

O-341-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2426167
BY MOONAGUE LIMITED
TO REGISTER THE TRADE MARK:**

WEATHER GUARD

IN CLASS 2

AND

**IN THE MATTER OF OPPOSITION NO 94981
BY IMPERIAL CHEMICAL INDUSTRIES PLC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2426167
By Moonague Limited
to register a trade mark in class 2**

and

**IN THE MATTER OF Opposition No 94981
By Imperial Chemical Industries PLC**

BACKGROUND

1. On 3 July 2006 Moonague Limited (“Moonague”) applied to register the words WEATHER GUARD as a trade mark in class 2. Registration was initially sought in respect of:

Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colourants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.

2. During the course of the proceedings Moonague limited its goods to “paint”; the opposition will be determined on this basis.

3. On 14 February 2007 Imperial Chemical Industries PLC (“ICI”) opposed the above application on grounds under sections 3(1)(b), 3(1)(c) and 3(1)(d) of the Trade Marks Act 1994 (“the Act”). In summary, ICI’s grounds are that the words WEATHER GUARD indicate a product that is designed to guard against the weather and that it is a sign that has become customary in the current language and the *bone fide* and established practices of the trade.

4. Moonague filed a counterstatement denying the grounds of opposition. Both sides filed evidence (this is summarised below) and the matter came to be heard before me on 22 October 2008. At the hearing, ICI were represented by Ms Victoria Wisener of ICI Group Intellectual Property; Moonague did not attend the hearing, instead, its trade mark attorney (Mr Timothy George Pendered of RGC Jenkins & Co) made written submissions.

EVIDENCE

ICI’s evidence

5. ICI’s evidence is given by Mr Walter Paul Johnston, Head of Intellectual Property and Group Trade Mark Counsel of ICI Paints (a division of ICI). Mr Johnston states that ICI is the proprietor of a number of trade mark registrations that use the prefix WEATHER, including the well known (in Mr Johnston’s view)

trade mark WEATHERSHIELD. He provides details of the WEATHERSHIELD registration in Exhibit WPJ1 – he notes that the registration was accepted on the basis that it had acquired a distinctive character through its use.

6. Mr Johnston states that ICI considered adopting the trade mark WEATHERGUARD in 2005, but his Trade Mark Group believed it to lack distinctive character and that it was descriptive. To be certain of this, ICI utilised the Patent Office's¹ Search and Advisory Service to provide an opinion on registrability. The report expressing this opinion is shown in Exhibit WPJ2, it is sufficient to say that the opinion supported ICI's view that the mark was lacking in distinctiveness and that it was descriptive. Exhibit WPJ2 also contains extracts from four web-sites, I will come back to this later.

7. Mr Johnston completes his evidence by referring to Exhibit WPJ3 which consists of various prints from the Internet search engine *Google*. The prints relate to a search for the words WEATHER GUARD. Mr Johnston states that the results show that the words are used extensively to describe a characteristic of a product, namely, that it is able to guard against the weather and it is this message that the mark communicates to customers.

Moonague's evidence

8. Moonague's evidence is given by its trade mark attorney, Mr Pendered of RGC Jenkins & Co. He begins by stating that the expression WEATHER GUARD is not recognised by current dictionaries; exhibited at TGP1 is a print from the online dictionary *OneLook* showing a nil return for the expression.

9. Mr Pendered then refers to his own *Google* search in relation to the expression WEATHER GUARD cross-referenced to the word PAINT. He states that although 187 hits were returned, most of these were irrelevant as they were not being used together in context or, because they relate to web-sites which are outside the UK. He notes that a number of hits relate to the use of the words by a company called *Johnstone*, but he states that this is use as a brand name.

10. Mr Pendered completes his evidence by referring to Exhibit TGP3 which consists of numerous UK trade mark registrations in class 2 which either begin with the word WEATHER or end with the word GUARD.

DECISION

11. The grounds of opposition are all sub sections of section 3(1) of the Act. All have full and independent scope². I will deal with them one by one, but will do so in reverse order. I should also add that because Moonague has filed no evidence

¹ Now the Intellectual Property Office ("IPO")

² See, by way of analogy, the decision of the High Court in *Have A Break* [2002] EWHC 2533(Ch)

to show that its mark has acquired a distinctive character through use, the proviso to sub section 3(1) has no part to play in my decision.

