

O-211-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 2537376

BY JOHN MYLAND LIMITED

TO REGISTER THE FOLLOWING TRADE MARKS IN CLASS 2:

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Background

1. On 8 January 2010, John Myland Limited ('the applicant') applied to register trade mark application number 2537376, for the marks MARBLEMATT and MARBLE MATT for the following goods:

Class 2: Paints, varnishes, lacquers, colorants, natural resins, emulsions and enamels; wood finishing preparations; wood preservatives and wood stains.

2. On 2 February 2010, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In the report, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act'), on the basis that the mark consists exclusively of the word 'Marble Matt', being a sign which may serve in trade to designate the characteristic of the goods e.g., paints which give a marble effect which is matt in appearance.

3. On 23 February 2010, Mr Jennings of Chancery Trade Marks acting as the applicant's representative, submitted arguments in respect of *prima facie* acceptance of the mark. The examiner was not persuaded by the submissions and, in maintaining the objection, furnished Mr Jennings with internet references which she considered supported the objection.

4. On 16 March 2010, Mr Jennings requested an *ex parte* hearing. At that hearing, held on 27 July 2010, the objection was maintained, and further time was granted for Mr Jennings to explore whether his client had any evidence of use.

5. On 29 September 2010, Mr Jennings requested that the notice of refusal should be issued as the applicant wished to file a form TM5 seeking a statement of reasons for the Registrar's decision. A TM5 was duly received at IPO on 13 October 2010.

6. I am now asked under section 76 of the Trade Marks Act 1994 and rule 69 of the Trade Marks Rules 2008 to state in writing the grounds of my decision and the materials used in arriving at it. No formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, I have only the *prima facie* case to consider.

Decision

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

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

(a)

(b) trade marks which are devoid of any distinctive character,

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

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.”

The above provisions mirror Article 3(1)(b) and (c) of First Council Directive 89/104 of 21 December 1988. The proviso to Section 3 is based on the equivalent provision of Article 3(3).

Relevant authorities – general considerations

8. The European Court of Justice (ECJ) has repeatedly emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (Case C-37/03P, *Bio ID v OHIM*, paragraph 59 and the case law cited there and, more recently, Case C-273/05P *Celltech R&D Ltd v OHIM*).

The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. Thus, in the case of the registration of colours per se, not spatially delimited, the Court has ruled that the public interest is aimed at the need not to restrict unduly the availability of colours for other traders in goods or services of the same type. Also, in relation to Section 3(1)(b) (and the equivalent provisions referred to above) the Court has held that “...the public interest ... is, manifestly, indissociable from the essential function of a trade mark” (Case C-329/02P, *SAT.1 SatellitenFernsehen GmbH v OHIM*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him,

without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment).

Section 3(1)(c)

9. There are a number of ECJ judgments which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), whose provisions correspond to Section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – (*Wm Wrigley Jr & Company v OHIM* – Case 191/01P (Doublemint) paragraph 30;
- thus Article 7(1)(c) (Section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM*, paragraph 31;
- it is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes – *Wm Wrigley Jr v OHIM*, paragraph 32;
- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, Case C-363/99 (Postkantoor), paragraph 57;
- if a mark which consists of a word produced by a combination of elements is to be regarded as descriptive for the purposes of Article 3(1)(c) it is not sufficient that each of its components may be found to be descriptive, the word itself must be found to be so – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, paragraph 96;
- merely bringing together descriptive elements without any unusual variations as to, for instance, syntax or meaning, cannot result in a mark consisting exclusively of such elements escaping objection – *Koninklijke Nederland v Benelux Merkenbureau*, paragraph 98;

- an otherwise descriptive combination may not be descriptive within the meaning of Article 3(1) (c) of the Directive provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word trade mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark – *Koninklijke Nederland NV v Benelux Markenbureau, (Postkantoor)*, paragraph 99.

9. In *Matratzen Concord AG v Hukla Germany SA* Case C-421/04) the ECJ stated:

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

10. I am also mindful of the decision of the General Court (formerly the CFI) in *Ford Motor Co v OHIM*, Case T-67/07 where it was stated:

there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics.

11. It is clear from the aforementioned case law that I must determine whether, assuming notional and fair use, the mark in suit will be viewed by the average consumer to directly designate the essential characteristics - being the *kind* and the *intended purpose*, of the goods for which registration is sought.

