

O-012-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2210056
BY SOVEREIGN HOMEMAKER
TO REGISTER THE TRADE MARK:**

PINEWOOD STUDIOS

IN

CLASS 20

AND

**THE OPPOSITION THERETO
UNDER NO 90343
BY PINEWOOD STUDIOS HOLDINGS LIMITED
AND
PINEWOOD STUDIOS LIMITED**

Trade Marks Act 1994

**In the matter of application no 2210056
by Sovereign Homemaker
to register the trade mark:
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and
the opposition thereto
under no 90343
by Pinewood Studios Holdings Limited
and Pinewood Studios Limited**

BACKGROUND

1) On 30 September 1999 Sovereign Homemaker, which I will refer to as Sovereign, applied to register the trade mark **PINEWOOD STUDIOS**. The application was published for opposition purposes in the “Trade Marks Journal” on 9 May 2001 with the following specification:

furniture, chairs, tables, mirrors, picture frames; goods (not included in other Classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother of pearl, meerschaum and substitutes for all of these materials, or of plastics; all being made from pine.

The above goods are in class 20 of the International Classification of Goods and Services.

2) On 8 August 2001 Pinewood Studios Holdings Limited and Pinewood Studios Limited, which I will jointly refer to as Studios, filed a notice of opposition. Since the filing of the opposition the statement of grounds has been amended on two occasions.

3) Studios states that Pinewood Studios Holdings Limited, which I will refer to as Holdings, is the parent company of Pinewood Studios Limited. Pinewood Studios Limited and/or its predecessors have operated a film studio under the name **PINEWOOD STUDIOS** from premises in Iver Heath, Buckinghamshire continuously since 1936. Studios states that **PINEWOOD STUDIOS** is a name synonymous with British films and film makers as well as some of the biggest and most successful American films ever made. Studios claims that **PINEWOOD STUDIOS** is the world’s most famous film studio and over the years has produced films directed by such people as Charlie Chaplin, Alfred Hitchcock, Stanley Kubrick, David Lean, Michael Powell, Ridley Scott and Billy Wilder. Nearly all of the “Carry On...” series of films and the James Bond films were produced at Pinewood Studios.

4) Holdings is the owner of five trade mark registrations. Two of these are for the trade mark **PINEWOOD STUDIOS**. The details of these registrations are as follows:

- United Kingdom registration nos 2146498A and B for:

articles of clothing; headwear and footwear;

provision of entertainer, amusement, leisure and recreation facilities, services and amenities; nightclub, discotheque, music hall, concert, dance hall, ballroom, cabaret, cinema and theatre services; amusement park, arcade and centre services, leisure centre, boating lake and water-shute complex services; funfair, circus and bingo hall services; provision of public baths, aquatic recreation, swimming, windsurfing, water skiing and outdoor recreation facilities, services and amenities; health and fitness club services; tenpin bowling alley and bowling green services; sports instruction services; organisation of recreational activities, quizzes, games and competitions; production of shows and of cabarets; organisation of beauty competitions; consultancy services relating to the planning of conferences, seminars and banquets; theme park services; instruction and tuition in association with all of the aforesaid;

hotel, motel and boarding house services; provision of tourist house and accommodation services; cafe, cafeteria, canteen, bar, coffee shop, snack-bar and restaurant services; catering services; provision of food for consumption off the premises; provision of holiday camp and camp ground services, facilities and amenities; provision of exhibition facilities and amenities; beauty salon services; provision of sauna and solarium services, facilities and amenities; provision of facilities and amenities all for conferences, seminars and banquets; booking and reservation services, all relating to all the aforesaid, provision of holiday accommodation; provision of caravan, mobile home, camp and camp ground services.

The above goods and services are in classes 25, 41 and 42 respectively of the International Classification of Goods and Services.

The other three registrations are for the trade mark **PINEWOOD**. The details of these are as follows:

- United Kingdom trade mark registration nos 1283325 and 1283326 which are for the following services respectively:

construction, restoration, repair, maintenance and alteration services relating to film, to television and to theatre sets; painting services; plastering services; masonry, metal casting and upholstery services all relating to film, to television and to theatre sets; rental of construction apparatus and of tools; maintenance and repair of lighting, of sound and of film apparatus; all included in Class 37;

cine-film production; production of radio and of television programmes; film-recording studios; rental of show scenery and of stage scenery; rental of film and of sound apparatus; rental of movie and of film projectors; cine-film rental; production of shows and cabarets; all included in Class 41.

