

O-423-10

TRADE MARKS ACT 1994

IN THE MATTER OF  
REGISTRATION NO 2293424B  
IN THE NAME OF  
CLARKE INTERNATIONAL LIMITED  
OF THE TRADE MARK:

**JUMP  
START**

IN CLASS 9

AND

THE APPLICATION FOR A DECLARATION  
OF INVALIDITY THERETO  
UNDER NO 83644

BY

UK HOME SHOPPING LIMITED

Trade Marks Act 1994

In the matter of registration no 2293424B  
in the name of  
Clarke International Limited  
of the trade mark:

**JUMP  
START**

in class 9  
and the application for a declaration of invalidity  
thereto under no 83644  
by UK Home Shopping Limited

**INTRODUCTION**

1) On 21 February 2002 Clarke International Limited (Clarke) applied for the registration of a series of 7 trade marks. These were for the trade mark above and the trade marks:



At the examination stage an objection was raised under section 41(2) of the Trade Marks Act 1994 (the Act), as it was not considered that all of the trade marks formed a series. As a result, the application was divided into two scions of the original application. This registration is one of the scions. The registration process for the trade mark was completed on 22 November 2002. The trade mark is registered for:

*battery chargers and parts and fittings therefor.*

The above goods are in class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The registration remains in the ownership of Clarke.

2) On 18 December 2009 UK Home Shopping Limited (UK) filed an application for a declaration of invalidation of all of the goods of the registration. The grounds of the application are made under sections 3(1)(b), (c) and (d) of the Act. Applications for invalidation under these grounds are governed by section 47(1) of the Act:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

Subsections 5 and 6 of section 47 of the Act state:

“(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

3) Sections 3(1)(b), (c) and (d) of the Act state:

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

(a) .....

(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.”

4) UK states:

“the term JUMP START has been widely used for many years by the trade and the public to mean the practice of starting a vehicle which has a flat (discharged) battery by connecting it to a secondary battery or battery charger by specially adapted cables called “jump leads” or “jumper cables”. Therefore, the term is non-distinctive for battery chargers and parts and fittings as it describes their intended purpose. Furthermore, the mark is not depicted in a font or style which lends any special visual distinction over plain words JUMP START.”

To support this contention UK attached a number of documents relating to the term.

5) UK states that as “a further indication that the term JUMP START is not distinctive and has never been distinctive, and as precedent of official TM Registry view of this, we direct your attention to the recently expired registration GB1492200 dated 26 February, for “portable battery charging apparatus; all included in class 9”, wherein there is a specific disclaimer of exclusive rights in the words “JUMP START.” UK states that “[i]f these words were subject to disclaimer because they were non-distinctive for these goods in 1992, they were equally non-distinctive in February 2002, when the application of this subject registration was filed”.

6) Clarke filed a counterstatement. It denies that the term JUMP START is non-distinctive for battery chargers and parts and fittings therefor. It also denies that the trade “mark is not depicted in a font or style which lends any special visual distinction over the plain words JUMP START. The mark is presented in a

particular font and that font has its own distinctive character apart from the words”.

7) Both parties filed evidence.

8) A hearing was held on 24 November 2010. UK was represented by Mr Lee Curtis of Harrison Goddard Foote. Clarke was represented by Ms Clare Turnbull of Brookes Batchellor LLP.

### ***Evidence for UK***

9) This consists of two witness statements made by Ms Rosemary Anne Barker. Ms Barker is a registered trade mark attorney.

10) Ms Barker states that the term JUMP START has been widely used for many years by the trade and the public to mean the practice of starting a vehicle which has a flat (discharged) battery by connecting it to a second battery or to a battery charger by specially adapted cables called jump leads or jumper cables. She exhibits the following material at RAB1:

- A page downloaded from dictionary.reference.com on 17 December 2009. Jump-start is defined as being “the starting of an internal-combustion engine that has discharged or weak battery by means of booster cables”. The extract states that jump-start is also a verb meaning to give a jump-start to an engine or to enliven or revive. The extract advises that the term originates from between 1975 and 1980. The page also includes various advertisements one of which is for a portable 900 amp battery jump start and compressor which is available for £29.9(the last number cannot be seen).
- A page downloaded from *Cambridge Dictionary Online* on 17 December 2009. The reference states that “[t]o jump-start a car is to start its engine by pushing the car, or by using jump leads”.
- Pages from a Google® search for the term: jump start battery charger. The search was made on 17 December 2009 and is not limited by country. On the pages various references to jump start appear: Car Jump Start 4000 (which from the evidence of Clarke would appear to relate to the registered proprietor); Rolson Car Jump Start Battery Charger Booster Starter, price in pounds sterling; External Battery Pack for the Palm 800W – Jump Start Emergency, price in pounds sterling; Portable 900amp battery jump start + compressor, price in pounds sterling; Clarke Jump Start 4000 (a product of the registered proprietor) which is described as a “Reliable, professional Jump Starter”; Maplin jumpstart compressor; Clarke Jump-Start 900 Battery Charger (a product of the registered proprietor); How To Jump Start A Car; “The first thing you want to remember when jump-starting a car is that a....”; How to jump start a car;

Metal Case Battery Charger with Jump Start; Jump start battery pack and enclosure therefor – US Patent 6222342.

- Pages from a Google® search for the term: jump starters. The search was made on 13 March 2010 and is not limited by country. On the pages various references appear: Car Jump Start 4000 (a product of the registered proprietor), Jump starters; two types of jump starters from Maplin Electronics; 6-in1 heavy duty portable power station and jump starter from Argos; portable jump starters (the website is co.uk and a United Kingdom telephone no is given); Black & Decker ... Emergency Jump Starters; The Clarke Jump Start 910 (a product of the registered proprietor); jump starters at Amazon.co.uk; jump starters at Dealtime; Jump Starter bargains; Jump Starter – Compare Prices, Reviews and Buy at NexTag – Price ..... Jump Starter – 17 results like the RING RPP210 Heavy Duty Jump Starter, Black & Decker BDJS350 Jump Starter 350 Amp, Power Start Heavy Duty Jump Starter; How to Choose Portable Emergency Jump Starters; Portable battery jump starter: Amazon.co.uk: Garden & Outdoors; jump starter manufacturers directory; SOS Booster: The professional Jump Starter; Jump Starters from Black and Decker; Jump Starters available on Seton.co.uk Jump Starters... 12v Jump Starters; Jump Starters – From £99; Costco – Stanley 500 Amp Jump-starter with Air Compressor and LED; Automotive Battery Chargers, jump starters, booster and cables; There are many great car jump starters that you can buy online, but the one I recommend is also the top selling jump starter; Order Engine Jump Starter & Air Compressor online today at Screwfix.com; How does a Portable Jump Starter Work?; Portable jump starters will never leave you stuck with a dead battery; Richardson Jumpstarters; lifts of all kinds, air compressors, jumpstarts, booster packs; Car Bulbs, Lighting, Jump Starters and much more plus Custom Car and Engine Bay Accessories; JTM Jumpstarters is an established manufacturer of high quality portable booster engine starting equipment and portable power packs (the undertaking has an Irish domain name).
- Pages downloaded from the Maplin website on 16 December 2009. These relate to a portable Jump Starter and Air Compressor. The product is described as a fully portable jump starter and compressor.
- A copy of a page from the spring/summer Argos catalogue (there is no indication as to the year). In relation to a Black & Decker model, the reader is advised that the product can “Jump start a vehicle with a flat battery in 90 seconds”. Product 11 on the page is a “6-in1- heavy duty portable power station and jump starter”. It is described as an “[e]mergency jumpstart system”.
- A copy of a page from catalogue no 101 of Screwfix, valid until 9 April 2010. The page is headed “CHARGERS & STARTERS”. On the page there appears an “Engine Jump Starter Power Pack”; and an “Engine Jump Starter & Air Compressor”.
- A copy of a page from catalogue no 33 of Toolstation dated February 2010. On the page a “Power Station Jump Starter/Compressor” appears.

