

O/066/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2549898  
BY THE CONSORTIUM FOR PURCHASING AND DISTRIBUTION LIMITED  
TO REGISTER A SERIES OF TRADE MARKS CONSISTING OF**

**care**  
from The Consortium

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 101115 BY  
NESTOR HEALTHCARE GROUP PLC**

## BACKGROUND

1. On 9 June 2010, The Consortium for Purchasing and Distribution Limited (“CPD”) applied to register:



as a series of 2 trade marks. The first trade mark in the series is in the colours shown above; the second trade mark in the series is in black and white. CPD sought to register the trade marks for goods and services in classes: 1, 2, 3, 4, 5, 7, 8, 9, 10, 11, 14, 15, 16, 18, 20, 21, 22, 24, 25, 27, 28, 30, 31, 35, 36, 39, 41, 42, 43 and 44. The application was examined and accepted then published for opposition on 23 July 2010.

2. On 22 October 2010, Nestor Healthcare Group Plc (“Nestor”) filed a notice of opposition which consisted of grounds based upon sections 3(1)(a), (b), (c) and (d) of the Trade Marks Act 1994 (“the Act”). Nestor’s opposition is directed against the following services in classes 35, 41 and 44:

**Class 35:** Advertising; advertising services provided via the Internet; trade fairs; business management; business administration; office functions; purchasing of goods on behalf of others; arranging of contracts; negotiating with suppliers of goods and services in connection with purchasing goods and services on behalf of others; provision of industrial, business and commercial management assistance; rental of office machines and equipment; rental of photocopying machines; rental of vending machines; providing information and advice relating to any of the aforesaid services.

**Class 41:** Education; providing of training; entertainment; sporting and cultural activities; providing information and advice relating to any of the aforesaid services

**Class 44:** Medical services; veterinarian services; hygienic and beauty care for human beings or animals; consultancy and advisory services relating to

agriculture, horticulture and forestry; providing information and advice relating to any of the aforesaid services.

Nestor frames its objections in the following terms:

**3(1)(a)**

“The trade mark is not a sign capable of distinguishing goods or services of one undertaking from those of another.”

**3(1)(b)**

“All of the words comprised within the mark are non-distinctive and the visual representation of the mark does not add sufficient surplus for the mark to be identified as an indicator of origin. The mark is not capable of functioning as a trade mark.”

**3(1)(c)**

“The words appearing in the mark describe either the service provided or a characteristic of the service that is provided. The visual representation of the mark does not provide sufficient surplus to overcome the descriptive nature of the words appearing within the mark.”

**3(1)(d) – (directed only at the services in class 44)**

“The term CARE is a term which is customary in the current language and established practices of the trade as a term to describe the class 44 services designated in the opposed application. The mark applied for does not contain sufficient surplus to overcome the generic nature of the term CARE.”

3. On 14 March 2011, CPD filed a counterstatement. In its counterstatement CPD said, inter alia:

3. [CPD] is a well known supplier of products and services for customers in the social care, education, early years and training sectors. For over forty years, it has been providing schools and colleges with services and supplies and, in 2010 won the “ERA Education Supplier of the Year” award. Under its “Care” brand, it has been supplying care homes and related sectors with goods and services for many years. [CPD] is well known as “The Consortium” and enjoys considerable goodwill and reputation in this name.

4. The mark that is the subject of [the application] comprises the word “care” in pink/purple lettering with a heart logo incorporated into the letter “a” and the words “from the Consortium” in smaller blue lettering underneath.”

4. In response to the grounds of opposition CPD says:

**3(1)(a)**

“5...The mark is graphically represented and it is capable of distinguishing [CPD’s services] from those of other undertakings because it contains the name of the applicant, is depicted in a distinctive combination of colours, and contains a distinctive embellishment to the letter “a”.

**3(1)(b)**

In addition to the above CPD says, inter alia:

“6. [CPD] denies that all of the words in the mark are non-distinctive in respect of all or any of the opposed services. The visual presentation of the mark and the inclusion of the applicant’s name are distinctive features.”

