

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 3852511

BY PULSE HEALTHCARE LIMITED

**TO PROTECT THE FOLLOWING TRADE MARK IN CLASSES 35,39,
44 AND 45**

CARE LIKE NO OTHER

Background

1. On 23rd November 2022, PULSE HEALTHCARE LIMITED ('the applicant') applied to register the above mark.
2. Registration was sought in classes 35, 39, 44 and 45 for the following services:

***Class 35:** Personnel placement; provision of temporary staff; provision of nursing staff*

***Class 39:** Escorting of patients during transportation*

***Class 44:** Medical care; healthcare services; nursing care; palliative care; home-visit nursing care; home health care services; provision of health care services in domestic homes; paediatric nursing services; post-operative nursing care; private nursing services; live-in nursing services; health care and social care services for those with complex care needs; health care services for those in need of mental health and physical health support; intermediate and short term health care and social care services; healthcare services, namely, selection of healthcare providers for the provision of healthcare services.*

***Class 45:** Escort services, namely, nurse escort services; companionship services for the elderly, disabled and unwell; providing personal and social support services to adults and children with complex needs and to their families.*

3. On the 29th November 2022, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under section 3(1)(b) of the Trade Marks Act 1994 ('the Act') which reads as follows:

“Absolute grounds for refusal

Section 3(1)(b)

The application is not acceptable in Classes 35, 39, 44, and 45. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because the sign merely serves a promotional function e.g., the average consumer would perceive the expression ‘CARE LIKE NO OTHER’ as a promotional message with the purpose of highlighting a positive attribute of the services being offered.

Merriam-Webster defines the idiom ‘like no other’ as “very special”. It is therefore considered that the sign in totality, when viewed on services such as medical, health and social care services, would be perceived by the relevant public as a laudatory promotional statement; merely intimating that the care provided is very special and incomparable, i.e., the care is like no other.

When a sign is purely promotional in nature it is considered that it cannot function as a badge guaranteeing the commercial origin of the services and does not distinguish your services from those of another undertaking.”

4. On the 7th February 2023, as no response to the examination report was received, a refusal letter was issued. This is in line with section 37(4) of the Trade Marks Act 1994 which states:

“If the applicant fails to satisfy the registrar that those requirements are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse to accept the application.

5. The applicant requested a statement of grounds by way of filing a

form TM5 on 7th March 2023. No submissions or evidence has been provided by the applicant as to why the examiner was wrong in their assessment. The refusal, therefore, is based on the administrative failure to respond within the timeframe. However, this decision will also consider the substantive objection under section 3(1)(b) for completeness. Whilst I have little material upon which to base my assessment, in my opinion, I am confident enough in this case that additional material would not have been needed given the clear and inherent meaning in the words and the services for which application has been made.

The Law

6. 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)...

(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)(b)

7. The Court of Justice of the European Union ('CJEU') has emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) of Directive 2008/95/EC ('the Directive', being the codified version of the original Directive 89/104/EEC) and Article 7(1) of Council Regulation (EC) No 207/2009 ('the Regulation', being the

codified version of original Council Regulation 40/94), in the light of the general interest underlying each of them (*Case C-37/03P, Bio ID v OHIM*, para 59 and the case law cited there and, e.g. *Case C-273/05P Celltech R&D Ltd v OHIM*).

8. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provisions referred to above upon which section 3(1)(b) is based) the Court has held that “...*the public interest... is, manifestly, indissociable from the essential function of a trade mark*” (*Case C-329/02P Satelliten Fernsehen GmbH v OHIM ‘SAT.1’*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above-mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function. Moreover, the word ‘devoid’ has, in the UK at least, been paraphrased as meaning ‘unpossessed of’ from the perspective of the average consumer.

9. Section 3(1)(b) must include within its scope those marks which, whilst not designating a characteristic of the relevant goods and services (i.e. not being necessarily descriptive), will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin. In terms of assessing distinctiveness under section 3(1)(b), the CJEU provided guidance in *Koninklijke KPN Nederland NV v Benelux Merkenbureau (Postkantoor) C-363/99* where, at paragraph 34, it stated:

“A trade mark’s distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to C-55/01

Linde and Others 5 [2003] ECR I-3161, para 41, and Case C-104/01 Libertel [2003] ECR I-3793, paras 46 and 75).”

10. Whilst I acknowledge that the distinctiveness of the mark must be assessed by reference to all of the services on which it is to be used, and that may lead to a different outcome according to the nature of those services, and how the mark would be perceived by the average consumer for those services, there are occasions when a general assessment may be made, where the services can be categorised and treated as homogeneous. The case of *BVBA management, Training en Consultancy v Benelux-Merkenbureau, Case C-239/05 of the CJEU*, states at para 38:

“In the light of the foregoing, the answer to the first question must be that the Directive must be interpreted as meaning that, when refusing registration of a trade mark, the competent authority is required to state in its decision its conclusion for each of the individual goods and services specified in the application for registration, regardless of the manner in which that application was formulated. However, where the same ground of refusal is given for a category or group of goods or services, the competent authority may use only general reasoning for all of the goods or services concerned”

11. In addition to considering the objection in respect of all the services claimed I also need to assess whether the mark, which in my opinion, consists of a promotional slogan, can fulfil the function of a distinctive trade mark. I am mindful that the test for assessing a slogan is no different than for any other category of marks. Following the CJEU decision in Case C398/08P Audi AG v OHIM (‘Vorsprung Durch Technik’) we know that this is only part of the consideration that must be made. In paragraph 44 of that decision, the Court stated:

“... while it is true... that a mark possesses distinctive character only in so far as it serves to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking, it must be held that the mere fact that a mark is perceived by the relevant public as a promotional formula,

and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient, in itself, to support the conclusion that the mark is devoid of distinctive character."