- A Wikipedia entry headed “Jump start (vehicle)”. The entry was downloaded on 17 December 2009. The entry states, inter alia, that “[a] jump start or boost is a term for a method of starting an automobile or other internal combustion engine-powered vehicle which has a discharged battery. A second battery (often in another vehicle) is temporarily connected to provide starting power to the disabled vehicle”.
- A printout from the AA’s website downloaded on 17 December 2009. It is entitled “Using Jump Leads”. The text refers to jump starting and jump-start.

11) Ms Barker states that Clarke has complained to UK that use of the term “Jump Starter” infringes the trade mark registration the subject of these proceedings. She states that it is for this reason that it needs to be established whether the registration can be valid when the terms jump start and jump starter are so widely used in a descriptive manner.

12) Exhibited at RAB2 is a printout from the Intellectual Property Office’s database for expired trade mark registration no 1492200:



The trade mark was registered for:

*portable battery charging apparatus; all included in Class 9.*

The registration includes the following disclaimer:

Registration of this mark shall give no right to the exclusive use, of the words "Jump Start".

Ms Barker notes that the disclaimer denotes that the words JUMP START were held to be non-distinctive for battery charging apparatus in 1992.

13) Exhibited at RAB3 are additional dictionary references for the term jump-start:

- From *The Oxford Modern English Dictionary*, edition published 1995. Jump-start is defined as a verb as “start (a motor vehicle) by pushing it or with jump-leads”. As a noun it is defined as “the action of jump-starting”.
- From *The Chambers Dictionary*, edition published 1998. Jump start is defined as “to start (a car) by using jump leads; to bump start (a car)”. The definition also advises that the term can be used as a noun.

### ***Evidence for Clarke***

14) This consists of a witness statement by Mr John Alan Clarke. Mr Clarke formed the company Clarkes Compressors (Installations) Limited on 18 February 1970. The company changed its name to Clarkes Compressors Limited in 1972 and again in 1993, to Clarke International Limited.

15) Mr Clarke states that the trade mark JUMP START has been used continuously since 1999 in respect of battery chargers and parts and fittings therefor. The annual turnover of goods sold under the trade mark for the years from 1 January 2000 to date is as follows:

	Turnover amount	Units sold
2000	£792,516	25,753
2001	£1,383,139	49,561
2002	£777,438	30,184
2003	£518,085	16,246
2004	£432,266	11,855
2005	£510,080	12,183
2006	£571,934	11,921
2007	£619,781	12,139
2008	£658,314	10,055
2009	£824,175	10,833
2010 – 12 May 2010	£457,402	5,646

16) Mr Clarke states that Clarke sells a large range of goods, including those of the registration. Exhibited at JAC1 are copies of pages from catalogues and price lists as well as a complete catalogue for 2008/9. The catalogues have the title *Clarke Power Products*, they start from 2003. Details and illustrations of products described as portable 12v rechargeable power supply and boost starters are shown. In the 2003 catalogue the products bear the name Clarke JUMP START 900 or Clarke JUMP START 910 (for a product which includes an air compressor). The products are described as providing “900 peak amps, 400 amps of starting boost for vehicles with low battery, and can also be used as a power supply for running 12v DC operated equipment”. They have “[h]eavy duty clamps for good battery connection & 2.5mm<sup>2</sup> EXTRA LONG (1 metre) booster cables”. On the pages the words “JUMP START RECHARGEABLE POWER

SUPPLY / BOOST STARTER”, “JUMP START900 RECHARGEABLE POWER SUPPLY”, “JUMP START 910 WITH 12v DC COMPRESSOR” appear, as well as “The Jump Start 910 has the same specification as the Jump Start 900”. In the trade price list for 11 July 2005, under the general heading “Clarke™ Start N charge”, the heading “ENGINE STARTERS & BATTERY CHARGERS” appears. Three models appear: the JumpStart 900, JumpStart 910 and JumpStart 4000, they are all described as engine starters. Under the same heading jump leads, inter alia, are advertised. In the 2005 catalogue the JUMP START 900 and JUMP START 910 appear again. The potential purchaser is advised that the products start petrol engines and diesel engines, “even when vehicle has a flat battery”. “JUMPSTART® IS A REGISTERED TRADE MARK OF CLARKE INTERNATIONAL LTD. DON’T BE CONFUSED BY INFERIOR IMMITATIONS (sic) WITH POOR QUALITY BATTERY & SHORT LEADS” appears on the page exhibited. The wholesale price list of 11 July 2005, categorises and describes the products in the same manner as the trade price list for the same date. On this page a picture of the product can be seen, it bears the trade mark Clarke JUMP START 900. The wholesale price list of 6 November 2008 lists the products, described as JUMPSTART 900, 910 or 4000, as engine starters / 12V power supplies. They appear on the same page as battery starters and battery chargers. In the catalogue for 2008/9 the products appear on a page which is headed “TOP QUALITY JUMP STARTERS”. Three products are illustrated on the pages, all of which bear the name Clarke above JUMP START 900, JUMP START 4000 and JUMP START 910. “JUMPSTART® IS A REGISTERED TRADE MARK OF CLARKE INTERNATIONAL LTD. DON’T BE CONFUSED BY INFERIOR IMMITATIONS (sic) WITH POOR QUALITY LIGHTWEIGHT BATTERY & SHORT LEADS” appears on the page. The products are described as “JUMP STARTS (WITH TOP QUALITY LONG LIFE BATTERY)” (page 12 of the exhibit). Beneath this description “The Clarke 12v JumpStart® range provides essential home, garage and road side assistance” appears. References to JUMPSTART® 900, 4000 and 910 appear on the page. The full 2008/9 catalogue is exhibited as well as the extract. At the rear of the catalogue there is a product index, where the products are identified in generic terms. Between jump leads and key cabinets “Jumpstarts” appears. From the catalogue for October 2009 a page showing new products is exhibited. On this page three products described as “PROFESSIONAL JUMPSTART 1010”, “PROFESSIONAL JUMPSTART 1000” and “PROFESSIONAL JUMPSTART1224” appear. On all of the products the name Clarke appears above JUMPSTART. The products are all described as being engine starters. The products are also described as JUMPSTART 1010, 1000 and 1224.

17) Mr Clarke states that the catalogues are distributed to retailers and dealers of the goods sold by Clarke. The number of catalogues produced and distributed has been as follows:

2001-2002	100,000
2003-2004	100,000

2005-2007 100,000  
2008-2010 50,000

The 2008/9 catalogue has 220 pages.

18) Mr Clarke states that Clarke is “under common ownership with the company Machine Mart Limited” (MML). He states that Clarke sells a substantial number of goods to MML. The goods sold under the trade mark the subject of these proceedings are stocked in all of MML’s stores. MML has retail stores in the following locations: Barnsley, Birmingham (2), Bolton, Bradford, Brighton, Bristol, Burton upon Trent, Cardiff, Carlisle, Chester, Colchester, Coventry, Croydon, Darlington, Deal, Derby, Doncaster, Dundee, Edinburgh, Gateshead, Glasgow, Gloucester, Grimsby, Hull, Ilford, Leeds, Leicester, Lincoln, Liverpool, London (3), Maidstone, Manchester, Mansfield, Middlesbrough, Norwich, Nottingham, Peterborough, Plymouth, Poole, Portsmouth, Preston, Sheffield, Sidcup, Southampton, Southend, Stoke-on-Trent, Sunderland, Swansea, Swindon, Twickenham, Warrington, Wolverhampton and Worcester.

