

O-587-16

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NUMBER 3107552
BY BERKSHIRE AND HARLEY LLP
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 09, 10 AND 44:**

The Berkshire Eye Clinic

Background

1. On 2 May 2015, Berkshire and Harley LLP ('the applicant') applied to register the above mark for the following goods and services:
 - Class 09: Instruments for diagnosis [for scientific use], laboratory optical apparatus, optical measurement apparatus, optical measuring components, ophthalmic lenses.
 - Class 10: Artificial lenses for implantation in the eye, intra-corneal implants, intraocular implants, intraocular lens biometers, intra-ocular lenses, intraocular lenses, intraocular lenses for surgical implantation, laser beam delivery instruments for medical use, laser instruments for medical use, ocular implants, ophthalmoscopes, prostheses (intraocular-) [lenses] for surgical implantation, ultrasonic eye axis length meters.
 - Class 44: Advisory services relating to degenerative diseases of the eye, advisory services relating to the treatment of degenerative diseases of the eye, consultancy services relating to eye surgery, performing diagnosis of eye diseases, providing laser therapy for treating medical conditions of the eye, provision of medical and surgical treatment services in relation to diseases of the eye.
2. On 20 May 2015, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act'), on the basis that the sign consists exclusively of a sign which may serve in trade to designate the geographical origin of the goods/services e.g. goods and services being provided by an eye clinic located in Berkshire.
3. On 23 June 2015, the Office received third party observations from Withers and Rogers on behalf of Mr Vaughan Tanner, arguing that the mark should be refused under sections 3(1)(b) and (c) on the basis of it being descriptive and devoid of any distinctive character. The observer was informed that the Registrar could not consider its submissions at that point in time, given that the mark had not been published in the Trade Marks Journal.
4. On 16 July 2015 the applicant responded to the examination report of 20 May 2105. The following submissions were made:

- Referring to three earlier marks that had been accepted for registration (EU004460671 'BERKSHIRE BEDDING', EU004460713 'BERKSHIRE BATH' and UK2414084 'ROYAL BERKSHIRE FOODS'), the applicant submitted that all three set a precedent and that, if subjected to the same assessment that the examiner had applied in this case, should have been refused under section 3(1)(c).
 - The applicant acknowledged the examiner's reasons for seeking to prevent unfair monopolisation for a single trader operating in the county of Berkshire, but argued that such monopolies had already been granted in respect of the three aforementioned registrations. This, he submitted, was unfair;
 - Finally, the applicant stated that the mark had acquired a distinctive character as a result of the use made of it, and that evidence to support the claim could be provided in the event of the *prima facie* objection being maintained.
5. The applicant's arguments were rejected in the official letter of 03 August 2015. In his letter, the examiner, Mr Eggleton, maintained that the mark was descriptive and non-distinctive in the *prima facie* case and, in respect of the earlier registrations, confirmed that each case must be considered on its own merits and that precedents were not binding on the Registrar.
 6. The examiner reiterated his belief that, due to the large size of the county of Berkshire, and the likelihood that more than one undertaking would be providing eye treatment services in that geographical area, the mark applied for would be perceived merely as a descriptive message by the average consumer, designating the nature and geographical location of the goods and services on offer.
 7. Finally, having maintained the *prima facie* objection, the examiner noted the applicant's claim to acquired distinctiveness and acknowledged the potential value of evidence being submitted in support of the claim.
 8. Subsequently, on 30 September 2015, the applicant filed evidence in support of the claim to acquired distinctiveness.
 9. The examiner responded in correspondence dated 19 October 2015, informing the applicant that the evidence submitted did not support the claim to acquired distinctiveness. The examiner noted that most of the evidence showed use of the word-only sign applied for in combination with a figurative element. Other gaps in the evidence were highlighted, and it was suggested that further submissions in the form of e.g. a witness statement and an indication of market share might assist further. The examiner also provided a hyperlink to pages on the IPO's website which provide further details on the submission of evidence in support of acquired distinctiveness.
 10. On 27 November 2015, the applicant requested an *ex parte* hearing.
 11. A hearing was held on 18 January 2016. At the hearing, the hearing officer, Mrs Bennett, maintained the *prima facie* objection under sections 3(1)(b) and (c), and set out her reasons in the report dated 19 January 2016. Those reasons were given as follows:

