

O-074-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2428182
BY BRITISH AMERICAN TOBACCO (BRANDS) INC.
TO REGISTER THE TRADE MARK**



IN CLASS 34

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By British American Tobacco (Brands) Inc

To register the trade mark



In class 34

BACKGROUND

1. On 26 July 2006 British American Tobacco (Brands) Inc. applied to register the above trade mark for the following goods:

Class 34: Cigarettes, tobacco, tobacco products, smokers' articles, lighters, matches.

2. An objection was raised by the UK Intellectual Property Office under Section 3(1)(b) of the Trade Marks Act 1994 ("the Act") on the grounds that the mark as a whole was a non-distinctive sign that would not be seen as a trade mark¹. Further particularisation of the reasons for this objection will be given later in this decision.

3. Following a hearing², at which the applicant was represented by Ms Purvee Shah of Murgitroyd & Company, I maintained the above objection. 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. No evidence of use for the purpose of demonstrating acquired distinctiveness has been put before me. Therefore, I have only the *prima facie* case to consider.

The applicant's case for registration

4. At the hearing, Mr Shah put forward a number of submissions to persuade me to waive the objection. These focused on the fact that the mark had an unusual and distinctive representation of a sun appearing in it and, additionally, the words SUN RIPENED TOBACCO were presented in different font sizes to each other. It was argued that the overall impression of the mark and the impact that it would have on the relevant consumer was that of a badge of origin. Following my expression of initial reservation

¹ The examination report raising this objection was sent to the applicant on 23 September 2006.

² The hearing itself took place on 24 August 2007.

with the mark (on the basis that the relevant public would take only an origin neutral meaning from the mark) the agent agreed to send in examples of the mark in use in order that a contextualised appreciation of it could be made. When submitting such examples, Ms Shah made similar submissions in writing to those she made at the hearing. One example of the mark in use (or more specifically the mark's intended use) is shown below:



DECISION

The law

5. 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 legal tests

6. The case-law in this area is fairly well settled. The question I must answer is whether the mark will perform the essential distinguishing function of a trade mark or whether it lacks the distinctiveness to do so? There was no real dispute between Ms Shah and myself on the test to be applied, indeed, her submissions focussed on whether the sign would be seen as a badge of origin or not. However, for the record, I should outline the approach I have undertaken with reference to which authorities. The approach to be adopted when considering issues under this ground was summarised by the European Court of Justice in paragraph 37, 39 and 41 to 47 of its judgment in Joined Cases C-53/01 to C- 55/01 *Linde AG, Winward Industries Inc and Rado Uhren AG* (8 April 2003) in the following terms:

“37. It is to be noted at the outset 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 or 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* 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”.

7. From the above, I am therefore aware that the mark’s distinctiveness must be assessed in relation to the goods sought by the applicant and that I must also have regard to the perception of the average consumer who is deemed to be reasonably well informed and reasonably observant and circumspect. I must therefore assess the impact that the mark will have on the average consumer when used in relation to the goods at issue and decide whether they will regard the mark as something that is identifying to them that the goods originate from a particular undertaking.

8. I also regard the test to be one of immediacy or first impression. A number of cases have commented on this. For example, in *Sykes Enterprises v OHIM (REAL PEOPLE, REAL SOLUTIONS)* [2002] ECR II-5179 the Court of First Instance stated:

“However, a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin.”

The average consumer

9. The mark has been applied for in relation to a range of goods in Class 34. They relate to tobacco and tobacco products and also some other smokers articles. This is not a specialist or technical field and the average consumer will therefore be the general public, albeit those who smoke. Most smokers, due either to the addictive properties of the goods or through choice, smoke regularly. Although this means that the goods are likely to be everyday purchases (although I accept that some consumers are only occasional smokers), this does not make the average consumer any less observant or circumspect given that the choice of goods at issue is a quite personal one depending on the taste and preference of the particular consumer.

The mark itself

10. The mark itself is constructed of two distinct elements. It consists of a stylised representation of a sun (I use the word stylised to indicate that it is not a faithful or realistic pictorial representation) above the words SUN RIPENED TOBACCO. The three words appear one above the other with the word SUN in a larger type font than the words RIPENED and TOBACCO.

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

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

The impact on the consumer

13. The impact of the words in the mark are clear, namely that of a reference to the goods as described above. It is also clear that the presence of the sun device has a relationship to these words and, to some extent, may re-enforce or supplement their meaning; in other words, the sun device, in the context of the mark as a whole, is not an arbitrary or fanciful inclusion. Despite all this, will the overall impression, as the attorney would have me believe, strike the consumer as a badge of origin?

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

“I do not think that the hearing officer was guilty of excision or dismemberment in his assessment of the present mark. Devices can be distinctive or non-distinctive, just like any other kind of sign. What matters are the perceptions and recollections that the sign in question is likely to trigger in the mind of the average consumer of the goods concerned and whether they would be origin specific or origin neutral.

I think that the verbal elements of the mark I am considering speak loud and clear. It seems to me that the message they convey is origin neutral. The artistic presentation neatly and skilfully builds upon and reinforces the origin neutral message in a way that makes it even more effective than the words alone might have been for that purpose. I think that net result is a well-executed, artistically pleasing, origin neutral device.”

15. Applying similar reasoning to the mark at issue here, it strikes me that the words SUN RIPENED TOBACCO also speak loud and clear and that they do so in a descriptive and therefore origin neutral manner. The presentation incumbent in the sun device (and the overall presentation of the words), despite having an element of artistic nature, merely build upon and re-enforces the message behind the mark. This all leads, in my judgment, to a mark that fails to strike the consumer as a badge of origin.

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

17. Before concluding, I should state that the application also covered some goods that would not contain tobacco, for example, lighters and matches. Whilst the words that appear in the mark cannot be said to be descriptive of this category of goods, this does not alter my finding in relation to the mark’s lack of distinctiveness. Lighters and matches are so closely related to tobacco and tobacco products that the mark, if used in relation to these goods, would not suddenly start to convey a trade origin message³. This is particularly so when one considers the range of notional and fair uses that the mark could be put to and the resulting varied circumstances where the consumer could potentially encounter the mark. For example, if the mark were used on promotional or advertising material or at the point of sale, then the consumer would have to go through a process of analysis and conjecture for them to come to any view close to that equating to the sign functioning as a badge of origin; this, as I have already identified, is not the test. I should add that the attorney did not make any distinction between the various goods at the hearing.

³ A similar finding can be seen in the decision of Mr Hobbs QC (sitting as the Appointed Person) in *Fourneaux De France* [BL O-240-02]

CONCLUSION

18. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from *prima facie* registration on the grounds of Section 3(1)(b) of the Act.

19. 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 and, for the reasons given, it is consequently refused under the terms of Section 37(4) of the Act.

Dated this 13th day of March 2008

**Oliver Morris
For the Registrar
The Comptroller-General**