

O-792-18

INTERIM DECISION

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3242204 BY
EMERGENCY RESPONSE DRIVER TRAINING LTD
TO REGISTER:**

ERDT

AS A TRADE MARK IN CLASS 41

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 410521
BY
EMERGENCY SERVICES TRAINING AND RESILIENCE LIMITED**

BACKGROUND & PLEADINGS

1. On 7 July 2017, Emergency Response Driver Training Ltd (“the applicant”) applied to register **ERDT** as a trade mark. The application was published for opposition purposes on 21 July 2017 for the following services:

Class 41 - Education and training consultancy; Education and training services; Training consultancy; Driver training; Driving instruction.

2. On 13 October 2017, the application was opposed in full by Emergency Services Training and Resilience Limited (“the opponent”) under sections 3(1)(b) and (c) of the Trade Marks Act 1994 (“the Act”). In its Notice of opposition, the opponent states that ERDT is devoid of any distinctive character under section 3(1)(b) of the Act because it:

“would be commonly recognised by the relevant public as a descriptive abbreviation of “emergency response driver training”, a term that is well used within the emergency training services industry...ERDT is a description of a service which could equally apply to any undertaking in the field, in that all emergency response driver training providers use the term ERDT as the commonly understood abbreviation of “emergency response driver training.”

3. In relation to its objection based upon section 3(1)(c) of the Act, it further states that ERDT is:

“used to exclusively describe/designate the kind of services offered by the applicant. The applicant’s services applied for relate to training services concerning emergency response drivers; this is the literal derivation of the abbreviation “ERDT” and the commonly understood phrase “emergency response driver training”. It is the opponent’s belief that the relevant public will recognise “ERDT” and “emergency response driver training” as a description of

the kind of services offered and should therefore be free to use by all traders providing such services and not be monopolised by any one undertaking”

4. The applicant filed a counterstatement which consists, in essence, of a denial of the grounds upon which the opposition is based.

5. Both parties filed evidence accompanied by written submissions. While neither party asked to be heard, the applicant filed written submissions in lieu of attendance at a hearing. In reaching a decision, I shall keep all of these submissions in mind, referring to them to the extent I consider it necessary.

EVIDENCE

The opponent’s evidence

6. This consists of three witness statements. The first, is from Steve Curley, the opponent’s Director of Training Services. Mr Curley explains that he has held this position since May 2012 and is:

“2...personally responsible for the development of driver training internally and consulting with external parties including fire authorities, to support existing training programmes.”

7. He states that he has also been the Managing Director at Roadcraft ERDT since 2016, adding that he has:

“4...been involved in the training within the emergency services since January 1982, where [he] began [his] career as an operational firefighter before moving to Transport Training Manager at the London Fire Brigade in 2004...”

8. Mr Curley states:

“5. ERDT is the well-known acronym within the industry that is used to refer to the generic training needed for emergency service drivers. It is synonymous with Emergency Response Driver Training. This type of training chiefly includes ambulances, fire engines, police cars and motorbikes. Service members who drive vehicles of this nature require ERDT as mandatory training to ensure that their skills are up to the required standard within the profession. The reasoning for this is mainly due to the safety of the public, as well as the staff themselves.”

9. He states that the standardised use of ERDT resulted from the work of the Joint Emergency Services Group (“JESG”) which assisted the Department of Transport (“DOT”) to design and develop the “High-Speed Driver Training [“HSDT”] Codes of Practice”; Mr Curley was a member of that group. JESG was, he explains:

“7...made up of expert driver training providers and managers from each of the emergency services, whose goal was to establish a common minimum standard that could be recorded and evidenced in relation to the training of emergency response drivers”.

10. The Group’s aim was, he explains, to have an approved training programme that would meet the requirements of Section 19 of the Road Safety Act 2006. He states that although the JESG initially decided that the title of the Codes of Practice should be “High Speed Driver Training”, as it was felt that this title placed “an unwanted focus on the speed element...”, the Group decided a better title for the training programme was “Emergency Response Driver Training”. He explains that from this point:

“11...the three Emergency Services split from the main group to form smaller, more manageable groups that could use the core standards to develop their own, role related courses to meet their individual needs”.

11. Mr Curley explains that he worked closely with the Fire Services working party who represented the Chief Fire Officer's Association ("CFOA") to "produce a student performance recording methodology that reflected the learning outcomes identified by the HSDT Codes of Practice." Paperwork was, he states, produced in this regard which, he further states is "now in use across the UK by all Fire Rescue Services" and has been since 2008. Exhibit SC1, consists of the paperwork to which Mr Curley refers. It is entitled: "High Speed Training Quality Assurance – Code of Practice". On page 6 under the heading "Quality Assurance Strategy" and "Part 1: Overview", there appears the following:

"Why a Quality Assurance Strategy for Emergency Response Driver Training (ERDT)?"

The urgent, situation-driven nature of emergency response driving has long been recognised..."

12. The letters ERDT appear throughout the document which also, I note, includes, inter alia, the following "advanced driver training (ERDT)..." Mr Curley states:

"13. Members of the public cannot purchase these services individually, ERDT is generally provided from an employer as mandatory training to their staff."

13. He states that the opponent provides "numerous emergency response driver training services for organisations including the Ministry of Defence". Exhibit SC2, consists of an invoice dated 15 March 2016, issued by the opponent to EOD Aldershot in the amount of £9342.29. Under the heading "Description of services/goods supplied", there appears the following: "Emergency Response Driver Training (ERDT) 7th March 2016 – 11th March 2016." Mr Curley states that this description is used because "this is what would be understood by the customer of the services given". He adds that in the last seven years, the opponent has "provided in excess of £75,000 worth of ERDT to the Ministry of Defence alone..."

