

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 2208648 BY SWEDISH MATCH INDUSTRIES ATKIEBOLAG TO REGISTER A TRADE MARK IN CLASSES 4 AND 34

DECISION AND GROUNDS OF DECISION

Background

1. On 15 September 1999 Swedish Match Industries Atkiebolag of P.O. Box 84, SE-522 22 Tidaholm, Sweden applied under the Trade Marks Act 1994 for registration of a trade mark in Classes 4 and 34 for the following goods:

Class 04 Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (not including motor spirit) and illuminants; candles, wicks; firelighters, barbecue lighters, fire starters, tapers, spills, solid fuels, fuel for pyrophoric lighters; refill units for gas lighters, refill units for petrol lighters all for lighting barbecues or lighting fires.

Class 34 Tobacco; smokers' articles; matches; cigarettes; lighters for smokers; flint lighters, flints, parts for lighters, pipe cleaners, refill units for gas lighters, refill units for petrol lighters, cigarette papers, cigarette filters, cigarette hand rolling machines, pipes, cigarette holders, tobacco pouches, ashtrays, cigarette boxes.

2. The mark for which registration is sought is represented at Annex A.

3. The following words appear on the form of application:

The applicant claims the colours orange and yellow.

4. Objection was taken to the mark under Sections 3(1)(b) and (c) of the Act because the mark consists of the device of a flame the whole being a sign which may serve in trade to designate the kind of goods.

5. In the course of subsequent correspondence it was proposed, in the official letter dated 18 November 1999, that the application be allowed to proceed for limited specifications in classes 4 and 34. Details of the proposed specifications are set out below:

Class 04 Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions.

Class 34 Tobacco; cigarettes; pipe cleaners; cigarette papers; cigarette filters; cigarette hand rolling machines; pipes; cigarette holders; tobacco pouches; ashtrays; cigarette boxes.

6. However, no response has been received to this specific proposal, other than an acknowledgment in the agents' letter of 10 May 2001 that it was actually proposed. The specifications have not been amended.

7. Following a hearing, at which the applicants were represented by Mr Buff of Phillips & Leigh, their Trade Mark Attorneys, the objections were maintained.

8. Evidence in support of this application has been filed by representatives of the applicants and their Trade Mark Attorneys. However, this evidence was not considered to be sufficient to overcome the objections which were again maintained.

9. Following refusal of the application under Section 37(4) of the Act 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.

The Law

10. The relevant part of Section 3(1) of the Act are as follows:

“The following shall not be registered -

(a)

(b) trade marks which are devoid of 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)

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.”

The case for Registration

11. The test for distinctiveness was laid down by Mr Justice Jacob in the TREAT case [1996] RPC 281 page 306 lines 2-5 when he said:

*“What does *devoid of 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?"

12. In the Proctor & Gamble Limited's application (1996 RPC 281), Walker L J said:

"Despite the fairly strong language of s. 3(1)(b), "devoid of any distinctive character" - and Mr Morcom emphasised the word "any" - that provision must in my judgment be directed to a visible sign or combination of signs which can by itself readily distinguish one trader's product - in this case an ordinary, inexpensive household product - from that of another competing trader. Product A and Product B may be different in their outward appearance and packaging, but if the differences become apparent only on close examination and comparison, neither can be said to be distinctive"

13. This application is for a sign which is a representation of a device of a flame. It is represented in a specific combination of the colours orange and yellow. In fact the form of application contains a colour claim in respect of these colours. It is appropriate at this point to make it clear that the applicants do not accept that the sign applied for is a device of a flame. In his letter of 20 October 1999 Mr Farwell of Phillips & Leigh makes the following statement:

"The mark does not consist of the device of a flame. The mark is an artistic representation of a flame but also includes an illuminated wall or background behind the flame (the yellow "glow" around the flame)."

14. In the same letter Mr Farwell further states:

"The mark itself is an artistic work attracting copyright and so may not serve in trade to designate the kind of goods since the only person entitled to reproduce the mark is our client, Swedish Match Industries Atkiebolag."

15. Whilst I have no objection to the precise description of this mark as provided by Mr Farwell I cannot simply accept his claim that the mark is an artistic work attracting copyright. No evidence has been placed before me as to the date the work was created, the jurisdiction in which it was created or by whom it was created. Moreover, the correct approach to the application of Section 3(1) cannot depend upon whether or not the applicant has another legal claim to the sign in question. It is clear from the European Court of Justice's judgement in the BABY-DRY case 2001 ETMR page , that the purpose of Article 7(1)(c) of Regulation 40/94 (which mirrors and has the same purpose as Section 3(1)(c) of the Act) is to prohibit the registration of trade marks that are directly descriptive and thus devoid of the distinctive character required to function as a trade mark. I can see no reason why a picture mark cannot be directly or exclusively descriptive of the goods simply because the picture is subject to copyright.

