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THE PATENT OFFICE

Harmsworth House,
13-15 Bouverie Street,
London EC4 8DP.

Friday, 4th July 2008

Before:

MR. R. ARNOLD QC
(The Appointed Person)

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In the matter of THE TRADE MARKS ACT, 1994.

and

In the matter of UK Trade Mark Application No. 2428182
by British American Tobacco (Brands) Inc.
to register the mark SUN RIPENED TOBACCO

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Appeal of the Applicant from the
Decision of Mr. Oliver Morris

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(Transcript of the Stenograph Notes of Marten Walsh Cherer
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MS. HELYN MENSAH (instructed by Messrs. Murgitroyd & Co) appeared
for the Applicant/Appellant.

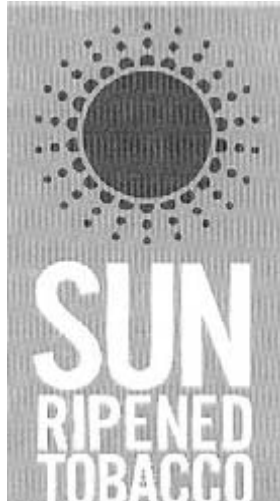
DR. W. TROTT appeared for the Registrar.

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DECISION

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1 THE APPOINTED PERSON:

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9 Introduction

10 1. On 26 July 2006 British American Tobacco (Brands) Inc.
11 applied to register the above trade mark for the following
12 goods in Class 34: "Cigarettes, tobacco, tobacco products,
13 smokers' articles, lighters, matches".

14 2. In an examination report dated 23 September 2006
15 objection was taken to the application under section 3(1)(b)
16 of the Trade Marks Act 1994 on the grounds that the mark as a
17 whole was a non-distinctive sign that would not be seen as a
18 trade mark.

19 3. The Applicant did not file any evidence in support of
20 the application, but filed submissions arguing for registration
21 on the basis of the inherent qualities of the mark. Following
22 a hearing, the objection under section 3(1)(b) was maintained
23 for reasons set out in a written decision of Mr. Oliver Morris
24 acting for the Registrar dated 13 March 2008 (O-074-08).
25 The Applicant now appeals against this decision.

1 The relevant provisions of the Trade Marks Act 1994

2 4. Sections 3(1)(b) and (c) of the 1994 Act provide as
3 follows: "3 (1) The following shall not be registered –
4 "(b) trade marks which are devoid of any distinctive
5 character,

6 "(c) trade marks which consist exclusively of signs or
7 indications which may serve, in trade, to designate the kind,
8 quality, quantity, intended purpose, value, geographical
9 origin, the time of production of goods or of rendering of
10 services, or other characteristics of goods or services".

11 5. These provisions implement the provisions of Article
12 3(1)(b) and (c) of Council Directive 89/104/EEC of 21
13 December 1988.

14 The Hearing Officer's decision

15 6. In his decision the Hearing Officer, having set out the
16 background, the relevant provisions and directed himself in
17 accordance with the judgment of the European Court of Justice
18 in paragraphs 37, 39, 41-47 in Joined Cases C-53/01 to
19 C-55/01 *Linde AG, Winward Industries Inc and Rado Uhren AG*,
20 and having concluded that the average consumer was the general
21 public who smoked, assessed the mark as follows:

22 "10. The mark itself is constructed of two distinct
23 elements. It consists of a stylised representation of a sun
24 (I use the word stylised to indicate that it is not a faithful
25 or realistic pictorial representation) above the words SUN

1 RIPENED TOBACCO. The three words appear one above the other
2 with the word SUN in a larger type font than the words RIPENED
3 and TOBACCO.

4 "11. It was pointed out to me at the hearing that SUN
5 RIPENED TOBACCO may not be a known term (which can be
6 contrasted, for example, with a designation such as sun
7 ripened tomatoes) and that no evidence had been produced to
8 demonstrate that the term was used by others. I do not
9 dispute this - I therefore do not know whether the words
10 represent a term of art, nevertheless, I take the view that
11 the words will be seen by the average consumer as a very
12 simple and direct reference (even if the consumer has not
13 encountered the term before) to the fact that the goods
14 consist of or contain tobacco that has been ripened by the
15 sun. I did not understand the attorney to dispute this.

