as a reference which is descriptive

of the goods, indicating to consumers that they are music from the film Dr. No., a book or a comic book about the character of 'Dr. No', or a poster of that film or character. As is apparent from examining the documentation supplied by the applicant, some of the goods referred to are marketed to the public under other indicators of origin, namely '007' and 'James Bond', which indicate to consumers that the commercial origin of the abovementioned goods relating to the film or the character of 'Dr. No' is the same as that of the films in the 'James Bond' series.

[28] The same conclusion applies in the case of model cars or watches produced by the companies with a licence to use the signs Dr. No and Dr. NO on those goods. In both cases, the use of those signs is merely descriptive, indicating to consumers that the car in question is a model of the one used in the film Dr. No, or that the watch is the one for the film Dr. No in a collection of watches produced to commemorate the fortieth anniversary of the films in the 'James Bond' series. In addition, an examination of the documentation relating to the cars shows that the indicators of commercial origin used for them by the applicant are 'James Bond', '007' and the 'Gun Symbol'. As in the cases analysed in paragraph 27 above, those indicators show that the commercial origin of the goods is the same as that of the other 'Bond' goods.

The signs in question were found to be non-distinctive in the market for goods conveying such imagery and information.

17. Essentially similar reasoning has been applied to essentially the same effect on numerous occasions at the national level in the United Kingdom and in the Community Trade Marks Office. Examples of this are the decision of Mr. Richard Arnold QC sitting as the Appointed Person in Linkin Park LLC's Application BL O-035-05, 7 February 2005; [2005] ETMR 17, p.172; the decisions issued on behalf of the Registrar of Trade Marks by Mr. M. Reynolds in NELLIE THE ELEPHANT Trade Mark [2004] ETMR 79, p.1084 and Mr. Allan James in DIANA PRINCESS OF WALES Trade Mark [2001]

ETMR 25, p.254; and the decision of the First Board of Appeal at the Community Trade Marks Office in Case R 1466/2005-1 Ferrero OHG mbH v. FIFA [2008] ETMR 76, p.1220 (and note the further decisions mentioned in paragraph [66] of that decision).

18. The approach adopted in these decisions is applicable where: (a) the potential for goods or services of the kind specified to provide consumers with imagery or information about someone or something denoted by the sign is sufficiently real and significant to be a material consideration; and (b) it is reasonable to believe that the sign '*will actually be recognised by the relevant class of persons*' as a description of the content or character of such goods or services: Case C-51/10 P Agencja Wydawnicza Technopol Sp. o z. o v. OHIM (above) at paragraphs [50], [52] and [56]. The latter requirement is not satisfied if the sign would be understood to designate content or character of a kind that the relevant average consumer would take to have come from a single economic undertaking believed or expected to be linked to the use of that sign: see, for example, Case T-507/08 Psytech International Ltd v. OHIM (16 PF) [2011] ECR II-00000 at paragraphs [34] to [43]. Content and character can serve to contextualise a sign as an indication of involvement by a particular person or organisation in the marketing of 'official' goods or services, as recognised in the finding of infringement made by the Court of Appeal in Arsenal Football Club Plc v. Reed [2003] EWCA Civ 696; [2003] RPC 39 at paragraphs [50] to [69] following the ruling of the Court of Justice in Case C-206/01 Arsenal Football Club Plc v. Reed [2002] ECR I-10273. It is relevant to bear in mind that the beliefs and expectations of consumers are liable to be influenced by their awareness of what is typical in relation to the marketing of such goods and services, as emphasised by Sir Nicolas

Browne-Wilkinson V-C in Mirage Studios v. Counter-Feat Clothing Company Ltd [1991] FSR 145 at pp.155 et seq.

