

O-331-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2458467B
BY IMPERIAL CHEMICAL INDUSTRIES LIMITED
TO REGISTER IN CLASS 2 THE TRADE MARK:**

ZERO

AND

**IN THE MATTER OF OPPOSITION NO 96821 BY
ZERO-LACK GMBH & CO. KG**

TRADE MARKS ACT 1994

**In the matter of application No 2458467B
by Imperial Chemical Industries Limited
to register the trade mark ZERO in class 2**

and

**In the matter of opposition No 96821 by
Zero-Lack GmbH & Co. KG**

Background

1. On 14 June 2007 Imperial Chemical Industries Limited (“ICI”) applied to register the trade mark ZERO in respect of:

Class 2: Paints, varnishes, lacquers; driers including curing driers, thinners, colouring matters, all being additives for paints, varnishes or lacquers; preservatives against rust and against deterioration of wood; priming preparations (in the nature of paints); wood stains; mastic; repositionable patches of paint, varnishes or lacquers.

2. Zero-Lack GmbH Co. KG (“ZL”) oppose registration of ICI’s application on the following grounds:

Under section 3(1)(b) of the Trade Marks Act 1994 (“the Act”) because:

““Zero” is used to describe paints and flame retardant coatings, for example zero classifications in relation to flame retardant protection coatings and zero-VOC paints (volatile organic compounds).”

Under section 3(1)(c) of the Act because:

““Zero” describes the characteristics of the goods, namely paints, lacquers etc. with reduced contaminants such that they effectively have “zero” contaminants.”

Under section 3(1)(d) of the Act because:

““Zero” is used in the painting and decorating profession when talking about the properties of paints, coatings etc to indicate that they have low or no emissivity of volatile organic compounds.”

3. ICI filed a counterstatement denying the grounds of opposition. Both sides then filed evidence, a summary of which follows. Neither party requested a hearing. ICI filed written submissions, ZL did not.

ZL's evidence

4. This comes from Ms Helen Jane Forsyth of Nash Mathews, ZL's representatives in this matter. Ms Forsyth explains her views on the descriptiveness and the use of the word ZERO in the painting and decorating profession. I do not intend to summarise Ms Forsyth's views in detail given that she is a trade mark attorney rather than a person working in the relevant field. Her views are, therefore, opinion rather than evidence of fact. I will, however, document the material she exhibits to her witness statement in support of her views.

Exhibit HJF1 – This is an extract from the *Telegraph Magazine* dated 7 June 2008. It contains an interview with Mr John Dison of *earthborn* a company which produces natural “eco” paints”. In relation to “eco” paints he states “...eco paints should be zero VOC (volatile organic compounds), have zero oil content, zero formaldehyde, and be as safe and healthy as possible”.

Exhibit HJF2 – This is a print taken from the website www.myplanetintl.com which relates to a number of different paints. There are five different references relating to five different paints which use the words “zero VOC” or “zero-VOC”.

Exhibit HJF3 – This contains two documents. The first is a print from www.professionalphainters.co.uk which relates to a domestic and commercial decorating service provider. It includes the text “We have vast experience in the latest flame retardant protection coatings from Dulux for zero and one classifications”.

The second document is a leaflet/brochure for “ICI Dulux Trader PYROSHIELD” which claims to be a flame retardant coating. The “Class 0” rating is referred to throughout this document and relates to a performance class set by Building Regulations for fire protection. Coatings can achieve different classifications, for example 2 coats of Pyroshield (and 2 coats of approved finish) will achieve Class 1 whereas 3 coats of Pyroshield (and 2 coats of approved finish) will achieve Class 0.

Exhibit HJF4 – This also contains two documents. The first is a print from www.dulux.com.au and contains the following text “We have always taken pride at being at the forefront of technology to improve the environmental performance of our products (for example introducing the first zero VOC water-based decorative paint to the Australian market in 1992) and are now looking at ways to better define the “sustainability challenge””.

The second document is a print from ecobites.com (formally ecostudio.com.au) and carries the text: “New environmental regulations,

and consumer demand, have led to the development of low-VOC and zero-VOC paints and finishes. Dulux has produced a range of eco paints aptly named Dulux enviro2”

ICI's evidence

5. This comes from Ms Victoria Wisener, a trade mark attorney in ICI's Legal and IP Department. Mirroring my approach to ZL's evidence, I will focus on the documentation provided to support Ms Wisener's view that the word ZERO is neither descriptive nor in use in the UK.

Exhibit VW1 – This is a print of the results of an Internet search conducted on *Google.co.uk* for the word “zero” found on “pages from the UK”. 21,200,000 hits were returned. Of these, the first one hundred were reviewed by Ms Wisener (and the *Google* print provided in evidence). None relate to paint. The websites of the first 10 hits are also provided.