- Community trade mark registration no 192831 which is registered for the following services:

film production, movie studio services; rental and production of stage scenery; films sets and the like; film post-production services;

films prepared for exhibition.

The above goods and services are in classes 9 and 41 respectively of the International Classification of Goods and Services.

Studios state that registration of the trade mark would be contrary to section 5(3)(b) (sic) of the Trade Marks Act 1994 (the Act). Studios state that Sovereign's trade mark is identical to Holding's trade marks and is for goods which are not similar to those encompassed by Holding's registrations. In view of the reputation for the trade mark PINWOOD STUDIOS use of Sovereign's trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

5) Studios state that Sovereign's trade mark offends against the provisions of section 3(1)(a), (b) and (c) of the Act in that the trade mark:

- is not capable of distinguishing the goods of one undertaking from those of other undertakings (section 3(1)(a) of the Act);
- is devoid of any distinctive character (section 3(1)(b) of the Act);
- consists exclusively of signs or indications which may serve in trade to designate the kind, intended purpose, or other characteristics of the goods to which the trade mark is applied .

Studios states that the witness statement submitted by Sovereign dated 16 January 2003, makes it clear that Sovereign's use is entirely descriptive.

6) Studios requests that the application is refused in its entirety and requests an award of costs.

7) Sovereign filed a counterstatement. It states the following:

“We have no quarrel with the claim and pedigree of Pinewood Studios through their fame and fortune as a film studio.

We dispute that our business or quality of business will touch on or damage the reputation of Pinewood Studios. As a matter of fact our businesses date from the 1920's and have always enjoyed a first class reputation locally which has always been as you can expect well earned.

Is it really a TRADE MARK an all encompassing trade mark, I think not. It is two words from the English dictionary. I agree that if we were to copy or to TAKE FROM the reputation of the Film Studios by work of a similar nature or to undertake work on a prohibited use as described in their protective list then we would be wrong. Someone has seen fit to list ALL the areas that they thought would incriminate their trade mark or other area where they would apply their trade mark. The use that we have applied has not been listed, otherwise our patent agent would have advised in the beginning SORRY ALREADY TAKEN.

There is little merit in their defence using sections 3a b and c. We are distinguishing exactly our undertaking. We are not aware that we have to write the words in any particular script i.e. serif or sanserif or any other type of letter.

In part they are quite correct, in the trade we quite commonly describe pine or pinewood as a description for this particular type of wood.

Pine wood is a soft wood usually used in the solid, in a variety of finishes and is very distinct from other woods. There are quite a few varieties of pine originating from many countries e.g. Canada, Northern Europe and Russia to name three, some fast growing some slow growing.

We chose PINEWOOD as our first word because it encapsulates exactly what we exclusively sell.

We also had a choice of many words to use in our title name of “Shop”.

SHOP was too common.

MART – it is not an auction house.

MARKET – it is not a stall.

And we settled on STUDIO simply because it also suitable describes what we get up to in the shop. We design and create rooms for people in pine. Yes it is descriptive, fits exactly.

When I first heard of the proposed name from a shortlist I gave my vote to the words Pinewood studio with the comments “Brilliant” simply the best.

We asked our patent agents to check if it was possible to register PINEWOOD STUDIOS in reference to FURNITURE – our speciality. They checked and advised in the positive.

We now have the position of the Glasgow Patent Agents versus the London Patent Agents each arguing that they are right. Our agents must be very aware of the 1994 Trade marks act as demonstrated in Mr Neil McKechnies counter statement of the 20/11/01. he succinctly and adequately covers all the relevant points which have been re-dug up by Wildbore and Gibbons.

My additional material was simply meant as proof of our type of establishment and the way in which we advertise it and the selection of the products which I thought would be helpful and give a visual focus on the problem.