19) Mr Clarke states that MML also operates mail order and on-line businesses and distributes a large number of catalogues to customers. He states that MML advertises the goods of Clarke “heavily” in its catalogues and the goods sold under the trade mark the subject of these proceedings have been featured in publications produced by MML since the products were launched at the end of 1999. Exhibited at JAC2 are copies of pages from catalogues distributed by MML and a complete spring/summer 2010 catalogue. The catalogues bear the title *Machine Mart*. In the spring/summer 1999, autumn/winter 1999/2000, and spring/summer 2000 trade catalogues the “Jump Start 900 Rechargeable Power Supply” appears. The product bears the name Clarke Jump Start 900. It appears on a page with the sub-heading “Heavy Duty Starters/Chargers”. The product is described as “[p]ortable 12v rechargeable power supply and boost starter”. In the autumn/winter 2000/01, spring/summer 2001, autumn/winter 2001/02 trade catalogues under the main heading of garage equipment is a sub-heading of “Clarke Starters/Chargers”. “Jump Start 900 Rechargeable Power Supply” appears on the page. The product bears the name Clarke Jump Start 900. In the spring/summer 2002, spring/summer 2003 and autumn/winter 2003/04 trade catalogues under the general heading of garage equipment various Clarke products appear, including 2 jump starts. The sub-heading “Jump Starts” appears above descriptions of the “Jump Start 900 Rechargeable Power Supply” and “Jump Start 910 with 12V DC Compressor”. A quotation from *Car Mechanics* appears on the page: “Longer leads, facility packed and at the best price make the Clarke our best buy”. Pictures of the products appear on the page, the names Clarke JUMP START 900 or 910 appear on the products. In the autumn/winter 2004/05 trade catalogue similar use occurs, with the sub-heading “Jump Starts” appearing. In the spring/summer 2005, autumn/winter 2005/6, spring/summer 2006, autumn/winter 2007/8, spring/summer 2008, autumn/winter 2008/9, spring/summer 2009 and autumn/winter 2009/10 trade catalogues three

products appear. The sub-heading “Jump Starts” appears on the page. The products all bear the name Clarke above the JUMP START name and particular model. “JUMPSTART® is a registered trade mark of Clarke International Ltd. Don’t be confused by inferior imitations (sic) with poor quality weak battery & short leads” appears on the pages. Within the pages there are references to JUMPSTART®900, 4000 and JUMPSTART® 910. There is also reference to “[t]he Clarke 12v JumpStart® range provides essential home, garage and road side assistance”. The complete catalogue has an index of products using generic terms; between jigsaw blades and key safes “Jump Leads & Starters” appears. Pages 214 and 215 of the catalogue show “Clarke Jump Starts”. The following appears on page 214:

“These stylish top quality jumpstarts build on the huge success of the current Clarke range”.

“JUMPSTART® is a registered trade mark of Clarke International Ltd. Don’t be confused by inferior imitations with poor quality weak battery & short leads” appears on the pages. As well as JUMP START followed by a number, all of the products illustrated bear the name Clarke. There is use of JumpStart followed by a numeral, to indicate the particular model, on the pages. There is also use of JUMPSTART®. The following appears on page 215:

“The Clarke 12v JumpStart® range provides essential home, garage and road side assistance.”

20) The number of catalogues distributed by MML is as follows:

autumn/winter 2005/6	1,575,000
spring/summer 2006	1,575,000
autumn/winter 2006/7	1,200,000
spring/summer 2007	1,250,000
autumn/winter 2007/8	1,300,000
spring/summer 2008	1,300,000
autumn/winter 2008/9	1,300,000
spring/summer 2009	1,300,000
autumn/winter 2009/10	1,250,000
spring/summer 2010	1,250,000

The spring/summer 2010 catalogue has 436 pages.

21) Mr Clarke states that from February 2009 to March 2010 MML advertised the goods of Clarke on television. Exhibited at JAC3 are two screenshots from the television advertising campaign. The first screen shot shows a product bearing the name Clarke JUMP START 4000, a banner beneath this reads “machinemart.co.uk 0800 803 000”. The second screen shot shows a variety of products, including one which bears the name Clarke JUMP START 1000. The

same banner appears at the bottom of the shot. The advertisement (written in the singular) was shown on Sky, IDS, Dolphin, ITV Digital and Channel Five. The following details are given re the television advertisement

Dates	Broadcaster	Viewing figures
16 February 2009 – 15 March 2009	Satellite television	20,808,693
13 April 2009 – 26 April 2009	Satellite television	6,120,549
31 August 2009 – 27 September 2009	Satellite television and Channel Five	19,608,674
16 November 2009 – 6 December 2009	Satellite television and Channel Five	11,976,687
1 March 2010 – 21 March 2010	Satellite television	13,635,175

22) Mr Clarke states that goods sold under the trade mark, along with other goods sold by Clarke, are advertised in many national newspapers and magazines as well as local newspapers. Mr Clarke states that exhibit JAC4 “consists of copies of relevant pages from publications, including the national newspapers the Daily Express, the Daily Star and The Times, showing advertising of goods sold under the Trade Mark”.

- *Daily Star* of 15 July 2005. Advertisement for MML. Variety of products shown including JUMPSTART 910, reference also to JUMPSTART 900. The reader is advised that the product is “ideal for starting cars, inflating tyres etc”. An illustration of the product is included. The name Clarke can be seen above JUMP START on the product.
- *Daily Star* of 13 February 2009. Advertisement for MML. Variety of products shown including Clarke JUMP START®. The product is described as the original JUMP START®. An illustration of the product is included but owing to the quality of the copying it is not possible to discern any details.
- *Daily Star* of 12 August 2009. Advertisement for MML. Variety of products shown including Clarke JUMP START®. The product is described as the original JUMP START®. An illustration of the product is included but owing to the quality of the copying it is not possible to discern any details. The advertisement advises that jump leads are available. 4 versions of the product are listed.
- *Daily Star* of 28 August 2009. Advertisement for MML. Variety of products shown including Clarke JUMP START®. The advertisement is effectively the same as that for 12 August 2009 (although a different model is shown in the advertisement).

- *Daily Star* of 12 September 2009. Advertisement for MML. The advertisement for the Clarke JUMP START® is the same as that for 28 August 2009.

23) A number of advertisements for MML from *Practical Classics*, a car magazine, are exhibited. They all show a variety of products. The advertisements exhibited span the December 1999 issue to December 2007:

- December 1999. Advertisement for Clarke JUMPSTART 900. The product can be seen. Clarke JUMP START 900 appears upon it.
- January 2000. Advertisement for Clarke JUMPSTART 900. The product can be seen. Clarke JUMP START 900 appears upon it.
- March 2000. Advertisement for Clarke JUMPSTART 900. The product can be seen. Clarke JUMP START 900 appears upon it.
- May 2001. Advertisement for Clarke JUMPSTART 900. The product can be seen. Clarke JUMP START 900 appears upon it.
- July 2001. Advertisement for Clarke JUMPSTART 900. The product can be seen. Clarke JUMP START 900 appears upon it.
- October 2001. Advertisement for Clarke JUMPSTART 900. The product can be seen. Clarke JUMP START 900 appears upon it.
- November 2001. Advertisement for Clarke JUMPSTART 900. The product can be seen. Clarke JUMP START 900 appears upon it.
- April 2002. Advertisement for Clarke JUMPSTART 900. The product can be seen. Clarke JUMP START 900 appears upon it.
- July 2002. Advertisement for Clarke JUMPSTART 900. The product can be seen. Clarke JUMP START 900 appears upon it.
- October 2002. Advertisement for Clarke JUMPSTART 910. The product can be seen. Clarke JUMP START 910 appears upon it.
- December 2002. Advertisement for Clarke JUMPSTART 910. The product can be seen. Clarke JUMP START 910 appears upon it.
- April 2003. Advertisement for Clarke JUMPSTART 900. The product can be seen. Clarke JUMP START 900 appears upon it.
- May 2003. Advertisement for Clarke JUMPSTART 900. The product can be seen. Clarke JUMP START 900 appears upon it.
- December 2003. Advertisement for Clarke JUMPSTART 910. The product can be seen. Clarke JUMP START 910 appears upon it.
- April 2004. Advertisement for Clarke JUMPSTART 910. The product can be seen. Clarke JUMP START 910 appears upon it.
- October 2004. Advertisement for Clarke JUMPSTART 910. The product can be seen. Clarke JUMP START 910 appears upon it.
- November 2004. Advertisement for Clarke JUMPSTART 910. The product can be seen. Clarke JUMP START 910 appears upon it.
- December 2004. Advertisement for Clarke JUMPSTART 910. The product can be seen. Clarke JUMP START 910 appears upon it.