19. Since there is no obligation to rule on the possible dividing line between the concept of lack of distinctiveness and that of minimum distinctiveness when assessing the registrability of a sign under Section 3(1)(b), see Case C-104/00 P Deutsche Krankenversicherung AG v. OHIM (COMPANYLINE) [2002] ECR I-7561 at paragraph [20], it is not necessary to dwell on the question of how far Section 3(1)(b) may go in preventing registration beyond the scope of Section 3(1)(c). It is sufficient to observe that a sign may be:

- (1) distinctive for the purposes of Section 3(1)(b), with the result that it cannot be regarded as descriptive for the purposes of Section 3(1)(c) and must be unobjectionable on both bases; or
- (2) neither distinctive for the purposes of Section 3(1)(b), nor descriptive for the purposes of Section 3(1)(c), with the result that it must be objectionable on the former but not the latter basis; or
- (3) descriptive for the purposes of Section 3(1)(c), with the result that it cannot be regarded as distinctive for the purposes of Section 3(1)(b) and must be objectionable on both bases.

These considerations point to the overall importance of establishing that a sign is free of objection under Section 3(1)(b).

20. The importance of the objection under Section 3(1)(b) is such that at this stage of the present proceedings I think it is appropriate to deal with it first. The law is conveniently summarised in paragraphs [29] to [37] and [45] of the Judgment of the Court of Justice in Case C-265/09 P OHIM v. BORCO-Marken-Import Mathiesen GmbH & Co. KG (the Greek letter ‘a’) [2010] ECR I-00000:

29. However, the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v. OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes 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 those of other undertakings (*Henkel v. OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v. OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v. OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v. OHIM*, paragraph 25; *Henkel v. OHIM*, paragraph 35; and *Eurohypo v. OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v. OHIM* [2004] ECR I-10107, paragraph 78; *Storck v. OHIM*, paragraph 26; and *Audi v. OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P and C-474/01 P *Procter & Gamble v. OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v. Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v. OHIM*, paragraphs 36 and 38; and *Audi v. OHIM*, paragraph 37).

34. In that regard, the Court has already stated that difficulties in establishing distinctiveness which may be associated with certain categories of marks because of their very nature – difficulties which it is legitimate to take into account – do not justify laying down specific criteria supplementing or derogating from application of the criterion of distinctiveness as interpreted in the case-law (see *OHIM v. Erpo Möbelwerk*, paragraph 36, and *Audi v. OHIM*, paragraph 38).

35. It is apparent from the case-law of the Court on Article 3 of Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relative to trade marks (OJ 1989 L 40, p.1), the wording of which is identical to that in Article 7 of Regulation No. 40/94, that the distinctive character of a mark must always be assessed specifically by reference to the goods or services designated (see, to that effect, *Libertel*, paragraph 76, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraphs 31 and 33).

36. As the Advocate General observed at point 47 of his Opinion, the requirement of an examination as to whether, on the facts, the sign in question is capable of distinguishing the goods or services designated from those of other undertakings, allows for the accommodation of the ground for refusal laid down in Article 7(1)(b) of Regulation No. 40/94 with the general capacity of a sign to constitute a trade mark recognised in Article 4 thereof.

37. In that regard, it should be pointed out that, even though it is apparent from the case-law cited that the Court has recognised that there are certain categories of signs

which are less likely prima facie to have distinctive character initially, the Court, nevertheless, has not exempted the trade mark authorities from having to carry out an examination of their distinctive character based on the facts.

...

45. As is clear from the case-law of the Court, the examination of trade mark applications must not be minimal, but must be stringent and full, in order to prevent trade marks from being improperly registered and, for reasons of legal certainty and good administration, to ensure that trade marks whose use could be successfully challenged before the courts are not registered (see, to that effect, *Libertel*, paragraph 59, and *OHIM v. Erpo Möbelwerk*, paragraph 45).

21. In substance, what matters for the purposes of the required assessment is whether, from the perspective of the relevant average consumer, the sign in question would serve to individualise the goods or services in question to a single economic undertaking. There should be a ‘*stringent and full*’ examination of its power to do so ‘*based on the facts*’ as they appear to be.

22. All of the goods listed in the present application for registration are apt to convey imagery or information as part of their appeal to consumers. Moreover, the potential for the Flying Scotsman locomotive to be the theme or subject of such imagery or information is not only real and significant, but acknowledged by the Applicant to be the motivating factor behind its application for registration in respect of those goods. So much so that the Applicant offered to restrict its application to goods of the kind specified in Classes 9, 16 and 28 to ‘*all relating to the famous, historic steam locomotive Flying Scotsman*’ if that would (which it would not) improve its position with regard to registration.

