

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2042882B
IN THE NAME OF CARRICK JEWELLERY LIMITED**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 49024 IN THE NAME OF
CHATEAU WATCHES LTD and GEORGE PANTON & SON LTD**

TRADE MARKS ACT 1994

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CARRICK JEWELLERY LIMITED**

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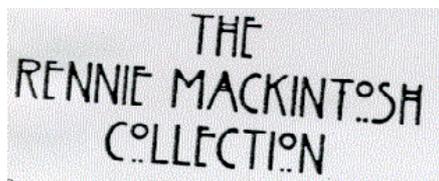
**IN THE MATTER OF opposition thereto under No 49024
in the name of Chateau Watches Ltd and George Panton & Son Ltd**

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Background

On 28 October 1995, Carrick Originals Limited of 7 Buchanan Street, Glasgow, G1 3HL,
applied to register the following trade mark

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The application was made in Classes 14 and 20 and in respect of the following goods:

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Class 14 Jewellery, watches and clocks, photo frames, picture frames, boxes; all being wholly or substantially wholly of precious or semi-precious metal, or coated therewith.

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Class 20 Trinket and jewellery boxes of wood and frames for pictures and photographs.

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The application proceeded on the basis of distinctiveness acquired through use. The applicants voluntarily disclaimed any rights to the exclusive use of the words "RENNIE MACKINTOSH".

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On 17 September 1998, Chateau Watches Ltd and George Panton & Son Ltd as joint opponents filed notice of opposition to this application. The grounds of opposition are in summary:-

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1 Under Section 3(1)(a)(b)(c)(d) Because the mark is not capable of distinguishing the applicants' goods, is devoid of any distinctive character, describes a characteristic of the goods it is to be used in connection with and is in use in the common language of the trade.

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- 2. Under Section 3(3)(a)** Because of public policy.
3. Under Section 3(3)(b) Because the mark would be likely to deceive the public if used on goods which are not the design of, or in the style of Charles Rennie Mackintosh.
4. Under Section 5(4)(a) and (b) Because the words RENNIE MACKINTOSH

were in common use prior to the date of the application.

5 The opponents ask that the application be refused and that costs be awarded in their favour.

The applicants filed a counterstatement in which they deny all of the grounds of opposition and ask that costs be awarded in their favour.

10 Only the opponents filed evidence in these proceedings and as neither party has requested a hearing, acting on the Registrar's behalf and after a careful study of the evidence filed I now give this decision.

Opponents' Evidence

15 This consists of six Statutory Declarations. The first is dated 14 May 1999, and comes from Peter Trowles, the Curator of the Charles Rennie Mackintosh Collection at the Glasgow School of Art, a position he has held since 1987.

20 Mr Trowles refers to the design of an alphabet, based in part on the hand drawn lettering used on architectural drawings by Charles Rennie Mackintosh and owned by the Glasgow School of Art. He says that the typeface was used by the School on its letterhead and advertising literature.

25 He continues saying that in the 1970's the School was asked by Letraset for permission to modify the typeface for sale to the public, and in 1997 a variation of the Letraset typeface was produced by The International Typeface Company (ITC) in conjunction with the School, the copyright of the two typefaces being vested with Letraset and ITC respectively. He says that other similar versions of the typefaces have been in existence since the 1980s and he gives his view that a typeface in the style of the Letraset and ITC typefaces cannot be considered
30 distinctive of only one trader. Mr Trowles refers to exhibit PT1 which is headed THE MACKINTOSH TYPE FACE and depicts four typefaces; ITC RENNIE MACKINTOSH LIGHT and ITC RENNIE MACKINTOSH BOLD both very similar in appearance, and two entitled ITC RENNIE MACKINTOSH ORNAMENTS, the first containing a similar typeface to the two earlier examples but also a range of designs, the second showing further examples
35 of designs. The exhibit is noted as "produced under license form the Glasgow School of Art and the typefaces shown while not identical in all respects are very close to that used in the representation of the mark applied for.

40 Mr Trowles states that he is aware that a number of traders, including the Glasgow School of Art use the name Charles Rennie Mackintosh and the style of typeface to indicate that the products is inspired by the designs of Charles Rennie Mackintosh. He concludes by giving his view that the mark is in common use and not distinctive of any particular trader.

45 The second Statutory Declaration is dated 12 May 1999 and comes from Kit Heath, a partner in Kit Heath Silver, who since 1986 have been designers of silver jewellery.

