O-253-08

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION NO 2452957

TO REGISTER A TRADE MARK

BY DURACELL BATTERIES BVBA

IN CLASS 9

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DECISION AND GROUNDS OF DECISION

Background

1. On 19 April 2007 Duracell Batteries BVBA, Nijverheidslaan 7, Aarschot, 3200, Belgium applied under the Trade Marks Act 1994 to register the following trade mark:

RECHARGEABLES REINVENTED

2. Registration is sought for the following goods:

Class 9

Batteries and battery chargers

3. Objection was taken against the application under Section 3(1)(b) of the Act because the mark consists of the words RECHARGEABLES REINVENTED being a sign which would not be seen as a trade mark as it is devoid of any distinctive character for an innovative type of battery and/or battery charger.

4. Following a hearing which was held on 27 November 2007 at which the applicant was represented by Ms Thornton-Jackson of D Young & Co, their trade mark attorneys, the objection was maintained and Notice of Final Refusal was subsequently issued.

5. 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.

The Law

7. 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

8. At the hearing, and in earlier correspondence, Ms Thornton-Jackson made submissions in support of this application. In her letter of 17 August 2007 Ms Thornton-Jackson said:

> "The words RECHARGEABLES and REINVENTED are adjectives and an alliteration, which makes the trade mark more memorable when it is subsequently called to mind. The mark does not contain any nouns and neither does it point to any particular subject matter. It is not clear from looking at the trade mark exactly what it is that is "rechargeable". The meaning of the trade mark is therefore ambiguous. The Applicant submits that the mark merely alludes to the fact that goods offered under the mark can be recharged in a new and original way. It does not describe either directly or indirectly, any of the goods themselves being sought for registration and there is no evidence to prove a link between the goods "batteries and battery chargers" and the term RECHAERGEABLES REINVENTED.
>
> The Applicant further submits that if upon looking at a trade mark, the average consumer cannot ascertain what is meant by the meaning of the trade mark, without giving it further detailed and analysed thought, then the trade mark must surely meet the required level of distinctiveness.
>
> …… Only marks that are descriptive and convey the meaning immediately can be said to fall below the requisite threshold of distinctiveness."

9. At the hearing these submissions were repeated.

Decision

10. 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 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."

11. 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 those 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 mark 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."

12. There is recent case law that appears to support the view that slogans must be seen as trade marks immediately – *Audi AG c Office de L'harmonisation dans le marche interieur (marques, dessins et modeles) (OHIMI)* Case T-70/06. Although published in French as opposed to English the decision made it clear that it does not matter if the sign has several meanings, is a play on words, is whimsical, surprising or unexpected if the sign does not satisfy the requirement that the relevant consumer must see the mark as a trade mark immediately.

13.The words RECHARGE and REINVENT are defined in Collins English Dictionary, New Edition, as:

> "**recharge** …. **1** to cause (an accumulator, capacitor, etc) to take up and store electricity again **2** to revive or renew (one's energies) (esp in **recharge one's batteries**) > **re'chargeable** adj"
>
> **"reinvent** …. **1** to replace (a product, etc) with an entirely new version **2** to duplicate (something that already exists) in what is therefore a wasted effort (esp in the phrase **reinvent the wheel**)"

14. The goods in question are batteries and chargers for batteries. Batteries are in use in virtually every household in the United Kingdom. They are used in toys, power tools, gardening equipment, domestic appliances and in many other areas. Of course, rechargeable batteries are very common now, especially in power tools, telephones and mobile telephones, music playing apparatus and other digital equipment. Many of these are provided with dedicated recharging apparatus. The effect of this volume of use is that practically all members of the general public are or have been exposed to rechargeable batteries. They are marketed as "rechargeable batteries" and I am aware from my personal knowledge of such everyday consumables that they are, in the course of conversation, perhaps at the point of sale, sometimes referred to in their abbreviated form – "rechargeables". In my view the average consumer of such goods, who I consider to be the general public of all ages, apart from the very young, will understand the meaning of the word RECHARGEABLES when it is used in relation to batteries and battery chargers. They will perceive this word as an indication that the batteries are rechargeable and that the battery charger is the apparatus which recharges such batteries.

15. The word REINVENTED is also a well known word. As the dictionary reference indicates, the expression "Don't reinvent the wheel" is a well known in the English language. Its primary meaning is "To replace (a product, etc) with an entirely new version". When used in relation to the goods in question the combination RECHARGEABLES REINVENTED will provide an immediate descriptive message. Consumers will immediately recognise that not only are the batteries rechargeable batteries but they are a new, updated version, presumably an improved version of the previous ones. Such a term is one that I consider to be particularly apt for use in the advertising and promotion of the goods in question.

16. In my view the trade mark RECHARGEABLES REINVENTED does not possess the singularity required to individualise the goods in question, in the minds of the relevant consumers who are the general public, to a single undertaking. It will be immediately perceived as a descriptive message indicating that the goods relate to rechargeable batteries that are in some way an improvement on an earlier version and chargers for use with such batteries.

17. Consequently I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

Conclusion

18. 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 Sections 3(1)(b) of the Act.

Dated this 8th day of September 2008

A J PIKE
For the Registrar
The Comptroller-General