

O/0772/26

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO. UK00004040261

IN THE NAME OF OVERSEAS TRADING LIMITED

IN RESPECT OF THE TRADE MARK:



IN CLASSES 5 AND 44

AND

THE OPPOSITION THERETO UNDER NO. 448722

BY THE PROCTER & GAMBLE COMPANY

Background and pleadings

1. On 17 April 2024, OVERSEAS TRADING LIMITED (“the applicant”) applied to register the trade mark no. UK00004040261 for the mark shown on the cover page of this decision in the UK. It was accepted and published in the Trade Marks Journal on 26 April 2024, in respect of the following goods and services:

Class 5: *Pregnancy test kits; ovulation test kits; diagnostic preparations for in vivo use; in-vitro diagnostic preparations and reagents for pregnancy testing and hormone testing; pregnancy test kits for home use; ovulation test kits for home use.*

Class 44: *Medical care; medical clinical services; pharmacy advice; preparation of prescriptions by pharmacists; special insemination and in vitro fertilisation services.*

2. On 22 July 2024, The Procter & Gamble Company (“the opponent”) opposed the trade mark on the basis of Sections 3(1)(b) and (c) of the Trade Marks Act 1994 (“the Act”).

3. In respect of Section 3(1)(c), the opponent argues that the mark is descriptive of the characteristic, kind, and/or intended purpose of the goods and services outlined above. It states as follows:

“The word CLEAR means easy to perceive, understand, or interpret, and the word RESPONSE means something that is done as a reaction to something that has happened. Therefore, the term ‘Clear Response’ for goods and services related to pregnancy and ovulation tests in Classes 5 and 44 immediately conveys the understanding that the goods and services offered under the mark will produce clear, straightforward pregnancy and ovulation test responses that are easy to interpret. Further, the minor figurative element within the ‘o’ of the mark represents a fertilised egg, which immediately conveys that the purpose of the goods and services on offer are to detect signs of fertilisation

or ovulation, and merely reinforces the descriptive nature of the mark. Accordingly, the sign is exclusively descriptive and should be refused under Section 3(1)(c)."

4. Under Section 3(1)(b), the opponent argues that the mark is devoid of distinctive character and is therefore not capable of distinguishing one undertaking from another. It states as follows:

"The mark comprising this Application consists of the ordinary understood words 'Clear' and 'Response' with very light stylisation of the letters and a minor decorative element on the 'o'. The words 'clear' and 'response' are commonly used in the medical and pharmaceutical industries to describe the effectiveness and accuracy of medical tests and diagnostic products, like pregnancy tests. The term 'Clear Response' is therefore non-distinctive as consumers are unlikely to associate the term with a single source of origin. Instead, they will perceive the term as a direct description of the characteristics and quality of the goods and services applied for, namely, pregnancy and ovulation tests that produce a clear response. The verbal elements are enclosed in a simple pink geometric shape, but this is a very simple stylization that adds nothing to the mark overall and will merely be seen as a background, particularly given that pink is a colour commonly associated with the goods and services applied for. The small decorative element on the letter 'o' is very small and hardly noticeable.

The mark applied for, when used or registered in relation to the goods and services covered by the Application in Classes 5 and 44 (in relation to pregnancy, ovulation and fertility tests and related services) does not have the capacity to identify these goods and services as coming from a single entity or trade source. Rather, the mark would be interpreted by the average consumer as an indication of a characteristic and/or kind and/or intended purpose of the goods and services, namely, pregnancy and ovulation tests that provide a clear response. As the Application is entirely descriptive, it follows that it cannot be held to have the sufficient level of distinctive character to be registrable under Section 3(1)(b)."

5. Accordingly, the claim that the application is devoid of distinctive character is based on the allegation that the mark is descriptive.

