

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER 10921  
BY VFM CHILDREN'S ENTERTAINMENT LIMITED  
FOR A DECLARATION OF INVALIDITY AND REVOCATION  
IN RESPECT OF TRADE MARK NUMBER 1521388  
IN THE NAME OF TABAK MARKETING LIMITED**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application Number 10921  
by VFM Children's Entertainment Limited  
for a Declaration of Invalidity and Revocation  
in respect of Trade Mark Number 1521388  
in the name of Tabak Marketing Limited**

### **BACKGROUND**

1. Trade Mark number 1521388 is for the mark CDCARD and is registered in Class 16 for the following specification of goods:-

"Greetings cards incorporating compact discs."

The mark was advertised as "Proceeding because of distinctiveness acquired through use and trade evidence" and stands registered from the filing date of 31 October 1994.

2. On 18 June 1999 VFM Children's Entertainment Limited applied for the invalidation and/or rectification of the trade mark registration. In summary, the grounds of invalidation and rectification were as follows:-

- (i) The registration is invalid under Section 47(1) of the Act because -
  - a) it was registered in breach of Section 3(1)(b) and is devoid of any distinctive character;
  - b) it was registered in breach of Section 3(1)(c) as it consists exclusively of signs or indications which may serve, in trade, to designate the kind, intended purpose or other characteristic of the goods;
  - c) it was registered in breach of Section 3(1)(d) as it consists exclusively of signs or indications which are customary in the current language or in the bona fide and established practices of the trade;
  - d) It was registered in breach of Section 3(3)(a), being contrary to public policy by virtue of preventing other traders from using a generic and particularly apt term for describing the goods;
  - e) It was registered in breach of Section 3(3)(b) as the mark is of such a nature as to deceive the public into believing that the registrant is the only supplier of the goods for which the mark is registered;
  - f) It was registered in breach of Section 3(6) as the evidence filed in support of the application was both misleading and made in bad faith.

(ii) The registration should be revoked under Section 46(1)(c) because, as a consequence of acts or inactivity of the proprietor the trade mark has become the common name in the trade for the products for which the trade mark is registered.

(iii) The registration should be revoked under Section 46(1)(d) as use of the trade mark by the proprietor in relation to the goods for which it is registered is liable to mislead the public into believing that the registrant is the only supplier of the goods in question.

(iv) The applicant further requests the Registrar to remove the trade mark from the register in exercise of her discretion.

3. The registered proprietor filed a Counterstatement denying the grounds of invalidity and revocation. Both sides filed evidence and have asked for an award of costs in their favour. The matter came to be heard on 27 February 2002 when the applicant was represented by Mr Ward of Counsel instructed by Sanderson & Co and the registered proprietor was represented by Mr Bernard of fj Cleveland.

### **Applicant's Evidence**

4. This consists of a statutory declaration by Michael Robin Markwell dated 14 January 2000. Mr Markwell is the Managing Director of VFM Children's Entertainment Limited (the applicants for invalidation).

5. Mr Markwell states that his company is well known in the industry for selling and supplying "CD cards" and he exhibits at "MRM1" to his declaration a copy of his company's order form illustrating he says, generic use of the words "CD cards". This order form is undated. He adds that approximately 5 - 6% of his company's customers use their own order forms and at Exhibit "MRM2" to his declaration are copies of purchase orders, dating from February 1998 to August 1999, from various customers all of which contain the words "CD cards" to describe the goods they wish to purchase.

6. Mr Markwell goes on to state that the generic expression "CD card" is also used for the purposes of describing compact disc cards in ordinary correspondence and contractual agreements and he refers to Exhibit "MRM3" to his declaration which is a copy of a letter dated 7 June 1999 from JS Marketing consisting of an agreement with his company which describes goods subject to the agreement as "CD cards". He goes on to Exhibit "MRM4", a copy of a letter dated 14 October 1998 from a buyer for Birthdays Ltd, a large retailer in greetings cards which refers to compact disc cards as "CD cards".

7. Mr Markwell states that the term "CD cards" is also commonly used to describe compact disc cards at the point of sale in retail outlets and he draws attention to Exhibit "MRM5" a copy of an undated point of sale display by the Post Office which states "CD Cards £1.99". He states that this was in use Xmas 1998 and is for the applicants goods. Mr Markwell adds that his company uses other similar displays and at Exhibit "MRM6" consists of a copy of an undated promotional leaflet illustrating his company's display stands with the advertisement "CD cards only £1.99".