- Spring 2005. Advertisement for Clarke JUMPSTART 910. The product can be seen. Clarke JUMP START 910 appears upon it.
- April 2005. In the advertisement “Clarke JUMP STARTS” appears. A picture of a product appears, upon which Clarke JUMP START 4000 appears. The advertisement advises that the “Jumpstart 910 features air compressor”.
- May 2005. Advertisement for Clarke JUMPSTART 910. The product can be seen. Clarke JUMP START 910 appears upon it.
- October 2005. Advertisement for Clarke JUMPSTART 910. The product can be seen. Clarke JUMP START 910 appears upon it.
- November 2006. In the advertisement “Clarke JUMP STARTS” appears. A picture of a product appears, upon which Clarke JUMP START 4000 appears.
- December 2006. In the advertisement “Clarke JUMP STARTS” appears. A picture of a product appears, upon which Clarke JUMP START 4000 appears.
- June 2007. In the advertisement “Clarke JUMP STARTS” appears. A picture of a product appears, upon which Clarke JUMP START 4000 appears.
- December 2007. In the advertisement “Clarke JUMP STARTS” appears. A picture of a product appears, upon which Clarke JUMP START 4000 appears.

24) Mr Clarke states that goods sold under the trade mark, along with other goods sold by Clarke, are included in flyers. The flyers are distributed in national publications as well as in local newspapers. They are also sometimes sent to specific individuals identified by independent research companies, as direct nationwide mailings. Exhibited at JAC5 are examples of the flyers.

- For MML. Handwritten annotation 2000, bordered with holly leaves. Included in the products advertised is the Clarke JUMPSTART 900. The product is advertised as supplying “[i]nstant mains-free boost starting for vehicles”.
- For Clarke Power Products. Handwritten annotation 2002. Amongst the products is one with the heading JUMPSTART 900. The product is illustrated, it bears the name Clarke JUMP START 900.
- For MML. Handwritten annotation 2002. A picture of a Christmas pudding appears upon it. An illustration of the Clark JUMP START 910 appears. Underneath this there is reference to the JUMPSTART 910 and the JUMPSTART 900.
- For MML. Handwritten annotation 2003. Spring special. To the right and below the name Clarke (stylised) appears an advertisement for JUMPSTART 910 and JUMPSTART 900. Pictures of the products are included, the name Clarke appears above the JUMP START elements.
- For Clarke Power Products. Handwritten annotation 2003. Spring savers. JUMPSTART 900 and JUMPSTART 910 appear. Illustrations of the

- product appear, the name Clarke appears above the JUMP START elements.
- For Clarke Power Products. Handwritten annotation 2003. Summer saver. JUMPSTART 900 & 910 WITH AIR COMPRESSOR appears. A picture of a product appears, Clarke appears above JUMPSTART 910. The reader is advised that the JUMPSTART 910 includes an air compressor.
  - For Clarke Power Products. Winter 2003/4. Effectively the same advertisement as immediately above.
  - For Clarke Power Products. Handwritten annotation 2003. Winter savers. JUMPSTART 910 WITH AIR COMPRESSOR appears. A picture of a product appears, Clarke appears above JUMPSTART 910.
  - For MML. Great gift ideas, a picture of holly and berries. JUMPSTART 910 WITH AIR COMPRESSOR appears. A picture of a product appears, Clarke appears above JUMPSTART 910.
  - For MML. Handwritten annotation 2004. Spring special. JUMPSTART® 910 appears. A picture of a product appears, Clarke appears above JUMPSTART 910. There is also a reference to JUMPSTART® 900.
  - For Clarke Power Products. Handwritten annotation 2004. Spring saver. JUMPSTART 900 & 910 WITH AIR COMPRESSOR appears. A picture of a product appears, Clarke appears above JUMPSTART 910. The reader is advised that the JUMPSTART 910 includes an air compressor.
  - For Clarke Power Products. “All deals end on 30<sup>th</sup> November 2004”. On page 18 of the exhibit various types of products are listed: cast iron stoves, submersible pumps, jumpstarts, compressors, drill presses and heaters. Opposite Jumpstarts a picture of a Clarke JUMP START 900 appears. On page 19 Clarke JUMPSTART® appears. Two products are shown. Both bear the name Clarke followed by JUMP START 900 or 910. There is reference to JUMPSTART® 900 and JUMPSTART® 910.
  - For MML. Handwritten annotation 2004. Pictures of a snowman and holly. Advertisement describing product as JUMPSTART® 910 WITH AIR COMPRESSOR, there is also reference to JUMPSTART® 900. A picture of a product appears upon which Clark JUMP START 910 appears.
  - For MML. Handwritten annotation 2005. Spring special. Advertisement effectively the same as that referred to immediately above.
  - For Clarke Power Products. July 2005. Included is an advertisement for “HEAVY DUTY JUMPSTART® 4000”. The product bears the name Clarke, beneath which appears JUMP START 4000.
  - For Clarke Power Products. Handwritten annotation 2005. Winter saver. Advertisement refers to “JUMPSTART 900 & 910 WITH AIR COMPRESSOR”, the reader of the advertisement is advised that the “JUMPSTART 910 INCLUDES AIR COMPRESSOR”. A picture of a product appears upon which Clark JUMP START 910 appears.
  - For MML. Handwritten annotation 2006. Great spring value. Under the heading “12V JUMP STARTS” appears a picture of a product bearing the name Clarke JUMP START 4000.

- For Clarke Power Products. Handwritten annotation 2006. Summer score. Under the heading “HEAVY DUTY JUMPSTARTS®” appears a picture of a product bearing the name Clarke JUMP START 4000.
- For MML. Autumn/winter 2006/07. An advertisement for “Clarke 12v Heavy Duty JumpStart® 4000”. The following wording appears:

“Provides essential home, garage & road side assistance. High power Jumpstart for bigger cars, vans etc & longer use as power supply.”

A picture of the product bearing the name Clarke JUMP START 4000 appears.

- For Clarke Power Products. Handwritten annotation 2006. Winter deals. Under the heading “HEAVY DUTY JUMPSTARTS®” appears a picture of a product bearing the name Clarke JUMP START 4000.
- For MML. Spring 2007. Under a page headed Clarke Garage Equipment various products appear. “JUMPSTART® is a registered trade mark of Clarke International Ltd. Don’t be confused by inferior imitations with poor quality weak battery & short leads” appears on the page. Illustrations of three products are shown. All of them bear the name Clarke, under which JUMP START appears and the particular model number. The text includes the following:

“Clarke 12v JumpStarts®

The Clarke 12v JumpStart® range provides essential home, garage and road side assistance.....JumpStart® 910 has the additional benefit of an air compressor for tyre inflations”.

This page (no 32 in the exhibit) bears the number 90, it is difficult to conceive of this, therefore, being part of a flyer.

- For MML. Handwritten annotation 2007. “Lowest prices this Christmas”. A picture of a Clarke JUMP START 900 appears.
- For Clarke Power Products. Handwritten annotation 2007. Winter deals. Under the heading “HEAVY DUTY JUMPSTARTS®” appears a picture of a product bearing the name Clarke JUMP START 4000.
- For Clarke Power Products. 2007/08 winter specials. HEAVY DUTY JUMPSTARTS®” appears a picture of a product bearing the name Clarke JUMP START 4000. Immediately beneath this an advertisement for professional jump leads appears.
- For MML. Handwritten annotation of 2008. A picture of the Clarke JUMP START 4000 appears. To the side of this there is reference to Jumpstart 4000, Clarke JumpStart® and JumpStart®910.
- For MML. Handwritten annotation 2008. Reference to Christmas. A picture of a Clarke JUMP START 4000 appears.

- For MML. Handwritten annotation 2009. Pictures of icicles and a reference to great gift ideas. A picture of a Clarke JUMP START 4000 appears. To the side of the picture “Clarke 4000 Jumpstart” is written.