**3(1)(c)**

“7...In respect of services for which the word “care” may be regarded as descriptive [the comments made in relation to section 3(1)(a) are repeated] gives the mark an identity that is perceptibly different from the sum of its parts.”

**3(1)(d)**

The comments in relation to section 3(1)(c) are repeated here.

5. Only Nestor filed evidence. Neither party asked to be heard; both parties filed written submissions in lieu of attendance at a hearing. I will refer to these written submissions as necessary below.

**EVIDENCE**

6. This consists of a witness statement, dated 8 July 2011, from David Carruthers, Nestor’s Group Solicitor. Mr Carruthers states that the term CARE is a non-distinctive generic word used in ordinary language to identify the act of caring for someone or something. He says that it has become an ordinary name for services provided by individuals or bodies to others and among other things identifies services provided in the care of the elderly, infirm, disabled, young or vulnerable. He adds that it also identifies services provided to others in respect of maintaining physical items and keeping machinery working. He concludes that the term is wide ranging, non-distinctive and descriptive in relation to services concerning the care of others and in relation to goods or services associated with such care. Exhibit DC1 consists of extracts from *The Oxford Dictionary of English* (2006), *The New Collins Concise English Dictionary* (1985)

and the results of a Google® search conducted on 27 June 2011, all of which provide definitions of the word CARE with which, I am sure, the average consumer would be familiar.

7. Mr Carruthers describes exhibit DC2 to his statement as:

“3...a large number of extracts taken from the Internet showing the term CARE in use by a wide variety of different parties to describe services and goods relating to the care of others.”

8. This exhibit, which consists of pages downloaded on 27 June 2011 from a range of United Kingdom websites, shows the word CARE being used in an entirely predictable manner in the context of the care of individuals. Mr Carruthers draws particular attention to the extract taken from [www.cqc.org.uk](http://www.cqc.org.uk) which is the website of The Care Quality Commission which he says:

“...specifically refers to CARE in the manner I have indicated.”

9. The following are typical examples of how the word CARE is used by the CQC:

“We are the independent regulator of health and social care in England”:

“We regulate care....We aim to make sure better care is provided for everyone – in hospitals, care homes...”

“New care standards.”

“...to help us improve care services.”

“Primary dental care providers.”

“Adult social care services...care at home...”

“Health care services...”

10. Mr Carruthers describes exhibit DC3 as:

“...various leaflets and booklets showing use of care...”

11. Once again this exhibit contains a number of documents originating in the United Kingdom which use the word CARE in a manner with which the average consumer would be very familiar i.e. “*Home Care Client Information Booklet*”, “*Developing Care Standards for Regulated Services*”, “*Quality Standards for Domiciliary Care*”, “*Effective Care Co-ordination in Mental Health Services*”, “*Your Stay in Intensive Care*”, “*Leukaemia Care*” and “*London Metropolitan Archives In-care and adoption files: Guidelines for Councillors*”.

12. Mr Carruthers concludes his statement in the following terms:

“4. ..This “from the consortium” is an entirely vague phrase which is merely directing the public to the idea that this particular care originates from some kind of consortium. However, given that “the consortium” could mean any consortium it does not serve to distinguish the supplier of [services] under this mark from any other. The word “care” itself is represented in ordinary lower case lettering in an everyday script. The mark will not be recognised as anything more than the words “care from the consortium” by the public.”

13. That concludes my summary of the evidence filed to the extent that I consider it necessary.

## **DECISION**

14. The opposition was originally based upon sections 3(1)(a), (b) and (c) of the Act (in relation to all the opposed services), and under section 3(1)(d) of the Act (insofar as the services in class 44 were concerned). However, in its submissions Nestor withdrew its objection based upon section 3(1)(a) of the Act.

Sections 3(1), (b), (c) and (d) of the Act state:

“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) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

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.”

15. In its submissions CPD said, inter alia:

“2. [CPD] does not contest that the word “care” is somewhat descriptive of some of the services being provided by [them]. However, [CPD] is not seeking to

register the word “care”. The mark the subject of this application is appreciably more than this.

