THE PATENT OFFICE

Room A2
Harmsworth House,
13-15 Bouverie Street,
London EC4Y 8DP.

Thursday, 2nd May, 2002

Before:

MR. GEOFFREY HOBBS QC
(Sitting as the Appointed Person)

In the Matter of the Trade Marks Act 1994

and

In the Matter of Trade Mark No. 2025255 in the name of FOURNEAUX DE FRANCE LIMITED

and

In the Matter of Declaration of Invalidity No. 11542 thereto by THE RANGE COOKER CO. PLC

Appeal of Applicant from the decision of Mr. M. Knight acting on behalf of the Registrar, dated 2nd November 2001.

(Transcript of the shorthand notes of Marten Walsh Cherer Ltd., Midway House, 27/29 Cursitor Street, London EC4A 1LT. Telephone No: 020-7405-5010. Fax No: 020-7405-5026.)

MR. IAN GILL (A.A. Thornton & Co.) appeared on behalf of the Applicant for Invalidity.

MR. M. EDENBOROUGH (instructed by Venner Shipley & Co.) appeared on behalf of the Registered Proprietor. Registry.

D E C I S I O N
(As approved)

MR. HOBBS: The designation FOURNEAUX DE FRANCE was registered as a trade mark under No. 2025255 with effect from 27th June, 1995. It was registered in the name of Fourneaux De France Limited for use in relation to:

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.

In the advertisement of the application for registration in the Trade Marks Journal it was noted that: "The mark consists of the French words meaning 'Furnaces of France'".

On the material before me that appears to have been an over-literal translation of the words in question. The nuance of the relevant words in the context of the registration is,

in my view, best encapsulated in the English expression "cookers from France".

On 13th January, 2000 the registered proprietors' trade mark attorneys wrote to the Range Cooker Co. Plc of Blackpool in the following terms:

> "We act on behalf of Fourneaux De France Ltd. of 30 Albion Close Newtown Business Park, Poole, Dorset BH12 3LL and our clients are the registered proprietors of UK trade mark registration FOURNEAUX DE FRANCE No. 2025255 covering various goods falling in Classes 7, 8, 11, 21 and 25. Full details of the registration are enclosed.
>
> We noticed that you are using a mark (as enclosed) in respect of domestic appliances, which includes predominantly the words FOURNEAUX FRANCE.
>
> Having regard to our client's UK trade mark registration No. 2025255, we shall be advising them as to appropriate action they may wish to take concerning the use of your enclosed trade mark but before we take the matter further, we would appreciate receiving your comments please regarding the situation.
>
> We look forward to hearing from you please as soon as possible."

Enclosed with the letter was an item of sales material bearing a logo within which the word "FOURNEAUX" appeared above and the word "FRANCE" appeared below the word "Morice" in the manner shown in Annexe A to this decision.

The Range Cooker Co. Plc markets specialist cooking appliances, including what are known as range cookers or cooking ranges. In particular it imports and sells range cookers from France, and the enclosure to the letter it had received from the registered proprietors' trade mark attorneys showed the trade mark of the French supplier of a range cooker which the company was offering for sale in the United Kingdom.

In that trade mark the words FOURNEAUX and FRANCE were clearly being used descriptively in relation to the products concerned.

The risk of incurring liability for infringement of registered trade mark for using the French supplier's trade mark in relation to cookers it had purchased for resale in the United Kingdom was something that the Range Cooker Co. Plc viewed with concern. It therefore applied on 17th March, 2000 for a declaration under section 47 of the Trade Marks Act 1994 to the effect that Registered Trade Mark No. 2025255 was and remained invalidly registered in respect of the following goods in Class 11:

> "Electric apparatus for cooking foods; ovens; rotisseries; split roasters (sic); electric grills; cookers and cooker hoods; extractors."

The aim of the application was to remove cookers and related goods from the scope of the registration. It was contended that the registration should be held invalid to that extent, in accordance with the provisions of sections 3(1)(a), 3(1)(c) and 3(3)(b) of the 1994 Act.

In a written decision issued on 2nd November, 2001 Mr. M. Knight, Principal Hearing Officer acting for the Registrar of Trade Marks, upheld the claim for a declaration of invalidity under section 3(1)(c) and section 3(3)(b) in relation to the goods in Class 11 which had been cited in the application under section 47 **other than** cooker hoods and extractors.

He approached the question of validity in accordance with the following statements of practice in chapter 6 of the Trade Mark Registry's Work Manual:

> "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 e.g. TOUJOURS/ALWAYS."

and in accordance with the approach summarised in the headnote to the decision in **EL CANAL DE LAS ESTRELLAS Trade Mark** [2000] RPC 291, later adopted in **TONALITE HENNE** [2001] RPC 729.