16 "12. Neither was there any dispute that the pictorial
17 element above the words would be seen by the average consumer
18 as a representation of a sun. Therefore, the question is
19 whether the elements (the words, the picture and the font)
20 combine to create a mark that would immediately be perceived
21 by the average consumer as a sign or badge of origin.

22 "13. The impact of the words in the mark are clear,
23 namely that of a reference to the goods as described above.
24 It is also clear that the presence of the sun device has a
25 relationship to these words and, to some extent, may

1 re-enforce or supplement their meaning; in other words, the
2 sun device, in the context of the mark as a whole, is not an
3 arbitrary or fanciful inclusion. Despite all this, will the
4 overall impression, as the attorney would have me believe,
5 strike the consumer as a badge of origin?

6 "14. I am mindful of the comment of Mr Hobbs QC sitting
7 as the Appointed Person in *Quick Wash Action* [BL 0/205/04]:

8 'I do not think that the hearing officer was guilty of
9 excision or dismemberment in his assessment of the present
10 mark. Devices can be distinctive or nondistinctive, just like
11 any other kind of sign. What matters are the perceptions and
12 recollections that the sign in question is likely to trigger
13 in the mind of the average consumer of the goods concerned and
14 whether they would be origin specific or origin neutral. I
15 think that the verbal elements of the mark I am considering
16 speak loud and clear. It seems to me that the message they
17 convey is origin neutral. The artistic presentation neatly
18 and skilfully builds upon and reinforces the origin neutral
19 message in a way that makes it even more effective than the
20 words alone might have been for that purpose. I think that
21 net result is a well-executed, artistically pleasing, origin
22 neutral device.'

23 "15. Applying similar reasoning to the mark at issue
24 here, it strikes me that the words SUN RIPENED TOBACCO also
25 speak loud and clear and that they do so in a descriptive and

1 therefore origin neutral manner. The presentation incumbent
2 in the sun device (and the overall presentation of the words),
3 despite having an element of artistic nature, merely build
4 upon and re-enforces the message behind the mark. This all
5 leads, in my judgment, to a mark that fails to strike the
6 consumer as a badge of origin.

7 "16. When making these assessments, I have taken into
8 account the examples of intended use supplied by the attorney.
9 Although it is only one form of the range of notional and fair
10 uses to consider, it was useful to see the sign in its true
11 context. Upon seeing it, there was nothing in the
12 presentation and form of use that gave me any inclination to
13 come to a contrary view to that expressed above. The mark
14 struck me as nothing more than an informative origin neutral
15 sign indicating the nature of the goods.

16 "17. Before concluding, I should state that the
17 application also covered some goods that would not contain
18 tobacco, for example, lighters and matches. Whilst the words
19 that appear in the mark cannot be said to be descriptive of
20 this category of goods, this does not alter my finding in
21 relation to the mark's lack of distinctiveness. Lighters and
22 matches are so closely related to tobacco and tobacco products
23 that the mark, if used in relation to these goods, would not
24 suddenly start to convey a trade origin message. This is
25 particularly so when one considers the range of notional and

1 fair uses that the mark could be put to and the resulting
2 varied circumstances where the consumer could potentially
3 encounter the mark. For example, if the mark were used on
4 promotional or advertising material or at the point of sale,
5 then the consumer would have to go through a process of
6 analysis and conjecture for them to come to any view close to
7 that equating to the sign functioning as a badge of origin;
8 this, as I have already identified, is not the test. I should
9 add that the attorney did not make any distinction between the
10 various goods at the hearing."

11 7. The Hearing Officer therefore concluded that the mark
12 applied for was devoid of any distinctive character and thus
13 excluded from registration under section 3(1)(b).

14 Standard of review

15 8. Counsel for the Applicant accepted that, since the appeal
16 is a review of the Hearing Officer's decision in accordance
17 with *Dyson Ltd's Trade Mark Application* [2003] EWHC 1062
18 Chancery, [2003] RPC 47, the degree of respect to be given to
19 the decision is that set out by Robert Walker LJ in *REEF Trade*
20 *Mark* [2002] EWCA Civ 763, [2003] RPC 5 at [28] as follows:
21 "In such circumstances an appellate court should in my view
22 show a real reluctance, but not the very highest degree of
23 reluctance, to interfere in the absence of a distinct and
24 material error of principle."

