

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2101996 BY
EFKA WERKE FRITZ KIEHN GmbH TO REGISTER
A TRADE MARK IN CLASS 34**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
45866 BY IMPERIAL TOBACCO LTD**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2101996
by Efka Werke Fritz Kiehn GmbH to register a
trade mark in Class 34**

and

10 **IN THE MATTER OF Opposition thereto under
45866 by Imperial Tobacco Ltd**

15 **BACKGROUND**

On 9 June 1996 Efka-Werke Fritz Kiehn GmbH of Trossingen, Germany, under application
No 2101996, applied to register the following trade mark:

No	Mark	Class	Journal	Specification
2101996	SMOKY	34	6138/10487	Cigarette papers, cigarette paper slips, cigarette paper tubes; filter cigarette paper tubes; smoking articles, machines for making one's own cigarettes, machines for rolling and filling one's own cigarettes, smoking tobacco and raw tobacco; tobacco filters, cigarette filters; cigarette cases

It was accepted by the Trade Marks Registry and published in the Trade Marks Journal. On
12 November 1996, Imperial Tobacco Limited, of Bristol, filed Notice of Opposition. The
35 grounds of opposition are, in summary, that the word SMOKY is not capable of distinguishing
the applicants goods; that it is devoid of distinctive character; that it is a sign or indication
which may serve in the trade to designate a characteristic of the goods covered by the
application; and it should therefore be refused under Sections 3(1)(a), 3(1)(b) and 3(1)(c) of
the Act. Also, the opponent considers that the application was made in bad faith.

40 The applicants denied these grounds and both sides sought their costs.

Evidence was filed by both parties and the matter came to be heard on 8 February 1999 when
the applicants were represented by Mr David Devons of Marks & Clerk, their trade mark
45 attorneys. The opponents were represented by Ms Denise McFarland of Counsel instructed by
Stevens Hewlett & Perkins, their trade mark attorneys.

OPPONENTS EVIDENCE

5 This consists of two Statutory Declarations. The first is by Richard Charles Hannaford, Secretary of Imperial Tobacco Ltd, a post he has held for nine years having been associated with the Company for 23 years.

10 Mr Hannaford states that he believes that the word SMOKY is descriptive of the characteristics of tobacco products manufactured for smoking. He attaches the Collins English Dictionary which defines the word as "emitting, containing or resembling smoke". In his view therefore the word SMOKY is devoid of distinctive character in relation to the goods he mentions.

15 Mr Hannaford says that the emission of smoke from tobacco products is a matter of interest to the industry because such products can be manufactured to be more or less 'Smoky' depending upon the composition of the goods, including the paper and filter used. Thus, he submits, the word SMOKY should be free for any trader in tobacco products to use to describe the characteristics or the effect of the products offered for sale, now and in the future.

20 Mr Hannaford goes on to say that emission of smoke is frequently referred to by tobacco traders and he exhibits a selection of past and present advertising and promotional material produced by his company. I note that there is no use of the word SMOKY in any of these advertisements.

25 The second Statutory Declaration is by Nigel Peter Bulpitt dated 9 April 1997. He is the Company Secretary of Gallaher Ltd and has been with the company for eleven years. Mr Hannaford states that his company is involved in the manufacture, sale and distribution of tobacco products worldwide and have been for 100 years.

30 Mr Bulpitt goes on to say that observations were submitted to the Trade Marks Registry in respect of the application in suit (under the provisions of Section 38) on the basis of the descriptiveness of the word SMOKY in relation to the goods covered by the application. He reiterates the fact made by Mr Hannaford that the concern of the tobacco industry about smoke emissions is such that the word SMOKY is one which is used regularly by the trade in relation to tobacco products. Thus it is his belief that the word should be free for others to use to describe the characteristics of such goods.

APPLICANTS EVIDENCE

40 This consists of two Statutory Declarations. The first is by Roger Keith Davis, Managing Director of UK Tabak Limited and dated 15 September 1997. He states that he has been associated with the tobacco industry since 1985 first of all with Charles Fairman (UK) Limited, importers of manufactured tobacco from Germany and Holland for sale to retailers and since 1995 with that company's successor UK Tabak Limited.