- Berkshire is a large county in England where there are likely to be a number of medical professionals offering consultations related to the treatment and care of the eye.
 - The term 'Eye Clinic' is a common name for a centre that deals with conditions of the eye and would only be seen as providing information relating to the kind of services being provided.
 - Perceiving the sign in its totality, the average consumer would be aware of the geographical location and the kind of business designated, but he or she would not distinguish the services from any other eye care centre in the same geographical area.
12. Having maintained the objection raised under sections 3(1)(b) and (c), the hearing officer concurred with the examiner's conclusions in respect of the 'informal' evidence submitted prior to the hearing, and granted a further period of time for the applicant to compile and submit formal evidence in support of the claim to acquired distinctiveness.
 13. The applicant submitted formal evidence of use on 16 March 2016.
 14. Having considered that second set of evidence, Mrs Bennett's letter of 31 March 2016 confirmed that, for a limited range of goods and services, acquired distinctiveness had been shown, and that the application could be accepted for publication in respect of the following revised list of goods and services:
 - Class 09: Instruments for diagnosis [for scientific use], laboratory optical apparatus, optical measurement apparatus, optical measuring components, ophthalmic lenses.
 - Class 10: Artificial lenses for implantation in the eye, intra-corneal implants, intra-ocular implants, intraocular lens biometers, intra-ocular lenses, intraocular lenses, intraocular lenses for surgical implantation, laser beam delivery instruments for medical use, laser instruments for medical use, ocular implants, ophthalmoscopes, prostheses (intraocular-) [lenses] for surgical implantation, ultrasonic eye axis length meters.
 - Class 44: Advisory services relating to degenerative diseases of the eye, advisory services relating to the treatment of degenerative diseases of the eye, consultancy services relating to eye surgery, performing diagnosis of eye diseases, providing laser therapy for treating medical conditions of the eye, provision of medical and surgical treatment services in relation to diseases of the eye.
 15. The applicant accepted this revised list of goods and services, and so the application was published on 03 June 2016 in Trade Marks Journal 2016/023.

16. On 06 June 2016, the Registrar received third party observations relating to the application's acceptance and publication. These observations were filed by the same third party which had initially filed observations in June 2015, and were identical in terms of their substance (see paragraph 3 above).
17. On 15 June 2016, the Registrar wrote to the applicant, relaying the comments set out in the third party observations. The applicant was informed that, on the basis of information submitted by the third party, a late objection under section 3(1)(b) was being raised pursuant to section 40.
18. In that letter of 15 June 2016, Mr Jefferiss confirmed that the *prima facie* objection was being maintained for reasons identical to those presented in previous correspondence. Mr Jefferiss also noted the previous Hearing Officer's reference to the highly specialised nature of the goods and services, and how that had been factored into her decision to accept. Given his review of the case brought about by the third party observations, Mr Jefferiss also reassessed the evidence and was not persuaded that the materials submitted up to that point supported the claim to acquired distinctiveness.
19. On 24 June 2016, the applicant submitted a response stating that:
 - In his letter of 15 June 2016, Mr Jefferiss referred only to section 3(1)(b), whilst the third party's observations made reference to 3(1)(b) and 3(1)(c). Clarification was sought.
 - Following the hearing officer's initial acceptance being at least partly based on highly specialised nature of the goods and services claimed, and the fact that no other trader would wish to use the term 'THE BERKSHIRE EYE CLINIC', the applicant noted Mr Jefferiss' reference to such findings and the fact that he was reassessing their validity in light of the observations received. In that context, the applicant stated that at no time had they claimed, verbally or in writing, that the goods or services at issue were 'highly specialised and no other trade would wish to use the term'. The applicant submitted that, because Mr Jefferiss had appeared to use this assumption as the basis for his late objection, that objection must be flawed.
 - A substantive search of the internet had revealed that only the applicant and the observing party actually have an interest in using the term 'THE BERKSHIRE EYE CLINIC'. Therefore, the applicant argued that the observer's claim that "*many undertakings do, and will wish to in future, use the expression*" was not correct.
20. In correspondence dated 04 July 2016, Mr Jefferiss responded to the applicant's letter of 24 June 2016, confirming that the reference to section 3(1)(b) alone had been an error. The objection raised following third party observations, was intended to mirror the original objection raised under *both* section 3(1)(b) *and* section 3(1)(c). Mr Jefferiss also clarified that his comments regarding the goods and services' degree of specialisation was nothing more than an attempt to paraphrase a point made by the hearing officer Mrs Bennett in her report of 19 January 2016.

