

O-367-06

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 2371979 IN THE NAME OF BOSTIK LIMITED
TO REGISTER A TRADE MARK IN CLASSES 1 AND 16**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 93242 IN THE NAME OF
HENKEL KGAA**

Trade Marks Act 1994

**IN THE MATTER OF Trade Mark application No. 2371979
in the name of Bostik Limited
to register a trade mark in Classes 1 and 16**

And

**IN THE MATTER OF opposition thereto
under No. 93242
in the name of Henkel KgaA**

BACKGROUND

1. On 1 September 2004, Bostik Findley Limited made an application under No. 2371979, to register the trade mark HYP A GLUE in Classes 1 and 16, in relation to the following specifications of goods:

Class 1 Adhesives; adhesive preparations, substances, materials and coatings; preparations for sealing; hardening preparations, solvents, resins; chemical preparations for sealing; bonding agents for admixture with grouts; chemical sealing grout for use in the building and construction industry; mixtures of resin and filler for use as a grout.

Class 16 Adhesives; glues; paste; gums; adhesive preparations, substances and materials; sealing preparations and compounds.

The application now stands in the name of Bostik Limited.

2. On 3 March 2005, Henkel KgaA filed notice of opposition to the application, the grounds of opposition being as follows:

1. Under Section 3(1)(a) because the word HYP A is conceptually and phonetically identical to the word HYPER which is typically used in the English language as a prefix or noun or verb to indicate that something is “super” (ie, higher quality), “over” “above” or “more than normal” and is a laudatory term. The word “GLUE” acts either as a noun or a verb meaning an adhesive or to cause one item to adhere to another, the mark as a whole indicating that the goods specified in the application are stronger than other products available on the market.

2. Under Section 3(1)(b) because the mark is devoid of distinctive character.

3. Under Section 3(1)(c) because the mark consists of signs or indications which may serve, in trade, to designate characteristics of the goods for which it is sought to be registered.

4. Under Section 3(1)(d) because the mark is consists exclusively of signs or indications which have or are likely to become customary in the current language and bona fide established practices of the trade.

3. The applicants filed a counterstatement in which they deny the ground on which the opposition is based.

4. Both sides ask that an award of costs be made in their favour.

5. Both sides filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. The matter came to be heard on 22 August 2006, when the Applicants were represented by Miss Anna Edward-Stuart of Counsel instructed by Murgitroyd & Co the applicants' trade mark attorneys. The Opponents were represented by Mr Doug McCall of W P Thompson & Co.

Opponents' evidence

6. This consists of a Witness Statement dated 18 August 2005, from Rigel Ross McGrath, a trade mark attorney with W.P. Thompson & Co.

7. At Exhibits RMM1 and RMM2, Ms McGrath provides extracts from various dictionaries relating to references for the words HYPER, which she says shows that the term is both laudatory and descriptive. Exhibit RMM3 consists of extracts from the written and electronic media, which Ms McGrath says shows the term is commonly used. Ms McGrath further submits that the public is aware of the replacement of the word "super" with "HYPER". Exhibit RMM4 consists of a further dictionary extract referring to the word HYPERMARKET. Exhibit RMM5 consists of an internet search for HYPER GLUE, Ms McGrath drawing attention to the search engine having asked whether she had intended to search for "super glue". Ms McGrath concludes her Statement by summarising the evidence, and asserting that it shows hyper is commonly used as a laudatory term in combination with a great variety of nouns verbs, adjectives, etc, indicating that the public "interprets" the word as a laudatory term.

Applicants' evidence

8. This consists of a Witness Statement dated 17 January 2006, from Emma Christina Anne Hodson, a Trade Mark attorney employed by Murgitroyd & Company.

9. Ms Hodson's Statement consists of submissions on the substance and evidential value of the evidence provided by the opponents, supported by Exhibit ECAH1, which consists of details of "HYPER" cases extracted from the UK register. This being the case, it is not necessary or appropriate that I summarise this Statement as evidence. I will, of course

consider and take into account these submissions in my determination of this case.

Opponents' evidence in reply

10. This consists of a Witness Statement dated 19 April 2006, from Rigel Ross McGrath, which, not unusually for evidence filed in reply, consists of submissions in response to the arguments made by the applicants in their evidence. Ms McGrath also provides Exhibits RMM (B)1 to RMM (B)4, which are copies of exhibits provided with her first Witness Statement. It is neither necessary or appropriate that I summarise this Statement as evidence, but I will consider and take into account these submissions in my determination of this case.

11. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

DECISION

12. Section 3(1) of the Act states:

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

- (a) signs which do not satisfy the requirements of section 1(1),
- (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,
- (d) 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:

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.”

13. The applicant has filed no evidence of any use of the trade mark so cannot rely on the proviso to section 3(1).

Section 3(1)(a)

14. Although opposition has been filed under each of the subsections of the Act, it is clear that the distinctiveness objection under section 3(1)(a) stands or falls together with the objections under sections 3(1)(b) and (c). (See *Philips v Remington* [2003] RPC 2 (at page 23)). I therefore say no more about it.

Section 3(1)(d) of the Act

15. The European Court of Justice (ECJ) in *Merz & Krell GmbH & Co* (C-517/99) [2002]

ETMR 21 stated:

“41. It follows that Article 3(1)(d) of the Directive must be interpreted as meaning that it subjects refusal to register a trade mark to the sole condition that the signs or indications of which the trade 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. It is immaterial, when that provision is applied, whether the signs or indications in question describe the properties or characteristics of those goods or services.”

16. The CFI also considered the issue in *Alcon Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-237/01 [2004] ETMR*. Having referred to the *Merz & Krell* case above it went on to say:

“Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services and, secondly, on the basis of the target public’s perception of the sign.”