14. Exhibit SC3, consists of what Mr Curley describes as “a selection of job descriptions from within the industry...” These are as follows:

August 2015 – Driver Training Instructor at South Wales Fire and Recuse Service which includes:

“C. Large Goods Vehicle (LGV) and Light Vehicle (LV) Emergency Response Driver Training (ERDT)(dependant on grade):

1. To liaise with the Central Staffing department to coordinate and conduct training of Fire Service employees on all LV ERDT, LGV ERDT vehicles, PCVs, off road, trailer towing and all light vehicles.
2. To organise, coordinate and undertake initial and requalification training in LGV ERDT and LV ERDT driving skills. Ensuring that High Speed Driver Training (HSDT) records are collated and stored appropriately.
3. To represent the Service at Regional and National driver training seminars and workshops on ERDT Specialist vehicle and other driving issues.”

December 2017 (i.e. after the date of the application) – Norfolk Fire and Rescue Service – “Emergency Response Driver Trainer”.

March 2013 – Driver Training School Manager at Devon and Somerset Fire & Rescue Service which includes:

“17. Deliver all types of driver training and assessment in a variety of vehicles including Emergency Response Driver Training.”

Undated – Driving Instructor at Cheshire Fire & Rescue Service which includes, inter alia:

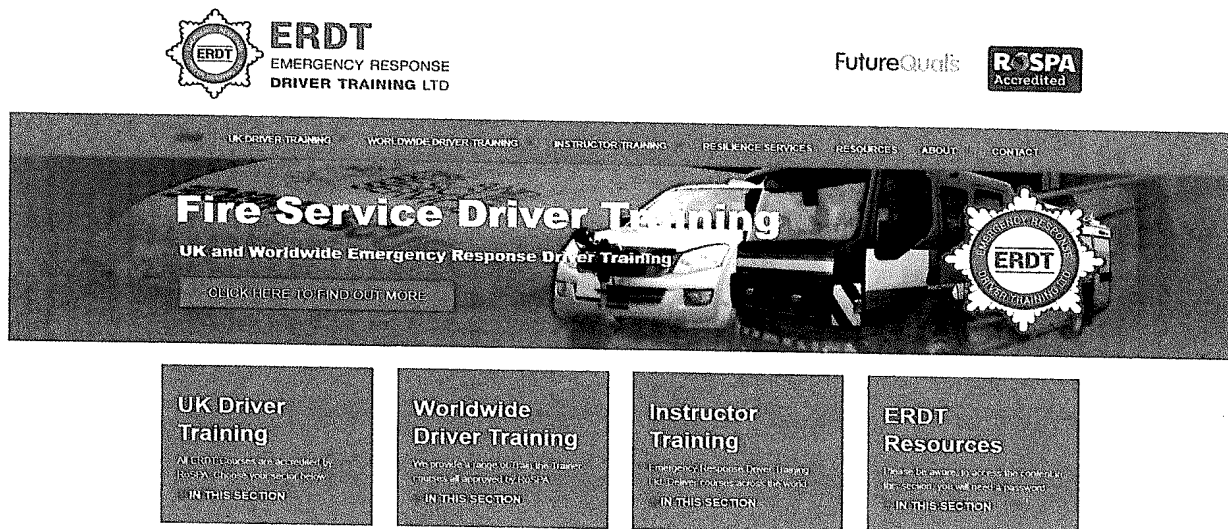
“2 Deliver Emergency Response Driver Training...”

March 2018 (i.e. after the date of the application) – Driving Instructor at Scottish Fire and Rescue Service. Under the heading “Desirable criteria” there appears the following: “Emergency Response Driving Instructor.”

15. Exhibit SC4, consists of what appears to be an undated page taken from the applicant’s website at www.emergencyresponsedrivertraining.co.uk. Of this page Mr Curley states:

“17. I have seen the applicant use ERDT descriptively, in direct reference to the training on their website....You can see that the company is offering services in relation to emergency response vehicles and the imagery used on the homepage revolves around this end consumer.”

16. The page provided looks like this:



17. Exhibit SC5, consists of what appears to be a further undated page from the applicant's website which, Mr Curley notes, includes the following:

"Please Note: Emergency response driver training courses using blue lights & sirens are not available to members of the public and any course enquiry must be submitted through your Emergency Service or organisation."

18. The second statement is from Trevor Neal, a Driver Trainer for the Leicestershire Fire and Rescue Service ("LFRS") and a representative of the CFOA. He explains that he has been involved in "the emergency response driver training" at LFRS since 2004 and has held the latter position since 2010.

19. Mr Neal explains that the LFRS is governed by the Combined Fire Authority and the CFOA is "a national association across all fire and rescue services who purpose is to promote the effectiveness of the service as a whole for the benefit of communities across the country". He states:

"5. I have a great deal of experience within the emergency service driver training and can confirm that ERDT is a recognised acronym within the industry for "Emergency Response Driver Training".

6. ERDT is a term that is not only well known amongst the emergency services industry but is a recognisable generic term that is an integral part of national paperwork that records driver's progress and is used across the UK fire and rescue services.

8. I am involved in the working group that oversees the development of the national framework and so have first hand knowledge of the development of the ERDT across the fire and rescue services of the UK.

9. The term ERDT in my opinion should not be exclusive to one party as it is used to describe a particular type of training within the emergency services profession.”

20. Exhibit NF1, consists of what Mr Neal describes as:

“7...the Record of Assessment used within national frameworks set out by the CFOA. This framework is the recognised methodology to record the progress of a candidate’s training.”