21. Mr Jefferiss subsequently concluded that '*...following receipt of the third party observations received, it would appear that there may be a need to keep the term free for other traders to use the term legitimately in the course of trade as it designates the geographical origin of the goods and services at issue*'.
22. On 11 July 2016, the applicant requested a second *ex parte* hearing to discuss the late objection.
23. A hearing was duly held on 01 September 2016. At the hearing, the applicant submitted that:
 - The applicant company had achieved a turnover of more than £200,000 in a little over four months, suggesting that this was a significant figure in such a short space of time and thereby proving that the applicant was a rapidly growing force in the relevant business sector. The evidence filed did not set out any marketing or promotional expenditure because "*...the traditional methods of promoting and marketing goods or services did not apply in this case*".
 - The late objection raised after receipt of the third party observations had been based on an incorrect assumption that the goods and services provided by the applicant were highly specialised and aimed at a specialist, niche market.
 - The growth of the applicant company over a relatively short period of time, considered in combination with the evidence submitted to prove acquired distinctiveness, was sufficient to demonstrate that the relevant consumer would perceive the sign 'THE BERKSHIRE EYE CLINIC' as a trade mark rather than as a descriptive message.
24. In my hearing report dated 06 September 2016, I concluded that:
 - The issue of whether or not the applicant was involved in a specialist market was not the key issue in this matter. The objection in the *prima facie* case has been set out clearly and the mark remains objectionable under 3(1)(b) and (c) of the Act for the reasons first set out by the original examiner and subsequently by Mrs Bennett (the first hearing officer). The objection that Mr Jefferiss (the second examiner) raised, following receipt and consideration of the third party submissions, is based on the same reasoning.
 - The matter to hand rests entirely on the question of the evidence of use and the acceptance by Mrs Bennett of the application on the basis of acquired distinctive character. Having been obliged to re-open the matter due to the submissions of a third party, Mr Jefferiss had duly considered all aspects of the case, including the nature of the evidence filed by the applicant, and the acceptance based upon that evidence.
 - Mr Jefferiss concluded that the evidence provided was insufficient to prove that the relevant public had been educated to such a degree that they would immediately

perceive the sign as being a trade mark of the applicant company rather than a descriptive message indicating the nature and geographical origin of the products.

- Finding that the objection raised in the *prima facie* case was valid, the decision in this matter rests on whether or not the evidence filed proves that the mark applied for had acquired distinctive character by use made of the sign prior to the date of application.
 - Having reviewed all of the evidence submitted by the applicant on 16 March 2016, I agreed with Mr Jefferiss' finding that the evidence on file was insufficient to prove a level of acquired distinctive character.
25. Therefore, having taken note of all of the arguments presented by the applicant, and having considered fully the evidence of use intended to prove an acquired distinctive character, I dismissed the evidence of use and maintained the objection raised against the application on 15 June 2016. In light of submissions presented to me at the hearing, I provided Mr Lucas with a further two month period in which he could submit further arguments and/or evidence.
26. On 05 October 2016, the applicant filed additional evidence in support of the claim to acquired distinctiveness.
27. In my letter of 17 October 2016 I concluded that this additional evidence was insufficient. Comprising 14 invoices dated between 05 June 2014 and 16 April 2015, and four letters from eye surgeons and specialists referring work or questions to the applicant dating from 24 August 2014 to 22 March 2015, the materials did not persuade me that the relevant public across the territory, has been exposed to the mark filed, to the extent that the term 'The Berkshire Eye Clinic' will be perceived as a trade mark message indicating goods and services originating from one undertaking, rather than a descriptive message.
28. The application was subsequently formally refused at that time.
29. On 7 November 2016, the IPO received form TM5 requesting a statement of reasons for the Registrar's decision.

Decision

30. The relevant parts of section 3 of the Act read as follows:

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

(a) ...

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

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical

origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) ...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b),(c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

The relevant legal principles - Section 3(1)(c)

31. There are a number of judgments from the CJEU which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 (recoded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1)(c) of the Community Trade Mark Regulation (the 'CTMR'), whose provisions correspond to section 3(1)(c) of the UK Act.
32. The main guiding principles which are relevant to this case are noted below:
 - Subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark *Wm Wrigley Jr & Company v OHIM*, C-191/01P (*Doublemint*), paragraph 30.
 - Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all. The provision therefore prevents such signs or indications from being reserved to one undertaking alone because they have been registered as trade marks (see judgment of 4 May 1999 in Joined cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions-und Vertriebs GmbH (WSC) v Boots-und Segelzubehör Walter Huber and Franz Attenberger (Chiemsee)* [1999] ECR I-2779, at paragraph 25).
 - It is also a well-established principle that the Registrar's role is to engage in a full and stringent examination of the facts, underlying the Registrar's frontline role in preventing the granting of undue monopolies, see to that effect CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z.o.o. v OHIM* [2011] ECR I-1541 (*Technopol*).
 - There must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics - see CJEU Judgment C-468/01 P to C472/01 P *Procter & Gamble Company v OHIM* (Three-dimensional tablets for washing machines or dishwashers) at paragraph 39, and General Court Judgment T-222/02 *Robotunits* at paragraph 34.