12. Before dealing with each of the grounds of opposition, I must comment on some of the evidence filed. ICI's evidence includes the details of its trade mark WEATHER SHIELD which, it highlights, required evidence of use to achieve registration. Furthermore, it refers to the Search and Advisory report that it commissioned in relation to the words WEATHER GUARD which confirmed its own view that the mark was not acceptable. I can see no relevance to this evidence. The fact that an earlier (and different) mark proceeded on the basis of acquired distinctiveness tells me little about the significance of the subject mark. Furthermore, the comments of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 should be borne in mind:

“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 to the Registrar to put the marks concerned on the Register. It has long been held that 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 e.g. *MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.”

13. I do not know the circumstances which led to the requirement to provide evidence of acquired distinctiveness. Nor do I know what led the Search and Advisory Service to give an adverse opinion in relation to the words WEATHER GUARD. I make the same observations in relation to Moonague's "state of the register" evidence where it highlights previous acceptances of WEATHER prefixed trade marks and GUARD suffixed trade marks.

Section 3(1)(d)

14. Section 3(1)(d) states that the following shall not be registered:

“trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade”.

15. I note the decision of Professor Annand (sitting as the Appointed Person) in *Stash* (BL O-281-04) where she stated:

“Mr. Malynicz made a second general criticism of the Opponent's evidence, including the survey, to the effect that it does not show use in trade. He argues that even if the Opponent's evidence does, as the Hearing Officer concluded, establish that the term “stash” has become widely used in rugby circles to indicate kit, particularly clothing, this is

insufficient to bar registration under section 3(1)(d) of the TMA. Although he acknowledges that in the light of recent ECJ case law consumer perception must be taken into account, Mr. Malynicz's submits that the concluding words of section 3(1)(d) qualify both the preceding phrases in that sub-paragraph, so that a mark must have become customary either "in the current language [*of the trade*]" or "in the *bona fide* and established practices of the trade" (emphasis in square brackets added).

30. I am unable to accept that argument. On my reading, there are two separate limbs of section 3(1)(d). A mark must be refused registration if, in relation to the goods or services applied for, it has become customary:

(a) in the current language; or

(b) in the *bona fide* and established practices of the trade.

It is clear from the proviso to section 3(1), that the general objection to marks which fall within section 3(1)(b) – (d) is that they are lacking in distinctive character (Case C-299/99 *Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd* [2002] ECR I-5475, para. 58). If the relevant public has come to view a sign in current language use as a generic name for the goods or services in question, then the objection is satisfied because the mark is *prima facie* lacking in distinctive character. An added requirement that the name must have become customary also in the current language of the trade is superfluous. I note that the District Court of The Hague, Civil Section D, expressed a similar view on parallel legislation in *Healing Herbs Limited v. Bach Flower Remedies Limited*, Case 02/244, 30 June 2004."

16. Although Professor Annand highlights that the "current language" test is not tied to a requirement that it be the "current language of the trade", this does not mean that the test for the current language goes beyond the goods sought to be registered. To this extent, I note the judgment of the European Court of Justice ("ECJ") in *Merz & Krell GmbH & Co.* (Case C-517/99) where it stated:

"29. The question whether particular signs or indications possess distinctive character cannot, however, be considered in the abstract and separately from the goods or services those signs or indications are intended to distinguish.

30. That finding is corroborated by Article 3(3) of the Directive. As the Court held at paragraph 44 of the judgment in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, it is through the use made of it that such a sign acquires the distinctive character which is a prerequisite for its registration under that provision. However, whether a

sign does have the capacity to distinguish as a result of the use made of it can only be assessed in relation to the goods or services covered by it.

31. It follows that Article 3(1)(d) of the Directive must be interpreted as only precluding registration of a trade mark where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought.”

17. Taking the above authorities into account, I must be satisfied that the word combination WEATHER GUARD is used to designate paint, be it in current language (presumably of anyone) or in the *bone fide* and established practices of the trade.

