

O/465/11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2521774
BY PPG ARCHITECTURAL COATINGS TO REGISTER THE TRADE MARK**

BONANZA

IN CLASS 2, 17, 19 AND 35

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 100195
BY IMPERIAL CHEMICAL INDUSTRIES LIMITED**

BACKGROUND

1) On 23 July 2009, PPG Architectural Coatings UK Limited ("PPG") applied under the Trade Marks Act 1994 ("the Act") for registration of the mark BONANZA in respect of the following goods and services:

Class 2

Colours, paints, varnishes, fixatives (varnishes), lacquers, preservatives against rust and deterioration of wood; colorants, mordants, raw natural resins; paints for wood (for inside and outside); dyes for wood; metals in foil and powder form for painters and decorators; finish coatings (paints) for inside and outside of buildings; facades paints; acrylic paints; products against corrosion; thinners, thickeners and binders for colours and pigments; binders and thinners for paints.

Class 17

Packing, stopping and insulating materials; insulating paints and coatings for inside and outside; watertightness and waterproofing materials for facade covering; sealant compounds for joints; pastes for trimming up, for removing bubbles, for dressing and waterproofing vertical wall masonry; facade coatings, insulating varnishes, paints and coatings; insulating gloves; fabrics (fibreglass), for insulation.

Class 19

Bituminous coatings; cement coatings; finishing mortar; synthetic resins based mortars, polyurethane foams, grouts, fillers.

Class 35

Retail services connected with the sale of colours, paints, varnishes, fixatives (varnishes), lacquers, preservatives against rust and deterioration of wood, colorants, mordants, raw natural resins, paints for wood (for inside and outside), dyes for wood, metals in foil and powder form for painters and decorators, finish coatings (paints) for inside and outside of buildings, facades paints, acrylic paints, products against corrosion, thinners, thickeners and binders for colours and pigments, binders and thinners for paints, packing, stopping and insulating materials, insulating paints and coatings for inside and outside, watertightness and waterproofing materials for facade covering, sealant compounds for joints, pastes for trimming up, for removing bubbles, for dressing and waterproofing vertical wall masonry, facade coatings, insulating varnishes, paints and coatings, insulating gloves, fabrics (fibreglass), for insulation,

bituminous coatings, cement coatings, finishing mortar, synthetic resins based mortars, polyurethane foams, grouts, fillers.

2) On 20 November 2009, the application was published in the Trade Marks Journal and on 22 February 2010, Imperial Chemical Industries Limited (“ICI”) filed notice of opposition to the application. The grounds of opposition are that the application offends Sections 3(1)(a), 3(1)(b) and 3(1)(c) of the Act. It claims that, in respect of the services listed in Class 35, the word BONANZA is not capable of distinguishing the services of PPG. The word BONANZA designates the intended purpose of retail services, namely that the goods being sold are in a sale or promotion. Therefore, it offends under Section 3(1)(c) of the Act. To support this, ICI refers to Cambridge Dictionaries On-Line that defines BONANZA as:

a situation from which large profits are made
The rise in house prices meant that those who were selling enjoyed a bonanza
April was a bonanza month for car sales
...
A large amount of something good
The magazine will hold another fashion bonanza in the spring

3) It further refers to the Collins English Dictionary that defines the word as follows:

Bonanza n. 1. A source, usually sudden and unexpected, of luck or wealth.

4) It contends that the word BONANZA has a general meaning that relates to a successful sale of goods and carries a feel good factor that makes the word desirable to use when selling products. Therefore, it will not be seen as an indication of origin and cannot distinguish the services covered as being those solely of the applicant.

5) Further, in respect of the goods listed in Classes 2, 17 and 19 and as alternative to the grounds based upon Section 3(1)(c) against the Class 35 services, it claims that the application should be refused under Section 3(1)(b) of the Act because the mark is devoid of distinctive character.

6) ICI also claims that the application should also be refused under Section 3(6) of the Act because PPG filed the application in bad faith. ICI claims that PPG has the sole intention of obtaining extensive, exclusive rights so as to try and force ICI to stop using the word BONANZA in relation to a bonanza.

7) PPG subsequently filed a counterstatement denying the opponent’s claims. In respect of the grounds based upon Section 3(1)(a) it submits that a word is

specifically recognised as subject matter of which a trade mark may consist. The word BONANZA is therefore capable of being a sign.

8) Only ICI filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 17 November 2011 when ICI was represented by Donald Pennant for ICI Group Intellectual Property and PPG represented by Alan Fiddes for Urquhart-Dykes & Lord LLP.

