

TRADE MARKS ACT 1994

IN THE MATTER OF:

APPLICATION No. 83621

IN THE NAME OF ORGANIC ABSORBENTS LTD

FOR A DECLARATION OF INVALIDITY

IN RELATION TO REGISTERED TRADE MARK No. 2506380

IN THE NAME OF LESS MESS LTD

DECISION

1. The signs **FAT TRAP** and **Fat Trap** were registered in the name of Less Mess Ltd on 12 June 2009, with effect from 14 January 2009, as a series of two trade marks for use in relation to *'containers for kitchen and household use; containers for the collection and disposal of fats, greases and oils'* in Class 21.

2. On 3 November 2009, Organic Absorbents Ltd applied for a declaration to the effect that the trade marks were and remained invalidly registered in breach of Sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994.

3. Section 3(1)(b) prevents registration of *'trade marks which are devoid of any distinctive character'*. Section 3(1)(c) prevents registration of *'trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, intended purpose, value, geographical origin, the time of production of goods or*

of rendering of services, or other characteristics of goods or services'. The corresponding provisions of the Trade Marks Directive (Directive 2008/95/EC of 22 October 2008) and the Community Trade Mark Regulation (Council Regulation 207/2009/EC of 26 February 2009) are Articles 3(1)(b) and 3(1)(c) and Articles 7(1)(b) and 7(1)(c) respectively.

4. The objections to validity were put forward on the ground that the designations were descriptive, hence non-distinctive, as a result of their propensity to be used and understood simply as indications that the containers to which they referred were designed or adapted to trap fat.

5. The registered proprietor joined issue with the applicant on these objections to validity in a defence and counterstatement filed on 11 January 2010. It maintained that **FAT TRAP** was a '*unique and fanciful expression*' which was '*merely allusive of the proprietor's goods*' and the fact that it alluded to '*certain features of the proprietor's goods*' was insufficient to render it invalid for descriptiveness or lack of distinctiveness. I note that the defence and counterstatement raised no claim for registrability on the ground of distinctiveness acquired through use under the proviso to Section 47(1) of the Act.

6. The application for invalidity was rejected for the reasons given by Mr. Oliver Morris acting on behalf of the Registrar of Trade Marks in a written decision issued under reference BL O-427-10 on 13 December 2010. He ordered the applicant to pay £1,300 to the registered proprietor as a contribution towards its costs of the registry proceedings.

7. The Hearing Officer referred to the registered proprietor as 'LM'. He noted that at the hearing before him the registered proprietor had adopted the position that '*the words*

FAT TRAP may constitute a descriptive combination for some goods but that this was not the case for simple containers such as LM's product' (paragraph 28). He then proceeded to test the rival contentions of the parties with regard to descriptiveness and distinctiveness by reference to the use of the expression **FAT TRAP** in relation to the registered proprietor's own commercial product as shown and discussed in the evidence on file.

8. In approaching the matter from that perspective, he noted that '*LM's product is a container, its specification clearly says so. Furthermore the purpose of the product can clearly be said to enable a person to collect their used cooking fat in it for future disposal*' (paragraph 30). However, he considered that '*Whilst LM's product is a container for fat, it is, in my view, far-fetched to say that the container is trapping the fat inside – the fat is hardly attempting to get out. Fat is poured into it and the lid is put on to prevent it from being spilled if accidentally knocked – this would never be categorised as trapping*' (paragraph 30). On the basis that '*something which is merely a container is hardly likely to function as a trap*' he declined to accept that conventional uses of the word 'trap' were apposite: '*All of these uses are clear and understandable but, for LM's product, I do not consider it apt for it to be considered as a trap or that it is something which traps*' (paragraph 31). With regard to the evidence before him, he said: '*Indeed I have struggled to find any of the promotional materials or articles relating to LM's product as suggesting that the container traps fat or acts as a trap*' (paragraph 34).

9. The closest that the Hearing Officer came to assessing the validity of the registration across the spectrum of goods embraced by the wording of the contested specification in Class 21 was in paragraphs 36 and 37 of his decision:

36) There is, of course, the argument as to perception. The matter must be considered against the perception of the relevant parties (the trade and the public). OA argue that as water companies, for example, use and will know of the words fat trap as a description (presumably they will be aware of grease separator systems) then, when seeing such words on a container for fat, such use will simply send a descriptive message. I note the argument, but in my view the relevant parties will be able to distinguish between what may be known descriptively as a fat trap and what will be seen as a different product. It is my view that the words FAT TRAP will be perceived as allusive, but not a directly descriptive combination of words for the goods of the registration.