21. The document provided contains the following “Version 2.1 October 15” and contains a number of references to ERDT, the first of which reads as follows:

“ERDT ELEMENT 1.1 Demonstrate basic driving skills”.

22. The third and final statement comes from Roy Dearnley, the Chairman of the Blue Light Training Providers Association (“BLTPA”) which, he explains, is “an overarching independent body within the industry” which was formed “to ensure members providing emergency response driver training are properly represented at discussions with the Department for Transport”. He explains he has been involved in the “emergency response driver training industry” since 1980. He has, he states, “instructed many emergency drivers”. Mr Dearnley is a member of the Institute of Health and Care development (“IHCD”) and was, inter alia, involved in the training of Clinical and Driving Tutors. He explains that he has had:

“4...extensive involvement in the creation of a harmonised framework in emergency driver training and co-authored the IHCD “Gold Folder” in 1994, which was the standard handbook for all tutors within the Ambulance Service and beyond.”

23. In 1995 whilst at the IHCD, he became the Regional Manager of the Ambulance Service Awards, a role he still performs, albeit on a part-time basis. More recently, he headed the Driving Department at Yorkshire Ambulance Service NHS Trust until his retirement in 2016. He was a member of the Driver Training Advisory Group (“DTAG”) from 2008 and attended the Blue Light User Group meetings; it was here that he introduced the Level 2 and 3 Driving awards currently being offered by FutureQuals. He states:

“7. The emergency response driver training industry is a restricted industry, with training being a mandatory requirement for drivers within the profession.

8. I recognise ERDT (or ERD training) as being the acronym of Emergency Response Driver Training used within the emergency services. This term is a general term used between providers and users across the national framework.

10. The term has been in common use throughout the 38 years I have been involved in the industry.

11. The term ERDT is a general phrase that is commonly used and should be kept free to use by the industry.”

24. Exhibit RD1, consists of what Mr Dearnley describes as “a trainer letter written by myself to advertise the BLTPA to new emergency response driver trainers”. The draft, undated letter provided contains the following:

“...the ongoing development of Emergency Response Driver trainers...”

“...membership is exclusively for those delivering ERDT...”

“...related to ERD training...evidence of ERD Training delivered...”

25. Mr Dearnley states that his letter includes the above because:

“9...the trainers would understand these general terms as relating to the type of training we are focused on.”

The applicant's evidence

26. This consists of a witness statement from Stephen Milton, the applicant's Managing Director, a position he has held since 2012. Mr Milton explains that he has over twenty years' experience “delivering driver and instructor training and support and resilience services”. He states that this has included work for over 78 Emergency services and organisations. From 1998 to 2012, he was the Senior Driving instructor with Strathclyde Fire and Rescue and was, he states “instrumental in writing [that organisation's] driver training manual”. He states he was involved at national level “with a driver and instructor training response to Section 19 of the UK Road Traffic Act.” He states that he has:

“6...developed a comprehensive emergency response driver and instructor training programme...”

27. He further states that the applicant is the first company to be accredited by the Royal Society for the prevention of Accidents (“RoSPA”) as:

“6...a training body for emergency response driver and instructor training and the only company authorised to offer a National and International Diploma in Emergency Response Driving Instruction accredited by RoSPA.”

28. Mr Milton explains the applicant's customers include the emergency services, blue light users, security services, the United Nations and the general public. He states that the applicant offers 29 different courses to its customers. Of these 29 courses, Mr Milton states that “16 are emergency response high speed driving courses”. Other courses include: security protection defensive driving, armoured vehicle defensive driving,

defensive and advanced driving, 4x4 and 6x6 off-road driving, floodwater driving and train the trainer on all the applicant's courses. Mr Milton states:

"9. The public that are looking to source one of the 13 non-emergency driving courses we offer would have no knowledge of any potential link between ERDT and the emergency services".

29. Mr Milton then reviews the letters ERDT by reference to the various emergency services in the United Kingdom, stating:

"10...The term ERDT is not used in any of the UK College of Policing Driving Standards..."

30. In support, he provides what appears to be undated exhibit SM1, entitled "Police driving training governance" and a reference to a website, i.e.

<https://www.app.college.police.uk/>. As far as I can tell, the letters ERDT are not mentioned in exhibit SM1.

31. Mr Milton states:

"10...The UK Fire & Rescue Service is the only Statutory Emergency Service that does not have a nationally delivered emergency driving course or a nationally recognised course title or course reviewing method."

32. He further states that:

"10...The term ERDT is not used at all in the London Fire Brigade 2014-2015 course guide...which runs to 280 pages."

33. In relation to the Scottish Fire & Rescue Service, he states:

“10...When conducting a Fire Service Emergency Response Driving course, they record the driver’s evidence of competency in a driver development portfolio, each element is recorded as Emergency Response Driving (ERD) 1.1 – 1.2 etc., not ERDT.”

34. In relation to the Defence Fire Service (DFRMO) who, he explains, “delivers fire and rescue capability to the MOD”, he states:

“10...The Emergency Response Driver (ERD) Course is designed to teach selected firefighters, employed on the MOD Estate the skills necessary to safely drive a fire appliance.”

35. Exhibit SM2, which contains a reference to “Issue 5 (Oct15)”, entitled “Emergency Response Driver (Appliance) Course – Course Information”, is provided in support.

36. In relation to Essex Fire & Rescue Service, he states:

“10...Emergency Response Driving (formerly EFAD) skills are acquired by means of a 9 day course, they do not use ERDT to describe Emergency driving at all in the Essex-EFAD-Course-document which runs to 112 pages.”