Mr Heath refers to the application which is the subject of this opposition. He says that in

1993 his company began producing jewellery inspired by Charles Rennie Mackintosh, and refers to exhibit KH1 which is an extract from a catalogue for 1993 and which depicts six designs of earring noted as being MACKINTOSH. He refers to exhibits KH2 and KH3 saying that in 1996 his company started using a font called PlazaDReg which is similar to the original script developed by the Glasgow School of Art. The exhibits consist of a details of packaging for jewellery and bears a script in a typeface similar to that of the application.

Mr Heath says that he is aware that a large number of businesses are using a similar font and also produce jewellery inspired by Charles Rennie Mackintosh designs, and consequently, he does not consider either the font nor the name to be distinctive of any one business.

The next Statutory Declaration is dated 12 May 1999 and comes from Alistair Gray, the Managing Director of Ortak Jewellery Limited, who are in the business of jewellery designers, manufactures and retailers.

Mr Gray refers to the application and to the opposition proceedings. He states that in 1982 his company started producing jewellery inspired by Charles Rennie Mackintosh designs, and refers to exhibit AG1 which consists of a sheet bearing the date 1982 and depicting designs for a spoon and jewellery endorsed as being “in style of Rennie Mackintosh”. Mr Gray gives his view that neither the words RENNIE MACKINTOSH or the font in which the mark is represented is distinctive of the applicants.

The next Statutory Declaration is dated 12 February 1999 and comes from Michael Wallis Hurst, a sole proprietor trading as Wallis Hunter, whose business is the manufacture and supply of jewellery and watches.

Mr Hurst says that he has been producing jewellery to his own designs and based on the designs of Charles Rennie Mackintosh since the 1960's. He says that his business has produced jewellery in the style of Rennie Mackintosh since 1993 and refers to exhibits MVH1 to MWH5 which consist of price lists for jewellery from that year. None specifically mention Charles Rennie Mackintosh but Mr Hurst says these are identified by the numbers 169, 178, 234 to 242 and 516 to 527, some of which are prefixed by the letters CRM as an abbreviation for Charles Rennie Mackintosh, and GS for Glasgow Style. Mr Hurst refers to exhibit MWH6 which he says is a copy of his company's catalogue, and which shows a range of jewellery endorsed as being “in the style of Charles Rennie Mackintosh”, and headed RENNIE MACKINTOSH represented in a very similar typeface to that used in the mark applied for.

Mr Hurst goes on to say that he is aware that there is a typeface based upon the design drawings of Charles Rennie Mackintosh and that his company uses a typeface based upon this which he says is commonly available to graphic designers using computers. He concludes his Declaration by giving his view on the mark applied for and the typeface used.

The next Statutory Declaration comes from Stuart Ferris Jack, the Managing Director of George Panton & Son Limited, a wholesale jewellers and one of the joint opponents in these proceedings.

Mr Jack says that Rennie Mackintosh worked in Glasgow and is particularly well known for

designing the Glasgow School of Art building which houses a Charles Rennie Mackintosh collection. He says that in the 1960's the head of graphics of the School designed an alphabet based on lettering contained on Charles Rennie Mackintosh architectural drawings, and that the typeface is now commercially available in a slightly different form through the International
5 Typeface Corporation and is widely used by different traders, including within the jewellery and giftware market. He gives his view that neither the font nor the name RENNIE MACKINTOSH are distinctive of any one business.

Mr Jack says that his company has been supplying jewellery in the style of Charles Rennie
10 Mackintosh since 1994, and refers to exhibit SFJ1 which consists of boxes marked "inspired by Charles Rennie Mackintosh" or "Inspired by C R Mackintosh" using a typeface similar to that used in the representation of the mark applied for. He concludes his Declaration by referring to exhibits SFJ2 and SFJ3 which consist of an invoice from Wallis Hunter Design (an earlier Declarant) dated 23 June 1994 for items of jewellery, some codified GS which is said to
15 denote Glasgow Style, and a page from the catalogue referred to earlier in exhibit MWH6.

The final Statutory Declaration is dated 7 May 1999 and comes from Philip Gerald Winburn, the Managing Director of, inter alia, Chateau Watches Limited (now Hannah Charles Limited, exhibit PGW1) one of the joint opponents in these proceedings. Mr Winburn states that his
20 responsibility is primarily the sourcing, purchasing and design of ranges of fashion jewellery, watches and precious jewellery.

Mr Winburn refers to the application which is the subject of these proceedings, stating that his company supplies watches, clocks, jewellery and giftware to designs inspired by Charles
25 Rennie Mackintosh, and that in common with other traders they use the name in relation to the goods. He summarises the grounds on which the opposition is based.