25 The Appeal

1 9. The Applicant contends that the Hearing Officer erred in
2 principle in three main respects. First, that he failed
3 to consider what was the dominant element of the mark
4 sought to be registered. Secondly, that, in consequence, he
5 did not properly assess the mark as a whole. Thirdly,
6 that, in any event, the Hearing Officer did not properly
7 assess the distinctive character of the mark in relation to
8 what counsel for the Applicant referred to, by way of
9 shorthand, as the "non-tobacco goods".

10 10. Before turning to consider those grounds of appeal, I
11 note that counsel for the Applicant began by reminding me that
12 the objection raised by the Examiner and upheld by the Hearing
13 Officer was under section 3(1)(b) of the Act, not under
14 section 3(1)(c). That is absolutely correct. In *Hormel Foods*
15 *Corp. v Antilles Landscape Investments NV* [2005] RPC 28, I
16 held that a mark which would be objectionable under section
17 3(1)(c) if it was a pure word mark does not cease to be
18 objectionable under section 3(1)(c) if it is presented in a
19 fancy script. I expressed the view that the position would be
20 different if, instead of being merely presented in a fancy
21 script, the mark contained visual elements additional to the
22 word, such as a device, and that in those circumstances the
23 relevant objection to consider would be that under section
24 3(1)(b).

25 11. In my judgment the approach that was suggested at least

1 with regard to section 3(1)(b) in that case is consistent with
2 the subsequent judgment of the European Court of Justice in
3 Case C-37/03P *BioID AG v Office For Harmonisation in the*
4 *Internal Market* [2007] ECR I-7975, in which the Court held, in
5 short, that the mark applied for in that case was devoid of
6 distinctive character within the meaning of Article 7(1)(b) of
7 Regulation 40/94/EC on the Community Trade Mark on the basis
8 that the word element was an abbreviation which was
9 descriptive of the goods and services in question and that the
10 additional visual elements did not endow the trade mark
11 applied for as a whole with any distinctive character.

12 12. So far as the first ground of appeal is concerned,
13 counsel for the Applicant argued that the Hearing Officer had
14 failed to identify the dominant element of the mark applied
15 for. She submitted that, if he had asked himself what the
16 dominant element of the mark applied for was, he would have
17 answered, or should have answered, that it was the sun device.
18 She further submitted that the sun device was distinctive for
19 all the goods in question. Indeed, she went so far as to
20 submit (and I quote from her skeleton argument): "... there
21 is no question that the concept of the 'sun' is wholly
22 fanciful and arbitrary in relation to all of the goods applied
23 for." .

24 13. I do not accept this argument. The Hearing Officer clearly
25 found that the mark was constructed of two distinct elements,

1 that is to say, the words "SUN RIPENED TOBACCO" and a stylised
2 representation of a sun. As I read his decision, he did not
3 consider that either of those elements was dominant to the
4 exclusion of the other. I see no error of principle in that
5 assessment. The Hearing Officer was not obliged to find a
6 single dominant element in the mark if he did not consider that
7 there was a single dominant element. Furthermore, I do not agree
8 that the sun device is wholly fanciful and arbitrary in
9 relation to all of the goods applied for. On the contrary, in
10 relation to the tobacco goods, I consider that the Hearing
11 Officer was right to take the view that it was descriptive, or
12 at least allusive, even considered on its own. Still further,
13 I consider that the Hearing Officer's overall approach, which
14 was to consider not merely the elements of which the mark was
15 comprised, but the overall impression that those elements gave
16 when the mark was considered as a whole, was clearly correct.

17 14. I turn, therefore, to the second ground of appeal.
18 Counsel for the Applicant argued that the Hearing Officer had
19 failed properly to assess the distinctive character of the
20 mark as a whole, in particular because he had failed to
21 consider the relative impact of the elements of which the mark
22 is composed. Furthermore, she submitted that the Hearing
23 Officer's citation and application of the decision of
24 Mr. Geoffrey Hobbs QC, sitting as the Appointed Person, in
25 *Quick Wash Action* (O-205-04) was inappropriate, in particular

1 because the Hearing Officer had omitted from his citation of
2 the decision in that case the observation of Mr. Hobbs that
3 the constituent elements of a composite mark may contribute
4 unequally to the whole.