Exhibit VW2 – This is counter-evidence to Ms Forsyth's HJF2. It shows the contact details for four of the five references in HJF2. It is clear that they are based in the US and not the UK. The fifth reference in HJF2 relates, Ms Wisener says, to an ICI Dulux brand used in the US.

Exhibit VW3 – This consist of three documents relating to the fire safety of buildings. Highlighted is the fact that the safety class referred to in Ms Forsyth's evidence is commonly referred to as “class” plus the appropriate digit (0-4) and that the word ZERO itself is not used.

6. The only additional points I note from Ms Wisener's evidence are that she highlights that the references in HJF4 relate to the Dulux business in Australia and that this company is a separate entity owned by an independent company called Orica Pty. Secondly, she highlights that none of the uses identified by Ms Forsythe are of ZERO alone.

The section 3(1)(d) ground of opposition

7. Section 3(1)(d) of the Act states that the following shall not be registered:

“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”.

8. In terms of relevant case-law, I note the judgment of the European Court of Justice (“ECJ”) in *Merz & Krell GmbH & Co. (Case C-517/99)* (“*Merz & Krell*”) where it was stated:

“31. It follows that Article 3(1)(d) of the Directive must be interpreted as only precluding registration of a trade mark where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought.”

9. I also note the decision of Professor Annand (sitting as the Appointed Person) in *Stash* (BL O–281-04) where she stated:

“In the event, I do not believe this issue of the interpretation of section 3(1)(d) is central to the outcome of the appeal. “Customary” is defined in the Oxford English Reference Dictionary, 1995 as: “usual; in accordance with custom”. In my judgment, the Opponent has failed on the evidence to prove that at the relevant date STASH contravened section 3(1)(d) as consisting exclusively of signs or indications which have become customary either in the current language or in trade practices for the goods concerned.”

10. Each ground of refusal I must deal with has independent scope and each must be interpreted in light of the general interest underlying them. In *SAT.1 SatellitenFernsehen GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-329/02 P the ECJ stated:

“25 Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

11. In terms of the interest underlying section 3(1)(d) the ECJ stated in *Merz & Krell* that:

“The purpose of Article 3(1)(d) of the Directive is to prevent the registration of signs or indications that are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and so do not satisfy the criterion laid down in Article 2 of the Directive.”

12. To be satisfied that a sign has become customary in the current language or in the *bona fide* and established practices of the trade and consequently that the sign is incapable of distinguishing the goods of one undertaking from those of others, evidence must be provided to that effect, evidence establishing customary use in the UK. ICI's counter evidence means that HJF2 & HJF4 of ZL's evidence is of no assistance given that the documents relate to use in the US and Australia respectively.

13. As Ms Annand stated in *Stash*, the word customary is defined as “usual”. On the basis of the remaining evidence, I am far from satisfied that it supports the proposition of commonality or usualness. Furthermore, I note from the evidence that the designations in use contain additional elements and/or they use the digit O rather than the word ZERO. Whilst the latter of these points does not present an insurmountable problem, the former means that only half the used designator is used. The wording of section 3(1)(d) and the text of the ECJ's judgment in *Merz & Krell* informs me that this ground of opposition cannot extend to circumstances where the sign in question composes part of the designator of the goods.

14. For both of the above reasons, the ground of opposition under section 3(1)(d) of the Act must fail.

The section 3(1)(c) ground of opposition

15. Section 3(1)(c) states that the following shall not be registered:

“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 services, or other characteristics of goods or services”

16. The ECJ has issued judgments germane to this issue. A helpful summary of the position was given in *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-191/01 P (“*Doublemint*”), where it was stated:

“32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

17. I also note that in *Matratzen Concord AG v Hukla Germany SA*, (Case C-421/04) (“*Matratzan*”) the ECJ stated:

“In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPNNederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

18. Finally, I also note the decision of the CFI in *Ford Motor Co v OHIM*, Case T-67/07 (“*Ford*”) where it was stated:

“there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics”

19. In relation to the underlying interest, section 3(1)(c) pursues an aim which reflects the public interest in ensuring that descriptive signs or indications may be freely used by all (see, for example, *Doublemint*).

20. ICI do not dispute that the word ZERO is a known dictionary word (meaning nothing or nil), but it argues that the word does not describe any of the goods. Although not expressed as such, it seems to me that ICI view the brevity of the mark as a key factor, in other words, the missing characteristic to which ZERO relates equates to the mark being free from objection because ZERO alone does not describe a characteristic of the goods. Whether I have summarised ICI's views correctly or not, this to me is indeed a key factor. For example, there can be no doubt that a designation such as “ZERO VOC” would be refused registration under this ground because it merely describes goods (such as paint) that have zero or nil VOCs (volatile organic compounds) - but does the same apply to ZERO solus?

