

O-248-08

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 2323320
BY CALOR GAS LIMITED
TO REGISTER A TRADE MARK
IN CLASSES 4 & 6

AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 92698
BY FLOGAS UK LIMITED

BACKGROUND

1) On 11 February 2003 Calor Gas Ltd of Athena Drive, Tachbrook Park, Warwick, CV34 6RL applied under the Trade Marks Act 1994 for registration of a number of trade marks, which were said to be a series for a wide range of products in Classes 4 & 6. The trade marks were reduced to a single trade mark, **PATIO GAS**, and following evidence of use the mark was accepted as having acquired distinctiveness through use in respect of the following goods:

In Class 4: “Gas for Patio Heaters.”

In Class 6: “Cylinders for gas for patio heaters.”

2) The opponent, Flogas UK Ltd of 81 Raynsway, Watermead Industrial Park, Wanlip Road, Syston, Leicester, LE7 1PF filed notice of opposition on 5 August 2004. The grounds of opposition are in summary:

a) The mark in suit is origin neutral, and comprises the normal English words “patio” and “gas” juxtapositioned in a normal, lexically-uninventive manner to form the phrase “Patio gas”. There is nothing syntactically unusual about the said phrase. It offends against Section 3(1)(b) of the Trade Marks Act 1994.

b) The mark comprises exclusively of a term that is apt to describe the intended purpose of the goods for which registration is sought, namely gas, or gas containers, that are suitable for use with gas-powered devices such as heaters that are suited for, or especially adapted for, use on a patio. The mark offends against Section 3(1)(c) of the Trade Marks Act 1994.

3) The applicant subsequently filed a counterstatement denying the opponent’s claims. The applicant states that it “coined” the mark in suit and that “The words PATIO GAS are not the natural way that traders would describe the goods of this application.”

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 4 June 2008 when the opponent was represented by Mr Wilson of Queen’s Counsel instructed by Messrs HBJ Gateley Wareing. The applicant was represented by Mr Ludbrook of Counsel instructed by Messrs AA Thornton & Co.

OPPONENT’S EVIDENCE

5) The opponent filed a witness statement, dated 8 July 2005, by Patrick Kilmartin the Chief Executive of the opponent company. He repeats his view that the mark is descriptive for the published goods. To back up his claim he provides exhibits which show use of the mark in suit by others. These are as follows:

- Exhibit PK1: Copies of pages from the website of Patio Gear (undated) which refers to “Patio Gas” supplied in containers carrying the mark PatioGear or Flogas. Also in this exhibit is a copy of a page from Town and City Gardens

(undated). Beneath a garden heater it states: “All you need to obtain is a green bottle of “Patio gas” from either a Calor gas dealer or a Flogas dealer.”

Exhibit PK2: Copies from an American company website which is advertising “patio gas grills”, “patio heaters” and “patio torches”.

Exhibit PK3: Copies of pages from another American website, this time describing a home for sale as having a “patio gas outlet for a gas grill”.

Exhibit PK4: Copies of pages from UK websites including copies dated 26 March 2003 from Webbs of Crickhowell which offers “Patio Heaters and patio gas as well”.

Exhibit PK5: Copies of pages, dated 9 April 2003, from the website of Patio-Heaters-UK. They offer a gas barbeque which has listed amongst its features “includes patio gas regulator”.

Exhibit PK6: Copies of pages, dated 26 March 2003, from the BBQ.Co.UK website which has a FAQ section. One question mentions “portable and patio gas BBQ’s”, however I note this question also refers to American and Canadian BBQ’s.

Exhibit PK7: Copy of an Institute of Electrical Engineers policy submission to Government relating to “Amend the Building Regulations”. At paragraph 6 it states:

“6. Three other areas where regulation might be worth considering are:

heating of outdoor swimming pools e.g impose a GJ/year limit:
outdoor patio gas space heaters, and
conservation of rainwater with the consequent energy savings from pumping.”

Exhibit PK8: An extract from the Liquefied Petroleum Gas Association’s magazine. This highlights a number of products which run on gas. This shows use of the term “Patio heater” with regard to a number of products from different manufacturers. The use of the term Patio Gas in this extract appears to be restricted to the applicant.

Exhibit PK9: Copies of pages from various suppliers which all show use of the term “patio heater” in relation to gas heaters for patio’s or outdoor use.

