

O-302-17

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 3180666
IN THE NAME OF KEVIN HICKEY
TO REGISTER THE FOLLOWING TRADE MARKS IN CLASS 25:**

Teen.

Teen

(Series of two)

Background

1. On 16 August 2016, Mr Kevin Hickey ('the Applicant'), applied to register the trade marks 'TEEN.' and 'TEEN', as a series of two, for the following goods:

Class 25: Clothing, footwear, headgear.

2. On 2 September 2016, the Intellectual Property Office ('IPO') issued an Examination Report in response to the application. In the report, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act') because, in the Examiner's words, the mark(s) "*consist(s) exclusively of a sign which may serve in trade to designate the kind and intended purpose of the goods e.g. clothing for teenagers*". In line with IPO procedure, a period of two months was allowed for the applicant to respond.
3. In his response to the Examination Report dated 24 October 2016, the applicant presented the following arguments:
 - The marks are not an abbreviation of the word 'teenager';
 - The word 'teen' is a suffix in the English language and features mostly at the end of numbers i.e. from 'thirteen' through 'nineteen';
 - His 'teen' brand caters for all sizes and ages, is not aimed at those wanting a youthful look, and is not limited to products being worn by teenagers;
 - By suggesting that his clothing was for teenagers, the Registrar was seeking to restrict his brand;
 - The Registrar has previously registered a 'Boy' trade mark (UK Registration Number 2268730) which, in the applicant's view, was on a par with his own;
 - Specifically in respect of section 3(1)(b), his marks were clearly distinctive.

4. The Examiner responded to these submissions in a letter dated 31 October 2016, stating that he remained unconvinced that the marks were acceptable. Maintenance of the objection was supported by a number of Internet hits which, in the Examiner's view, demonstrated that the term 'teen' was commonly used in trade on clothing for teenagers.
5. The Applicant responded by requesting an *ex parte* hearing, which was duly held on 6 December 2016. At the hearing, Mr Hickey effectively restated the submissions he had previously presented in writing (as recorded above).
6. Whilst I was not persuaded to waive the objection at the hearing, I did agree to provide the Applicant with an opportunity to submit examples showing how the mark was intended to be used - prior to making a final decision. Such examples were supplied by Mr Hickey on 23 December 2016, alongside a written copy of the submissions made orally at the hearing.
7. Having studied the examples provided, I remained unpersuaded that the mark met the criteria for acceptance and so refused the application in a letter dated 9 January 2017. This led to the applicant submitting a Form TM5 (Request for a Statement of Reasons for Registrar's Decision) on 9 February 2017.
8. Under section 76 of the Trade Marks Act 1994 and rule 69 of the Trade Marks Rules 2008, I am now asked to state in writing the grounds of my decision and the materials used in arriving at it. No formal evidence of use has been put before me for the purposes of demonstrating acquired distinctiveness since the marks are not yet in use. Therefore I have only the *prima facie* case to consider.

Decision

9. Section 3(1) of the Act reads 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, 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.

Section 3(1)(c)

The legal principles

10. The key principles to bear in mind when assessing signs against section 3(1)(c) have been addressed in a number of judgements delivered by the Court of Justice of the European Court ('CJEU') and the General Court ('GC'). They are: *JanSport Apparel Corp v Office for Harmonisation in the Internal Market* (Case T-80/07), *OHIM v Wrigley ('Doublemint')* (Case C-191/01 P), *Matratzen Concord AG v Hukla Germany SA*, C-421/04 and *Sykes Enterprises v OHIM ('Real People Real Solutions')* [2002] ECT II-5 179 .

11. In *JanSport Apparel Corp v Office for Harmonisation in the Internal Market* (Case T-80/07) the Court set out the considerations to be taken when assessing a mark under Section 3(1)(c):

"18. Under Article 7(1)(c) of Regulation No 40/94, 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 or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service are not to be registered.

19. By prohibiting the registration of such signs, that article pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (Case C-191/01 P OHIM v Wrigley [2003] ECR I-12447, paragraph 31).

20. Furthermore, the signs covered by Article 7(1)(c) of Regulation No 40/94 are signs regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquired the product or service to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (Case T-219/00 Ellos v OHIM (ELLOS) [2002] ECR II-753, paragraph 28, and Case T-348/02 Quick v OHIM (Quick) [2003] ECR II-5071, paragraph 28).