37. Exhibit SM3, consists of a 36 page document from August 2009 entitled “Generic Risk Assessment 1.1 – Emergency response and arrival at the scene” issued by CFRA – Chief Fire & Recuse Adviser. As far as I can tell, the document does not contain any references to ERDT.

38. In relation to the Ambulance service, Mr Milton states:

“The IHCD suite of driving courses which were available from the 1970s to 2015 comprised modules non-emergency Ambulance Driving (D1) and Ambulance Emergency Driving (D2). These courses were used between the late 1970s and 2015 by every NHS Ambulance Service.”

39. Exhibit SM4, consists of an undated page (but which refers to “Course dates in July and September 2011”) which, Mr Milton states, relates to the opponent’s ambulance driving course which, he notes, does not refer to ERDT. It does, I note, refer to: “IHCD accredited ambulance driver training (D1 & D2)”.

40. From 2016, the ambulance service has, he states, operated by reference to the FutureQuals Level 3 Certificate in “Emergency Response Ambulance Driving”, a copy of which from, it appears, March 2018, is provided as exhibit SM5. Mr Milton states that:

“10...The term ERDT is not used in any of the FutureQuals qualification specification...”

41. Mr Milton also refers to a website, i.e. <https://www.futurequals.com>. As far as I can tell, exhibit SM5 contains no reference to ERDT.

42. Mr Milton states:

“11. I have contacted a wide range of people holding senior positions in the emergency services to find out if they are familiar with the use of the Mark other than in relation to ERDT [i.e. the applicant]...These emails make it clear that people involved in the emergency services regard the Mark as only applying to ERDT [i.e. the applicant] and not to the type of services they purchase. “

43. Exhibit SM6, consists of twenty one responses to the approach made by the applicant to the individuals concerned. The following response (no. 2 of 21), from the Training & Compliance Manager at Aberdeen International Airport, is typical:

“I Darren Sutherland can confirm that I require “**emergency response driver training**” “blue light driver training” or “EFAD driver training” from time to time. “ERDT” is not a term in general use to identify this kind of training. In my opinion “ERDT” only applies to the services provided by [the applicant]. “ERDT” is not used by me or to the best of my knowledge by anyone else except to refer to the services provided [by the applicant]”.

44. In an official letter dated 14 June 2018, the Tribunal reacted to the filing of this exhibit stating:

“Exhibit SM6 to the above witness statement is hearsay evidence. The weight afforded to this evidence will be a matter for the Hearing Officer when the final determination is made. The Registry has considered Tribunal Practice Notice 5/2009 in reaching this view.”

I shall return to this evidence later in this decision.

45. Mr Milton provides a number of observations on the evidence of Mr Curley, explaining that he was also a member of the working group to which Mr Curley refers. Exhibit SM7, consists of a Working Group Report dated 2008 (“4/08/2008”) produced by the JESG entitled “High Speed Training” and which bears the wording “DRAFT Confidential”. I note that paragraph 2 on page 10 begins:

“It must be stressed that this is the minimum necessary for any emergency response driver to exceed a limit safely...”

46. Specifically, Mr Milton states: (i) Section 19 of the Road Safety Act 2006 “has not been implemented in Law and is still a draft document”, (ii) the JESG “was dissolved and the documents they formulated have not become a statutory requirement”, and (iii) the HSDT Codes of Practice 2008 “is still a draft document and has not been implemented as a statutory requirement”.

47. In relation to Mr Curley’s comment to the effect that the JESG changed the name of the training programme to “Emergency Response Driver Training”, Mr Milton states:

“17...This is an unsubstantiated claim...and the Draft High Speed Driver Training Codes of Practice 2008 is still titled High Speed Training and the driver competencies are listed as High Speed Driver Training (HSDT) 1.1-1.2 etc.”

48. Exhibit SM8, consists of a copy of the JESG’s “Codes of Practice – Driver Development” from 2008 (“4/30/2008”). It bears the title “High Speed Driver Competency and Training” and is marked “DRAFT Confidential”. I note the fourth bullet point under the heading “Overview” reads:

“**High Speed Assessor Competency** – not compulsory but available should any training body prefer to train and use experienced emergency response drivers to assess others competencies and identify training needs”.

Page 3 contains the following:

“...They will also provide the basis for the practical and theoretical assessment of Emergency Response Drivers...”

49. In relation to the evidence of Mr Dearnley, Mr Milton states that:

“19...the BLTPA is owned by the same owner as [the opponent] Mr Peter Huddleston who holds, directly or indirectly, 75% or more of the voting rights of

[the opponent] and BLTPA. BLTPA is also registered at the same address as [the opponent]. [He] has also personally witnessed at the National Blue Light Users Conference 2017 Mr Steve Curley [of the opponent] managing BLTPA trade stand. These facts make it clear [to him] that this is not an independent witness statement.”

50. Given his background, Mr Milton states that Mr Dearnley should be aware that “since the 1970s the Ambulance Service have never used the term ERDT to describe Ambulance emergency driving”, adding that there is no mention of ERDT on the BLTPA’s website, i.e. <https://bltpa.com/>.

51. Exhibit SM9, consists of an email dated 25 May 2018 from Sally Watson (who is a PA to the directors of the LFRS) addressed to “Malcom Jones;mail@erdt.co.uk”. The relevant part of the email, which is headed “Trevor Neal and Leicestershire Fire and Rescue” reads as follows:

“After liaising with the Chief Fire Officer, I can advise that the statement by Trevor Neal is a personal statement only.”