3. The rights being sought by [CPD] are in respect of how the mark appears as a whole and in respect of its distinctive elements. If called upon to judge the trade mark in any contentious situation, both the Registry and the relevant Courts would be required to implement the jurisprudence for comparing signs and give suitable weight to the dominant and distinctive features of the mark. It is submitted that the dominant and distinctive features include the stylised “a” and the wording “The Consortium”.

4. [CPD] are not seeking to monopolise the word “care” in respect of the goods and services applied for, nor would the registration of its mark give it such a monopoly. [CPD] fully understands that a trade mark application for the word “care” would have attracted the appropriate objections.

6. Finally, for completeness, [CPD] observes that the word “Care” is not descriptive for all of the goods and services applied.”

### **The average consumer of the opposed services**

16. In its submissions Nestor said:

“8. The distinctive character of the mark must be assessed in relation to the goods and services covered by the mark taking account of the relevant public’s perception at the point at which the application was filed. Insofar as classes 41 and 44 are concerned the relevant public in this case is made up of the ordinary member of the public who seeks to obtain the service designated. Insofar as class 35 is concerned the relevant public includes both ordinary members of the public and businesses.”

17. In its submissions Nestor argues that the average consumer of the services in classes 41 and 44 would be a member of the general public, whereas the average consumer of the services in class 35 would be a member of the general public or a business. Broadly speaking, I agree. While many of the services in class 35 are more likely to be directed at businesses than a member of the general public, equally I see no reason why a member of the general public may not wish to avail themselves of, for example, the various rental services mentioned in CPD’s application. In short, I intend to proceed on the basis that the average consumer of all the opposed services would be a member of the general public who would be reasonably well informed, observant and circumspect, but I will keep in mind that some of the services are more likely to be used by a business.

## The objection based upon section 3(1)(d) of the Act

### The Law

18. In *Telefon & Buch Verlagsgesellschaft mbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-322/03, the General Court (GC) stated:

“49 Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50 With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51 Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).”

19. This ground of opposition is only directed at the services contained in the class 44 element of CPD’s application i.e.

Medical services; veterinarian services; hygienic and beauty care for human beings or animals; consultancy and advisory services relating to agriculture, horticulture and forestry; providing information and advice relating to any of the aforesaid services.

20. In its submissions Nestor said:

“15. The evidence provided by [Nestor] has shown that the word CARE is used by multiple and numerous suppliers of care services in a wide range of



environments. This is of course everyday knowledge and will be within the everyday knowledge of the Hearing Officer even without the benefit of the evidence filed. The dominant element of this mark is the word CARE which is shown in the evidence to be customary in the current language and in the bona fide practices of the trade. Exhibits DC2 and DC3 show that care is customary in the current language and bona fide practices of the trade. The additional words are equally non-distinctive...”

21. In order for Nestor’s objection based upon 3(1)(d) of the Act to succeed, it must establish that at the relevant date in these proceedings (i.e. the date of CPD’s application for registration), the average consumer would have considered CPD’s trade marks to consist exclusively of signs or indications which had become customary in the current language or in the bona fide and established practices of the trade. In *Stash Limited v Samurai Sportswear Ltd* (BL O/281/04) Professor Annand, sitting as the appointed person, stated:

“33. In the event, I do not believe this issue of the interpretation of section 3(1)(d) is central to the outcome of the appeal. “Customary” is defined in the Oxford English Reference Dictionary, 1995 as: “usual; in accordance with custom”. In my judgment, the Opponent has failed on the evidence to prove that at the relevant date STASH contravened section 3(1)(d) as consisting exclusively of signs or indications which have become customary either in the current language or in trade practices for the goods concerned.”