8. Mr Markwell explains that the main reason why the term "CD card" is commonly used in the trade with respect to "CD cards" is because it is a particularly apt term and provides an immediate simply and accurate message explaining to the public what goods are for sale. He adds that "CD cards" are purchased on impulse and are rarely listed on a potential purchaser's shopping list. Therefore, he says, it is important for traders to be in a position to advertise their goods with the use of a simple, short message and without any lengthy descriptive expression and it is essential for the message and without any lengthy descriptive expressions and it is essential for the message to be large and instantly legible as there is often not sufficient space to include lengthier terms such as "compact disc greeting cards" or "CD with cards". Furthermore, the expression "CD card" can include a greetings card, a Get Well card, a Christmas card, a Birthday card, or any other kind of card and therefore, the expression "CD card" is the only convenient simple and short method of selling a variety of different types of cards under the same advertising display. In this respect Mr Markwell notes that it is common to sell different types of cards such as Christmas, Birthday, Get Well and other such cards on the same shelf and in the case of his company's CD cards the display usually includes a variety of different types of cards consisting of a mixture of Birthday, Christmas, and other such "CD cards".

9. Next, Mr Markwell refers to the statutory declaration of 11 September 1998 filed by Terry Windsor, the Managing Director of Tabak Marketing Ltd (the registered proprietors) which was filed in support of the mark in suit prior to its registration and he asserts that Mr Winsor knew that other companies were using the term "CD cards" prior to 11 September 1998. Mr Markwell goes on to state that Mr Winsor's declaration of 6 September 1995, made in support of registration, which consisted of copies of advertising and promotional features in a number of publications where the term "CD cards" is used generically. Mr Markwell at Exhibit "MRM7" to his declaration draws attention to a copy of page 17 of "International Spring Fair Daily Review" (undated) in which an article refers to Tabak Marketing Limited's goods with the sentence "the CD cards (which retail at £4.99) come complete with instructions how to fold the card around the CD". Mr Markwell then refers to his Exhibit "MRM8" comprising a copy of an extract from "For the Record ..... For the Retailer" dated November/December 1994 which features an article referring to Tabak Marketing Limited which states that "by the end of this year there will be more than 500 different styles of CD cards available". Mr Markwell notes that there is a space between the letters "CD" and the word "card" and that the word "card" is in lower case.

10. Mr Markwell goes on to draw attention to other uses of "CD card" which he states are examples of generic use. At Exhibit "MRM9" to his declaration is an extract from "Incentive 95 Preview" taken from "Incentive Today", May 1995, which contains news that "the CDCard Company is tuning up with two new ranges of CDCards. Next, at Exhibit "MRM10", Mr Markwell refers to an unspecified publication which refers to Terry Winsor "undertaking card customisation for such companies as IBM, which find a CD card with an appropriate message to be the ideal corporate gift."

### **Registered Proprietor's Evidence**

11. This consists of five statutory declarations, one each from Terry Winsor, Alan Peter Bernard, Ivan Rodrigues, Warren Lomax and Liz Karn.

12. Mr Winsor is the Managing Director of Tabak Marketing Limited, the registered proprietors. He states that his company coined the name CDCARD and began using it in 1992. He claims that it quickly became associated with his company and functions as an effective trade mark.

13. Mr Winsor states that in September 1998 it came to his attention that VFM Children's Entertainment Limited (the applicant) had begun using the mark CDCARD and he adds that, as this was an extremely well known mark of his company at the time, he immediately contacted his trade mark agents who advised him that this was trade mark infringement but that he would have to wait until his registration was granted before he could institute proceedings.

14. Mr Winsor goes on to refer to the application for the mark in suit and incorporates those sworn declarations made during the prosecution of the application into his current declaration as Exhibits "W1" and "W2". This includes a copy of a letter dated 13 August 1998 from Jane Hargreaves, the Buying and Marketing Manager of Athena, which states that "We are still purchasing CD Greetings Cards from the CDCARD Company and have never seen any other company using the word CDCARD to describe their products, as this would be misleading to our stores and to our customers." Also, at Exhibit "W3" is a copy of the Statutory Declaration made by Michael Godfrey of the Giftware Association, a Trade body for those involved in the business of producing and distributing giftware with over 1100 member companies over 30% of which are involved in personal and gift stationery, which was submitted in support of the application. He adds that these declarations were made to address the question of distinctiveness at the application date and asserts that the mark has become more famous since then.