Exhibit PK10: This consists of a witness statement by Mr Kilmartin dated 1 October 2004 in support of his company’s UK Trade Mark Application 2327191 FLOGAS PATIO GAS, which is being opposed by the applicant in the instant case.

6) Lastly, Mr Kilmartin states that the mark in suit merely serves to indicate that the product is intended to be used in garden appliances which require gas fuel.

APPLICANT’S EVIDENCE

7) The applicant filed three witness statements. The first, dated 15 November 2005, is by Alexander Davis a Director of the applicant company. He states that his company invented the mark in suit and has used the mark since May/June 2000. He states that

his company uses the mark with and without the word Calor. At exhibit AD1 he provides evidence of such use.

8) The second witness statement, dated 10 November 2005, is by Leonie Jane Boone an investigator. At exhibit FI1 she provides a copy of her report. This considered the use of the term “Patio gas” by Patiogear Ltd as shown in the opponent’s evidence. It states that Patiogear offers a product referred to as “patio gas” which is branded with the name Patio Gear. Patiogear Ltd has a nation wide contract with the opponent to supply Flogas products.

9) The third witness statement, dated 21 November, is by Ian Gill, the applicant’s Trade Mark Attorney. At exhibit IG1 & 2 he provides a copy of a witness statement and also various letters filed in support of the trade mark application. I summarise these below.

Exhibit IG1: A witness statement, dated 13 August 2003, by Rachel Hodge a Market Development Manager for the applicant company. She states that the mark in suit was first used in February 2000 and that it has been used throughout the UK since this time. She provides the following turnover and advertising figures for the UK for gas, cylinder hire charge and appliances under the mark in suit.

Year	Turnover £	Advertising
2000	1,240,600	905,000
2001	2,200,280	805,000
2002	1,526,308	715,000

Ms Hodge also provides five exhibits, CG1-CG5. The first, CG1, consists of a media information pack provided by the applicant. This shows use of the mark It makes reference to both “Patio Gas” and “BBQ Gas” being used in connection with patio heaters and barbeques. It includes safety tips as well as stories for the media to carry. All mention the mark in suit and provide details of how to obtain supplies. The items are dated between February 2000 and June 2003. There is also mention of the use of a clip-on connector making the Patio Gas cylinder easier to use. The pictures of the cylinders show the “Calor” name, then under this “Patio Gas”. The mark in suit is printed in the same style of type face and positioned in the same place as the words “Butane” and “Propane” on standard types of cylinders. On all the main house mark is “Calor”. Exhibit CG2 consists of stories and photographs which have appeared in various newspapers and magazines throughout the UK. Typically they show a patio heater and alongside a cylinder of “Calor Patio Gas”.

Exhibits CG3,CG4 and CG5 show copies of advertising materials for the mark in suit for 2001, 2002 & 2003 respectively. They are similar to the advertising and promotional material above, in that they mention the mark “Patio Gas” and in some cases the cylinder is shown.

Exhibit IG2: This consists of various letters from manufacturers of barbecue equipment and patio heaters. There are also letters from Calor gas main dealers, advertising and marketing companies, public relations and communication

companies. Virtually all say that they associate the mark in suit with the applicant and that the applicant has used the mark for a number of years.

10) That concludes my review of the evidence. I now turn to the decision.

DECISION

11) The opposition is based upon section 3(1)(b) and 3(1)(c) which read:

“3.-(1) 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, geographic origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d)

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.”

12) It is clear from the views expressed by the European Court of Justice in *Companyline* [2003] E.T.M.R. 20, *Linde AG (and others) v Deutsches Patent-und Markenamt*, Journal Cases C-53/01 to C-55/01, and the High Court in *Have a Break* [2002] EWHC 2533 (Ch) that Section 3(1)(b) has separate and independent scope from Section 3(1)(c).