6. The applicant filed a counterstatement denying the claims made. As regards the opponent's claim that the mark is devoid of distinctive character under Section 3(1)(b), the applicant states as follows:

- Whilst the application includes the word elements 'Clear' and 'Response', as well as a decorative element, the words 'Clear' and 'Response' are not terms that have one single meaning, but can instead be interpreted in multiple ways, so context and discernment is required in the interpretation of the meaning of the words when combined together.
- The applicant put the opponent to proof of its claim that the words 'clear' and 'response' are commonly used in the medical and pharmaceutical industries to describe the effectiveness and accuracy of medical tests and diagnostic products, like pregnancy tests.
- The applicant disagrees that the pink geometric shape forming part of the mark adds nothing to the mark's overall impression and that the decorative element is hardly noticeable. The applicant submits that the figurative element of the mark adds to its distinctiveness because it is eye-catching and would be noticed by the average consumer.
- The applicant disagrees with the opponent that the contested mark, when used in relation to the goods and services covered by the application in Classes 5 and 44, does not have the capacity to identify these goods and services as coming from a single entity or trade source. The mark has functioned for a number of years to identify the goods and services as coming from a single entity or trade source. In this connection, the applicant states that the distinctiveness of the mark on the market is such that three separate trade mark applications have been filed at the UKIPO by two different entities other than

the applicant. The third parties were trying to register the applicant's mark for their own gain, and subsequently withdrew their applications after receiving a request from the applicant requesting to withdraw their applications since they had applied to register the mark when they were not entitled to do so.

- The application has been accepted for registration after going through a full and stringent examination process at the UKIPO, where the examiner did not consider the application to be in breach of Section 3(1)(b).

7. As regards the opponent's claim that the mark is descriptive under Section 3(1)(c), the applicant states as follows:

- The applicant denies that the mark is descriptive. The opponent states that the term 'Clear Response' for goods and services related to pregnancy and ovulation tests in Classes 5 and 44 immediately conveys the understanding that the goods and services offered under the mark will produce clear, straightforward pregnancy and ovulation test responses that are easy to interpret. The applicant disagrees with this claim, because the definitions provided by the opponent are not the normal usage of the terms to designate the essential characteristics, goods or services in respect for which registration is sought and put the opponent to prove of its claim.
- The applicant disagrees that the figurative element of the application is minor and immediately conveys that the purpose of the goods and services on offer are to detect signs of fertilisation or ovulation, and merely reinforces the descriptive nature of the mark. The application has been accepted for registration by the UKIPO, and the examiner did not consider the application to be in breach of Section 3(1)(c).

8. Both parties are professionally represented. The applicant is represented by Franks & Co Limited. The opponent is represented by D Young & Co LLP. Both sides filed evidence in chief, and the opponent also filed evidence in reply.

9. Neither party requested a hearing, but they both filed submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

Relevance of EU Law

10. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence

11. The opponent's evidence consists of two witness statements from Gemma Kirkland, one dated 16 December 2024 and accompanied by 7 exhibits (PG1 – PG7) – this was filed as evidence in chief - another dated 17 April 2025 and accompanied by 6 exhibits (PG8 – PG13) – this was filed as evidence in reply. Ms Kirkland is a Partner and Chartered Trade Mark Attorney at D Young & Co LLP, the opponent's representative.

12. The applicant's evidence consists of two witness statements, one from Pradipta Ganguly (with exhibits OTL01-OTL05), another from Dulmalik Lawal (with exhibits AL01-AL08), both dated 17 February 2025. Mr Ganguly says that he is from the applicant's company, although he does not clarify what his position is. Mr Lawal is a Chartered Trade Mark Attorney at Franks & Co Limited, the applicant's representative.

13. I do not intend to summarise the evidence (or submissions) in full here. However, I confirm that I have taken all filed documents into account and will refer to them to the extent that I deem necessary below.

DECISION

14. The relevant parts of Section 3(1) read:

“3.— Absolute grounds for refusal of registration

(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.”.

15. The relevant date for determining whether the contested mark is objectionable under Sections 3(1)(b) and 3(1)(c) is its deemed filing date, being it 17 April 2024.

16. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of Section 3(1)(c) but still be objectionable under Section 3(1)(b): *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, at [25]. However, in this case the opponent’s claim that the contested mark is devoid of distinctive character under Section 3(1)(b) is based on the allegation that the mark is descriptive under Section 3(1)(c). Hence, I will begin with the examination of the ground under Section 3(1)(c) of the Act because the conclusion on this ground will also determine the outcome of the ground under Section 3(1)(b).

SECTION 3(1)(C)

General principles

17. 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 set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol 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].”

The relevant public

18. Descriptiveness must be assessed through the perception of the relevant public, including those in the trade. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, the Court of Justice of the European Union (“CJEU”) held that:

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

19. 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 that:

“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).”