23. The sign in question is plainly designed to trigger perceptions and recollections of the Flying Scotsman locomotive in the context of trading activities centred on the marketing of goods conveying imagery and information relating to that locomotive. Would the locomotive come to mind with connotations of trade origin that the average consumer might take to be applicable to such goods? I do not think so. This appears to me to be a case in which no pointers as to provenance would be provided by the content or character of the relevant goods.

24. The issue for determination against that background is whether the sign nevertheless conveys a message about the content or character of the goods by means of a graphic representation which would, from the perspective of the relevant average consumer, serve to individualise them to a single economic undertaking. That primarily depends upon the effect that the non-verbal content would be likely to have upon the perceptions of individuals exposed to the use of the sign as a whole in relation to such goods.

25. There is enough artistry and creative expression in the non-verbal content (including the asymmetric typography of the verbal elements) to satisfy me that the sign as a whole will be seen as alluding emblematically to the content and character of the goods concerned. I am reinforced in that view by the examples of use the Applicant has provided. It remains to be determined whether, as a result of the artistry and creative expression it displays, the sign possesses a distinctive character in the relevant sense of the word 'distinctive' i.e. so as to be capable of thereby providing an indication of trade

origin when used in respect of goods conveying imagery or information relating to the Flying Scotsman locomotive.

26. The case for refusal of registration can be summarised as follows: the verbal elements qualify the pictorial element and vice versa; in that way the pictorial element is effectively identified as an artistic representation of the Flying Scotsman locomotive; as a result the pictorial element magnifies the effect of the words; the average consumer's perceptions of the sign as a whole are thus liable to be permeated by the message of the words and would accordingly be origin neutral in relation to goods of the kind I am required to envisage for the purpose of deciding whether registration was correctly refused.

27. The case for allowing registration can be summarised as follows: the sign operates by attaching the made-up name for a locomotive to an image which represents the locomotive emblematically; the image is emblematic to a degree which shows that the sign is not being used simply and solely as an indication of content or character in relation to the goods concerned; moreover it personalises the sign in a manner which is apt to result in it being seen as a 'fingerprint' of the involvement of a particular economic undertaking; the average consumer's perceptions of the sign as a whole would accordingly be origin specific even in relation to goods of the kind I am required to envisage.

28. Both approaches involve assessment of the sign without dismemberment or excision. By contrast, the Hearing Officer's finding that the sign was excluded from registration by Section 3(1)(c) was made upon the basis that *'the device supports the*

meaning of the words, but adds nothing to them'. In the result, he tested the application for registrability under that section as if it was an application for registration of the words without more. I regard that approach to assessment of the sign as untenable. It gave nil or negligible weight to the presence of non-verbal content which simply could not be treated as insignificant in the context of the sign as a whole.

29. I do not consider that this is a case in which the words 'speak louder' than the non-verbal content of the sign in which they appear. In my view the application for registration was by a slender margin acceptable under Section 3(1)(b) of the Act in accordance with the second of the two approaches to assessment I have summarised above. That excludes the possibility of refusal under Section 3(1)(c) (see paragraph [19] above). Nevertheless for completeness I should make it clear that I would have regarded the non-verbal content of the sign as sufficient to prevent it from consisting '*exclusively*' of subject matter within the scope of Section 3(1)(c) on applying the criteria discussed in paragraphs [133] to [150] of the judgment of Mr. Richard Arnold QC sitting as a deputy judge of the High Court in Hormel Foods Corp. v. Antilles Landscape Investments NV (SPAMBUSTER Trade Mark) [2005] EWHC 13 (Ch); [2005] RPC 28; even if I had thought that the sign as a whole was caught by the exclusion from registration contained in Section 3(1)(b).

30. For the reasons I have given, the appeal is allowed and the application for registration is remitted to the Registrar for further processing in accordance with the provisions of the Trade Marks Act 1994 and the Trade Marks Rules 2008. In accordance

with the usual practice in this tribunal on ex parte appeals against the refusal of registration, I make no order for costs.

Geoffrey Hobbs QC

31 August 2011

Bruce Marsh of Wilson Gunn appeared on behalf of the Applicant.

Dr. Bill Trott appeared on behalf of the Registrar.