

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION m 2042514  
BY JOSEPH ENTERPRISES INC  
TO REGISTER THE TRADE MARK  
**MINI CLAW**

AND

IN THE MATTER OF OPPOSITION  
THERE TO UNDER OPPOSITION m 45261 BY  
SANDHOLZER INTERNATIONAL GMBH

TRADE MARKS ACT 1994

IN THE MATTER of trade mark  
application m 2042514  
by Joseph Enterprises Inc.

5 and

IN THE MATTER of opposition  
thereto under opposition m 45261 by  
Sandholzer International GmbH

DECISION

10 On the 25 October 1995 Joseph Enterprises Inc. applied to register the trade mark MINI  
CLAW in class 8: 'Gardening Implements'.

The application is opposed by Sandholzer International GmbH.

Their grounds of opposition are that the Applicants' mark taken as a whole offends against:

- 15           Ž       ss 1(1) and 3(1)(a) of the Act in that it is incapable of distinguishing goods of the  
Applicant from those of other undertakings,
- Ž       s 3(1)(b) as it is devoid of any distinctive character,
- Ž       s 3(1)(c) as it consists exclusively of a sign or indication which may serve, in  
trade, to designate the kind and intended purpose of the goods specified in the  
Application, and
- 20           Ž       s 3(1)(d) in that it consists exclusively of a sign or indication which is customary  
in the current language and in the *bona fide* and established practices of the trade.

The Applicants have registered the mark:

	<b>MARK</b>	<b>m .</b>	<b>CLASS</b>	<b>GOODS</b>
25	GARDEN CLAW	1549547	8	Hand-operated tools and implements; parts and fittings for all the aforesaid goods; all included in Class 8.

Each party ask for an award of costs in their favour.

Both sides filed evidence in these proceedings and the matter came to be heard on 23 September 1998 when the Applicants were represented by Mr Bruce Marsh, trade mark agent of Wilson Gunn M'Caw. The Opponents were not represented.

## DECISION

5 Four statutory declarations are provided in evidence. The first is given by Anthony James Axe a Registered Trade Mark Attorney employed by Williams Powell & Associates, Agents for the Opponents. Evidence in reply is given by Mr Richard Dressel, who is the General Manager of Joseph Enterprises U.K., the Applicants in this matter, and by Mr Bruce Marsh, acting on their behalf. Finally, another declaration, commenting on these two, is provided by Mr Axe. I do  
10 not intend to summarise this evidence in detail, but only to refer to those parts I have found relevant to this Decision.

The grounds of opposition are all based on s 3(1) of the Act:

‘The following shall not be registered-

- (a) signs which do not satisfy the requirements of section 1 (1),
- 15 (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  
20 in the current language or in the *bonafide* 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.’

25 The first ground of opposition refers to s 3(1)(a) and s 1(1); the latter provides the definition of a trade mark:

‘..any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.’

To register a ‘sign’ it must be representable graphically and be capable of distinguishing goods or services of one undertaking from those of other undertakings.

30 It is clear that the MINI CLAW is a sign that can be represented graphically. There is no doubt about its nature or representation as it appears in the application and no one reading the Trade Marks Journal or inspecting the Register (assuming it is registered) would fail to understand from its appearance what it is. However, s 1(1) also requires trade marks to

distinguish one undertaking from another, in other words, be a badge of trade origin. In AD2000<sup>1</sup>, the Appointed Person, Geoffrey Hobbs QC states:

5           ‘...the requirements of section 1(1) are satisfied even in cases where a sign represented graphically is only “capable” to the limited extent of being “not incapable” of distinguishing goods or services of one undertaking from those of other undertakings. Such signs are not excluded from registration by section 3(1)(a). Section 3(1)(a) has the more limited effect envisaged by article 3(1)(a) of the Directive of preventing the registration of “*signs which cannot constitute a trade mark*” at the time when they are put forward for registration. It is clear that signs which are not objectionable under section 3(1)(a) may nevertheless be  
10           objectionable under other provisions of section 3 including sections 3(1)(b), 3(1)(c) and 3(1)(d).’

The test required by s 3(1)(a) is therefore rather a modest one and it seems to me that MINI CLAW meets this basic test. The outcome of this case thus depends on the application of ss 3(1)(b) to (d).

15           Taking section 3(1)(b) first, in the TREAT<sup>2</sup> case, Jacob J provides the following answer to the question ‘What does devoid of any distinctive character mean?’:

20           ‘I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or words inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent use and recognition as a trade mark, in itself....devoid of any distinctive  
inherently character’.

