

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO. 2108404A
BY ORANGE PERSONAL COMMUNICATIONS SERVICES LTD
TO REGISTER A TRADE MARK IN CLASSES 18 & 25

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 2108404A
BY ORANGE PERSONAL COMMUNICATIONS SERVICES LTD
TO REGISTER A TRADE MARK IN CLASSES 18 & 25**

5

DECISION AND GROUNDS FOR DECISION

10 On 22 August 1996, Orange Personal Communications Services of St James Court, Great Park Road, Almondsbury Park, Bradley Stoke, Bristol, applied under the Trade Marks Act 1994 for registration of the following mark:

15



20

25

Following division of the original application in April 1998, the goods claimed in this particular application are as follows:

30

Class 18 Leather and imitations of leather and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; bags; cases; wallets; purses; card holders; umbrellas, parasols and walking sticks.

35

Class 25 Articles of clothing; footwear, headgear, all included in Class 25.

Objection was taken against the mark under section 3(1)(b) on the grounds that the mark consists essentially of the word "orange" contained within a non-distinctive square background device, the whole being devoid of distinctive character for e.g. goods coloured orange.

40

Objection was also taken under Section 5(2) of the Act in respect of Class 25 only, because of the existence of registration number 1531626 in Class 25 for the word only mark "ORANGE GAL". This registration is subject to separate disclaimers of the words "ORANGE" and "GAL".

45

Hearing and Decision

At a hearing on the original application prior to division at which the applicants were represented by Dr S James of RGC Jenkins & Co., the objections were maintained. At a
5 subsequent hearing on the evidence filed, at which the applicants were represented by Mrs H Buckley of the same company, the objections were further 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 (as amended) to state in writing the grounds of my decision and the materials used in arriving at it. The relevant part of Section 3(1)(b) of the
10 Act is set out below:

"The following shall not be registered -

(b) Trade marks which are devoid of any distinctive character

15 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".

The Prima Facie Case for Registration

20 At the first hearing, Dr James put forward arguments in support of acceptance of the mark as a totality. The full case for prima facie acceptance may be summarised as follows:

- 25 - the mark, as a whole, performs the function of a trade mark. It consists of a three part mark ie the word "orange", a black square and the unusual placement of the word "orange" within the square.
- Dr James offered to exclude any goods coloured orange if this was felt to assist the case for acceptance.
- 30 - the applicants have made a significant commitment and investment in the use of the main corporate trade mark and this application will therefore be seen simply as another registration in these classes in the ORANGE family of marks. The mark applied for has a reputation across the board.

35 At the hearing on 6 October 1997, the Hearing Officer, Mr D Landau, rejected these submissions. He commented that the mark might have a considerable reputation in relation to telecommunications, but it had no such reputation in relation to classes 18 or 25. In relation to these classes the mark must be tested against the standard criteria for registrability. On this
40 basis the Hearing Officer considered that the mark is devoid of distinctive character within the meaning of Section 3(1)(b) because it consists essentially of the word "orange" contained in a black box. He did not consider that the other elements of the mark carry it on either the basis of relative proportions or surplus. He went on to comment that the mark would not be seen as a trade mark in the prima facie as no one would see "orange shirt" for example as a trade mark
45 for shirts even if this is a misdescription. Unless the colour can be considered clearly fanciful for the goods then the mark does not qualify for acceptance in the prima facie under Section 3(1)(b) of the Act.

The outstanding citation under Section 5(2) of the Act, no 1531626 was maintained at the hearing. Some time later, on 31 August 1999, this trade mark was actually assigned to the applicants and therefore ceased to be an official objection against this application proceeding.

5 **Acquired Distinctiveness: the Applicants' Evidence**

Following the hearing on the prima facie case for registration, the applicants submitted evidence in the nature of Statutory Declarations and exhibits of Clifford Sydney Cooper and a Statutory Declaration of Michael Dines. This evidence was rejected as insufficient by the first Hearing Officer in correspondence, and also by myself at a hearing held on 17 August 1999.

Mr Cooper is the Managing Director of Orange Music and Electrical Company Limited (formerly known as Orange Musical Industries Limited). The primary commercial interests of the company since 1968 being manufacture and retail of electronic and other musical instruments under the stylised word "ORANGE" as presented below:



Mr Cooper goes on to give details for the following clothing and related goods sold under the stylised word "ORANGE" as follows:

30	Product	Date of first sale
	Tee shirts	1969
	Singlets	1970
	Bomber jackets	1970
35	Leather Belts	1970
	Caps and woolly hats	1970
	Badges	1970
	Bags for musical instruments	1970
40	Holdall bags	1970

Samples of some of these clothing items are given in the exhibits. There are no exhibits to cover the Class 18 items. Sales in the UK of these items were approximately £2-3,000 per year in the early 1970s rising to £10,000 per year since the mid 1990s. Sales of carrier bags holdalls and bags adapted to carry musical instruments averaged out at around £20,000 per year since the 1970s. Sales have all been limited to within and around the music industry. Mr Cooper states that a large number of goods bearing the trade mark have also been given away for promotional purposes through dealers in the UK and at music Trade Fairs. He goes on to

state that by an agreement effective from 24 December 1997, all goodwill and reputation in the stylised work "ORANGE" was assigned to this applicant company. I note that this was after the date of the application.

5 Mr Dines is an employee of Orange Musical and Electrical Company Limited (formerly known as Orange Musical Industries Limited) managing the manufacturing side of the company's business. He states that he also has had an on-going involvement in the retail side of the business.