20. Accordingly, I need to make the assessment taking into account the expectations of the relevant public in deciding whether, at the date of the application, the contested mark was perceived as descriptive. The goods and services for which the applicant seeks registration are as follows:

Class 5: *Pregnancy test kits; ovulation test kits; diagnostic preparations for in vivo use; in-vitro diagnostic preparations and reagents for pregnancy testing and hormone testing; pregnancy test kits for home use; ovulation test kits for home use.*

Class 44: *Medical care; medical clinical services; pharmacy advice; preparation of prescriptions by pharmacists; special insemination and in vitro fertilisation services.*

21. I have no submissions or evidence from either party as to who the relevant public will be. The goods and services at issue are directed at the following: (a) a woman of reproduction age seeking pregnancy or ovulation tests; (b) a couple seeking fertility treatments; (c) a fertility clinic purchasing in-vitro diagnostic preparations and reagents for pregnancy testing and hormone testing; and (d) a member of the general public seeking medical and pharmacy services. Although where intermediaries influence decisions to purchase goods and services their views should be taken into account, in this case the average consumer for the contested goods and services is largely the general public, and it is their views which are likely to be of decisive importance.¹ In addition, depending on the outcome of this decision, I will consider the views of the

¹ CJEU, Case C-371/02 *Björnekulla Fruktindustrier AB v Procordia Food AB*, paragraphs 24 and 25.

average consumer of in-vitro diagnostic preparations and reagents for pregnancy testing and hormone testing, which is a fertility clinic. Having said that, the verbal element of the mark is made up of two ordinary English words whose meaning would be understood by any English-speaker and does not require any specific or technical knowledge.

The class 44 services

22. The opponent's essential contention is that the words "Clear Response" (as two separate words) or "ClearResponse" (as two words conjoined) are descriptive for goods and services related to pregnancy and ovulation tests in Classes 5 and 44 because they immediately convey the understanding that the goods and services offered under the mark will produce clear, straightforward pregnancy and ovulation test responses that are easy to interpret. Further, the opponent states that "*the minor figurative element within the 'o' of the mark represents a fertilised egg, which immediately conveys that the purpose of the goods and services on offer are to detect signs of fertilisation or ovulation, and merely reinforces the descriptive nature of the mark*". The opponent also states that 'CLEAR' and 'RESPONSE' are basic English words that will be understood by everyone, in the context of medical tests, to mean that the test gives you an answer that is easy to understand, read or see, or that it gives you an answer that is certain or leaves no doubt.

23. I pause here to note that the primary focus of the opponent's case is the alleged descriptiveness of the applicant's mark in relation to pregnancy and ovulation tests. In this connection, it is important to observe that:

- (a) The applied-for *medical care; medical clinical services; pharmacy advice; preparation of prescriptions by pharmacists* have nothing to do with pregnancy tests or ovulation tests.
- (b) Admittedly, the applied-for terms *medical care; medical clinical services* are sufficiently broad to include the provision of medical investigations/tests. In relation to these services, the opponent argues that 'CLEAR' and 'RESPONSE' will be understood to mean that the test gives you an answer that is easy to

understand, read or see (or that it gives you an answer that is certain or leaves no doubt). However, the provision of medical investigations/tests (provided as a service) would require the assistance of a doctor and/or qualified health professional in order for the results of the investigations/tests to be read, understood and communicated. This would equally apply to pregnancy testing services and it is in the converse of over-the-counter pregnancy/ovulation tests for home use which are carried out without the assistance of health professionals and whose results are straightforward insofar as the test is designed to provide an immediately readable positive/negative answer. Given that the provision of *medical care* and *medical clinical services* implies the intervention of a doctor and/or qualified health professional who will communicate and explain the results of medical investigations/tests to a patient, the services through which the medical tests/investigations are supplied cannot be said to be easy to understand, read or see; neither can it be said that the services give you an answer that is certain, straightforward or leaves no doubt – even if that was the case, the notion would refer to the effects of the test, but would not immediately describe the services through which the tests are carried out.

24. Accordingly, even if the words '*CLEAR RESPONSE*' (or their conjoined use) conveys the notion that in the context of medical tests, the test gives you an answer that is easy to understand, that notion does not describe the services at issue or the way those services are delivered.

