

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
APPLICATION NO. 2188531  
BY AXIONS SA AND MR CHRISTIAN BELCE-KENNEDY  
TO REGISTER A  
TRADE MARK IN CLASS 30**

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### **IN THE MATTER OF APPLICATION NO. 2188531 5 BY AXIONS SA AND MR CHRISTIAN BELCE-KENNEDY TO REGISTER A TRADE MARK IN CLASS 30**

#### **10 DECISION AND GROUNDS OF DECISION**

On 11<sup>th</sup> February 1999, Axions SA and Mr Christian Belce-Kennedy applied under the Trade  
15 Marks Act 1994 for registration of the trade mark CIGAR in respect of the following goods in  
Class 30:

“Chocolate; biscuits; wafers; cookies; confectionery”.

20 Objection was taken against the mark under Section 3(1)(b) and (c) of the Act because it consists  
of the word “cigar”, being devoid of any distinctive character and a term other traders may  
legitimately wish to use for, eg, confectionery in the shape of cigars.

At a hearing at which the applicant was represented by Mr Marcus Collins of White & Case, the  
25 objection was maintained. Following refusal of the application under Section 37(4) of the Act,  
I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to  
provide a statement of the reasons for my decision.

30 In correspondence and at the hearing, Mr Collins put forward various arguments in support of  
acceptance of the mark, which are summarised as follows:

35 **S** the word CIGAR, when applied to chocolate, biscuits, wafers, cookies and confectionery  
does have considerable distinctive character because none of these goods are related to  
tobacco products, smokers’ articles or activities associated with smoking;

**S** the mark when used in relation to the goods is fanciful and therefore distinctive;

40 **S** the mark does not consist exclusively of signs or indications which may serve in trade to  
designate the kind, quality, quantity, intended purpose, value, geographical origin, the  
time and production of goods or other characteristics of the goods;

45 **S** The word CIGAR was previously registered (no 2060963) in relation to soaps, toiletries,  
perfumery, essential oils, cosmetics, hair care preparations and hair lotions. That mark  
was not considered descriptive on grounds that the bars of soap to which it could be  
applied might be cigar shaped. Similarly, the use of the word in relation to the applicant’s  
goods is not objectionable;

S if necessary, in order to satisfy the distinctiveness objection, the specification of goods could be amended by excluding certain goods.

These arguments did not persuade me that the mark is of a distinctive character.

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

The relevant part of the Act under which the objection was taken is as follows:

10 *Section 3(1):*

*The following shall not be registered-*

15 (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.*

20 The mark consists of the well known word “cigar” which does not require further definition by reference to a dictionary. In my view the word CIGAR, when viewed in relation to the goods covered by the application, may serve in trade to designate certain characteristics. From my own knowledge, items of confectionery are manufactured and sold in novelty shapes, the classic example being chocolate Easter eggs. The fact that the goods are not related to smoking is not relevant and I have to consider the possible effect that registration of this mark might have on other businesses in the food trade. For instance, it would seem perfectly reasonable that a novelty confectionery merchant would wish to describe, eg a chocolate in the shape of a cigar as a cigar chocolate and use such a description in the promotion of these goods.

30 In this regard, I take particular note of the comments in the unreported decision of Simon Thorley QC (as appointed person) in the DAY BY DAY trade mark (application no 2068646). He commented:

35 *“In my judgement, Mr James correctly submitted that I should have regard not only to natural use on packaging but also to natural use in the context of advertising .....”.*

and

40 *“The hearing officer was satisfied that the mark might serve to designate the time of delivery of goods or their qualities. I have concluded that this objection to registration is well founded since I am satisfied that the expression “Day by Day” could naturally be used by traders descriptively to indicate those attributes. I believe the examples referred to above demonstrate this. I accept that these are examples of non-trade mark use but that is precisely what section 3(1)(c) is directed against. Put compendiously, this sub-section is directed against the registration of descriptive marks”.*

Furthermore, in the AD2000 trade mark (1997) RPC 168, Geoffrey Hobbs QC said:

5       *“Although section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse registration of signs which are excluded from registration by the provisions of section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacob Esq QC in his decision on behalf of the Secretary of State in Colorcoat Trade Mark [1990] RPC 511 at 517 in the following terms:*

10       *“That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see eg Yorkshire Copper Work Ltd’s Trade Mark Application (1954) RPC 150 at 154 lines 20-25 per Viscount Simonds LC. Essentially the reason is that the privilege of a monopoly should not be conferred where it might require “honest men to look for a defence”.*”

15       Regarding the registration of an identical mark in Class 3, I am not aware of the circumstances surrounding its acceptance and, in any event, each case must be dealt with on its own merits. Mr Justice Jacob in the British Sugar PLC and James Robertson and Sons Ltd (TREAT) decision  
20       (1996) RPC 281 said:

25       *“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the Register. It has long been held that under the old act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see MADAME trade mark (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.”*

30       Having decided that the mark fails to qualify under Section 3(1)(c) of the Act, it follows that the mark is devoid of any distinctive character and also fails to qualify under Section 3(1)(b) of the Act. The test for distinctiveness was clearly set out by Mr Justice Jacob in the TREAT decision  
35       (1996) RPC 281:

40       *“Next, is “Treat” within Section 3(1)(b). What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word inherently from the old Act but the idea is much the same) devoid of any distinctive character.”*

45       I take the view that the public would require educating that the word CIGAR is a badge of origin.

Mr Collins offered to enter an exclusion to the specification of goods which he contended would overcome the objection under Section 3(1)(b)(c). If, for instance, the following exclusion was added: “but not including any such goods in the form of cigars”, it is my view that such a limit would render the mark deceptive and consequently an objection under Section 3(3)(b) of the Act would arise. Items of novelty confectionery, biscuits etc are often sold and promoted using the descriptions that approximate to their shapes, eg “jelly babies” or “gingerbread men”, and it is my opinion that the public would clearly expect a CIGAR confection, biscuit etc, to be cigar shaped. The offer to restrict the specification by excluding goods in order to overcome the distinctiveness objection is therefore rejected.

If the applicant had suggested a positive limitation to the goods, eg a restriction to a specific item, it is possible that a limit in scope might enable the mark to be viewed as being fanciful in relation to that particular product and consequently the objection could be reassessed. However, in the absence of such a proposal and without details about how the mark is being used, or is proposed to be used, I have to maintain the objection.

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

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30 Dated this 20<sup>th</sup> day of February 2001.

Charles Hamilton  
For the Registrar  
the Comptroller General

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