TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3008663
FOR THE TRADE MARK**

MYO

**AND APPLICATION NO. 3008672
FOR THE TRADE MARK**

MYO PRECISE

IN CLASSES 07 AND 34

**IN THE NAME OF
BRITISH AMERICAN TOBACCO (BRANDS) INC.**

AND

**THE CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS. 400943 AND 400944**

BY IMPERIAL TOBACCO LIMITED

Background and pleadings

1. British American Tobacco (Brands) Inc. ("the applicant") applied to register the trade marks MYO and MYO PRECISE[1] in the UK on 5 June 2013. The marks were accepted for registration and published in the Trade Marks Journal on 28 June 2013 in respect of the following goods:

Class 7: *Machines for processing tobacco. Parts and fittings for such machines.*

Class 34: *Cigarettes; tobacco; tobacco products; lighters; matches; smokers' articles, machines for rolling cigarettes*.

2. Imperial Tobacco Limited ("the opponent") opposes the trade marks on the basis of Section 3(1)(b)(c) and (d) of the Trade Marks Act 1994 ("the Act"). It claims that MYO means 'make your own' in relation to cigarettes, is used in the tobacco industry, indicates the kind of goods, and is devoid of any distinctive character. In relation to MYO PRECISE, the same argument is made, with the additional claim that PRECISE indicates that the cigarettes produced will be to the same standard as factory made cigarettes.

3. The applicant filed counterstatements denying the claims made. The applicant states that MYO is not a common abbreviation, nor an acronym, which is known to, or understood by, the average English speaking consumer in the UK. It puts the opponent to proof that MYO is used in the tobacco industry to signify "make your own tobacco" and goods for making one's own cigarettes. The applicant claims that the relevant class of persons is not those within the tobacco industry but, instead, the average UK consumer of the goods. The applicant states that, at most, PRECISE is suggestive that the goods have an element of precision, and that MYO PRECISE is distinctive.

4. The two cases were consolidated at this point. Both sides filed evidence. They both also filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. A hearing took place before me on 8 September 2014, by video conference, at which the opponent was represented by Mr Simon Malynicz, of Counsel, instructed by Stevens, Hewlett & Perkins, and the applicant was represented by Mr Andrew Norris, of Counsel, instructed by Baker & McKenzie LLP.

Opponent's evidence

5. Camille Bates, Intellectual Property Counsel for the opponent, has filed a witness statement, dated 5 February 2014. She states that MYO is "commonly used by traders within the tobacco industry and by consumers of tobacco products as an abbreviation for the phrase "make your own" to refer to cigarettes made by the consumer from tobacco and either rolling papers or ready made tubes, commonly with the aid of a "cigarette rolling machine"". Ms Bates exhibits extracts from the applicant's website[2], where 'making your own with a cigarette machine' appears as a

[1] Application numbers 3008663 and 3008672, respectively.
[2] Exhibit CB1.

sub-heading. The text says that machines allow people to make their own cigarettes, "just like factory made cigarettes", giving a more even finish than rolling by hand. Another of the applicant's website pages refers to roll-your-own and make-your-own tobacco growing in popularity in Western Europe.

6. Exhibit CB2 includes the head notes of a selection of articles appearing in the tobacco trade publication "Tobacco Journal International" when a search in the publication's archives for the term MYO was performed in July 2013. The articles date from 2002 to 2013. The publication has a circulation of more than 6,000 copies per issue and is aimed at executives in the tobacco industry. The head notes are unexpanded search results, but they all include "RYO/MYO" as a reference to non-factory made cigarettes. The references are chiefly non-country specific or global: there are references to the term in the context of European countries, China, Japan, the US and South America. The UK is mentioned in an article in 2005. Although the results are unexpanded, what does come through from the headnotes is that the global RYO/MYO market is expanding.

7. Ms Bates exhibits at CB3 a selection of website pages which she states illustrate use of MYO in a descriptive manner by retailers, manufacturers, such as Landewyck Group, and suppliers to the tobacco industry, such as ITCM. These pages are as follows:

- Page 29: a print made on 30 July 2013 showing that a UK wholesaler called 'deebee' was selling "DISC*JPS MYO TOBACCO CAN 50g" for £13.73.

- Page 31: a retail trade press article dated 19 January 2012 advertising the opponent's JPS tobacco and a cigarette making kit: "Over the past year the economic conditions have prompted growing numbers of consumers to seek more value for money from their tobacco purchases. Many smokers are switching to roll your own (RYO) tobacco for the control and economy offered by that segment and this has ensured dramatic growth. The 'make your own' proposition (MYO) provides costs conscious consumers with a lower priced alternative to both cigarettes and RYO tobacco."

- Page 32: a page from a retail press website called "Convenience Store", with an article on tobacco dated 15 August 2013, which says "On the subject of value, the Make Your Own (MYO) segment of the category is expected to become an increasingly prominent feature in 2013/14 and beyond as consumer awareness and understanding of how the kits work, and the value that they offer, grows."