- As regards signs or indications which may serve to designate the geographical origin of the categories of services in relation to which registration of the mark is applied for, especially geographical names, it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of services concerned, but they may also, in various ways, influence consumer tastes by, for instance, associating the services with a place that may give rise to a favourable response (see *Chiemsee*, cited above, at paragraph 26: judgment of 25 October 2005 in Case T-379/03 *Peek & Cloppenburg KG v OHIM* ('*Cloppenburg*') [2005] ECR II-4633, at paragraph 33).
- The registration of geographical names as trade marks is excluded under section 3(1)(c) not only where they designate specified geographical locations which are already famous or known for the category of services concerned, and which are, therefore, associated with those services in the minds of the relevant consumers; it is equally excluded if the geographical name is liable to be used by other traders and must remain available to them as indications of the geographical origin of the category of services concerned (see *Chiemsee*, at paragraphs 29 and 30).
- However, section 3(1)(c) does not preclude the registration of geographical names which are unknown to the relevant class of persons (or at least unknown as the designation of a geographical location), or of names in respect of which, because of the type of place they designate, such persons are unlikely to believe that the category of services concerned originates there (see *Chiemsee* at paragraph 33).
- In light of all the foregoing, a sign's descriptiveness cannot be assessed other than by reference to the goods or services concerned, on the one hand, and by reference to the understanding which the relevant persons have of it, on the other (see judgment of 15 October 2003 in Case T-295/01 *Nordmilch eG v OHIM* ('*Oldenburger*') [2003] ECR - 4365, at paragraphs 27 to 34).

Application of legal principles - Section 3(1)(c)

33. Before considering the sign in its totality, I will first assess the geographical reference it contains, i.e. 'Berkshire'. I must assess whether the geographical name contained within the mark is likely to be associated in the mind of the relevant class of persons with the categories of goods and services concerned, or whether it is reasonable to assume that such an association may be established in the future. In making that assessment, particular consideration should be given to the relevant class of persons' degree of familiarity with the geographical name in question, with the characteristics of the place designated by that name, and with the goods and services concerned (see *Chiemsee*, at paragraph 37).
34. Whilst it cannot be shown categorically that the county of Berkshire has a reputation for providing eye clinics, or is commonly associated with the goods and services provided by an eye clinic, the area involved is of a significant size and incorporates several large cities and towns, including Reading and Slough (**see Annex A**). It is therefore reasonable to conclude that within the county of Berkshire, more than one undertaking will provide such eye care and treatment services.

35. An assessment of the relevant consumer is important in coming to a conclusion as to the likely perception of the mark in the first instance. In *Matratzen Concord AG v Hukla Germany SA*, C-421/04 (*Matrazen*), the CJEU stated that:

"...to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, who are reasonably well informed and reasonably observant and circumspect, in the territory in respect of which registration is applied..."

36. I am also mindful of the decision of the General Court (formerly the Court of First Instance) in *Ford Motor Co v OHIM*, T-67/07 where it was stated that:

"...there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics".

37. The goods and services on offer are, to some degree at least, highly technical and specialised. The goods provided by the applicant include scientific equipment used for diagnosis purposes in the field of eye health and care, and ophthalmic lenses for the eye. The services provided by the applicant are advisory and consultancy services relating to degenerative diseases of the eye and also medical and surgical services performed on the eye.
38. The relevant public in respect of the goods provided by the applicant will be both specialist and non-specialist. In the case of the former, it will include a professional consumer in the field of eye care e.g. an optician purchasing lenses and other items to be used in the treatment of patients, or an ophthalmic surgeon utilising e.g. intra-corneal or intra-ocular implants in surgical procedures. In the case of the latter, the relevant public is also likely to be the end user or recipient of those goods who would benefit from the use of e.g. lenses following treatment. This would include any member of the general public suffering with degenerative eye disease who are therefore considering or opt to have optical surgery.
39. Because of the nature of the goods and the services provided, the relevant public, professional or not, is likely to be highly aware and attentive in its consideration and selection of such products.
40. The sign is comprised of descriptive terms that are all, individually at least, immediately obvious and clear. The word 'THE' will be perceived simply as the definite article, although it is possible that the consumer may also perceive this element in a laudatory sense. The word 'BERKSHIRE' will be immediately understood by the public as referring to the English county (**see Annex A**). It will be perceived to be a large, well-populated area in the south of the country, close to London. The words 'EYE CLINIC' are readily understood to refer to a place where medical services dedicated to matters of the eye

