

O-217-07

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 2349793 IN THE NAME OF KABUSHIKI KAISHA MIKI
TO REGISTER THE TRADE MARK CAMELLIA IN CLASS 14**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 92453 IN THE NAME OF
CHANEL LIMITED**

Trade Marks Act 1994

**IN THE MATTER OF trade mark application No. 2349793
in the name of Kabushiki Kaisha Miki
to register the trade mark CAMELLIA
in Class 14**

And

**IN THE MATTER OF opposition thereto under no. 92453
in the name of Chanel Limited**

BACKGROUND

1. On 24 November 2003, Kabushiki Kaisha Miki made an application to register a trade mark incorporating the word CAMELLIA in Class 14 in relation to the following specification of goods:

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones, horological and chronometric instruments.

2. The mark, in its entirety is as follows:

カメラリア
CAMELLIA

3. On 28 April 2004, Chanel Limited filed notice of opposition to the application, the grounds of opposition being as follows:

- 1. Under Section 3(1)(b)** The mark consists essentially of a word that is directly descriptive of a well known flower. It is common for goods of the type covered by the application to be shaped like natural objects such as plants, flowers and animals, and the mark is therefore devoid of distinctive character.
- 2. Under Section 3(1)(c)** because the mark consists of signs or indications which may serve, in trade, to designate characteristics of the goods for which it is sought to be registered.
- 3. Under Section 3(1)(d)** because the mark is consists exclusively of signs or

indications which have or are likely to become customary in the current language and bona fide established practices of the trade.

4. Under Section 5(4)(a) by virtue of the law of passing off.

4. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based.
5. Both sides ask that an award of costs be made in their favour.
6. Only the opponents filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. Neither side took up the offer of an oral hearing, instead electing to file written submissions in lieu of a hearing. After a careful study of the evidence and submissions, I now go on to give my decision.

Opponents' evidence

7. This consists of a Witness Statement from Martin Hamilton, the Company Secretary of Chanel Limited, a post he has occupied for more than 20 years.
8. Mr Hamilton refers to the meaning of CAMELLIA, a definition of which taken from Collins English Dictionary is shown as Exhibit MH1. He says that the mark also includes Katakana script which is simply the phonetic reading of CAMELLIA with no actual Japanese meaning. Exhibit MH2 consists of the results of an enquiry raised with the official Translation Service as part of the ex-parte examination.
9. Mr Hamilton goes on to say that the application covers goods with the primary purpose of decoration or ornamentation, asserting that it is very common for such goods to be in the form of, or bear representations of flowers, including CAMELLIAS. Exhibit MH3 consists of prints taken from the Internet showing such use, Mr Hamilton referring in particular to the website of the Natural History Museum.
10. Mr Hamilton goes on to refer to his company's use of the CAMELLIA symbol for a wide variety of fashion and accessory items, including jewellery, watches, lipsticks, nail polish, clothing and fashion accessories. This use is stated as having commenced as early as 1987, but also claims use of a CAMELLIA symbol since the founder of the company incorporated it into her earliest designs. He introduces Exhibit MHJ4 as "...demonstrating the Opponent's close association with the camellia...". The Exhibit includes references such as the following which mention Chanel's connection with the CAMELLIA:

A page headed with the name CHANEL placed below what I take to be the image of a CAMELLIA flower. The text beneath is headed "THE CAMELLIA AND CHANEL; A LOVE STORY". It goes on to refer to the significance of the CAMELLIA flower, to the CAMELLIA being "symbolic; irrevocably and eternally linked to the House of Chanel" and to Coco Chanel having worn a white fabric CAMELLIA in the form of a brooch. It goes on to refer to this CAMELLIA being available as a hair ornament, and to the Chanel Fine Jewellery collection having "...given the Camellia

pride of place as one of its finest and most distinctive ornaments.”

A page taken from the June 1998 edition of Elle magazine says that “...the white camellia was probably dearer to Coco Chanel’s heart and is more symbolic of the designer’s spirit of discreet elegance. For example, she always wore a fabric version of the flower as a brooch.” Amongst other items decorated with camellia flowers, the page shows a leather camellia necklace and earrings in the shape of a camellia flower.

An extract from the 5 April 1998 edition of the Sunday Mirror that refers to the creation of a Chanel garden at the Chelsea flower show. One paragraph refers to the garden having 50 different flowers “Amongst them will be hundreds of white camellias, Coco’s favourite flower – now a familiar symbol on many of Chanel’s goods.”

An extract from 25 April 1998 edition of the Financial Times that refers to “Camellias, an icon at House of Chanel, have inspired a new fragrance.”

An extract from June 1998 edition of Marie-Claire magazine that mentions COMING UP CAMELLIAS...Chanel’s long love affair with the camellia – reputedly Coco Chanel’s favourite flower and a regular motif on her belts, brooches and fabrics...” The prices quoted as in \$ so it is not certain that this is of UK origin.

11. There is also an article that refers to an encrusted CAMELLIA brooch on the side of a knitted beanie. Originally produced in white silk, the article states that some 40,000 material CAMELLIAS are delivered to Chanel each year.