18. ICI have filed evidence to support its ground of opposition. Exhibit WPJ4 consists of a search report from the Internet search engine *Google*. A large number of hits have been generated in relation to a search conducted for the term WEATHER GUARD. The results total 1,480,000. Of these, the first 50 results have been filed in evidence. It should be noted that the results filed in evidence are the search results themselves, typically consisting of a few lines of text together with the URL of the web-site that *Google* has identified as being potentially relevant. The actual web-site content has not been provided. It is, therefore, not possible to accurately ascertain how the words are being used and the context of such use. There are further problems with this evidence. Firstly, it is clear that a large number of them relate to what I would describe as trade mark use, for example, the first entry is for “Weatherguard Windows and Conservatories”. The second problem is that the goods and services to which this *Google* report covers are many and varied, they include conservatories, clothing, camera equipment and roofing services; therefore, even if they were designating goods, they are not designating the relevant goods. The only “hits” with potential relevance are:

An entry headed “Speciality Paints and Adhesives” at (www.sdcoatings.co.uk) with the following text: “Weatherguard SB Stipple is a water based, high build, textured coating....”

An entry headed “Weatherguard 10 – Watco” at (www.watco.co.uk) for an anti-graffiti coating.

An entry headed “Leyland Paint from Towcester Building Supplies” at (www.tbsmerchants.co.uk) with the text “Weather Guard Exterior Gloss.”

19. The above extracts highlight the problem. Without seeing contextualised use on the actual web-site it is not possible to ascertain whether or not the use of the words WEATHER GUARD is as a designation of the relevant goods. It may be

that the uses represent use in a trade mark sense, and, indeed, it is possible that such uses relate to a single undertakings product. In summary, this evidence cannot be relied upon to demonstrate the requirements necessary for this ground of opposition.

20. Further evidence is provided in Exhibit WPJ2. The first is an extract from the web-site of *The Guardian* newspaper (www.guardian.co.uk), the extract is from an article (the copyright statement is from the year 2005) relating to ship owners and it contains the following text:

“Environmentalists argue that the rusting hulks at Alang contain health hazards such as asbestos and tributyltin, used as a weather-guard in ship paint”

21. Also supplied is an extract from the web-site of *Macksons Paint Industries*, however, there is no use of the words WEATHER GUARD at all in this extract so this does not assist. There is a further extract (carrying a date of June 2005) from the website www.cardiff.gov.uk which appears to relate to local planning rules. It contains the following text:

“Original clay pots should be retained where they are structurally sound. A proprietary weather-guard can retain ventilation and discourage damp through to the chimney breast”

22. The final extract is from “[your car parts.co.uk](http://yourcarparts.co.uk)” which carries the following text in relation to the sale of masonry paint:

“A water borne smooth sheen finish based on acrylic resin. Excellent covering power with long lasting protection to all exterior substrates, guarding against weather damage”

23. Of the four extracts contained in WPJ2, only two (the *Guardian* extract and the Cardiff planning extract) refer to the word combination WEATHER GUARD. Success under section 3(1)(d) requires a finding that the sign has become “customary”. In the *Stash* case, Professor Annand stated:

“33. In the event, I do not believe this issue of the interpretation of section 3(1)(d) is central to the outcome of the appeal. “Customary” is defined in the Oxford English Reference Dictionary, 1995 as: “usual; in accordance with custom”. In my judgment, the Opponent has failed on the evidence to prove that at the relevant date STASH contravened section 3(1)(d) as consisting exclusively of signs or indications which have become customary either in the current language or in trade practices for the goods concerned.”

24. Neither of the two examples can be said to be use within the practices of the trade. Nevertheless, the first example is use in language as a designation of paint (or at least a constituent of paint) and the second is used in language in relation to something applied to a chimney. However, it is not clear whether this second extract relates to paint or to something else; it strikes me more as a reference to a device for keeping rain etc. out of the chimney whilst retaining ventilation. Irrespective of the reliability of the second reference, I cannot accept that these two examples prove that the sign is customarily used. **The ground of opposition under section 3(1)(d), therefore, fails.**

Section 3(1)(c)

25. Section 3(1)(c) states that the following shall not be registered:

“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 services, or other characteristics of goods or services”

26. The ECJ has dealt with the purpose and scope of section 3(1)(c) on a number of occasions. A helpful summary of the position was given in *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-191/01 P, where it was stated³:

“32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

27. I also take into account the decision of the ECJ in *Postkantoor* (Case C-363/99) which considered the registrability of combinations of descriptive words. Paragraphs 98 – 100 of the judgment are reproduced below:

“98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular

³ The judgment was in relation to the analogous provision of Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation).

as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark.