15. Mr Winsor states that sales of products under the CDCARD mark have continued to increase since registration of the mark. He provides the following sales figures by way of confirmation:-

<b>Year ending 31 March</b>	<b>Retail Price Turnover in products sold in UK under CDCARD</b>	<b>No. of products sold</b>
1995	1,096,552	219,750
1996	860,000	172,000
1997	1,199,000	239,800
1998	1,032,500	206,500
1999	1,330,125	266,050
2000	1,893,750	378,750

16. Mr Winsor adds that his company has continued to advertise and promote the mark Annual expenditure on promotion has been:

1995	£32,000
1996	£26,000
1997	£56,000
1998	£38,000
1999	£29,000
2000	£40,000

17. He explains that this has included regular stands at exhibitions, particularly the Spring and Autumn International Gift Fairs at the NEC in Birmingham, advertisements in various magazines including Progressive Greetings Magazine, Giftware News and others. He refers to Exhibit W4 to his declaration which is a copy of an advertisement which has appeared monthly in Progressive Greetings Magazine for the last 6 years.

18. Next, Mr Winsor states that there are several assertions made by Mr Markwell in his Declaration that he would like to respond to, even though, he says, they are not substantiated. In answer to Mr Markwell's claims that Tabak Marketing Limited uses CDCARD in a generic sense Mr Winsor states that this is not true as it is a brand name. He adds that it is quite different when a brand owner uses its mark to represent its products, compared to others doing it and that brand owners can refer to "a Mars bar", "2 Shredded Wheats" and "a bottle of Coke". He states that this is just shorthand and all good trademarks are used like this and it does not make them generic terms unless the rest of the industry does it. Referring to alleged examples of generic use given by Mr Maxwell, Mr Winsor says that these uses are either by VFM or by their customers in direct response to their price lists etc. He adds that it does not amount to independent use. Mr Winsor then refers to Exhibit "W5" to his declaration which contains copies of other companies promotion and packaging ie. Marks & Spencer, Andrew Brownsword, Lifetime and the Musical Card Company. He states that none uses "CD Card". Lifetime describe the products as COMPACT DISC GREETINGS CARDS, Marks & Spencer as a ROMANTIC COMPACT DISC BLANK CARD and The Musical Card Company as a COMPACT DISC GREETINGS CARD.

19. The registered proprietor's next declarant is Alan Peter Bernard, a partner in the firm fj Cleveland, the agents for the registered proprietor.

20. Mr Bernard refers to Exhibit "APB2" to his declaration which is a copy of a page from the OHIM Bulletin No. 46/2000 published on 13 June 2000 showing the advertisement of CTM application No. 1030113 for the mark cd card made by a Greek applicant. He states that Tabak Marketing Limited will oppose this CTM application on the basis of their existing registrations of CDCARD in the UK and also in Benelux, Germany, Italy, Portugal and Spain. He adds that the CTMO examine marks for inherent registrability and have accepted the application for cd card.

21. Mr Rodrigues' declaration is dated 2 May 2000. He is the associate publisher of Greetings Today, previously Greetings, which he explains is one of the leading publications relating to the greeting card and gift trade industry. He adds that Greetings Today has been issuing monthly journals covering advertising and editorial for the greeting card industry and the gift trade for the last twenty years.

22. Mr Rodrigues states that his company has dealt with the CDCARD company since 1993 when the concept of greeting cards containing compact discs and the trade mark CDCARD were created by them. He adds that, with full knowledge of this industry, he has never seen the word CDCARD being used by other companies which issued their own range of compact disc greeting cards until recently. Mr Rodrigues concludes that if another company uses the word CDCARD it will confuse and mislead the public and the industry because people associate that name with the CDCARD Company only and it is a registered trade mark.

23. Mr Lomax's declaration is dated 3 May 2000. He is co-owner and Director of Progressive Greetings (Max Publishing). Mr Lomax explains that Progressive Greetings was formed ten years earlier in the UK, and is now the number one journal used by the greeting card industry and is international, covering 42 countries.

24. Mr Lomax states that the CDCARD Company has dealt with Progressive Greetings since 1993 using their created trade mark CDCARD and that every month from 1993 they have advertised in the section called Product Directory a copy of which is attached to Mr Lomax's declaration, and have taken many full page colour advertisements and editorials. He adds that since 1994, other companies have published greeting cards containing compact discs but have not to his knowledge attempted to use the name CDCARD, apart from one company recently. Mr Lomax concludes by stating that the word CDCARD is from the CDCARD Company and is a trade mark registered by them.