are provided, and where technical products such as lenses and intra corneal implants will be available, to be used during treatments and/or for the patient to take away following treatment or consultation.

41. When faced with the mark, the relevant consumer will therefore perceive, immediately and without the need to analyse in detail, a descriptive message indicating that the products on offer (whether goods or services) relate to the care and treatment of the eyes, and are provided at a clinic situated in the county of Berkshire.
42. Whilst the county of Berkshire may have no reputation or association for such goods and services *per se*, the relevant public will have a level of expectation as to the likelihood of there being more than one such undertaking situated in the county. As such, the mark at issue will offer no trade mark message and will not succeed in distinguishing the goods and services of one undertaking from the same or similar goods and services provided by others in the same field of business.
43. In the recent *Canary Wharf* decision ([2015] EWHC 1588 (Ch)), the Court concluded that, notwithstanding the fact that the Canary Wharf development may not have been associated with the services specified, there was an overriding public interest in keeping the sign free for use by others. In particular, it was found that the area's nature and reputation as a business district meant that others would be likely to want to use the term. The Court found that this was sufficient, even though the development was not actually well known for wider services such as 'car parking' or 'security services'. The decision in *Canary Wharf* therefore confirmed the consideration of public interest in marks incorporating a geographical location, whether or not there exists, or is likely to exist, an association between that location and the goods or services of offer.
44. The mark 'THE BERKSHIRE EYE CLINIC' is a term that others in the same field of business should be free to use when providing eye care/treatment services and closely related or ancillary goods, in the county of Berkshire. The acceptance of this term as a trade mark for one undertaking is likely to disadvantage other undertakings and the need to keep free is clear.

Conclusion in the *prima facie*

45. The mark is considered in the *prima facie* case to be descriptive of the geographical origin of the goods and services listed under this application and subsequently fails under section 3(1)(c) of the Act.
46. As I have found that the mark in question is open to objection under section 3(1)(c) of the Act, it follows that it is also open to objection under section 3(1)(b). Anna Carboni, sitting as the Appointed Person in COMBI STEAM, O-363-09, summarised the leading case law in respect of this part of the Act:

"It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs "a residual or sweeping-up function", backing up the other two provisions, which contain specific and characteristic examples of types of

marks that lack distinctive character: Procter & Gamble Ltd's Trade Mark Application [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): Koninklijke KPN Nederland BV v Benelux-Merkenbureau Case C-363/99 (POSTKANTOOR) [2004] ETMR 57 (ECJ) at [86]”.

47. It is clear from the above guidance that if a mark is entirely descriptive of characteristics of goods or services, it will also be devoid of any distinctive character under section 3(1)(b). As I have found that the mark in question is open to objection under section 3(1)(c) of the Act, it follows that it is also open to objection under section 3(1)(b) of the Act. In the event I am wrong that 3(1)(c) and (b) are co-extensive, I conclude also that section 3(1)(b) would apply independently and that the expression ‘THE BERKSHIRE EYE CLINIC’ would be considered to be origin neutral by the relevant consumer.

Acquired distinctiveness

48. As has been set out previously, the applicant submitted formal evidence of use on 16 March 2016 with additional material submitted on 05 October 2016.

