

O-1085-23

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 3905253
IN THE NAME OF JACQUELINE YOUNG
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 21**



Background

1. On 26 April 2023, Ms Jacqueline Young ('the Applicant') applied to register the above trade mark for the following goods:

Class 21: *Large-toothed combs for the hair; Combs for the hair (Large-toothed -); Hair combs; Hot pots, not electrically heated; Combs; Horse combs; Mane brushes [horse combs].*

2. On 12 May 2023, the Intellectual Property Office ('IPO') issued an examination report in response to the application. The examination report contained an objection under Sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994 ('the Act'). It is noted that the Section 3(1)(b) objection was not raised separately, rather it was raised in conjunction with, and as an automatic consequence of, the Section 3(1)(c).
3. The Section 3(1)(c) objection was raised on the basis that the mark was considered to consist exclusively of a sign which may serve in trade to designate the kind and intended purpose of the goods on offer, i.e., heated combs intended to provide an extensive [deep] condition of the user's hair. The Collins English Dictionary was used as a reference for the meaning of each of the mark's words. In relation to the stylisation of the mark, the examination report argued that it was minimal and did not distract the consumer's attention from the descriptive words. A deadline of 12 July 2023 was provided for a response.
4. On 24 July 2023, 12 days after the expiry of the deadline, a 'Failure to respond' letter was issued. This letter confirmed that the Registrar had not received any response relating to the objections under Section 3(1)(b) and (c), and that as a direct result of the Applicant's failure to respond the application was being refused under Section 37(4) of the Trade marks Act 1994. Included within the refusal letter was information pertaining to the possibility of filing a Form TM5 in order to obtain a 'statement of grounds' (SOG). The refusal letter also included information explaining that the TM5 was not to be used for requesting an extension of time, or for responding to the original objections. The refusal letter provided a period of 1 month in case the Applicant wished to file a TM5.

5. On 21 August 2023, the Applicant sent correspondence in which it stated the previous letters were “not very clear about the reason for the prevention of the Trade Mark”. The Applicant also included in its correspondence the following: “I shall complete form M5 [sic] as your email asks”. A Form TM5 was received on 21 August 2023 accompanying the correspondence.
6. Under Section 76 of the Trade Marks Act 1994, and rule 69 of the Trade Marks Rules 2008 (‘the rules’), I am now tasked to state in writing the grounds of my decision and the material used in arriving at it. In doing so, I will consider not only the decision to refuse the application due to the lack of response in accordance with Section 37(4), but I will also consider the validity and relevance of the original Section 3(1) objections raised.
7. It should be noted that although the Applicant corresponded further with the IPO subsequent to the filing of the Form TM5, no submissions were made as to the acceptability of the application or as to any potential error in the examination of it. In addition, although the Registry asked on a number of occasions if the Applicant had requested the SOG in error or without understanding the correct reasons for making such a request, the Applicant did not directly address the question or formally rescind/withdraw the TM5. Of further note is the fact that no evidence of acquired distinctiveness has been put before me. Considering that there are no submissions to take account of, the decision will be made on the *prima facie* acceptability of the application only.

Decision

8. I shall consider first the decision to refuse the application as a direct result of having not received correspondence within the time set (that is, the period expiring on 12 July 2023). In doing so I turn to Section 37(4) of the Trade Marks Act 1994. Section 37 sets out provisions which govern the examination of trade mark applications, with sub-section (4), in particular, providing the Registrar with grounds for refusing such an application where it fails to meet the requirements for registration. The provision (and its requirements) reads as follows:

“If the applicant fails to satisfy the registrar that those requirements are met, or to amend the application so as to meet them, **or fails to respond before the end of the specified period**, the registrar shall refuse to accept the application.”
9. The decision to refuse the application as a result of the applicant’s failure to respond within a clearly-communicated time frame was correct, and in full accordance with established law and practice. Section 37(4) is a mandatory provision (not discretionary), giving the Registrar no alternative other than to refuse the application. The decision to refuse the application on the basis of Section 37(4) is sound, and therefore stands.
10. However, for the avoidance of any doubt, and for purposes of complete thoroughness in the interests of legal certainty, I will now consider the original objections under Sections 3(1)(b) and (c) and whether in my opinion they are sound.

Section 3(1)

11. The relevant parts of section 3 of the Act read 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,*

(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.”