I now repeat myself as it is unreasonable in my opinion to give one party exclusive rights for two very common words in the English language and dictionary but it is reasonable to give the exclusive rights to a party to use the words as theirs for a particular type of trade. We accept that Pinewood Film Studios have the exclusive rights to the words as it refers to the world of entertainment and for the list of categories in which their application has been successful, but as already highlighted in my opinion would be totally unreasonable to prohibit the use when applied to pinewood furniture and the logic it brings and not to mention it is a category not covered in the areas of protection of the Film Studio.”

8) Both sides filed evidence.

9) The matter came to be heard on 7 January 2004. Sovereign was represented by Mr Ewing,

a partner in Sovereign. Studios were represented by Mr March, of Wildbore & Gibbons.

Evidence of Studios

10) This consists of witness statements by Paul Leonard Hitchcock, Iain Alastair Robertson Smith, Robin Busby, Michael G Wilson and Brian Herbert March. The first four witness statements go, to the most part, to the issue of the fame of PINEWOOD STUDIOS as a film studio. This is accepted by Sovereign in its counterstatement. I do not consider that there is any doubt that PINEWOOD STUDIOS is famous as a film studio. The first four witnesses stray into considering the effects of registering the trade mark of Sovereign. This is an issue for me to consider and not the witnesses, they are expert on the market and/or their businesses not on the provisions of the Act (see by analogy *European Limited v The Economist Newspaper Ltd* 1998 FSR 283 at 291 – expert witnesses “are experts in the market, not on confusing similarity”). The final witness statement from Mr March picks out various of the comments made by Mr Ewing for Sovereign in his witness statement of 16 January 2003. I deal with Mr Ewing’s evidence below.

Evidence of Sovereign.

11) The first evidence of Sovereign is a statutory declaration by Neil McKechnie, who was Sovereign’s trade mark attorney. Mr McKechnie’s declaration represents submissions and a critique of the evidence of Studios rather than evidence of fact. Consequently, as there is no evidence of fact to comment upon, I will say no more about the statement of Mr McKechnie here. However, I bear in mind his comments in reaching my decision.

12) The other evidence of Sovereign is a witness statement made by Ian Alexander Ewing. Mr Ewing is a partner in Sovereign. Three items are exhibited to the statement:

- A picture of the PINEWOOD STUDIOS’ shop, this shows the words PINEWOOD STUDIO on the signage. Beneath these words SPECIALISTS IN PINE BEDROOM FURNITURE is written.
- An advertisement for PINEWOOD STUDIOS in Falkirk. The advertisement relates to pine bedroom, lounge and dining furniture.
- An advertisement for PINEWOOD STUDIO. This advises that the shop specialises in pine furniture.

13) Mr Ewing states the following, inter alia:

“The combined material will give an additional focus on the problem by simply showing that we sell PINE WOOD FURNITURE (not plastic or any other material) simply furniture made from pine wood and mostly bedroom furniture. We sell it from premises we call a shop and we design bedroom and home interiors from within the premises, therefore we call it a studio hence Pinewood Studio. To give any person or firm the exclusive rights to three words from the English dictionary would not be appropriate or fair. We are simply using the words LITERALLY.”

DECISION

Objection under Section 5(3) of the Act

14) Section 5(3) of the Act reads:

“(3) A trade mark which—

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

15) In considering the issue I first need to consider which trade mark(s) is being considered. The statement of grounds claims a reputation for PINEWOOD STUDIOS. Other than the statement in paragraph 1 of the statement of grounds, that Holdings is the owner of the trade marks PINEWOOD STUDIOS and PINEWOOD, there is no reference to PINEWOOD on its own. Throughout the rest of the statement of grounds there is reference to PINEWOOD STUDIOS. The statement of grounds refers to the reputation in the trade mark PINEWOOD STUDIOS, not PINEWOOD on its own. I pointed this out to Mr March at the hearing. He submitted that there was an inferred claim to reputation for PINEWOOD on its own. I do not consider that is appropriate to infer the basis of objections in grounds of objections. The grounds were the third set of grounds submitted by Studios. They had plenty of time to clarify and make clear what their grounds were. Studios must stand or fall by the grounds which it has chosen. It has not claimed a reputation for PINEWOOD on its own. Consequently, I will deal with section 5(3) objection on the basis of PINEWOOD STUDIOS. I also note, although nothing turns upon this, that the witness statements invariably relate to the trade mark PINEWOOD STUDIOS. Mr Hitchcock only refers to PINEWOOD STUDIOS. Mr Smith only refers to PINEWOOD STUDIOS. Mr Busby, who supplies the most comprehensive statement, refers specifically to PINEWOOD STUDIOS. In over five pages he refers to PINEWOOD on its own only once. In paragraph 11 of his statement he deals with the reputation of PINEWOOD STUDIOS in detail. He refers to PINEWOOD STUDIOS eight times, PINEWOOD not once. At no time does Mr Busby, who is the deputy managing director of Pinewood Studios Limited, refer to a reputation for PINEWOOD on its own. Mr Wilson in his statement refers to PINEWOOD twice and PINEWOOD STUDIOS nine times. Even if using inference was appropriate in relation to a statement of grounds the evidence would not support the claimed implication.

