

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION
NO 2025255 IN CLASS 7 STANDING IN THE NAME OF
FOURNEAUX DE FRANCE LIMITED**

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY
NO 11542 IN THE NAME OF THE RANGE COOKER CO PLC**

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**IN THE MATTER OF Trade Mark Registration
No 2025255 in Class 7 standing in the name of
Fourneaux De France Limited**

and

**AN APPLICATION FOR A Declaration of Invalidity
No 11542 in the name of the Range Cooker Co Plc**

BACKGROUND

1. Trade Mark Registration No 2025255 in respect of the trade mark FOURNEAUX DE FRANCE was placed on the register on 27 June 1995 in respect of the following goods:

Class 7

Dishwashers; can opener machines; mixers; blenders; machines for processing foods; mincers, electric knives and vegetable peelers.

Class 8

Cutlery; tableware.

Class 11

Electric apparatus for cooking foods; ovens; rotisseries, split roasters, electric grills; cookers and cooker hoods; extractors; electric pans, electric saucepans and electric coffee makers; fridges and freezers.

Class 20

Kitchen furniture and kitchen units; butchers blocks.

Class 21

Household and kitchen utensils and containers; glassware; porcelain and earthenware; saucepans, fish kettles, sieves, fish slices, sea food platters and stock pots; heat insulation apparatus for food and beverages.

Class 25

Aprons and oven gloves; outer clothing; footwear and headgear.

2. By an application dated 17 March 2000, The Range Cooker Company Plc sought a declaration that the registration was invalid. The grounds of the application are based upon Section 47(1) & (5) under the Trade Marks Act 1994 in that:-

- (a) The trade mark consists of a french word Fourneaux which means, amongst other things, stoves, cookers, cooking ranges and furnaces, together with the words De France, which mean of 'France'. Furthermore, the word Fourneaux is used in compound phrases to denote other kinds of cooking devices, such as fourneaux de cuisine, meaning kitchen stoves, fourneaux électriques meaning electric cookers and fourneaux à gaz meaning gas cookers.
- (b) The trade mark in question was therefore registered in breach of Section 3(1)(c) because it consists of a sign which may serve in trade to designate the kind or geographical origin of goods covered by the registration, mainly stoves, cooking ranges, other kinds of cookers and related goods, such as cooker hoods and extractors originating in France.
- (c) Further, the trade mark consists of the word FOURNEAUX DE FRANCE it is not capable of distinguishing the goods of one undertaking from those of another as required by Section 1(1) and thus it was registered in breach of Section 3(1)(a).
- (d) To the extent of the registration covers goods which did not originate in France, the trade mark is of such a nature as to deceive the public as to the origin of the goods and therefore was registered in breach of the provisions of Section 3(3)(b) of the Act.

3. The registered proprietors deny the allegation. They said that the applicants for the declaration of invalidity have not provided any evidence that the trade mark was registered in breach of the provisions of the Trade Marks Act. Both sides sought an award of costs.

4. Evidence was filed by both sides and in line with the Registrars practice, after reviewing the case. I notified the parties that I did not consider that an aural hearing was necessary in order for a decision in these proceedings to be determined. The agents for the applicants for the declaration of invalidity Venner Shipley & Co agreed that a decision could be reached without a hearing, as did the agents for the registered proprietors, A A Thornton & Co. After careful consideration therefore of the statement of case, counterstatement and the evidence filed I give the following decision.

DECISION

5. The evidence submitted by the applicants for the declaration of invalidity consists of a witness statement by Mr Nicholas Geoffrey South dated 19 September 2000. He is employed by the applicants trade mark attorneys, A A Thornton. He attaches extracts from Cassell's French-English Dictionary and the Collins Roberts French-English Dictionary showing the English translation of the French word "fourneau". He also provides details of investigations made via the internet in respect of the English translation of the same word. fourneau.