The relevant legal principles - Section 3(1)(c)

12. There are a number of judgments from the CJEU which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 (recoded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1)(c) of the Community Trade Mark Regulation (the 'CTMR'), whose provisions correspond to section 3(1)(c) of the UK Act.
13. The main guiding principles which are relevant to this case are 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*, C191/01P 'Doublemint', paragraph 30);
 - Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all. The provision therefore prevents such signs or indications from being reserved to one undertaking alone because they have been registered as trade marks (see judgment of 4 May 1999 in Joined cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots-und Segelzubehör Walter Huber and Franz Attenberger (Chiemsee)* [1999] ECR I-2779, at paragraph 25).
 - The words 'may serve in trade' include within their scope the possibility of future use even if, at the material date of application, the words or terms intended for protection are not in descriptive use in trade (see, to that effect, CJEU Cases C-108/97 and C109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots and Segelzubehor Walter Huber and others*;
 - As well as the possibility of future use, the fact there is little or no current use of the sign at the date of application is also not determinative in the assessment. The words 'may serve in trade' are to be interpreted as meaning, 'could' the sign in

question serve in trade to designate characteristics of the goods/services, see e.g. BL O/096/11 'Putter Scope', a decision of the Appointed Person at para 11;

- It is a well-established principle that the Registrar's role is to engage in a full and stringent examination of the facts, underlying the Registrar's frontline role in preventing the granting of undue monopolies, see to that effect CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z.o.o. v OHIM* [2011] ECR I-1541 (*Technopol*).
- 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 goods and services in question or one of their characteristics - see CJEU Judgment C-468/01 P to C472/01 P *Procter & Gamble Company v OHIM* (Three-dimensional tablets for washing machines or dishwashers) at paragraph 39, and General Court Judgment T-222/02 'Robotunits' at paragraph 34.
- When determining whether a sign is devoid of distinctive character or is descriptive of the goods or services in respect of which registration is sought, it is necessary to take into account the perception of the relevant consumer who is reasonably well-informed and reasonably observant and circumspect (*Matratzen Concord AG v Hukla Germany SA*, C421/04);
- In light of all the foregoing, a sign's descriptiveness cannot be assessed other than by reference to the goods or services concerned, on the one hand, and by reference to the understanding which the relevant persons have of it, on the other (see judgment of 15 October 2003 in Case T-295/01 *Nordmilch eG v OHIM* ('*Oldenburger*') [2003] ECR - 4365, at paragraphs 27 to 34).

Application of legal principles – Section 3(1)(c)

The mark in the prima facie

14. The mark contains the stylised words 'Hot Comb'. The words are stylised insofar as they use a red, shadow-effect font, which gives the impression of three-dimensional letters. The word 'Comb' falls below and to the right of the word 'Hot'. Below the stylised words 'Hot Comb' appears the combination of four words 'Hot comb, deep condition', written in a plain red text. According to the examination report, the words are descriptive of combs and hot combs that offer a deep condition of the user's hair.
15. As is stated in case-law, the perception of the relevant consumer must be considered in order to decide whether an apparently descriptive meaning will be perceived by the relevant party. The majority of the goods are combs used by humans. Such goods are not specialist items, and are likely to be purchased by the majority of average consumers who have hair. The "average consumer" is a legal construct, and refers to a person who is considered to be reasonably well informed and reasonably observant and circumspect. The level of attention of the average consumer will vary depending on the category of goods or services in questions (see C-342/97, '*Lloyd Schuhfabrik Meyer*'). Given the nature of the

goods at issue, I am of the opinion that the level of attention in relation to combs will be quite low. I note that the goods at issue also include *Mane brushes [horse combs]*. Whilst I believe it likely that a fewer number of consumers would be relevant for such a good (i.e., horse owners, horse trainers etc.), I nevertheless do not consider the item to be so specialist in nature that it requires a heightened degree of attention. This is because a brush/comb for a horse is still a relatively rudimentary item.

16. Considering that the goods applied for include combs and brushes/combs, it appears to me self-evident that the words possess the directly descriptive meaning as provided by the examiner. As an aside, I find it worth clarifying that whilst I recognise a brush and a comb are different items described by different words, they are effectively one and the same as regards their intended purpose: to control hair. In addition, it is important to recognise that the *Mane brushes* have been qualified as being *horse combs*. Due to the Applicant having not provided any argument to the contrary of the finding in the examination report in relation to the applied for combs/brushes, I see no reason to disagree with the examiner's position in relation to these goods.
17. I note that the mark contains a certain degree of stylisation. The wording of Section 3(1)(c) uses the term 'exclusively' when referring to marks which are found to be descriptive. Although the Applicant did not make this submission, I nevertheless have to consider whether the inclusion of stylisation affects the concept of 'exclusively', thus rendering Section 3(1)(c) not relevant. Whilst the stylisation is notable, it is my opinion that it is not particularly noteworthy, and its inclusion would not affect the purely descriptive message of the mark to the point that Section 3(1)(c) no longer applies. As explained by the examiner in the original objection letter, the stylisation is minimal and would not distract the consumer from the purely descriptive message.
18. In order to support this finding I refer to the '*Spambuster*' judgment of the England and Wales High Court, [2005] (EWHC) 13 (Ch). In this judgment, Lord Justice Arnold acting as Queen's Council (as he then was) considered whether the use of a stylised font impacted the otherwise entirely descriptive message of the word 'Spambuster'. LJ Arnold said:

*“Although the coloured cartoon font employed in the defendant's mark is much less common than the font under consideration in *Messe München v OHIM*, it still amounts to a way of writing the descriptive word SPAMBUSTER. Thus the defendant's Mark contains nothing additional to the word SPAMBUSTER, it merely represents that word in one particular manner. In oral use the visual presentation would disappear, leaving just the word SPAMBUSTER. In this connection I note that in '*Postkantoor*' (see C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau*) the Court of Justice stated:*

“98. As a general rule, a 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 for the purposes of Art. 3(1)(c) of the Directive. Merely bring 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.”

19. LJ Arnold continued that permitting to register a mark that was directly descriptive merely because it was represented in a “fancy” script would be akin to “drive a coach and horse through s.3(1)(c)”.
20. LJ Arnold did not dismiss the impact of any or all figurative/stylistic elements on otherwise descriptive words entirely. Indeed, he acknowledged that additional devices as simple as an exclamation mark surrounded by an oval would prevent a mark from being considered to consist exclusively of otherwise descriptive words. However, he reiterated that if a word is sought to be registered the question is whether the word(s) are distinctive per se, regardless of whatever visual presentation might be adopted. I consider the same analysis to be relevant and to apply to the mark in question. In this regard, I reiterate my position that the word combination ‘Hot Comb Hot comb, deep condition’ is not distinctive per se (as it is descriptive), and the use of stylisation simply amounts to mere presentation of the objectionable words in a particular (but non-distinctive) manner.
21. Despite the use of stylisation, it is my view that the mark as a totality will ultimately be perceived by the consumer as consisting entirely of descriptive words and, considering that it lacks an additional figurative element that does not amount to more than mere presentation, the Section 3(1)(c) objection therefore correctly applies.
22. Based on the above, and lacking any opinion to the contrary presented by the Applicant, I find the mark applied for will likely be viewed as a combination of terms which directly designate the characteristics of kind and intended purpose of the comb/brush goods applied for. I therefore find the prima facie meaning of the mark to be excluded from registration for the goods applied for under section 3(1)(c), and also 3(1)(b) as a consequence of the finding under (c).
23. However, the application was also made in relation to *Hot pots, not electrically heated*. These goods are self-evidently not combs/brushes. The question therefore arises whether the combination of words ‘Hot Comb hot comb, deep condition’ is directly descriptive of a good which are not a comb (or brush). I refer again to the wording of Section 3(1)(c), which states that a trade mark that consists exclusively of signs or indications which may serve in trade to designate a characteristic of the goods shall not be registered. Considering that the words contained within the application do not, in any way, relate to a pot (hot or otherwise), I do not find it likely that the average consumer would perceive a directly descriptive link between the applied for goods and the mark.
24. The Trade Marks Act 1994 refers to instances where objections may be partial, specifically under Section 5A which states the following:

Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.
25. Further, in the decision of 11 May 2006, Mr Richard Arnold QC (as he then was), acting as the Appointed Person in BL O/136/06, *SENSORNET*, found the following:

50 “...if an objection to registrability only applies to some goods or services in the specification applied for, then the application should only be refused in

so far as it covers those goods or services and should be allowed to proceed in respect of the remainder. I consider that this is equally true during examination and during opposition.”

26. On the basis that the concept of the mark directly describes a hot comb (or brush) only, the objection in relation to goods which are not hot combs (or brushes) must be waived. The application may, therefore, proceed to publication for the following goods:

21 *Hot pots, not electrically heated.*

Conclusion

27. In this decision, I have considered the objection issued by the examiner. Ordinarily, I would have also considered any and/or all submissions filed by the applicant and their arguments submitted therein. However, an alternative argument endorsing the acceptability of the mark was not provided by the applicant.
28. Whilst the Section 37(4) refusal was correctly raised as a result of a failure to respond, it is my opinion that the Section 3(1)(b) and (c) objection should not have originally been raised in relation to *Hot pots, not electrically heated*.
29. Therefore, upon review, and despite the failure to respond in relation to these specific goods, I nevertheless consider it fair and appropriate to allow the application to proceed to publication for *Hot pots, not electrically heated*.
30. The Section 3(1)(b) and (c) objection is considered to have been correctly raised in relation to the following goods, for which the application shall be refused:

Large-toothed combs for the hair; Combs for the hair (Large-toothed -); Hair combs; Combs; Horse combs; Mane brushes [horse combs].

Dated this 15th of November 2023

Dafydd Collins