22. I agree with the point made by Nestor in its submissions to the effect that the descriptive meaning of the word CARE (in the context of the services at issue in class 44) would be well known to the average consumer and that the evidence provided by them puts the matter beyond any doubt. In fact, in its submissions CPD appear to accept as much when it explains that it understand that an application to register the word CARE alone would, in its words, “have attracted appropriate objections”. However, in order to engage section 3(1)(d) of the Act CPD’s trade marks must consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade. Nestor has not provided any evidence in these proceedings which establishes that at the relevant date the trade marks in the form in which they appear in CPD’s application had become customary in the current language or in the bona fide and established practices of the trade. In the absence of appropriate evidence, Nestor’s objection based upon section 3(1)(d) of the Act directed against the services in class 44 of CPD’s application cannot succeed and is dismissed.

## **The objections based upon sections 3(1)(b) & (c) of the Act**

### **The Law**

23. In *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* the CJEU said in relation to article 3 of the regulation, the equivalent of section 3(1)(c) of the Act:

“54 As the Court has already held ( Windsurfing Chiemsee , para.[25], Linde, para.[73], and Libertel , para.[52]), Art.3(1)(c) of the Directive pursues an aim which is in the public interest, namely that such signs or indications may be freely used by all. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

55 That public interest requires that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods. Therefore, marks consisting exclusively of such signs or indications are not eligible for registration unless Art.3(3) of the Directive applies.

56 In those circumstances, the competent authority must, under Art.3(1)(c) of the Directive, determine whether a trade mark for which registration is sought currently represents, in the mind of the relevant class of persons, a description of the characteristics of the goods or services concerned or whether it is reasonable to assume that that might be the case in the future (see to that effect Windsurfing Chiemsee , para.[31]). If, at the end of that assessment, the competent authority reaches the conclusion that that is the case, it must refuse, on the basis of that provision, to register the mark.

57 It is irrelevant whether there are other, more usual, signs or indications for designating the same characteristics of the goods or services referred to in the application for registration than those of which the mark concerned consists. Although Art.3(1)(c) of the Directive provides that, if the ground for refusal set out there is to apply, the mark must consist exclusively of signs or indications which may serve to designate characteristics of the goods or services concerned, it does not require that those signs or indications should be the only way of designating such characteristics.

58 Similarly, whether the number of competitors who may have an interest in using the signs or indications of which the mark consists is large or small is not decisive. Any operator at present offering, as well as any operator who might in the future offer, goods or services which compete with those in respect of which registration is sought must be able freely to use the signs or indications which may serve to describe characteristics of its goods or services.”

24. In *BioID AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-37/03 P the CJEU stated that for a term to be viewed as being descriptive of a characteristic of goods and services:

“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).”

25. In *Combi Steam Trade Mark* (BL O/363/09) the Appointed Person commented on section 3(1)(b) of the Act in the following terms:

“7. 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): *Case C-363/99 Koninklijke KPN Nederland BV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] ETMR 57 (ECJ) at [86]. However, the converse is not true: a mark which is not descriptive may nevertheless be devoid of distinctive character for other reasons (*ibid.*).

8. When a trade marks examiner assesses the distinctiveness of a trade mark within the meaning of section 3(1)(b), s/he must do so firstly by reference to the goods or services listed in the specification, and secondly by reference to the perception of the mark in relation to such goods or services by the relevant public, which consists of average consumers of the goods or services in question, who are deemed to be reasonably well informed, observant and circumspect: *Joined Cases C-53/01 to C- 55/01 Linde AG, Winward Industries Inc and Radio Uhren AG* [2003] ETMR 78 at [41].

9. It is not necessary to show that a mark has a particular level of creativity or originality in order to establish distinctive character: *Case C-329/02P SAT.1 Satelliten Fernsehen GmbH v OHIM* [2005] ETMR 20 (ECJ) at [41]. While the Court of First Instance (“CFI”) has repeatedly referred to “a minimum degree of distinctive character” as being sufficient to avoid article 7(1)(b) of the CTMR/article 3(1)(b) of the Directive (for example, *Case T-34/00 Eurocool Logistik GmbH & Co. KG v OHIM (“EUROCOOL”)* [2003] ETMR 4 at [39]; *Case T-128/01 Daimler Chrysler Corp v OHIM* [2003] ETMR 87 at [33]; *Case T-320/03 Citicorp v OHIM (“LIVE RICHLY”)* at [68]), the ECJ has not adopted this wording and has deemed it unnecessary to give any more precise definition to the possible dividing line between lack of distinctiveness and the minimum distinctiveness to which the CFI refers: *Deutsche Krankenversicherung AG v OHIM (“COMPANYLINE”)* [2002] ECR I-7561 at [20].