45 Having read the opponents evidence Mr Davis says that although the words smoke, smoking and smoker are commonly used in the trade the word SMOKY is not (nor is it used by the public). In his view the word is no more than a comforting allusion to characteristics of tobacco and tobacco products.

The second Statutory Declaration is a joint Declaration by Gunter Schütze, Director and Kurt Haller, Marketing Manager of EFKA-Werke Fritz Kiehn GmbH, the applicants and dated 3 November 1997. They state that they are fully conversant with the English language.

5 The declarants state that the applicants have been using the trade mark SMOKY in the United Kingdom since February 1995. The turnover that year under the trade mark was 5000 DM and 9000 DM in the following year, 1996. They exhibit some promotional material showing use of the trade mark. This is attached as Annex A to this decision.

10 The declarants go on to state that the company intends to market cigarette papers and tobacco for personal use so that users will know that SMOKY tobacco is suitable for use with SMOKY cigarette papers. It is their view that the word will only be seen as a trade mark in relation to such products and cigarette making equipment.

15 OPPONENTS EVIDENCE IN REPLY

This consists of a Statutory Declaration by Ian Robert Smith, a partner in Stevens Hewlett & Perkins, the opponents trade mark attorney and dated 15 January 1998.

20 Mr Smith observes that the applicants' promotional material (at Annex) shows that the trade mark being used is SMOKY MAC, not SMOKY solus; and that it is used only on cigarette making machines for smokers to 'roll their own'. He also comments that the turnover set out by the joint declarants amounts to less than £7000, which precludes the trade mark having acquired distinctiveness through use.

25 That concludes my review of the evidence filed in these proceedings.

DECISION

30 The grounds of opposition are based on Section 3(1)(a)(b)(c) and (d) of the Act which read as follows:

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

35 (a) signs which do not satisfy the requirements of section 1(1),

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

40 (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,

45 (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.

5 Insofar as the objection based upon Section 3(1)(a) is concerned this refers back to Section 1(1) which states:

10 1.-(1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

15 This defines the meaning of a trade mark. In this case the trade mark is a word which can, clearly be represented graphically and in some circumstances could distinguish the goods of one trader from those of another and therefore the opposition based upon Section 3(1)(a) is dismissed.

20 I go on to consider the objection based upon Section 3(1)(c) because it is to this objection that I think the evidence and argumentation at the Hearing was principally addressed. I have evidence on behalf of the opponents from two large tobacco companies stating that the word SMOKY is one which is used and required to be used by those involved in the tobacco industry. This evidence does not however contain any exhibits which show how that word is
25 used by the industry. However, it seems to me that given the climate of public opinion surrounding the subject of smoking there must be concern within the tobacco industry to produce products which reduce the amount of smoke produced by tobacco, and tobacco products at large. In such circumstances it does not seem unreasonable that individuals should and could have recourse to describing a tobacco or tobacco blend as 'SMOKY'. Similarly, I
30 can accept that particular types of paper for use in cigarette making and, similarly filters, might well contribute to the amount of smoke produced by the end product. Mr Simon Thorley QC acting as the Appointed Person in the matter of application No 2104222 (for the trade mark MEMORY LOCK) said in considering the matter by reference to Section 3(1)(c):

35 "The question of registrability must therefore be seen in the context of a perceived trading need for remote controls which can be programmed, the programming of which needs to be protected against loss when batteries are charged".

40 In this case I can see a perceived need for traders to use the term SMOKY to describe a characteristic of goods which produce, or contribute or otherwise to the production of smoke. Accordingly, registration of the trade mark for the current specification of goods covered by the application would be contrary to the provisions of Section 3(1)(c).

45 Insofar as the objection under Section 3(1)(b) is concerned I refer to the comments of Jacob J in TREAT [1996] RPC page 306 line 1-5:

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?

5 For the reasons given above, I consider that the word SMOKY is one which is apt for use by the tobacco industry at large in relation to products and goods which produce smoke to a greater or lesser degree. In those circumstances I think that the word SMOKY is prima facie, devoid of distinctive character in relation to goods covered by the current specification. Therefore the opposition based upon Section 3(1)(b) is upheld. The word also fails to meet the provisions of Section 3(1)(d) because it is a sign in the current language of the trade
10 according to the evidence. Thus the opposition on that ground is also upheld.