6. The extract from Cassell's French-English Dictionary cites "stove and cooking-range" among the English translations of the word fourneau, and indicates that "fourneaux" is the plural of "fourneau". The dictionary also illustrates the use of the word fourneau in compound phrases to denote various kinds of cooking devices namely "fourneau de cuisine" meaning kitchen-stove, "fourneau électrique", meaning electric cooker and "fourneau à gaz" meaning gas cooker. The extract from the Collins Robert French-English Dictionary cites "stove" as the primary English translation of the word fourneau. The English translation of "fourneau" from the various internet translation services include cooker and repeated occurrences of oven and stove.

7. The registered proprietors evidence consists of a statutory declaration by Mr Paul John Kelly, a Trade Mark Attorney employed by the registered proprietors Trade Mark Attorney's Venner, Shipley & Co dated 31 October 2000. Mr Kelly notes the contents of Mr South's declaration. He states that the words in question would not convey any descriptive meaning to the general public in the United Kingdom and that, in his view, the applicants for invalidity and public declaration of invalidity have not produced any evidence to show that the general consumers in the United Kingdom would understand the meaning if any of the words that are the subject of the registration in suit.

8. Mr Kelly goes on to state that the registered proprietors have been using the trade mark since 1993 and since that date have spent in excess of £1 million in relation to advertising such that the trade mark has become associated with the company. No other details are provided (ie turnover goods under the mark, no promotional literature etc).

9. There is also a witness statement dated 7 June 2001 from Mr John Douglas Ogle Armstrong, the registered proprietors' chairman. He provides background information on his companies activities. He states that the cookers which his company imports from France are intended to appeal to a particular section of the British public who are familiar with the French way of life, especially cooking practices, and want a French style cooker. Such people are usually, he says, also familiar with the French language and in shopping for French style range cooker would be well aware that they would be called "fourneaux" in the French language. These cookers are different from those usually on the market in the United Kingdom in various respects including operating at different temperatures. He goes on to say that the test must be whether the words of the trade mark convey any descriptive meaning to perspective purchasers of the products in question rather than the general public. For the reasons given he believes that they do. The goods in question are specialist products aimed at a particular section the public and this should be taken into account. He goes on that the word "fourneau" appears to related in some way to the English word furnace and therefore even British persons unfamiliar with the French language might guess that it is something to do with heating and cooking.

10. Having reviewed the evidence, I consider the law. These proceedings are brought under Section 47(1) and 47(5) of the Act which state as follows:

47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

Provided that this shall not affect transactions past and closed.

11. The provisions under Section 3 to which the applicant refers are set out below:

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

(3) A trade mark shall not be registered if it is -

- (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

Section 1(1) of the Act states:

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.

12. First of all, I do not consider that any evidence has been filed, or submissions made, to support the allegation that the trade mark in suit fails to satisfy the requirements of Section 1(1) and 3(1)(a) of the Act. I do not intend therefore to consider that aspect of the case and the allegation is dismissed. Secondly, no evidence has been filed in support of the very serious allegation that the application for the trade mark in suit was made in bad faith. That ground too is dismissed. I go on therefore to deal with the allegation that the trade mark FOURNEAUX DE FRANCE is a sign which indicates both the kind and origin of goods sold under it.

13. Chapter 6 of the Trade Mark Registry's Work Manual deals with the subject of the acceptance or otherwise for registration of words in foreign languages as follows:-

4.1.4 **Words in foreign languages**

4.13.1 **Well known European languages**

The following are likely to be known to a reasonable (and increasing) number of UK residents:

French, German, Italian and Spanish.

4.13.2 **Goods**

Object if the words (in English) would be the subject of an objection under Section 3(1)(c) of the Act. Normally no need to object on the basis that the English equivalent would be devoid of any distinctive character without being descriptive eg TOUJOURS/ALWAYS .

14. This is in line with a decision of Mr Geoffrey Hobbs QC in EL CANAL DE LAS ESTRELLAS [2000] RPC 291 the head notes of which state:

“Held, dismissing the appeal:

(1) There was no rule that foreign words had to be examined for registrability by reference to their meaning in translation. The purpose of translation was to ensure that foreign words were not registered without knowing their meaning.