- Page 36: a page from what appears to be the blog or website of a smoker aficionado (MrTobacco.co.uk). This page includes a heading "MYO (Make Your Own), with a picture of a cigarette making machine, with a cigarette protruding: "The hollow cigarettes that are filled using a machine to produce Kingsized filtered cigarettes that look like any other pre made straight".

- Page 41, printed on 30 July 2013 from the website of a distributor called Landewyck Group, in English, which refers to the distribution of cigarettes,

cigars, cigarillos, pipe tobacco, RYO, MYO in the Canary Islands, Portugal, Italy, Austria, Slovenia, Switzerland, Bulgaria, Albania and Kosovo.

- Page 44: a page from a website called 'forecourt trader', with an article dated 9 June 2011: "Imperial Tobacco says it is helping fight the illicit tobacco trade with its new JPS make-your-own (MYO) cigarette kit. MYO cigarettes have been available before in the UK but without the backing of a big brand name like JPS. However, don't get too excited just yet as the product was launched into the grocery multiples in March but will not make its way into the independent trade until later in the summer."

- Page 50, printed on 30 July 2013, referring to a company called ICTM which provides cigarette packaging machines: "Our highly skilled and knowledgeable engineering teams are able to create packaging solutions across a wide range of tobacco packaging products that include cigarettes, cigars, roll your own (RYO)/make your own (MYO) tobacco products and snuss."

- Page 51, which was printed on 5 February 2014, which appears to be from the website of a retailer called eurobaccy.com, with a menu as follows:

    Cigarettes
    Cigars
    Tobacco
        All products
        Ryo pouches
        Myo tabs
        Pipe tobacco

- Page 55, printed on 5 February 2014, from the website of a wholesaler called Blakemore, with prices in sterling. Amongst the list of products for sales is "JPS Make Your Own Tobacco" and "JPS MYO Tobacco".

- Page 61, printed on 5 February 2014, from a website called wholeleaftobaccoonly.com, with prices in sterling, referring to converting the leaves into RYO, MYO, or pipe tobacco.

8. Exhibit CB4 is a page printed on 17 October 2013 from a website of the packaging company RPC Superfos, in which it discusses a packaging solution for the applicant's tobacco:

> "The traditional packaging for the MYO-tobacco is plastic bags or composite cans but BAT observed a new trend on the MYO market in central Europe: plastic containers appeared to become increasingly popular so BAT decided to launch tobacco in plastic containers."

Mr Bas Castelijn, Sourcing Manager at British American Tobacco Western Europe states:

> "The container ...gives us what we want from the packaging of our MYO tobacco... [t]he co-operation with RPC Superfos went very well. Together we have done a good job for this new line extension and the end user is happy about MYO tobacco in a SuperLift container."

9. Ms Bates states that other tobacco manufacturers (apart from the parties in these opposition proceedings) use MYO in a descriptive manner. An example is provided in Exhibit CB5, from the website of Japan Tobacco International, which Ms Bates states is one of the largest tobacco companies in the world. Page 68 of the evidence is an article appearing on the website dated 24 May 2012, which says "JT to Acquire Leading Roll your Own/Make your Own Tobacco Company...Our investment in Gryson [a Belgian firm] present Japan Tobacco International ... with an attractive opportunity to enhance its position in the growing and profitable RYO/MYO market in Europe...". A further page (69 of the evidence) lists the ingredients in "Camel MYO Blue in Belgium" and "Winston MYO Classic in Belgium".

10. Exhibit CB6 is a screenshot from the website of Scandinavian Tobacco Group, printed on 30 July 2013, which contains a list (in English) of the company's tobacco brands, which have either MYO or RYO after the brand name (e.g. Escort (MYO) and Falcon (RYO). At the bottom of the page, it says:

> "Roll-Your-Own (RYO) means home made hand rolled cigarettes with paper and tobacco alone.
> Make-Your-Own (MYO) means home made cigarettes rolled with paper and tobacco with the help of a small filling machine."

11. Ms Bates states that MYO is also used by the Commission of the European Communities and exhibits (CB7) a copy of a Commission document dated 27 June 2008 relating to the merger of British American Tobacco Plc and Skandinavisk Tobakskompagni. On page 2 of the document, there is a footnote:

> "RYO is a semi-finished product offered as a pack of loose tobacco and used in conjunction with paper wrappers with which consumers can roll cigarettes themselves. For Make Your Own ('MYO'), a stuffing/injection machine (hand-held or desktop) and an empty filter cigarette tube are used. An MYO cigarette normally looks more like a manufactured cigarette than a RYO cigarette."

Page 2 of the document says that where RYO is used in the document, it signifies both of the definitions contained in the footnote which I have reproduced above. Page 3 of the document states:

> "13. The notifying party submits that there is a separate market for RYO, including Make Your Own tobacco ('MYO') which is distinct from the FMC [factory manufactured cigarettes] market."

12. The final factual part of Ms Bates' statement (as opposed to submissions) relates to MYO being a recognised acronym for 'make your own', shown on screenshots taken from acronymfinder.com and allacronyms.com, where the meaning is shown as second and fourth. Ms Bates also exhibits details of a trade

mark registration in the US[3] for GOLDEN HARVEST RYO MYO TOBACCO, in which RYO, MYO and TOBACCO are disclaimed.