5 15. I do not accept this argument either. In my view, the
6 Hearing Officer in the present case was no more guilty of
7 excision or dismemberment in his consideration of the mark than
8 the Hearing Officer in that case was. On the contrary, as I
9 have already said, I consider that he correctly assessed the
10 overall impression of the mark considered as a whole.

11 Furthermore, I agree with the observations of the Hearing
12 Officer in paragraphs 15 and 16 of his decision. Indeed, I
13 would go further so far as paragraph 16 is concerned. The
14 illustration of intended use of the mark which was supplied to
15 the Hearing Officer by the Applicant in support of its
16 application and which is reproduced underneath paragraph 4 of
17 his decision, shows, in my view, the mark applied for being used
18 in a wholly origin neutral way. That impression is particularly
19 brought home by the use on the same packaging of the words
20 "NATURALLY SUN RIPENED TOBACCO MORE TASTE", but even if one was
21 to disregard that wording and consider the impact of the mark
22 applied for on its own, the manner in which it is used, to my
23 mind, is suggestive at best of a certification mark.

24 16. I turn, therefore, to the third ground of appeal.
25 Counsel for the Applicant argued that even if the Hearing

1 Officer was correct to uphold the objection under section
2 3(1)(b) in relation to cigarettes, tobacco and tobacco
3 products, he was not correct to uphold the objection in
4 relation to smokers' articles, lighters and matches. She
5 submitted, correctly, that the jurisprudence of the European
6 Court of Justice from at least Case C-363/99 *Koninklijke KPN*
7 *Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619 onwards
8 establishes that the distinctive character of a trade mark
9 must be assessed separately in relation to the various goods
10 in respect of which it is sought to be registered. Counsel
11 submitted that the Hearing Officer had failed to undertake
12 that exercise. In my judgment, that is not correct. On the
13 contrary, I consider that in paragraph 17 of his decision, the
14 Hearing Officer did precisely what he was required to do so
15 far as that is concerned.

16 17. Counsel for the Applicant also argued that the Hearing
17 Officer's conclusion in respect of the non-tobacco goods was
18 unsustainable in view of his acceptance that the words that
19 appeared in the mark could not be said to be descriptive of
20 this category of goods. She submitted that, given that his
21 reasoning in relation to the tobacco goods was that the words
22 were descriptive and the device simply reinforced that
23 message, it followed that that reasoning could not apply to
24 the non-tobacco goods.

25 18. I do not accept this argument either. In paragraph 17 of

1 his decision, the Hearing Officer, as I have already noted,
2 accepted that the words that appear in the mark cannot be said
3 to be descriptive of the non-tobacco goods. He nevertheless
4 held that the mark was devoid of any distinctive character in
5 relation to non-tobacco goods on the ground that lighters and
6 matches are so closely related to tobacco and tobacco products
7 that the mark, if used in relation to those goods, would not
8 suddenly start to convey a message as to trade origin. I see no
9 error of principle in that approach and I consider that the
10 assessment is one that was open to him.

11 19. I explored with counsel two alternative bases upon which
12 the Hearing Officer might have reached his conclusion. The
13 first, in accordance with the reasoning of the Court of First
14 Instance in Case T-461/04 *Imagination Technologies Ltd v*
15 *Office For Harmonisation in the Internal Market* (20
16 September 2007) at paragraph 42, is that a mark remains
17 descriptive of goods and services even if it is misdescriptive
18 in the sense that the goods and services in question do not in
19 fact have the characteristics in question but could have.

20 20. The second, in accordance with the decisions of the
21 Board of Appeal in Case R 246/1991-1 *Enotria Holdings*
22 *Ltd's Application* (27 March 2000) and the Cancellation
23 Division in Decision 75 C000835728/1 *Beiersdorf*
24 *AG's Application* [2001] E.T.M.R. 19, is that a mark which is
25 partly descriptive for the goods specified and partly

1 deceptive should be refused under a combination of section
2 3(1)(b) and section 3(3)(b).

3 21. However, I prefer to rest my decision on the ground that
4 the Hearing Officer correctly considered whether the mark had
5 a distinctive character in relation to the non-tobacco goods
6 and concluded that it did not because it was origin neutral
7 rather than origin specific, and I see no error of principle
8 in that approach.

9 Conclusion

10 22. The appeal is dismissed.

11 Costs

12 23. In accordance with the usual practice, I make no order for
13 costs. Thank you both very much.

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