25) The number of flyers produced was:

spring 2005	3,800,000
summer 2005	450,000
Christmas 2005	4,000,000
spring 2006	1,507,000
Christmas 2006	1,100,000
spring 2007	1,250,000
Christmas 2007	400,000
spring 2008	3,300,000
Christmas 2008	400,000
Christmas 2009	2,000,000

### **Decision**

#### **Preliminary issue**

26) Mr Curtis noted that in its counterstatement Clarke has simply denied the grounds of invalidation. It has not pleaded that if any of the objections are upheld that it relies on the proviso to section 47(1), ie that the trade mark will have acquired a distinctive character in relation to the goods of the registration through use. Ms Turnbull confirmed that if any of the objections were upheld, Clarke would pray in aid the proviso. Mr Curtis was asked if the evidence that UK filed would have been any different if this had been pleaded. He doubted that this would have been the case. There would be little point to the evidence of Clarke other than to prove distinctiveness acquired through use, UK would have been aware of this. The basis of the alternative defence is obvious, it is doubtful that different evidence would have been filed by UK. In a letter of 4 June 2010 UK specifically refers to the evidence of use furnished by Clarke and states:

“Accordingly, this does not show that the words JUMP START alone have taken on any distinguishing function over the years.”

In considering this matter account is taken of the judgments in *Willis Arnold Charlesworth v Relay Roads Limited (in liquidation)* [2000] RPC 300, *Mastercard International Incorporated v Hitachi Credit (UK) Plc* [2005] ETMR 10 and *Sinclair Investment Holdings SA v Carlton Ellington Cushnie and others* [2006] EWHC 573 (Ch). It is plain that Clarke was submitting a defence in the alternative and that UK was aware of this. Consequently, it is determined that Clarke can rely upon this defence in the alternative; in effect there is a de facto amendment to the pleadings of the counterstatement to include the use proviso as a defence in the alternative.

### **Section 3(1)(c) of the Act**

27) In *JanSport Apparel Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-80/07 the General Court (GC) gave a helpful summary of the considerations to be taken into account in relation to article 7(1)(c) of the regulation, the equivalent of section 3(1)(c) of the Act:

“18 Under Article 7(1)(c) of Regulation No 40/94, ‘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 or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’ are not to be registered. In addition, Article 7(2) of Regulation No 40/94 (now Article 7(2) of Regulation No 207/2009) states that, ‘paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community’.

19 By prohibiting the registration of such signs, that article pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 31).

20 Furthermore, the signs covered by Article 7(1)(c) of Regulation No 40/94 are signs regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquired the product or service to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (Case T-219/00 *Ellos v OHIM (ELLOS)* [2002] ECR II-753, paragraph 28, and Case T-348/02 *Quick v OHIM (Quick)* [2003] ECR II-5071, paragraph 28).

21 The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought (see the judgment of 9 July 2008 in Case T-323/05 *Coffee Store v OHIM (THE COFFEE STORE)*, not published in the ECR, paragraph 31 and the case-law cited). Accordingly, a sign’s descriptiveness can only be assessed by reference to the goods or services concerned and to the way in which it is understood by the relevant public (Case T-322/03 *Telefon & Buch v OHIM– Herold Business Data (WEISSE SEITEN)* [2006] ECR II-835, paragraph 90).

22 It follows that, for a sign to be caught by the prohibition set out in that provision, there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see Case T-19/04 *Metso Paper Automation v OHIM(PAPERLAB)* [2005] ECR II-2383, paragraph 25 and the case-law cited).

23 It must finally be pointed out that the criteria established by the case-law for the purpose of determining whether a word mark composed of several word elements is descriptive or not are identical to those applied in the case of a word mark containing only a single element (Case T-28/06 *Rheinfelsquellen H. Hövelmann v OHIM (VOM URSPRUNG HER VOLLKOMMEN)* [2007] ECR II-4413, paragraph 21).

28) The Court of Justice of the European Union (CJEU) Case C-363/99 stated:

“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 indications which may serve, in trade, to designate characteristics of the goods or services concerned.”

“102. It is also irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. The wording of Article 3(1)(c) of the Directive does not draw any distinction by reference to the characteristics which may be designated by the signs or indications of which the mark consists. In fact, in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially.”

29) The CJEU in *Alcon Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-192/03 P held that use after the date of the application could be used to draw conclusions as to the position at the date of application<sup>i</sup>. In *Telefon & Buch Verlagsgesellschaft mbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-322/03 the GC took into account documents emanating from four years after the date of application<sup>ii</sup>. Use after the date of application can also go to the issue of foreseeability in relation to the use of the term<sup>iii</sup>.

30) It was Ms Turnbull's submission that the trade mark is inherently distinctive for battery chargers and parts and fittings therefor and that the stylisation of the words lends additional distinctive character to the words. She submitted that the only evidence that pre-dates the date of the application consists of dictionary definitions of the phrase jump start. It is her submission that these refer to starting a motor vehicle by pushing it or with jump leads. She stated that the function of Clarke's goods, as contained in the specification of goods, is a battery charger. She submitted that the goods have a function which is the charging or re-charging a battery, which is not what is described in the dictionary references. She submitted that the purpose of the goods was to "put a charge into a discharged battery".

31) Jump start is a phrase that appears in dictionaries. It is also a phrase that is in common use; this is not an esoteric phrase that is solely the province of lexicographers. As per the jurisprudence of the CJEU and GC consideration of the trade mark can take into account use after the date of application. Dictionary references refer to starting a car with jump leads. The page downloaded from dictionary.reference.com on 17 December 2009 defines jump-start as "the starting of an internal-combustion engine that has discharged or weak battery by means of booster cables". The extract advises that the term originates from between 1975 and 1980. A Wikipedia entry headed "Jump start (vehicle)". The entry was downloaded on 17 December 2009. The entry states, inter alia, that "[a] jump start or boost is a term for a method of starting an automobile or other internal combustion engine-powered vehicle which has a discharged battery. A second battery (often in another vehicle) is temporarily connected to provide starting power to the disabled vehicle". Wikipedia is not always a completely reliable source of information, however, there has been no challenge to this evidence and it relates to common experiences of those whose cars have flat batteries.

32) Clarke has put in evidence in relation to its use of the trade mark. If the evidence has any relevance, it must relate to the goods of the specification, so Clarke must see that this evidence relates to the specification of the registration. Clarke by its choice of evidence defines what it considers the nature of the goods to be. In the 2003 catalogue the products bear the name Clarke JUMP START 900 or Clarke JUMP START 910 (for a product which includes an air compressor). The products are described as providing "900 peak amps, 400 amps of starting boost for vehicles with low battery, and can also be used as a power supply for running 12v DC operated equipment". They have "[h]eavy duty clamps for good battery connection & 2.5mm<sup>2</sup> EXTRA LONG (1 metre) booster cables". In the trade price list for 11 July 2005, under the general heading "Clarke™ Start N charge", the heading "ENGINE STARTERS & BATTERY CHARGERS" appears. Three models appear: the JumpStart 900, JumpStart 910 and JumpStart 4000, they are all described as engine starters. Under the same heading jump leads, inter alia, are advertised. The goods, for which Clarke has furnished evidence, recharge low or exhausted batteries, they pass a charge

to them. It is contradictory at one moment to claim that the goods of the specification are not used to jump start vehicles but at the same time show use of the trade mark on products that are clearly advertised as inter alia being car starters/chargers. The logic of this is that the evidence of use does not relate to the goods upon which Clarke uses the trade mark and therefore can have no relevance in the proceedings.

33) The evidence from UK shows that the essential nature of jump starting is to use one battery to provide current to another battery, to charge the battery. There are other types of battery chargers, such as those that recharge domestic batteries but that does not gainsay that battery chargers are used to jump start cars. Clarke shows use of the trade mark on products that serve this purpose.