16. At the hearing held on 10 March 2000 I advised Mr Buff that the objections under Sections 3(1)(b) and (c) of the Act were maintained. However, I agreed to allow the applicants further time in which to consider the position and to make any further submissions they consider appropriate.

17. Subsequently further evidence was filed in support of this application. The first evidence to be received was in the form of a Witness Statement dated 7 February 2001 from Mr Farwell, the trade mark attorney responsible for the filing and prosecution of this application. Mr Farwell states that he conducted a small trade survey in the Norwich area on 6 February 2001. He states that the purpose of this survey was to determine if devices of flames or combinations of flame colours are wanted in trade for the goods in question. At Exhibit KRF1 Mr Farwell produces a can of lighter fluid purchased at an establishment named Dillons. This carries a device of a single stylised flame. At Exhibit KRF2 Mr Farwell provides another can of lighter fluid purchased at an Esso garage. This carries a device of three flames. Mr Farwell goes on to state that at the same Esso garage he observed a bag of Coalite smokeless fuel bearing a representation of an open fire on a yellow background. A box of firelighters with a device of flames is produced as Exhibit KRF3. At Exhibit KRF4 Mr Farwell provides details of Community Application No 001535525 which is for the same mark and goods as this application. This exhibit makes it clear that this application has been accepted for publication but I note from records available in the Registry that this application remains as a “pending” application.

18. Further evidence was provided in the form of a Witness Statement dated 7 February 2001 by Ms Jackman. Ms Jackman states that she is the Company Secretary and a Director of Swedish Match UK Limited, a sister company of the Applicants. Ms Jackman explains that in 1997 the applicants decided to create an overall brand identity. To assist them in research for a new design they appointed the Censydiam Centre for Systemic Diagnostics in Marketing. The appropriate section of their report is attached at Exhibit SMJ1. Exhibit SMJ2 provides actual examples of the sign applied for in use on matches. Exhibit SMJ3 provides samples of sales literature promoting the sign with further promotional material at Exhibit SMJ4. Details of the circulation of this promotional material is attached at Exhibit SMJ5.

19. Ms Jackman filed a Supplementary Witness Statement dated 8 February 2001. Exhibit SMJ1 is simply a copy of her Witness Statement dated 7 February 2001. Exhibit SMJ2 is a copy of a publication entitled “Guidelines for the core brands within match division”. Ms Jackman states that these guidelines were designed to cover every aspect of use of the design. Ms Jackman draws attention to pages 3 and 4 of the publication where different qualities are attributed to different colours. At page 9 the publication states “*the Bryant & May logo represents the heart of our identity*”. Exhibits SMJ3 and SMJ4 provide details of advertisements used by the applicants to promote the sign in the United Kingdom and SMJ5 provides a copy of a report detailing the extent of the applicants’ advertising campaigns in relation to the core brands.

20. On 5 April 2001 Mr Farwell wrote to the Registry enclosing details of Swedish Trade Mark Registration No 344978 which is for the same mark and goods as this application.

21. Mr Farwell wrote to the Registry again on 10 May 2001. In this letter Mr Farwell set out a review of this application together with further comment on the objections taken under Sections 3(1)(b) and (c) of the Act. Additionally Mr Farwell enclosed further evidence in the form of three further Witness Statements. These are from different managers of Swedish Match UK Limited and all provide exhibits demonstrating product displays from various retail establishments at different locations. It was submitted that the colouring and design of the products included in these exhibits does not resemble the sign applied for by the applicants. There are differences although I note that the colours orange and yellow appear to be commonly used on the packaging of these goods.

22. In the same letter Mr Farwell further states:

“...it is the applicants’ contention, and the nub of their case, that the capacity to distinguish of the mark in suit lies in the pleasing and inventive combination of carefully chosen colours.”

23. The evidence submitted in support of this application has not been submitted in order to demonstrate that the sign applied for has, in fact, acquired a distinctive character. The evidence is submitted in order to highlight the care with which this particular combination of colours was chosen.