17. As set out above, the evidence consists primarily of extracts from various dictionaries along with various internet printouts showing use of the word hyper. The opponents claim that the word hypa is phonetically identical to the word hyper and that it is a laudatory word. The printouts, not all of which date from a period before the relevant date, refer to a range of topics from Saharan reptiles to the child rearing practices of middle class American parents. Where the printouts predate the relevant date, they show use of the word hyper both as an adjective and as a prefix. In some instances the word is placed within inverted commas. In most cases, use of the mark is confined to a single instance and none make any reference to areas of trade in any way connected with the specification of goods which the application in suit seeks to protect. Taken as a whole, the evidence filed does not show that HYP A GLUE is a sign that has become customary in the current language or in the bona fide and established practices of the trade in relation to the goods of the application. I therefore dismiss the ground of opposition under section 3(1)(d) of the Act.

Section 3(1)(c) of the Act

18. The issues underlying section 3(1)(c) of the Act were subject of much consideration by the ECJ in the case of *Koninklijke PN Neverland NV v Benelux Merkenbureau Case C-363/99 [2004] ETMR 57*. It stated:

“56. In those circumstances, the competent authority must, under Article 3(1)(c) of the Directive, determine whether a trade mark for which registration is sought currently represents, in the mind of the relevant class of persons, a description of the characteristics of the goods or services concerned or whether it is reasonable to assume that that might be the case in the future (see to that effect *Windsurfing Chiemsee*, paragraph 31). If, at the end of that assessment, the competent authority reaches the conclusion that that is the case, it must refuse, on the basis of that provision, to register the mark.

57. It is irrelevant whether there are other, more usual, signs or indications for designating the same characteristics of the goods or services referred to in the application for registration than those of which the mark concerned consists. Although Article 3(1)(c) of the Directive provides that, if the ground for refusal set out there is to apply, the mark must consist exclusively of signs or indications which may serve to designate characteristics of the goods or services concerned, it does not require that those signs or indications should be the only way of designating such characteristics.

58. Similarly, whether the number of competitors who may have an interest in using the signs or indications of which the mark consists is large or small, is not decisive. Any operator at present offering, as well as any operator who might in the future offer goods or services which compete with those in respect of which registration is sought must be able freely to use the signs or indication which may serve to describe characteristics of it goods or services...

97. It is not necessary that the signs and indications composing the mark that are referred to in Article 3(1)(c) of the Directive 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 those signs and indication could be used for such purposes. A word 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 (see to that effect, in relation to the identical provisions of Article 7(1)(c) of Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p.1), Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-000, paragraph 32).

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 as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indication 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 impressions 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 must as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark.”.

19. The mark consists of the two words HYP A and GLUE. The word glue needs no explanation. I am not aware of HYP A having its own meaning. As indicated above, the opponents claim that HYP A is phonetically identical to the word HYPER and its evidence includes dictionary and electronic media references which do not define the word HYP A but

which show the word HYPER to have a number of meanings, the definition differing depending on whether the word is used as a prefix or in an adjectival sense. Appearing as it does as a separate, unhyphenated word within the mark tends towards adjectival use. HYPER as an adjective is said to mean overactive, overexcited or overwrought. Ms McGrath submitted that the public is aware of the use of the word HYPER as a replacement for the word SUPER. Despite the inclusion of an exhibit showing the results of an internet search (a search which took place after the relevant date in these proceedings). The only evidence that I can see that goes to establishing that HYPER and SUPER are interchangeable can be found at Exhibit RMM5. This consists of details from a search conducted on the Internet for HYPER GLUE and shows that the search engine asked whether the searcher had meant SUPER GLUE. This could be an indication that HYPER and SUPER are synonyms but could just as easily have been brought about by the search engine being programmed to suggest more common search terms where GLUE is preceded by any word: I do not know one way or the other. Certainly there is nothing in any of the evidence to support the opponents' claim that the mark indicates that the goods are stronger than other products available or of a higher quality. The use of the word HYP A may be intended to allude in some way to certain properties of the goods at issue being in excess of the norm but that does not make it descriptive. There is nothing in the evidence to suggest that HYP A GLUE is a sign which should remain freely available for use by others in the trade.

20. In *Henkel KGaA v Deutsches Patent und Markenamt* C-218/01 the ECJ identified the essential purpose of a trade mark. It said:

“30. As in the case of every other mark, the sign of which registration is applied for must fulfil the mark's essential function which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For a trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality.”

21. I can see no reason why the trade mark HYP A GLUE should not fulfil the essential function of a trade mark. For the reasons given above I consider it is neither descriptive of the goods nor of a characteristic of them. The opposition under section 3(1)(c) fails.

Section 3(1)(b) of the Act.

22. The ECJ has provided clarification of the meaning of the term “devoid of any distinctive character” in Article 3(1)(b) of the Directive (from which section 3(1)(b) of the Act is derived), in *Philips v Remington* [2003] RPC 2 at paragraph 35 and reiterated its position in the later judgment of *Linde AG v Deutsches Patent und Markenamt* [2003] RPC 45 where it stated:

“40. For a mark to possess distinctive character within the meaning of that provision, it must service 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”.

23. At the date of application, which is the date on which this matter must be judged, I can see no grounds for holding that the mark lacked distinctive character for the goods for which registration is sought. There is nothing in the evidence nor have I heard submissions which satisfactorily explain why the mark could not distinguish those goods. The opposition under section 3(1)(b) fails.

24. The opposition has failed on all grounds.

Costs

25. The opposition having failed, the applicants are entitled to a contribution towards their costs. I therefore order that the opponents pay the applicants the sum of £1300 towards their costs. This sum to 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 14th day of December 2006

**Mike Foley
For the Registrar
The Comptroller-General**