37) I must also have regard to the fact that whilst the exact product (or a characteristic of it) sold by LM may not be described as a fat trap, other types of container in class 21 may have a more trapping quality. I have considered this aspect, but a container is a container. There is nothing in the specification that would indicate a more active trapping quality. The fat separator systems, for example, are quite distinct products and would never be described as containers. They would, in any event, fall in a different class. The other types of product shown in the evidence would not, similarly, be considered as a container. I see no reason to find that a container in class 21 will have any more a fat trapping characteristic than LMs container and, therefore, for the reasons given, consider that the words FAT TRAP are not descriptive of the goods in question.

10. The claim for invalidity on the grounds of descriptiveness and lack of distinctiveness was rejected without reference to any assessment of distinctiveness acquired through use.

11. The applicant for invalidity appealed to an Appointed Person under Section 76 of the 1994 Act contending that the Hearing Officer's decision should be reversed on the grounds that:

1. The term "FAT TRAP" designates containers for trapping fat, greases and oils. As such, it is wholly descriptive of the goods.

2. “TRAP” is a term which includes, as a normal meaning, a container or a device used to collect a specified thing.

3. The term FAT TRAP has been adopted for fat collecting containers by other parties, independently of the Proprietor, and both before and after the adoption of the term by the Proprietor.

4. The term FAT TRAP is used in a purely descriptive sense by other parties in connection with containers for collecting fat.

12. By not serving a respondent’s notice under Rules 71(4) to (6) of the Trade Marks Rules 2008, the registered proprietor effectively chose to proceed on the basis that the Hearing Officer’s decision was correct for the reasons he had given. For the purposes of the present appeal, no claim to distinctiveness acquired through use is open to the registered proprietor either on the basis of its pleadings at first instance or by reference to any conclusions reached by the Hearing Officer in the course of the decision under appeal.

13. At first instance and on appeal the registered proprietor maintained that its registration was valid for all goods of the kind specified, that is to say ‘*containers for kitchen and household use; containers for the collection and disposal of fats, greases and oils*’ classifiable in Class 21 at the date with effect from which the relevant request for registration was made (see Altecnic Ltd’s Trade Mark Application [2001] EWCA Civ 1928; [2002] RPC 34 at paragraph [42] per Mummery L.J, with whom Kennedy and Sedley L.JJ agreed) whether or not they possessed features which might have made it additionally appropriate to include them in another class (see paragraphs [71] and [72] of the judgment of Arnold J. in Omega Engineering Incorporated v. Omega SA [2010])

EWHC 1211 (Ch); [2010] ETMR 49, which were not called into question in the subsequent judgment of the Court of Appeal in Omega SA v. Omega Engineering Incorporated [2011] EWCA Civ 645; [2011] ETMR 40).

14. It does not appear from the Hearing Officer's decision that he addressed the scope of the specification with a view to examining the range and variety of container configurations that were apt to be embraced by the language in which it was expressed. The scope of the specification was therefore discussed at some length at the hearing before me. In response to my request for further submissions in writing, the applicant for invalidity adopted the position that although '*containers for kitchen and household use*' are apt to be containers of the kind covered by Class 21, the registered proprietor had specified '*containers for the collection and disposal of fats greases and oils*' in general terms and therefore without limitation to containers classifiable in Class 21. The registered proprietor simply observed that '*the mark FAT TRAP is registered in Class 21 of the Trade Marks Classification System, which covers, inter alia, "Household or kitchen utensils and containers (not of precious metal or coated therewith)"*.' Neither party took the opportunity to address my concern that the relevant objections to validity could not properly be determined without a wider and deeper analysis than the Hearing Officer had undertaken in relation to the coverage of the registration in issue.

15. This was not a minor concern. In paragraph [32] of his decision, the Hearing Officer recognised that pouches or mats designed to be used during or after cooking in order to soak up fat could aptly be described as trapping fat. He nevertheless thought that the same could not be said of a simple container as exemplified by the registered proprietor's commercial product. However, it emerged at the hearing before me that the

registered proprietor's **FAT TRAP** products include plastic cylindrical containers provided with a removable **FAT BAG** insert which absorbs the fats, oils and greases poured into the container and enables the waste to be easily and safely disposed of. The designation **FAT BAG** was registered under number 2533451 with effect from 2 December 2009 as a trade mark belonging to a third party for use in relation to 'Absorbent and/or adsorbent material contained within a non-selective permeable cloth or membrane for the purpose of absorbing and/or adsorbing fats, oils and grease, and other liquids' in Class 1.