The applicant's evidence

13. This comes from Rachel Wilkinson-Duffy, the applicant's trade mark attorney, and from Lars Engel, Western Europe Brand Development Manager for one of the BAT companies in the group to which the applicant belongs.

14. Ms Wilkinson-Duffy's statement is dated 7 April 2014. She states that the information contained within it is taken from her own personal knowledge as an English-speaking UK resident and consumer:

> "Based on my personal experience as a former smoker and having a husband who has smoked hand rolled cigarettes for many years, I believe the term "MYO" is not a known acronym for "make your own" in the English language, at least in the United Kingdom, either generally or specifically in relation to tobacco products. In my experience, hand rolled cigarettes are most commonly referred to as "roll ups" or sometimes "rollies". Whilst I do not doubt that the term "make your own" would be understood by UK consumers as describing a process of rolling cigarettes, I do not believe that the term "MYO" is likely to be understood as an acronym for "make your own", but rather an invented word."

15. Ms Wilkinson-Duffy's statement, as a consumer, albeit one who is acting for the applicant in these proceedings, was filed after the Registry refused the applicant permission to file a survey of UK consumer's views relating to MYO. The refusal was given after consultation with a (different) hearing officer on the basis that he was not satisfied that such a survey had sufficient potential relevance because it would be focused on the end-users of the goods and would not take into account the perception of the sign in question from the perspective of the trade, which is an important factor in absolute ground cases. The applicant did not ask to be heard on the preliminary view to refuse permission to adduce a survey.

16. Having put the opponent to proof in its counterstatement that MYO is a term used in the tobacco trade, Mr Engel concedes in his statement, dated 4 April 2014, that MYO is used by the tobacco industry. He states:

> "3. Based on my knowledge, the term "MYO" is a term used only by manufacturers in the tobacco industry and not by the general end-consumers of tobacco goods. The structure of the trade is such that the term "MYO" is exclusively used by tobacco manufacturers but not be end-consumers.
>
> 4. In the trade, the term "MYO" is almost always used alongside the definition "make your own". The term will not, in my view, be readily understood when seen on its own without this explanatory addition beside it."

[3] Exhbit CB8.

17. Mr Engel exhibits one of the same prints of acronyms as Ms Bates, from acronymfinder.com, and a further exhibit to show that this is a US-centric site, so although MYO might be understood by US consumers, it does not follow that the term is known to or understood by consumers in the UK.

Decision

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

> "**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 practice 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."

19. If a mark is objectionable under sections 3(1)(b,(c) or (d) of the Act, it is because the mark will not be able to fulfil its essential function, set out by the Court of Justice of the European Union ("CJEU") in *Koninklijke Philips Electronics NV and Remington Consumer Products Ltd,* Case C-299/99:

> "30. Moreover, according to the case-law of the Court, the essential function of a trade mark is to guarantee the identity of the origin of the marked product 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, and for the 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 (see, in particular, Case C-349/95 Loendersloot [1997] ECR I-6227, paragraphs 22 and 24, and Case C-39/97 Canon [1998] ECR I-5507, paragraph 28)."

20. It is well established in law that the absolute grounds for refusing registration must be examined separately, although there is a degree of overlap between

sections 3(1)(b), (c) and (d) of the Act. The CJEU said in *SAT.1 Satellitenfernsehen GMBH v OHIM*, case C–329/02 P [2005] E.T.M.R. 20:

> "25 Thirdly, it is important to observe that each of the grounds for refusal to register listed in Art.7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C–456/01 P and C–457/01 P Henkel v OHIM [2004] E.C.R. I-0000 , [45] and [46])."
> ….

21. The central argument between the parties in this case involves the identity of the average consumer for the goods. Mr Engel accepts in his evidence that MYO is a term used only by manufacturers in the tobacco industry (and then in conjunction with the words make your own) and not by end-consumers of the goods. The applicant submits that it matters not that the industry uses it descriptively: what matters is the perception of the end-consumer, rather than the trade. The opponent takes the opposite view: if the mark will not function as a trade mark for one type of consumer, it must be objectionable, even if that consumer group is the trade.

22. The applicant relies upon three judgments to show that the perception of end-users is paramount. The first is from the CJEU, *Björnekulla Fruktindustrier AB v Procordia Food AB*, Case C-371/02, [2004] R.P.C. 45:

> "20 The essential function of the trade mark is to guarantee the identity of the origin of the marked goods or service to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or service from others which have another origin (see, inter alia, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, and Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 22). For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the EC Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have been produced under the control of a single undertaking which is responsible for their quality (*Canon*, paragraph 28).
>
> 21 That essential function of trade marks has been incorporated by the Community legislature into Article 2 of the Directive, which provides that signs which are capable of being represented graphically may only constitute a trade mark if they are capable of distinguishing the goods or services of one undertaking from those of other undertakings (*Merz & Krell*, paragraph 23).
>
> 22 That condition is given effect to in, inter alia, Articles 3 and 12 of the Directive. While Article 3 specifies the circumstances in which a trade mark is incapable, *ab initio*, of fulfilling its function as an indication of origin, Article 12(2)(a) addresses the situation where the trade mark is no longer capable of fulfilling that function.