34) The evidence of Clarke shows use of the term as a descriptive term, a descriptive term in relation to the goods upon which it claims use and which it must, therefore, consider to be representative of the goods of the specification. It, also, in its literature describes the products as, inter alia, rechargeable power supplies. In the 2008/9 catalogue in the index, between jump leads and key cabinets jumpstarts appears. This index only uses descriptive and generic names. On the page identified in the index, page 58, the heading is "TOP QUALITY JUMP STARTERS", lower on the page "JUMP STARTS (WITH TOP QUALITY LONG LIFE BATTERY) appears. It is not possible to see how the average consumer seeing such usage would view this term as anything other than being descriptive. It is not possible to see how this use by Clarke would not be seen by Clarke as being descriptive, of telling the potential customer the purpose of the product; this would be predicated on Clarke assuming that the potential customer would understand that the purpose of the product was being described. The index of the Machine Mart catalogue for spring/summer 2010 also includes an index, where goods are described by purpose. Between jigsaw blades and key safe, "Jump Leads & Starters" appears. On one of the pages identified, 214, the following is stated:

"These stylish top quality jumpstarts build on the huge success of the current Clarke range".

In the advertisement from the *Daily Star* of 15 July 2005, exhibit JAC4, the reader is advised that the products are "ideal for starting cars", further making the connection between battery charging and jump starting cars. In the advertisements exhibited at pages 53, 59, 61, 63, 65 of JAC4, CLARKE is followed by JUMP STARTS in such a manner that it is not possible to envisage that the average consumer is expected to view this other than as a descriptive term. At JAC5 page 17, a flyer lists by their nature or purpose: cast iron stoves, submersible pumps, **jumpstarts**, generators, compressors, drill presses and heaters. The nature of the advertisement is such that it is predicated on the basis that reader will know that jumpstarts is a term describing a particular type of product; there is nothing else in the advertisement to advise the reader of the

nature of the product. The product is illustrated with a set of jump leads. Clarke must assume that the reader of the leaflet will see this as a clear description or there is no point in the advertisement.

35) From a dictionary definition, JUMP START describes a purpose of battery chargers, they are connected to the failed battery of a vehicle in order to jump start the battery. The use on many occasions by Clarke is of such a nature that there must be a presumption by Clarke that the consumer will understand this meaning. Clarke on various occasions defines the products for which it has submitted evidence of use as jump starts.

36) Clarke submits that even if JUMP START is descriptive of a characteristic of the goods, the stylisation of the trade mark gives the mark distinctiveness and means that it does not exclusively describe the intended purpose of the goods. In its counterstatement Clarke states that “[t]he mark is presented in a particular font and that font has its own distinctive character apart from the words”. A position maintained by Ms Turnbull at the hearing. All word marks have to be in a font. One word appears above the other, if there is more than one word the words have to be placed in some form of order, whether next to each other or above each other. In relation to battery chargers used for jump starting vehicles, the average consumers for the products are the vehicle purchasing public at large and those involved in the servicing of vehicles. In relation to both sets of customers the presentation of the trade mark will not represent an unusual variation, the presentation does not have any inherent distinctiveness in itself. The average consumer will immediately perceive, without further thought, that the goods are battery chargers for the jump starting of cars. The trade mark consists exclusively of signs that describe the purpose of the goods. Owing to the absence of any significant stylisation, the position of the trade mark purely in oral use must also be considered as per the judgment of the CJEU in *KPN Nederland NV v Benelux Merkenbureau*:

“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.”

**37) The trade mark is descriptive of battery chargers that are used to jump starts vehicles, ie it describes the purpose of the goods, and so was registered contrary to section 3(1)(c) of the Act.**

### **Section 3(1)(b) of the Act**

38) In *KPN Nederland NV v Benelux Merkenbureau* the CJEU stated:

“86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

Consequently, on the basis of the finding in relation to section 3(1)(c) of the Act, registration of the trade mark was contrary to section 3(1)(b) of the Act.

39) However, the ground of invalidation under section 3(1)(b) of the Act will also be considered on its own merits. In *Develey Holding GmbH & Co Beteiligungs KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-238/06 P the CJEU stated:

“79. According to consistent case-law, the distinctive character of a trade mark within the meaning of Article 7(1)(b) of Regulation No 40/94 means that the mark in question makes it possible 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 those of other undertakings (Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* [2004] ECR I-5173, paragraph 32, and Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 42). That distinctive character must be assessed, first, by reference to the products or services in respect of which registration has been applied for and, second, by reference to the perception of the relevant public (*Procter & Gamble v OHIM*, paragraph 33, and Case C-24/05 P *Storck v OHIM* [2006] ECR I-5677, paragraph 23).”

The GC in *Rewe Zentral AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-79/00 described the issue in a clear and practical manner:

“26. The signs referred to in Article 7(1)(b) of Regulation No 40/94 are signs which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition.”

40) Owing to the descriptive nature of the trade mark, the average consumer will not perceive the trade mark as originating from a particular undertaking but will see it as describing the purpose of the product. The claimed stylisation will not change this perception owing to the overall impression of the trade mark. In *BioID AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-37/03 P the CJEU stated:

“73 As pointed out by the Advocate General in point 105 of his Opinion, when the overall impression conveyed by the trade mark applied for to the relevant public is examined, the abbreviation BioID, which is devoid of any distinctive character, is the dominant element of that mark.

74 Moreover, as OHIM observed in paragraph 21 of the contested decision, the figurative and graphic elements are so minimal in nature that they do not endow the trade mark applied for as a whole with any distinctive character. Those elements do not possess any feature, in particular in terms of fancifulness or as regards the way in which they are combined, allowing that mark to fulfil its essential function in relation to the goods and services covered by the trade mark application.”

In this case the claimed stylisation is far more minimal than that in the above case. The claimed stylisation will not endow the trade mark with a distinctive character.

**41) Consequently, outwith the finding under section 3(1)(c) of the Act, the trade mark is devoid of any distinctive character for battery chargers and so registration of the trade mark was contrary to section 3(1)(b) of the Act.**

### ***Parts and fittings***

42) The registration includes parts and fittings for battery chargers as well as battery chargers. In *Ford Motor Co v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-67/07 the GC stated:

“43 As regards the other goods covered by the application for registration, namely parts and fittings for land motor vehicles, it must be pointed out that the descriptive character of a sign must be assessed separately for each category of goods and/or services covered by the application for registration. Nevertheless, all the goods specified in the trade mark application may be inseparably linked since some of those goods may only be used in connection with the others, and a solution which is common to all the goods should therefore be adopted (see, to that effect, Case T-216/02 *Fieldturf v OHIM (LOOKS LIKE GRASS... FEELS LIKE GRASS... PLAYS LIKE GRASS)* [2004] ECR II-1023, paragraph 33, and Case T-315/03 *Wilfer v OHIM (ROCKBASS)* [2005] ECR II-1981, paragraph 67).”

In *Hans-Peter Wilfer v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-301/05P* AG Sharpston stated:

“47. The Court of First Instance ruled that, in relation to containers, cases and bags in Class 18, since Mr Wilfer had not drawn any distinctions within this generic category the Board of Appeal’s findings were to be confirmed in so far as they related to all goods in that category. With respect to the equipment in Class 9, it is clear from the arguments of the parties that the same equipment may be used for different instruments. Their use in connection with the bass guitar is therefore just one of their possible uses. There is a sufficiently direct and specific relationship between the sign and the goods in question where the technique evoked by the sign involves, or indeed requires, the use of those goods. That technique does not merely constitute in this case a field in which those goods are applied but rather is one of their specific functions. Accordingly, the fact that the goods in question may also be used in another way, to which the sign in question does not refer, cannot undermine that finding. In the present case, even though the equipment in question is not intended to be used exclusively in connection with bass guitars, it is nevertheless not used autonomously in relation to the handling of electric instruments. In addition, that equipment must be used in order to play the electric guitar, which is not capable of producing musical sounds on its own. Thus, the possibility of playing an electric bass guitar is a function of the equipment referred to in the application and not simply one of the many fields in which the equipment is applied. In particular, the combined use of these two categories of goods is required or, at the very least, implied by their inherent characteristics.”