12. Mr Hamilton goes on to give details of sales of fine jewellery and watches under or by reference to the name CAMELLIA or its French equivalent CAMÈLIA. Exhibit MH5 consists of the following:

An advertisement for amongst other things, a CAMELLIA ring from Chanel Fine Jewellery, which is endorsed as having appeared in Tatler in February 2004.

An article that appeared in the jewellery section of the June 2002 edition of Tatler entitled “Cutting edge – Go ornamental for flowers this season...” The list of jewellery includes an item described as “Pearl camellia Secret watch...by Chanel”. A later part of the exhibit contains an advertisement for the watch.

Feature from the July 2001 edition of Vogue magazine that lists, amongst other things, a Chanel “platinum and diamond large Camellia ring.”.

Advertisement from 30 March 1997 edition of YOU magazine that shows a model wearing “CAMELLIA” earrings and rings, referring to them as “Creamy opal and black onyx camellias – Coco Chanel’s favourite flower to adorn her suits.”

13. Mr Hamilton concludes his Statement saying that in view of the substantial use of the names CAMELLIA and CAMÈLIA for jewellery and watches from 1997 to the date of the application, use of the opposed mark in relation to the goods covered would cause confusion

by suggesting that such goods were issued by, and with the direct authorisation of the opponents.

14. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

DECISION

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

“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 practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

16. There is no claim that the mark has become distinctive by virtue of the use made of it, and in any event there is no evidence of it having been used, so the proviso is not relevant in these proceedings. Turning first to the ground under Section 3(1)(d) of the Act, as that is most easily disposed of. The leading guidance from the European Court of Justice on Article 3(1)(d) (equivalent to Section 3(1)(d) of the UK Act) is contained in *Merz & Krell GmbH & Co*, [2002] ETMR 21:

“41. It follows that Article 3(1)(d) of the Directive must be interpreted as meaning that it subjects refusal to register a trade mark to the sole condition that the signs or indications of which the trade 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. It is immaterial, when that provision is applied, whether the signs or indication in question describe the properties or characteristics of those goods or services.”

17. As this case indicates, an objection based on this ground is not to be determined on the basis that the mark is in some way descriptive of the goods or services; that is a matter to be considered under the provisions of Sections 3(1)(b) and (c) of the Act. It would therefore follow that if the decision is not to be made on the basis of descriptive aptness, any assertion that a mark has

become customary in the language and practices of the trade connected to the relevant goods and services has to be supported by clear and cogent evidence. Apart from use shown by the opponents, which is a matter to be determined under Section 5, there is no evidence that at the relevant date that CAMELLIA was a word customary in the common parlance or practices of the trade, that is other than as a description of the shape of goods, which as I have said is a matter for consideration under Sections 3(1)(b) and (c). There is also the Katakana symbols to be considered. Whilst these are a phonetic rendering of CAMELLIA there is no evidence that these are used by or in the jewellery trade, so the mark cannot “consist exclusively of” as required by subsection (d). I do not, therefore, see on what basis I can conclude that the mark tendered for registration falls foul of Section 3(1)(d) of the Act, and the objection founded on that section is dismissed.

18. Turning next to consider the grounds under Section 3(1)(b) and (c) of the Act. In the *Cycling Is* decision [2002] R.P.C 37, it was stated that the distinctiveness of a trade mark is not to be considered in the abstract, but rather by reference to the goods or services in respect of which registration is sought, and the relevant public’s perception of that mark. In the judgment issued in respect of *Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003), paragraphs 37, 39 to 41 and 47, the European Court of Justice (ECJ) summarized the considerations in respect of assessing distinctiveness under Section 3(1)(b) 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 or services of one undertaking from those of other undertakings.

39. Next, pursuant to the rule in 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.”

19. In a judgment issued in respect of *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case -191/01 P, the *Doublemint* case, the ECJ gave the following 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:

“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 of 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.”

20. From this it is clear that the prohibition to registration under Section 3(1)(c) of the Act relates to signs that may not be being used as a designation of a characteristics of the relevant goods or services, but nonetheless could be apt for such use. 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.

21. The mark consists of two elements; the word CAMELLIA, and placed above and to the right, the Katakana characters that are a phonetic rendering of CAMELLIA albeit with no actual Japanese meaning. Being a composite mark, the question I must answer is whether these elements, either in their own right or as part of a collective whole, create a mark that is likely to be seen by the consumer as origin specific.

22. The opponents say that CAMELLIA is the name of a shrub, the flower of which is capable of, and is actually used as a design for jewellery. I would consider it to be reasonably common knowledge that jewellery is made in the shape of natural objects such as insects, animals, plants and flowers, so even without evidence I do not see this to be a particularly startling assertion. I doubt whether the shape of the CAMELLIA blossom is anywhere near as well known as other flowers such as a rose or daffodil, and it may well be that a consumer would not recognize the actual shape of the flower for what it is. However, if you say or see the word CAMELLIA, it will be obvious that this is a reference to the shrub and its flower, whether or not you know what it looks like.