23 If the function of the trade mark as an indication of origin is of primary importance to the consumer or end user, it is also relevant to intermediaries who deal with the product commercially. As with consumers or end users, it will tend to influence their conduct in the market.

24 In general, the perception of consumers or end users will play a decisive role. The whole aim of the commercialisation process is the purchase of the product by those persons and the role of the intermediary consists as much in detecting and anticipating the demand for that product as in increasing or directing it.

25 Accordingly, the relevant classes of persons comprise principally consumers and end users. However, depending on the features of the product market concerned, the influence of intermediaries on decisions to purchase, and thus their perception of the trade mark, must also be taken into consideration.

26 The answer to the question referred must therefore be that Article 12(2)(a) of the Directive should be interpreted as meaning that in cases where intermediaries participate in the distribution to the consumer or the end user of a product which is the subject of a registered trade mark, the relevant classes of persons whose views fall to be taken into account in determining whether that trade mark has become the common name in the trade for the product in question comprise all consumers and end users and, depending on the features of the market concerned, all those in the trade who deal with that product commercially."

23. The second case relied upon is *Backaldrin Österreich The Kornspitz Company GmbH v Pfahnl Backmittell GmbH*, Case C-409/12:

"8 Backaldrin had the Austrian word mark KORNSPITZ registered for goods in Class 30 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. Those goods include the following:

'flour and preparations made from cereals; bakery goods; baking agents, pastry confectionery, also prepared for baking; pre-formed dough … for the manufacture of pastry confectionery'.

9 Under that trade mark, Backaldrin produces a baking mix which it supplies primarily to bakers. They turn that mix into a bread roll which is oblong in shape and has a point at both ends. Backaldrin consented to the use of that trade mark by those bakers and the foodstuffs distributors supplied by them in the sale of that bread roll.

10 Backaldrin's competitors, which include Pfahnl, like the majority of bakers, know that the word sign 'KORNSPITZ' has been registered as a trade mark. By contrast, according to Pfahnl's claims, which Backaldrin disputes, that word sign is perceived by end users as the common name for a bakery product, namely for bread rolls which are oblong in shape and have a point at

both ends. That perception is explained, inter alia, by the fact that the bakers using the baking mix provided by Backaldrin do not generally inform their customers either that the sign ‘KORNSPITZ’ has been registered as a trade mark or that the bread rolls are produced using that mix.

...

23 In the case described by the referring court, which remains subject to its factual assessment alone, the end users of the product at issue in the main proceedings, namely the bread rolls known as ‘KORNSPITZ’, perceive that word sign as the common name for that product and are not, therefore, aware of the fact that some of those bread rolls have been made using a baking mix supplied under the trade mark KORNSPITZ by a particular undertaking.

24 As the referring court has also stated, that perception on the part of end users is due, in particular, to the fact that the sellers of the bread rolls made using that mix do not generally inform their customers that the sign ‘KORNSPITZ’ has been registered as a trade mark.

25 The case set out in the order for reference is, in addition, characterised by the fact that the sellers of that finished product do not generally, at the time of sale, offer their customers assistance which includes an indication of the origin of the various goods for sale.

26 Clearly, in such a case, the trade mark KORNSPITZ does not, in the trade in respect of the bread rolls known as ‘KORNSPITZ’, fulfil its essential function as an indication of origin and, consequently, it is liable to revocation in so far as it is registered for that finished product if the loss of its distinctive character in respect of that product is attributable to acts or inactivity of the proprietor of that trade mark.

27 That finding is not contrary to the interpretation of Article 12(2)(a) of Directive 2008/95 given by the Court in paragraph 26 of the judgment in *Björnekulla Fruktindustrier*, according to which, in cases where intermediaries participate in the distribution of a product which is the subject of a registered trade mark, the relevant classes of persons whose views must be taken into account in determining whether that trade mark has become the common name in the trade for the product in question comprise all consumers or end users and, depending on the features of the market concerned, all those in the trade who deal with that product commercially.

28 It is true, as the Court highlighted in that interpretation, that whether a trade mark has become the common name in the trade for a product or service in respect of which it is registered must be assessed not only in the light of the perception of consumers or end users but also, depending on the features of the market concerned, in the light of the perception of those in the trade, such as sellers.

29 However, as the Court pointed out in paragraph 24 of the judgment in *Björnekulla Fruktindustrier*, in general, the perception of consumers or end users will play a decisive role. It must be held, in line with what the Advocate

> General stated at points 58 and 59 of his Opinion, that in a case such as that at issue in the main proceedings, which is, subject to verification by the referring court, characterised by the loss of distinctive character of the trade mark concerned from the point of view of the end users, that loss may result in the revocation of that trade mark. The fact that the sellers are aware of the existence of that trade mark and of the origin which it indicates cannot, on its own, preclude such revocation.
>
> 30 It follows from all of the foregoing considerations that the answer to the first question referred is that Article 12(2)(a) of Directive 2008/95 must be interpreted as meaning that, in a case such as that at issue in the main proceedings, a trade mark is liable to revocation in respect of a product for which it is registered if, in consequence of acts or inactivity of the proprietor, that trade mark has become the common name for that product from the point of view solely of end users of the product."