10. The ECJ approaches the issue of distinctiveness by reference to the underlying purpose of article 3(1)(b) of the Directive/7(1)(b) CTMR, which in the

Court's view is to preclude registration of trade marks that are incapable of performing the essential function of guaranteeing the identity of the origin of the marked product 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: SAT.1 v OHIM at [23]; Case C-37/03 P BioID AG v OHIM [2005] ECR I-7975 (ECJ) at [27]."

26. The case law indicates that to fall foul of section 3(1)(c) of the Act there must be a "sufficiently direct and specific relationship" between [CPD's trade marks] and the [opposed services] "to enable the public concerned immediately to perceive, without further thought, a description of the services in question or one of their characteristics".

27. In *BioID* the CJEU said in relation to article 7(1)(b) of the regulation:

"29 Thirdly, as regards a compound mark, such as that which forms the subject-matter of the present dispute, any distinctive character may be assessed, in part, in respect of each of the terms or elements, taken separately, but that assessment must, in any event, be based on the overall perception of that trade mark by the relevant public and not on the presumption that elements individually devoid of distinctive character cannot, on being combined, present such character (see SAT.1 v OHIM, cited above, paragraph 35). The mere fact that each of those elements, considered separately, is devoid of distinctive character does not mean that their combination cannot present such character (see, by way of analogy, Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-1619, paragraphs 99 and 100, Case C-265/00 Campina Melkunie [2004] ECR I-1699, paragraphs 40 and 41, as well as SAT.1 v OHIM, cited above, paragraph 28)."

28. In its submissions in relation to its opposition based upon section 3(1)(b) of the Act, Nestor said:

"9. If the words comprised with in a device mark are devoid of distinctive character the mark as a whole must be held to be devoid of distinctive character unless the figurative or graphic elements are sufficient to make the mark distinctive. If the overall impression of the mark is devoid of distinctive character for the relevant public it will be incapable of performing the essential function of a trade mark..."

10. In this case the mark is devoid of distinctive character because it describes the services at issue or an essential characteristic of those services. In the alternative, to the extent that the mark is not directly descriptive it is comprised of banal ordinary words which will be perceived as non-distinctive matter by the relevant consumer and which will therefore fail to indicate origin. Additional features of the mark do not add sufficient surplus such that the mark as a whole is distinctive."

29. In its submissions in relation to its opposition based upon sections 3(1)(b) and (c) of the Act, Nestor said, inter alia:

“11. The word CARE describes any services associated with the provision of care for persons, animals, or for agriculture, horticulture, forestry or the environment i.e. all services in class 44. The word CARE also describes education, training and information services provided in relation to care, whether of persons, animals, agriculture, horticulture, forestry or the environment i.e. all services in class 41. Insofar as business services in class 35 are concerned, in class 35 the word CARE describes services provided in relation to care of persons, animals, agriculture, horticulture forestry or the environment, and the nature of the service i.e. that the provider takes care in arranging and providing the services identified in class 35. The word CARE is non-distinctive in relation to all opposed services and any services associated with care, taking care, providing care or providing services in relation to care, taking care or providing care.

12. The words FROM THE CONSORTIUM are a vague non-distinctive phrase which conveys simply that the care is provided by a consortium. CONSORTIUM is a non-distinctive general term and does not add distinctive character to the mark as a whole. CARE FROM THE CONSORTIUM is equivalent to CAKE FROM THE SHOP or CAKE FROM THE SUPERMARKET. It identifies what is provided i.e. care and where it comes from i.e. the consortium in a completely non-specific manner using terms which apply to CARE provided by any consortium....The inclusion of the definite article THE before CONSORTIUM does not define a specific consortium. The relevant consumer will perceive the mark as a whole as a non-distinctive term.