**43) The parts and fittings are inseparably linked to the battery chargers, they are part and parcel of the main product. They will include such things as jump leads, and so will perform an essential function in jump starting a motor vehicle. Consequently, the objections under sections 3(1)(b) and (c) of the Act to battery chargers apply equally to the parts and fittings for battery chargers.**

***Section 3(1)(d) of the Act***

44) In *Telefon & Buch Verlagsgesellschaft mbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-322/03* the GC stated:

“49 Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only 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 (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). 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 mark (*BSS*, paragraph 37).

50 With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51 Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

45) To succeed under this head UK must establish that at the date of application the term JUMP START was in usage in trade sectors covering the trade in the goods of the registrations. None of its evidence shows any use within trade sectors on or before the date of the application within the United Kingdom. Mr Curtis prayed in aid the evidence of Clarke. This all relates to the use by two connected undertakings. It is not considered that this shows use in trade sectors but in, effectively, one particular undertaking. The purpose of this ground of objection is to stop one undertaking from monopolising a term or word that is used by a number of undertakings in the area concerned. The logic of Mr Curtis's argument would mean that an undertaking's own trade mark could be used as the basis for an objection under this head, as it could be argued that it is being used in the trade sector.

**46) UK has failed to establish that at the date of application the term JUMP START was in usage in trade sectors covering the trade in the goods of the registration. The ground of invalidation under section 3(1)(d) of the Act is dismissed.**

### ***Acquired distinctive character through use after registration***

47) In *Premier Luggage and Bags Ltd v. Premier Co (UK) Ltd & Another* [2002] ETMR 69 Chadwick LJ stated:

“51 The relevant question, therefore, is whether the trade mark had acquired a distinctive character through use in connection with products supplied by Premier Luggage either by the date of application, or (if not) by the date of the trial. The judge did not differentiate between those dates -because, as he said at paragraph 21 of his judgment:

"Although the proviso [to section 3(1) of the Act] refers to the mark acquiring distinctiveness prior to the date of the application for registration, section 47 of the 1994 Act provides that, if it is sought to obtain a declaration of invalidity where a mark has already been registered, it is sufficient if a distinctive character has been acquired since registration."

52 There is, I think, a danger in that approach, because it fails to recognise where the burden of proof lies in the two cases. The position was explained by Jacob J. in the *British Sugar* case, at page 302 (lines 7-12). After pointing out that section 72 of the Act provided that registration of a person as proprietor was prima facie evidence of the validity of the original registration, Jacob J. went on to say this:

"This clearly casts the onus on he who wishes to attack the validity of the original registration. But once the attacker can show the registration was wrongly made (particularly for non-compliance with section 3(1)(b)-(d)) and the proprietor wishes to rely on the proviso to section 47(1) it is for the proprietor to show that is [sic] mark is distinctive.""

Consequently, the material date for proof of use is the date of the hearing. Consequent upon the findings in relation to sections 3(1)(b) and (c) of the Act, the onus is upon Clarke to establish that the trade mark has acquired distinctive character through use.

48) In *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger* Joined Cases C-108/97 and C-109/97 the CJEU stated:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the

relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

In *Rautaruukki Oyj v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-269/06 the GC stated:

“43 Article 7(3) of Regulation No 40/94 provides that the absolute grounds for refusal do not preclude the registration of a trade mark if it has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it. In the circumstances referred to in Article 7(3) of Regulation No 40/94, the fact that the sign which constitutes the mark in question is actually perceived by the relevant section of the public as an indication of the commercial origin of a product or service is the result of the economic effort made by the trade mark applicant. That fact justifies putting aside the public-interest considerations underlying Article 7(1)(b) to (d), which require that the marks referred to in those provisions may be freely used by all in order to avoid conceding an unjustified competitive advantage to a single trader (*Shape of a bottle of beer*, paragraph 21 above, at paragraph 41, and *Shape of a sweet*, paragraph 21 above, at paragraph 55).

44 First, it is clear from the case-law that the acquisition of distinctiveness through use of a mark requires that at least a significant proportion of the relevant section of the public identifies the products or services as originating from a particular undertaking because of the mark. However, the circumstances in which the condition as to the acquisition of distinctiveness through use may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data, such as specific percentages (see *Shape of a sweet*, paragraph 21 above, paragraph 56, and case-law cited).....

46 Third, in assessing, in a particular case, whether a mark has become distinctive through use, account must be taken of factors such as, inter alia: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the significance of the investments by the undertaking to promote it; the proportion of the

relevant class of persons who, because of the mark, identify the goods as originating from a particular undertaking and statements from chambers of commerce and industry or other trade and professional associations. If, on the basis of those factors, the relevant class of persons, or at least a significant proportion thereof, identifies the goods as originating from a particular undertaking because of the trade mark, it must be concluded that the requirement for registering the mark laid down in Article 7(3) of Regulation No 40/94 is satisfied (see *Shape of a sweet*, paragraph 21 above, at paragraph 58, and case-law cited).”

In *CNH Global NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-378/07* the GC stated:

“54 As regards, secondly, sales volumes and advertising material, it must be pointed out that, according to the case-law, they constitute secondary evidence which may support, where relevant, direct evidence of distinctive character acquired through use, such as provided by the affidavits. Sales volumes and advertising material as such do not show that the public targeted by the goods in question perceives the sign as an indication of commercial origin. Accordingly, as regards the Member States for which no other evidence has been produced, proof of distinctive character acquired through use cannot be furnished by the mere production of sales volumes and advertising material (see to that effect *Texture of a glass surface*, paragraph 41).”

In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 Jacob J stated

“With that in mind I must deal with the evidence – for all depends upon the conclusions to be drawn from that. I begin with the original registration. As I have said I do not have to consider whether the mark was rightly registered under the 1938 Act. By virtue of section 105 of the 1994 Act and Schedule 3 paragraph 18(2) it is section 47 of the 1994 Act which sets out the grounds upon which a mark registered under the old Act can be attacked. I have already described the evidence used to support the original registration. It was really no more than evidence of use. Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that “use equals distinctiveness”. The illogicality can be seen from an example: no matter how much use a manufacturer made of the word “Soap” as a purported trade mark for soap the word would not be distinctive of his goods. He could use fancy lettering as much as he liked, whatever he did would not turn the word into a trade mark. Again, a manufacturer may coin a new word for a new product and be able to show massive use by him and him alone of that word for the product. Nonetheless the word is apt to be the name of the product, not a trade mark. Examples from old well-known cases of this sort of thing abound.

The Shredded Wheat saga is a good example: the Canadian case is *The Canadian Shredded Wheat Co. Ltd. v. Kellogg Co. of Canada Ltd.* in the Privy Council and the United Kingdom case *The Shredded Wheat Co. Ltd. v. Kellogg Co. of Great Britain Ltd.* in the House of Lords. In the former case Lord Russell said:

“A word or words to be really distinctive of a person's goods must generally speaking be incapable of application to the goods of anyone else.”

It is precisely because a common laudatory word is naturally capable of application to the goods of any trader that one must be careful before concluding that merely its use, however substantial, has displaced its common meaning and has come to denote the mark of a particular trader. This is all the more so when the mark has been used in conjunction with what is obviously taken as a trade mark.

I do not consider that the evidence filed to support the registration was anywhere near enough to support the conclusion that when the mark was registered, it was distinctive. Yes it had been used for about 5 years in conjunction with Silver Spoon, but it was not proved that the public regarded it as a trade mark - a reliable badge of trade origin - on its own. Further the use was only for what was essentially an ice cream topping. It did not cover the full range of goods covered by the registration.

