

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2262106
IN THE NAME OF SIMON HUNT
TO REGISTER A TRADE MARK IN CLASS 11**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 90431
BY HALFORDS LIMITED**

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**IN THE MATTER OF Application No. 2262106
in the name of Simon Hunt to register a Trade Mark in Class 11**

AND

**IN THE MATTER OF Opposition thereto under No. 90431
by Halfords Limited**

BACKGROUND

1. On 22 February 2001 Simon Hunt applied to register the following series of two trade marks in Class 11 of the Register:

DASHLIGHT

DASHLITE

2. Registration was sought for the following specification of goods:

“Torches, torches rechargeably powered from a cigarette lighter in a car.”

3. The application was accepted by the Registrar and published in the Trade Marks Journal.

4. On 21 September 2001 Halfords Limited filed Notice of Opposition. The Statement of Case says that the opponent is a major retailer of car parts and accessories who has been selling continuously a “rechargeable dashlight” since at least October 1998 in the UK. It adds that the applicant (Mr Hunt) has been aware of the opponent’s “dashlight product” since at least January 1999 and that Mr Hunt is the proprietor of UK Trade Mark Registration Number 1564365 for the trade mark DASHLITE which is registered for goods including torches “but not including any such goods for use with dashboards or instrumentation”. The Statement of Case goes on to say that cigarette lighters in cars are most commonly located in the dashboard or dash of a car and that a torch is a portable light, with the word lite being a common alternative spelling for light and phonetically identical.

5. In summary, the grounds of opposition were as follows:

(i) Under Section 3(1)(a) of the Act because the marks are not a sign capable of distinguishing the specified goods of one undertaking from those of another undertaking.

(ii) Under Section 3(1)(b) of the Act as the marks are devoid of any distinctive character.

(iii) Under Section 3(1)(c) of the Act because the marks consist exclusively of signs or indications which may serve in trade to designate the kind and intended purpose of the goods in the application.

(iv) Under Section 3(1)(d) as the marks 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.

(v) Under Section 3(6) of the Act as the application was made in bad faith because – the applicant was aware that the opponent had been using the “product description dashlight” for over a year; the applicant was aware (in light of registration number 1564365) that the marks are signs which serve to designate the kind and purpose of the goods; the applicant was not the proprietor of the marks in suit as he has represented that any reputation in the DASHLITE mark in the UK rested with Lee Hunt International Pty.

6. The applicant filed a Counterstatement denying the above grounds. Both sides filed evidence and have asked for an award of costs in their favour. The matter came to be heard on 29 January 2003 when the applicant was represented by Mr Langley of Origin Limited (the applicant’s professional advisors in the opposition) and the opponent was represented by Mr Dunlop of Wynne-Jones Laine & James (the opponent’s professional advisors in this case).

Opponent’s Evidence

7. This consists of two witness statements, one each from Helen Shute and Brian Kenneth Charles Dunlop dated 12 April 2002 and 22 April 2002 respectively.

8. Ms Shute is an Assistant Product Manager of Halfords Limited (the opponent). She states that her company has been selling a “rechargeable dashlight” since October 1998 and attached as “Exhibit HS1” to her statement is a copy of the packaging for this product. Ms Shute explains that it can be seen that the term “Rechargeable Dashlight” sits under her company’s trade mark HALFORDS. She goes on to state that the product was part of a range sold by her company and “Exhibit HS1” includes copies of packaging of other products having an identical configuration in their naming:- “Travel Fan & Map Light” and “Rechargeable Spotlight”. Ms Shute opines that customers would perceive all these terms as being mere product descriptors. She adds that there have been no instances of confusion with the Lee Hunt product.

9. Ms Shute goes on to draw attention to Exhibit “HS2” to her statement which contains “print-outs” to show the term “dash light” being used for lights for use on the dashboard of vehicles, the bulk of which relates to use in the USA after the relevant date. She states that many of the products illustrated contain a plug for insertion into the cigarette lighter. Ms Shute also points out that the “Type S Auto” accessories show torch-like lights mountable on the dashboard and powered from the cigarette lighter described as “Dash Light”. Also included in Exhibit HS2 is a dictionary definition of “Dashlight” taken from a 1993 version of the Merriam-Webster Dictionary (a standard American English dictionary) which defines it as “a light on the dashboard of an automobile”.