Opponent's Evidence

9) This takes the form of a witness statement, dated 14 February 2011, by Victoria Wisener, IP Counsel for ICI. She states that ICI has used the word BONANZA in its sales literature to promote the sale of paint and paint related products in the past and wishes to continue to do so. An example of one of ICI's "bonanza promotions" is provided at Exhibit VW1. This consists of an advertisement flyer entitled "November Bonanza!" offering free gifts if specified amounts were spent "on Dulux Trade".

10) Exhibit VW2 consists of extracts from four websites and all dated 14 February 2011. The first, from www.kqbanswers.com where the word BONANZA is defined as "an especially rich vein of precious ore; a sudden happening that brings good fortune (as a sudden opportunity to make money)". The second, from www.trueknowledge.com states "the word 'bonanza' has a couple of senses or meanings: 1: an especially rich vein of precious ore; 2: a sudden happening that brings good fortune (as a sudden opportunity to make money)". The third presents the results of a search on the *Google* search engine for "define:bonanza" and provides similar definitions to above. The fourth is from wiki.answers.com that states "A bonanza (from *bonacia*, a fortuitously *calm* sea) can be a windfall, bounty or riches. [...]"

11) Examples of current use are provided at Exhibit VW3 and consist of Internet extracts, all dated 19 or 20 January 2011. The extracts were obtained by conducting a Google search for "bonanza". The search retrieved 872,000 results and the first ten pages of these results are exhibited as are selected first pages from the first ten pages of these results. By way of illustration, some of the use shown is:

- An extract from www.greenhousebonanza.com. It is headed "Greenhouse Bonanza – Your UK Greenhouse Specialist" and also includes the heading "Greenhouse Bonanza" with the following strap line "Britain's biggest value in greenhouse shopping". Further down the page is the heading "Coming up at Greenhouse Bonanza".
- An extract from www.davidnewtoninteractive.co.uk. It is headed "Welcome to Balloon Bonanza" and states that "Balloon Bonanza has been in business for 15 years [...]"

- An advertisement from www.northleachbonanza.co.uk. It is headed “Christmas Bonanza” and includes the text “Experience a Magical Christmas Shopping Extravaganza ... Plenty of gift ideas and festive delights for family & friends”.
- A number of articles that appeared on the websites of UK national newspapers such as the Financial Times, the Independent, The Times, The Mail and other online publications with headings such as:

“Stress tests unleash fee bonanza”.

“Winter chill promises a snow business bonanza for Continental Europe”.

“Apps fuel mobile games sales bonanza”

“Top authors await ebook bonanza”

“South Sudan awaits oil bonanza”

“Health chiefs’ pay bonanza: [...]”

“Library bonanza for the big screen”

“Cash Bonanza for upwardly mobile”

“Barbie’s 50th birthday bonanza”

“Warren unveils bonanza”

“Boxing Day shopping bonanza at Meadowhall”

“Christmas online shopping bonanza underway”

- An extract from the website www.abonanzapartyshop.co.uk, headed “A Bonanza Party Shop” and includes the text “Welcome to the A Bonanza Party Shop”

12) Exhibit VW5 is an advertising flyer that Ms Wisener states was produced by PPG and is reproduced below:



13) Exhibit VW6 consists of a report by the investigation company, *Carratu*. It states that “On 19th January 2011, Carratu were requested to conduct research into the use of the term “Bonanza” in general advertising, between circa July 1994 and July 2009.” It located nine examples of use of the term in promotions featured in national newspapers

- i) An advert from the *Daily Express* newspaper for a new variety of plant called “Peach Bonanza”;
- ii) An advert for a “balcony bonanza” by *Cunard* offering free cabin upgrades to a cabin with a balcony on a cruise to New York. The advert appeared in the *Daily Express* on 26 November 2008;
- iii) An advert for a “Tax Free Betting Bonanza” on www.jackpotstrike.com that appeared in the *Daily Star* newspaper on 23 May 2008;
- iv) The *Alliance and Leicester* building society advertising a savings account as “Part of our Best Buy Bonanza” that appeared in the *Daily Express* newspaper on 27 February 2008;
- v) The following advert that appeared in the *Daily Star* newspaper on 6 May 2007:



- vi) An offer that appeared in the *Daily Mirror* newspaper, dated 16 December 2006, which states “five lucky readers will each win £1,000 with the Daily Mirror’s Christmas Cash Bonanza”;
- vii) An advert that appeared in the *Daily Express* on 1 May 2006 for computers and computer equipment that is promoting a “Bank Holiday Bonanza” where “free double memory + free printer on selected systems” is being offered.
- viii) The *Daily Mirror*’s own fantasy football game is advertised on 24 February 2006 and includes the text “Now’s your chance to March towards a £10,000 bonanza”;
- ix) The *Daily Star* newspaper promoting its offer for half price entry to the *Alton Towers*, *Thorpe Park* and *Chessington* amusement parks, on 26 August 2005, with the words “It’s a bank holiday bonanza in Saturday’s ‘Daily Star’”;

14) In addition, *Carratu* also identified a number of additional extracts dating from between 1964 and 2001 and include:

- i) An advertisement for the DIY store, *Homebase*, that appeared in *The Mirror* newspaper on 8 December 2001 with the following text appearing prominently; “Christmas Bonanza 20%ff all decorations and artificial trees”;
- ii) An advertisement for *Allied Carpets* that appeared in the *Daily Mirror* on 26 April 1996. Prominently featuring at the top of the advert is the text “Bed Bonanza Extra 25% Off All Bed Marked Prices”;
- iii) An advertisement for C & A department store that appeared in the *Daily Mirror* on 1 December 1993. Prominently featuring at the top of the advertisement is the text “£££s Off Bonanza Takes Off Today”;

- iv) An advertisement for *Gateway* supermarket that appeared in the *Daily Express* on 22 August 1990. Prominently featuring at the top of the advert is the text “The 100 Day Bonanza, 100 days of RED HOT Shopping”;
- v) An advertisement dated 23 June 1988 and appearing in the *Daily Mirror* promoting “Woolworths Music & Video Bonanza”;
- vi) Two advertisements for *Debenhams* department store, the first promoting “Half Price Bonanza” with “£30 Million of Bonanza Reductions”. The second promoting “Bonanza Reductions” on furniture ranges. These advertisements appeared in the *Daily Mirror* on 21 October 1981 and in the *Daily Express* on 6 November 1980, respectively.

15) Exhibit VW7 is a copy of PPG’s “letter before action”, dated 7 November 2008 and sent in response to ICI’s use of its leaflet exhibited at VW1. The letter requires that ICI immediately stop using and undertake to never use the name BONANZA in relation to its business.

DECISION

The Law

16) The relevant parts of Section 3(1) of the Act are 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,
 - (d) [...]

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.

17) Section 1(1) of the Act reads:

- 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.

18) Section 3(6) of the Act reads:

3. - (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

Section 3(1)(a)

19) The relevant case law, as referred to by Mr Fiddes, is *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd*, Case C-299/99, where the CJEU stated:

“36. It is true that Article 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 Article 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, Article 3(1)(a) of the Directive, like the rule laid down by Article 3(1)(b), (c) and (d), precludes the registration of signs or indications which do not meet one of the two conditions imposed by Article 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 Article 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 Article 3(1)(b), (c) and (d) and Article 3(3) of the Directive which is none the less excluded from registration by Article 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.”

20) Consequently, in order for its sign to fall foul of section 3(1)(a) of the Act, PPG's application will not be capable of registration, as it will fall foul of sections 3(1)(b), (c) and/or (d) of the Act, and it cannot acquire distinctive character through the use made of it.

21) Ms Wisener submits that in respect of PPG's Class 35 services, the word BONANZA is not capable of distinguishing and claims that it is used in retail services to indicate a sale, a special retail promotion, a giveaway or a windfall. At the hearing Mr Pennant reiterated this argument claiming that the word is in generic use.

22) Whilst both parties appear to be in agreement that the mark is represented graphically, Mr Fiddes argued for PPG that the word BONANZA is also capable, "even if it is only to the limited extent of being 'not incapable', of distinguishing goods of one trader from another". I concur with this view. There is nothing inherent in the word BONANZA that makes it incapable of registration whatever the use made of it. The Act envisages that even signs which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade can be registered, if they have acquired a distinctive character. Consequently, the opposition under section 3(1)(a) of the Act is dismissed.

Section 3(1)(c)

23) Next, I find it convenient to consider the ground based upon Section 3(1)(c) of the Act. As explained by the Court of Justice of the European Union ("the CJEU") in *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-191/01 P ("*Doublemint*"), at paragraphs 30 and 31, the purpose of this exclusion from registration of such signs is the public interest in precluding any individual trader from obtaining a monopoly in a sign which other traders might legitimately wish to use because of its descriptiveness.