25. Further, tests carried out by providers of *medical care* and *medical clinical services* normally involve complex investigations used to detect a condition, confirm a diagnosis, guide treatment decisions, or track how well a treatment is working over time; they range from a simple blood draw to advanced imaging and genetic analysis. The same goes for the contested *special insemination and in vitro fertilisation services* which are complex fertility treatments used to achieve pregnancy; whilst the provision of these services includes fertility tests such as hormone analysis, ultrasound and semen analysis, the results are far from straightforward (or easy to understand, read or see) and require the intervention of specialists who, based on the results of the tests, assess which technique is the most suitable for each case. Hence, it cannot be

said that the words 'CLEAR RESPONSE' simply describe any of the applied-for services in class 44. It follows that the opposition based on Section 3(1)(c) fails in relation to all of the applied-for services in class 44, namely:

Class 44: *Medical care; medical clinical services; pharmacy advice; preparation of prescriptions by pharmacists; special insemination and in vitro fertilisation services.*

26. Although it has not been necessary to look at the opponent's evidence in order to dismiss the opposition in relation to the applied-for services, I now turn to consider that evidence in relation to the goods in class 5.

The class 5 goods

27. The words "clear" and "response" are, of course, part of the common English language. However, the question here is whether the conjoined use of the words "clear response" produces a descriptive meaning that conveys a notion that is apt to describe the applied-for goods, i.e. it is an indication which may serve in trade to designate a characteristic of the goods. This can be the case even if the precise combination is not an established expression.

28. The opponent's evidence in this regard consists of the following:

- PG1: This exhibit consists of online dictionary definitions for the words 'clear' and 'response'. In her narrative evidence Ms Kirkland refers to the definitions from the Cambridge English Dictionary which are as follows:

CLEAR - "*Easy to understand, hear, read or see*" and "*Certain, having no doubt, or obvious*".

RESPONSE - "*An answer or reaction*" – for example "*Thank you for your swift response*".

- PG2: this exhibit consists of screenshots from Amazon UK showing customer reviews. Ms Kirkland points out that individuals have described the applicant's product (a pregnancy test) as providing "clear and accurate results" and as doing "what it says on the tin" and "what it says on the box". In this connection I note that: (a) many reviews refer to the word 'clear' within the following combinations 'clear instructions', 'clear answer', 'clear results', 'clear line', however, none of the reviews use the combination 'clear response'. Further, the name of the product as it is sold on Amazon is not simply 'clear response' but 'Clear Response Midstream Pregnancy Test 2 Pack, 99% Accurate, Faster Than A Minute' – consequently, it is not clear whether the comments about the product doing what it says on the tin/box refer to the words 'clear response' or to the other words "Midstream Pregnancy Test 2 Pack, 99% Accurate, Faster Than A Minute".
- Exhibit PG3: this exhibit consists of a collection of medical journals and official correspondence from health organisations, including the NHS. Ms Kirkland states that this evidence demonstrates *"the frequent use of the terms 'clear response' and 'clear' within the medical field"*. The only examples of phrases which are highlighted within this evidence are the following: "**How clear** did you find the results of the test"; "we suggest that a **clear explanation** of all the services across primary care..."; "low **response rate**"; "**be clear** about what is meant by primary care", "we seek assurance that there are **clear timeframes** ..."; "we would like to see strong evidence, provided by primary care providers, which brings together their concerns and a **clear response** as to how these concerns will be addressed"; "this is a public health and economic crisis that demands a **clear response**"; "A **clear response**: The credibility of a medical journal does not depend on how incomprehensible the articles are that are included [...] If authors responses are to be published they should at least make sense to your readers!"; "Tests performed at screening for well-babies: automated otoacoustic emission (AOAE1) – if a **clear response** is obtained in both ears the baby is discharged from the screening programme"; "setting **clear specifications** for screening equipment [...]"; "If no **clear response** is obtained on completion of the screen, the baby is referred to diagnostic services provided

by audiology”; “Regardless of the service delivery model, all NICU babies with a no **clear response**”; “NHSP ‘**Clear Response**’ letter”. The most that can be said in relation to this evidence is that it shows that the combination “clear response” is an established and meaningful expression – however, it does not show that “clear response” is used in trade to describe pregnancy tests (or any of the other goods for which the application seeks registration).

- Exhibit PG4: this exhibit includes various articles which use the word ‘clear’ and ‘response’ in relation to pregnancy tests and fertility. Ms Kirkland points out that a BBC article notes that “some say the electronics give women a **clearer answer**” and that another medically reviewed article refers to pregnancy tests which “give a **clear readout**” and “gave me such a **clear response** with the actual words ‘pregnant’ or ‘not pregnant’” whereas an article from an IVF clinic states that it is “disappointing not to get a **clear response**”; however, the latter refers to infertility not to the test in itself as shown below:

5.Unexplained infertility.

