

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. 2112455
BY DAIMLER-BENZ AEROSPACE A.G.
TO REGISTER A
TRADE MARK IN CLASS 9**

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION

5 **NO 2112155 BY DAIMLER-BENZ AEROSPACE A.G.**
TO REGISTER A TRADE MARK
IN CLASS 9

10 **DECISION**

Background

15 On 11 October 1996, Daimler-Benz Aerospace A.G. of Willy-Messerschmitt-Strasse 1, Tor 1
85521 Ottobrun, Germany, applied under the Trade Marks Act 1994 for registration of a series
of trade marks, **HELIRADAR** and **heliradar**, in respect of the following goods in Class 9:

20 “Electrical and electronic radio and optical detection and range finding apparatus;
electronic and optical imaging detecting and ranging apparatus for aeronautical purposes;
airborne ground proximity, hazard and obstacle detecting and warning apparatus; all
25 weather flight control systems and image sensor; flight directors, flight management
computers and flight control systems; autopilot systems; parts and fittings for such
equipment including transmitting and receiving apparatus; processors; antenna systems;
optical imaging apparatus; computers; display apparatus”.

25 Objection was taken against the mark under the following Sections of the Act:

30 **3(1)(b) and (c):** on the grounds that the marks consists of the combining from “Heli”
meaning “helicopter” and the word “Radar” conjoined, the whole being
devoid of any distinctive character and being a sign which may serve, in
trade, to designate the kind and characteristics of eg, electronic radar
apparatus designed for use on or with helicopters;

35 **5(2):** The following earlier mark was considered to be similar and in respect of
the same goods:

Number	Mark
2065189	RADAR

40 **Specification**

45 Computer software; media use for storage and transmission of digital data;
computer software for on-line, inter-active, CD-ROM and multi-media
use; electronic apparatus for virtual reality entertainment; pre-recorded
audio and/or video records, tapes, cassettes and discs, sound and/or video

recordings; audio and/or video recording and playing apparatus; motion picture and television films; virtual reality glasses; parts and fitting for all the aforesaid goods”.

Hearing and submissions

5

At a hearing at which the applicant was represented by Mr J B King of Kings Patent Agency Limited, the objections were maintained. However, subsequent to the hearing, the objection under Section 5(2) was waived and therefore no further mention of this objection need be made in this decision.

10

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.

15

The relevant parts of the Act under which the objections were taken and maintained are as follows:

Section 3(1):

20

“The following shall not be registered-

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

25

(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.

30

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.”

35

At the hearing, Mr King argued that “heli” was not a shortening of the word “helicopter” and referred to the Dictionary of Aviation (R J Hall & R D Campbell) which showed that “HEL” was an abbreviation for “helicopter”. By way of information, Mr King filed a document titled “HeliRadar - The key to all weather helicopter flight” which explains the precise nature of the goods and how they operate. Relevant extracts include:

40

page 2:

“HeliRadar - a sensor for All Weather conditions

45

A primary flight guidance instrument and obstacle warning system for use under all weather conditions must fulfill certain requirements, ie image-like vision of flight path and landing site with sufficient field of view, good image resolution and image update rate, the reliable detection of obstacles including power lines, and a sufficient operating range under

adverse weather conditions (eg > 1000m).

As each of the currently available sensors fails to fulfill all of these requirements, the problem can only be solved with a new invention. Due to the physical preconditions and the requirement to detect small obstacles such as wire with 10mm diameter, an operating frequency of 33 Ghz was selected. Since a real aperture radar is not a suitable choice due to defects in image resolution and a conventional SAR cannot look in flight direction, a “Synthetic Aperture Radar with Rotating Antennas” (ROSAR) was identified as the only feasible solution to provide an all-weather flight guidance and obstacle warning system.

System Concept of HeliRadar

Four antenna arms each carrying 8 small antennas at their tips, scan the area selected by the pilot with tan FM-CW radar signal according to the ROSAR principle. The transmit/receive unit is located in the center of the antenna arms directly above the rotor head. From there, the resulting IF signals are transmitted through the rotor shaft into the helicopter cabin where they are converted to digital signals. The HeliRadar Computer cares for the ROSAR processing and obstacle detection and warning. Finally, the image as well as obstacle warning are fed into a large field of view display in the helicopter cockpit.”

Mr King also filed a letter in support of the application, from Professor Christopher M Snowden who is Head of School of Electronic and Electrical Engineering of the University of Leeds.

Professor Snowden, in his letter of 7 August 1997, confirms that his school associates the word “HeliRadar” exclusively with Daimler-Benz Aerospace, which has been used by them for several years for a flight guidance and obstacle warning system based on a synthetic aperture radar with rotating antennas.