10. Mr Dunlop is a registered trade mark attorney and a partner in the firm of Wynne-Jones, Laine & James, the opponents professional advisors.

11. Mr Dunlop states that in January 1999 Halfords Limited received a letter from Lee Hunt International Pty. Limited (copied as Exhibit “BKCD1” to his statement) accusing Halfords of passing off and trade mark infringement. The letter states that the reputation in DASHLITE rests with Lee Hunt International Pty. Limited, an Australian company. Mr Dunlop states that, when the application in suit was filed, Simon Hunt was not a director of Lee Hunt International Pty. Limited and he adds that in his experience it would be most unusual for a company to agree to allow a trade mark application for their trade mark to be owned by an individual. Mr Dunlop goes on to refer to Exhibit “BKCD2” to his statement which is a letter and enclosures from Australian lawyers which indicates that the position in Australia is similar.

12. Mr Dunlop also refers to copies of further correspondence exchanged with Lee Hunt International Pty. Limited and subsequently Misham Lawyers (also at Exhibit “BKCD1”) which includes discussion of the exclusion of “goods for use with dashboards or instrumentation” in UK Trade Mark Registration Number 1564365 and Mr Dunlop states that this exclusion was in effect, acknowledged by the applicant in that registration as being relevant. He concludes by stating that “dashlight” is a dictionary definition which the opponent uses as a descriptive term.

Applicant’s Evidence

13. This consists of a witness statement by Simon Hunt (the applicant) dated 20 July 2002.

14. Mr Hunt states that the DASHLITE brand of rechargeable torches have been sold in twenty three countries since 1986 by companies with which he is connected and that twenty seven thousand rechargeable torches were sold in the UK as at the end of 2001. He adds that DASHLITE torches are manufactured by Lee Hunt International Pty. Limited, an Australian company of which he is managing director.

15. Mr Hunt is critical of the evidence contained in Ms Shute’s statement filed on behalf of the opponent. He points out that the products shown in Exhibit “ITS2” to her declaration are for the U.S.A. market and that the dictionary definition she provides is taken from an American dictionary. Mr Hunt states that while ‘Dashlight’ may be descriptive in the U.S.A. of a certain form of light it does not follow that it is descriptive in the UK of the goods covered by the application in suit. Mr Hunt adds that lighting regulations and product categories vary between countries. In Mr Hunt’s view the evidence submitted by the opponent provides no example of UK descriptive use of the term “dashlight”. He goes on to explain that in the UK flashing emergency lights must conform to the Road Vehicles Lighting Regulations 1989 (SI 1989 No. 1796) which, in effect, require flashing lights for cars (although not necessarily tall vehicles such as lorries and large vans or off-road vehicles) to be placed on the roof rather than the dashboard.

16. Mr Hunt states that in 1997, as managing director of Lee Hunt International Pty. Ltd., he and their UK distributor (Portland Marketing Limited), approached Halfords with the aim of asking Halfords to retail their DASHLITE rechargeable torch. He adds that Halfords started selling their own version of a rechargeable torch in October 1998 calling it the “Dash Light” having obtained the product from a different supplier.

17. Next Mr Hunt turns to the allegation that he filed the present trade mark application in bad faith because the application should have been made in the name of Lee Hunt International Pty.

Limited. Mr Hunt says that when he filed the application, it was his intention to simply hold it on trust for Lee Hunt International Pty. Ltd until such time as assignment to that company was needed. Mr Hunt explains that when he made the application in February 2001, he was not a director of the company, but he was a director between 1989 and 1998 and from August 2001 onwards. Although not a director when the application was made, Mr Hunt states that he was nevertheless actively involved in running operations for Lee Hunt International Pty. Ltd and in fact had all the responsibilities of a managing director. He adds that when applying for the mark in suit he was acting in the best interests of Lee Hunt International Pty. Ltd.

Opponent's Evidence in Reply

18. This comprises a second witness statement by Brian Kenneth Charles Dunlop, which is dated 18 October 2002.

19. Mr Dunlop states, that as made clear in the statement of Ms Shute, Halfords have been selling a product described as a "dashlight" since October 1998 and have more recently sold the "dashlight" illustrated in Exhibit "HS2" to Ms Shute's statement. He goes on to point out that the Halford's "dashlight" products are sold in the UK.

