

TRADE MARKS ACT 1994

AND

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996
IN THE MATTER OF INTERNATIONAL REGISTRATION No 811890
AND THE REQUEST BY FOSSIER CARMINE
TO PROTECT A TRADE MARK IN CLASS 6**

Background

1. On 12 September 2003, Fossier Carmine, Zone Industrielle, 97 Rue du Chateau-d'eau, F-80100 Abbeville, France, on the basis of International Registration 811890, requested protection in the United Kingdom under the provisions of the Madrid Protocol of the following mark:



2. Protection is sought in Class 6 in respect of:

Metal keys, metal key blanks, metal locks (other than electric)

3. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and notice of refusal under Article 9(3) was given because the mark is excluded from Registration by Section 3(1)(b) and (c) of the Trade Marks Act 1994. This is because the mark is devoid of any distinctive character because the mark consists exclusively of the cross section of a key or locking device being a sign which may serve, in trade, to designate the kind of goods e.g. keys or key blanks for locking devices.

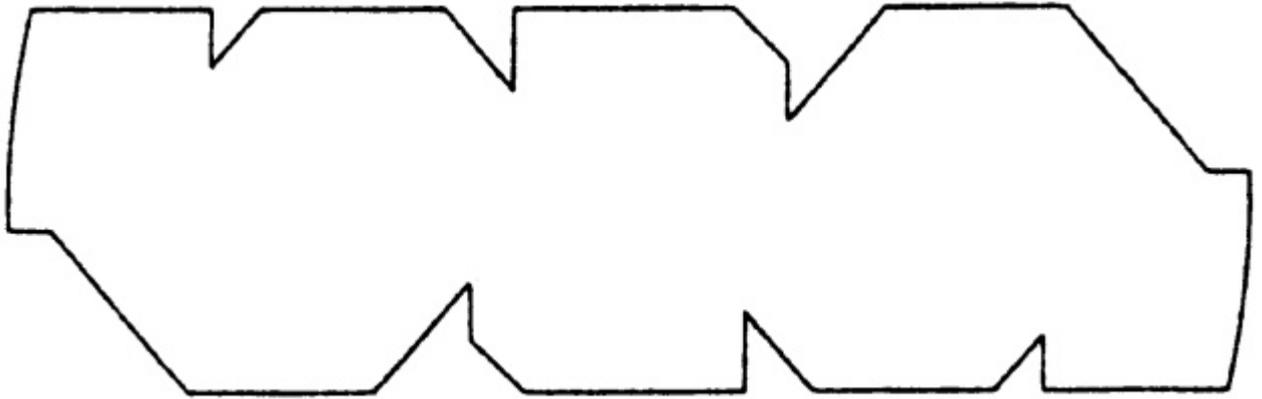
4. Following a hearing, at which the applicant was represented by Mr Grimshaw of Mewburn Ellis, their trade mark attorneys, the objection under Section 3(1)(b) and (c) of the Act was maintained.

5. Notice of refusal was issued under Article 9(3) and I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

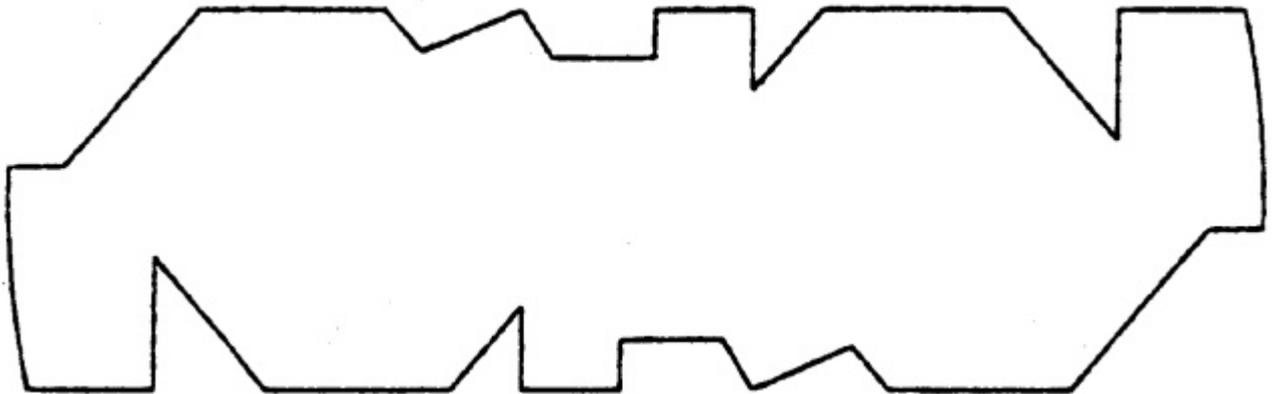
6. No evidence has been put before me. I have, therefore, only the prima facie case to consider.

7. For the sake of completeness I draw attention to the fact that at the hearing on this application I also maintained objections under Section 3(1)(b) of the Act in respect of the following trade marks:

M811891:



M811892:



The Law

8. Section 3(1)(b) and (c) of the Act reads as follows:

“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.”

The case for Registration

9. In correspondence prior to the hearing Mr Grimshaw stated:

“The mark applied for does not appear to us to consist of a “cross-section” of a key, it is simply a fanciful logo mark.