21. The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought (see the judgment of 9 July 2008 in Case T-323/05 Coffee Store OHIM (THE COFFEE STORE), not published in the ECR, paragraph 31 and the case-law cited). Accordingly, a sign's descriptiveness can only be assessed by reference to the goods or services concerned and to the way in which it is understood by the

relevant public (Case T- 322/03 *Telefon & Buch v OHIM - Herold Business Data (WEISSE SEITEN)* [2006] ECR II-835, paragraph 90).

22. *It follows that, for a sign to be caught by the prohibition set out in that provision, 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 Case T-19/04 *Metso Paper Automation v OHIM (PAPERLAB)* [2005] ECR II-2383, paragraph 25 and the case-law cited).*"

It is clear from the aforementioned case law that I must consider whether the mark is descriptive for the goods applied for, and whether there is a public interest in keeping the term free for use.

12. It is not necessary that a sign be in use in a descriptive sense at the time the application was filed. A mark will be refused if it *could* be used in a descriptive sense, as confirmed in *OHIM v Wrigley ('Doublemint')* (Case C-191/01 P, paragraph 32):

"In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned."

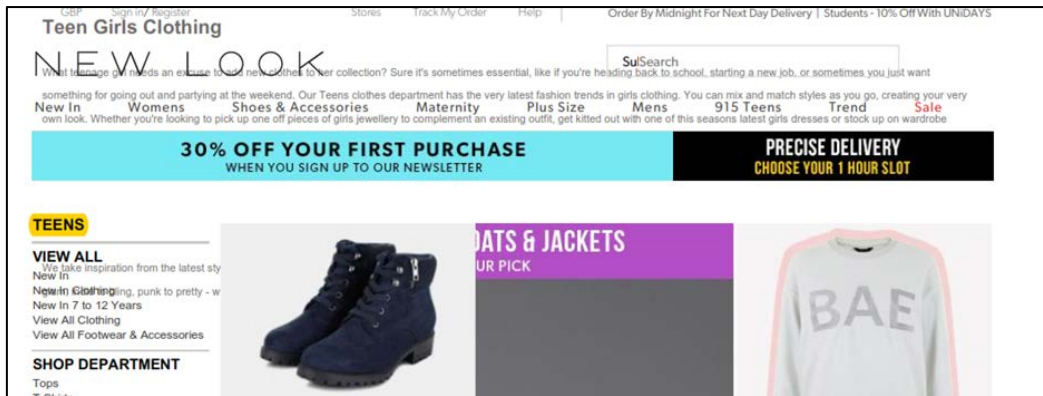
13. Furthermore, in *Matratzen Concord AG v Hukla Germany SA*, C-421/04 the CJEU confirmed that:

"...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..."

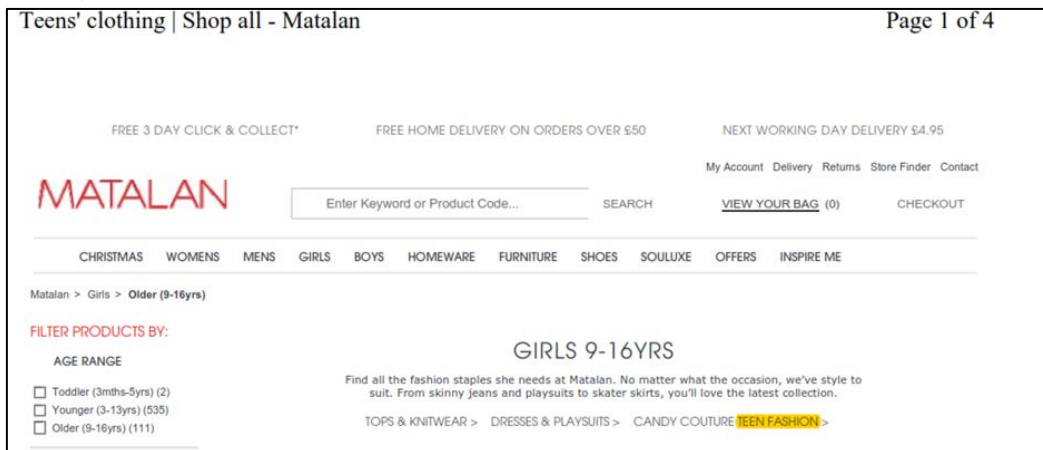
14. I must also be aware that the test is one of immediacy or first impression, as confirmed by the General Court which, in its decision on *Sykes Enterprises v OHIM ('Real People Real Solutions')*, [2002], ECT II-5179, stated:

*"...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin."***Application of the legal principles**

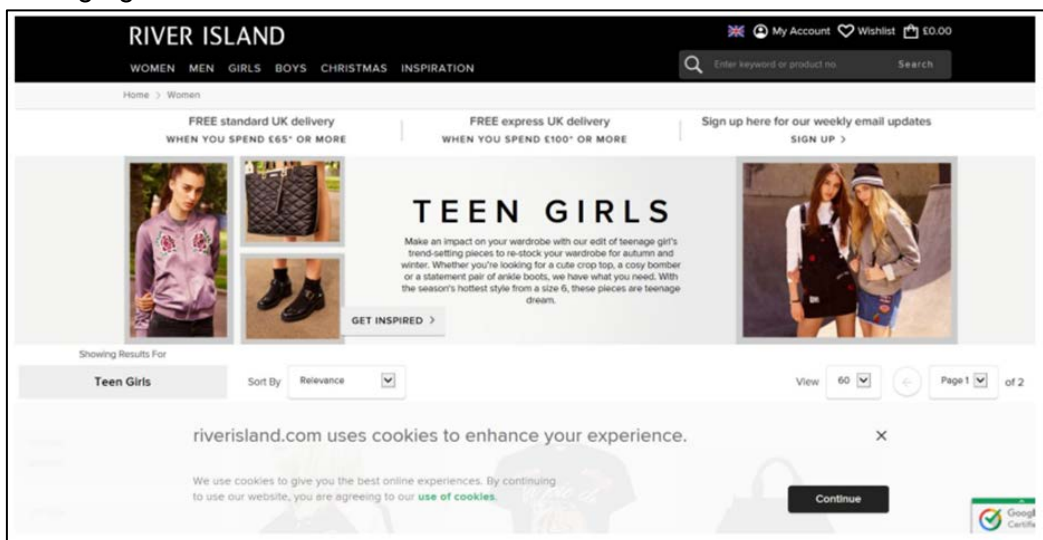
15. It is clear from the aforementioned case law that I must determine, assuming notional and fair use in trade, whether the marks in suit will be viewed by the average consumer as designating a characteristic of the goods for which registration is sought.
16. The goods at issue are 'clothing, footwear and headgear' at large in Class 25. In order to gauge and understand the perception of the relevant public, I must first identify who that public is. It would seem reasonable to assume that the average consumer for clothing would be the public at large. These are general, non-specialised goods for use by all. The level of attention paid when purchasing them is likely to be moderate, as they are everyday items, not necessarily very expensive, and one would assume them to have a relatively short life span.
17. I must therefore determine how the average consumer, being the public at large, would perceive the marks (i.e. the word 'teen' both with and without a full stop) when seeing them used in relation to clothing. In my opinion, when encountered in the *prima facie* case, the term 'teen' would merely be understood as an indication as to the kind or intended purpose of the goods, i.e. clothing, footwear and headgear suitable and/or sized for teenagers to wear. Although the application seeks to protect variations of the word 'teen' (as opposed to 'teenager'), I refer to the definition provided in the Examination Report (taken from the Oxford Dictionary of English (3rd Edition)), which confirmed that the word 'teen' is both an adjective meaning 'relating to teenagers', and a noun meaning 'a teenager'.
18. Further to the above, it is not necessary to prove that a term is already in descriptive use in the field in question. At the hearing, Mr Hickey submitted that the word 'teen' is not presented as a 'search filter' on the websites referenced in the Examination Report and therefore cannot be descriptive (a 'filter' being a category used for limiting the results of a search in a website e.g. the website of the fashion retailer 'New Look' may be searched by filtering via categories such as 'gender', 'size', 'type of clothing' etc.). I do not accept that submission at all; the circumstances under which a particular term may be regarded as designating a characteristic are not confined to its capacity for use as a search or internet filter. Section 3(1)(c) of the Act merely requires that a term *may* serve, in trade, to designate a characteristic of the product. Therefore, in my view, the dictionary definition presented at paragraph 17 above is sufficient to substantiate the Registrar's view that the word 'teen' is descriptive for the goods claimed.
19. Though he did not have to do so, the Examiner nevertheless provided evidence of third party internet use in order to further substantiate the objection raised. In relation to the 'New Look' website (reproduced below), when looking at the left-hand side of the screen, the column running vertically is entitled 'Teens', which one would perceive as being a means for identifying clothing which is suitable for, or aimed at, teenagers. This, in addition to the dictionary definition, clearly indicates that the term is being used descriptively.