His conclusion was as follows:

> 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
>
> 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 into 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)."

He granted a declaration of invalidity to the extent I have identified above and awarded the Range Cooker Co. Plc £400 as a contribution towards its costs on the basis that it was the successful party in the proceedings before him.

On 30th November, 2001 the Range Cooker Co. Plc gave notice of appeal to an Appointed Person under section 76 of the Act, contending in substance that the logic of the Principal Hearing Officer's decision on the question of invalidity was equally applicable to cooker hoods and extractors, and that those items should have been included in the declaration of invalidity that had been granted in respect of the registration in suit.

The registered proprietor did not appeal against the Principal Hearing Officer's decision, but maintains, in response to the appeal brought by the Range Cooker Co. Plc, that cooker hoods and extractors are goods for which the trade mark in suit should remain registered on the basis that they are not goods relative to which the expression FOURNEAUX DE FRANCE can be said to be clearly and naturally descriptive to

the degree envisaged in the recent decision of the European Court of Justice in the **BABY-DRY** case.

In that case the ECJ took the view that the designation BABY-DRY was a syntactically unusual combination of words susceptible of being regarded as a lexical invention and therefore free of objection under the provisions of Community law reflected in section 3(1)(c) of the Trade Marks Act 1994.

I do not think that the same can be said of the words FOURNEAUX DE FRANCE in the context of cookers, and the question which now confronts me is whether cooker hoods and extractor fans should, like electric apparatus for cooking foods, rotisseries, spit roasters and electric grills, be treated as goods so closely related to cookers as to be an integral part of the commercial context in which the meaning and significance of the words FOURNEAUX DE FRANCE is to be regarded as essentially descriptive.

Having listened with care to the arguments that have been addressed to me on this appeal, I have come to the conclusion that cooker hoods and extractors are closely connected items of commerce, and that they are both so closely connected with cookers that it would be unrealistic to treat the words FOURNEAUX DE FRANCE as descriptive of the character of the latter but not the former. The expression "cookers from France" is descriptive at a high level of generality. That makes it suitable, in my view, for descriptive use in the marketing of units of equipment of the kind found in modern

cooker installations including not only grilling and roasting units, but also hood and extractor units.

It seems to me that the logic of the Principal Hearing Officer's decision does indeed carry through and read on to those items with the result that the declaration of invalidity

that he granted ought also to have embraced them.

For the reasons which I have sought to indicate, it appears to me that the Principal Hearing Officer did not go quite far enough in his decision, and I therefore propose to allow the appeal as requested.

Do you want to address me on costs?

MR. GILL: I believe it is relatively well established in these instances that costs follow the event. I do not think there is anything unusual in this instance. I do feel the need for the appeal stems from the error of the Hearing Officer. In the light of this, had the appeal not been contested I would have been able to accept that it was not appropriate to award costs. However, this appeal has been vigorously contested, which I must admit I find surprising in the specific circumstances, particularly in that a cross-appeal was not filed. I would seek an order for costs up to the limit provided by the Registry guidelines.

MR. HOBBS: Yes, it is very pragmatic on appeal. The Registry guidelines are quite formulaic in relation to proceedings below. We are somewhat more pragmatic here.

Mr. Edenborough, what do you say?

MR. EDENBOROUGH: I cannot resist an application for costs against us, but I would say it should be in accordance with the Appointed Person's normal way in which costs are administered in this forum.

MR. HOBBS: I know how I normally do it. How do the others normally do it?

MR. EDENBOROUGH: Broad brush. It broadly follows what was below.

MR. HOBBS: From what I have seen of it, Mr. Thorley tends to say very much, the same again, unless he thinks there should be an allowance for aggravation. Aggravation should be reflected in an upgrade, or there should be some discount. It was £400 below. The decision was 2nd November, 2001, but there was no hearing below. On the other hand, there is no evidence before me for the purposes of this appeal.

Mr. Gill, can you give me an indication of your preparation time for this appeal?

MR. GILL: I spent about two and a half hours yesterday, and that was primarily the substance of it.

MR. HOBBS: Someone had to read and prepare the document that was put in, whether it was you or not, the statement of case and grounds of appeal.

MR. GILL: Yes. It was quite straightforward. It was not me who prepared it, but I cannot believe it would have taken more than half an hour to do that.

MR. HOBBS: It is very fair of you to take that approach. It seems to me that I will do the same again, and that the appeal will be allowed and the order for costs in this connection will be £400 as a contribution towards the costs of the successful party.

Thank you both very much for your submissions and for responding so well to my "interrogation." I enjoy it, and I hope you do not mind it too much. Thank you very much indeed.