We should explain that the mark applied for was created by the applicant as a stylised mark resulting from their use of the mark TARA. The mark applied for was formed by taking the upper outline of the mark TARA”.

10. In further correspondence on 11 January 2008 Mr Grimshaw explained that the applicant has not yet commenced use of this mark but did enclose samples of “very similar marks currently in use on keys that are sold by our client”. Three keys were enclosed and these are on the official file.

Decision

11. In a judgement issued by the European Court of Justice on 23 October 2003, *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-191/01 P, (the DOUBLEMINT case), the Court gives guidance on the scope and purpose of Article 7(1)(c) of the Community Trade Mark Regulation (equivalent to Section 3(1)(c) of the Trade Marks Act). Paragraphs 28 - 32 of the judgement are reproduced below:

- “28. Under Article 4 of Regulation No 40/94, a Community trade mark may consist of any signs capable of being represented graphically, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.
29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or rendering of the service, or other characteristics of the goods or service are not to be registered.
30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.
31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 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 (see, *inter alia*, in relation to the identical provisions of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73).

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.”

12. Section 3(1)(c) of the Act has common roots to Art. 7(1)(c) of the CTMR, and is substantially identical to that provision. Accordingly, the ECJ’s guidance with regard to that provision may be taken to apply equally to Section 3(1)(c) of the Act. The provision excludes signs which may serve, in trade, to designate the kind of goods or other characteristics of goods. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the services in question.

13. The specification of goods is limited to “Metal keys, metal key blanks, metal locks (other than electric)”. These goods are very specific and are very closely linked, both in function and in their proximity at the point of sale.

14. I am aware that goods such as “metal keys, metal locks” are widely available in a range of outlets and stores throughout the United Kingdom. They are required as a vital necessity for most, if not all, domestic, commercial and industrial premises. It follows that the relevant consumer for such goods are the general public as well as commercial and industrial consumers. This must result in a very high volume of sales and high service levels. Very often these goods are available from both specialist outlets but also from less predictable sources such as shoe repair outlets. This has happened as the result from such commercial undertakings finding it necessary to diversify and provide additional goods and services from those that they have traditionally provided. In respect of “metal blanks” the relevant consumer is more likely to be those organisations and individuals who cut the keys from the blanks.

15. The fact that these goods may be purchased from outlets such as shoe repairers and not just specialist shops suggests that there is a strong business requirement for them to advertise the fact that they sell such goods. Of course, not all keys are so

shaped, for example automobile keys are usually barrel shaped for security reasons but flat keys, with one edge straight and the opposite edge profiled, remain very common. In relation to the goods in question it is my view that this mark will be perceived as no more than an outline of a key.

16. Mr Grimshaw has indicated that the mark represents the upper outline of the word TARA. The same suggestion was made in respect of the other two marks discussed at the hearing (see Paragraph 7 of this decision). The word TARA appears on the three keys provided as examples of the mark in use but I must say that without education of this interpretation of the mark I do not accept that this mark will be so perceived by the relevant consumers. In respect of the goods applied for it will be perceived as the outline of the profile of a key which designates the kind of goods in question.

17. Consequently, I have concluded that the mark applied for consists exclusively of a sign which may serve, in trade, to designate the kind of goods and is, therefore, excluded from registration by Section 3(1)(c) of the Act.

18. Having found that this mark is to be excluded from registration by Section 3(1)(c) of the Act, that effectively ends the matter, but in case I am found to be wrong in this decision, I will go on to determine the matter under section 3(1)(b) of the Act.

19. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in *Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

“37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule 1 Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning 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 products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of

the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

20. I must determine whether the trade mark applied for is capable of enabling the relevant consumer of the goods in question to identify the origin of the goods and thereby to distinguish them from other undertakings. In *OHIM v SAT.1* (Case C-329/02) the European Court of Justice provided the following guidance at paragraph 41:

“41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings.”

21. Section 3(1)(b) of the Act prohibits (prima facie) the registration of trade marks which are devoid of any distinctive character. Its purpose is to prohibit registration of marks which do not fall foul of the clear parameters set by Sections 3(1)(c) and (d) of the Act but, nevertheless, still do not fulfil the function of a trade mark because they do not identify goods and services from one undertaking from those of other undertakings.

22. It is now well established that the matter must be determined by reference to the likely reaction of an relevant consumer of the goods in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. In relation to “metal keys, metal locks” I re-iterate that I consider the relevant consumer to be the general public and commercial and industrial organisations and, in respect of “metal blanks”, I consider the relevant consumer to be those organisations and individuals that cut the keys from the blanks.

23. I am not persuaded that the trade mark applied for is distinctive in that it would serve in trade to distinguish the goods of the applicant from those of other traders. In reaching this conclusion I have considered the mark in its totality. In my view the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark. In respect of the goods applied for this sign will be perceived as an outline of the profile of a key and an indication as to the nature of the goods. I therefore conclude that the mark applied for is devoid of any distinctive character in relation to all of the goods applied for and it is therefore excluded from prima facie acceptance under Section 3(1)(b) of the Act.

Conclusion

24. In this decision I have considered all the documents filed by the applicants and all the arguments submitted to me in relation to this application and, for the reasons given, it is partially refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) and (c) of the Act.

Dated this 21st day of May 2008

**A J PIKE
For the Registrar
The Comptroller-General**