That is not the end of the matter, however, because, as indicated above, there are goods included in the specification in relation to which the word SMOKY would not be descriptive of any characteristic of them or devoid of distinctive character or indeed to which any of the
15 grounds of opposition apply. In that respect I do not consider that the word SMOKY attracts objection in relation to ‘machines for making one's own cigarettes, machines for rolling and filling ones own cigarettes’, nor in relation to cigarette cases. Whilst it could be argued that the way in which the machines were filled could produce a more, or less, SMOKY cigarette, that would be a consequence of the way in which the individual used the machine rather than a
20 characteristic of it. Thus if the applicant were to amend the application to limit the specification to those goods to which no objections apply the application for registration could proceed accordingly.

Finally, the opponent opposed on the basis of Section 3(6) which states:

25 3 - (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

The objection was and is based upon the perception that the applicant did not intend to use the trade mark on all of the goods of the specification and that the use shown by the applicant was
30 only on machines for making cigarettes. Ms McFarland, rightly in my view, indicated that this was very much a secondary objection.

First of all, I accept, prima facie, the declaration made by the applicants on the application form by their representatives that they intended to use the trade mark on all the goods stated. Their evidence reinforces that. There has been no evidence to the contrary by the opponents. The fact that the applicants have promoted their cigarette making machines under the term SMOKY MAC as shown in the Annex does not amount to an admittance that the declaration on the application form was false. The opposition based upon Section 3(6) is therefore
40 dismissed.

In summary the opposition has succeeded on the basis of the provisions of Section 3(1)(b)(c) and (d) in relation to this application for registration but only in relation to some of the goods covered by it. If the applicants wish to proceed with the application for a limited specification
45 they should in accordance with Section 37 submit a form TM21 limiting the application in accordance with this decision within one month of the end of the appeal period. Failure to do so will mean that the application must be refused in its entirety.

If the application proceeds on a limited basis the applicant should pay to the opponent the sum of £400, a sum which reflects only partial success of the opposition. If the application does not so proceed the applicants must pay to the opponent the sum of £800.

5

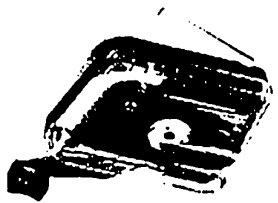
Dated this 4 day of June 1999

10

M KNIGHT

For the Registrar

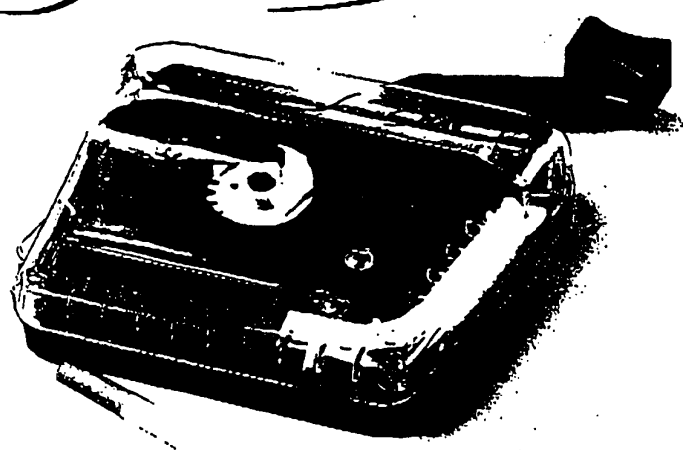
15 the Comptroller General



CIGARETTE MAKER
TO MAKE YOUR OWN FILTER CIGARETTES

Smokey **MAG**

Smokey **MAG**



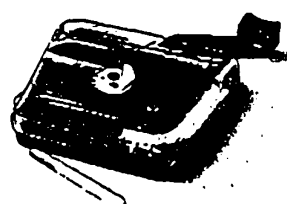
Smokey **MAG**



CIGARETTE MAKER
TO MAKE YOUR OWN FILTER CIGARETTES

CIGARETTE MAKER
TO MAKE YOUR OWN FILTER CIGARETTES

Smokey **MAG**



CIGARETTE MAKER
TO MAKE YOUR OWN FILTER CIGARETTES