21. I am conscious of the judgment in the *Ford* case where it was held that there must be a “...sufficiently direct and specific relationship...”. This could, therefore, be seen to support ICI's view that the mark ZERO is too imprecise to send a descriptive message on its own. However, this must be balanced by the judgment of the ECJ in *Doublemint* which suggests that imprecision is not enough to escape refusal so long as one of the possible meanings designates a characteristic. I also note that whilst a directness of relationship may be necessary, this does not mean that the goods in question must be capable of direct description with reference to the mark. In other words, it is not a requirement, when applied to this case, that the paint (etc.) may be described as “ZERO PAINT”. Descriptions of characteristics as opposed to direct descriptions of the goods themselves are also covered by section 3(1)(c).

22. I have already found that the evidence in these proceedings is insufficient to show that the word is in customary use. However, it does at least show that there is a class of coating (such as paint) designated “Class 0”. Indeed, evidence has been filed by both sides to show this. There is also evidence, although not overwhelming in volume, to show that paint may have an absence of something (such as VOC) which may be highlighted in use to a prospective customer.

23. In terms of the “Class 0” designation and the VOC content (or absence thereof) the evidence itself does not show the degree to which average consumers of paint (the average consumer being a member of the general public) will know of these facts. It could therefore be argued that an average

consumer may not take a direct descriptive message if they have no idea at all what the ZERO could potentially relate to.

24. However, the trade and/or more knowledgeable consumers (such as painting contractors) must also be considered because descriptiveness must be assessed with reference to:

“..the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services..” (“*Matratzan*”).

25. It seems to me that the trade will certainly know of the “Class 0” designation and, although the evidence is not overwhelming, it is also reasonable to assume that they will know of VOCs and other such constituents and that they may be rendered absent in certain paint. Whilst I note that the *Telegraph Magazine* article is from after the relevant date, VOCs are clearly not a new phenomena as other evidence highlights.

26. In terms of the brevity of the message, I note the decision of Amanda Michaels (sitting as the Appointed Person) in BL 0-246-09 *ZERO*. Although this case dealt with a mark that had a degree of stylisation, it is still relevant because the decision (as did the Hearing Officer’s decision that was being reviewed) dealt with the descriptiveness of the word ZERO, albeit in relation to beverages. On this point Ms Michaels stated:

“As to whether the word was descriptive, the Hearing Officer considered *Doublemint* and the contrasting CFI decision in Case T-67/07 Ford. He concluded that the question he had the answer was whether ‘zero [is] simply too imprecise to act as a description of a characteristic of the goods?’ The applicant did not criticise the formulation of the question, but argued that zero cannot be said to describe a characteristic of the goods because describing a beverage as ‘a zero beverage’ tells one nothing about it. The Hearing Officer applied *Doublemint*, citing paragraph 32 of the judgment of the ECJ to the effect that it does not matter that a word is not currently in use to describe goods, nor that there are several alternative meanings of the word in relation to the goods, as long as at least one of them could be used to designate a characteristic of the goods. He thought that there were a number of possible meanings of the word zero in relation non-alcoholic beverages. In my view, that was a conclusion which was open to him; zero could for instance refer to ‘zero alcohol’, ‘zero sugar’ or ‘zero calories.’ The applicant argued that this ambiguity saves the word from being descriptive, because it results in the word having no descriptive meaning, but in my view it was open to the Hearing Officer to make the finding he did. It seems to me that with regard to this ground for appeal, the Applicant is inviting me to substitute my own view for that of the Hearing Officer.”

27. There are two potential messages that could be taken. Even though ZERO is not qualified, those in the trade could view the word ZERO as indicating an absence of VOC (or some other harmful constituent) or they could view the word ZERO as an alternative to "Class 0". Whilst ambiguity (in terms of two possible meanings) does not immunise a mark from refusal, it nevertheless seems to me that the most likely perception would relate to the absence of VOCs. This is because it is unclear from the evidence as to whether the Class 0 designation can describe the paint itself (or a characteristic of it) and that it is, therefore, a Class 0 paint or a paint that achieves class 0 when applied. I say this because the evidence shows (in relation to a particular paint) that two coats equate to Class 1 and three coats equate to Class 0. It is therefore the user who achieves a particular classification on the surface being painted depending on his or her wishes. Whilst Class 0 may be possible to achieve by application, the more direct message, and the one those in the trade will be drawn towards, will relate to the absence of VOC's or other harmful constituents. This is particularly relevant given that such harmful constituents could be more relevant (harmful) during application so those working in the trade will grasp this immediately. The fact that the characteristic being qualified is missing does not prevent the descriptive perception from being taken. The end result is that it is still a term that sends a descriptive message.