52. As to the exhibit to Mr Neal’s statement, Mr Milton states:

“23...this document is a driver training record only which is not used by the UK’s largest Fire Services and is not used by the Police or Ambulance Service.”

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

DECISION

54. The opposition is based upon sections 3(1)(b) and (c) of the Act which 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.”

55. Although the applicant has filed evidence in these proceedings, as none of that evidence relates to any use it may have made of the trade mark the subject of the application, it is not able to benefit from the proviso to section 3(1) of the Act; I have, as a consequence, only the inherent characteristics of its trade mark to consider.

56. I begin by reminding myself that as the Court of Justice of the European Union (“CJEU”) pointed out in *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, sections 3(1)(b) and (c) of the Act are independent and have differing general interests. I also remind myself that as the CJEU confirmed in *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, distinctive character must be assessed by reference to the average consumer of the services at issue.

The average consumer

57. Although this point generated a range of submissions in both the counterstatement and (in particular) in the applicant's written submissions, the position is, in my view, quite straightforward. The services applied for are as follows:

Education and training consultancy; Education and training services; Training consultancy; Driver training; Driving instruction.

58. With the exception of the last two categories mentioned, the education and training is not limited to a particular discipline. The average consumer of the first three categories mentioned will, therefore, include members of the general public, commercial undertakings and organisations, whilst the last two categories will include the same groups wishing to avail themselves of training/instruction in driving.

59. In *Exalation v OHIM*, Case T-85/08, the General Court ("GC") confirmed that, at least where technical terms are concerned, it is appropriate to take account of meanings known to those in the trade. The court stated:

"38. In paragraph 18 of the contested decision, the Board of Appeal stated that the applicant had not submitted any substantiated evidence to invalidate the examiner's observations to the effect that the element 'lycopin' (lycopene) designated a carotenoid with antioxidant properties.

39 For the first time at the hearing, the applicant challenged the Board of Appeal's assessment that the term 'lycopin' is descriptive. The Court observes that the applicant has not given any details to support its claims and there is thus no need to consider whether such an argument may be raised at this stage in the proceedings. In particular, the applicant has put forward no argument capable of calling into question the meaning attributed to the term 'lycopin' by the Board of Appeal. In those circumstances, the Court must find that the applicant has not

succeeded in challenging the meaning attributed to the element 'lycopin' by the examiner and by the Board of Appeal.

40 First, that technical term designates a food supplement necessarily known by some of the relevant public, in particular professionals dealing with dietetic, pharmaceutical and veterinary preparations.

41 Secondly, the Board of Appeal established in the contested decision that the meaning of the term 'lycopin' was easily accessible to consumers of all the goods covered by the application for registration. The meaning of the term 'lycopin' does in fact appear in dictionaries and on web sites. It is probable therefore that the substance designated by that term is also known by some of the consumers of all the goods listed in paragraph 3 above.

42 Thirdly, consumers of pharmaceutical, veterinary, dietetic and sanitary preparations for medical use who are not aware of the meaning of the term 'lycopin' will often tend to seek advice from the informed section of the relevant public, namely doctors, pharmacists, dieticians and other traders in the goods concerned. Thus, by means of the advice received from those who prescribe it or through information from various media, the less well informed section of the relevant public is likely to become aware of the meaning of the term 'lycopin'.

43 The relevant public must therefore be regarded as being aware of the meaning of the term 'lycopin', or at least it is reasonable to envisage that the relevant public will become aware of it in the future (see paragraphs 25 and 26 above)."

60. As Mr Milton's statement indicates, driver training can take many forms (paragraph 28 refers). However, in both his statement and evidence, there appears numerous references to "emergency response" and "emergency response driving/driver" being used in what is clearly a purely descriptive manner (paragraph 63 below refers). As a consequence, I am satisfied that the average consumer will include, for example,

organisations wishing to educate/train their staff in relation to emergency response driving.

My approach to the opposition

61. Although sections 3(1)(b) and (c) of the Act are independent and have differing general interests, it is clear that if the trade mark the subject of the application is open to objection under section 3(1)(c) of the Act, it is also to be regarded as devoid of any distinctive character and open to objection under section 3(1)(b) of the Act. I shall, as a consequence, begin by considering the objection based upon 3(1)(c) of the Act.

The opposition based upon section 3(1)(c) of the Act

62. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technool sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v*

Wm Wrigley Jr Co (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or

serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal

set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms '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', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or

services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

63. As I mentioned earlier, Mr Milton’s statement and evidence contains numerous references to “emergency response” and “emergency response driving/driver” being used in a purely descriptive manner. Examples of such usage are as follows:

Witness statement

- Paragraph 6: “...a comprehensive emergency response driver and instructor training programme...as a training body for emergency response driver and instructor training...Diploma in Emergency Response Driving...”;
- Paragraph 10: “...a Fire Service Emergency Response Driving course...”, “...is recorded as Emergency Response Driving...”, “...The Emergency Response Driver (ERD) Course...”, “Emergency Response Driver (Appliance) Course”, “Emergency Response Driving (formerly EFAD) skills”.

Exhibits

- Exhibit SM2: “Emergency Response Driver (Appliance) Course”;
- Exhibit SM7: “It must be stressed that this is the minimum necessary for any emergency response driver...”;
- Exhibit SM8: “...use experienced emergency response drivers...”

And:

- “..for the practical and theoretical assessment of Emergency Response Drivers...”

64. In light of the applicant’s own evidence, in approaching the matter under section 3(1)(c) of the Act, my starting point is that the phrases “emergency response driver” and “emergency response driving” are descriptive of education and training in relation to such driving techniques.