25. The registered proprietor's final statutory declaration is from Liz Karn, Chairperson of the British Promotional Merchandise Association (BPMA). She explains that the BPMA is the leading trade body representing the suppliers of promotional merchandise and has operated for 35 years. She adds that the current registered membership comprises over 800 companies.

26. Ms Karn states that the CDCARD company has been a member since 1994 and that, to the best of her knowledge and belief, it created greetings cards containing compact discs in 1993. She goes on to state that, as Chairman of BPMA, and previously as a committee member, she cannot recall ever seeing the word CDCARD being used by any other company.

27. This completes my summary of the evidence filed in this case. I now turn to the decision.

## **DECISION**

28. At the hearing Mr Ward made it clear that the only grounds being pursued by the applicant were those of Section 47(1) grounds based upon Section 3(1) and Section 3(6) of the Act and the Section 46(1)(c) ground.

29. Firstly, the Section 3(1) ground. The relevant parts of Section 3(1) of the Act are as follows:-

"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) 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:

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."

30. At the hearing Mr Bernard on behalf of the registered proprietor made no admissions in relation to the acceptability of the mark in suit in the prima facie. Accordingly, I must consider whether, on a prima facie, basis, the mark in suit meets the requirements of Section 3(1)(b)(c) and (d) of the Act.

31. It was common ground at the hearing that the prima facie case should be considered in the light of the 20 September 2001 judgement of the European Court of Justice in Proctor & Gamble Company v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case - 383/99P for the mark Baby Dry. This judgement gives very useful guidance on the test for descriptiveness under Section 3(1)(c) of the Act.

32. I give below paragraphs 37, 39 and 40 of the judgement in full:

"37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Procter & Gamble and the OHIM acknowledge, to prevent registration as trade marks signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function."

"39. The signs and indications referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may service in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a

mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way or designating the goods or services concerned or their essential characteristics."

"40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services of their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark."

33. These paragraphs indicate that only marks which are no different from the usual way of designating the relevant goods or services or their characteristics are now debarred from registration by Section 3(1)(c).

34. At the hearing it was admitted, (as shown by the evidence), that the goods covered by the mark in suit are described in a generic sense as "Compact disc greeting cards" or as "CD greeting cards".

35. The mark in suit is CDCARD and comprises the highly descriptive acronym CD (a normal and popular alternative to the words "compact disc") and the obvious dictionary word CARD, conjoined. It is plain to see that the separate elements, CD and CARD, describe the goods sold under the mark ie. greetings cards (often described generally as cards) and CD's. However, as made clear by the BABY DRY decision, "descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form".

36. In considering the prima facie case I bear in mind my own knowledge and experience which tells me that the descriptive words "Greeting Cards" and "Cards" are often easily interchangeable. For example, a customer may visit a "Card Shop" or "Greeting Cards Shop", purchase a "Card" for a friend or relatives birthday or a "Greetings Card" for a friend or relatives birthday, or ask for "Cards" with badges or which play tunes or "Greeting Cards" with badges or which play tunes. In the prima facie I see no reason why customers should not refer descriptively in normal use to CD CARDS as an alternative to CD GREETING CARDS e.g. "Will you pick me up a CD CARD for Jim's birthday please" or "Do you stock CD CARDS please?" Such use would describe the goods directly in a trading context.

37. In my considerations of the prima facie case I do not lose sight of the fact that the mark in suit consists of two conjoined elements ie. the acronym CD and the word CARD joined together. However, I do not believe this has any impact upon the position in the current case as the totality does not possess a separate meaning from the obvious combination and it would not be seen or heard as an invented word or as having an identity distinct from its component parts. In my view the mark is an obvious descriptor for CD's and greeting cards/cards sold together as a package.

38. In his submissions Mr Bernard reminded me that the mark "Cd card" in Class 16 had been accepted by the Office for the Harmonisation of the Internal Market on a prima facie basis. However, such acceptance is not binding upon this tribunal and I am unaware of the background and circumstances to that acceptance. I must consider the case in suit on its own merits in light of the information before me and on the basis of my own knowledge and experience.

39. To conclude on the prima facie case, I take the view that the mark at issue comprises two obvious and highly descriptive elements conjoined and that in its totality, the mark may serve in normal usage from a customer's point of view to designate the kind of goods concerned in a natural way. The mark does not meet the requirements of Section 3(1)(c) of the Act and thus also fails under Section 3(1)(b).