Even though it is disappointing not to get a clear response, over time this problem will fix itself. No, you shouldn't miss infertility treatment.

This evidence indicates that the combination “clear response” (or equivalent combinations such as clear answer or clear readout) might be used to describe the results of pregnancy tests; however, it does not show use of the same expression to describe the results of ovulation tests.

- Exhibit PG5: this exhibit contains screenshots from Amazon UK showing reviews in the field of pregnancy and ovulation tests, which Ms Kirkland states refer to “clear” and “response” as descriptive terms for the products. Ms Kirkland points to the following combination: “early response”, “fast response”, “accurate response” and “early result” and says that *“these terms, which all describe how clear the response of the test is, are all commonly used by traders and consumers to describe the characteristics and quality of the products”*.

However, none of the reviews use the exact combination 'clear response' or it is an equivalent of 'clear response'.

- Exhibit PG6: this exhibit shows use of the colour pink in the marketing of pregnancy, ovulation and fertility tests.
- Exhibit PG7: this exhibit consists of printouts from the UKIPO regarding applications for trade marks including the words 'Clear & Simple', 'CLEAR RESPONSE', 'RAPID RESPONSE RESERVE' and 'EMERGENCY RAPID RESPONSE TEAM'. Ms Kirkland points out that these applications have been either refused or withdrawn, however, she provides no further information about the reasons why these applications did not proceed to registration. Nevertheless, having checked our records, I have gathered the following information:

UK00003104913

Clear & Simple Pregnancy Test (figurative)

This mark was filed on 21 April 2015, in relation to among others, pregnancy test and ovulation tests in class 5. However, it was refused registration on the basis of Section 3(1)(b) based on the following reasoning:

"The application is not acceptable in Class 5 and Class 10. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because the mark consists essentially of the words "Clear & Simple Pregnancy Test" which would not be seen as a trade mark by the relevant consumer as they merely describe the goods being provided; e.g. a pregnancy test that it is clear and simple to use. All of those goods claimed are likely to include instructions as to how to use them, therefore in this context the words "Clear & Simple" are likely to be seen as being directly meaningful in the minds of the average consumer, whom is

therefore likely to perceive this mark as being an advertising strap-line rather than a (standalone) badge of trade origin”.

UK00003081603

CLEAR & SIMPLE (figurative)

The mark was filed on 14 November 2014, in relation to among others, pregnancy test and ovulation tests in class 5. However, it was refused registration on the basis of Section 3(1)(b) based on the following reasoning:

“The application is not acceptable. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because it would simply be seen as a promotional statement that could apply to any undertaking who were promoting their goods as being clear and simple to use. All of those goods claimed are likely to include instructions as to how to use them, therefore in this context the words “Clear & Simple” are likely to be seen as being directly meaningful in the minds of the average consumer, whom is therefore likely to perceive this mark as being an advertising strap-line rather than a (standalone) badge of trade origin. The mark does feature a degree of stylization however I am afraid this is insufficient in ‘carrying’ these highly descriptive words”.

UK00003974701

Clear Response

The mark was filed on 2 November 2023 in relation to among others, pregnancy testing services in class 44. It was subsequently withdrawn after the UKIPO issued the following refusal letter:

“The application is not acceptable in Class 44. There is an objection under Section 3(1) (b) of the Act as the mark is devoid of any distinctive character. This is because the relevant public would perceive the expression ‘Clear Response’ as nothing more than a non-distinctive message and as a result,

would not attribute any trade marks significance to the sign. It is considered that the average consumer, when greeted with the sign `Clear Response` for services such as pregnancy and medical testing would not perceive the sign as a trade mark and would instead view the expression as detecting a clear negative or positive response...."

UK00003979082

Clear Response

The mark was filed on 14 November 2023 in relation to, inter alia, medical services in class 44. The mark is shown as withdrawn.