Mr Winburn gives details of Charles Rennie Mackintosh and recounts information given to him by Peter Trowles, the Curator of the Glasgow School of Art relating to the development of a
30 typeface based on lettering used by Charles Rennie Mackintosh on architectural drawings. Details of the typeface and similar fonts offered by other companies are given at exhibit PGW2 and PGW3. Exhibit PGW2 consists of details of an alphabet in the same style as the lettering used in the mark applied for, is shown as being related to Letraset and bears a copyright mark of 1973, and a further copy of the exhibit PT1. Exhibit PGW3 consists of a print from an
35 Internet site for a graphics company offering software to create a Charles Rennie Mackintosh font.

Mr Winburn says that since the late 1980's the designs of Charles Rennie Mackintosh have been as a used as inspiration by traders who produce goods sold by reference to the Charles
40 Rennie Mackintosh name, or the typeface. He refers to exhibit PGW4 which consists of a collection of brochures and catalogues promoting, inter alia, jewellery linked to Charles Rennie Mackintosh, some using the typeface similar to that used in the mark applied for.

Mr Winburn gives his views on the evidence of use provided by the applicants which he
45 considers did not establish RENNIE MACKINTOSH or the typeface as a trade mark distinctive of the applicants. He concludes his Declaration by commenting on the likely consequences should the application be registered.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

5 Turning first to consider the grounds under Section 3(1). That section reads as follows:

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

- 10 (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- 15 (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 rendering of services, or other characteristics of goods or services,
- 20 (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

25 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.

Section 1(1) in turn reads:

30 **1-(1)** In this Act “trade mark” means any sign capable of being represented graphically which is capable of distinguishing the goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

35 I begin by looking at how the law stands. In the *British Sugar Plc v James Robertson & Sons Ltd (TREAT)* trade mark case, (1996) RPC 9, Mr Justice Jacob said:

40 “...I begin by considering the “not a trade mark” point. Section 1(1) has two parts, *sign*, and *capable of distinguishing*. *Sign* is not an issue: a word is plainly included within the meaning of *sign* as the remainder of Section 1 indicates. But what about *capable of distinguishing*? Does this add any requirement beyond that found in section 3(1)? Section 3(1)(b) bars the registration of a mark which is *devoid of any distinctive character* unless it has *in fact acquired a distinctive character*. I cannot see that the closing words of the first sentence of section 1(1) add anything to this. If a mark on its

45 face is non-distinctive (an ordinary descriptive and laudatory words fall into this class) but is shown to have a distinctive character in fact then it must be *capable of distinguishing*. Under section 10 of the old Act, for a mark to be registerable in Part

B, it also had to be *capable of distinguishing*. But the Pickwickian position was that some marks, even though 100% distinctive in fact, were not regarded as *capable of distinguishing* within the meaning of that provision. I do not think the Directive and the 1994 Act takes a more limited meaning over.

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Thus, *capable of distinguishing* means whether the mark can in fact do the job of distinguishing. So the phrase in Section 1(1) adds nothing to section 3(1) at least in relation to any sign within sections 3(1)(b)-(d). The scheme is that if a man tenders for registration a sign of this sort without any evidence of distinctiveness then he cannot have it registered unless he can prove it has a distinctive character. That is all. There is no pre-set bar saying no matter how well it is proved that a mark has become a trade mark, it cannot be registered. That is not to say that there are some signs which cannot in practice be registered. But the reason is simply that the applicant will be unable to prove the mark has become a trade mark in practice - "Soap" for "Soap" is an example. The bar (no pun intended) will be factual not legal.

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and

"Next is "Treat" within Section 3(1)(b). What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned ("North Pole" for bananas) can clearly do. But a common laudatory word such as "Treat" is, absent from use and recognition as a trade mark, in itself (I hesitate to borrow the word *inherently* from the old Act but the idea is much the same) devoid of any distinctive character."

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I also have regard to the comments of Aldous LJ in the Phillips Electronics NV v Remington Consumer Products Limited case (1999) RPC 23 in which he stated:

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"The more the trade mark describes the goods, whether it consists of a word or shape, the less likely it will be capable of distinguishing."

