

O-271-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2231137
BY JAMES GILBERT LTD
TO REGISTER A TRADE MARK IN CLASS 28**

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Background

1. On 13 January 2000 James Gilbert Ltd of 5/6 St Matthews Street, Rugby, CV21 3BY, applied under the Trade Marks Act 1994 for registration of a series of two three dimensional marks in respect of the following goods:

Class 28

Games and playthings; sporting articles; footballs

2. The marks for which registration is sought are represented at Annex A.

3. On 24 January 2000 the Registrar advised Kings Patent Agency Limited, the trade mark attorneys representing the applicants, that the application failed to meet the requirements of Section 32(2)(d) of the Trade Marks Act 1994 in that the marks applied for were not represented with sufficient precision to permit a full and effective examination. This objection was overcome and the application given an amended filing date of 27 January 2000.

4. On 5 June 2000 objection was taken under Sections 3(1)(b) and (c) of the Act because the marks consist of a non-distinctive 3-D pattern, being signs which may legitimately be used by other traders to e.g. decorate rugby balls.

5. In addition, on 18 July 2000, a further objection was taken under Section 41(2) of the Act because the marks were not considered to form a series of marks.

6. At a Hearing, at which the applicants were represented by Mr J B King of Kings Patent Agency Limited, their trade mark attorneys, the objection under Section 3(1)(b) was maintained. The objection under Section 3(1)(c) was waived. In addition the objection under Section 41(2) was also waived as the application was to proceed for the first mark in the series only. I will therefore make no further reference to Sections 3(1)(c) and 41(2) of the Act.

7. Following refusal of the application under Section 37(4) of the Act 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.

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

The Law

9. Section 3(1)(b) of the Act reads as follows:

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

(b) trade marks which are devoid of any distinctive character"

The Case for Registration

10. In correspondence prior to the Hearing Mr King made submissions in letters dated 7 June 2000 and 2 August 2000.

11. In his letter dated 7 June 2000 Mr King referred to the applicants' UK registration no. 2004640. It was submitted by Mr King that the distinctive feature formed by the patterns is a variation on registration 2004640 and is in effect, the identical trade mark but applied to a different construction of three dimensional product. In the prior registration the ball was formed from four panels whereas in the present application eight panels are used.

12. Earlier registration 2004640 is at Annex B.

13. In his letter of 2 August 2000 Mr King argued that the pattern of the application was not a common geometrical pattern but one which had been specifically designed for the purpose of identification and that as rugby balls are not items purchased for their decorative nature any pattern must be a deliberate move to identify the product. In addition the typical purchaser of a rugby ball e.g. manager of a club or player would be selective as to the quality and nature of the product and players would associate a marking applied to the ball with a particular product.

14. At the Hearing Mr King maintained that as the applicants already have registration for a mark which incorporated the pattern applied for the objection should be waived. He also argued that the application was a distinctive pattern which had been specifically designed for the applicant and would be perceived by the average consumer as an indication of the origin of the goods. In order to illustrate this argument Mr King exhibited an example of the mark in use as applied to an actual rugby ball.

15. I agreed to consider the information provided and advise Mr King of my decision.

16. By letter of 28 January 2002 I advised the agent that the objection was being maintained. At this time information was provided relating to the application of patterns to rugby balls by several manufacturers, including the applicant.

17. This information is at Annex C.

The Decision

18. The purpose of Section 3(1)(b) is to prohibit registration of signs which, although not

caught by the clear parameters set out by Sections 3(1)(c) and (d) are, nevertheless, incapable of distinguishing the goods and services of one undertaking from those of other undertakings.

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 must first of all be observed 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* [2002] ECR I-5475, 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 judgement 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. In my view the relevant public would not consider this mark to denote trade origin. There is nothing to suggest that the average consumer of sports balls regards patterns per se as identifying the origin of the product and not as merely decorative. The overall impression does not convey trade mark significance. In my view the mark applied for will not be taken as a trade mark without first educating the public.

21. Mr King referred to the applicants' registration 2004640 which had proceeded to registration on the basis of acquired distinctiveness through use and trade evidence and submitted that the distinctive feature of this application is a variation on existing registration 2004640 and is, in effect, the identical Trade Mark but applied to a different construction of three-dimensional product.

22. The proviso to Section 3(1) of the Act states:

"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."

23. In the "*Have A Break*" decision (Court reference CH/2002/APP 0514) Mr Justice Rimer stated at paragraph 26:-

"As a matter of construction, each "it" refers back to "trade mark". It follows in my view that, to establish a case under the proviso, the applicant must prove that the use of the subject mark has resulted in the acquisition by it of a distinctive character."

24. As no evidence of use relating to the subject mark has been submitted the proviso to Section 3(1) cannot therefore apply to this case.

25. The Registrar's Practice Amendment Notice (PAN) 3/02 on Prior Rights says, at paragraphs 12 and 13, that:

"In all cases the applicant must file evidence showing use of the mark applied for, before the date of the application, **in relation to the goods/services listed in the application.**

However, it is recognised that marks that are factually distinctive for one range of goods/services can more quickly become distinctive for similar goods/services. Accordingly, in assessing whether the evidence the applicant has filed on the application under examination is sufficient to show that the mark has acquired a distinctive character for the goods/services listed in the application, account may also be taken of any evidence filed on earlier applications for the same or closely similar trade mark for the same or similar goods/services."

CONCLUSION

26. In this decision I have considered all the documents filed by the agent 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) of the Act.

Dated this 2ND day of September 2003

IAN PEGGIE
For the Registrar
The Comptroller General

Annex available in a paper copy only.

ANNEX A

FIRST MARK IN THE SERIES

The mark comprises a pattern, applied to an ovoid shaped football or a three dimensional representation thereof as shown in the attached representation.

In the first mark in the series the dark and light shaded areas represent areas of different colour, shade or tone.

SECOND MARK IN THE SERIES

The mark comprises a pattern, applied to an ovoid shaped football or a three dimensional representation thereof as shown in the attached representation.

In the second mark in the series the shading represents any colour, shade or tone.