Mr King in his accompanying letter says that this statement appears to indicate that Professor Snowden’s opinion is that the mark has acquired distinctiveness through several years’ use. Mr King adds that Professor Snowden was the Chairman of the Microwaves and RF Conference of 1995 and is a renowned expert in this particular field of technology.

Mr King was invited to submit formal evidence which might show that the marks, through sales of the goods prior to the application date, had in fact acquired a distinctive character of the result of the use made of them. No evidence of use was submitted.

Decision

The marks applied for are **HELIRADAR** and **heliradar**. There are no material differences between the marks and for practical purposes I treat them as the same.

Both marks consist of a single word “Heliradar”, which as far as I am aware does not itself appear in English dictionaries. However, the marks consist of two elements, namely “heli” and “radar”. The definition of “heli-” in Collins English Dictionary is given as:

“combining form. helicopter: helistop. [C20: shortened from helicopter].”

Included in the definition of “radar” in the same dictionary is:

“1. a method for detecting the position and velocity of a distant object, such as an aircraft.

5

“2. the equipment used in such detection”.

Although I note that the word “helicopter” is shown in its abbreviated form as “HEL” in the Dictionary of Aviation, without the benefit of expert advice on the matter I cannot ignore the above definition of “heli-” provided in Collins English Dictionary. The term “heli” is not an unusual prefix and is used in other common English words such as “heliport” (an airport for helicopters) or “helipad” (a place for helicopters to land and take off) to denote a reference to helicopters. In combination with the word “radar” it is my view that the totality directly conveys to potential customers “helicopter radar”. Geoffrey Hobbs QC in the EUROLAMB trade mark (RPC 1997 page 287) said:

15

“My view on what I regard as the critical point is that the word “EUROLAMB” would be understood by persons encountering it, used in relation to the goods of interest as defined by the specification, as being an abbreviation of the longer expression “European Lamb”. I therefore think that the word “EUROLAMB” is no more and no less registrable than the words “European Lamb”. My view is that the words “European Lamb” would not be registrable.”

20

It is clear from the literature supplied by the applicant that the goods are intended to be used in helicopters as a system for flight guidance and obstacle warning, which utilises a new technology described as “rotating synthetic aperture radar” (or ROSAR). Although I acknowledge that the applicant’s goods are highly sophisticated, it is my opinion that the neither **HELIRADAR** nor **heliradar** is prima facie distinctive for any goods which are used in relation to radar systems or equipment for helicopters and therefore both marks are unacceptable under Section 3(1)(b) and (c) of the Act.

25

30

Mr King in correspondence following the hearing acknowledged that “HeliRadar” might well be an apt term for certain of the goods but the applicants have nevertheless clearly adopted this as a trade mark and the only reason any other business would wish to use the mark would be to cause confusion or pass off their products as emanating from the applicants. As a way of overcoming the objections Mr King offered to restrict the specification of goods which, in his view, would not be specifically related to helicopters. His proposal was to limit the goods to as follows:

35

“Electronic and optical imaging detecting and ranging apparatus; flight control systems; flight directors; flight management computers and flight control systems; autopilot systems; parts and fittings for such equipment; computers; display apparatus”.

40

I rejected this proposal because the remaining goods could still be used in relation to helicopter radar systems or apparatus. Moreover, given the explanatory information provided about how the marks are in reality being used, a restriction of the goods in the manner proposed would be

45

artificial and in my view such an offer reinforces the descriptiveness objection against the marks.

Because of the highly technical nature of the goods, the conclusion might be reached that there was only a small risk that other businesses in this field would wish to choose the same or closely resembling mark for the same or similar goods. I do not regard the possibility of other traders wishing to use this term as de minimis. In order to be registrable, an unused mark must not, inter alia, consist of signs which **may** serve in trade to designate the intended purpose or other characteristics of goods and not be devoid of any distinctive character. In my view, the marks clearly designate the intended purpose of the goods and are thus debarred from registration under Sections 3(1)(c) of the Act.

It follows that the marks are also devoid of any distinctive character. In *British Sugar Plc v James Robertson & Sons Ltd* (1996) RPC 281, Jacob J made the following comments:

“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.”

I take the view that these comments apply equally to descriptive words or combinations of descriptive words. Although the goods involved in the TREAT decision were foodstuffs, every day consumer items, the same considerations apply to technical goods. Therefore, I consider the marks to be devoid of any distinctive character and are not acceptable, prima facie, for registration under Section 3(1)(b).

Concerning the likelihood or otherwise of other traders wishing to use the same or similar marks, I also have to consider the effect that registration would have on other businesses. In the AD2000 trade mark (1997) RPC 168, Geoffrey Hobbs QC said:

“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 551 at 517 in the following terms:

“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 e.g. *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”.”