12. The goods at issue are 'paints, varnishes, lacquers, colorants, natural resins, emulsions and enamels; wood finishing preparations; wood preservatives and wood stains.' In relation to identifying the relevant consumer, it is reasonable to assume that the goods claimed will be used by the general public who would purchase such goods with a moderate level of attention and knowledge. I consider that the goods may also be purchased by more specialist consumers in the field of interior design and decoration, as well as by artists.

13. The series of two marks consists of the words 'marble' and 'matt' in both separate and conjoined forms. Collins English Dictionary defines the word 'marble' as meaning "*verb* (transitive) to mottle with variegated streaks in imitation of marble", whilst Chambers 21st Century Dictionary defines the word 'matt' as meaning "*adjective* said e.g. of paint: having a dull surface without gloss or shine".

14. In my view the relevant consumer of the goods in question would see the signs 'MARBLE MATT' and 'MARBLEMATT', on first impression, as a normal means of designating a characteristic of the goods for which registration is sought. It appears reasonable when applying the normal rules of English language and grammar, that the words are descriptive of goods which produce a marble effect and which have a matt finish. Furthermore, the documents provided by the examiner from information found on the Internet, demonstrate that paints produce a marble effect. It is a technique that has been used since the ancient Greeks and is a decorative technique used to give walls, furniture or items the appearance of natural stone. Veined lines are added to try and capture a natural look and it is considered one of the more advanced painting techniques.

15. This reasoning applies equally to both the separated and conjoined versions of the mark, and I maintain that the sign 'MARBLEMATT' would merely serve to designate a characteristic of the goods as would the more conventional presentation 'MARBLE MATT'. To support this finding I rely on the decision of the ECJ Case C-265/00 *Campina Melkunie BV and Benelux-Merkenbureau, (Biomild)* paragraphs 39-41 where the following is stated;

39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

40. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition will have to be satisfied as regards both the aural and the visual impression produced by the mark.

41. Thus, a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of

which registration is sought, is itself descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.

16. The above can be said in respect of the conjoined sign 'MARBLEMATT', where two descriptive words have been coupled together without any graphic or semantic modification which may imbue them with additional characteristic such as to render the sign, when considered as a whole, to be distinctive. I do not consider that the sign would be perceived in any other way than the two separate elements 'marble matt' brought together. This is because it is held that consumers perceiving a verbal sign, will break it down into elements which, for them suggest a concrete meaning or which resemble words known to him. (GC T356-02 *Vitacraft-Werke Wührmann & Sohn GmbH & Co KG, v OHIM*, paragraph 51)

17. Consequently, I have concluded that the mark applied for consists exclusively of a sign which may serve, in trade, to designate the kind and intended purpose of the goods and which is therefore excluded from registration by section 3(1)(c) of the Act. Having found that to be the case, it effectively ends the matter. However, in case I am found to be wrong in this decision, I will go on to determine the matter under section 3(1)(b) of the Act.

Section 3(1)(b)

18. I approach this ground of objection on the basis of the following principles derived from the ECJ cases referred to below:

- an objection under Section 3(1)(b) operates independently of objections under Section 3(1)(c) – (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);
- for a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);

- a mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86);
- a trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);
- the relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

19. Furthermore in relation to section 3(1)(b) it was held in *Postkantoor* that:

86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.

20. I do not consider that an application should necessarily escape objection if it is considered too imprecise a term to indicate a direct and specific relationship with the goods or services at issue without further thought, but is, in some sense, more generally non-distinctive. In this case, the evidence presented by the examiner in correspondence shows that the words 'marble' and 'matt' are not unusual when considered in relation to the goods. On the contrary, they are in fact meaningful and recognised words, used in the English language and found in any dictionary. I have already set out in paragraph 20 above how I consider the average consumer would view the mark in suit.

21. Even if the mark were to fall short of conveying the requisite level of specificity to support an objection under section 3(1)(c) (which I do not believe to be the case), I would nevertheless hold that it would not be capable of performing the essential function of a trade mark without the relevant public being educated into seeing it that way. In my view consumers would not consider the mark to be that of any particular manufacturer or supplier of paints, varnishes, lacquers, colorants, natural resins, emulsions and enamels, wood finishing preparations, wood preservatives or wood stains. It could properly be at home on any of them. On this basis, the section 3(1)(b) objection is also made out.

22. I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is an indication of trade origin. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from *prima facie* acceptance under Section 3(1)(b) of the Act.

Conclusion

23. In this decision I have considered all the documents filed by the applicant, and all the arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is refused under the terms of section 37(4) of the Act because it fails to qualify under sections 3(1)(b) and 3(1)(c) of the Act.

Dated this 17 day of June 2011

**Bridget Whatmough
For the Registrar
The Comptroller-General**