24. The third case relied upon is from the High Court, *Hasbro Inc, Hasbro SA and Hasbro UK Ltd v 123 Nahrmittel GmbH* [2011] EWHC 199, in which Mr Justice Floyd said, in relation to acquired distinctiveness and the CJEU's judgment in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, Case C-342/97):

> "... a mark can possess distinctive character if only a proportion of the relevant public recognises that the mark means that the goods originate from a particular undertaking. The proportion of the relevant public which identifies the mark as denoting origin is a factor which the court must take into account in assessing distinctiveness. But it follows from this that the existence of a proportion of the relevant public who have not heard of the mark, or do not regard it as identifying the goods of a particular undertaking is not necessarily destructive of validity.

25. Mr Malynicz submitted that the arguments based on *Kornspitz* should be rejected, not least because that was a retrospective exercise, looking at use which has been made of a mark, but not from the perspective of a mark which may now or in the future serve in trade to designate characteristics of the goods, bearing in mind the public interest. As per *Wm. Wrigley Jr. Company v OHIM* ('Doublemint'), Case C-191/01 P, a mark must be refused registration if at least one of its possible meanings is descriptive, even if the mark has not yet been used. Mr Malynicz illustrated the opponent's point that the mark must be rejected even if the public does not see a mark as descriptive, but the trade does, by using a hypothetical example from the pharmaceutical industry. He submitted that the trade (doctors, pharmacists) may know a name as indicating a certain chemical composition but the public may not. The mark must nevertheless be refused registration because there is a public interest in keeping it free when at least one of its meanings to at least one section of the relevant public (e.g. the trade) is descriptive.

26. Mr Malynicz submitted that it was important to take into account intermediaries and wholesalers; it could be the case that the goods are only sold to traders, and not to end-users. In his submission, MYO/MYO PRECISE is a paradigm case of the public interest in keeping terms free for other traders to use in the natural course of their business. In relation to section 3(1)(d) of the Act, he submitted that the

question is whether it has become a common name in the trade, not just the common name in the trade, relying upon *Hormel Foods Corporation v Antilles Landscape Investments N.V.* [2005] EWHC 13 (Ch), in the context of section 46(1)(c) of the Act:

> "If a trade mark has become a common name for goods or services for which it is registered, then it can no longer perform this essential function even if there are also other common names for those goods or services."

27. In *Matratzen Concord AG v Hukla Germany SA,* Case C-421/04, the Court of Justice held (my emphasis):

> "24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779, paragraph 29; Case C-363/99 Koninklijke KPNNederland [2004] ECR I-1619, paragraph 77; and Case C-218/01 Henkel [2004] ECR I-1725, paragraph 50)."

28. In *Exalation v OHIM*, Case T-85/08, the General Court confirmed that, at least where technical terms are concerned, it is appropriate to take account of meaning known to those in the trade. This reasoning is reflected in Mr Malynicz's pharmaceutical example. The court stated that:

> "40 First, that technical term [lycopin] designates a food supplement necessarily known by some of the relevant public, in particular professionals dealing with dietetic, pharmaceutical and veterinary preparations.
>
> 41 Secondly, the Board of Appeal established in the contested decision that the meaning of the term 'lycopin' was easily accessible to consumers of all the goods covered by the application for registration. The meaning of the term 'lycopin' does in fact appear in dictionaries and on web sites. It is probable therefore that the substance designated by that term is also known by some of the consumers of all the goods listed in paragraph 3 above.
>
> 42 Thirdly, consumers of pharmaceutical, veterinary, dietetic and sanitary preparations for medical use who are not aware of the meaning of the term 'lycopin' will often tend to seek advice from the informed section of the relevant public, namely doctors, pharmacists, dieticians and other traders in the goods concerned. Thus, by means of the advice received from those who prescribe it or through information from various media, the less well informed section of the relevant public is likely to become aware of the meaning of the term 'lycopin'.
>
> 43 The relevant public must therefore be regarded as being aware of the meaning of the term 'lycopin', or at least it is reasonable to envisage that the

relevant public will become aware of it in the future (see paragraphs 25 and 26 above)."

29. These two cases support the opponent's position that descriptiveness must be assessed through the perception of the relevant public which includes those in the trade. In *Björnekulla Fruktindustrier*, the question referred to the CJEU was:

> "In cases where a product is handled at several stages before it reaches the consumer what is or are, under Article 12(2)(a)[4] of the Trade Mark Directive, the relevant circle or circles for determining whether a trade mark has become the common name in the trade for a product in respect of which it is registered?"

The CJEU began by stating:

> "14 The answer to the question referred by the national court depends principally on the meaning of the expression "in the trade" used in Art.12(2)(a) of the Directive."