(2) For registration, foreign words needed only to be capable of functioning satisfactorily as trade marks in relation to the goods or services supplied in or from the United Kingdom, whether or not they would also qualify for protection elsewhere.

(3) The less obscure a foreign word was, the greater the weight which had to be given to its meaning in translation.

(4) Traders engaged in intra-Community trade were not, unjustifiably, to be prevented from using words in the language of other member states of the European Union.

(5) Spanish was a modern language widely understood and spoken in the United Kingdom. Spain was a trading partner of the United Kingdom and a fellow member of the European Union. The services specified in the application were supplied nationally and internationally.

(6) EL CANAL DE LAS ESTRELLAS was easily recognisable as Spanish which when used in respect of the services specified would be understood as laudatory and not a reference to stellar bodies.

(7) The disclaimers offered did not cure the defects of the mark.”

15. Though that decision related to a case under the Trade Marks Act 1938 (as amended) I do not consider that the position is any different under the current law. Mr Simon Thorley QC acting as the Appointed Person quoted the above authority with approval in TONALITE HENNE [2001] RPC 36 which was a case determined under the Trade Marks Act 1994.

16. When examining a trade mark which appears to be a word in a well known European language it is necessary to consider the meaning of that word against the goods (and/or services) of the specification in order to determine whether an objection arises. In this case, as can be seen from the evidence of the applicants for a declaration of invalidity the word “Fourneau” means, amongst other things in the Cassell's dictionary;

Stove, cooking-range

and in the Collins Robert French-English dictionary

Stove to do the cooking

17. Thus, it seems to me that the trade mark FOURNEAUX DE FRANCE (for the DE FRANCE element is very obvious and does not require any translation) is descriptive of electrical apparatus for cooking foods; ovens, rotisseries, spit roasters, electric grills and cookers, all of which are included in Class 11 of the registration, originating from France. Thus, under the provisions of Section 3(1)(c) the application for registration in respect of the trade mark in suit should have been refused acceptance for registration. For the remainder of the goods in Class 11 (and for all the other goods covered by the registration) there is no objection on the basis of Section 3(1)(c) stemming from the translation of the trade mark onto English. For the reasons outlined, the trade mark indicates the origin of the goods and would be deceptive therefore if the goods sold under the trade mark did not originate in France. Thus, there is a valid objection under Section 3(3)(b).

18. In reaching this view I have taken note of Mr Kelly's view that the trade mark would not in fact convey any descriptive meaning to the general public. However, on the facts available, I cannot agree.

19. The registered proprietors trade mark attorney stated in evidence that the registered proprietors had been using the trade mark since 1993 and since then have spent in excess of £1 million on advertising expenditure. I therefore consider whether in view of the use that has been claimed the registration has in fact acquired a distinctive character in relation to the goods to which the objection above arises see (Section 47(1) above. The problem is that this use claimed is not substantiated in any way. No information is provided as to the turnover in respect of goods sold under the trade mark in the United Kingdom for any period. It is not clear that the advertising expenditure has been incurred in the United Kingdom; no catalogues

or promotional material whatsoever are provided. Thus on the basis of the scant information provided I am unable to establish whether or not the trade mark in suit has been used, never mind whether through use it has acquired a distinctive character for the goods to which the application for a declaration of invalidity is directed. In the circumstances I can do no more than state that I have insufficient information to decide that issue and therefore the grounds upon which the declaration of invalidity are based must be upheld.

20. For the reasons given above registration No 2025255 is declared invalid in respect of the following goods:-

Electric apparatus for cooking foods; ovens, rotisseries, spit roasters, electric grills; cookers.

21. In accordance with Section 47(6), which states:

Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.

the registration shall be deemed never to have been made in respect of those goods.

22. As the applicants for the declaration of invalidity have been successful, they are entitled to an award of costs.

23. The registered proprietors are ordered to pay to the applicant for the declaration of invalidity the sum of **£400**. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of the case with any appeal against the decision is unsuccessful.

Dated this 02 Day of November 2001

M KNIGHT
For the Registrar
The Comptroller-General