16) Sovereign accept that there is a reputation in PINEWOOD STUDIOS as a film studio. Do any of the goods and services of the PINEWOOD STUDIOS registrations include goods or services which would be covered by such a reputation? Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

I will give the words in the specifications their natural meaning. I also bear in mind the comments of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* where he stated:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.”

I take on board the class in which the goods or services are placed is relevant in determining the nature of the goods and services (see *Altecnic Ltd's Trade Mark Application* [2002] RPC 34). In relation to the services I firmly bear in mind the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

Taking on board the above, I cannot see how any of the goods or services of the PINEWOOD STUDIOS registrations encompass anything that fall within the reputation of the film studios. Mr March, when I put this point to him, argued that *provision of entertainer, amusement, leisure and recreation facilities, services and amenities; cinema services; production of shows and of cabarets* of the class 41 specification would encompass services for which there is a reputation. I do not consider that this would follow from a normal reading of the terms within the context of the trade. To accept such an interpretation would also require, in my view, giving an over wide construction to the terminology. *Provision of entertainer, amusement, leisure and recreation facilities, services and amenities*, in my view, clearly relates to end services supplied to the public, not the services of a film studio. *Cinema services*, to me, clearly means the services of public cinemas. It is what the likes of UGC do, not Studios. I cannot see how what Studios do can be described as *production of shows and of cabarets*, this is what goes on in theatres and clubs. The sort of things that a reputation could be claimed for are covered by the PINEWOOD registrations and are noticeably absent from the PINEWOODS STUDIOS registrations eg *masonry, metal casting and upholstery services all relating to film, to television and to theatre sets, cine-film production and film-recording studios*.

17) Studios claim a reputation in PINEWOOD STUDIOS only. The reputation is accepted. However, there is nothing in the specifications of the registrations of Holdings that include goods or services to which the reputation would accrue. Consequently, the objection under section 5(3) of the Act must fail.

18) If I am wrong in the above and there is something in the specifications to which Studios' reputation would accrue, could they succeed under this head? I have had some difficulty in actually ascertaining what the basis of the objection under section 5(3) is. The grounds

effectively rehearse the Act. Mr March's skeleton argument simply listed the basic premises behind section 5(3) without any linkage to this particular case or specific identification as to the nature of the heads of damage.

19) In his opinion in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* Case C-408/01 (paragraph 36 et seq) Advocate General Jacobs summarised the bases for a claim under Article 5(2) of First Council Directive 89/104 of December 21, 1988 (from which section 5(3) of the Act is derived):

“Article 5(2) protects the proprietor of a mark with a reputation against use of an identical or similar sign where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark'. There are thus in principle four types of use which may be caught: use which takes unfair advantage of the mark's distinctive character, use which takes unfair advantage of its repute, use which is detrimental to the mark's distinctive character and use which is detrimental to its repute.

The concept of detriment to the distinctive character of a trade mark reflects what is generally referred to as dilution. That notion was first articulated by Schechter, who advocated protection against injury to a trade mark owner going beyond the injury caused by use of an identical or similar mark in relation to identical or similar goods or services causing confusion as to origin. Schechter described the type of injury with which he was concerned as the gradual whittling away or dispersion of the identity and hold upon the public mind' of certain marks. The courts in the United States, where owners of certain marks have been protected against dilution for some time, have added richly to the lexicon of dilution, describing it in terms of lessening, watering down, debilitating, weakening, undermining, blurring, eroding and insidious gnawing away at a trade mark. The essence of dilution in this classic sense is that the blurring of the distinctiveness of the mark means that it is no longer capable of arousing immediate association with the goods for which it is registered and used. Thus, to quote Schechter again, for instance, if you allow Rolls Royce restaurants and Rolls Royce cafeterias, and Rolls Royce pants, and Rolls Royce candy, in 10 years you will not have the Rolls Royce mark any more'.

