

O-255-07

**IN THE MATTER OF TRADE MARK APPLICATIONS
NO. 2371978 AND 2371979 IN THE NAME OF BOSTIK LIMITED
TO REGISTER A TRADE MARK IN CLASSES 1 AND 16**

AND

**IN THE MATTER OF OPPOSITIONS THERETO
UNDER NOS. 93242 AND 93243 IN THE NAME OF
HENKEL KGAA**

DECISION

Introduction

1. This is an appeal against two related decisions of the Hearing Officer, Mr. Mike Foley, dated 14 December 2006, in which he rejected opposition proceedings brought by Henkel KGAA against two separate applications, No 237978 to register the mark HYPER GLUE and No 2371979 to register the mark HYPAGLUE. It is common ground that I should deal with the two appeals together.

Background

2. Each of the trade mark applications in issue on this appeal was filed on 1 September 2004. Both now stand in the name of Bostik Limited. Application No. 2371978 sought registration of the trade mark HYPER GLUE in Classes 1 and 16, in relation to the following specifications of goods:
Class 1 Adhesives; adhesive preparations, substances, materials and coatings; preparations for sealing; hardening preparations, solvents, resins; chemical preparations for sealing; bonding agents for admixture with grouts; chemical sealing grout for use in the building and construction industry; mixtures of resin and filler for use as a grout.

Class 16 Adhesives; glues; paste; gums; adhesive preparations, substances and materials; sealing preparations and compounds.

Application No. 2371979 sought to register the trade mark HYP A GLUE for an identical specification of goods in Classes 1 and 16,

3. On 3 March 2005, Henkel KgaA filed notices of opposition to each application; both grounds of opposition relied upon each of subsections 3(1)(a), (b), (c) and (d) of the 1994 Act. The main thrust of the Statement of Grounds of Opposition was that as the contested marks consist of two text elements hyper/hypa and glue, this will indicate that the product is more adhesive or more efficient than other products in the marketplace.
4. Both parties filed evidence on the opposition, much of which consisted effectively of submissions, with the most significant evidence being various exhibits to a witness statement of Mrs McGrath dated 18 August 2005.

The Hearing Officer's decisions

5. The two decisions are in largely identical terms. Mr Foley first dealt briefly with the distinctiveness objection under section 3(1)(a), commenting that this stood or fell together with the objections under sections 3(1)(b) and (c). There is no challenge to that part of his decision.
6. Next, Mr Foley dealt with the objection under section 3(1)(d) of the Act. He considered the evidence and concluded that it did not show that HYPER GLUE/HYP A GLUE are signs which have become customary in the current language or in the bona fide established practices of the trade. He therefore rejected the objection under section 3 (1)(d) and there is no appeal of that finding.

7. However, the Opponent does challenge Mr Foley's decisions in so far as he dismissed the oppositions based upon both section 3(1)(b) and (c). The Hearing Officer dealt with these in reverse order. Firstly, in paragraph 18 of each decision, Mr Foley cited the judgment of the European Court of Justice in Case C-363/99, *Koninklijke PN Neverland NV v Benelux Merkenbureau* [2004] ETMR 57. He went on in relation to HYPA GLUE to say:

[19] “The mark consists of the two words HYPA and GLUE. The word glue needs no explanation. I am not aware of HYPA having its own meaning. As indicated above, the opponents claim that HYPA is phonetically identical to the word HYPER and its evidence includes dictionary and electronic media references which do not define the word HYPA but which show the word HYPER to have a number of meanings, the definition differing depending on whether the word is used as a prefix or in an adjectival sense. Appearing as it does as a separate, unhyphenated word within the mark tends towards adjectival use. HYPER as an adjective is said to mean overactive, overexcited or overwrought. Ms McGrath submitted that the public is aware of the use of the word HYPER as a replacement for the word SUPER. Despite the inclusion of an exhibit showing the results of an internet search (a search which took place after the relevant date in these proceedings). The only evidence that I can see that goes to establishing that HYPER and SUPER are interchangeable can be found at Exhibit RMM5. This consists of details from a search conducted on the Internet for HYPER GLUE and shows that the search engine asked whether the searcher had meant SUPER GLUE. This could be an indication that HYPER and SUPER are synonyms but could just as easily have been brought about by the search engine being programmed to suggest more common search terms where GLUE is preceded by any word: I do not know one way or the other. Certainly there is nothing in any of the