In regards to marks that consist of slogans, the test, is also succinctly outlined in the EUIPO Boards of Appeal "Case-law Research Report — The distinctive character of slogans (October 2021) as follows:

[15] The following non-exhaustive factors laid down in the case-law may serve to establish distinctiveness for a slogan: (a) it has a number of meanings; (b) it constitutes a play on words; (c) it introduces elements of conceptual intrigue or surprise, so that it may be perceived as imaginative, surprising or unexpected; (d) it has some particular originality or resonance, and / or triggers in the minds of the relevant public a cognitive process or requires an interpretative effort; (e) it has unusual syntactic structures and / or linguistic and stylistic devices such as alliterations, metaphors, rhymes.

[16] It is important to underline that none of the above factors apply in absolute terms independently from one another. For instance, the fact that a slogan has a number of meanings does not necessarily mean that it is distinctive. On the other hand, even if a slogan is not capable of setting off a cognitive process in the mind of the relevant consumer, it is not necessarily devoid of distinctive character.

12. It is also a well-established principle these days that the Registrar's role in examination will involve 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*. Whilst this case was, technically speaking, in relation only to section 3(1)(c) or its equivalent in European law, the principle about the 'prevention of undue monopolies' must hold good whether section 3(1)(b) and/or (c) applies.

Decision

13. In arriving at my decision, I firstly must identify the average consumer of the services contained within the application. The specification covers a range of provision of healthcare and patient care services, and personal care and support services across classes 35, 39, 44 and 45. I consider it reasonable to assume that the relevant consumer would be the general public at large and those requiring such care, and those within specialist care sectors i.e., nursing care/palliative care/medical staff. As such, it is my opinion that the perception of the mark in regards to all of the services will likely be the same. I am aware that I am entitled, in line with the BVBA case mentioned in paragraph 10, to give general reasoning for all of those services concerned in my decision.

14. I am aware that is inappropriate to base an objection solely around the promotional nature of the mark. In the '*VORSPRUNG DURCH TECHNIK*' decision (referred to above), the Court acknowledged that the fact that a slogan-type mark carries a promotional message does not, in and of itself, constitute a basis for refusal, i.e. a slogan can still denote commercial origin even if it is simultaneously performing a promotional purpose. This recognises that a promotional statement can also function as a trade mark. In paragraph 47 of that decision (and as reinforced in EUIPO's guidance on slogans), the court confirmed that characteristics such as having a number of meanings, being a play on words, or being perceived of as imaginative, surprising and/or unexpected are, as a rule, likely to endow a sign with distinctive character (whilst also noting that such characteristics are not essential pre-requisites for a finding of distinctive character). The message to be taken from such comments is that one should avoid deeming a sign as being devoid of any distinctive character simply because it performs a promotional function. The question, however, is whether the particular mark applied for only performs a promotional function and there is no possibility of it ever, in the prima facie, performing the function of being a trade mark as well.

15. I must now decide whether the mark applied for, used in relation to the services claimed, would be seen as one which lacks any capacity *prima facie* to differentiate the products of one provider to another. I must consider the perception of the average consumer when seeing the words 'CARE LIKE NO OTHER' in normal and fair use in relation to the services claimed. Taking into consideration the fact that all the services claimed are associated with the care sector, I feel that the objection is valid in respect of all the services.
16. I do not consider it to have any of the qualities that would enable this sign to be seen as a trade mark. The mark is not, in any way, imaginative, surprising or unexpected. Used in respect of care services and providers, the words 'CARE LIKE NO OTHER' would be perceived as a non-distinctive statement that solely promotes a high-level of care provision to the consumer and that the level of care provided surpasses that of other providers. Therefore, I do not believe that the relevant consumer would be able to distinguish who is providing such services and would instead only be able to perceive the mark as a laudatory statement.
17. Furthermore, I am not satisfied that the sign in question has any features that would render it memorable in the eyes of the average consumer such that it would possess the duality of function acknowledged by VORSPRUNG DURCH TECHNIK. I consider it to be nothing more than an origin neutral phrase that lacks the capacity to individualise care services to a single provider and a phrase that solely promotes an elevated level of care given. I therefore do not believe that the average consumer would understand the sign as having the distinctive character required for it to function as a trade mark, in the absence of education.

Conclusion

18. Having considered the materials before me and given due care and attention to the points raised above, the application is refused under section 3(1)(b) of the Trade Marks Act 1994, for all services in classes 35, 39, 44 and 45.

Dated this 9th day of May 2023

Amy Simms