24) The proviso to section 3(1) of the Act provides an exception to this exclusion. If a trader can demonstrate that through the use made of it his mark has become sufficiently distinctive so that it does in fact serve as an indication of origin in the minds of the relevant public or a significant proportion thereof (see *Windsurfing Chiemsee* C-108/97) then registration may be granted. However, PPG does not rely upon this exception and I only have the *prima facie* case to consider.

25) Other relevant case law of the CJEU is summarized below:

(i) The court in *Doublemint* went on to state:

"32. In order for OHIM to refuse to register a trade mark under Article

7(1)(c) of Regulation No 40/94 [the equivalent provision to Section 3(1)(c) in the Community Trade Mark Regulation], 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 provision 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.”

(ii) In *Matratzen Concord AG v Hukla Germany SA*, (Case C- 421/04) the court 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, 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 KPNNederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

(iii) In *Ford Motor Co v OHIM*, Case T- 67/07:

“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”

26) The thrust of ICI's argument is that the word is commonly used in the retail trade to designate sales promotions. The evidence filed in support of this includes advertisements from a number of national newspapers and identified by the investigation company *Carratu*. Two of the seven examples, from between 2005 and 2009, show the word BONANZA being used to promote a retail sales event, firstly in the phrase “Bank Holiday Bonanza” by *Screwfix Trade Counter*, and a second where the provenance is unclear promoting computers and uses the word in the same phrase “Bank Holiday Bonanza”. Further examples show BONANZA used in respect of a “balcony bonanza” promotion for cruise ship holidays, an online betting firm promoting a “tax free betting bonanza” and a number of newspapers promoting chances to win money as “bonanzas” and one

further paper promoting a chance to win tickets to theme parks as a “bank holiday bonanza”.

27) In addition, there are a number of examples dated between 1964 and 2001. Most significant of these are seven advertisements that appeared, between 1980 and 2001, in national newspapers promoting sales events for well known retail traders such as *Woolworths* and *Debenhams*. These all illustrate the word BONANZA being used to identify a promotional event.

28) Whilst this evidence is not overwhelming, I am not convinced by Mr Fiddes’ submission that these exhibits illustrate use of BONANZA as a sub-brand. There are only three recent examples, in addition to the parties’ own use, of the word BONANZA being used in connection with retail services (and one of these, namely on the website www.northleachbonanza.co.uk appears to be after the relevant date). Nevertheless, the word BONANZA is an ordinary word of the English language. At paragraph 2 and 3 of this decision, I have detailed dictionary definitions for the word, as referenced by ICI. In addition to these references, I note that the *Collins English Dictionary* also lists that BONANZA also means “a large amount of something desirable” and uses the example phrase “a festive feature film bonanza”¹. Therefore, the word BONANZA can be used, in the retail or wholesale environment, to mean “something desirable” such as a discount on the normal price paid for goods. Consequently, there is a compelling case for the word designating a characteristic of the services.

29) When this is considered together with the exhibits illustrating retailers (and other service providers such as a cruise holiday provider) using the word in just such a way, it is clear to me that the case is made out. In addition, there are a further seven examples of retailers using the word in this descriptive fashion between 1980 and 2001. There is nothing before me to suggest that more recent usage will be perceived any differently by the consumer, or that any descriptive meaning has been lost over time. It appears from the evidence that use of the word BONANZA in sales promotions may be less popular at the relevant date than in the past, but this does not mean that the consumer will attribute trade significance to the word.

30) Therefore, taking account of the dictionary definition of the word and the long standing, if somewhat sparse use, in respect of sales promotions, it is likely that at the relevant date the average consumer and traders alike, upon seeing the word BONANZA used in the context of retail services will understand it as promoting a sales event where there are desirable discounts available.

¹ "bonanza". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 28 November 2011 <<http://oxforddictionaries.com/definition/bonanza>>.

31) I am aware of the caution expressed by Anna Carboni, sitting as the appointed person, in *CHORKEE* BL O-048-08 that just because a word has a dictionary meaning, caution should be exercised when assuming that the consumer will understand the word as having such a meaning. In the current case however, there is evidence of its use in respect of retail services to designate a sales promotion where desirable discounts are offered. Whilst not wholly compelling, when taken together with the dictionary reference, it demonstrates that the term is likely to be understood by the average consumer as designating an opportunity to benefit from desirable discounts.

32) In light of this finding, the word *BONANZA* is one that traders may legitimately wish to use with both traders and average consumers perceiving the word as designating a sales promotion offering desirable discounts.