In contrast, the concept of detriment to the repute of a trade mark, often referred to as degradation or tarnishment of the mark, describes the situation where - as it was put in the well-known *Claeryn / Klarein* decision of the Benelux Court of Justice - the goods for which the infringing sign is used appeal to the public's senses in such a way that the trade mark's power of attraction is affected. That case concerned the identically pronounced marks *Claeryn'* for a Dutch gin and *Klarein'* for a liquid detergent. Since it was found that the similarity between the two marks might cause consumers to think of detergent when drinking *Claeryn'* gin, the *Klarein'* mark was held to infringe the *Claeryn'* mark.

The concepts of taking unfair advantage of the distinctive character or repute of the mark in contrast must be intended to encompass instances where there is clear exploitation and free-riding on the coat tails of a famous mark or an attempt to trade upon its reputation'. Thus by way of example Rolls Royce would be entitled to prevent a manufacturer of whisky from exploiting the reputation of the Rolls Royce mark in order to promote his brand. It is not obvious that there is any real difference between

taking advantage of a mark's distinctive character and taking advantage of its repute; since however nothing turns on any such difference in the present case, I shall refer to both as free-riding.”

(The footnotes have been removed.)

20) At the hearing Mr March seemed to put forward that use of Sovereign’s trade mark would fall foul of section 5(3) because:

- 1) Use by Sovereign of its trade mark on furniture of a poor standard would damage the repute of Holdings’ trade mark.
- 2) Use by Sovereign of its trade mark would take advantage of the repute in Holdings’ trade mark.
- 3) Use by Sovereign of its trade mark would dilute the distinctive character of Holdings’ trade mark.
- 4) Registration of Sovereign’s trade mark might inhibit Holdings from producing furniture at some stage.

I consider that points one and four are non-starters. The argument behind point one would give carte blanche to stopping any goods on the contingent basis that the opponent could not control the quality of the goods. In *Daimler Chrysler AG v Javid Alavi trading as MERC* [2001] RPC 42 Pumfrey J stated:

“...but Jacobs AG emphasises that the provision is not to be used to give marks ‘an unduly extensive protection’”

Mr March’s argument would give the excessive protection that is not to be allowed. It is also contrary to the accepted jurisprudence. This looks upon the issue turning upon the nature of the goods. Neuberger J in *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 referred to *Lucas Bols v. Colgate-Palmolive* (1976):

“The best-known example of tarnishing is perhaps to be found in the decision of the Benelux Court of Justice in *Lucas Bols v. Colgate-Palmolive* (1976) 7 I.I.C. 420 where the mark CLAERYN for gin was held to be infringed by use of the sign KLAREIN for a detergent. The court said the following:

It is ... possible ... that the goods to which [the use of] a similar mark relates, appeals to sensations of the public in such a way that the attraction and the "capacity of the mark to stimulate the desire to buy" the kind of goods for which it is registered, are impaired.”

In *Hollywood SAS v Souza Cruz SA* [2002] ETMR 64 the Third Board of Appeal of the Office for Harmonization in the Internal Market (OHIM) commented at paragraph 68:

“In the light of these aspects, the idea that the appellant's trade mark conveys a message of health, dynamism and youth cannot be ruled out as a matter of principle, provided that evidence of this is adduced. However, in order to be protected within the meaning of Article 8(5) CTMR, this image must have acquired a level of reputation. The Opposition Division considered that the opponent had submitted adequate evidence of the existence of the trade mark's reputation, but that it had not proved the existence of an image association with the trade mark possessing this reputation.

Therefore the evidence to be adduced must focus specifically on the existence of this image association with the trade mark which possesses the reputation.”

In the above case the clash was between chewing gum and cigarettes, tobacco products, lighter and matches. The Third Board of Appeal only found that there was a viable case in respect of cigarettes, tobacco, tobacco products and smokers' articles. The opposition was rejected for lighters and matches. The opponent could only succeed for the goods which by their nature could damage the repute of the opponent. On the basis of Mr March's argument such goods as industrial chemicals and medical apparatus would be caught, if Studios' did not control the quality of the goods.