13. The word Care, in linguistic terms, started life as a verb but the evidence shows that the term has developed a further meaning as the name of caring services of whatever kind. See for example...showing dictionary reference defining care as “the provision of what is necessary for the health, welfare, maintenance and protection for someone or something” and “serious attention or consideration applied to doing something correctly or to avoid damage or risk.”

14. The mark is descriptive because in normal usage it conveys to the public an indication of the service provided to the public; other providers must be free to use the word CARE and the words FROM THE CONSORTIUM to indicate care services from another consortium other than the applicant..”

30. In relation to what it describes as “Added Surplus” Nestor said:

“16. The word elements of the mark fail the test for registration under sections 3(1)(b)(c) and (d) of the Act. The Hearing Officer should therefore consider whether the layout and stylisation of the mark is sufficient to justify registration of the mark as a whole. The remaining elements of the mark other than the non-

distinctive words are the colour of the word CARE in the first mark in the series; the layout of the mark and the minor indentation in the centre of the letter A of the word CARE.”

31. Having referred to a wide range of judgments from the United Kingdom and Europe, Nestor concludes:

“19. Essentially the required surplus has been considered in a long line of cases in Europe and the UK and it is established that minor embellishments to representations of words, standard layouts, use of colours and variations in font are simply inadequate to turn a descriptive, generic or non-distinctive mark into a distinctive mark.”

32. CPD have applied for a series of two trade marks. In the first trade mark in the series the word “care” is shown in pink/purple and the words “from The Consortium” are shown in a normal typeface in blue with the letters T and C capitalised; the second trade mark in the series is shown in black and white. In both versions of the trade mark the void that would normally appear in the letter “a” is formed by the shape of a heart. In its submissions CPD argues that the dominant and distinctive features of its trade marks include, inter alia, “the stylised a”. Although the word “care” (in the form I have described above) is by far the largest element of the trade marks, the wording which appears beneath this word will not be overlooked. As I mentioned above Nestor argues that the word care:

“describes any services associated with the provision of care for persons, animals, or for agriculture, horticulture, forestry or the environment i.e. all services in class 44. The word CARE also describes education, training and information services provided in relation to care, whether of persons, animals, agriculture, horticulture, forestry or the environment i.e. all services in class 41. Insofar as business services in class 35 are concerned, in class 35 the word CARE describes services provided in relation to care of persons, animals, agriculture, horticulture forestry or the environment, and the nature of the service i.e. that the provider takes care in arranging and providing the services identified in class 35. The word CARE is non-distinctive in relation to all opposed services and any services associated with care, taking care, providing care or providing services in relation to care, taking care or providing care.”

33. In its written submissions CPD accept that “... the word care is somewhat descriptive of some of the services being provided by them” adding that they are “not seeking to monopolise the word care in respect of the goods and services applied for”. In my view, CPD’s approach to the word “care” (absent stylisation) is a realistic one. As the evidence shows, the word care (absent stylisation) has a range of meanings all of which would be well known to the average consumer and which, in my view (and it appears CPD’s view also) are likely to be considered either descriptive of or non-distinctive for the opposed services. Having reached that conclusion on the word care absent stylisation, does the colour in which the word “care” is presented in the first trade

mark in the series and the shaping of the void of the letter “a” assist CPD? As Nestor points out, the case law indicates that as it is commonplace for traders to present words in a variety of colours presenting an otherwise descriptive/non-distinctive word in colour is unlikely to lend it any distinctiveness. What then of the heart shape? The heart shape which appears in the letter “a” of the word “care” was immediately apparent to me when I was first exposed to CPD’s trade marks. As the average consumer is considered to be, inter alia, observant, I suspect that may also be the case for many average consumers. That said, I am prepared to accept that for some average consumers the heart shape may go largely unnoticed. In summary, while the colour in which the word “care” is presented in the first trade mark in the series do not lend the word any distinctive character, the presence of the heart shape which, in my view, will be noticed by a not insubstantial number of average consumers (and which I accept may loosely allude to care and caring) does, in my view, add a degree of distinctive character to the word overall, albeit I accept to only a very limited degree.