UK00003605507

RAPID RESPONSE RESERVE

The mark was filed on 5 March 2021 in relation to goods and services in classes 1, 5, 35, 42 and 44 related to medical services and products but not including pregnancy tests. It was refused based on the following reasons:

"The application is not acceptable in Classes 01, 05, 35, 42 and 44. There is an objection under Section 3(1)(b) of the Act, as the mark is devoid of any distinctive character. This is because the mark consists of the words "RAPID RESPONSE RESERVE", being a sign which fails to allow the consumer to perceive the mark as originating from a single undertaking. It is considered that the relevant consumer would not attribute any trade mark significance to the mark, which simply serves to indicate to the consumer what the user of the mark does by way of business, i.e. the provision of goods and services which are held in reserve for a rapid response during a global pandemic. Therefore, looking at the mark in its totality, it is considered that the words are too ordinary and mundane to be perceived as a trade mark and for them to immediately indicate trade origin. For an application to be considered distinctive and capable of indicating a single trade source it should have an element that is unique to the applicant and sets them aside in the market place. Unfortunately, this mark does not appear to meet this criteria".

UK00003947087

Emergency Rapid Response Team

The mark was filed on 18 August 2023 in relation to, inter alia, emergency medical assistance services in class 44. It was refused based on the following reasoning:

"The application is not acceptable in Classes 9, 44 and 45. There is an objection under Section 3(1)(b) and (c) of the Act. This is because the mark consists exclusively of a sign which may serve in trade to designate the kind and intended purpose of the goods and services e.g. Goods and services provided by or for an emergency rapid response team. Research has shown that the oxford English dictionary defines the word Emergency as "a serious, unexpected, and often dangerous situation requiring immediate action." The word Rapid as "happening in a short time or at a great rate." The word Response as "a reaction to something." The word Team as "two or more people working together." Therefor the combination of these words does not denote any trade origin against the goods and services and instead is descriptive/ It is therefore considered that the average consumer would not perceive the words 'Emergency Rapid Response Team" as a trade mark guaranteeing the commercial origin of the goods and services and that they would instead see the sign as the kind and intended purpose of the goods and services".

29. I pause here to say that whilst in one of the applications listed above the trade mark 'CLEAR RESPONSE' was refused for pregnancy and medical testing services in class 44, that decision is not binding upon me, and as it will be recalled, I have reached a different conclusion, for the reasons I gave. Hence, I shall say no more about it.

30. In response to the applicant's evidence, the opponent filed the following evidence:

- PG8: a further screenshot from Cambridge English dictionary showing the following definitions of 'CLEAR': "*Certain, having no doubt, or obvious*". This evidence was filed in response to Mr Lawal's observation that such definition was not shown in PG1.
- PG9: three further consumers' reviews containing the words 'clear response' in relation to pregnancy tests. These are as follows:

"I especially appreciate the digital test giving a clear response and it does indeed work six days sooner"

"Gives a clear response that leaves no doubt whether you are pregnant or not".

"I loved that it gave me such a clear response with the actual words "pregnant" or "not pregnant," and I also loved the countdown."

- PG10: additional journal articles allegedly demonstrating that the words 'clear response' are used in the medical and public sectors. None of the examples contained within this evidence relate to pregnancy tests or ovulation tests.
- PG11: further examples of pregnancy and ovulation tests showing the use of pink in the marketing of these products.
- Exhibit PG12: a screenshot from Amazon UK showing the applicant's own product listing. Ms Kirkland points out that the words 'RESULT' and 'RESPONSE' are used interchangeably in the description of the product as follows:

"RAPID RESULT: Get your results in just a few minutes with our fast-acting pregnancy tests. This quick response time allows you to know your status promptly, helping you to plan your next steps without delay."

In addition, Ms Kirkland provides two further printouts from online dictionaries showing that the words “response” and “result” are synonymous.

Lastly, this exhibit includes a screenshot showing the result of a Google search for “*CLEAR TEST RESPONSE*” which utilises AI, and states as follows: *“CLEAR TEST RESPONSE” typically refers to the outcome of a test, indicating that the result is clear, unambiguous and easily interpreted. In the context of pregnancy tests, a clear response usually means the test provided a definitive “Pregnant” or “Not Pregnant” result. In the context of other tests or assessments, a clear response means the result is easily understood and provides a definite conclusion.*”

- PG13: This evidence was filed in response to the applicant’s evidence aimed at supporting the claim that the applied-for mark had acquired reputation and enhanced distinctiveness. The only reason why this evidence would be relevant is if I were to find that the application falls foul of Section 3(1)(c), in which case I would need to consider whether the mark had become distinctive as a result of the use made of it. Hence, I will return to this evidence if necessary.