Legal principles of acquired distinctiveness

49. The key authority for acquired distinctiveness is *Chiemsee* (cited above), the relevant test being set out in paragraph 55:

“...the first sentence of Article 3(3) of the First Directive 89/104/EEC is to be interpreted as meaning that:

- *A trade mark acquires distinctive character following the use which has been made of it where the mark has come 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 goods of other undertakings;*
- *In determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;*
- *If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied;*
- *Where the competent authority has particular difficulty in assessing the distinctive character of the mark in respect of which registration is applied for, Community law does not preclude it from having recourse, under the conditions laid down by its national law, to an opinion poll as guidance for its judgment.”*

50. I am also mindful of the CJEU decision in *Bovemj Verzekeringen NV v Benelux Merkenbureau (Europolis)* C-108/05, where it was held that a trade mark may be registered on the basis of acquired distinctiveness “...only if it is proven that the trade mark has acquired distinctive character through use throughout the territory of a member state”.
51. The proviso to section 3 based on acquired distinctiveness does not establish a separate right to have a trade mark registered. It allows an exception to, or derogation from, the grounds of refusal listed in section 3(1)(a) - (d) and as such, its scope must be interpreted in light of those grounds of refusal - see e.g. case T-359/12 *Louis Vuitton Malletier v OHIM* and case law referred to at para [83]. The established principles to consider when assessing a claim to distinctiveness acquired through use can be summarised as follows:
- Mere evidence of use, even if substantial, does not make the case for acquired distinctiveness.
 - A significant proportion of the relevant consumers need to be educated that the sign has acquired distinctiveness.
 - If, to a real or hypothetical individual, a word or mark is ambiguous in the sense that it may be distinctive or descriptive then it cannot comply with the requirements of the Act for it will not provide the necessary distinction or guarantee.
 - It follows that, with regard to the acquisition of distinctive character through use, the identification by the relevant class of persons of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark. The expression ‘use of the mark as a trade mark’ in section 3 refers solely to use of the mark for the purposes of the identification, by the relevant class of person, of the product as originating from a given undertaking.
 - Acquired distinctiveness cannot be shown by reference only to general, abstract data such as predetermined percentages (see also *Chiemsee* (para [52]) case and others).
 - The mark must have acquired distinctiveness through use throughout the territory of the UK.
 - In assessing whether a trade mark has acquired a distinctive character, the competent authority must make an overall assessment of the relevant evidence, which in addition to the nature of the mark may include: (i) the market share held by goods bearing the mark; (ii) how intensive, geographically widespread and long-standing the use of the mark has been; (iii) the amount invested by the proprietor in promoting the mark; (iv) the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor; (v) evidence from trade and professional associations; and (vi) (where the competent authority has particular difficulty in assessing the distinctive

character) an opinion poll. If the relevant class of persons, or at least a significant proportion of them, identifies goods or services as originating from a particular undertaking because of the trade mark, it has acquired a distinctive character.

52. The question to be determined is whether, through the use made of it, the sign applied for has acquired a distinctive character in respect of the goods for which registration is sought. In doing so, this question must be asked through the eyes of the average consumer who is reasonably well informed, observant, and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, C-342/97[1999] ECR I-3830 paragraph 26).
53. In order to demonstrate that an otherwise non-distinctive or descriptive sign, which has been initially rejected in the *prima facie* case, has acquired a distinctive character because of the use made of it, the applicant must provide evidence in a number of key areas. The office must be able to determine how long the sign has been in use. Clearly it is the case that the longer a sign has been in the relevant market place, the more time the relevant public has to become accustomed to it and accept it as a badge of origin rather than a descriptive expression. It is also vital to show the extent of use of the sign geographically. A trade mark registration is a national right and, as such, it must be the case when considering claims to acquired distinctiveness, that the relevant public across the relevant territory has become aware of the sign and educated, by use, that it is *more* than simply a descriptive term, and has evolved to become a badge of origin indicating the goods or services of one undertaking.
54. In this case, I have identified the average consumer as being both the general public requiring advice about, and/or treatment for eye disease, and the professional consumer working in the field of degenerative eye diseases.
55. It is worth noting at this point that whilst the applicant has stated that no claim had been made to the effect that the goods or services on offer were of a specialised nature (see paragraph 19 of this decision), in his letter of 16 March 2016 the applicant stated:
- “...few specialist niche businesses would be able to attain a turnover of such in such a short period of time....there are relatively few specialist eye consultant surgeries in the UK compared with other industries in general across the UK...gaining distinctiveness early is far easier than a vast over-crowded non-specialist market...we believe that this further evidence...in a relatively small, niche market in the first year demonstrates that the mark has become known to the average consumer in the area of ophthalmology....”*
56. Whilst I do not feel that the nature of the applicant’s goods and services is necessarily key to the finding that the mark is inherently descriptive of the geographical origin of those goods or services, I believe that the specialist nature and niche market within which the applicant operates has been established by the applicant itself, in spite of claims to the contrary.
57. The position must be assessed at the date of application, being 02 May 2015. The applicant submitted formal evidence of use on 16 March 2016. That evidence was

provided in the form of an initial covering letter, together with three separate sets of submissions and supporting materials (the covering letter explaining that electronic file size restrictions relating to the IPO's IT systems meant that the evidence had to be submitted in this way). The three 'sets' of evidence were named as follows:

- 'Jembro - Harley - Berkshire - response to hearing with examiner 18 Jan 16 PART 1 - mar 16' (referred to hereafter as 'Part 1')
- 'Jembro - Harley - Berkshire - response to hearing with examiner 18 Jan 16 PART 2 - mar 16' (referred to hereafter as 'Part 2')
- 'Jembro - Harley - Berkshire - response to hearing with examiner 18 Jan 16 PART 3 - mar 16' (referred to hereafter as 'Part 3')

58. The applicant did not provide a witness statement with the evidence of use but, in Part 1, he set out information relating to the company background and use of the mark. Notably, the applicant stated that:

- The mark has been in use since December 2014, achieving a turnover of £205,689 by the end of April 2015. The applicant stated that such a level of turnover generated in "*just over four months*" should be considered significant when considering the likelihood of gaining a reputation in the field of eye care and eye treatment.
- The applicant has not actively marketed or promoted the mark, relying instead on hospital referrals, industry networking and editorial features to raise awareness of the mark and the products provided under that sign. There appears to have been no expenditure in this area.
- In appendix A of Part 1, the applicant provides an undated screen grab from its website, which includes the mark text 'THE BERKSHIRE EYE CLINIC', in the context of providing information about a procedure utilising something called 'MacularScope Plus' (a trade mark of the applicant). The screen grab relates to a procedure utilising new technology in the field of eye treatment and care.
- In appendix B of Part 1, the applicant provides an excerpt from the Reading Chronicle, dated 14 June 2015. The excerpt refers to "*a Reading surgeon*" being the first in the country to carry out a revolutionary treatment for the most common cause of blindness in Britain. The article is accompanied by a picture of a fingertip with a small device atop of it, and refers to a procedure utilising a telescope smaller than a pea. The article makes no reference to either the mark at issue, or the applicant, so I can only speculate as to the connection between this excerpt and the pending trade mark application.

59. Part 2 of the evidence comprised of the following:

- Two invoices for services provided. The invoices are dated 08 April 2015 and 18 April 2015. The figures involved are £2793 and £1800, less than £5000 in total. The

invoices were sent to addresses in Berkshire and Buckinghamshire. The mark text 'THE BERKSHIRE EYE CLINIC' is presented in combination with a highly distinctive colourful figurative element (see **Annex B** for example).

60. Part 3 of the evidence comprised of the following:

- Two letters confirming future appointments for procedures. The first is dated 28 April 2015 (one week prior to the application's filing date), with a proposed procedure fee of £2930 and sent to an address in Reading, Berkshire. The second letter dated 02 April 2015 with procedure fees of £14,000, was sent to an address in Hampshire. Both letters show the word elements making up the mark to hand, namely 'THE BERKSHIRE EYE CLINIC' presented in combination with the same colourful, figurative device element placed above the word elements.

61. The applicant submitted a further round of evidence on 05 October 2016 consisting of the following:

- 14 invoices dated between 05 June 2014 and 16 April 2015, and four letters from eye surgeons and specialists referring work or questions to the applicant, dating from 24 August 2014 to 22 March 2015. In total, the 14 invoices, spread across a 10 month period immediately prior to date of filing, amount to £19,600. The invoices all display the mark text in combination with the same colourful, figurative device element seen in earlier evidence.
- In all of the letters and invoices provided by the applicant, across both sets of evidence, the word elements in the mark are separated and presented on two lines, one above the other, to read 'THE BERKSHIRE' and 'EYE CLINIC' (see **Annex B** for example).

62. It is recognised, of course, that acquired distinctiveness may arise as a result of the use of a sign as part of, or as a component of, a composite trade mark, or in conjunction with another sign, but this is not inevitably the case and the evidence must be capable of supporting such a conclusion.

63. Following a full analysis of the evidence provided by the applicant, I must conclude that this information is wholly inadequate in terms of proving that the mark has acquired distinctive character. Whilst the applicant has stated that the business has developed rapidly in a short space of time, it is uncommon for the Registrar to find evidence of acquired distinctiveness in circumstances where the duration of use is significantly less than five years. The evidence provided is that of very recent use, some of it dating to no more than a matter of weeks prior to the date of filing the application. Furthermore, it does not convince me that the mark has become distinctive across the relevant territory, being the UK as a whole. Whilst it is not necessary to show use in every major town and city in Wales, Scotland, Northern Ireland and England, there must be some evidence that the mark at issue has been used widely across the territory to the extent that the relevant public will have had the opportunity to become accustomed to it being used to denote trade origin.