In AD2000 Geoffrey Hobbs also states:

25           ‘The wording of section 3(1)(b) follows the wording of article 3(1)(b) of the Directive and is identifiable from the 7th recital to the Directive as a provision establishing “*the absence of any distinctive character*” as a ground for refusal or invalidity “*concerning the trade mark itself*”. Section 3(1)(b) prohibits the registration of signs which satisfy the requirements of section 1(1), but are nonetheless “*devoid of any distinctive character*”.  
30           The proviso to section 3(1) indicates that the essence of the objection to registration under section 3(1)(b) is immaturity: the sign in question is not incapable of distinguishing goods or services of one undertaking from those of other undertakings, but it is not distinctive by nature and has not become distinctive by nurture.’

35           The latter part of this test - distinctiveness by nurture, i.e. acquired through use - is not relevant to this Decision. The evidence does not support this and the Applicants’ agent confirmed at the hearing they did not contend that it did. The application was made in October 1995 and Mr Dressel, in his statutory Declaration, states that his ‘..company first started

---

<sup>1</sup>AD2000 Trade Mark [1997] RPC 5, page171.

<sup>2</sup>

*British Sugar Plc v. James Robertson & Sons Ltd.* [1996] RPC 9, page 306.

promoting the goods sold under the MINI CLAW trade mark in September 1995', in other words, the product did not have time to acquire distinctiveness through use, before the date of application.

5 Thus the meaning of the words used in the mark is the crucial issue in this case. Mr Axe, for the Opponents, states:

'..the mark is devoid of any distinctive character for any small-sized claw or claw-like garden implement, and that others should be free to use the expression MINI CLAW as a straightforward description of their relevant goods, the mark applied for fails to meet the said requirement and therefore fails to meet the most basic requirement for a Trade Mark.'

10 And again:

'The totality, MINI CLAW, should be free for use by other traders for any claw-like implement which is of MINI- size'

15 This poses the key questions: Can MINI CLAW can be considered to consist exclusively of signs which may serve to designate the kind, intended purpose other characteristic of trade goods? (s 3(1)(c)). Or does it consist exclusively of customary trade words (s 3(1)(d))?

Mr Axe also points out in his evidence that the Registry has the following practice<sup>3</sup> on use of the word MINI:

20 'It is practice to object to marks consisting of the prefix MINI (indicating something small) when combined with the name of the goods/services or of some feature of the goods/services. A source of reference is MINIGROOVE (1955 RPC 183) which was refused registration in respect of long playing gramophone records (i.e. records having smaller grooves than the short playing type).'

25 Several other examples are produced in guidance. 'MINILIFT' is considered directly descriptive of installing and repairing small lifts such as those for transporting the disabled up a flight of stairs in their own home would be unacceptable for registration. As would MINICAB for bus services or MINICRUISE for short term or otherwise limited cruises.

30 Mr Axe also supports his view that MINI is a descriptive, combining form by reference to a dictionary definition of the word as 'Something small or short of its kind: [as a prefix] forming nouns, denoting smaller or shorter than the standard size'. He also contends that the Applicants' use of the word indicates an item smaller than the similar, but larger product they sell called the GARDEN CLAW. Mr Axe notes, commenting on Mr Dressel's evidence, that the MINI CLAW is also marketed as 'MINI KRALLE', 'MINI GRIFFE' and 'MINI KLAUW' and that confirms this interpretation of the prefix MINI-. In particular, Mr Axe refers to the extract from 'Hardware Today, which includes the information that 'the MINI  
35 CLAW is a smaller version [of the GARDEN CLAW..]'

---

<sup>3</sup>Trade Marks Registry Work Manual, Addendum to Chapter 6, pages 58 to 59.

In the Hearing Mr Marsh stated: ‘..MINI CLAW is a totally invented term which does not actually have any descriptive relevance in its entirety or when the terms are actually dissected into their separate elements.’ The latter part of this assertion, at least as far as MINI is concerned, I cannot accept. Both the Registry practice described above, and the evidence  
5 provided by Mr Axe, flies in the face of it. Mr Marsh regards the reference to the Applicants’ advertising literature as used in Continental Europe as irrelevant as it is made outside the United Kingdom. However, Mr Axe says that it illustrates the Applicants’ understanding of the meaning of its own mark, ‘which presumably does not change with the jurisdiction’. I agree with Mr Axe.