65. The evidence appears to indicate that both Mr Curley and Mr Milton were members of the JESG. That Group, which considered the issue of training in high speed driving, comprised members from, inter alia, all the emergency services. Both gentlemen provide exhibits from 2008 (SC1 and SM7, SM8) relating to that Group. Although the “Code of Practice” provided as exhibit SC1 to Mr Curley’s statement specifically refers to “...Emergency Response Driver Training (ERDT)” and, as far as I can tell, Mr Milton’s exhibits SM7 and SM8 do not, Mr Milton’s evidence does refer to “emergency response driver(s)” and “emergency response driving”. While I understand that the JESG has been dissolved and the draft documents they formulated have not become statutory requirements, it appears that at least at some point in 2008, JESG was considering using the words and letters “Emergency Response Driver Training (ERDT)” for a training programme in relation to this type of driving. Although Mr Milton takes issue with Mr Curley’s comments regarding the renaming of the training programme, as the words “Emergency Response Driver(s)” appears so frequently in the applicant’s own statement and evidence, the possibility that the initials letters of those three words i.e. “E”, “R” and “D” might have a letter “T” (i.e. the first letter in the word “Training”) added to them does not appear to me to require a great leap.

66. As to Mr Curley’s evidence, although one of the advertisements at exhibit SC3 is undated and two are after the material date in these proceedings, with one exception (which refers to “Emergency Response Driving Instructor”), the job descriptions from the

various Fire and Rescue Services all contain the words “Emergency Response Driver Training” either alone or together with the letters “ERDT” being used in a purely descriptive manner. Similarly, the undated extracts from the applicant’s website provided as exhibits SC4 and SC5, contain the phrases “UK and Worldwide Emergency Response Driver Training” and “Please Note: Emergency response driver training courses..”. In his statement, Mr Neal of the LFRS states that “ERDT is a recognised acronym within the industry for “Emergency Response Driver Training” and in support he provides as exhibit NF1, an assessment record from October 2015, which refers to ERDT as the first element of the assessment. Although Mr Milton’s exhibit SM9 makes it clear that Mr Neal’s statement is a personal one, I see no reason why this should undermine his evidence (the Chief Fire Officer does not, for example, indicate he/she disagrees with Mr Neal’s views). Given what appears to be the relationship between the opponent and the BLTPA, Mr Milton suggests that Mr Dearnley’s evidence is not independent. Whilst I note that Mr Dearnley states that the BLTPA is “an overarching independent body within the industry”, I shall keep Mr Milton’s concerns in mind in reaching a conclusion.

67. As to the applicant’s evidence, I accept that the letters ERDT do not appear in the undated document provided as exhibit SM1 in relation to “Police driving training governance”. In addition, Mr Milton states that the letters ERDT are not used in the London Fire Brigade’s 2014-2015 course guide and in the Essex Fire & Rescue Service’s course. He further states that the letters ERDT do not appear in the Scottish Fire & Rescue Service’s or in the MOD’s driving courses. However, although after the material date, I note that exhibit SC3 to Mr Curley’s statement includes a job advertisement from the Scottish Fire and Rescue Service which includes a reference to “Emergency Response Driving Instructor” and exhibit SC2 consists of an invoice issued by the opponent to the MOD in March 2016, which includes a reference to “Emergency Response Driver Training (ERDT)”.

68. Whilst I note Mr Milton’s comments on the use of the letters ERDT by the ambulance service, I also note that exhibit SM5 to his statement, indicates that the

FutureQuals Level 3 Certificate is in “Emergency Response Ambulance Training”, i.e. it uses the words “Emergency Response” and “Training”.

69. Finally, I have the emails provided as exhibit SM6 to consider. As the Tribunal pointed out in its letter of 14 June 2018, this is hearsay evidence. The relevant part of the Tribunal Work Manual in this regard reads as follows:

“4.8.10 Hearsay

Hearsay evidence is oral or written statements made by someone who is not a witness in the case but which the Court or Tribunal is asked to accept as evidence for the truth of what is stated.

If a witness statement, affidavit or statutory declaration contains hearsay evidence, it should be filed in sufficient time and it should contain sufficient particulars to enable the other party or parties to deal with the matters arising out of its containing such evidence. If the provision of further particulars of or relating to the evidence is reasonable and practicable in the circumstances for that purpose, they should be given on request.

It is also to be borne in mind that in estimating the weight (if any) to be given to hearsay evidence in proceedings before the Tribunal, the Tribunal and those acting on its behalf shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence. In estimating the weight, if any, to be given to hearsay evidence attention is drawn to the provisions of section 4 of the Civil Evidence Act 1995, which states:-

4.—(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following:

(a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;

(b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;

(c) whether the evidence involves multiple hearsay;

(d) whether any person involved had any motive to conceal or misrepresent matters;

(e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;

(f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight.

Parties to proceedings have on occasions solicited letters from third parties for the purposes of the proceedings, rather than getting the third party to file evidence by witness statement, affidavit or statutory declaration. These are often headed 'to whom it may concern', or, in some cases, are addressed directly to the Tribunal. Such letters will be treated as hearsay evidence. Parties are encouraged to present such evidence in the form of a witness statement rather than in the form of a letter if they wish to rely on it. A signatory to a witness statement, who can be cross-examined, is likely to exercise greater care and precision than a signatory to a letter."

70. Although none of the emails provided are dated, they have, it appears, been solicited for the purposes of these proceedings (point (b) above); consequently, I see no reason why the individuals concerned could not have filed evidence in the correct evidential format accompanied by a statement of truth (point (a) above). The statements do not include multiple hearsay (point (c) above) and there is nothing to suggest that the statements are edited accounts (point (e) above) or that those making the statements

had any motive to conceal or misrepresent matters or are an attempt to prevent proper evaluation of the weight of the evidence (points (d) and (f) above).