40. The registered proprietor has filed evidence of use and trade evidence in support of the registration, which relate to periods before and after registration. This goes to the proviso to Section 3(1). In accordance with this proviso, if it can be shown that the mark has in fact acquired a distinctive character as a result of the use made of it, it can be registered.

41. Both parties accepted that the appropriate test is that laid down by The European Court of Justice in conjoined cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Windsurfing Chiemsee v Attenberger (1999 ETMR 585). The relevant parts of the court's decision are reproduced below:

*"49. In determining whether a mark has acquired distinctive character following the use made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings.*

*50. In that connection, regard must be had in particular to the specific nature of the geographical name in question. Indeed, where a geographical name is very well known, it can acquire distinctive character under Article 3(3) of the Directive only if there has been long-standing and intensive use of the mark by the undertaking applying for registration. A fortiori, where a name is already familiar as an indication of geographical origin in relation to a certain category of goods, an undertaking applying for registration of the name in respect of goods in that category must show that the use of the mark - both long-standing and intensive - is particularly well established.*

*51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.*

*52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages."*

42. Although that case concerned an application for a geographical name, the principles set down apply to distinctive character in general.

43. I turn firstly to the evidence of use filed by the registered proprietor. At the hearing Mr Ward conceded that the registered proprietor had devised the idea of selling greetings cards incorporating compact discs, had thus coined the name CD CARDS and had a very large market share in the goods. However, Mr Ward went on to make a number of criticisms of this evidence, in particular that the registered proprietors market share reflected the fact that they were first in the market; that while they may have coined the mark CD CARDS, the mark merely described a new product and that the registered proprietor's use and sales reflected a near de facto monopoly in the product. Mr Ward also submitted that actual use of the mark by the registered proprietor e.g. on packaging was in the vast majority of cases in combination with other trade mark material e.g. a stylised compact disc device, and the evidence intended to demonstrate the repute of the mark e.g. in press cuttings, showed generic rather than trade mark use. In essence, most of Mr Ward's criticisms go to the nature of the mark in suit in that it is the applicant's case that the mark CDCARD is so descriptive that it amounts to or virtually amounts to a generic term for the relevant goods. In such circumstances high levels of user or a large market share in the goods will not assist a registered proprietor.

44. In response, Mr Bernard was able to point to a number of instances of the registered proprietors use of CDCARD solus with the letters TM or R adjacent to the mark. He also submitted that the vast majority of third party comment e.g. press articles, was in a trade mark context and any instances of use in a generic sense in (press articles or features), was without the consent of the registered proprietor and was outside the registered proprietor's control.

45. Having examined the evidence of use submitted by the registered proprietor and after considering the submissions I have reached the view that the registered proprietor has used the mark in suit, albeit often with other trade mark material, and possesses a significant share of the market in the goods. However, this is by no means conclusive. It is well established that use does not necessarily equate with distinctiveness. As Morrit L J put it in Bach Flower Remedies Ltd v Healing Herbs Ltd (2000 RPC 513) -

"..... use of a mark does not prove that a mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have materiality".

46. I now go on to consider the trade evidence filed in support of the application which is summarised earlier. This may be conveniently listed under three categories, namely statutory declarations from those in trade associations (Mr Godfrey and Ms Karn), the trade press (Mr

Rodrigues and Mr Lomax) and the trade itself (Ms Hargreaves).

47. Mr Ward criticized this evidence, principally on the basis that the declarants could not speak on behalf of the public and comment upon public perceptions of the mark. Furthermore, he suggested that Mr Rodrigues and Mr Lomax were not independent as they accept advertising from the registered proprietor. I do not believe this particular criticism of Mr Rodrigues' and Mr Lomax's evidence to be well founded and they are both entitled to draw upon the experience they have gathered in their official capacities in putting forward views and opinions.

48. The evidence from independent sources is intended to invite a finding that the mark identifies the goods of one undertaking to the relevant trade and the customers for the goods. The declarants make it clear that they associate the mark CDCARD with the registered proprietor. However, I fail to see how they can extrapolate their experience onto the general public so as to reach a conclusion as to the approach of the general public to the mark. All of the declarants have experience of the applicant who as stated earlier in this decision, were the first to market the goods in question and coined and protected the mark in suit.