10 Mr Dines states that the primary product range of the company consists of musical instruments and associated equipment used in connection with the performance and recording of music. The company has also made sales of other products including clothing, holdalls and belts. These have been sold and distributed in the UK since 1969 in the case of tee-shirts and carry bags and since 1970 for other items, although they ceased producing carry bags around 1990.

15 Mr Dines states that the goods concerned were originally sold and distributed through the company's dealer network in the music industry and at music Trade Fairs, although around 1995 the company set up a retail outlet called Gigwear Shop in London and since then the products have been sold and distributed from these premises. He says that the company has a
20 dealer network of around 100 dealers spread throughout the UK and that the items continue to be referred to as e.g. "Orange tee shirts" and "Orange caps" and so on. However, as I have already noted the applicant could not claim the benefit of this goodwill at the relevant date.

25 In addition to the formal evidence submitted, the agent drew my attention in later correspondence to the following points:

- The applicant is the proprietor of three registrations in which the word ORANGE is the predominant element in classes relevant to this application, namely:

30 1531626 - ORANGE GAL in Class 25 (assigned on 31 August 1999)
2051026 - THE DIFFERENCE IS ORANGE in Classes 18 and 25
2156326 - MISTER ORANGE in Classes 18 and 25

35 Consequently, the agent claims that these registrations show that the applicant is a prolific proprietor of "ORANGE" registrations in Classes 18 and 25, that these registrations should afford the applicant prior rights in an application such as this, comprising the word ORANGE.

40 - The applicants have had the trade mark the subject of this application accepted in the prima facie in the United Kingdom in other classes of goods and services. Consequently this application covering classes 18 and 25 should also be accepted.

45 **Acquired Distinctiveness: Decision on the Evidence**

When considering evidence of user it is important to bear in mind not only the facts in relation

to the market(s) but also the strength of the Section 3 objection. Here we have a composite mark consisting of the word "orange" in a square black box. The word is placed towards the bottom of the box. The identity of this mark is therefore carried by the word "orange" and the presentation is only apparent from a visual inspection of the mark.

5

Objection to the word "ORANGE" is strong in my view bearing in mind general consumer items such as these where colour can be an important part of the purchasing process. No one would see "orange" shirts as a trade mark for shirts even if it is, in fact, a mis-description. Consequently, the agent's offer to exclude orange coloured items was not felt to assist. Unless colour can be considered fanciful in relation to the goods concerned, it seems to me that the evidence must be sufficiently convincing to justify acceptance. The presentation of the word "orange" within the square box does not provide sufficient surplus in the mark to imbrue the mark with the distinctive character required under Section 3(1)(b) of the Act.

10

15

The evidence filed in this application does not prove the case for acceptance. The evidence refers to a different mark (i.e. the stylised word ORANGE) and the sales figures and market saturation are extremely limited bearing in mind the huge market in the UK for such general consumer items. Sales have been restricted to within music circles and sales from a retail outlet are restricted to the Gigwear Shop only, in London. Further, the applicant did not own the goodwill at the relevant date.

20

I conclude that the mark would not have been recognised as a badge of trade mark origin at the time the application was made.

25 In AD 2000 trade mark (1997) RPC 168, Mr 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 *Colourcoat Trade Mark* (1990) RPC 511 at 517 in the following terms:

30

"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 Work 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"".

40

Finally, I do not accept the Agent's argument that the application may proceed on prior rights with earlier registrations because these are for different marks altogether. The word "ORANGE" forms only a part of these marks in each case, and the proviso to Section 3 makes clear that a trade mark which is excluded from prima facie registration by Section 3(1)(b) to (d) may nevertheless be registered if:

45

"Before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it".

5 It appears to me therefore that the words "acquired a distinctive character as a result of the use made of it" should, in principle, be regarded as meaning the use made of the mark put forward for registration. There is no provision in the 1994 Act for acceptance because of "special circumstances"

10 In a similar vein, I am not persuaded to accept the application because of the agent's argument that the applicant company has built up a family of marks under the corporate brand logo for similar types of products. I bear in mind the comments of Mr Matthew Clark QC in the unreported decision of the GIBSON appeal (application number 2129557 dated 17 December 1999) where he said:

15 "While I think that Counsel for the applicants did accept that the question as to whether the proviso to Section 3 of the 1994 Act applies must turn on evidence of use, it appeared to me that at times his submissions were amounting almost to a legal proposition that, in certain situations, a non-distinctive mark may acquire a
20 distinctiveness in a relation to very different types of goods, emanating from the same source. If that was a correct understanding of the applicant's position then, in my view, it clearly goes too far, if it is meant to be a proposition of general application, which means that, in certain classes of cases, the necessary evidential basis for distinctiveness having been acquired can be foregone."

25 He went on in that decision to comment:

".....I consider that it is not sufficient, in a case such as the present, to say that, absent adequate evidence, an inference of distinctiveness can be drawn simply because of the distinctiveness of the mark or similar mark when used in relation to the
30 proprietor's other goods."

Conclusion

35 The mark is not acceptable in the prima facie because it is debarred from registration under Section 3(1)(b) of the Act.

The evidence filed to substantiate the claim that the mark has acquired a distinctive character is not sufficient to satisfy the proviso to Section 3(1)(b) of the Act

40 In this decision I have considered all the documents filed by the applicants and all the arguments submitted to me in relation to this application, and for the reasons given above, it is refused under the terms of Section 37(4) of the Act.

45 **Dated this 30 day of August 2000**

50 **Janet Folwell
For the Registrar
The Comptroller General**