

O-019-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2326399
BY BEKO (UK) LIMITED
TO REGISTER A TRADE MARK
IN CLASSES 7, 8, 9, 11, 20, 24, 35 and 37**

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Background

1. On the 13 March 2003, Beko (UK) Limited of Beko House, Caxton Way, Watford WD18 8UF applied to register the following sign as a trade mark in Classes 7, 8, 9, 11, 20, 24, 35 and 37:



The application was filed for a series of two marks and the colour RED claimed in the second mark of the series.

The application was made in respect of the following goods and services:

Class 07:

Cleaning machines; dishwashers; washing machines, compressors for washing machines; laundry washers, scrubbing machines, vacuum cleaners, food processors, fruit presses for household, garbage disposals, grinders for household, kitchen machines electric; machines for cleaning and washing carpets and upholstery; machines for use in the preparation of food and beverages; electric kitchen machines; electric can openers; electric knives and sharpeners; electric hair dryers; electric machines for use in the care and appearance of the skin, nails and hair; sewing, embroidering and knitting machines; laundry and ironing machines; portable steamers for fabrics; grinding machines; waste disposal machines; parts and fittings for all the aforesaid goods.

Class 08:

Hand tools and implements; cutlery, forks, knives, pizza cutters, razors, razor blades, scissors, shaving cases, slicers, spoons, hair clippers for personal use, nail clippers; electric hair trimmers; electric hair clippers; electric epilating devices; electric razors; parts and fittings for all the aforesaid goods.

Class 09:

Audio, video, optical, photographic and cinematographic apparatus and instruments; camcorders; cash registers; cassette players; compact disc players; computers; printers; radios; bar code readers; scanners; slide projectors; telephones; television apparatus; video recorders; irons; fax machines; video recording, amplifying, reproducing and transmitting apparatus and instruments; tape recorders and tape play-back machines; optical disc recorders and play-back machines; record playing apparatus and instruments; loud-speakers; earphones and headphones; radio receivers and radio signal tuners; video cameras; television apparatus and instruments; remote control apparatus and instruments;

Class 11:

Air conditioning apparatus; air deodorising apparatus; air filtering installations; bread toasters; coffee machines; cooking apparatus and installations; cooling appliances and installations; freezers; gas boilers; grills; hair driers; heat pumps; ice boxes; ice machines; kettles; kitchen ranges; laundry dryers; autoclaves; refrigerating apparatus and machines; refrigerators; stoves; cooling and freezing apparatus, appliances and containers; refrigerators; freezers; air-conditioning, air cooling and ventilation apparatus and instruments; lighting apparatus; electric apparatus for making beverages; installations, apparatus, appliances and utensils, all for cooking; stoves, ovens, microwave ovens toasters and griddles;

Class 20:

Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; armchairs; curtains; bedding; beds; binding screws; boxes; carts for computer; chairs; clotheshooks; parts and fittings for all the aforesaid goods.

Class 24:

Textiles and textile goods, not included in other classes; household linen; bed and table covers; bath linen, bed blankets; bed covers; bed linen; coverings; curtains; face towels; mattress covers; napkins; pillowcases; shower curtains; table linen; flags; duvet covers; bedspreads; table cloths; table linen; table mats; table napkins of textile; table runners; towels; washing mitts.

Class 35:

Marketing and advertising; marketing, advertising and sales promotion activities for household appliances like refrigerators, heaters, air conditions, vacuum cleaners, and textiles and furnitures; the bringing together for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods.

Class 37:

Repair and maintenance services; repair and service activities for household appliances like refrigerators, heaters, air conditions, vacuum cleaners, and textiles and furnitures.

2. Objection was taken against the application under Section 3(1)(b) of the Act because the marks consist of a single block of colour in a non-distinctive quadrilateral, the whole being devoid of any distinctive character.

3. A further objection under Section 41(2) of the Act was raised by letter on 10 August 2004 because of the presence of the colour Red in the second mark in the series this being a material particular which affects the identity of the mark.

4. A Hearing was held on 25 August 2004 at which the applicant was represented by Mr C R Beuhrlen of Beck Greener, Trade Mark Attorneys. The objections were maintained and the application was subsequently refused in accordance with Section 37(4) of the Act.

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

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

The Law

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

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

(b) Trade marks which are devoid of any distinctive character;”

The Case for Registration

8. In correspondence prior to the Hearing Mr Beuhrlen suggested that the mark applied for consisted of a flag-like device which is easily recognisable by purchasers of goods without the need to educate the public.