49. The sort of association that arises from a monopoly situation does not necessarily mean that a mark has acquired the necessary distinctive character. In passing off cases, such as Cellular Clothing 16 RPC 309, it has been said (per Lord Davey) that:-

"To succeed in such a case (the claimant) must demonstrate more than simply the sole use of the descriptive term. He must demonstrate that it has become so closely associated with his goods as to acquire the secondary meaning not simply of goods of that description but specifically of goods of which he and he alone is the source."

50. It seems to me that the words I have emphasized from the guidance of the ECJ in the Windsurfing Chiemsee cases (paragraph 40 of this decision refers), have the same effect of demanding more than the sort of association than arises simply from monopoly use of a description. The trade evidence in the present case makes it clear that the terms "CD greetings cards" (Mr Hargreaves) and "compact disc greeting cards" (Mr Rodrigues) are normal and apt descriptor for the relevant goods. It does not throw any light on why CDCARD which seems an obvious contraction for compact disc greeting cards, is not a normal and apt descriptor for the goods, except that the declarants state that others do not use the term. This may simply reflect the fact that the registered proprietor coined the term, protected and registered it and thus ensured a de facto and legal monopoly. I do not therefore accept that the mark has acquired the necessary distinctive character.

51. I do not consider that the trade witnesses who have given evidence can speak for the general public. The customer for the relevant goods is the general public at large and would not generally be a sophisticated or specialist consumer given the nature of the product. In my view, there is no directly relevant evidence on how the public would perceive the mark and the evidence filed does not demonstrate that the mark has acquired a distinctive character.

52. In the present case I am reminded of the position in *Mc Cain International Limited v Country Fair Foods Limited* and *Another* 1981 RPC 69, where the plaintiffs coined the

concept and name "oven chips" which was an apt description for chips which could be cooked in the oven, although the consumer could not have become aware of what the expression meant until the product came on the market. Once on the market the name "oven chips" would inform the consumer of the nature of the product. In that case it was held that where a person introduces a new product to the market, gives it a name descriptive of the product and has a monopoly, whether legal or de facto, in that product he cannot claim a monopoly in that name. While this case was not decided under the 1994 Act, it seems to me that the principles set out are consistent with the tests set out by the ECJ in that a mark can only acquire distinctive character following use made of it, if it distinguishes a product from the like goods of other undertakings.

53. At the hearing, Mr Bernard was critical of the applicant's evidence as, in his view, it did not demonstrate use of the mark in suit by third parties. In his submission the applicant's claim to generic use of "cd card" amounted to infringement. He went on to submit that the applicant had supplied no supporting evidence from third parties e.g. the trade or public, in relation to the alleged descriptive nature of the mark in suit and that most of their submissions amounted to mere criticism or 'nit-picking' of the evidence filed in support of the registration by the registered proprietor.

54. There is some force in Mr Bernard's criticisms, and Section 72 of the Act places the onus on the applicant to show that registration is invalid. However, an application for revocation and/or invalidation before the Registrar's tribunal may include a re-hearing by the tribunal on the basis of which the application for registration was accepted by the Registrar, in addition to the consideration of new evidence. An applicant is entitled to make submissions in this regard and the tribunal may re-evaluate the circumstances of the mark's acceptance and registration. See *Treat* 1996 RPC 281.

55. On the basis of all the evidence submitted in this application for invalidity and revocation and after taking into account the submissions of both parties, I have come to the conclusion that, for the reasons given, the mark in suit fails to qualify under Section 3(1)(b) and (c) of the Act and the evidence filed does not show that the mark has acquired a distinctive character sufficient to satisfy the proviso of Section 3(1) of the Act. In my view the mark in suit had not acquired a distinctive character before the date of registration and has not acquired a distinctive character since registration. Accordingly, my findings apply to the position as at 31 October 1994 and subsequent to that date.

56. As the application for revocation is successful under Section 47(1) of the Act by virtue of Section 3(1)(b) and (c) of the Act I have no need to go on and consider the other grounds raised.

57. In accordance with Section 47(6) of the Act, the registration will be declared invalid and deemed never to have been made.

58. The applicants are entitled to a contribution towards their costs. I order the registered proprietors to pay them the sum of £300 being the filing fee in respect of this action, as the evidence filed in this case is duplicated within the invalidation action numbered 12174 (heard

on the same day) and the costs in relation to this evidence have been taken into account in the award made in those proceedings. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 19 day of April 2002**

**JOHN MACGILLIVRAY**  
**For the Registrar**  
**the Comptroller-General**