20. Likewise, the 'Matalan' website shows the term 'teen' being used in a descriptive sense along the very top of the screen i.e. 'Teens' Clothing'. It is clear that the four pages which followed in the Examiner's letter (not duplicated within this decision) depict clothing for teenagers. The term 'teen fashion' also appears towards the centre of the page as part of the wider term 'Candy Couture Teen Fashion' (see highlighted text below):



21. The final internet reference presented by the Examiner was taken from the 'River Island' website. It can clearly be seen that this store offers a range of clothing aimed at teenage girls:



22. The Examiner has quite clearly demonstrated that the term ‘teen’ is often used descriptively in relation to clothing. It serves no different a purpose from other terms we would widely recognise such as ‘womens’, ‘mens’ etc., all which are used to designate a sub-category of clothing. The average consumer, being the public at large, would take nothing more from the term ‘teen’ (with or without a full stop), used in respect of clothing, other than it conveying a clear and descriptive message. In his correspondence with the Examiner and at the hearing, Mr Hickey submitted that his clothing can be worn by anyone regardless of age, and is therefore not specifically targeted at the teen market. This is not relevant to my consideration. I must assess the mark against the goods listed in the application form. In this instance, the mark is ‘Teen’ and the goods are *inter alia* ‘clothing’. That is the only context in which I can make an assessment. Whether or not ‘non-teens’ purchase Mr Hickey’s products is irrelevant to my assessment of the mark applied for.
23. At the hearing, Mr Hickey was keen to impress upon me that the Registrar had previously accepted a ‘Boy’ trade mark (registration number 2268730) which, in his view, held precedent value in terms of his own application. It has been long held that the state of the register is not a factor which must be considered, as per the TREAT case (1996) PRC, page 25 which states:

“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 TM and the same must be true under the 1994 Act.”

In my hearing report I addressed the issue of the ‘Boy’ mark in some detail, outlining the differences which may have led to its acceptance. It is not on a par with the mark at hand, and in light of this I do not intend to dwell on it any further.

24. As explained at paragraph 6 above, following the *ex parte* hearing I provided Mr Hickey with more time to show me how he intended to use the marks. On 22 December 2016, I received images of the first mark in the series (i.e. the version incorporating a full stop) being used on a swing tag and a stitched label. In both cases, the use was in respect of clothing (tee shirts), and is reproduced below:



25. Having considered these examples, I remained of the opinion that the descriptive message permeated the marks so strongly that, even when seen on a label or swing tag in such fashion, the average consumer would perceive the sign as being nothing more than a designation of the type of clothing as opposed to a brand.
26. Up to this point, and aside from passing references at paragraphs 17 and 22 above, I have not focused specifically upon the impact of the full stop in the second mark. Reflecting the fact that I have sought to address its impact on *both* the objection under section 3(1)(c) and the objection under section 3(1)(b), I have presented dedicated analysis of the second mark's additional punctuation at paragraphs 32 through 36 below. That analysis aside, I should confirm that for the reasons outlined above, I do not believe that either of the two signs satisfy the criteria set out in section 3(1)(c).

Section 3(1)(b)

27. The marks have attracted an objection under both sections 3(1)(b) and 3(1)(c). Any mark found to be unacceptable under section 3(1)(c) will automatically be found to be non-distinctive, and will therefore also attract an objection under section 3(1)(b). The overlap between sections 3(1)(b) and (c) was briefly discussed at the *ex parte* hearing. However, and in the event that I am found to be wrong with respect to the objection under section 3(1)(c), it is necessary to also consider the marks specifically in the context of section 3(1)(b).