evidence to support the opponents' claim that the mark indicates that the goods are stronger than other products available or of a higher quality. The use of the word HYPA may be intended to allude in some way to certain properties of the goods at issue being in excess of the norm but that does not make it descriptive. There is nothing in the evidence to suggest that HYPA GLUE is a sign which should remain freely available for use by others in the trade." [emphasis added].

In relation to HYPER GLUE, paragraph 19 of the decision began:

"The mark consists of the two words HYPER and GLUE. The word glue needs no explanation. As indicated above, the opponent's evidence includes dictionary and electronic media references and show the word to have a number of meanings, the definition differing depending on whether the word is used as a prefix or in an adjectival sense."

The rest of the paragraph was identical to paragraph 19 of the HYPA GLUE decision.

8. In both decisions, Mr Foley went on to cite the decision of the ECJ in C-218/01, *Henkel KGaA v Deutsches Patent und Markenamt* and in paragraph 21 he concluded that he could see no reason why the trade marks HYPA GLUE/HYPER GLUE should not fulfil the essential function of a trade mark. He considered the marks were neither descriptive of the goods nor of a characteristic of them. The oppositions under section 3(1)(c) therefore failed.
9. Mr Foley then went on to examine the objection under section 3 (1)(b) by reference to *Philips v Remington* [2003] RPC 2 at paragraph 35 and *Linde AG v Deutsches Patent und Markenamt* [2003] RPC 45. He found that as at the date of applications and on the evidence and the submissions made to him, he could see no grounds for holding that the mark lacked distinctive character for the goods for which registration is sought. Hence, the oppositions under section 3(1)(b) also failed.

The Grounds of Appeal

10. None of the seven Grounds of Appeal turns upon the Hearing Officer's view that HYP A is phonetically identical to the word HYPER or indeed upon any distinction between the two marks, but in each case the opponent challenges the Hearing Officer's analysis of the evidence and his conclusions as to the descriptiveness of the marks. I deal with each Ground in turn below. Since there is no distinction drawn for present purposes between "hypo" and "hyper", I shall refer below to "hyper" in relation to each of the trade mark applications

Standard of review

11. This appeal is a review of the Hearing Officer's decision. That decision with regard to each of the issues in this case involved a multi-factorial assessment of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applies:

"In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. A decision does not contain an error of principle merely because it could have been better expressed."

This has recently been further explained by Lindsay J in *Esure Insurance Limited v Direct Line Insurance Plc* [2007] EWHC 1557, 29 June 2007 who said, at paragraph 12:

"... an error of principle such as to justify or require departure from the decision below ... includes the taking into account of that which should not have been, the omission from the account of that which should have been within it and the case (explicable only as one in which there must have been error of principle) where it is plain that no tribunal properly instructing itself could, in the circumstances, have reasonably arrived at the conclusion that it reached."

Merits of the appeal

12. Paragraph 2 of the Grounds of Appeal complains that the Hearing Officer artificially dissected the trade marks, differentiating between the word "hyper" used as an adjective and "hyper" used as a prefix. The Hearing Officer took the view that "hyper" would tend to be seen as an adjective rather than as a prefix but the opponent argued that the average consumer of the goods would be unlikely to undertake any such examination of the trade marks in use, particularly since there is no phonetic difference between "hyper glue", "hyper-glue" and "hyperglue". This, it was said, was important because use as an adjective is "said to mean overactive, overexcited or overwrought," whilst the dictionary entries in evidence showed that use as a prefix would have other meanings including above, over, in excess, beyond and in particular, "super-".