13) In considering these grounds I take account of the following principles derived from the ECJ cases referred to below:

- a) for a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- b) a mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Koninklijke KPN Nederland v Benelux Merkenbureau*, paragraph 86);
- c) a trade mark’s distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public’s perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);

d) the relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

14) I also take into account the following:

- subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – (*Wm Wrigley Jr & Company v OHIM* – Case 191/01P (*Doublemint*) paragraph 30;
- thus Article 7(1)(c) (Section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM*, paragraph 31;
- it is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes – *Wm Wrigley Jr v OHIM*, paragraph 32;
- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, Case C-363/99 (*Postkantoor*), paragraph 57;
- if a mark which consists of a word produced by a combination of elements is to be regarded as descriptive for the purposes of Article 3(1)(c) it is not sufficient that each of its components may be found to be descriptive, the word itself must be found to be so – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, paragraph 96;
- merely bringing together descriptive elements without any unusual variations as to, for instance, syntax or meaning, cannot result in a mark consisting exclusively of such elements escaping objection – *Koninklijke Nederland v Benelux Merkenbureau*, paragraph 98;
- however such a combination may not be descriptive if it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements – *Koninklijke Nederland NV v Benelux Markenbureau*, paragraph 99.

15) The opponent contends in its skeleton argument:

“3. The fundamental fact that emerges from the many pages of advertising and webpages exhibited to the statements in this case is that the word “Patio” has become an extremely well used word in conjunction with other words to indicate objects for use in the garden. In particular, there is a very well known

object usually referred to as a Patio Heater, though sometimes also as a Gas Patio Heater or Patio Gas Heater. As the latter names imply, this device burns gas to provide heat.

4. Two further facts which emerges from the same paperwork are:

- a) that the term BBQ is commonly used to denote equipment for use in association with barbeques, and
- b) that gas powered barbeques have become increasingly popular."

16) The opponent sought to link the instant case to the use of the term "BBQ Gas" by the applicant. Mr Wilson contended "...but we say that the relevance of BBQ Gas is that it is as descriptive, if not more descriptive than Patio Gas. The use of the two in parallel....but it is one of the reasons we say that the effect of the other side's material has not been to educate the public that it is a trade mark, but to educate the public that this is an available commercial product which Calor happen to supply."

17) The average consumer for the goods would be the average adult citizen in the UK, I am assuming that such products would not be sold to a child. Gas cylinders are, to my mind, purchased with a degree of care and attention. They are potentially lethal and have to be handled and stored with care.

18) The applicant referred me to a number of authorities, *Windsurfing Chiemsee v Boots und Segelzubehor* [1999] ETMR 585, *Wrigley v OHIM* [2001] ETMR 58, *Proctor and Gamble v OHIM* [2002] RPC 17, *Phillips v Remington* [2003] RPC 2, *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (POSTKANTOOR)[2004] ETMR 57, *Nestle v Mars* [2006] FSR 2 and *West (t/a Eastenders) v Fuller Smith & Turner Plc* (ESB) [2003] FSR 44. However, I do not believe that these cases differ in their principles from those quoted above. Mr Ludbrook also referred to POSTKANTOOR (which was also referred to in paragraph 13 above) in his skeleton as follows:

"[T]he purpose of the prohibition of registration of purely descriptive signs ... as trade marks was to prevent registration ... of signs or indications which, because they were 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 marketed them and were thus devoid of the distinctive character needed for that function.

The signs or indications ... were only those which might serve in normal usage from the 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 was sought. A mark composed of signs or indications satisfying that definition should not be refused registration unless it comprised no other signs or indications and, in addition, the purely descriptive signs or indications of which it was composed were not presented or configured in a manner that distinguished the resultant whole from the usual way of designating the goods or services concerned on their essential characteristics.

With regard to word trade marks, descriptiveness had to be determined not only in relation to each word taken separately but also in relation to the whole which they formed. Any perceptible difference between the combination of words submitted for registration and the terms used in common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics was apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.

[A] mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics ..., unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the second case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purpose of the same provision.

It is ... irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. The wording [of the section] does not draw any distinction by reference to the characteristics which may be designated by the signs or indications of which the mark consists. In fact, in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially.”

19) Mr Ludbrook, for the applicant, drew from the above and in the *ESB* case the following:

“7.....

- (i) The word "devoid" is to be construed strictly.
- (ii) Sections 3(1)(b) and (c) are not designed to exclude from registration marks which merely possessed an indirect descriptive connotation.
- (iii) The fact that some mental activity is necessary to discern a reference to the quality of or characteristic of the goods from the substance of a mark assists in its registrability.
- (iv) Uncertainty as to the precise nature of the reference in a mark to the quality or character of the goods is also of assistance re registrability.
- (v) There is no requirement that a mark be both “capable of distinguishing” and “not devoid of distinctive character”.