21) There is nothing in the nature of the goods of Sovereign which suggests that the repute of Holdings would be damaged by use of the trade mark upon the goods in the specification.

22) The fourth basis of the claim can be seen as fettering, a concept that is not found in the analysis of the Advocate General above. The concept of fettering as a form of damage under section 5(3) was raised in *LOADED* BL 0/455/00, a decision of Mr Thorley QC, sitting as the appointed person. As far as I am aware this is the only decision in which it has been accepted. I consider that there is a clear difference between this case and *LOADED*. In *LOADED* the issue went to the core business of the opponent:

“Equally the possibility that the widespread use of the trade mark on clothing could materially affect the ability of *LOADED* magazine to obtain advertisements from others for their clothing in the magazine is real not fanciful for the reasons not given by Mr. Paul.”

Advertising is a key part of any magazine publisher's business. The claimed fettering in this case does not affect the business of Holdings. Again it is a contingent claim. What if Holdings decided it wanted to market furniture? The same could be said about any undertaking. To succeed Studios need to show a lot more than a “what if”.

23) In *Premier Brands UK Ltd v Typhoon Europe Ltd* Neuberger J stated:

“As I have mentioned, the mere fact that the way in which the sign is used by TEL may give rise to an association between the sign and the mark in the minds of some members of the public is, in my judgement, simply not enough on its own to enable the proprietor of the mark, however well known and valuable it may be, to invoke section 10(3).”

In *Daimler Chrysler AG v Javid Alavi trading as MERC* Pumfrey J stated

“...but Jacobs AG emphasises that the provision is not to be used to give marks ‘an unduly extensive protection’, emphasising that there is a question of a risk of unfair advantage or detriment: there must be actual unfair advantage or detriment. But, for this to happen, there must be some sort of connection formed (I avoid the word association) between the sign used by the defendant and the mark and its associated reputation”

A mere association will not be enough for Studios to succeed. In considering the issue various factors need to be borne in mind. The respective trade marks are identical. For film studios

PINEWOOD STUDIOS, as a whole, is distinctive. In *Premier Brands UK Ltd v Typhoon Europe Ltd* the following is said:

“Mr Arnold contended that the effect of section 10(3) was that the stronger the distinctive character and reputation of a particular trade mark, the easier it would be to establish detriment to it. In my judgement, that is a good point.”

Consideration has to be given as to what the reputation of the earlier trade mark relates and to the goods of the later trade mark. These are not issues that can be considered in a void. There is no obvious connection between the goods of the application and the work of a film studio. Indeed the respective businesses seem to be completely different. Mr Wilson refers to the selling off of old props by Studios. However, I do not see that the occasional sale of props would connect to the goods of the application. The props are more likely to be bought primarily as memorabilia rather than for function. This is also a very specialist niche market. I need to consider the average consumer for the goods of the application. It is also the case that the goods of the application are all of pine, if somewhat surprisingly taking into account some of the listed goods. The PINEWOOD element of Sovereign’s trade mark will clearly in the context of the goods bring to mind the material of manufacture. Taking into account the nature of the goods, the distance between the services of a film studio and the goods of the application, I consider that the public concerned is most likely to see the use of the trade mark of Sovereign as a clever play on words. He or she might think of the business of Studios but I do not think he or she will consider that there is a connection. It will be a mere bringing to mind. The presence of two trade marks where there was one is not enough for success:

“The presence of two similar marks where there was only one before seems to me to be detrimental to the distinctive character of the first. I am satisfied that this is not what the words are talking about.”

(*Daimler Chrysler AG v Javid Alavi trading as MERC.*)

24) I do not need to consider the issue of “without due cause”. If Studios had established its case, taking into account the findings in *Premier Brands UK Ltd v Typhoon Europe Ltd & Another*, Sovereign could not have relied upon due cause. There is also no issue as to whether the goods and/or services are similar or not. There has been an acceptance that they are not and even if they were this would not place the matter outside of section 5(3) of the Act (see the decision of the European Court of Justice in *Adidas-Salomon AG, formerly Adidas AG, Adidas Benelux BV and Fitnessworld Trading Ltd* Case C-408/01 to this effect.)