13. It is certainly right that the Hearing Officer found that the trade marks "tend" to indicate adjectival use rather than use as a prefix. I am not persuaded either that this amounted to an artificial dissection of the mark, or that this adversely affected the Hearing Officer's overall analysis of the impact of the trade marks. If the use was as an adjective, then the meaning put forward for it was overactive, overexcited or overwrought, whilst if the use was as a prefix, the opponent accepted that this too would indicate an excessive quality, above, over, in excess, beyond and "super", as shown in the examples given of the words hyperactive, hyperinflation and hypermarket. The opponent submitted in argument that this produces quite a subtle distinction, but any such distinction is in my view more theoretical than real: whether as adjective or prefix, whether "dissected" or not, the same quality of excess is inferred. If some subtle distinction may be drawn between the two, it does not seem to me that it is a distinction which would be made by the average consumer or purchaser of the goods, still less that there was any evidence to that effect before the Hearing Officer. In the

circumstances, it does not seem to me that this point is sufficient to vitiate the Hearing Officer's decision.

14. In addition, the opponent complains that the Hearing Officer did not properly apply the guidance of the ECJ in the *Postkantoor* case, Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ETMR 57, despite having cited it in his decision. The impact of that decision was helpfully summarised by Mr David Kitchin QC (as he then was) sitting as the Appointed Person in *Simply Click trade mark* (O-249-05) where at paragraph 17 he said:

“First, it is in the public interest that a sign which is descriptive of a characteristic of the services in respect of which registration is sought may be freely used by all. Second, it is not necessary that the descriptive sign is actually in use at the time of the application for registration; it is sufficient that it could be used for such purposes. Third, a sign must be refused for registration if at least one of its possible meanings designates a characteristic of the services concerned. Fourth, it is irrelevant that there may be other, more usual, signs or indications for designing the same characteristic of the services. Fifth, it is irrelevant whether the characteristic of the services which may be the subject of the description is commercially essential or merely ancillary. Finally, a mark consisting of a word composed of elements, each of which is descriptive of a characteristic of the services, is itself descriptive of that characteristic unless there is a perceptible difference between the word and the sum of its parts.”

15. The opponent's complaint was that the Hearing Officer did not consider all the possible meanings of "hyper" and in particular the possibility that it would be taken to relate to the performance of the adhesive products in the specification, indicating that they are stronger or of better quality than others. It was submitted that all possible

meanings of the word hyper, whether as adjective or prefix (and a number of dictionary definitions were put in evidence, as discussed below) should have been considered but were not, because the Hearing Officer had considered hyper only as used as an adjective. For the reasons I have given above, it does not seem to me that this had any effect upon the decisions, nor does it take the first Ground of Appeal any further. I therefore reject that ground.

16. Paragraph 3 of the Grounds of Appeal states that the Hearing Officer ignored or gave insufficient weight to two particular exhibits, RMM1 and RMM4, and as a result had failed to find that “hyper” is synonymous with “super”. RMM1 consisted of extracts from the New Penguin English Dictionary and the Collins Concise Dictionary, giving the definitions of “hyper” used as a prefix. These are (in so far as relevant) in the first instance “excessively, excessive, above, beyond, super-” and in the second, “above, over, or in excess, denoting an abnormal excess.” These do not, it seems to me show that “hyper” is simply synonymous with “super” but, again, that it denotes some excessive quality; indeed, it is interesting that the subsequent entries in RMM1 for a number of words prefixed “hyper” are mostly defined as being abnormal or excessive in some way, with no use of the word “super”. The Hearing Officer proceeded on the basis that “hyper” denotes some excessive quality. It seems to me that this was consistent with these dictionary entries; if the Hearing Officer failed specifically to consider them, as the opponent suggests, then it does not seem to me that he wrongly failed to find that “hyper” and “super” are interchangeable words.
17. Similarly, RMM4 to Mrs McGrath's witness statement consisted of another extract from the Collins Concise Dictionary. The single page exhibited contained a number of entries for words beginning "hyper" from hypercritical to hyperventilation, but the opponent relied upon it only in relation to the entry for "hypermarket" which again, it was said,