10 On more than one occasion in their evidence the Applicants say that they are neither arguing for registration of the words MINI or CLAW separately, but for the whole trade mark MINI CLAW. This appears to imply that, taken as a whole, ‘the sum’ of these two words is greater than their parts. At the Hearing Mr Marsh stated of the word CLAW that ‘in conjunction with the word MINI it creates a mark which in its entirety, is distinctive.’ See also his similar  
15 comment about the mark ‘in its entirety’ quoted in the last paragraph.

In view of what has been said about the word MINI I do not see how this be true. Use of MINI brings, in my view, no distinctiveness to the mark at all as it is a very clear code to most people that, when used as a prefix, the suffix is small, even where it is a word that may not recognised because it has not been encountered before.

20 In view of this, the case appears to depend on a restating of the questions I posed above: Can CLAW denote the kind of product or its intended purpose or some other characteristic of it or, following the words of s 3(1)(d) it is a customary word in the current language or in the *bonafide* and established practices of the trade? If the answer to either of these questions is ‘yes’, then the mark MINI CLAW is not registerable.

25 Mr Axe makes three relevant points. First the use of the word ‘claws’ in the Registry publication ‘Guide to the Classification of Goods and Services in the United Kingdom’ (1994). There is an entry for ‘Claws (hand tools)’ which gives the relevant Class for these goods as Class 08 (the Class into which the present application falls). From this Mr Axe concludes that the word CLAWS is considered by the Trade Marks Registry to be generic for such tools.

30 At the Hearing, Mr Marsh pointed out that the reference in this publication was to ‘Claws’ (plural) and not to CLAW (singular), the latter not being ‘listed in the Registry’s classification guide as being a term of reference.’ This seems to me too small a difference to be significant, and I do not think it helps me one way or another.

The purpose of the above Registry Guide is to aid the classification of goods and services and  
35 in framing specifications. It is not a list of generic names for products, though it is wholly possible that generic appellations may appear within it. In Schedule 4 to the Trade Mark Rules 1994 Class 8, is listed as including: ‘hand tools and implements (hand operated); cutlery; side arms; razors.’ This class embraces a vast range of items from ‘Die holders’ to ‘Crimping irons’, and includes some of the products listed by Mr Axe as having claw like characteristics  
40 such as hammers (his first Statutory Declaration page 2, paragraph 4). There is no indication given as to the type of product to which the words CLAWS applies. No doubt a trader who deals in ‘CLAWS’ and seeks to register a trade mark for his product would turn to the Guide

to find this entry and then would be able to correctly complete Form TM3. The term would be known to him and others involved in his trade. It seems clear that the presence of 'CLAWS' in the GUIDE tells us that there are certain 'hand tools' which can be classed in this way for trade mark registration purposes. However, it does not follow that CLAWS is a generic name for garden implements.

Next Mr Axe refers to an extract from Webster's Dictionary (1966) defining CLAW as meaning 'A gardening tool for loosening soil'. There is much discussion between the Applicants and the Opponents on the significance of this entry, mainly focusing on the age of the dictionary in which it appears. Definitions from more modern dictionaries are quoted by both the Opponents and Applicants and it emerges that this extract from Webster's 1966 edition is unique amongst the references made. Mr Axe contends that the age of this definition is not important. I am inclined to believe, however, that it is. S 3(1)(d) refers to the 'current language of the trade'; definitions that appear in 38 year old dictionaries and not in more modern examples cannot be called current. Again, evidence of trade usage is required and it this point I wish to consider now.

The Opponents are have not provided any evidence that the term CLAWS is 'customary in the current language...and established practices of the trade'. The word customary means 'in accordance with custom or habitual practice'<sup>4</sup> and implies there would be frequent and regular usage of the word CLAW in the gardening trade such that collation of evidence demonstrating this would be a relatively simple task. No such material has been produced.

During the Hearing and in evidence, the Applicants referred to this of lack of evidence. The only reference I have seen in the material I have before me that shows use of the word CLAW in gardening literature occurs in the Applicants' evidence, from the Statutory Declaration by Mr Marsh, Exhibit B. This is advertising literature produced by the Opponents (it is clear that this document is for the UK use, since the prices given are pounds) which calls the Opponents' version of these tools (the MAXI TEUFEL and the MIDI TEUFEL) 'claws'. For example, in describing the MAXI TEUFEL instructions to use the product are given: 'The claw is pressed vertically about six inches into the ground with the foot.' I will return to the significance of this evidence below, but this one reference is hardly indicative of widespread use of the word CLAW and this lack of evidence seems to me fatal to the opposition under s 3(1)(d).

