

O-287-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2443998
BY MATSUSHITA ELECTRIC INDUSTRIAL., LTD
TO REGISTER A SERIES OF TWO TRADE MARKS
IN CLASS 11**

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IN CLASS 11

DECISION AND GROUNDS OF DECISION

Background

1. On 18 January 2007 Matsushita Electric Industrial Co Ltd of 1006 Oaza Kadoma, Kadoma-shi, Osaka 571-8501, Japan applied under the Trade Marks Act 1994 to register the following series of trade marks:



The logo consists of the word 'Combi' in a large, black, sans-serif font, with a red wavy underline underneath it. Below the underline is the word 'Steam' in a smaller, black, sans-serif font.



The logo consists of the word 'Combi' in a large, black, sans-serif font, with an orange wavy underline underneath it. Below the underline is the word 'Steam' in a smaller, black, sans-serif font.

2. Registration is sought for the following goods:

‘Class 11 steam ovens and parts and fittings therefor’

3. An objection was taken against the application under Section 3(1)(b) and (c) of the Act because the marks consist essentially of the words ‘combi steam’ which describes a characteristic of the goods e.g. ‘a combination of a normal oven and a steam oven, or a microwave and steam oven’. This objection was issued under Section 40 of the Act, as it was apparent that the mark has been originally accepted in error.

4. A Hearing was held on 18 January 2008 at which the applicant was represented by Mr Alge of Marks & Clerk, their trade mark attorney. The objection was revised at the hearing to Section 3(1)(b) to take into account the presentation of the mark.

Following the hearing, the objection was maintained a Notice of Final Refusal subsequently issued.

5. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

6. No evidence has been put before me, therefore I have only the prima facie case to consider.

The Law

7. Section 3(1)(b) of the Act reads as follows:

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

(b) trade marks which are devoid of any distinctive character.”

The case for registration

8. In correspondence prior to the hearing, Mr Alge made submissions in support of the application.

9. In his letter dated 10 September 2007, Mr Alge referred to the visual elements contained within the marks i.e. the font in two different sizes and on two different planes and an arbitrarily positioned wave line device (that alludes to a heat wave). Mr Alge referred to these visual elements being present in the Applicant’s CTM Registration E5176748 ‘Steam PLUS’ in Class 11. It was also submitted that the average consumer will perceive the marks as ‘logos’ that will serve to indicate the origin of goods marked with the same.

10. These submissions were considered, however it was determined that the term ‘combi steam’ is used in trade (supported by extracts from the Internet showing the mark used in such a descriptive context) and that the objection was therefore maintained.

Decision

11. The approach to be taken when considering the issue of distinctive character under Section 3(1)(b) of the Act has been summarised by the European Court of Justice in paragraphs 37,39 to 41 and 47 in it’s Judgement in Joined Cases C-53/01 to C-55/01 Linde AD, Windward Industries Inc and Rado Uhren AG (8 April 2003) in the following terms:

“37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings."

12. In order to achieve registration I acknowledge that there is no requirement for a trade mark to possess a specific level of linguistic or artistic creativity or imaginativeness. I must determine whether the trade marks applied for are capable of enabling the relevant consumer of the services in question to identify the origin of the services and thereby to distinguish them from other undertakings. In *OHIM v SAT.1* (Case C-329/02P) the European Court of Justice provided the following guidance at paragraph 41:

"41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings."

13. The objection raised relates to all goods covered in the Class 11 specification:

'Steam ovens and parts and fittings therefor'

14. The objection under Section 3(1)(b) is maintained against these goods. The descriptive message in the term 'COMBI STEAM' in relation to these goods is clear; 'combi' is a term used in trade as an abbreviation for 'combination' when used in

conjunction with ovens, to describe an oven which cooks with a combination of dry heat and steam.

15. The relevant consumer of such products is the general public who wish to purchase an oven that will offer such cooking features.

16. Mr Alge has, in his submissions, mentioned the presentation of the marks in terms of the font, positioning of words and the wavy line devices. Whilst these elements could be considered by some relevant consumers as slightly unusual, I do not consider that these are sufficient to detract the consumer from the immediate descriptive message contained in the term 'combi steam'. Indeed, the wavy line devices, described by Mr Alge as 'alluding to a heat wave', could be seen as reinforcing the descriptive message by imitating, or replicating, convective heat transfer. The positioning of the words, with the word 'COMBI' being placed directly over the word 'STEAM' does not affect the eye passing over the marks and they will still be immediately perceived as the term 'combi steam'.

17. At the hearing of this application, Mr Alge proposed to disclaim the words 'COMBI STEAM' from the mark, however this was not accepted as a means of overcoming the objection, as the mark as a whole remains and is insufficiently distinctive to be able to act as an indication of sole trade origin.

18. The trade marks applied for consists of a term well used in trade, COMBI STEAM, which other traders are allowed to use freely within their legitimate course of trade to describe, for example, ovens. I consider that the additional elements of stylisation are not sufficient to render the entire marks distinctive and do not detract from the overwhelmingly descriptive message of the marks.

19. Consequently, I have concluded that the marks applied for consist exclusively of signs which may serve in trade to designate the kind of goods and are therefore excluded from registration under Section 3(1)(b) of the Act. For the reasons stated, the average consumer when encountering the marks is unlikely to give the presentation within the marks any significance and therefore the marks cannot act as an indication of sole trade origin without prior education to this fact.

Conclusion

20. In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 3(1)(b) of the Act.

Dated this 20th day of October 2008

**A J PIKE
For the Registrar
The Comptroller-General**