64. Use of the mark in combination with other elements of trade mark significance, as has been seen in much of the evidence provided by the applicant (paras 58-60 above), does not, in and of itself, lead to a rejection of that evidence. However, there are also major flaws and gaps in the other aspects of the evidence, e.g. no marketing or promotional activity whatsoever, less than one year of use prior to filing the application, limited level of sales of services and a limited geographical spread of use of the mark across the relevant territory. Taken in combination, these factors cause the case for acquired distinctive character to fail.
65. The 14 invoices that form the major part of the second round of evidence (submitted 05 October 2016) are all dated between 05 June 2014 and 16 April 2015 and total £19,600. It is noted, however, that whilst the mark text is present on those invoices (as was the case with the earlier evidence), it is always used in conjunction with a highly distinctive, multi-coloured figurative element.
66. It is also the case that the word elements in the mark are not presented in the same way on the invoices as they are in the mark to hand. A level of stylisation and design has been added to separate the primary element 'THE BERKSHIRE' from the secondary element 'EYE CLINIC', where the former is positioned above the latter, and with both elements further distinguished through use of different fonts and typeface size. This stylisation and design, present in all of the letters and invoices submitted across both sets of evidence and the screen grab (Appendix A in Part 1), creates a different impact and impression to that conveyed by the 'plain' word-only sign applied for.
67. The four letters from other consultant ophthalmic surgeons, dated between 24 August 2014 and 22 March 2015, referring work to, or asking advice of, the applicant, are of little assistance in terms of demonstrating acquired distinctiveness. Whilst they may indicate that the applicant is known to some degree in the relevant sector, this in itself does not establish that those also involved in the same areas of business understand and perceive the term 'THE BERKSHIRE EYE CLINIC' as being a trade mark rather than a descriptive term. It is to be noted that in the letter from Mr Gerard O'Connor, dated 11 January 2015, the writer begins by wishing the applicant and "*...your colleagues at your eye clinic...*" a Happy New Year. The writer does not, it appears, consider the term 'eye clinic' to be anything other than descriptive of a place of business where treatment of the eyes is carried out.
68. Taken in totality, the body of evidence provided by the applicant shows that the mark 'THE BERKSHIRE EYE CLINIC' is rarely used as filed, in a trade mark sense. It shows that the mark has been used for a very short period of time prior to the filing date of 02 May 2015. It also shows that, at least prior to filing, the applicant spent nothing on marketing and promotional materials or activities but instead relied on 'word of mouth' and hospital referrals to raise awareness of its products. The level of sales revenue (by way of procedures carried out) is not particularly impressive in a field that, by its very nature, cannot be said to be inexpensive, and there is no evidence whatsoever of sales of any of the goods applied for. Finally, the geographical extent of use is limited mostly to the county of Berkshire and neighbouring Buckinghamshire/Hampshire, and so it cannot be established that the mark will be perceived by a wider public across the territory as the trade mark of one single undertaking.

Conclusion

69. In this decision, I have considered all documents filed by the applicant and all arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is refused because it fails to qualify under sections 3(1)(b) and (c), and because the applicant has failed to demonstrate that the sign has acquired distinctiveness through use pursuant to the proviso to section 3(1).

Dated this 14th day of December 2016

A handwritten signature in black ink, appearing to be 'A. Feldon', written over a horizontal line.

**Andrew Feldon
For the Registrar
The Comptroller-General**

Annex A

Collins English Dictionary defines Berkshire as:

Noun: A historic county of S England

Population of Berkshire is estimated at 863,800 (mid-2014)

Major cities and towns of Berkshire:

Reading (population 318,000)

Slough (population 144,000)

Maidenhead (population 80,000)

Bracknell (population 77,000)

Windsor (population 27,000)

Number of eye specialists in Reading:

A search of the term 'ophthalmic' in the Reading yellow pages returned 72 hits for undertakings providing optician services and similar eye treatment services.

A search of the term 'eye clinic' in the UK yellow pages returned 541 hits including 'The Windsor Eye Clinic', 'Lancashire Eye Clinic' and 'Ayrshire Eye Clinic & Laser Centre'.

Annex B



THE BERKSHIRE
— EYE CLINIC —