71. I also note that in paragraph 3.12 of its submissions filed during the evidence rounds, the applicant describes the content of this exhibit as a “survey”. Guidance on conducting surveys is provided in the Tribunal section of the Trade Marks Work Manual at paragraph 4.8.4.5 which includes the following:

“If a party wishes to adduce survey evidence it must seek the permission of the hearing officer. In seeking the permission of the hearing officer it must advise the hearing officer of all details of how it is intended for the survey to be conducted for example:

- the purpose of the survey
- the questions that are to be put.
- what those interviewed are to be shown as stimulus material.
- the nature of the population sample, in terms of size, social class, gender and location.
- the types of persons who will conduct the survey.
- the instructions that will be given to those people.
- the types of locations where the survey will be conducted.
- whether it is intended that statistically based conclusions are expected to be drawn from the survey

The hearing officer will consider whether the proposed survey is likely to have any determinative effect upon the proceedings.

If the hearing officer gives permission for survey evidence to be adduced, it will be necessary for it to conform to the criteria set out in the head note to *Imperial Group plc & Another v. Philip Morris Limited & Another* [1984] RPC 293:

“If a survey is to have validity (a) the interviewees must be selected so as to represent a relevant cross-section of the public, (b) the size must be statistically significant, (c) it must be conducted fairly, (d) all the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved, (e) the totality of the answers given must be disclosed and made available to the defendant, (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put, (h) the exact answers and not some abbreviated form must be recorded, (i) the instructions to the interviewers as to how to carry out the survey must be disclosed and (j) where the answers are coded for computer input, the coding instructions must be disclosed.”

72. By my reckoning, of the 21 emails provided (not all of which are from those based in the UK), 13 are from individuals involved in Fire and Rescue (10 of which are from those employed at airports), 1 is from a Team Leader in a Mountain Rescue Team, 1 is from an individual described as “Acting police SGT Traffic Management Unit” (in Grand Cayman), 2 are from individuals involved in the ambulance service (1 in Guernsey and 1 in the Isle of Man), and the area of activity of 4 of the individuals is, to me at least, uncertain. All of the individuals appear to be in senior position in their respective organisations.

73. No permission was sought by the applicant to adduce survey evidence into the proceedings. However, I suspect the word “survey” is being used in its loosest sense to simply refer to an approach made by the applicant to those with whom it may, for example, have had business dealings in the past. If that is correct, then the information provided suffers from a number of the defects mentioned above. For example, no indication is given of, inter alia: (i) the question to which the individuals concerned were asked to respond, (ii) why the particular individuals were selected, (iii) whether the

individuals concerned have an existing business relationship with the applicant, (iv) whether the responses provided to the Tribunal are the only responses the applicant received and if not, (v) what other responses were received and what did they say. In addition, all but the first response are worded in an identical fashion. In *Re Christiansen's TM* [1885] 3 RPC 54 at 60 Lord Esher stated:

"Now, to my mind, when you have evidence given upon affidavit, and you find a dozen people, or twenty people, all swearing to exactly the same stereotyped affidavit, if I am called upon to act upon their evidence, it immediately makes me suspect that the affidavits are then not their own views of things and that they have adopted the view of somebody who has drawn the whole lot of the affidavits, and they adopt that view as a whole and say 'I think that affidavit right' and they put their names to the bottom."

74. For the sake of convenience, the standard wording adopted in 20 of the 21 emails provided is as follows:

"I Darren Sutherland can confirm that I require **“emergency response driver training”** “blue light driver training” or “EFAD driver training” from time to time. “ERDT” is not a term in general use to identify this kind of training. In my opinion “ERDT” only applies to the services provided by [the applicant]. “ERDT” is not used by me or to the best of my knowledge by anyone else except to refer to the services provided [by the applicant]”.

75. Notwithstanding the problems I have already identified in relation to the emails provided, even if all of the emails had been provided in the form of witness statements accompanied by a statement of truth, their probative value would, in my view, have been questionable. I reach that conclusion because firstly, all but one of the emails is identically worded in relation to which, I note, Lord Esher “...stated: ...”it immediately makes me suspect that the affidavits are then not their own views of things and that they have adopted the view of somebody who has drawn the whole lot of the affidavits...”. Secondly, it appears to me that the individuals concerned are using the phrases “emergency response driver training”, “blue light driver training” and “EFAD

[meaning Emergency Fire Appliance Driver] driver training” in a purely descriptive manner. Whilst I accept that in their experience ERDT is “not a term in general use...” and “is not used by [them] or to the best of [their] knowledge by anyone else...”, the evidence shows that the phrase “emergency response driver training” is.

76. In support of its position, in its submissions, the applicant refers to guidance provided in the Trade Marks Work Manual. This reads as follows:

“Abbreviations, acronyms or initials

Trade marks consisting of abbreviations, acronyms or initials will be accepted unless research indicates that the letters represent descriptive words used in trade to denote the goods and/or services intended for protection. For example ABS (Advanced Braking System) for braking systems, CAD (Computer Aided Design) for computer software, PMS (PreMenstrual Syndrome) for pharmaceutical products. In such cases an objection under section 3(1)(c) will be taken.”