28. The above finding is based on the perspective of the trade. Whilst I stated that the position was more arguable from the perspective of the average consumer I should, for the sake of completeness, give my views on the matter. Whilst I concede that the evidence is not sufficient to allow me to find that the average consumer will know of the Class 0 designation or that they will know of VOCs, it nevertheless strikes me that paints and similar coatings have long been associated with harmful constituents and a reduction or elimination of harmful constituents is something that would represent a good selling point for a trader. I am content to take this on judicial notice. In view of this, it therefore seems to me that the word ZERO used in relation to paint or other coatings will be perceived as a descriptive message that there are ZERO contaminants or other harmful content even though the average consumer is not aware of the specific contaminant.

29. In view of the above, the section 3(1)(c) ground of opposition succeeds.

The section 3(1)(b) ground of opposition

30. Section 3(1)(b) of the Act states that the following shall not be registered:

“trade marks which are devoid of any distinctive character”

31. The test to be applied under this ground has been dealt with by the ECJ in a number of its judgments, notably in Joined Cases C-53/01 to C- 55/01 *Linde AG, Winward Industries Inc and Rado Uhren AG* (8 April 2003). The test equates to assessing the impact that the sign will have on the average consumer when used in relation to the goods at issue and then deciding whether they will see it as something that is identifying to them goods originating from a particular undertaking. The test is, essentially, whether the sign will perform the essential distinguishing function of a trade mark.

32. The underlying interest is, again, tied to the capacity of the sign put forward for registration to perform the essential distinguishing function (see, for example, *Henkel KGaA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) C-456/01P and C-457/01P).

33. Although, and as stated earlier, each of the grounds of opposition have independent scope and require separate analysis, it nevertheless follows that a mark that is perceived as a description cannot, therefore, perform the essential distinguishing function. This was confirmed in *Koninklijke KPN Nederland NV v Benelux Merkenbureau* Case C-363/99 where the ECJ stated:

“86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive”

34. In view of the above, and given my findings in relation to the section 3(1)(c) ground of opposition, the section 3(1)(b) ground of opposition also succeeds.

35. However, in the event that I am found to be wrong on my assessment under section 3(1)(c) and that the word ZERO solus cannot be said to fall foul of a descriptive allegation, I intend to consider whether, none the less, the mark is non-distinctive for reasons other than being descriptive.

36. My initial observation on this is that a mark cannot escape refusal under section 3(1)(b) because it points towards a non-specific characteristic of the goods concerned. I note the judgment in *Imperial Chemical Industries plc v OHIM* (case T-224/07) where it was stated:

“21 For a finding that there is no distinctive character, it is sufficient that the semantic content of the word mark in question indicate to the consumer a characteristic of the goods or service which, whilst not specific, represents promotional or advertising information which the relevant public will perceive first and foremost as such, rather than as an indication of the commercial origin of the goods or service (REAL PEOPLE, REAL SOLUTIONS, paragraphs 29 and 30, and Case T-128/07 *Suez v OHIM* (Delivering the essentials of life), not published in ECR, paragraph 20).”

37. ICI argue that:

“..the single word ZERO alone is unusual and striking..”

and that it is

“..clearly able to function as a trade mark..”.

38. I doubt whether my description of the mark would be the same as ICI. I would certainly not describe it as a striking trade mark. It seems to me that the average consumer would, as soon as they encounter the mark, be put on notice that the sign is indicating to them the absence of something. This is not a good start for a sign which is said to be capable of identifying the goods of a particular undertaking. Although the word ZERO is not one that would be regarded as a normal promotional or advertising message (such as a promotional strap line), refusal under section 3(1)(b) is not limited to that type of sign. In my view, all the mark does is to inform the average consumer that the goods have an absence of something. Given that the goods are items such as paint, it will be no stretch for an average consumer to be aware (as I stated earlier) that paint can often contain harmful constituents and that the mark may simply be informing them of such absence. Although the mark may still leave a question mark in the mind of the average consumer (zero what?) this does not equate to a mark being regarded as a distinguishing sign of origin. It is an information sending word and will be taken as such. Therefore, even if the mark falls short of conveying the required level of specificity under section 3(1)(c), I nevertheless hold that it would not perform the essential function of a trade mark. **The section 3(1)(b) objection succeeds.**

The goods of the application

39. Much of my commentary above refers to goods such as paint. However, the above findings extend to all the goods of the application because they are all forms of paint (or very similar goods) or other coatings.

Conclusion

40. As the grounds of opposition under section 3(1)(b) and (c) have been successful, the mark must be refused registration.

Costs

41. ZL having been successful, it is entitled to a contribution towards its costs. I hereby order Imperial Chemicals Industries Limited to pay Zero-Lack GmbH Co. KG costs on the following basis:

Preparing a statement and considering the other side's statement: **£400**

Preparing evidence and considering and commenting on the other side's evidence: **£400**

Expenses (official fee for opposition): **£200**

Total: £1000

42. The above sum should 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 27th day of October 2009

**Oliver Morris
For the Registrar
The Comptroller-General**