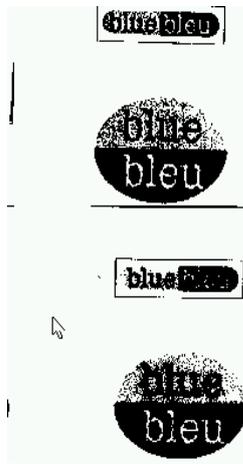


TRADE MARK ACTS 1994

**IN THE MATTER OF
APPLICATION NO: 2185306
BY OSR INTERNATIONAL LIMITED
TO REGISTER A TRADE MARK IN CLASS 25**

DECISION AND GROUNDS OF DECISION

On the 24 December 1998, OSR International Limited of 361-365 Moseley Road, Balsall Heath, Birmingham, B12 9DE, applied under the Trade Marks Act 1994 for registration of a series of 4 of the trade mark "blue bleu" and device



in Class 25 in respect of:

"Articles of clothing, footwear and headgear."

Objection was taken to the mark under paragraphs (b) and (c) of Section 3 (1) of the Act, on the grounds that it consists of a sign which consists exclusively of the English word "Blue", and the French equivalent, designating the colour of the goods. Objection was also taken to the mark under Section 5 (2) of the Act, on the grounds of the likelihood of confusion with an earlier mark.

At the Hearing at which the applicants were represented by Ms Wiseman of Barker Brettell, their agents, the Section 5 (2) objection was not discussed but was waived in correspondence subsequent to the hearing. This being the case, I will make no further reference to it in this decision. However, the Section 3 (1) (b) and (c) objection was maintained and following refusal of the application under Section 37 (4) of the Act, I am now asked under Section 76 of the Act and Rule 56 (2) of the Trade Marks Rules 1994 to provide a statement of the reasons for my decision. No evidence has been put before me. I have, therefore, only the prima facie case to consider.

Section 3 (1) objection

The relevant part of Section 3 (1) of the Act reads as follows:

"The following shall not be registered -

(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"

The marks consist essentially of the common dictionary word "Blue" and the French word "Bleu" which translates as the colour "Blue" on a two toned oval background, the 3rd and 4th marks in the series claiming the colours light blue and dark blue as an element of the mark. The word "Blue" is so well known as a colour as to require no further explanation. However, for the sake of completeness, Collins English Dictionary (third edition 1994) defines the word as follows:

BLUE - 1. any of a group of colours, such as that of a clear unclouded sky, that have wavelengths in the range 490-445 nanometres. Blue is the complementary colour of yellow and with red and green forms a set of primary colours.

At the Hearing Ms Wiseman argued that the overall significance of the mark had no direct reference to the characteristics of the goods claimed and was a fanciful and novel combination that was clearly meaningless. Ms Wiseman believed that the mark to be on a par with previous acceptances, in particular 2014611 ONLY BLUE and 2118026 ROSE ET BLEU. The state of the Registrar is, in principle, irrelevant to the fate of an application. This principle was recently re-affirmed by Jacob J, in British Sugar plc v James Robertson & Sons Ltd (supra) at p. 305 in the following terms:

"Both sides invited me to have regard to the state of the registrar. Some traders have registered mark consisting of or incorporating the word "Treat". I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see, eg. MADAME Trade Mark (1966) RPC 541 and the same must be true under the 1994 Act. I disregard the state of the register evidence."

With regard to the objection raised under Section 3 (1) (b) of the Act, the question as to what exactly "devoid of any distinctive character" means, was also commented upon by The Hon. Mr Justice Jacob as follows:

"Next, is "Treat" within Section 3 (1) (b)? What does devoid of distinctive

character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is 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 word inappropriate for the goods concerned ("North Pole" for bananas) can clearly do so. But a common laudatory word such as "Treat" is, absent use and recognition as a trade mark, in itself, (I hesitate to borrow a word from the old Act inherently but the idea is much the same) devoid of any distinctive character."

In my view, and when used in connection with the goods (articles of clothing, footwear and headgear) for which registration is sought, the meaning that the words "Blue, Bleu" is likely to convey to the general public who are reasonably well informed and circumspect is, here we have a range of clothing products bearing dual language labelling and describing the colour of the products as "blue". That being the case, the mark clearly offends under Section 3 (1) (b) of the Act as it is devoid of any distinctive character. It may also be said to be open to objection under Section 3 (1) (c) of the Act as they are the type of words that others may legitimately wish to use descriptively in the normal course of trade. Moreover, I have to consider what the likely impact would be on other businesses if the mark was registered. In the AD2000 trade mark (1997) RPC 168, Geoffrey Hobbs QC said:

"Although Section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse registration of signs which are excluded from registration by the provisions of Section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacob Esq QC in his decision on behalf of the Secretary of State in Colorcoat Trade Mark (1990) RPC 551 at 517 in the following terms:

"That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see e.g. Yorkshire Copper Works Ltd's Trade Mark Application (1954) RPC 150 at 154 lines 20-25 per Viscount Simonds LC. Essentially the reason is that the privilege of a monopoly should not be conferred where it might require "honest men to look for a defence"."

I have considered the background material within the mark and considered the mark as a whole. However, I consider the stylisation to be hardly noticeable and certainly de minimis within the mark. In the TREAT case (1996) RPC 281, Mr Justice Jacob said:

"I am, of course, aware that the words "Toffee Treat" are written in a fancy way. But then so are many descriptors. One only has to look at how British Sugar write such words as "Meringue mix" or "Golden Syrup" to see parallel sorts of use. I do not think this affects the matter one way or the other."

Merely presenting the word in a slightly stylised fashion does not turn it from being devoid of distinctive character into a trade mark. Where the residual element (the sign apart from the

non distinctive word) is insufficient to justify a registration the application must be refused. In the P.R.E.P.A.R.E decision (application no. 2006629), the Appointed Person Geoffrey Hobbs QC concluded that the sign P.R.E.P.A.R.E so closely resembled the word PREPARE as to be devoid of any distinctive character. In my opinion the presentation of the marks as applied for does not add sufficient surplus to the words “blue bleu” to justify protection.

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 paragraphs (b) and (c) of Section 3 (1) of the Act.

Dated this twenty third day of August 2000.

MARTIN LAYTON
for the Registrar
the Comptroller