The legal principles

28. The relevant case law is set out below:

- An objection under section 3(1)(b) operates independently of objections under section 3(1)(c) (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C- 53/01 to C-55/01, paragraphs 67 to 68);
- For a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- A mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86);
- A trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);
- The relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

29. Furthermore, in relation to section 3(1)(b) it was held in *Postkantoor* that:

“In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.” (Paragraph 86)

30. Ms. Anna Carboni, sitting as the Appointed Person in *COMBI STEAM* (BL O-363-09), conveniently summarised the leading case law in respect of this part of the Act when, at paragraph 7 of that decision, she stated the following:

“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].”

Application of the legal principles

31. In my view, the marks (both with and without the full stop) cannot be seen as anything other than designating a characteristic of the goods in the *prima facie*. However, if I am found to be wrong in this (for example, if the inclusion of a full stop is considered to take the first mark outside the scope of section 3(1)(c)), I would maintain that the mark is still absent of any distinctive character. The marks cannot be said to be fanciful or to have any degree of inventiveness. Neither do they contain stylisation or anything which may imbue them with trade mark character. The average consumer would have to be educated in order to recognise the signs as a badge of origin (on this, Mr Hickey confirmed to me that no use has yet been made of the mark, so claiming distinctiveness acquired through use is not an option that is open to him).

The Effect of the Full Stop

32. The first mark in the series contains an extra element, namely a full stop. By way of background, the effect (or lack of effect) of punctuation within a mark has been considered a number of times, both in case law and through Convergence Projects with the European Union Intellectual Property Office (‘EUIPO’) (namely the [Common Communication of the Common Practice of Distinctiveness – Figurative Marks Containing Descriptive/Non-Distinctive Words](#), published on 2 October 2015, and which is consistent with the practice of the Registrar).

33. As far as case law is concerned, Geoffrey Hobbs, sitting as Appointed Person in the *P.R.E.P.A.R.E.* case (RPC [1997], No. 24) stated:

“...and the sign P.R.E.P.A.R.E. has all the appearance to my eye of being just such an acronym. I do not consider that it is represented graphically in a manner which would cause people to overlook the word PREPARE and regard the representation simply as a string of letters. I am satisfied that the grammatical significance of the full stops is swamped by the linguistic significance of the letters and the sign would accordingly be used and understood by people in the same way as the word PREPARE.”

34. The effect of punctuation, specifically a full stop, was discussed further in the *BioID* case before the CJEU (C-37/03, *BioID AG v Office for Harmonisation in the Internal Market*) where, at paragraph 72, the following was stated:

“Furthermore, the two graphic elements placed after the abbreviation BioID, namely a full stop (■) and a sign (®), do nothing to enable the relevant public to distinguish, without any possibility of confusion, the products or services covered by the trade mark application from others which have another origin. It follows that those graphic elements are not capable of fulfilling the essential function of a trade mark, as described in paragraph 25 of the present judgment, in relation to the relevant goods and services.”

35. Guidance can also be found in the Common Communication mentioned in paragraph 32 above. The relevant excerpt is reproduced below:

Criterion	<i>Combination with punctuation marks and other symbols</i>
Common Practice	<ul style="list-style-type: none"> In general, the addition of punctuation marks or other symbols commonly used in trade does not add distinctive character to a sign consisting of descriptive/non-distinctive word elements. <p><u>Non-distinctive examples:</u></p> <p>“Flavour and aroma” FreshSardine.™</p>

36. Taking into account the authorities and guidance quoted above, I must make a finding in relation to the case before me. I believe this application to be on a par with the ‘*BioID*’ mark, and also the ‘*FreshSardine*’ example as used in the Common Communication shown above. The impression created by the first mark ‘TEEN.’ is dominated by the word element. The full stop appears at the end of the word, and so its impact upon the whole sign is relatively insignificant. There is nothing inventive or quirky about the addition or placement of the full stop within the mark and it adds nothing to the distinctive character of it. The first mark is therefore treated as a ‘teen’ mark, exactly as the second in the series. As a result, the reasoning I have set out at paragraphs 15 through 26 (for section 3(1)(c)) and paragraph 31 (for section 3(1)(b)) applies to the sign ‘Teen.’ as much as it does to the sign ‘Teen’.

Conclusion

37. In this decision I have considered all of the arguments put to both the examiner and myself and have concluded that the marks are not acceptable. The marks are therefore refused under the terms of section 37(4) of the Act because they fail to qualify under sections 3(1)(b) and 3(1)(c).

Dated this 4th day of July 2017

**Morwenna Bell
For the Registrar
The Comptroller-General**