23. The evidence forming Exhibit MH3 gives details of an Internet search that lists different jewellery traders that are selling items such as a “White Camellia Pin”, a “life size camellia blossoms with cloudy diamonds set in silver and gold”, an “Aqua-Peridot Crystal Camellia Brooch” and a “Designer Camelia Flower Brooch”. There are also several references to the Chanel CAMELLIA. The pages from the June 2002 edition of Tatler (Exhibit MH5) refer to the jewellery trade as producing items based on flowers, citing a number of examples where the CAMELLIA has been the inspiration for such a design. So although printed some time after the relevant date in these proceedings, there is no reason to question whether the results shown at MH3 are representative of the position at, and before the application was made. Therefore, CAMELLIA must be regarded as a word that is descriptive of goods that are representations of that shrub or its flower, which notionally encompasses all of the goods covered by the application.

24. This does not necessarily mean that the mark as a whole is devoid of distinctive character. There is another element to the mark composed of the Katakana symbols. Although a phonetic representation of CAMELLIA, the characters do not actually have that meaning; in fact they have no meaning. Those who are familiar with Japanese will recognize the characters for what they are, but to most they will be Oriental type symbols with no meaning or known relevance for the goods. Added to the relatively small size of the characters, this does not assist the applicants in establishing that the mark, as a whole is capable of functioning as a badge of origin. The word CAMELLIA is devoid of distinctive character for the goods covered by the application, and in my view is not carried over the threshold to distinctiveness by the prominence of the characters in the mark. The ground under Section 3(1)(b) and (c) succeeds accordingly.

25. Whilst my decision on absolute grounds decides the matter, in case I am found to be wrong I will go on to consider the ground under Section 5(4)(a). That section reads as follows:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in

the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark”.

26. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponents’ goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents; and

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.”

27. To the above I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case, in which he said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472).

Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

28. The first question is whether the opponents have any goodwill in CAMELLIA. From the evidence there can be little doubt that to those in, or related to the fashion industry, and presumably consumers of designer wear, the image of the CAMELLIA flower is synonymous with Coco Chanel. The founder of the House of Chanel wore a representation of the flower made from fabric as a brooch, through which the flower became symbolic of the business. However, the act of inventing a name, or a conceptual connection to some image does not, of itself, bring the inventor any rights. In the decision in *Harrods Limited v Harrodian School Limited* [1996] R.P.C 697, Millett LJ at paragraph 791 stated:

“It is well settled that (unless registered as a trade mark) no one has a monopoly in his brand name or get up, however familiar these may be. Passing off is a wrongful invasion of a right of property vested in the plaintiff; but the property which is protected by an action for passing off is not the plaintiff’s proprietary right in the name or get up which the defendant has misappropriated but the goodwill and reputation of his business which is likely to be harmed by the defendant’s misrepresentation.”

29. The question is as put by Walton J in *The Athletes Foot Marketing Associates Inc. v. Cobra Sports Limited and Another* [1980] R.P.C 343,

“I think this passage is extremely important in considering the present case, for it makes the distinction between "reputation"--gained possibly as the result of advertising, possibly merely by word of mouth--and "goodwill" which of course can hardly exist without the goods, services or provider of these acquiring a reputation, but which requires something more. Nor, of course, is that passage consistent with any suggestion that the plaintiffs' desire possibly to commence business in this country in the future would have made any difference to the outcome.”

30. The evidence shows the CAMELLIA link with Coco Chanel to have been exploited by Chanel, who have used the image as the inspiration for the design of various items such as jewellery and a watch. It is therefore not surprising that any reference to such goods is by use of the word CAMELLIA. Even so, it is still possible for a word that is apparently descriptive to acquire a secondary meaning and become distinctive of a traders goods. (See *Reddaway v Banham* [1896] R.P.C 218 HL).

31. The opponents succeeded in establishing that items such as flowers are used by the jewellery trade as the basis for the designs of, amongst other things, jewellery, and that the word CAMELLIA would therefore be purely descriptive of items of goods of that shape. It also shows that use of CAMELLIA is not unique to them, with other traders also manufacturing items in that image. The opponents do not appear to have used CAMELLIA or even the image of the CAMELLIA flower in any way that could be considered to be trade mark use. The closest it gets is the script “Une fleur de Chanel” that is said to be a reference to the CAMELLIA. Without this explanation this would not be at all obvious. I therefore do not see how the opponents can lay claim to any secondary meaning in a word that is merely descriptive and commonly used; it has no secondary meaning that ties it to them other than in the conceptual link with their founder. I therefore do not see how they can possess any goodwill in the word, but even if they did, given that it is apparently already in use within the relevant trade, I do not see how use by another would amount to a misrepresentation that could lead to damage.

32. The opposition having been successful, the opponents are entitled to a contribution towards their costs. I therefore order that the applicants pay the opponents the sum of £1,150. This sum to be paid within seven days of the expiry of the appeal period, or within seven days of the final determination of this case in the event of an appeal being unsuccessful.

Dated this 1st day of August 2007

**Mike Foley
for the Registrar
the Comptroller-General**