100. Thus, 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 for the purposes of Article 3(1)(c) of the Directive, 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.”

28. Both the words WEATHER and GUARD are known English words. I am content to adopt the opponent’s definitions as given in its statements of grounds and repeated in Ms Wisener’s skeleton argument:

“The words “weather” and guard” have well-known meanings in the English language. Specifically, “weather” means the state of the atmosphere at a particular place and time as regards heat, cloudiness, dryness, sunshine, wind, rain etc. and “guard” is to protect against harm of damage”

29. Taking into account both sides’ submissions, the dispute centres on whether the words are descriptive or are merely suggestive. This strikes me as an accurate assessment of the question that needs to be addressed because the mark is, at the least, suggestive. I say this because, as ICI submit, the ability for paint, particularly exterior paint, to be able to provide protection against the weather is likely to be a desirable characteristic of which traders will no doubt wish to inform its customers. To that extent, it seems to me that the words WEATHER and GUARD could, in certain circumstances, be used to provide such

a description. The evidence from “your car parts.co.uk” describes the product as “guarding against weather damage”. This seems to me to be a normal use of language and I would have the same reaction to seeing the words “guard against weather damage”.

30. However, the matter turns not on whether the words can be used in some other combination or construction, but whether the combination WEATHER GUARD is a descriptive term in its own right. On this, Moonague submits that the combination of words suggests a physical barrier that provides shelter against the rain, but when applied to paint, which is liquid in nature, the reference is oblique and, essentially, fanciful. ICI, on the other hand, consider that such a reference (in the manner described by Moonague) is not fanciful given that paint, when it dries, is no longer liquid and that it can act as a guard or barrier to the weather. ICI consider the mark to be descriptive for another reason, I will return to this shortly.

31. As far as the potential for the word GUARD to be seen as a physical guard is concerned, there are clear and obvious examples of physical objects that have a guarding function. For example, a “fire guard” is a well known device which guards against the dangers inherent in a fire. To that extent, I can see the argument that the words WEATHER GUARD may be apt to describe a physical object that prevents the ingress of meteorological elements. For example, if at the bottom of an external door a device was attached to prevent the ingress of rain or snow, that could, perhaps, be referred to as a weather guard, the physical object being the guard in question. But, can this apply to paint? I understand ICI’s submission that paint, when dried, has a physicality that could, arguably, be a physical guard. However, in my view, the use of the word GUARD in this manner would normally point to some form of object or device and I find it difficult to imagine that paint, even when dry, would be described as a physical guard; this would not fit in with the normal uses of the word in this sense.

32. ICI’s further argument is that the mark represents simple use of language as a description that the goods provide protection against the harmful effects of the weather. The word GUARD in this respect is not, therefore, a physical object, but is operating more as an explanation of the intended purpose of the goods. The point is exemplified in Ms Wisener’s skeleton argument for ICI when she states:

“The ability to act as a weather guard is an essential function of any exterior paint”

33. I note that there is at least one piece of evidence (the extract from the *Guardian*) which uses the words weather guard in this context. But, there are a number of other factors to consider. Firstly, it is not the weather *per se* that is being guarded against, but instead the harmful effects of the weather. Of more significance is the construction of the word combination. I have already accepted that the word GUARD may be capable of use in conjunction with the word

WEATHER, but natural use of language, in terms of describing function, would be “to guard against...” an adverse effect. This ties in with ICI’s definition in its pleadings “to protect against harm and damage”.

34. It seems to me that use of the word GUARD directly following the adverse effect which is being guarded against is not an ordinary use of language other than to refer to a physical object (a physical guard) or perhaps to someone who watches over (or guards) something. I have already dealt with the former proposition, in terms of the latter, whilst it could be argued that someone watching over something may be a concept utilised in relation to goods in a metaphorical sense (the goods performing the watch), use in this nature is not one that I can say other traders may require as a legitimate description for paint. Therefore, I am left with the view that whilst the words are suggestive, they do create the unusual combination as to syntax or meaning set out by the ECJ in *Postkantoor*.

