

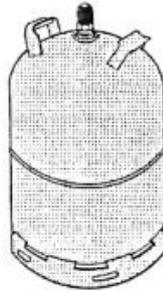
TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION No 2154261
TO REGISTER A TRADE MARK
BY CALOR GAS (NORTHERN IRELAND) LIMITED
IN CLASS 4.**

DECISION AND GROUNDS OF DECISION

Background

1. On 23 December 1997 Calor Gas (Northern Ireland) limited of Airport Road West, Sydenham, Belfast, BT3 9EE, Northern Ireland applied to register a series of two trade marks in Class 4. However, the second trade mark applied for was subsequently deleted resulting in an application to register the following trade mark:



The Trade Mark consists of the colour yellow applied to the outer surface of the cylinder within which gas is contained.

2. The goods for which registration is sought are:

Class 4 Fuel gas in liquid form.

3. Objection was taken against the application under Section 3(1)(a) of the Act because the mark applied for is not capable of functioning as a trade mark.

4. Subsequent to the *Ty Nant* decision [1999] ETMR 981 the Trade Marks Registry conducted a review of all unregistered applications where objections had been raised under Section 3(1)(a) of the Act. As a result of this review the basis of the objection was amended and, on 3rd September 1999, an objection was raised under Section 32(2)(d) of the Act. Under the provision of Rule 11 of the Trade Mark Rules 1994 the applicant was allowed a period of two months until 3rd November 1999 within which to remedy this deficiency in the application. This period of two months is not extendable in any circumstances.

5. This objection was waived on 13th September 1999 after it was agreed that the description of the mark was to be amended to the following form of words:

“The Trade Mark consists of the colour yellow applied to the whole visible surface of the cylinder within which gas is contained.”

6. However, in the official letter dated 3rd November 2003, The Registry advised that following the decision of the European Court of Justice in “*Libertel*” (C-104/1) an application to register colour alone as a trade mark must contain a reference to the mark that is represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The Court went on to say that “this condition cannot be satisfied merely by reproducing on paper the colour in question, but may be satisfied by designating that colour using an internationally recognised identification code”. Under Rule 11 of the Trade Mark Rules 2000 a period of two months until 3rd January 2004 was allowed within which this deficiency in the application must be remedied. However, as 3rd January 2004 is a Saturday, and is therefore a non-business day, this deadline was extended to 5th January 2004.

7. On 5th January 2004 a representation of the colour applied for was filed as a JPEG file which had been copied onto a floppy disc. This represented the colour yellow, by identifying the reference values, using the RGB coding system, as R255, G160, B22. The RGB colour model is an additive model in which red, green and blue light are combined in various ways to reproduce other colours. The name of the model and the abbreviation “RGB” come from the three primary colours, Red, Green and Blue, often used in additive light models. The RGB colour model itself does not define what is meant by “red”, “green” and “blue”, and the results of mixing them are not exact unless the exact spectral make-up of the red, green and blue primaries are defined. The colour model then becomes an absolute colour space. The office’s guidance at the time on electronic filing, the Patent and Trade Mark Application System (PATRAS) indicated that this was an acceptable means of identifying an electronically filed colour because it would allow the office to reproduce the colour accurately on the electronic register.

8. On 24th March 2004 The Registry advised that the image provided is an unambiguous electronic representation of a specific colour but not the colour originally applied for. The colour identified by the RGB codes was not pure yellow but a colour which appeared to be orange. It was suggested by the registry that a further image should be provided in the same format as the one already filed but that it should represent precisely the actual colour applied for.

9. Further correspondence ensued but the registrar’s objection about the variance in the colour applied for and the electronic representation of the colour filed were not overcome. Consequently, on 5th May 2005 the registry advised that the application does not meet the requirements of Section 32(2)(d) of the Act. This is because the application does not meet the *Sieckmann* criteria as defined by the European Court of Justice in Case C-273/00 because the colour applied for is defined in the application as being yellow but the electronic representation of that colour indicates that it is orange. Under Rule 11 of the Trade Mark Rules 2000 a non-extendable period of two months until 5th July 2005 was allowed for this deficiency to be remedied.

10. No further representations were filed but a hearing was requested on 1st July 2005.

11. A hearing was held on 18th January 2006. The applicant was represented by Mr Ramage of Alexander Ramage Associates, their Trade Mark Attorneys. At the hearing I advised Mr Ramage that I would issue my decision in writing in due course. My decision was issued on 30th January 2006 and the objection under Section 32(2)(d) of the Act was maintained. According to Rule 11, the consequence of non-compliance is that the application is deemed never to have been made.

12. 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.

The Law

13. Section 32 of the Act reads as follows:

“32.-(1) An application for registration of a trade mark shall be made to the registrar.

(2) The application shall contain-

- (a) a request for registration of a trade mark
- (b) the name and address of the applicant
- (c) a statement of the goods or services in relation to which it is sought to register the trade mark, and
- (d) a representation of the trade mark.”

The case for registration

14. Mr Ramage advised me that the Oxford Concise Dictionary 9th Edition defines the word yellow as a colour between green and orange and further defines orange as a reddish yellow colour.

15. The mark applied for is the colour yellow applied to a cylinder containing gas. In order to comply with the *Libertel* judgement (C-104/01) the applicant filed a representation of this colour as a JPEG which contained a representation of this colour. The colour is identified by reference to an internationally recognised system which refers to the primary colours Red, Green and Blue. This is known as the RGB system and it identifies this particular colour by indicating the amount of red, green and blue contained in the colour being referenced. This particular shade of yellow is identified as Red 255, Green 160 and Blue 22.

