

**TRADE MARKS ACT 1994
AND
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. 774088
AND THE REQUEST BY CASA DAMIANI S.P.A
TO PROTECT A TRADE MARK IN CLASS 14**

Background

1. On 28 December 2001, CASA DAMIANI S.P.A. of Viale Santuario, 46, I-15048 VALENZA (AL), Italy, on the basis of international registration no.774088, requested protection in the United Kingdom, under the provisions of the Madrid Protocol, of the trade mark:

MATERNITY

2. The International Registration is numbered 774088 and protection is sought in Class 14 in respect of:

Precious metals and their alloys and goods made of or coated with these materials not included in other classes; jewellery, bijouterie, precious stones; timepieces and chronometric instruments.

3. It was considered that protection in the United Kingdom may be granted and it was published for opposition purposes in the official Trade Marks Journal No 6426 on 17 April 2002.

4. However, on 10 June 2002 the acceptance of this designation was withdrawn because it was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and notice of refusal under Article 9(3) was given because the trade mark is excluded from registration by Section 3(1)(b) and (c) of the Trade Marks Act 1994. This is because the mark consists exclusively of the word MATERNITY being a sign which may serve in trade to designate the kind and intended purpose of the goods, e.g. goods designed to be given as tokens of motherhood.

5. At a hearing, at which the applicants were represented by Mr Symonds of Mathys & Squire, their Trade Mark Attorneys, the objections were maintained. Notice of final refusal under Article 9(3) was issued on 19 August 2003. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of the decision and the materials used in arriving at it.

6. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

The Law

7. Section 3(1)(b) and (c) of the Act reads as follows:

“3.-(1) The following shall not be registered-

(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,”

Raising objections after acceptance and publication

8. At the hearing Mr Symonds submitted that the registry has no right to raise objections at this stage in the proceedings and went on to claim that the notification itself is deficient. In further submissions Mr Symonds claimed that the objections raised under Sections 3(1)(b) and (c) of the Act are invalid. In support of this Mr Symonds referred me to the references obtained from the Internet which were sent to him on 10 June 2002 and suggested that these references did not support the objection.

9. In his submissions Mr Symonds claimed that the Registry has no right to raise an objection after acceptance and publication of the designation. In support of this submission Mr Symonds referred me to Article 10(1) of The Trade Marks (International Registration) Order 1996 which reads as follows:

“Publication, opposition proceedings and observations

10.-(1) Where following examination pursuant to article 9 it appears to the registrar that the requirements of article 3 are met in relation to all or some of the goods or services comprised in the international registration, the registrar shall publish a notice specifying particulars of the international registration and specifying the goods or services for which protection will be conferred.”

10. Mr Symonds submitted that the inclusion of the word “will” has the effect of making it mandatory for the Registrar to confer protection.

11. Mr Symonds also submitted that the Notification of a Provisional Total Refusal of Protection was deficient because it did not comply with Rule 17(2) of the Common Regulations. The relevant part of Rule 17 of the Common Regulations reads as follows:

“(1) [Notification of refusal] The notification of any refusal of protection under article 5 of the Agreement and article 5 of the Protocol shall relate to one international registration, shall be dated and shall be signed by the Office making the notification.

(2) [Refusals not based on an opposition] Where the refusal of protection is not based on an opposition, the notification referred to in paragraph (1) shall contain or indicate

(i)

(ii)

(iii)

(iv) all the grounds on which the refusal is based together with a reference to the corresponding essential provisions of the law,

(v)

(vi)”

12. It is my view that the Notification of a Provisional Total Refusal of Protection was correctly raised and that it conforms with the requirements of the Order. The Registrar has the right to raise such a Notification at any time within 18 months; this is confirmed at Paragraph 11 of the Order. The inclusion of the word “will” in paragraph 10 of the Order cannot indicate that it is mandatory to confer protection after acceptance and publication. In my view Mr Symonds is placing too much emphasis on the word “will”. The following provisions provide support to this conclusion:

(i) Article 9 is not limited in any way as to time except by the time limit set out in article 11(1);

(ii) article 10(6) provides for observations to be filed after publication and

(iii) article 12(a)(i) only requires protection to be conferred where the period allowed for giving notice of refusal based on opposition expires without notice of refusal based on opposition or otherwise having been given.

13. Furthermore, I do not agree that the Notification did not comply with Rule 17(2)(iv) of the Regulations. The official letter dated 10 June 2002 does not constitute a formal Notification but an alert to the fact that formal Notification has been raised and forwarded to WIPO. The formal Notification was sent to the World Intellectual Property Organisation (WIPO) on 7 June 2002, a copy being forwarded to the applicants’ representatives with the official letter dated 10 June 2002. A copy of this formal Notification is on the Registry’s official file and it is clear that this Notification sets out the grounds on which the refusal is based together with a reference to the corresponding provisions of law.

The Decision on Absolute Grounds

14. At the hearing I agreed with Mr Symonds that the Internet references which were forwarded with the official letter dated 10 June 2002 were not conclusive as to the validity of the objection. However, I maintained the objection because I consider the word MATERNITY to be an everyday word which is apt for use in trade to describe goods which are given to a partner as a token of their love and devotion when celebrating the birth of a child.