35. I have considered the evidence, but as already stated, little can be taken from it to support the view that the word combination and its particular construction is apt for descriptive purposes. Taking all the factors into account, it is my view that the combination of the words WEATHER GUARD does not lend itself to descriptive use in relation to paint. Furthermore, the use of this combination, and the suggestive message that it creates, meets the test outlined in case-law such as *Postkantoor* in that it is more than the sum of its parts. **The ground of opposition under section 3(1)(c), therefore, fails.**

Section 3(1)(b)

36. Section 3(1)(b) states that the following shall not be registered:

“trade marks which are devoid of any distinctive character”

37. The test to be applied under this ground has been dealt with by the ECJ in a number of its judgments, notably in Joined Cases C-53/01 to C- 55/01 *Linde AG, Winward Industries Inc and Rado Uhren AG* (8 April 2003). The test equates to assessing the impact that the sign will have on the average consumer when used in relation to the goods at issue and then deciding whether they (the average consumer) will regard the sign as something that is identifying to their goods originating from a particular undertaking.

38. At the hearing, I asked Ms Wisener whether the ground of opposition under section 3(1)(b), despite having independent scope, was tied to the descriptiveness of the mark under section 3(1)(c), and, therefore, in the event that I dismissed the opposition under section 3(1)(c), whether ICI were in a better or different position under section 3(1)(b). Ms Wisener's answer was that irrespective of an adverse finding under section 3(1)(c), ICI's view was that the mark was devoid of distinctive character because it was not the sort of sign that

the average consumer would see, upon first impression, as a sign indicating trade origin; she described the sign as being origin neutral⁴.

39. In the recent decision of the CFI in *Imperial Chemical Industries plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 224/07 it was stated:

“20 According to the case-law, registration of a trade mark which consists of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark is not excluded as such by virtue of such use. A sign which fulfils functions other than that of a trade mark in the traditional sense of the term is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94, however, if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those which have a different commercial origin (LIVE RICHLI, paragraph 67).

21 For a finding that there is no distinctive character, it is sufficient that the semantic content of the word mark in question indicate to the consumer a characteristic of the goods or service which, whilst not specific, represents promotional or advertising information which the relevant public will perceive first and foremost as such, rather than as an indication of the commercial origin of the goods or service (REAL PEOPLE, REAL SOLUTIONS, paragraphs 29 and 30, and Case T-128/07 *Suez v OHIM* (Delivering the essentials of life), not published in ECR, paragraph 20).”

40. Ms Wisener’s submissions focussed on the fact that the words WEATHER GUARD are descriptive and, therefore, could not convey a message of trade origin. She also argued that there was nothing fanciful or inventive about the word combination that would strike the consumer as sending to them a message of trade origin. Whilst I understand the submission, I have already held that the mark is not descriptive and, therefore, I cannot uphold the opposition on the ground that it lacks a capacity to distinguish because it is a description. Neither does lack of imagination constitute a valid ground for refusal⁵. It is, nevertheless, clear from the statement in the authority I have quoted above that a trade mark should be refused registration if it provides promotional or advertising information or, for some other reason, that it is not perceived immediately as an indication of the commercial origin of the goods. However, it is my view that whilst a suggestive message will be seen by the consumer, there is no reason why it will not be seen as trade origin specific – it is not a message that simply advertises or

⁴ A reference to the mark not specifying the origin of the goods (see the decision of Mr Hobbs QC sitting as the Appointed Person in *Cycling is* (BL O/561/01))

⁵ See, for example, the judgment of the CFI in *DAS PRINZIP DER BEQUEMLICHKEIT* (Case T-138/00)

promotes the goods in question. **The ground of opposition under section 3(1)(b), therefore, fails.**

COSTS

41. Moonague has been successful and is entitled to a contribution towards its costs. I hereby order Imperial Chemical Industries Plc to pay Moonague Limited the sum of £1250. This sum is calculated as follows:

Considering notice of opposition	£200
Preparing and filing counterstatement	£300
Considering ICI's evidence	£150
Filing evidence	£300
Preparing and filing written submissions	£300
Total	£1250

42. The above sum should 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 23rd day of December 2008

**Oliver Morris
For the Registrar
The Comptroller-General**