34. Turning now to the words “from The Consortium”, *The Oxford Dictionary of English* 2010 defines consortium as meaning, inter alia, “an association, typically of several companies.” Whilst, in its counterstatement, CPD say that they are well known as The Consortium and enjoy goodwill and reputation in this name, no evidence has been provided to support this contention. Absent use, it appears to me that whether presented in blue or black and white the words “from The Consortium” would be seen by the average consumer as descriptive/non-distinctive wording indicating that something (in this case services) are provided by an association of businesses.

35. Having reached those conclusions on the individual elements of CPD’s trade marks, I must now go on and assess the overall impression the trade marks create. In *Campina Melkunie BV and Benelux-Merkenbureau* (C-265/00) the CJEU said:

“39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.”

36. In *Flying Scotsman* O-313-11 the Appointed Person said:

“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 registerability 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).”

37. The Appointed Person dealt with section 3(1)(b) of the Act first. Having found the mark under consideration to be free from objection under section 3(1)(b) of the Act, this excluded the possibility of refusal under section 3(1)(c); I shall adopt a similar approach.

38. While it is clear from the comments of the CJEU in *Campina* that as a general rule combining elements each of which are descriptive is unlikely to create a distinctive totality, it is equally clear from the court’s comments in *Bio/D* (by reference to the comments in *SAT1*) that a trade mark’s distinctive character must be based upon the average consumer’s overall perception of it and not on the presumption that elements individually devoid of distinctive character cannot, on being combined, present such character.

39. Consisting as it does of the dominant element of CPD’s trade marks, it is the word “care” (in the form in which it appears above) which is likely, in my view, to be the element which first catches the average consumer’s attention. While Nestor argues, and CPD appear to agree (as do I) that the word care alone would be descriptive and devoid of distinctive character for the opposed services, and while the colours in which the first trade mark in the series is presented do not assist CPD, in my view, the heart shape which appears in the letter “a” of the word “care” would be noticed by a not insubstantial number of average consumers and as a consequence lends the word (in the form applied for) a limited degree of distinctive character. Earlier I found that the words “from The Consortium” were descriptive and non-distinctive and that the form in which they were presented and the colour present in the first trade mark in the series did not lend the words any distinctive character. Having reached those conclusions on the individual elements of the trade marks, I must now go on and assess the likely reaction of the average consumer to the totality of the trade marks.



40. Returning to the comments in *Campina*, I note that the court commented that even if a trade mark consists of a combination of otherwise descriptive elements, it may still escape objection if it introduces something more, for example, as to syntax or meaning. While I accept that the individual elements “care” (absent stylisation) and “from The Consortium” may, when considered separately be open to objection, when placed together I think they create a totality which the average consumer would struggle to interpret without considerable further thought and analysis. The imprecise message the totality of CPD’s trade marks are likely, in my view, to convey to the average consumer, combined with the limited degree of distinctiveness the heart shape appearing in the void of the letter “a” in the word “care” lends to the trade marks as a whole, is, in my view, just sufficient for CPD’s trade marks to avoid objection under section 3(1)(b) of the Act. As the trade marks are distinctive for the purposes of this section of the Act, applying the rationale of the Appointed Person in *Flying Scotsman*, they cannot be considered objectionable under section 3(1)(c) of the Act.

### **Conclusion**

41. Nestor’s opposition based upon sections 3(1)(b) and (c) of the Act in relation to all the opposed services has failed as has its opposition based upon section 3(1)(d) of the Act in relation to the services in class 44.

### **Costs**

42. CPD has been successful and is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide, I award costs to CPD on the following basis:

Preparing a statement and considering Nestor’s statement:	£300
Considering Nestor’s evidence:	£300
Written submissions:	£100
<b>Total</b>	<b>£700</b>

43. I order Nestor Healthcare Group Plc to pay to The Consortium for Purchasing and Distribution Limited the sum of **£700**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16<sup>th</sup> day of February 2012**

**C J BOWEN**  
**For the Registrar**  
**The Comptroller-General**