16. The **FAT BAG** inserts appear to be functionally equivalent to the **FAT TRAP** disposable pouches for absorbing fats, oils and greases which the applicant for invalidity was shown to have been marketing in the United Kingdom since 2006. However, when it applied under number 2426728 on 10 July 2006 to register **FAT TRAP** as a trade mark in relation to materials '*to be used for the absorption of fat and grease, paint, oils, mild acids, body fluids*' in Class 1 the Registrar objected to the application under Sections 3(1)(b) and (c) on the ground that the words consisted exclusively of a sign which may serve in trade to designate the kind and intended purpose of the goods e.g. materials for trapping fat. The application for registration was either withdrawn or allowed to lapse in the face of that objection.

17. More broadly, the evidence on file indicates that the designation **FAT TRAP** is used and understood as a synonym for the designation **GREASE TRAP** in relation to interceptors fitted to domestic and commercial drainage systems.

18. Having regard to the position of the registered proprietor as noted in paragraph [13] above and also to the matters I have referred to in paragraphs [15] to [17] above, I think it is clear that the Hearing Officer oversimplified the required approach to assessment in paragraph [37] of his decision, where he said: *'... whilst the exact product (or a characteristic of it) sold by LM may not be described as a fat trap, other types of container in Class 21 may have a more trapping quality. I have considered this aspect, but a container is a container. There is nothing in the specification that would indicate a more active trapping quality ... I see no reason to find that a container in Class 21 will have any more [of] of a fat trapping characteristic than LM's container ...'*

19. In order to resolve the objections to registration under Sections 3(1)(b) and (c), it was necessary (for the reasons discussed at greater length in my decision in NMSI Trading Ltd's Trade Mark Application BL O-313-11; 31 August 2011) to grapple with the following propositions:

- (1) The registrability of the signs had to be assessed in context first, by reference to the goods in respect of which registration had been applied for and second, by reference to the relevant public's perception of the sign **FAT TRAP** in that connection.
- (2) In accordance with Article 13 of the Trade Marks Directive, the assessment had to be made with reference to each discrete category of goods covered by the wording of the registration.

- (3) If and to the extent that the wording encompassed goods in Class 21 within the scope of a well-founded objection to registration, it had to be narrowed sufficiently by amendment to overcome the objection or else struck out.
- (4) As part of the process of determining whether the wording encompassed goods within the scope of a well-founded objection, it was necessary to have in mind the characteristics that goods of the kind specified in Class 21 might optionally be designed or adapted to possess.
- (5) If it was reasonable to believe that the sign **FAT TRAP** would actually be recognised by the relevant class of persons as a reference to the possession of such characteristics, there would be a well-founded objection to registration which the registered proprietor needed to overcome by amendment if it could.

20. These propositions do not appear to me to have been fully confronted in the decision under appeal and unfortunately I do not think the stage has yet been reached at which I could fully confront them in a decision delivered on appeal under Section 76 of the Act without usurping the role reserved to the Registrar in the first instance. If I embarked on a process of decision taking which ought to have been undertaken by the Registrar, I would effectively be depriving the parties of one of the levels of adjudication built into the two-tier framework which Section 76(4) is intended to maintain. That would be particularly inappropriate in circumstances where ‘any question arising as to the class within which any goods ... fall’ is a matter which must be determined by the Registrar in accordance with the provisions of Section 34(2) of the 1994 Act.

21. For these reasons, I have come to the conclusion that the Hearing Officer's decision and his order as to costs should be set aside and that the application for a declaration of invalidity should be remitted to the Registrar for determination by a different hearing officer. The application should then proceed upon the footing that the evidence is complete and the case is ready for hearing, subject to the outcome of any application for permission to adduce further evidence which either party might propose to make. The costs of the present appeal are to be treated as costs incurred in connection with the proceedings in the Registry. The question of how and by whom the costs incurred in connection with the proceedings in the Registry are to be borne and paid is reserved for determined by the Registrar at the conclusion of those proceedings.

Geoffrey Hobbs Q.C.

19 October 2011

Michael Harrison of Messrs Pemberton Reid appeared on behalf of the Applicant for Invalidity.

Michael Brown of Messrs Alpha and Omega appeared on behalf of the Registered Proprietor.

The Registrar was not represented.