33) Consequently, the ground based upon Section 3(1)(c) of the Act is successful in respect of all of PPG's Class 35 services.

Section 3(1)(b)

34) Anna Carboni, sitting as the Appointed Person in O-363-09 *COMBI STEAM Trade Mark*, conveniently summarised the leading case law in respect of this part of the Act:

7. It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs "a residual or sweeping-up function", backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: *Procter & Gamble Ltd's Trade Mark Application* [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): *Case C-363/99 Koninklijke KPN Nederland BV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] ETMR 57 (ECJ) at [86]. However, the converse is not true: a mark which is not descriptive may nevertheless be devoid of distinctive character for other reasons (*ibid.*).

8. When a trade marks examiner assesses the distinctiveness of a trade mark within the meaning of section 3(1)(b), s/he must do so firstly by reference to the goods or services listed in the specification, and secondly by reference to the perception of the mark in relation to such goods or services by the relevant public, which consists of average consumers of the goods or services in question, who are deemed to be reasonably well informed, observant and circumspect: *Joined Cases C-53/01 to C- 55/01*

Linde AG, Winward Industries Inc and Radio Uhren AG [2003] ETMR 78 at [41].

9. It is not necessary to show that a mark has a particular level of creativity or originality in order to establish distinctive character: Case C-329/02P *SAT.1 Satelliten Fernsehen GmbH v OHIM* [2005] ETMR 20 (ECJ) at [41]. While the Court of First Instance (“CFI”) has repeatedly referred to “a minimum degree of distinctive character” as being sufficient to avoid article 7(1)(b) of the CTMR/article 3(1)(b) of the Directive (for example, Case T-34/00 *Eurocool Logistik GmbH & Co. KG v OHIM* (“EUROCOOL”) [2003] ETMR 4 at [39]; Case T-128/01 *Daimler Chrysler Corp v OHIM* [2003] ETMR 87 at [33]; Case T-320/03 *Citicorp v OHIM* (“LIVE RICHLI”) at [68]), the ECJ has not adopted this wording and has deemed it unnecessary to give any more precise definition to the possible dividing line between lack of distinctiveness and the minimum distinctiveness to which the CFI refers: *Deutsche Krankenversicherung AG v OHIM* (“COMPANYLINE”) [2002] ECR I-7561 at [20].

10. The ECJ approaches the issue of distinctiveness by reference to the underlying purpose of article 3(1)(b) of the Directive / 7(1)(b) CTMR, which in the Court’s view is to preclude registration of trade marks that are incapable of performing the essential function of guaranteeing the identity of the origin of the marked product 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: *SAT.1 v OHIM* at [23]; Case C-37/03 P *BioID AG v OHIM* [2005] ECR I-7975 (ECJ) at [27].

35) It is clear from the above guidance that if a mark is entirely descriptive of characteristics of goods or services, it will also be devoid of any distinctive character under section 3(1)(b). Consequently, as I have found that, in respect of PPG’s services, the mark in question is open to objection under Section 3(1)(c) of the Act, it follows that it is also open to objection under Section 3(1)(b) of the Act.

36) Section 3(1)(b) includes within its scope those marks which, whilst not designating a characteristic of the relevant goods will nevertheless fail to serve the essential function of a trade in that they will be incapable of designation origin.

37) ICI relies on this ground of opposition insofar that it also applies to all the goods listed in PPG’s application. In considering this ground of opposition, I must put myself in the place of someone who encounters PPG’s mark, used in respect of these goods and determine how they would react.

38) The public interest role underlying section 3(1)(b) is about what the average consumer thinks, in this case the general public. Does the mark have the capacity to identify the origin of the goods thereby enabling the average consumer to repeat the purchasing experience or to avoid repeating it? Whether the trade mark performs this essential function will be a matter of first impression because the average consumer does not analyse marks beyond what is usual for a reasonably well-informed and reasonably observant and circumspect person in the ordinary course of purchasing the relevant goods.

39) ICI submits that the word BONANZA, when used in respect of the goods listed, is devoid of any distinctive character because of the mark's meaning in respect of sales promotions. It is the overall impression on the average consumer that matters. In that respect, it does not necessarily follow that because the word designates a characteristic of retail services that it will also be non-distinctive in respect of the goods sold through such a sales promotion. On the face of it, the word BONANZA has no direct significance in respect of the goods claimed.