77. However, in its submission, the opponent refers to the decision of the CJEU in *Alfred Strigl v Deutsches Patent- und Markenamt (C-90/11)* and *Securvita Gesellschaft zur Entwicklung alternativer Versicherungskonzepte mbH v Öko-Invest Verlagsgesellschaft mbH (C-91/11)*, in which the Court stated:

“Article 3(1)(b) and (c) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that it is applicable to a word mark which consists of the juxtaposition of a descriptive word combination and a letter sequence which is non-descriptive in itself, if the relevant public perceives that sequence as being an abbreviation of that word combination by reason of the fact that it reproduces the first letter of each word of that combination, and that the mark in question, considered as a whole, can thus be

understood as a combination of descriptive indications or abbreviations which is therefore devoid of distinctive character.”

78. Having considered the totality of the evidence provided, and having concluded that “emergency response” and “emergency response driver/driving” are purely descriptive, I am satisfied that by the date of the application for registration in July 2017, the words “emergency response driver training” are likely to have been known to the relevant average consumer as describing a particular type of driving. I am also satisfied that those words may serve in trade to designate the intended purpose of education and training in relation to such driving.

79. Having reached that conclusion, it is, in my view, hardly surprising given the length of the phrase “emergency response driver training”, that it would be reduced to the first letter of each word of which it is composed to create the acronym ERDT. In my view, the letters ERDT are, whether appearing alone or preceded by the words Emergency Response Driver Training, absent evidence of acquired distinctiveness, open to objection under section 3(1)(c) of the Act. The evidence shows that in 2008 the JESG represented, inter alia, all of the emergency services. In those circumstances, even if the letters ERDT were not in widespread use by all of the emergency services at the date the application was filed, it is, in my view, entirely foreseeable that they may be used by one or more of the emergency services at some point in the future. As a consequence of the conclusions I have reached, the opposition based upon section 3(1)(c) of the Act succeeds.

80. Having reached what I regard as a very clear conclusion under section 3(1)(c) of the Act, it follows the application is to be regarded as devoid of distinctive character under section 3(1)(b) of the Act. As a consequence, it is not necessary for me to conduct a separate assessment in that regard.

Provisional conclusion under sections 3(1)(b) and (c) of the Act

81. The applicant's services are broad enough to include education and training in relation to emergency response driving. Consequently, as matters stand, the application will be refused for all the services for which registration has been sought.

82. However, in its written submissions filed in lieu of a hearing, the applicant stated:

"3.6. If it is decided that the Mark is used as a descriptive abbreviation by a significant subset of the public for all the services included in the application the Owner is willing, if necessary, to accept a fall back definition excluding that subset of the public. The suggested wording is set out in the First Limited Specification in the Schedule to these submissions.

First Limited Specification

Education and Training Consultancy; Education and Training Services; Training Consultancy; Driver Training; Driver Instruction. (none of the aforementioned services relating to the provision of training to employees of the local fire and rescue services in England)."

And:

"6.4. If it is decided that the Mark is used as a descriptive abbreviation by the general public for training for drivers of emergency response vehicles, rather than all the services included in the application, the Owner is willing, if necessary, to accept a fall back definition excluding those services. The suggested wording is set out in the Second Limited Specification in the Schedule to these submissions.

Second Limited Specification

Education and Training Consultancy; Education and Training Services; Training Consultancy. (none of the aforementioned services relating to the provision of training to drivers of emergency service vehicles)".

And:

"7.4. Nevertheless if it is decided that this is not the case the Owner is willing, if necessary, to accept a fall back definition excluding those particular services for that subset of the public. The suggested wording is set out in the Third Limited Specification in the Schedule to these submissions.

Third Limited Specification

Education and Training Consultancy; Education and Training Services; Training Consultancy; Driver Training; Driver Instruction. (none of the aforementioned services relating to the provision of training to drivers of emergency service vehicles employed by the local fire and rescue services in England)".

83. I think it most unlikely that an ordinary member of the general public would be aware that the letters ERDT are used as an acronym for Emergency Response Driver Training. Similarly, as far as I am aware, the letters ERDT are neither descriptive of nor non-distinctive for a wide range of educational and training services not relating to driving. For example, the trade mark the subject of the application is likely to be distinctive in relation to education and training in the field of carpentry.

84. However, inter alia, exhibit SC4 to the statement of Mr Curley strongly suggests (unsurprisingly), that the applicant's commercial interests lie in the field of broadly speaking, education and training in relation to the driving of motor vehicles; I say motor

vehicles having noted that collinsdictionary.com defines “motor vehicle” as “a road vehicle driven by a motor or engine, esp. an internal-combustion engine”.

85. In his evidence (paragraph 28 refers), Mr Milton identifies a range of other courses the applicant provides. However, it appears to me that, for example, 4x4 and 6x6 off-road driving could all constitute part of emergency response driver training. Given the conclusions I have already reached, none of the limited specifications suggested by the applicant are, in my view, sufficient to overcome the objections. If the application is to proceed to registration on some basis, it will be necessary for the applicant to review its position and offer a revised specification/revised specifications, keeping in mind the comments of Arnold J in *Omega SA (Omega AG) (Omega Ltd) v Omega Engineering Incorporated* [2012] EWHC 3440 (Ch), in relation to the application of the principle in *POSTKANTOOR*. In this regard, it may be more productive for the applicant to consider offering a positively limited specification(s) rather than exclusions.

Next steps

86. With the above in mind, **the applicant is allowed 14 days from the date of this interim decision to offer a revised specification/revised specifications.** Any such revised specification/specifications offered should be copied to the opponent who will then be allowed a period of 14 days from the date that it receives a copy of the revised specification/specifications to provide comments. At the conclusion of that period, I will review any submissions the parties may make and issue a supplementary decision, in which I will deal with costs and set the period for appeal.

Dated this 12th day of December 2018

C J BOWEN

For the Registrar