24. Mr Farwell, in his Witness Statement dated 7 February 1991, refers to certain goods for sale in retail outlets in the Norwich area. At paragraph 3 Mr Farwell concedes that this a survey of limited scale and is, in my view, one to which I can attribute little weight. At Exhibit KRF1 Mr Farwell provides details of a Community application for an identical sign and identical goods but this is still an application with “pending” status and not a registered mark. However, even if it had achieved registration it would be of no direct assistance in this particular matter. The comments made in the MADAME case (1996) RPC page 545 were re-stated by Mr Justice Jacobs in the TREAT trade mark case (1996) RPC page 281:

“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. Madame TM and the same must be true under the 1994 Act.

Decision

25. Mr Farwell submitted that the sign applied for is more than a simple representation of a flame. He stresses that it is an artistic representation of a flame which includes an illuminated background behind the flame device. In my view the sign applied for would be seen, by the average consumer of these goods, as a device of a flame in the colours orange and yellow. I see nothing unusual in the fact that the sign is represented in the colours orange and yellow nor is there anything unusual in there being an illuminating effect as this is a perfectly natural effect of a flame. From the evidence submitted in support of this application it is clear that the colours orange and red are commonly used as colours applied to devices of flames on the packaging of goods such as firelighters and matches. This view appears to be confirmed by Exhibit KRF3 of the Witness Statement of Mr Farwell dated 7 February 2001 which carries an example of the use of these colours applied to a flame device, on a packet of firelighters. Further evidence in support of this view is provided by the exhibits of the Witness Statements of Mr Bosley dated 4 May 2001, Mr Kerr dated 8 May 2001 and Ms Balding dated 9 May 2001, all of which provide examples of the use of the colours orange and yellow, sometimes applied to flame devices, on the packaging of goods such as charcoal, firelighters, fire lighting fluid, and matches.

26. In his Witness Statement dated 7 February 2001 Mr Farwell provides details of goods from manufacturers other than the applicants and submits that the devices of flames are not common for the goods at issue. However, this is not entirely borne out by the Exhibits. Exhibit KRF1 provides details of a stylised device of a flame used on a can of lighter fluid, Exhibit KRF2 provides details of a stylised device of three flames on a can of petrol lighter refill and Exhibit KRF3 provides details of a stylised device of a flame, in the colours red and orange, on a packet of firelighters.

27. In her Witness Statement dated 7 February 2001 Ms Jackman explains that in 1997 the applicants decided to create an overall brand identity. In the course of this project the applicants appointed the Censydiam Centre for Systematic Diagnostics in Marketing to undertake diagnostic research on new designs for the packaging of the goods at issue. The relevant pages of their report is at Exhibit SMJ1 and one of the recommendations is found at Page 36 where they state:

*The most common feature appears to be the change in colours.....the new colours succeed in **adding more warmth and a relatively younger, and emotionally loaded impression**. This is evoked by the warmth and depth of the yellow and orange.*

28. In her supplementary Witness statement dated 8 February 2001 Ms Jackman provides further evidence of the background surrounding the choice of these colours and the importance attributed to them in the applicants' advertising campaigns. Whilst it is clear from the evidence that the applicants have made the decision to develop their marketing and promotional presentations based on the colours orange and yellow it does not necessarily follow that the use of these colours in the sign applied for

produces a distinctive trade mark.

29. In my view the sign applied for is a clear representation of a flame with a degree of background matter. The device of the flame itself is not stylised but appears to be an accurate representation of a flame. The background appears to represent the background glow which is usually associated with a flame. I see nothing unusual or arresting about the flame, it's background, the combination of colours or, more importantly, the sign as a whole. When viewed by the relevant public the sign will simply indicate that the goods on which the mark is used are flammable e.g. they may be used create a flame (matches), they may assist in lighting a particular substance (barbeque lighting fluid) or they are goods which are intended to be set alight (barbeque charcoal).

30. Whilst it is clear that a combination of non-distinctive elements can create a distinctive whole I do not accept that this is the position with this sign. I do not see that there is anything in this sign which would serve to distinguish the goods from those of other traders of these goods.

31. In my view the sign applied for will not be taken as a trade mark without first educating the public that it is a trade mark. It follows that this application is debarred from prima facie acceptance by Section 3(1)(b) and (c) of the Act.

32. 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 in that it fails to qualify under Sections 3(1)(b) and (c) of the Act.

Dated this 6TH day of March 2002

A J PIKE

**For the Registrar
The Comptroller General**

ANNEX A