40) In her witness statement, Ms Wisener submitted that BONANZA is synonymous with other words typically used in promotional literature such as "sale", "special offer" and "bargain". Mr Pennant conceded that the objection in respect to the goods was "less clear" than in respect of the services, but contended that the mark can also relate "to where goods are to go" i.e. into a bonanza. He supported this contention by reference to the GC's judgment in *Best Buy Concepts Inc. v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, T-122/01, saying that the current case is "in the same territory". Whilst it may be in the "same territory", it is not on all fours with the current case. The GC case involved a mark that consisted essentially of the words BEST BUY. Quite clearly, such a phrase has a clear, unequivocal meaning in respect of goods that, as the court noted, is perceived immediately by the relevant public. On the other hand, the word BONANZA does not have such an immediate and clear meaning in respect of the relevant goods. Unlike BEST BUY, it may have a number of meanings in the minds of the consumer, as evidenced by the various dictionary references. There is no evidence before me to support ICI's submission that the word, when used in respect of the goods, would indicate to the consumer that they were available through a sales promotion. Consequently, I conclude that use of the word BONANZA in respect of the goods is likely to be perceived as an indication of trade origin.

41) Contrary to Mr Pennant's submission that when the mark is used in absence of other branding, the consumer will not perceive any trade indication, in respect of goods at least, I consider that the opposite is true. The word BONANZA alone, when used in respect of goods has a level of ambiguity that gives it the necessary level of distinctiveness prevents the consumer make such a direct link.

42) Mr Pennant also submitted that use by the applicant is not trade mark use, however, there is only one exhibit showing use by the applicant and this is in

respect of retail services and not goods (the goods shown in the exhibit (see paragraph 12 above) are identified by the mark *Johnstone's*. Therefore, this use does not advance his argument.

43) In summary therefore, I find that the word BONANZA is distinctive in respect of the goods covered by the application and the ground based upon Section 3(1)(b) of the Act is dismissed.

Section 3(6)

44) My findings above have an impact upon the ground based upon Section 3(6) and I will comment briefly on this.

45) Bad faith includes dishonesty and “some dealings which fall short of the standards of acceptable commercial behaviour” (*Gromax Plasticulture Ltd v. Don & Low Nonwovens Ltd* [1999] RPC 367). It is necessary to apply what is referred to as the “combined test” and to decide what PPG knew at the time of filing its application and then, in the light of that knowledge, whether its behaviour fell short of acceptable commercial behaviour (*Barlow Clowes International Ltd (in liquidation) & Others v Eurotrust International Limited & Others*, [2005] UKPC 37). Bad faith impugns the character of an individual or collective character of a business and, as such, it is a serious allegation (*Royal Enfield Trade Marks BL O/363/01*). The more serious the allegation the more cogent must be the evidence to support it, however, the matter still has to be decided upon the balance of probabilities. The material date for bad faith is the date of the filing of the application for registration (*Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* Case C-529/07 paragraph 35).

46) Mr Pennant’s position that there is a lack of intention to use the mark by PPG, as required by Section 32(3) of the Act, presupposes that PPG knew that the word BONANZA is a sign that should be kept free in respect of retail services or that, if they did know this, they did not believe their use of the sign had been such as to educate the consumer that it was an indicator of origin.

47) However, as the ground based upon Section 3(1)(c) has succeeded in relation to the services, I only need to comment upon the ground based upon Section 3(6) of the Act insofar as it extends to PPG’s goods. In this respect, as I have found the mark to be distinctive for these, the Section 3(6) ground based on Section 32(3) cannot succeed. Consequently, the ground based upon Section 3(6) of the Act is not made out and the opposition, insofar as it relies on this ground, is dismissed.

Summary

48) The opposition is successful insofar as the grounds based upon Section 3(1)(b) and Section 3(1)(c) relate to PPG's services listed in its Class 35 specification. In all other respects, the opposition fails.

COSTS

49) The opposition having been partially successful, ICI is entitled to a contribution towards its costs. In making the award, I reduce the amount to take account that it has only been successful in respect of the Class 35 services. I also take into account that a hearing has taken place and that only ICI submitted evidence. I award costs on the following basis:

Preparing Notice of Opposition and considering PPG's statement	£500
Preparing and filing evidence	£600
Preparing for and attending the hearing	£600
Reduction for partial success	(£400)
TOTAL	£1300

50) I order PPG Architectural Coatings UK Limited to pay Imperial Chemical Industries Limited the sum of £1300. 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 21st day of December 2011

**Mark Bryant
For the Registrar,
the Comptroller-General**