

O-014-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2356365
BY THE PROCTOR AND GAMBLE COMPANY
TO REGISTER A TRADE MARK IN CLASSES 3, 5, 11 AND 21**

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Background

1. On 19 February 2004, The Proctor and Gamble Company of One Proctor and Gamble Plaza, Cincinnati, Ohio, 45201 US applied to register the following trade mark in Classes 3, 5, 11 and 21:

MERRY CHRISTMAS

The application was made in respect of the following goods:

Class 03:

Bleaching preparations and other substance for laundry use; preparations for the care, treatment and beautification of fabrics; cleaning, polishing, scouring and abrasive preparations; pot pourri; incense; oils for perfumes and scents; scented water for household use and for use on fabrics; scented wood; aromatics; essential oils; fumigation preparations to be emitted into the air, atmosphere or on fabrics in the form of smoke, vapour or gas; preparations for perfuming or fragancing the air.

Class 05:

Air fresheners; air purifying preparations; room air fresheners; deodorants for fabrics and air; preparations for neutralizing odors.

Class 11:

Apparatus and instruments, all for scenting, purifying or freshening the atmosphere; parts and fittings for all the aforesaid goods; battery-powered or electric-operated aromatherapy and air cleaner units and refills to be inserted in these units; free-standing, unscented, non-substance emitting air deodorization devices and filters for refrigerators and other small spaces.

Class 21:

Household or kitchen utensils and containers (not of precious metal or coated therewith); oils and fragrances burners; apparatus for heating oils for perfumes and for releasing fragrance into the ambient atmosphere; dispensers and dispensing apparatus; deodorizing apparatus; apparatus and containers for scenting the atmosphere or for dispensing perfumes, air freshening or air purifying preparations into the ambient atmosphere; glassware; porcelain and earthenware.

2. Objection was taken under Section 3(1)(b) of the Act because the mark consists of the words MERRY CHRISTMAS, being a sign which would not be seen as a trade mark as it is devoid of

any distinctive character because the words are the standard greeting used during the Christmas season and are included on the packaging of many kinds of goods.

3. At a Hearing, at which the applicants were represented by Ms Angela Thornton-Jackson of D Young & Co, their trade mark attorneys, the objection was maintained.

4. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

5. No evidence has been put before me. I have, therefore, only the prima facie case to consider.

The Law

6. Section 3(1)(b) 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,”

The Case for Registration

7. At the hearing and in correspondence Ms Thornton-Jackson maintained that while it may be true that the greeting could be included on many types of goods during the Christmas season, usage in this way would clearly not be as a trade mark and that the mark was distinctive in relation to the goods applied for. The goods at issue are functional rather than decorative and it would be inappropriate to use the term as a greeting on these goods.

The Decision

8. The test to be applied in respect of this application is not whether the mark, in its totality, is a combination which is used in common parlance to describe the goods applied for but whether the mark, again in its totality, is devoid of any distinctive character. The whole purpose of Section 3(1)(b) of the Act is to prohibit registration of signs which, although not caught by the clear parameters set out by Sections 3(1)(c) and (d) of the Act are, nevertheless, incapable of distinguishing the goods and services of one undertaking from those of other undertakings.

9. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act was summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in Joined Cases C-53/01 to C-55/01 *Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

“37. It must first of all be observed that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented

graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

....

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (*see Philips* [2002] ECR I-5475, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (*see Case C-210/96 Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings."

10. I must assess the mark's distinctiveness in relation to the goods for which the applicant seeks registration. The application covers a wide range of household goods including cleaning preparations, air fresheners, apparatus for scenting or freshening the atmosphere and household or kitchen utensils and containers. I must also have regard to the perception of the relevant consumers of the goods, who, in my view, are the general public.

11. I must of course assume notional and fair use of the mark in relation to the goods applied for, which includes use on the packaging of the goods as well as use in advertising and other promotional ways.

12. The mark consists of the words "Merry Christmas" and whether the term is used on the packaging of the goods or in advertising it seems to me that the phrase gives the obvious message of conveying seasonal greetings. The term could be used on the packaging of a wide variety of goods, including the goods covered by the application, to promote the sales of the goods during the Christmas period or to indicate that the goods are for use during the Christmas period. In view of the obvious primary meaning of the term applied for it seems unlikely to me that the relevant consumer will consider this mark to denote trade origin because it will simply be seen as a seasonal greeting.

13. For the reasons given I am not persuaded that the mark MERRY CHRISTMAS is distinctive in that it would serve in trade to distinguish the applicants goods from those of other traders. In my view the mark will not be identified as a trade mark without first educating the public that it is one. 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

14. In this decision I have considered all documents filed by the agent and all the arguments submitted and, for the reasons given, the application is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 3(1)(b) of the Act.

Dated this 13th day of January 2005

IAN PEGGIE
For the Registrar
the Comptroller-General