20. Mr Dunlop draws attention to Mr Hunt's failure to explain why he was not a Director of Lee Hunt International Pty. Ltd in the period 1998 to August 2001 and the reasons for his holding the trade mark application in trust. Mr Dunlop can think of no bona fide reason why trade marks should be held outside a company, which is the rightful proprietor for those trade marks.

21. This completes my summary of the evidence filed in this case. I now turn to the decision.

DECISION

22. Firstly I turn to the grounds of opposition based upon Section 3(1) of the Act, which reads as follows:

"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 of rendering of services, or other characteristics of goods or services,
- (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.”

23. As the marks in suit are not proceeding on the basis of distinctive character as a result of use, I must consider their acceptability on a prima facie basis.

24. The application is for a series of two marks. At the hearing Mr Langley conceded that the second mark EASYLITE comprised a mere alternative spelling of the first mark EASYLIGHT and in effect, for the purposes of this opposition under Section 3(1), agreed that the two marks stood or fell together. I would add that while the visual impression of the marks is different, the marks will be pronounced identically and that in relation to the goods, the idea of the marks will remain the same. Accordingly I agree with the parties that the alternative spellings do not have any impact upon the prima facie consideration of acceptability under Section 3(1).

25. Both parties were in agreement that the marks must be considered in their totality and in relation to the goods for which registration has been requested.

26. Mr Dunlop, in essence, submitted that the term DASHLIGHT is a natural description for the goods as cigarette lighters in cars are most commonly located in the dashboard or dash of the car and a torch is a portable light or more generally a light. He also drew attention to the opponent’s evidence, in particular the dictionary definition found in the Merriam Webster dictionary and the third party use of the DASHLIGHT. Whilst conceding that much of the evidence goes to use in the USA and is after the relevant date for these proceedings, Mr Dunlop argued that such evidence nevertheless was strongly indicative that the combination of the words DASH and LIGHT/LITE was an obvious and meaningful one in the English language.

27. On behalf of the applicant, Mr Langley submitted that the marks in their totality amounted to no more than an indirect allusion to torches that are charged through car cigarette lighters and that they would not be taken by the relevant public as designating the purpose or essential characteristics of the goods. He emphasized that the goods were torches and not a light situated on or in the dashboard of a car as such. Mr Langley was also highly critical of the opponent’s evidence stating that third party use was in the USA for flashing lights and that the dictionary definition was American and referred to a light on the dashboard of a car, as opposed to a torch.

28. I turn now to a consideration of the evidence filed by the opponent in relation to Section 3(1) of the Act. Much of this evidence relates to material accessed from American internet sites and contains information relating to the position after the relevant date for these proceedings. The only third party use shown in the UK is of TYPE S DASH LIGHTS and this appears both undated and unspecific. Furthermore, the dictionary reference is taken from the Merriam Webster Dictionary which is a standard American English Dictionary, as opposed to a British English Dictionary. While American English and British English words and usage are usually identical, this is not necessarily the case and there is no evidence to show that DASHLIGHT is a well known generic term in British English. On the whole, I do not find the opponent’s evidence to be of assistance in relation to Section 3(1) of the Act. However, there is some merit in Mr Dunlop’s submission that it goes to show that the combining or conjoining of the words DASH and LIGHT/LITE is a not unreasonable step.

29. In relation to Section 3(1), both parties at the hearing concentrated their arguments on Section 3(1)(b) and Section 3(1)(c). On Section 3(1)(b) it was accepted that the tests set out in the decision of Geoffrey Hobbs QC sitting as the Appointed Person in *Cycling Is.....* [2002] RPC 37, are relevant. In particular, I find paragraphs 66 to 71 of that decision, set out below, to be of particular assistance:

“66. That brings me to the question of whether the signs possess a distinctive character enabling them to fulfil the essential function of a trade mark in relation to goods and services of the kind specified in the application for registration. (The goods and services comprise “clothing footwear and headgear” in Class 25 and “advertising all relating to the cycling industry” in Class 35).

67. The case for allowing registration rests upon the proposition that the signs are cryptic to a degree which makes it more likely than not that they would carry connotations of trade origin (whatever other connotations they might also carry) in the minds of the relevant class of persons or at least a significant proportion thereof.