Turning to s 3(1)(c), can the word CLAW be more generally descriptive of the product in a manner 'which may serve, in trade, to designate the kind...intended purpose...or other characteristics of..' these goods?

Returning to the Applicants' Exhibit B I drew this document to Mr Marshes attention in the Hearing. He said that it was 'somewhat tainted by being the Opponents' own literature' and added '...they are likely to try and use the term "claw" therein to reinforce their attack on our application.'. This seems an unjustified assertion given that this evidence was produced by the Applicants, not the Opponents. If the latter had sought to do this they would have produced such documents in their own evidence. I'm inclined to believe that this is an example of the word claw being used descriptively to describe this particular variety of tool.

---

<sup>4</sup>*Collins English Dictionary*, 1984.

It should be noted that s 3(1)(c) prevents the registration of ‘signs or indications which *may* serve’ to designate in trade, *inter alia*, the kind and characteristics of goods. In other words, this clause is not solely concerned with the current vocabulary of the trade, but also encompasses words that may, reasonably, become part of that vocabulary in the future. It seems to me that this would reasonably apply to the word ‘claw’, not least because it has been used descriptively of a range of tools already. For example, Mr Marsh included in his evidence an extract from the Oxford English Dictionary 2nd Edition. This was intended to rebut the charge that CLAW is a dictionary word which describes a type of gardening implement. It is true that this reference contains no definition of CLAW as a gardening implement. However, the fifth definition of the word CLAW as a noun is:

‘A mechanical or other contrivance resembling a claw; e.g. a curved iron with sharpened extremity for grappling or tearing; the back part of a hammer head curved and cloven, or any similar tool for extracting nails; the spreading divisions of the foot of a table or stand; the ends of a horse-shoe, etc. Also, part of the mechanism of a lock; a device in a cine-camera or projector.’

I further note that the extract from the Chambers English Dictionary in Exhibit AJA1 to Mr Axe’s Declaration also contains a definition of the noun CLAW as, *inter alia*, ‘an instrument shaped like a claw’ and ‘anything like a claw’. Mr Marsh argued that the intended purpose of the Applicants’ product was to break up and aerate soil, rather than to claw it. On this footing he asked me to accept that the word CLAW would not be used, in trade, to describe the Applicants’ goods.

I reject that submission for the following reasons:

- (1) The Applicants’ specification is not limited to the product described in their evidence, but covers gardening implements at large.
- (2) Even if I accept that the word CLAW does not accurately describe the intended purpose of the actual goods of interest to the Applicants, it appears apt for use as a noun to describe tools of a shape resembling a claw.
- (3) In view of the dictionary definitions, which include examples of analogous use on other tools (such as a claw hammer, claw-lever and claw screw) and the Opponents own use of the word ‘claw’ to describe the same type of product, I consider that the word CLAW may serve in trade to designate the kind or other characteristic (shape) of gardening implements.
- (4) Although a word which describes the shape of the goods cannot be regarded as being automatically debarred from registration by s 3(1)(c) - the shape of goods themselves maybe registerable if distinctive - such a word is so barred where the shape described is not distinctive. I do not regard a claw shape as arbitrary and therefore distinctive either for the specific goods of interest to the Applicants, or for gardening implements at large.

In view of my earlier finding that the addition of MINI fails to cure the descriptiveness of the mark and adds nothing to its distinctiveness, I find that the mark as a whole is excluded from registration by ss 3(1)(b) and (c) of the Act.

The application fails and the Opponents are successful.

5 Finally, there is one other point on which I would like to comment. Mr Marsh notes that the Registry has already registered the mark GARDEN CLAW and allowed MINI CLAW to pass through the examination process to advert without objection. Mr Axe says that objections to the distinctiveness of the mark GARDEN CLAW should have been raised and reminds us that 'Examiners are not infallible.'

I would not wish to argue with the latter comment. However, I should make it clear that my decision relates solely to the mark MINI CLAW. The trade mark GARDEN CLAW is registered and that is *prima facie* evidence of its validity by virtue of section 72 of the Act.

10 Finally, on the subject of costs, the Opponents asked that these be paid and I set them at £835.

**Dated this 26th day of November 1998**

**Dr W J Trott  
Principal Hearing Officer  
For the Registrar, the Comptroller-General**