9. At the hearing Mr Buehrlen maintained that the flag-like device would function as an indication of origin as it was more than a simple geometric shape and sufficiently memorable for acceptance.

Decision

10. 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.

11. 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.”

12. The application is for a series of two marks. The marks consist of a simple shape and the colour red is claimed as an element of the second mark. There is no colour claim relating to the first mark in the series and I must, therefore, assume that registration is sought for the device applied for in any colour.

13. I must assess the mark’s distinctiveness in relation to the goods and services for which the applicant seeks registration. The application covers a wide range of domestic electrical appliances and household consumer goods as listed above. I must also have regard to the perception of the relevant consumers of the goods and services, who, in my view, are the general public.

14. Assuming notional and fair use of the mark, it seems unlikely to me that the relevant consumer would consider this mark to denote trade origin. The mark is a single colour in a simple shape. Although it is not a uniform geometric shape it does not vary to a significant degree to be perceived as unusual or memorable. In order to be able to fulfil its essential function a trade mark must be capable of being perceived and recalled as being an indication of origin. In order to do this the sign must be capable of making an impact in the perception of a relevant consumer and be capable of being perceived as a badge of origin. In my view the trade marks in question are so banal that they are unlikely to make the necessary impression.

15. The colour red is claimed as an element of the second mark in the series. In my view the colour claim does not give the second mark a distinctive character. Consumers are accustomed to seeing coloured rectangles used in trade as signage on packaging often for the purpose of framing descriptive information and the reasons for maintaining the objection under 3(1)(b) of the Act apply equally to both marks.

16. I am not persuaded that the mark applied for is distinctive in that it would serve in trade to distinguish the applicant's goods and services from those of the traders. In my view the mark applied for will not be identified as a trade mark without first educating the public that it is one. I therefore conclude that this 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.

17. An objection was also taken under Section 41(2) of the Act.

18. Section 41(2) of the Act reads as follows:

“41. – (2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.”

19. In order to satisfy the requirements of Section 41(2) of the Act both marks must resemble each other in the material particulars while differing from each other only in respect of matter of a non-distinctive character which does not substantially affect the identity of each other.

20. Although the essential shape of the marks is the same, the first mark is merely a black representation of the simple shape, whereas the material particulars of the second mark include a colour claim relating to the colour red. In my view, in this case this accounts for part of the identity of the second mark.

21. In Logica's Trade Marks [BL O/068/03] Professor Ruth Annand sitting in her role as the Appointed Person established that Section 41(2) of the Act contains three conditions which must be met. In her decision she stated:

“38 I agree with Mr James that section 41(2) contains three conditions and not two but prefer to describe them according to their positive and negative aspects. First on the positive side, section 41(2) requires that trade marks for which registration is sought to resemble each other in their material particulars. Second and third, the

negative aspects are that any difference in the trade marks must not comprise matter, which when considered:

- (a) as a separate element of the trade mark would be regarded as having distinctive character; and
- (b) in the context of the trade mark as a whole, substantially affects the identity of the trade mark.”

22. Turning to the meaning of “non substantially affecting the identity of the trade mark”, I believe it would be hard to improve on Jacob J’s observation in *Neutrogena Corporation v Golden Limited* [1996] RPC 473, at 488-489 regarding, in effect, the identical phrase in Section 30(1) of the Trade Marks Act 1938:

“Not substantially affecting its identity means what it says, both in this section and in other sections of the Act (e.g. Section 35). An alteration which affects the way a mark is or may be pronounced, or its visual impact or the idea conveyed by the mark cannot satisfy the test.”

23. If there is a difference of substance between the marks, either visually or phonetically they will not qualify as a series.

24. In this application the identity of the marks is substantially affected by the visual differences and the material particulars of the marks therefore vary. The first mark could be used in any colour and colour cannot therefore be regarded as being a feature of the mark. By contrast, the second mark has two features, the shape and the colour red in combination. Given the difference between the marks applied for, I am satisfied that the marks contained within this application differ as to their material particulars in such a way that they do not satisfy the requirements of Section 41(2) of the Act.

Conclusion

25. In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to the application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) and 41(2) of the Act.

Dated this 17th day of January 2005

**IAN PEGGIE
For the Registrar
the Comptroller-General**