It went on to find:

> "The answer to the question referred must therefore be that Article 12(2)(a) of the Directive should be interpreted as meaning that in cases where intermediaries participate in the distribution to the consumer or the end user of a product which is the subject of a registered trade mark, the relevant classes of persons whose views fall to be taken into account in determining whether that trade mark has become the common name in the trade for the product in question comprise all consumers and end users and, depending on the features of the market concerned, all those in the trade who deal with that product commercially."

30. This was because although, in general, the perception of end users plays a decisive role, the role of the intermediary is important because it is the intermediary who 'commercialises' the product by detecting and anticipating the demand for the products, and by increasing or directing that demand. The opponent has provided evidence which shows retailers using the term 'make your own' and MYO interchangeably, and not, contrary to what Mr Engle states, together. The message which comes through from the evidence as a whole is that the market for making your own cigarettes is taking off; the article on the 'forecourt trader' website suggests that the opponent's MYO/make your own kits will be a product which petrol station retailers will want to sell as this is a growth area and they will be profitable. These are intermediaries who will direct consumers towards tobacco and paraphernalia which enables them to make cigarettes. If retailers buying from the tobacco industry encounter the term MYO which is used descriptively by the tobacco industry, then that is the term which they will naturally use to promote and display such goods. This is apparent from the opponent's evidence from deebee and Blakemore who use the term MYO in trade without further explanation. The deebee print is dated only a month after the date of application and refers to the opponent's JPS MYO

[4] Equivalent to section 46(1)(c) of the Act.

TOBACCO CAN. Although the Blakemore print was printed after the date of application, it too refers to the same item, JPS MYO. The 'forecourt trader' article also refers to the same item, but well before the date of application.

31. The applicant points to *Kornspitz* as showing that even when the trade knew that a term was a trade mark and not descriptive of the goods, it made no difference because the end users regarded it as a description of the goods. Therefore, on the logic of *Kornspitz*, I should pay no attention to the perception of the tobacco trade because the end consumer does not know what MYO means. The opponent submits that even if the end consumer does not know now what MYO means, it may well do so in the future, as per *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] E.T.M.R. 57:

> "56 In those circumstances, the competent authority must, under Art.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 , para.[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 Art.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 indications which may serve to describe characteristics of its goods or services."

32. In the first supplement to *Kerly's Law of Trade Marks and Trade Names*, fifteenth edition, the editors say[5], having referred to paragraph 98 of *Schutz (UK) Ltd & Anor v Delta Containers Ltd & Anor* [2011] EWHC 1712 (Ch):

> "This passage also indicates that in any given case there may be more than one relevant class of people and the task of the Court is to identify the typical consumer representative of each class. See for example *Hearst v AVELA*[6] where it is apparent that Birss J. considered three classes, licensees, retailers

[5] At chapter 2-020k.
[6] [2014] EWHC 439.

and end consumers, adopting the viewpoint of an average consumer for each class."

33. In *Jack Wills Ltd V House of Fraser (Stores)* Ltd [2014] EWHC 110 (Ch), Arnold J observed that there may be more than one segment of the relevant class of persons and it will rarely be appropriate to treat the average consumer as representative solely of one of those segments. In *Interflora v Marks & Spencer* [2013] EWHC 1291 [212-224] he found that there is no single meaning rule in European trade mark law; i.e. there is no rule that states that a mark has a single meaning in law even if it is in fact understood by different people in different ways, citing the passage relied upon by the applicant in these proceedings from *Hasbro,* which I have reproduced above at paragraph 23 of this decision.

Section 3(1)(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.

34. The enquiry is not whether the marks MYO and MYO PRECISE are descriptive of a characteristic of the services, although that could also apply to a mark which falls foul of section 3(1)(d). It is whether the marks were customary in the current language (of the UK territory) or were customary in the bona fide and established practice of the trade (i.e. in the trade the subject of the opposed goods) at the date of application.

35. In *Telefon & Buch Verlagsgesellschaft mbH v OHIM,* Case T-322/03, the General Court summarised the case law of the Court of Justice under the equaivalent of s.3(1)(d) of the Act, as follows:

> "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).

52.Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS,* paragraph 40)."

36. The CJEU, in *Björnekulla Fruktindustrier*, said that 'in the trade' should be interpreted as meaning that in cases where intermediaries participate in the distribution to the consumer or the end user of a product, the relevant classes of persons include all those in the trade who deal with the goods commercially. This includes retailers and wholesalers. The evidence shows use of both RYO and MYO, but the articles exhibited make a distinction between them. Wholesalers know that there is a difference and that MYO refers to goods which enable a smoker to make his own cigarettes which look more like manufactured cigarettes than roll-ups. The evidence I have listed at paragraph 7 is not from manufacturers but is from retailers, wholesalers and those in the retail press. "Forecourt trader", in June 2011, says that "MYO cigarettes have been available before in the UK but without the backing of a big brand name like JPS". Deebee and Blakemore use the abbreviation without expansion to 'make your own'. The evidence shows that MYO is clearly used by manufacturers on their websites, in their trade press articles, and when referring to packaging options for MYO products. Landewyck Group referred to distribution of RYO and MYO tobacco, in a print taken a month after the relevant date. Although distribution to the UK is not specified, RYO and MYO are mentioned elsewhere in the evidence in connection with the UK, so it is a reasonable assumption that Landewyck Group would use both these terms if distributing to the UK, as the print is in English. Although there is no evidence that, at the relevant date, the end consumer of cigarettes knew what MYO means, I find that at that date MYO had become customary in the bona fide and established trade practices of those who deal commercially with the goods of the application (trade intermediaries), in addition to manufacturers of the goods in question. The section 3(1)(d) ground succeeds in relation to MYO (application 3008663). There is no evidence of use of the combination MYO PRECISE; therefore, the objection under section 3(1)(d) in relation to MYO PRECISE (application 3008672) fails.