25) In the absence of any connection the basis of section 5(3) of the Act under points two and three must also fail. So if I am wrong in my finding in paragraph 17 Studios’ case would still fail.

26) For the purposes of finality and so as not to leave any matters hanging in the air, I will briefly deal with the PINEWOOD trade marks, for which a reputation was not claimed in the grounds of opposition. If a reputation had been pleaded and established the consumer would be expected, on the basis of Studios’ claim, to see a connection between PINEWOOD of Holdings and the trade mark of Sovereign, in relation to goods made of pine (wood). I consider that taking into account the nature of the goods the consumer would not only not see a connection, he or she would not even make an association. For pine goods he or she would see PINEWOOD as relating to the goods and not to the trade mark of Holdings. So if Studios

had established a basis under Section 5(3) of the Act, even though its registrations encompass services directly related to its reputation, the nature of the goods of the application would militate against a finding for them.

Objection under Sections 3(1)(a), (b) and (c) of the Act

27) The relevant sections of the Act read as follows:

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

(a) signs which do not satisfy the requirements of section 1(1),

(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,

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.

1.— (1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

28) The European Court of Justice in *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) and Boots- und Segelzubehör Walter Huber* [1999] ETMR 585 set out the sort of evidence that is needed to show distinctiveness acquired through use:

“— in determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;

— if the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied;

— where the competent authority has particular difficulty in assessing the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude it from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment.”

The evidence of Sovereign clearly does not satisfy the above requirements and so Sovereign cannot seek assistance from the proviso. Its case stands or falls upon the nature of the trade mark.

29) In *Philips Electronics NV v Remington Consumer Products Ltd* [2003] RPC 2 the European Court of Justice held that:

“It is true that Art.3(1)(a) of the Directive provides that signs which cannot constitute a trade mark are to be refused registration or if registered are liable to be declared invalid.

37 However, it is clear from the wording of Art.3(1)(a) and the structure of the Directive that that provision is intended essentially to exclude from registration signs which are not generally capable of being a trade mark and thus cannot be represented graphically and/or are not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

38 Accordingly, Art.3(1)(a) of the Directive, like the rule laid down by Art.3(1) (b), (c) and (d), precludes the registration of signs or indications which do not meet one of the two conditions imposed by Art.2 of the Directive, that is to say, the condition requiring such signs to be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

39 It follows that there is no class of marks having a distinctive character by their nature or by the use made of them which is not capable of distinguishing goods or services within the meaning of Art.2 of the Directive.

40 In the light of those considerations, the answer to the first question must be that there is no category of marks which is not excluded from registration by Art.3(1)(b), (c) and (d) and Art.3(3) of the Directive which is none the less excluded from registration by Art.3(1)(a) thereof on the ground that such marks are incapable of distinguishing the goods of the proprietor of the mark from those of other undertakings.”

Consequently, if I find that the trade mark of Sovereign is not objectionable under sections 3(1)(b) and (c) the ground of opposition under section 3(1)(a) must also fall. As the trade mark is clearly graphically represented this ground would seem, anyway, completely superfluous.

30) I intend to consider the section 3(1)(b) objection first. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)*). In *Rewe Zentral* the Court of First Instance also stated:

“The signs referred to in Article 7(1)(b) of Regulation No 40/94 are signs which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition.”

In *Cycling Is...TM* [2002] RPC 729, Mr Hobbs QC, sitting as the appointed person, describes trade marks as being origin neutral and origin specific ie those which act as an indicator of origin and those which do not. The purpose of a trade mark is to indicate origin. In *Sykes*

Enterprises, Incorp v OHIM (Real People Real Solutions) T-130/01 the Court of First Instance stated:

“Since the relevant consumer is not very attentive if a sign does not immediately indicate to him the origin and/or intended use of the object of his intended purchase, but just gives him purely promotional, abstract information, he will not take the time either to enquire into the sign's various possible functions or mentally to register it as a trade mark.”