31. I now draw my conclusions.

32. The evidence shows that the combination “clear response” is an established and meaningful expression.

33. Whilst some of the evidence is not really pertinent (as it relates to the words ‘clear’ and ‘response’ being used separately or in a conjoined form but in different contexts), there is also evidence of the same or similar expressions being used to describe the results of pregnancy tests, i.e. ‘clear response’, ‘clear answer’, ‘clear readout’. Admittedly, there are only four examples of ‘clear response’ being used in relation to pregnancy tests by consumers (PG4 and PG9).

34. In all of the examples whereby ‘CLEAR RESPONSE’ is used by customers in relation to pregnancy tests, it is used to convey the notion that a digital pregnancy test produces an unambiguous, easy-to-understand result by displaying the word

‘pregnant/not pregnant’. The same goes for the AI definition, which refer to the same type of digital pregnancy tests. In this context, the word ‘clear’ refers to a characteristic of the result, and the word ‘response’ refers to the result in itself. The evidence also shows that traditional home pregnancy tests based on one line being a negative result and two lines being a positive result, are more ambiguous than digital pregnancy tests which display the words ‘pregnant’/‘not pregnant’ – this is because the words ‘pregnant/not pregnant’ removes the guess work of interpreting faint lines. The article² states in fact as follows:

“The Clearblue Digital test has a few clever features which help elevate it above competitors. It's the only test with a smart countdown, which reassures you that the test is working while you wait. It also has a wide, absorbent, "no mess" tip with what Clearblue calls "floodguard technology." In other words, this prevents excess urine from "flooding" the test strip and interfering with results. Women especially appreciate that the digital display that clearly states "pregnant" or "not pregnant" leaves no room for interpretation either.

I have two daughters (one is 4-years-old and one is 2-years-old), and I used this Clearblue test every time I wanted to see if I was pregnant. Although it's definitely pricey, I loved that it gave me such a clear response /with the actual words "pregnant" or "not pregnant, and I also loved the countdown. I was always so anxious I had done something wrong, and this made it very clear that the test was working properly before the results appeared”.

35. I bear in mind that the applied for *pregnancy test kits* and *pregnancy test kits for home use* include goods identical to the digital pregnancy tests in relation to which the expression ‘clear response’ was used in the examples provided in evidence, i.e. pregnancy tests which replace the traditional two lines with the words ‘pregnant’/‘not pregnant’. In those circumstances ‘CLEAR RESPONSE’ will immediately convey the notion that the test gives a clear result, referring to the effects of the test, i.e. a test giving a clear response/result. This raises the question of whether a description of one of the effects of the goods can be a characteristic under Section 3(1)(c). In my view,

² PG4

the question must be answered in the positive because the effects/results of using the goods fall within the notion of intended purpose of the goods which is one of the characteristics specifically listed in Section 3(1)(c). Admittedly, not every description of the effects of using goods/services can be regarded as describing their intended purpose, but many such descriptions will fall into this category.³ In the present case, obtaining a clear response represents the intended purpose of pregnancy tests and would therefore constitute a characteristic of such goods for the purposes of Section 3(1)(c). However, the same would not apply to ovulation tests, as there is no evidence that they would give a clear response in terms of 'ovulation/not ovulation'. Neither would it apply, in my view, to diagnostic preparations for in vivo use; in-vitro diagnostic preparations and reagents for pregnancy testing and hormone testing, which are all goods used in fertility treatments. These goods are not digital pregnancy tests for home use; furthermore, whilst they might be used in the context of in-vitro procedures (including pregnancy and hormone testing), they are not tests in themselves, and so they cannot give a 'clear response' – it follows that the expression 'CLEAR RESPONSE' cannot be said to describe the intended purpose of these goods (or any other characteristic).

36. Accordingly, I consider that the words 'CLEAR RESPONSE' are descriptive of the intended purpose of digital pregnancy tests. Accordingly, this objection would catch the following goods of the application:

Class 5: *Pregnancy test kits; pregnancy test kits for home use.*

37. Having said that, the applied for mark contain a degree of stylisation, the main feature of which is that the letter 'O' is replaced by the image of a fertilised egg. In this connection, the opponent itself accepts that this is how the average consumer will perceive this figurative element of the mark – hence I do not need to discuss how this element is likely to be perceived by the average consumer.