indicated that "hyper" is interchangeable with "super". It does not seem to me that the definition supports the opponent's argument; the definition is "a huge self-service store, usually built on the outskirts of the town" and hence makes no reference to "super" at all. Furthermore, it seems to me that in common parlance the word "hypermarket" is not used simply synonymously with "supermarket". I asked Mrs McGrath at the hearing whether the opponent wish to rely upon any of the other "hyper" prefixed words in RRM4, and was told that it did not. Again, I note that the majority of the definitions refer to excessive, extreme or abnormal conditions and do not indicate broader use of "hyper" as a prefix and as a synonym for "super". Again, if the Hearing Officer failed specifically to consider RMM4, then it does not seem to me that he wrongly failed to find that the sole definition relied upon supported the argument that "hyper" and "super" are synonymous.

18. Paragraph 4 of the Grounds of Appeal criticised the Hearing Officer's views of Mrs McGrath's exhibit RMM5. That exhibit consisted of the results of a single internet search made on Google for the words "hyper glue", placed within inverted commas. The results opponent relied upon the search not so much for the results as because Google had generated a further response to the search term, namely "Did you mean "super glue"? The opponent argued that this showed that "hyper" was indeed interchangeable with "super", and was an indication of the strength of the term "super glue" in the English language. Hence, it said, the Hearing Officer was wrong to conclude that "This could be an indication that HYPER and SUPER are synonyms but could just as easily have been brought about by the search engine being programmed to suggest more common search terms where GLUE is preceded by any word: I do not know one way or the other."

19. I agree that there was no evidence before the Hearing Officer to show that the query was generated by Google because “hyper” is a synonym for “super” rather than for a number of other possible reasons canvassed at the hearing before me. In the circumstances, I reject paragraph 4 of the Statement of Grounds of Appeal, and I also reject paragraph 5, which effectively reiterates points already made. All of the points mentioned above depend upon the proper interpretation of the evidence, and I consider that the Hearing Officer’s conclusion was one which was open to him on the evidence.
20. In paragraph 6 of the Grounds of Appeal, the opponent complained that whilst the Hearing Officer had cited *Postkantoor*, it was not clear that he had properly applied the reasoning of the ECJ to the facts of this case, by considering whether the marks were capable of being used so as to describe the goods, or might be so used in the future. I accept that the decision does not deal with this point specifically, but I note that the Hearing Officer said that the mark may “allude in some way to certain properties of the goods at issue being in excess of the norm but that does not make it descriptive. There is nothing in the evidence to suggest that HYP A GLUE is *a sign which should remain freely available* for use by others in the trade.” The words which I have emphasised in that last sentence seem to me to show that the Hearing Officer had in contemplation the *Postkantoor* test which he had cited only in the preceding paragraph of his decision. I consider that this is a decision in which the Hearing Officer’s reasons could have been better expressed rather than one which contains an error of principle. I do not consider that on this point the decision demonstrates either any error of principle or any failure to take into account any relevant evidence.
21. Paragraph 7 of the Grounds of Appeal challenged the findings in paragraph 23 of the decision, which rejected the opposition under s 3(1)(b), on the basis that this ignored evidence showing that the mark

was or might become descriptive and hence devoid of distinctive character. This argument was based again upon the premise, discussed above, that “hyper” and “super” had been shown to be synonyms. For the same reasons, it does not seem to me that there was any error on the part of the Hearing Officer in his assessment of the evidence before him, and I reject this Ground of Appeal too.

22. In the circumstances, the appeal is dismissed.
23. The Hearing Officer ordered the opponent to pay the applicant the sum of £1300 as a contribution to its costs of each opposition. I order the opponent to pay a single additional sum of £1200 in respect of the applicant’s costs of the appeal.

Amanda Michaels

3 September 2007

Mrs Rigel Moss McGrath of Messrs W P Thomson & Co appeared for the Appellant (the Opponent)

Miss Anna Edwards-Stuart of counsel instructed by Messrs Murgitroyd & Co appeared for the Respondent (the Applicant).