Section 3(1)(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.

37. The case law under section 3(1)(c) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch), with my underlining:

"91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

> "33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).
>
> 36. … due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).
>
> 37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).
>
> 38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).
>
> 39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-

2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (Koninklijke *KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland* , paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a ‘characteristic’ of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms ‘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’, the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis

> of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."
>
> 92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

38. I have underlined the last paragraph because there have been submissions that MYO could refer to such entities as the Metropolitan Youth Orchestra.

39. MYO has not been confined to manufacturers as an abbreviation for make your own; as found above, intermediaries in the trade are using it. This means that MYO as a descriptive term is more likely to be placed before the public. There is a clear picture from the evidence that the market for making your own cigarettes is growing. For example, Ms Bates exhibits a page from the applicant's own website which refers to make-your-own tobacco growing in popularity in Western Europe. There is no reason to suppose that the UK is not included in that trend. The retail trade press article from January 2012 says that economic conditions have prompted many smokers to look for more value for money and that MYO provides cost conscious consumers with a lower priced alternative to both cigarettes and RYO tobacco. The article from 'Convenience Store' is dated only two months after the date of application and says that the MAKE YOUR OWN (MYO) segment is expected to become increasingly prominent in 2013/2014 as consumer awareness and understanding of how the kits work grows.

40. Trade intermediaries play a natural part in assisting the growth of consumer awareness of products; as per the CJEU, in *Björnekulla Fruktindustrier*, "the role of the intermediary consists as much in detecting and anticipating the demand for that product as in increasing or directing it". Consequently, intermediaries may use to the public the descriptive terms that they themselves use, especially when that term is a natural abbreviation, such as MYO. The letters are likely to be recognised as an abbreviation with little or no assistance from the trade when used in relation to goods to make your own cigarettes. Intermediaries will follow the trade's example in using MYO as a descriptive abbreviation, and the public will follow suit. Although there is no evidence that, at the relevant date, the end consumer of cigarettes knew what MYO means in relation to the goods of the application, the issue is whether consumers will, in the future, understand what the term means. I agree with Mr Malynicz that the logic in *Kornspitz* is not completely reversible because the test under section 3(1)(c) has a futurity aspect. The fact that a mark must be cancelled if it becomes a common name for the goods to the public does not mean that it must be registered if it currently has no meaning so far as the public are concerned.

41. In relation to the goods in class 7, *machines for processing tobacco; parts and fittings for such machines*, these appear to be goods used by manufacturers. The

general interest underlying section 3(1)(c) of the Act is to ensure that descriptive signs relating to one or more characteristics of the goods may be freely used by all traders offering such goods (*Doublemint*). MYO is a term used by manufacturers and those who package the tobacco, from the evidence filed. Processing of tobacco could include the tins or containers into which make your own tobacco is placed for sale. Consequently, it seems to me that the monopolisation of a term which is used by the major players in the tobacco industry and also by other traders in relation to the processing of tobacco for use in the make your own market would be unfair.

42. I find that the mark MYO consists exclusively of letters which may serve, in trade, to designate the goods of the application used to make your own cigarettes. Those goods to which the objection applies are:

Class 34: *Tobacco; tobacco products; smokers' articles; machines for rolling cigarettes*.

Class 7: *Machines for processing tobacco. Parts and fittings for such machines.*

43. I also find that the opposition to the mark MYO PRECISE also succeeds against these goods. This is because the evidence shows that the aim of make your own cigarette paraphernalia is to produce a cigarette which mimics the appearance of a manufactured cigarette. 'Precise' will be perceived by the average consumer as meaning that the goods enable you to make your own cigarettes which look accurate or are precise/exact in appearance. It is laudatory and descriptive of such goods.

Section 3(1)(b): trade marks which are devoid of any distinctive character

44. The principles to be applied under art.7(1)(b) of the CTM Regulation (equivalent to section 3(1)(b) of the Act) were conveniently summarised by the CJEU *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

> "29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel* v *OHIM* [2004] ECR I-5089, paragraph 32).
>
> 30. Under that provision, marks which are devoid of any distinctive character are not to be registered.
>
> 31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve 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 (*Henkel* v *OHIM*, paragraph 34; Case C-304/06 P *Eurohypo* v *OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi* v *OHIM* [2010] ECR I-0000, paragraph 33).
>
> 32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been

applied for and, second, by reference to the perception of them by the relevant public (*Storck* v *OHIM*, paragraph 25; *Henkel* v *OHIM*, paragraph 35; and *Eurohypo* v *OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat* v *OHIM* [2004] ECR I-10107, paragraph 78; *Storck* v *OHIM*, paragraph 26; and *Audi* v *OHIM*, paragraphs 35 and 36)."