Moreover, in the LAURA ASHLEY trade mark (1990) RPC 539, Robin Jacob QC said:

5 “What the Registrar has to have in mind is what monopoly is being created. He has to ask himself, as a guardian of the public interest, whether that monopoly will interfere with the legitimate rights of others, not only of today, but “tomorrow and the day after tomorrow”, to use Viscount Simonds’ vivid expression, YORKSHIRE Trade Mark (1953) 71 RPC.”

It is my view that other businesses who wish to use the term “heliradar”, or similar constructions, should remain free to do so and not be fettered by registration of the applicant’s marks.

10 It may be the case that the goods sold in relation to the marks are new development and no other traders are capable of manufacturing such systems. However, this does not justify registration of such highly descriptive marks. In this regard Templeton L.J. said in the McCain International Ltd v Country Fair Foods Ltd and another (1981) RPC 69 (The “Oven Chips” case) before the Court of Appeal (in which referring to the Cellular Clothing Company v Maxton & Murray (1899) A.C. 326 case), on page 75 line 35 continuing to line 5 on page 76:

“Similarly in the same case at page 344, again in words I find helpful in the present case because they deal with the invention of a new product, Lord Davey said this:

20 ...where a man produces, or invents, if you please, a new article and attaches a descriptive name to it - a name which, as the article has not been produced before, has, of course, not been used in connection with the article - and secures for himself either a legal monopoly or a monopoly in fact of the sale of that article for a certain time, the evidence of persons who come forward and say that then name in question suggests to their minds and is associated by them with the plaintiff’s goods alone is of a very slender character, for the simple reason that the plaintiff was the only make of the goods during the time that his monopoly lasted, and therefore there was nothing to compare with it and anybody who wanted the goods had no shop to go to, or no merchant or manufacturer to resort to, except the plaintiff...If a man invents a new article and protects it by a patent....he has a legal monopoly; but when the patent expires all the world may make the article, and if they may make the article they may say that they are making the article, and for that purpose use the name with the patentee has attached to it....”

And on page 72, lines 37-48, Templeton L.J. said:

35 “Mr Harman, in a very forceful and if I may say so, very attractive argument, submitted that “oven chips is a fancy name and not a phrase in common use in the English language, so that it will be associated with one particular manufacture and not with a product. He said it is novel phrase - and that is true; it has never been used before - that also is true. He castigated the phrase an ungrammatical aggregate of two English nouns and said that it was nonsensical without an explanation. But in my judgement the words “oven chips”, grammatical or not, constitute an expression which is an ingenious and apt description of the contents, namely, potato chips prepared for cooking in the oven; and although the consumer may not have been aware, and could not have been aware of what the expression meant until oven chips came on to the mark, once they had come on the market he could recognise a name which is apt and appropriate to describe a product rather than

a manufacturer, the product being potato chips prepared for cooking in the oven”.

As I have stated above, the marks **HELIRADAR** and **heliradar** are in my view wholly apt descriptors for any goods which may relate to helicopter radar systems or equipment.

5 There is one final matter that I have to consider, namely, the letter from Professor Snowden of
Leeds University in support of the application . I have no reason to doubt Professor Snowden’s
expertise in the field of electronic and electronic engineering and I accept that his school
associates the word “HeliRadar” exclusively with the applicant and has done so for several years.
10 However, I am not persuaded that this statement is, in itself, sufficient in proving that the marks
have acquired a distinctive character of the result of the use made of them. Professor Snowden
does not identify **HELIRADAR** or **heliradar** as trade marks, badges of trade origin, but merely
refers to recognition of “the word ‘HeliRadar’”, which his school associates with the applicant.
15 Although he says that the applicant has used the word for several years and in relation to goods
covered by the application, no specific goods are mentioned and no date is given regarding when
use commenced in the United Kingdom. Moreover, in the absence of relevant details such as
exhibits showing how the marks are promoted or price lists, invoices, sales figures, advertising
expenditure etc, it is impossible to gauge to whether they have acquired distinctiveness which
might permit acceptance. As stated earlier in this decision, Mr King was invited to submit formal
20 evidence in order to show that through sales of the goods, the marks had, prior to the application
date, acquired a distinctive character but no evidence was forthcoming.

Conclusion

25 The marks are not acceptable prima facie because they are debarred from registration under
Section 3(1) (b) and (c) of the Act. Furthermore, in the absence of any evidence showing use of
the marks in the United Kingdom, I am of the view that they have not acquired a distinctive
character as a result of the use made of them.

30 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 reason given above it is refused under
the term of Section 37(4) of the Act.

Dated this 20 day of May 1998

35

40 CHARLES HAMILTON
For the Registrar
The Comptroller General

45