68. The case for refusing registration rests upon the proposition that the signs are visually and linguistically meaningful in a way which is more likely than not to relate the goods and services to the activity of cycling without also serving to identify trade origin in the minds of the relevant class of persons.

69. The difference between these two positions resides in the question whether the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin specific or origin neutral.

70. The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect.

71. I do not suppose that such a person would pause to construe the signs when encountering them in any of the different settings (including advertising and promotional settings) in which they might be used. Even so, the degree of attention required to take note of the signs in the first place would be sufficient, in my view, to leave a well-informed and reasonably observant and circumspect person with the clear impression that the signs were being used with reference to goods and services related to cycling.”

30. The marks in suit are DASHLIGHT and DASHLITE. DASH is a well known dictionary word, which in relation to the goods of the application obviously describes the instrument panel in a car. The word DASH is conjoined to the well known dictionary word LIGHT and (in the case of the second mark in the series) its alternative spelling LITE, which in relation to the goods of the application describes an instrument that illuminates or the effect of illumination. While both elements of the marks ie. the words DASH and LIGHT/LITE, have a direct reference to the goods at issue e.g. the torches are situated on the DASH and function as a LIGHT/LITE or provide LIGHT/LITE, the marks must be considered as a whole or descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form.

31. In considering the marks in their totality I bear in mind my own knowledge and experience which tells me that the words “Light” and “Torch” are often readily interchangeable. For example one could make the following alternate requests – “Please point the torch over here” or “Please point the light over here”; “Shine the torch over there” or “Shine the light over there”; “Put the map under the torch” or “Put the map under the light”. In the prima facie it seems to me that the customer for rechargeable torches powered from a cigarette lighter of a car would merely regard the word DASHLIGHT, or its mere alternate spelling DASHLITE, as describing a light source emanating from a torch in a vehicle’s dash and/or a light source (torch) which is kept (and recharged) in the vehicle’s dash. Such use of the word DASHLIGHT/DASHLITE would directly describe the purpose and characteristics of the goods in a trading context. The customer could illuminate a map with the light or torch in situ in the dash, the light emanating from the dash, or remove the torch/light from the dash for use if elsewhere.

32. To conclude in relation to Section 3(1)(b), I find that the marks are “origin neutral” and thus “devoid of distinctive character” in relation to the goods applied for.

33. While it seems to me that the opponent’s case under Section 3(1)(c) is now stronger than the Section 3(1)(b) case I go on to consider this ground.

34. On Section 3(1)(c) both parties referred me to the September 2001 judgement of the European Court of Justice in *Proctor & Gamble Company v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case – 282/99P for the mark Baby Dry. This judgement gives very useful guidance on the test for descriptiveness under Section 3(1)(c) of the Act.

35. I give below paragraphs 37, 39 and 40 of the judgement in full:

“37. It is clear from those two provisions taken together that the purpose fo the prohibition of registration of purely descriptive signs or indication as trade marks is, as both Proctor & Gamble and the OHIM acknowledge, to prevent registration as trade marks signs or indication which, because they are not different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function.”

“39. The signs and indication referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indication satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole form the usual way or designating the goods or services concerned or their essential characteristics.”

“40. As regards trade marks composed or words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but

also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services of their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”

36. My earlier findings in relation to the descriptive nature of the words DASHLIGHT and DASHLITE (paragraphs 29 to 31 of this decision) remain relevant to the assessment of the acceptability of the marks under Section 3(1)(c). Following these earlier findings it seems to me that the marks, taken in their totality, may serve in normal usage from a consumers point of view to directly designate the essential characteristics of the goods for which registration is sought. The combination of the words DASH and LIGHT/LITE does not confer distinctive character on the word combinations enabling them to be registered as a trade mark. The opposition also succeeds under Section 3(1)(c).

37. Turning to the Section 3(1)(a) and Section 3(1)(d) grounds it seems to me that on the basis of the opponent’s evidence filed in this case (upon which I have commented at paragraph 27 of this decision), these grounds cannot be sustained.

38. As the opposition has been successful under Section 3(1)(b) and Section 3(1)(c) I have no need to go on and consider the ground of opposition raised under Section 3(6) of the Act.

39. The opposition has succeeded and the opponent is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £1,900. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 05 day of February 2003

**J MacGillivray
For the Registrar
the Comptroller-General**