45. Owing to my findings above that the term is descriptive for the goods listed in paragraph 40, the marks MYO and MYO PRECISE will not serve in trade to identify the products in respect of which registration is applied for as originating from a particular undertaking. Consequently, in relation to these goods, the opposition also succeeds under section 3(1)(b) of the Act.

46. This leaves *cigarettes, lighters* and *matches* to consider. The consideration here is whether the marks are objectionable for these goods because they are closely allied to goods which enable one to make your own (precise) cigarettes. In *The Range Cooker Co Plc* v *The Fourneaux De France Limited*, BL O/240/02, Mr Geoffrey Hobbs QC, sitting as the Appointed Person considered the mark FOURNEAUX DE FRANCE which translates into 'cookers from France'. The mark was objectionable under section 3(1)(c) as describing cookers (from France)[7]. The issue was whether closely allied goods, which comprised cooker hoods and extractor fans, "should be treated as goods so closely related to cookers as to be an integral part of the commercial context in which the meaning and significance of the words FOURNEAUX DE FRANCE is to be regarded as essentially descriptive." Mr Hobbs concluded that cooker hoods and extractor fans were items of commerce which were closely connected with cookers and that it would be unrealistic to treat FOURNEAUX DE FRANCE as descriptive of cookers and not of such closely connected goods.

47. In BL O/218/02, Mr Hobbs, sitting as the Appointed Person, considered the mark "Tools and Middleware" to be devoid of any distinctive character for a wide range of goods in class 9. The applicant had tried to overcome the examiner's descriptiveness objection to the mark by limiting the specification away from tools and middleware; tools describing a type of software, and middleware describing computer products which sit between hardware and software. Mr Hobbs considered that the mark was "an ordinary way of designating the general nature of the goods of interest to the Applicant and are not likely to trigger origin-specific perceptions and recollections in the mind of the average consumer of the goods concerned."

48. In a decision for the Registrar[8], Mr Allan James, the Hearing Officer, considered the mark COMPUTER BOOKSHOPS in classes 9, 16 and 41. The mark had been objected to by the examiner under sections 3(1)(b) and (c) of the Act on the basis that it described goods and services relating to a shop which sells books about computers. Mr James waived the objection raised under section 3(1)(c) but maintained that the objection under section 3(1)(b) was validly raised and that the

[7] The grounds of invalidity in that case were 3(1)(a), 3(1)(c) and 3(3)(b) of the Act. There was no section 3(1)(b) ground.
[8] BL O/266/02.

mark was devoid of any distinctive character for the goods and services in the application. He observed that:

> "... the Registrar has long been reluctant to register the name of one product as a trade mark for another product in a closely related sector of the market: see Portogram Radio Electrical Company Limited's Application 69 RPC [1952] 241 at 245. I believe that it is self evident why the word "duvet", for example, would not be able to function as a trade mark for bed sheets, or why the word "shirt" would not function as a trade mark for ties. In use in relation to such goods these signs would be, at best, ambiguous as to their meaning, and would probably just result in confusion. A similar point arose in a recent decision dated 2 May 2002 of Mr G Hobbs QC as Appointed Person in Fourneaux de France Limited v The Range Cooker Co. plc, SRIS 0-240-02."

49. In my view, MYO and MYO PRECISE, for *cigarettes, lighters* and *matches*, fall into the same camp as DUVET for bed sheets and SHIRT for ties. Whilst not directly descriptive of ready-made cigarettes, lighters and matches, MYO and MYO PRECISE for these goods would be ambiguous and confusing because there is insufficient clear blue water between goods for which the description is apt and those which are closely allied to those goods. For this reason, the mark would not be able to do the job of identifying the commercial source of the goods and would not, therefore, perform the essential function of a trade mark which is to distinguish the applicant's goods from those of other traders. **The opposition succeeds against all the goods of the application under section 3(1)(b) of the Act.**

Outcome

50. The opposition succeeds in full.

Costs

51. The opponent has been successful and is entitled to a contribution towards its costs. Both parties were content for the scale of costs published in Tribunal Practice Notice 4/2007 to apply. The costs breakdown is as follows:

Considering 2 notices of opposition	£400
Opposition fee x 2	£400
Filing evidence and considering applicant's evidence	£1000
Preparing for and attending a hearing	£1000
Total	**£2800**

52. I order British American Tobacco (Brands) Inc. to pay Imperial Tobacco Limited the sum of £2800 which, in the absence of an appeal, should be paid within seven days of the expiry of the appeal period.

Dated this 29th day of October 2014

Judi Pike
For the Registrar,
the Comptroller-General