

**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 48997 IN THE NAME OF  
HISTORIC ORIGINALS LIMITED**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF application No 2042882B in the name of  
CARRICK JEWELLERY LIMITED**

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**and**

**IN THE MATTER OF opposition thereto under No 48997  
in the name of HISTORIC ORIGINALS LIMITED**

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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  
RENNIE MACKINTOSH  
COLLECTION

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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.

**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 14 September 1998, Historic Originals Limited filed notice of opposition to this application. The grounds of opposition are in summary:-

**1 Under Section 1(1) and Section 3(1)(a)(b)(c)(d)**

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Because the mark consists of the stylised words "THE RENNIE MACKINTOSH COLLECTION" and is incapable of distinguishing the goods of one manufacturer, inspired by the designs of Charles Rennie Mackintosh from those of another, is represented in a typeface commonly associated with the works of Charles Rennie

Mackintosh.

## 2. Under Section 3(3)(b)

5 Because the mark would be likely to deceive the public as to the nature and quality of the goods if the designs are not inspired by or based on the designs of Charles Rennie Mackintosh.

10 The opponents ask that the application be refused in the exercise of the Registrar's discretion and that costs be awarded in their favour.

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

15 Only the opponents filed evidence in these proceedings. The matter came to be heard on 22 March 2000, when the opponents were represented by Mr Michael Brown of Alpha and Omega, their trade mark attorneys, the applicants were not represented.

### Opponents' Evidence

20 This consists of two Statutory Declarations. The first is 17 May 1999, and comes from Sanford Simpson, the Managing Director of Historic Originals Limited, the opponents in these proceedings.

25 Mr Simpson says that the mark applied for is the words THE RENNIE MACKINTOSH COLLECTION represented in a typeface known as Willow or Willow Let, and he goes on to refer to the goods covered by the application.

30 He says that his company manufactures and sells a range of jewellery, some of which have been inspired by the designs of Charles Rennie Mackintosh, and refers to exhibit SS1 which consists of a copy of his company's 1998 catalogue which he notes uses the same Willow let typeface. Mr Simpson refers to a report of a ex-parte hearing held in connection with the application (exhibit SS2), and in particular to the weight given by the Hearing Officer to the typeface, which he agreed would carry the mark if it could be shown to be exclusively  
35 associated with the applicants. He refers to exhibit SS3 which consists of a letter dated 13 July 1998 from the International Typeface Corporation to the opponents confirming that the Willow typeface was introduced in 1990 although does not say that the mark applied for is in the WILLOW typeface or that it is associated with Charles Rennie Mackintosh.

40 Mr Simpson next refers to exhibit SS4 which consists of the cover of a publication entitled "Charles Rennie Mackintosh, Textile Designs" represented in a similar typeface to that used in the representation of the mark applied for, and a page showing the book to be the subject of copyright from 1993. He says that he is aware of other companies that produce jewellery inspired by the designs of Charles Rennie Mackintosh, and refers to exhibit SS5 which consists  
45 of a letter from Ortak Jewellery Limited to Mr Simpson confirming that the company has produced jewellery based on Charles Rennie Mackintosh designs since 1984. Mr Simpson ends his Declaration concluding that the words THE RENNIE MACKINTOSH

COLLECTION in the Willow typeface designates the kind of goods, as opposed to being distinctive of any particular manufacturer.

5 The second Statutory Declaration is dated 17 May 1999 and comes from Michael Stanley Brown, a Chartered Patent Agent and Registered Trade Mark Attorney. Mr Brown confirms that he is the agent acting for the opponents in these proceedings and goes on to give an outline of his patent and trade mark experience.