What then of the position now? British Sugar rely upon more extensive evidence. First there is a great deal more use of exactly the same type as went on before. Sales figures went on going up - to nearly £3m p.a. Since introduction in 1986 sales over the 10 year period total about £13m. of which over half have taken place since registration in September 1992. The product has just over 50% of the ice cream topping market sector. Next British Sugar rely upon evidence from Mrs. Nash MBE. She was in public relations at British Sugar. She took telephone inquiries and dealt with letters from the general public. People sometimes complained when a flavour disappeared (blackcurrant did) or wanted information on availability (for instance when the toffee flavour came out, magazines, mainly at British Sugar's instigation, published recipes for making banoffi pie, a dessert made from bananas, toffee and ice cream). She said that customers often referred simply to “your “Treat” range”. But of course all the customers concerned, whether writing or telephoning, knew they were dealing with Silver Spoon the manufacturers. I do not think Mrs. Nash's evidence establishes that the general public perceive the word “Treat” to be a badge of trade origin in itself. I think her evidence does show recognition of the word amongst British Sugar customers, but recognition does not necessarily mean recognition as a trade mark.”

49) The use on the product itself is all with the name CLARKE. In the use shown in promotional material there is use in a manner which is indicative of the purpose of the goods rather than as indicative of being a trade mark. Clarke tries to enforce a trade mark message in certain of its material by using the ® symbol and advising that JUMP START is its registered trade mark. However, at the same time it uses JUMP START in what will invariably be perceived as a descriptive term. The distribution has only been through two economically linked undertakings, the goods have not been distributed at large. It is noted that there are a number of individual outlets. The products concerned are several among very many that are sold in these outlets. In the publicity material the products are shown with many others, the publicity is not for these products alone. No figures are given in relation to the percentage of the market held by Clarke in relation to the products. There is no indication as to the number of times that the television advertisement was shown, or at what times. The television advertisement has not been adduced into the proceedings and so it is not possible to view the use in relation to JUMP START in any context.

50) In *Société des produits Nestlé SA v Mars UK Ltd* Case C-353/03 the CJEU stated :

“29 The expression ‘use of the mark as a trade mark’ must therefore be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product or service as originating from a given undertaking.

30 Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.

32 In the final analysis, the reply to the question raised must be that the distinctive character of a mark referred to in Article 3(3) of the directive may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.”

Consequently, use with other matter, such as CLARKE, may be taken into account. It will depend on the circumstances of the use and the nature of the trade mark and the products in relation to which it is used. In relation to the use it is necessary that the use is as a trade mark, not descriptive use. This will turn on the perception of the average consumer. Taking into account the highly descriptive nature of JUMP START and Clarke’s own use of the term in a descriptive fashion, in combination with CLARKE, JUMP START will not be perceived by the average consumer as having trade mark significance but as

describing the nature of the particular Clarke product. As the quotation from *Car Mechanics* states “at the best price make the Clarke our best buy”. The identification of origin is with Clarke.

51) In *Bach and Bach Flower Remedies Trade Marks* [2000] RPC 513 Morrit LJ stated:

“43. With regard to the third and fourth submissions it is necessary to refer to the reference by Neuberger J. to the dictum of Viscount Maugham in *The Shredded Wheat Co. Ltd v. Kellogg Co. of Great Britain Ltd* (1940) 57 R.P.C. 137. At page 30 Neuberger J. said:

“While I am persuaded by Mr Bloch that the three propositions<sup>iv</sup> propounded by Mr Hobbs are perhaps somewhat too rigid, it does seem to me that they have considerable force, and at least provide useful general guidance. In that connection I derive assistance from certain passages in well-known judgments.

In *The Shredded Wheat Co. Ltd v. Kellogg Co. of Great Britain Ltd* (1940) 57 R.P.C. 137, Viscount Maugham said at page 147 that:

‘[I]t may be useful to cite the statement by Mr Justice Parker in *In re Gramophone Company's Application* [1910] 2 Ch. 423 at page 437 since he was a master in this branch of law: “For the purpose of putting a mark on the register, distinctiveness is the all-important point, and in my opinion, if a word which has once been the name of the article ought ever to be registered as a trade mark for that article, it can only be when the word has lost, or practically lost, its original meaning. As long as the word can appropriately be used in a description of the articles or class of articles in respect of which a trade mark is proposed to be registered, so long, in my opinion, ought the registration of that word for those articles or that class of article to be refused.”’

Neuberger J. also referred to the statement of Jacob J. in *British Sugar plc v. James Robertson & Sons Ltd* [1996] R.P.C. 281 at 302 to the effect that for a common descriptive term to acquire a distinctive character it must be shown that its original meaning has been “displaced”.

In paragraph 45 Morrit LJ stated:

“If to a real or hypothetical individual a word or mark is ambiguous in the sense that it may be distinctive or descriptive then it cannot comply with the requirements of the Act for it will not provide the necessary distinction or guarantee. It is in that sense that a common or descriptive meaning

must be displaced. It is also in that sense that I accept the second submission made by counsel for HHL before Neuberger J.”

At paragraph 49 he stated:

“First, use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have any materiality.”

In his part of the judgment Chadwick LJ stated on page 534 at line 11 et seq:

“The test of capacity to distinguish must, as it seems to me, reflect the test which is to be applied, following the decisions of the Court of Justice in *Gut Springenheide and Tusky* [1998] E.C.R. I-4567 (at paragraph 31) and *Lloyd Schufabrik Meyer v. Klijsen Handel BV* [1999] E.T.M.R. 690, in determining whether there is a likelihood of confusion in the context of Article 5(1)(b) of Directive 89/104. That has not been in dispute on this appeal. The test is whether the average consumer of the category of products concerned would recognise the words as distinctive--that is to say, as a guarantee of origin. For that purpose the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.”

On page 535 at line 11 et seq he stated:

“As Morrit L.J. has pointed out, a reasonably well informed and reasonably observant and circumspect consumer would know, if it be the case, that the words or word are widely used in a generic or descriptive sense--even if he is, himself, aware that they are also used in a distinctive sense. With that knowledge, it seems to me impossible for him to say that the words identify, for him, the goods as originating from a particular undertaking. Knowing, as he does, that the use of words may be intended as descriptive, he cannot assert that he understands them as necessarily distinctive.”

52) In this case Clarke’s use is often in a descriptive fashion. The nature of this use must be predicated on the basis that the average consumer will understand that the purpose of the product is being described. Clarke in its use is confused as to whether it is using the term as a trade mark or a descriptor. The use does the very opposite to displacing the descriptive meaning, it reinforces it. Clarke’s actual use of JUMP START is damning to its own case, it reinforces the case of UK.

**53) Clarke cannot benefit from the use proviso.**

**54) The trade mark was registered in contravention of sections 3(1)(b) and (c) the Act and is to be invalidated in its entirety. In accordance with section 47(6) of the Act the registration is deemed never to have been made.**

**Costs**

55 UK having been successful is entitled to a contribution towards its costs. Costs are awarded on the following basis:

Application fee:	£200
Preparing statement and considering the statement of Clarke:	£500
Preparing evidence and considering the evidence of Clarke:	£1,000
Preparing for and attending the hearing:	£500
Total:	£2,200

**Clarke International Limited is ordered to pay UK Home Shopping Limited the sum of £2,200. This sum is 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 07 day of December 2010**

**David Landau  
For the Registrar  
the Comptroller-General**

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<sup>i</sup> “41. Moreover, the Court of First Instance could without inconsistency in its reasoning or error of law take account of material which, although subsequent to the date of filing the application,

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enabled the drawing of conclusions on the situation as it was on that date (see, by analogy, the order in Case C-259/02 La Mer Technology [2004] E.C.R. I-0000 , [31]).”

ii “62 Even though those documents were gathered four years after the application for registration of the mark WEISSE SEITEN had been lodged, they confirm the linguistic development which took place and the conclusions which result from the documents concerning the period prior to the lodging of the application.”

iii *Wm Wrigley Jr Company v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* Case C-191/01 P:

“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.”

iv The three propositions were:

1. "The name of a product is the very antithesis of a trade mark. It tells you what the product is.
2. So long as a name retains the capacity to function as the name of a product, it is ineligible for registration as a trade mark.
3. The question with which the court is confronted in the present case, and which should be answered in the affirmative on the applicant's contention, is whether the word BACH retains the capacity to function as the name of product. If it does, then, on the basis of his first two propositions, Mr Hobbs contends that the applicants must succeed."