³ See Decision BL-115-18 at paragraph 30

38. In *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2013] F.S.R. 29, Arnold J. (as he then was) held that a descriptive word with a minor figurative embellishment was, as a whole, devoid of any distinctive character. He found that:

“116. Taking all of the evidence into account, I conclude that the CTM is precluded from registration by art.7(1)(c) in relation to the services in issue because NOW would be understood by the average consumer as a description of a characteristic of the service, namely the instant, immediate nature of the service. The figurative elements of the CTM do not affect this conclusion. In the alternative, if the inclusion of the figurative elements means that the CTM does not consist exclusively of the unregistrable word NOW, I consider that the CTM is devoid of distinctive character and thus unregistrable by virtue of art.7(1)(b) .

117. I would comment that it appears to me that PCCW only succeeded in obtaining registration of the CTM because it included figurative elements. Yet PCCW is seeking to enforce the CTM against signs which do not include the figurative elements or anything like them. That was an entirely foreseeable consequence of permitting registration of the CTM. Trade mark registries should be astute to this consequence of registering descriptive marks under the cover of a figurative figleaf of distinctiveness, and refuse registration of such marks in the first place.”

39. A similar point arose in *Thomas Pink Ltd v Victoria's Secret UK Ltd*, [2014] EWHC 2631 (Ch), when Birss J. found that the registration of the descriptive word PINK (for clothing) with the letters in the colour pink, and in a unique form of script, and within a rectangular box, did not prevent the mark being *prima facie* unregistrable under Section 3(1)(c). In the alternative, the mark was excluded by Section 3(1)(b).

40. See also the judgment of the GC in *Spirig Pharma v EUIPO*, Case T-261/15 ('Daylong' with stylised letter 'o' for cosmetics and medications that last all day), *Bayer Intellectual Property v EUIPO*, Case T-123/18 (stylised heart device for services for treating cardiovascular diseases) and Case T-361/18, *APEDA v EUIPO* ('Sir Basmati' 'Rice' and device of a man in a turban with other figurative elements).

41. In the present case, I consider that whilst the device is not overly stylised and it is evocative of pregnancy, it is not a ‘minor figurative embellishment’ so as to be considered a ‘figurative fig leaf’ addition.⁴ I say this because the image of a fertilised egg whilst evocative of pregnancy, it is sufficiently removed from any immediate and direct description of the goods (i.e. pregnancy tests for home use) or their characteristics, including their intended purpose, and from the meaning of the words ‘CLEAR RESPONSE’, to be attributed an origin function by the average consumer. In my view, the addition of the device is not simply a banal feature, and it is sufficiently original that it adds an origin specific message to the mark. It follows that the opposition under Section 3(1)(c) fails.

42. As the opposition has failed under Section 3(1)(c), it also fails under Section 3(1)(b) because the latter is based on the same ground, i.e. that the mark is descriptive.

43. As I have rejected the opposition, I do not need to consider whether the use made by the applicant is sufficient for the mark to have acquired distinctiveness. However, in case I am wrong, I will briefly discuss it.

44. First, as the opponent states in its submissions in lieu, the applicant did not plead acquired distinctiveness. However, I do not need to deal with this point because I find that the evidence filed does not establish acquired distinctiveness. As the opponent points out in its submissions, the applicant’s sales figures for the five-year period 2019-2024 was approximately £707K with the turnover for 2022/2023 being £134,928 and for 2023/2024 being £144,963 – however, since the relevant date is 17 April 2024, it is impossible to know what proportion of these sales relate to prior to the relevant date. These figures appear to be relatively low and the opponent filed evidence that the market for pregnancy tests in the UK, was estimated to be valued at USD 281.26 million in 2023 (which equates to around £212.4 million at current exchange rates) and that the applicant’s sales appear to equate to just a 0.06% market share. Further, there is no evidence about marketing spend. Overall, bearing in mind the relatively low level of sales, the minuscule market share and the absent of marketing spent I consider

⁴ Starbucks (HK) Ltd v British Sky Broadcasting Group Plc [2013] F.S.R. 29

that, were I wrong on the figurative element carrying the mark, this evidence would not establish acquired distinctiveness.

45. The opposition fails in its entirety, and the mark will proceed to registration.

COSTS

46. The applicant has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £1,500, calculated as follows:

Preparing the counterstatement

And considering the notice of opposition: £400

Filing evidence: £700

Written submissions: £400

Total: £1,500

47. I therefore order The Procter & Gamble Company to pay OVERSEAS TRADING LIMITED the sum of £1,500. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 25th day of August 2026

TERESA PINTO

For the Registrar