16. The RGB system is definitive, accurate and durable. Mr Ramage advised me that this particular colour is not identified by the Pantone reference system.

17. Mr Ramage referred me to the results of the survey conducted by Millward Brown Ulster Limited which were attached to his letter dated 7th September 2004. Although none of the original documents are included it was confirmed at the hearing that the image shown to the respondents during this survey is the colour applied for.

18. I was also referred to a decision by the Second Board of Appeal on 6th October 2005 in Case R255/2004-2 which was an appeal by J. C. Bamford Excavators Limited against a decision by the Office for Harmonization in the Internal Market (OHIM). This relates to an application to register an almost identical colour in classes 7 and 12. Mr Ramage referred me to this decision because, throughout its text, the colour is referred to as yellow. This colour is available to be viewed on a print from the on-line database provided by OHIM and, although the copy on the official file is a photocopy it appears to be very similar to the colour provided in the JPEG filed in support of this application.

19. Mr Ramage also relies on the evidence submitted on 6th December 2002 which consists of a survey of retailers of the gas cylinders in question. Again, yellow is the only colour referred to with no mention being made of the colour being orange.

Decision

20. In *Libertel* (C-104/01) the European Court of Justice decided that the sign applied for must be capable of graphic representation (Paragraph 23). The Court went on to make the following comments in respect of graphic representation of a sign:

“28. Furthermore, as the Court has held, a graphic representation within the meaning of Article 2 of the Directive must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified (Case C-273/00 *Sieckmann* [2002] ECRI-11737, paragraph 46).

29. In order to fulfil its function, the graphic representation within the meaning of Article 2 of the Directive must be clear, precise, self-contained, easily accessible, intelligible, durable and objective (*Sieckmann*, paragraphs 47 to 55).”

21. The sign for which registration is now sought comprises of two elements. There is the device of a gas cylinder which is accompanied by the following words:

“The Trade Mark consists of the colour yellow applied to the whole visible surface of the cylinder within which gas is contained.”

22. My understanding at the hearing was that Mr Ramage accepts that the actual colour applied for must be represented in accordance with the judgement of the Court in *Libertel*.

23. In fact, in order to so comply, the applicant filed a representation of the colour applied for 5th January 2004. This representation of the colour was filed as a JPEG which was itself filed as an attachment to a floppy disc. The JPEG contains a

representation of the colour identified as R 255, G 160, B22. Although the RGB system is not a particularly well known colour identification system it is a system that is internationally recognised. This JPEG was examined by a technical expert at the Trade Mark registry who confirmed that it is an unambiguous electronic representation of a single colour. Mr Ramage was advised of this by the official letter dated 24th March 2004. This letter went on to make the following comments:

“However, the problem we have is that the colour is not close to pure yellow (the colour of the cylinder applied for) but sits between yellow and red in the orange region. The “Photoshop” package indicates the closest Pantone colours in the “Coated” inks to be Pantone 1375C, which comprises 81.3% Pantone Yellow and 18.7% Warm Red. The closest in the “Uncoated” inks is Pantone 123U, which comprises 93.8% Pantone Yellow and 6.2% Warm Red. In essence, the colour of the image is orange which is, of course, contrary to the mark applied for which states the colour yellow.”

24. In his letter of 17th December 2004 Mr Ramage makes it clear that the applicant is satisfied that the colour filed as a JPEG with RGB reference R 255, G 160, B22 is the “unique shade of yellow which, we believe, is colloquially known as “Calor Gas Yellow”.” Mr Ramage further indicated that none of the purchasers of gas produced by the applicant refer to the colour of the container as orange.

25. In support of this submission Mr Ramage refers to the survey conducted by Millward Brown Ulster Limited . A representation of the gas cylinder, in colour, is attached to these survey documents. The gas cylinder appears to be orange in colour but the Affidavit by Mr Stephen Young, Director of Millward Brown Ulster Limited makes it clear that in the responses to the survey no mention is made to the colour being described as orange. Although this is a sworn affidavit I must point out that the original response documents are not available for inspection.

26. While I accept the dictionary definitions of the words yellow and orange it does not necessarily follow that the colour identified as R 255, G 160, B 22 is a shade of yellow. I accept that there are numerous shades of yellow but I do not accept that the colour represented by the RGB reference is a representation of the colour yellow. In order to comply with the requirements of Section 32(2) of the Act the written description of the trade mark applied for must correspond to the visual representation of it. The Registrar regards the written statement as forming a part of the graphical representation of the mark. A person inspecting the register would not regard the visual representation of the mark filed as being yellow. Thus there is ambiguity caused by the tension between the written description and the colour represented in the JPEG file.

27. Mr Ramage has referred me to the decision of the Second Board of Appeal (Case R255/2004-2). A copy of that decision is attached at Annex A. Although there is a copy of this particular colour available for inspection from the on-line database provided by OHIM I note that there were some 17 exhibits in relation to that decision including promotional leaflets etc.. I have no evidence before me as to any colour being represented in these exhibits or what colour that would be. It is possible to assume that it is the same as that available from the on-line database provided by OHIM but as Mr Ramage has pointed out, these colours change with age, their means

of reproduction and the properties of the surface to which they are applied. I therefore place little weight on the fact that the Second Board of Appeal refer to the mark as the colour yellow.

28. In the circumstances I have concluded that this application does not meet the requirements of Section 32(2)(d) of the Act because the form of application does not contain a representation of the trade mark which is clear, precise or intelligible.

Conclusion

29. 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 stated, the application is deemed never to have been made because the form of application does not meet the requirements of Section 32(2)(d) of the Act.

Dated this 12th day of May 2006

**A J PIKE
For the Registrar
The Comptroller-General**

THE ANNEX IS NOT ATTACHED