(vi) A mark could be both distinctive (in that it communicated a message as to the trade origin of the goods to which it was applied) while simultaneously conveying a clear description of those goods.

8. To expand on the latter point, even if it is the case that a mark has (for some consumers) a descriptive connotation, if it has in addition a distinctive character then it is not to be excluded from registration. Descriptiveness and distinctiveness are not mutually exclusive. A mark may be both distinctive (in that it communicates a message as to the trade origin) while simultaneously conveying a clear description of those goods.”

20) To my mind the mark in suit is clearly descriptive for the goods for which it is sought to be registered. It is clear that, at the relevant date (11 February 2003) the term “patio heater” was in common use. The average consumer in the UK when seeing the mark in suit would, in my opinion, believe that the gas was specifically designed for patio heaters and/or other patio appliances. It is not a mark that requires mental activity to discern its purpose. It would be seen as a clear description of the goods. I do not accept that the mark has a dual message, as I believe that it is entirely origin neutral. I do not believe that the average consumer would have any uncertainty as to what the product was. It has a clear meaning, if you have a patio heater this is the gas to use with it. It clearly designates its intended purpose. The grounds of opposition under Section 3(1)(b) and 3(1)(c) succeed.

21) However, this is not the end of the matter as I have to consider whether the mark has acquired distinctiveness through use, it was accepted by the Registry initially on this basis. I was referred to the ECJ decision in *Windsurfing Chiemsee v Boots und Segelzubehor* [1999] ETMR 585:

“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.

.....

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 ... 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.”

22) Mr Ludbrook also provided a list of propositions, as follows, which he states were expounded by the ECJ in *Societe Des Produits Nestle SA v Mars UK Ltd* [2006] FSR 2.

“(i) In order to acquire distinctiveness, identification by the relevant class of persons of the product or service emanating from a given undertaking had to be as a result of the use of the mark as a trade mark.

(ii) In order for the latter condition to be satisfied it was not necessary that the mark applied for had been used independently.

(iii) Acquisition of distinctive character could be as a result both of use as a component of a mark and of the use of a separate mark in conjunction with a registered trade mark. In both cases it was sufficient that, in consequence of such use, the relevant class of persons actually perceived the goods as originating from a given undertaking.

(iv) Thus, the distinctive character of a mark could be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.”

23) The mark was in use for three years prior to the relevant date. The applicant has provided turnover and advertising figures which are reasonably substantial, albeit they have not put them into context of the overall market for gas contained in cylinders. However, if the use had been very modest I am sure that the opponent would have been quick to point this out. The applicant has shown that the mark was used throughout the UK. From both sets of evidence it is clear that, as at the relevant date, no-one else was using the mark in suit as a descriptor.

24) I note that all the instances of use shown of the mark in suit on the actual product also included use of the mark Calor. It was stated that the gas cylinders have to, by law, be so marked by the supplier. Whilst I accept that this is a legal requirement the average consumer will, in all probability, not be aware of such a requirement. They will see the name of the supplier, Calor, and, what I consider to be, a description of the product, patio gas. The evidence from members of the trade carries little weight, as the evidence was in the form of letters instead of the correct evidential format, they mostly had a commercial relationship with the applicant, and they were aware that the actual gas contained within the cylinders was propane. The average consumer would not be in such a position. They would be faced with a cylinder of gas marked “patio gas” in somewhere such as B&Q. To my mind it would be natural for them to assume that this was the correct gas to use with their patio heater, and assume that the patio gas that they were buying was supplied by the applicant rather than by one of its competitors. I do not believe that they would have been surprised to have seen cylinders of “Flogas Patio Gas”. I do not accept the contention that the average consumer would have viewed the mark in suit as a secondary mark with “Calor” being the house mark.

25) The applicant made much of the fact that no use of the mark in suit by other parties had been shown in the evidence. However, it would appear to me that the market is dominated by a few major players who are well aware of the others actions. I do not find it surprising that the applicant's competitors avoided use of the mark in suit so as to negate any legal action against them. However, the industry is not the average consumer. My earlier finding on the grounds of Section 3(1)(b) & (c) stands .

26) As the opponent was successful it is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £2,000. This sum 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 27th day of August 2008

**George W Salthouse
For the Registrar,
the Comptroller-General**