The decisions above indicate that the correct approach is to start with the premise that a trade mark is capable of distinguishing insofar as it is not incapable. A trade mark which is found to have sufficient inherent distinctive character to be able to distinguish must be capable of distinguishing. A trade mark which does not have any inherent distinctive character may nonetheless acquire distinctiveness through the use made of it, and in doing so it must by inference be capable of distinguishing. In this particular case there is no evidence of anything inherent in the mark which leads me to believe that it is incapable of ever being regarded as a trade mark, and to that extent I dismiss the ground founded under Section 3(1)(a).

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In looking at the grounds founded under Section 3(1)(b)(c) & (d) there are two aspects of this particular mark which need to be considered, namely, are the words RENNIE MACKINTOSH able to distinguish the applicants goods, and if not, is the stylisation of the typeface in which they are represented of a distinctive character and able to carry the mark.

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The evidence establishes that the words RENNIE MACKINTOSH are descriptive of goods made in the style of the designs of CHARLES RENNIE MACKINTOSH and that prior to the application being filed a number of traders were using these words to describe such goods. Consequently I cannot therefore see how the words RENNIE MACKINTOSH can be distinctive of any particular trader. I have no difficulty in finding the words RENNIE MACKINTOSH to be devoid of any distinctive character in relation to the goods for which registration is sought and am fortified in this view by the fact the applicants volunteered to disclaim any rights in the words RENNIE MACKINTOSH. Further, I do not consider the additional words in the trade mark THE RENNIE MACKINTOSH COLLECTION add anything to make the mark as a whole any more distinctive.

Turning to the question of the stylisation of the lettering in which the mark is represented. The opponents state that this is a recognised typeface based on the hand drawn lettering used on architectural drawings by Charles Rennie Mackintosh, and that it is commonly used by traders in relation to goods based on his designs. There are a number of exhibits such as KH2, KH3, SFJ1, PGW4 and PT1 that show this to be the case and although these are in the main undated or dated after the relevant date, the number of instances lead me to the view that there is a reasonable likelihood that the typeface is in common use. More convincing evidence can be found in exhibit PGW2 to the Declaration by Philip Gerald Winburn which records that in 1973 the copyright to a very similar typeface was vested in Letraset. All in all I find the evidence sufficient to establish that the style of typeface used in the representation of the mark is not exclusive to the applicants.

It appears that the typeface in which the trade mark is represented further associates the mark as whole with the noted designer and designates the goods sold under it accordingly. I find therefore the opposition to be successful under Section 3(1)(b) and (c), but I cannot unequivocally say that the evidence establishes that the mark consists exclusively of signs or indications which at the relevant date had become customary in the trade, and consequently I dismiss the ground under Section 3(1)(d).

Turning to the grounds founded under Section 3(3). That section reads as follows:

(3) A trade mark shall not be registered if it is-

(a) contrary to public policy or to accepted principles of morality, or

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

The objection is that use of the mark on goods that are not associated, inspired by or based on the designs of Charles Rennie Mackintosh would be against public policy or deceive the public. While there appears to be a style associated with Rennie Mackintosh there is no prescribed design. Each trader manufactures to designs based on their own perception of the work of Charles Rennie Mackintosh or the inspiration that they derive, and in that respect the consumer is unlikely to have a fixed idea of what to expect. Also the selection and purchase of jewellery and watches is in my experience unlikely to take place without the consumer seeing the goods beforehand which significantly reduces the likelihood of deception. I therefore

dismiss the ground founded under Section 3(3)(a) and (b).

The remaining ground is founded on Section 5(4)(a) and (b). That section reads as follows:

5 **5.(4)** A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

10 **(a)** by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

15 **(b)** by virtue of an earlier right other than those referred to in subsection (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

20 A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

25 Subsection (a) of Section 5(4) implements Article 4(4)(b) of the Directive which provides that a trade mark shall not be registered if it conflicts with an earlier non-registered trade mark or other sign used in the course of trade which confers on its proprietor the right to prohibit use of a later trade mark. Subsection (b) implements Article 4(4)(c) of the Directive which allows for registration to be refused where the use of the mark applied for could be prevented by virtue of any other right, in particular under copyright or design law. Both subsections are based on what is generally referred to as relative grounds for refusal.

30 The opponents’ objection under this section is based upon the claim that the mark applied for was in common use prior to the date of application and not that they, or anyone else possesses any rights, in an earlier trade mark, sign or otherwise. This is an objection based on absolute grounds which properly falls to be dealt with under Section 3 and which I have dealt with earlier. Consequently this ground of opposition must fail.

35 The opposition having been successful I order the applicant to pay the opponents the sum of £435 as a contribution towards their costs. This sum is to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27 day of April 2000

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45 **Mike Foley**
 for the Registrar
 The Comptroller General