10 Mr Brown refers to exhibit MSB1 which consists of a copy of the report of a hearing (also shown as exhibit SS2) and refers to the statement that the Hearing Officer had checked the encyclopaedia of typefaces and had found nothing similar to the stylisation of the applicants' trade mark. He next refers to exhibit MSB2 which consists of the letter to the applicants confirming the acceptance of the application, and notes the statement attributed to the Hearing Officer from which he draws the conclusion that the trade mark the subject of the application  
15 would not have been accepted had the Hearing Officer known that the typeface was associated with Charles Rennie Mackintosh. Mr Brown refers to the wording of Section 3(1)(c), giving his view that the trade mark RENNIE MACKINTOSH in a typeface associated with Charles Rennie Mackintosh is totally descriptive of goods in the style of Charles Rennie Mackintosh and should not be registered.

20 Mr Brown refers to the wording of Section 3(1)(c), giving his view that the trade mark THE RENNIE MACKINTOSH COLLECTION is totally descriptive of a collection of goods made in the style of Charles Rennie Mackintosh and should not be registered.

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

### **Decision**

30 Turning first to consider the grounds under Section 3(1) and Section 1(1). These sections read as follows:

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

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- (a) signs which do not satisfy the requirements of section 1(1),
  - (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  
40 purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of goods or services,
  - (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and  
45 established practices of the trade:

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:

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**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.

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

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:

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“...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 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

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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.”

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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 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 being regarded as a trade mark and to that extent I dismiss the grounds founded under Section 1(1) and Section 3(1)(a).

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Setting aside the basis on which the mark came to be accepted, in considering whether the application meets the requirements of Section 3(1)(b)(c) and (d) there are two aspects relating to this particular mark which need to be considered, namely, do the words RENNIE MACKINTOSH have sufficient distinctiveness to be 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 in these proceedings is less than conclusive and I am hindered by the complete lack of any from the applicants. What the evidence does show is that RENNIE MACKINTOSH is part of, and would be readily associated with the name, CHARLES RENNIE MACKINTOSH who is referred to in exhibit SS1 as “one of the key figures in turn-of-the-century British art and architecture”, and that the applicants are but one of a number of traders in jewellery items based on or inspired by the designs of CHARLES RENNIE MACKINTOSH and who use the name, in whole or in part, to highlight this association. I have therefore no difficulty in finding that the words RENNIE MACKINTOSH to be devoid of any distinctive character when used in relation to the goods for which registration is sought, and am fortified in this view by the actions of the applicants who of their own volition disclaimed 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.

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This leaves the question of the stylised typeface which it is clear from exhibit SS2 was claimed as being exclusively associated with the applicants. The opponents in turn state that it is not exclusive to the applicants but is in fact a recognised typeface known as WILLOW which was introduced in 1990, although the evidence does not establish this to be the case. Exhibit SS4 dates from 1993 and shows use of a typeface which although not identical in every respect, bears a remarkable similarity. The natural question is why did the publisher use this particular

5 style of font. The exhibit is a book recording the textile designs of CHARLES RENNIE  
MACKINTOSH and from the facts before me I consider it reasonable to infer that the  
typeface was used because it is synonymous with CHARLES RENNIE MACKINTOSH and  
his designs. Although the evidence is not absolutely conclusive, I find it sufficient to show  
that there is a reasonable likelihood that the style of typeface used in the representation of the  
mark is not exclusive to the applicants. But I cannot go so far as to say that it establishes that  
its use is customary in the trade. It therefore appears to me that the typeface in which the  
trade mark is represented is one which further associates the whole with the noted designer  
and designates the goods sold under it accordingly.

10 For the reasons given above I find the opposition to be successful under Section 3(1)(b) and  
(c), but dismiss the ground under Section 3(1)(d).

15 Turning to the ground founded under Section 3(3)(b). 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

20 (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).

25 The objection is that use of the mark on goods that are not inspired by or based on the designs  
of Charles Rennie Mackintosh would 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 from it 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  
30 significantly reduces the likelihood of deception. I therefore dismiss the ground founded under  
Section 3(3)(b).

35 Finally, the Registrar has no discretion to refuse an application which meets the requirements  
for registration set out in the Act, and consequently, this final ground cannot succeed.

40 The opposition having been successful I order the applicant to pay the opponents the sum of  
£635 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**

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