15. Collins English Dictionary (5th. Edition first published 2000) provides the following definitions for the word MATERNITY:

“n. 1. Motherhood. 2. the characteristics associated with motherhood; motherliness. 3. Modifier; relating to pregnant women or women at the time of childbirth. e.g. a maternity ward.”

16. It is clear from a recent decision of the European Court of Justice that the concept of keeping signs free for descriptive use is a consideration which continues to apply in assessing registrability under section 3(1) of the Act. In *Linde A.G. v. Rado Uhren A.G.* (Case C-53/01) the following guidance was given at paragraphs 73 - 74:

“73. According to the Court’s case-law, Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, to that effect, Windsurfing Chiemsee, paragraph 25).

74. The public interest underlying Article 3(1)(c) of the Directive implies that, subject to article 3(3), any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all and not be registrable.”

17. In a recent Opinion of Advocate General Jacobs in *OHIM v. Wm. Wrigley Jr. Company* (Case C-191/01P) he said at paragraph 97:

“97. In any event, it seems clear that there was no intention, in the Baby-Dry judgment, to depart from the view in Windsurfing Chiemsee that it is in the public interest that descriptive signs may be freely used by all. Very recently, in Linde, (42) the Court has expressly reaffirmed that position.”

18. I do not contend that in relation to the goods applied for the word MATERNITY has become customary in the current languages or in the bona fide and established practices of the trade. This is confirmed by the fact that no objection has been raised under section 3(1)(d) of the Act.

19. As I have previously stated, the word MATERNITY is an everyday word which I consider is apt for use in trade to describe goods which are given to a partner as a token of their love and devotion when celebrating the birth of a child. The goods applied for include jewellery and goods made from or coated with precious metals. These terms cover all forms of jewellery such as rings, necklaces and bracelets. These goods may, of course, be purchased by individuals at any time but they are also very popular choices as gifts for others at moments that are commemorative for particular individuals. Rings in particular are traditionally given to one's partner to commemorate betrothal (engagement rings) and marriage (wedding rings). Eternity rings are often provided as tokens of lasting affection. Rings or other forms of jewellery are often given to one's children on the celebration of their 18th or 21st birthday and watches have for some time been a traditional present to celebrate one's retirement from a place of work after many years service. It is clear that many items of jewellery are often given to commemorate a particular event or milestone in one's life.

20. To many people in the United Kingdom the birth of a child is a moment of supreme joy and happiness and is a moment that seems to be perfectly apt for a gift or token of love between the parties concerned. It is clear that in respect of this application I must consider the trade mark, MATERNITY, and judge if it is an apt term to be used in trade to describe a characteristic of the goods applied for.

21. In order to judge this matter I must look through the eyes of the relevant consumer of the goods applied for, whom, in this case, I judge to be, or to include, the general public. The general public have become accustomed to purchasing goods covered by the specification applied for as commemorative gifts or tokens of love and devotion. In my view a member of the public encountering this trade mark, in use in relation to these goods, would not perceive it to be a sign denoting trade origin. They would judge it as an indication that the goods sold bearing this sign are suitable to be offered as gifts or tokens of love and devotion for a particular event be it the news that one is with child or that the child is now born. They would view it in the same way as they would the words ETERNITY, WEDDING or ENGAGEMENT. They would see it as no more than an indication that the goods are suitable as a commemoration of that particular event.

22. As Simon Thorley QC said when acting in his capacity as the Appointed Person in the FOIA Centre decision:

“10. It is also plain from a recent decision of the Court of Justice (see Case C-53/01) Linde A.G. v. Rado Uhrn A.G. (8th April 2003) and a recent opinion of Advocate General Jacobs (see Case C-191/01P OHIM v. Wm. Wrigley Jr. Company) that the concept of keeping signs free for descriptive use is a consideration which continues to apply in assessing registrability under Section 3.

11. In my judgment therefore Mr James' submissions as to the applicable law under Section 3(1)(c) are correct. It is not sufficient merely to take a snap shot of the appreciation of the relevant consumer as at the date of application. It is necessary, following the guidance in the Windsurfing case, to look ahead and look around in order to ensure that trade mark protection is not being given to a sign which may, (in the sense of being reasonably likely to), serve in trade to designate one of the

descriptive aspects referred to in section 3(1)(c).”

23. When considering this matter through the eyes of the relevant consumer of the goods in question I consider it to be reasonably likely that the word MATERNITY is one which is, or will be in the foreseeable future, one which is apt for use in trade to describe a characteristic of goods contained within the specification of goods applied for in this application.

24. In the circumstances I have concluded that the trade mark at issue comprises a word which, prima facie, cannot distinguish the applicants' goods from those of other undertakings and is therefore debarred from registration by Section 3(1)(c) of the Act.

25. For the same reasons I consider the trade mark to be devoid of any distinctive character and therefore not acceptable for registration under Section 3(1)(b) of the Act.

Conclusion

26. In this decision I have considered all the documents filed by the applicants and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Articles 3 and 9(3) of the Trade Marks (International Registration Order 1996 (as amended) because it fails to qualify under Sections 3(1)(b) and (c) of the Act.

Dated this 21st day of October 2003

**A J PIKE
For the Registrar
The Comptroller General**