The basis of Studios' claim under section 3(1) of the Act lay in the comments of Mr Ewing in his additional evidence. They have put no evidence of their own in. Mr March submitted that Mr Ewing in his evidence about the nature of his trade mark was being disingenuous. I consider that Mr Ewing's evidence merely shows the lay person's completely understandable lack of knowledge of trade mark law. It would be a strange type of disingenuousness that made what might be considered admissions against interest. I have produced Mr Ewing's comments in both his evidence and counterstatement verbatim at the beginning of the decision. Mr Ewing describes the goods as being made of pine wood and a design service being supplied by a studio. Of course, Mr Ewing has not applied for registration of a design service. He has applied for registration of goods. Pine wood does describe the nature of the material of manufacture of the goods. I do not consider that it is the normal way of describing such goods, however, Mr Ewing states that it is a way of describing the material of manufacture of the goods. The exhibits he has produced show use of pine in relation to the goods, not pine wood. In my experience it is the term pine that is normally used to describe furniture made from pine. Pine wood is more likely to describe a wood of pine trees rather than the wood from which goods are made. Of course that a term has two meanings does not preclude it from being objectionable (see *Wrigley v OHIM (DOUBLEMINT)* Case C-191/01 P). To consider whether the trade mark acts as an indicator of origin it is necessary to consider it in its entirety. There is no evidence that the word studios is used as a synonym for shop. Mr Ewing relates this word to the design work of Sovereign. It is also the case that PINEWOOD STUDIOS is likely to be seen as a clever form of wording, playing on the name of the studios – although not connecting with them. I consider that the trade mark PINEWOOD STUDIOS for the goods of the application can, in the terms of *Rewe Zentral*, allow the satisfied customer to purchase the goods again and the dissatisfied customer to avoid purchasing the goods again. I do not consider that the trade mark is devoid of any distinctive character. **The ground of objection under section 3(1)(b) of the Act is dismissed.**

31) My comments in relation to section 3(1)(b) impinge, to some extent, upon the objection under section 3(1)(c) of the Act. These are not watertight, mutually exclusive areas. In considering the matter under section 3(1)(c) I consider it useful to keep in mind the following words from the opinion of Advocate General Jacobs in *Wrigley v OHIM (DOUBLEMINT)* Case C-191/01 P):

“Similarly, any difference between terms used in the mark whose registration is sought and those which may serve in trade to designate characteristics of the relevant products must be more than minimal before registration can be accepted. If that were not so, it would be possible to register any mark which to all practical intents and purposes consisted exclusively of terms which may serve to designate a products characteristics, save for some insignificant discrepancy introduced solely in order to obtain registration. Such a situation would clearly be contrary to the legislative intention of Article 7(1)(c) of the Trade Mark Regulation.”

In the judgment for the same case the European Court of Justice stated:

“In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provisions itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

32) The goods of the specification are all of pine. Mr Ewing states that pine wood describes the material his goods are made from. As I have stated above I do not consider that pine wood would be the normal way of describing such goods. However, it is Mr Ewing’s claim, it is an admission against interest and so I do not see that I have any choice but to accept it. The trade mark is not PINEWOOD on its own. It includes the word STUDIOS. I do not see how STUDIOS describes any characteristic of the goods. If the trade mark was for a design service this would be another matter. I also do not see that the presence of this word is minimal. In considering the trade mark, I have to consider it in its entirety. In so doing I cannot see how it can fall foul of section 3(1)(c) of the Act. **The objection under section 3(1)(c) of the Act is dismissed.**

33) As I indicated above if the objections under section 3(1)(b) and (c) of the Act failed, the objection under section 3(1)(a) has to fail. **I, therefore, dismiss the objection under section 3(1)(a).** I cannot see that this objection had any merit or any chance of success. The section 3(1)(c) objection, in my view, also had little hope of success, in view of the presence of the word STUDIOS. The issue really was a matter of section 3(1)(b) of the Act. Would the trade mark be seen as an indicator origin or not? I have decided that it would. Studios made no objection to the trade mark under section 3(1) of the Act until the evidence of Mr Ewing came in. Clearly it did not identify an objection until it latched on to Mr Ewing’s evidence.

34) Sovereign Homemaker having been successful is entitled to a contribution towards its costs. I order Pinewood Studios Holdings Limited and Pinewood Studios Limited to pay Sovereign Homemaker the sum of £1075. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of January 2004

**David Landau
For the Registrar
the Comptroller-General**