

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 2443998 IN THE  
NAME OF MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD**

**AND IN THE MATTER OF THE APPLICANT'S APPEAL TO AN APPOINTED  
PERSON FROM THE DECISION OF MR A J PIKE DATED 20 OCTOBER 2008**

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**DECISION**

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Introduction

1. On 18 January 2007 the Applicant, Matsushita Electric Industrial Co., Ltd, applied to register a series of the two trade marks set out below in respect of “steam ovens and parts and fittings therefor” in Class 11:



2. The application was accepted and published for opposition purposes on 20 April 2007. Although not opposed, a late objection was issued by the Registrar under section 40 of the Trade Marks Act 1994 (“the Act”) on the basis that the marks consist essentially of the words ‘combi steam’ which describe a characteristic of the goods, “e.g. a combination of a normal oven and a steam oven, or a microwave and steam oven”, contrary to sections 3(1)(b) and (c) of the Act.
3. The Applicant’s case for registration was argued by Mr Alge of Marks & Clerk at a hearing before one of the Registrar’s Hearing Officers, Mr A J Pike, on 18 January 2008. Mr Pike upheld the Registrar’s objection under section 3(1)(b) and issued a Notice of Final Refusal. Following a request by the Applicant pursuant to rule 62(2) of the Trade Marks Rules 2000, Mr Pike set out his reasons in a decision dated 20 October 2008 (BL O-287-08 – “the Decision”).

4. On 14 November 2008, the Applicant gave notice of appeal to an Appointed Person under section 76 of the Act. I heard the appeal on 23 February 2009, at which the Applicant was represented by Ms Lindsay Lane of Counsel and the Registrar was represented by Dr Bill Trott.

Section 3(1)(b) of the Act

5. Section 3(1)(b) of the Act contains one of the so-called “absolute grounds” for refusal of registration, based on the inherent characteristics of the trade mark concerned. It falls into the scheme of absolute grounds, 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, geographic 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.

6. These provisions implement article 3(1) and the proviso at article 3(3) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (“the Directive”) and they correspond to articles 7(1) and 7(3) of Council Regulation No. 40/94 on the Community trade mark (“CTMR”).
7. It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs “a residual or sweeping-up function”, backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: *Procter & Gamble Ltd’s Trade Mark Application* [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): Case C-363/99 *Koninklijke KPN Nederland BV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] ETMR 57 (ECJ) at [86]. However, the

converse is not true: a mark which is not descriptive may nevertheless be devoid of distinctive character for other reasons (*ibid.*).

8. When a trade marks examiner assesses the distinctiveness of a trade mark within the meaning of section 3(1)(b), s/he must do so firstly by reference to the goods or services listed in the specification, and secondly by reference to the perception of the mark in relation to such goods or services by the relevant public, which consists of average consumers of the goods or services in question, who are deemed to be reasonably well informed, observant and circumspect: *Joined Cases C-53/01 to C-55/01 Linde AG, Winward Industries Inc and Radio Uhren AG* [2003] ETMR 78 at [41].
9. It is not necessary to show that a mark has a particular level of creativity or originality in order to establish distinctive character: *Case C-329/02P SAT.1 Satelliten Fernsehen GmbH v OHIM* [2005] ETMR 20 (ECJ) at [41]. While the Court of First Instance (“CFI”) has repeatedly referred to “a minimum degree of distinctive character” as being sufficient to avoid article 7(1)(b) of the CTMR/article 3(1)(b) of the Directive (for example, *Case T-34/00 Eurocool Logistik GmbH & Co. KG v OHIM (“EUROCOOL”)* [2003] ETMR 4 at [39]; *Case T-128/01 Daimler Chrysler Corp v OHIM* [2003] ETMR 87 at [33]; *Case T-320/03 Citicorp v OHIM (“LIVE RICHLI”)* at [68]), the ECJ has not adopted this wording and has deemed it unnecessary to give any more precise definition to the possible dividing line between lack of distinctiveness and the minimum distinctiveness to which the CFI refers: *Deutsche Krankenversicherung AG v OHIM (“COMPANYLINE”)* [2002] ECR I-7561 at [20].
10. The ECJ approaches the issue of distinctiveness by reference to the underlying purpose of article 3(1)(b) of the Directive / 7(1)(b) CTMR, which in the Court’s view is to preclude registration of trade marks that are incapable of performing the essential function of guaranteeing the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin: *SAT.1 v OHIM* at [23]; *Case C-37/03 P BioID AG v OHIM* [2005] ECR I-7975 (ECJ) at [27].
11. Having set out the relevant provision and some of the authorities on its interpretation, I now turn to consider the Decision and the Applicant’s appeal.

### The Decision

12. The Hearing Officer directed himself as to the approach he should take, as follows:

11. The approach to be taken when considering the issue of distinctive character under Section 3(1)(b) of the Act has been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 in its Judgement in *Joined Cases C-53/01*

to C-55/01 Linde AD, Windward Industries Inc and Rado Uhren AG (8 April 2003) in the following terms:

- “37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.
39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.
40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).
41. In addition, a trade mark’s distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court’s case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).
47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

12. In order to achieve registration I acknowledge that there is no requirement for a trade mark to possess a specific level of linguistic or artistic creativity or imaginativeness. I must determine whether the trade marks applied for are capable of enabling the relevant consumer of the services in question to identify the origin of the services and thereby to distinguish them from other undertakings. In *OHIM v SAT.1* (Case C-329/02P) the European Court of Justice provided the following guidance at paragraph 41:

“41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings.”

13. I should mention at this point that no reliance was placed by the Applicant on the proviso to section 3(1) and no evidence of use of its marks was submitted, so the Registrar was considering the inherent characteristics of the trade marks as at the application date.
14. The Registrar relied on a number of internet print-outs resulting from searches via the Google search engine for webpages containing the words “combi steam ovens”,

“combination steam oven” and “combination combi steam oven”. Copies of these print-outs were supplied to the Applicant for the hearing at first instance and were given to me at the appeal hearing. They show use of the term “combi steam oven” (sometimes with a hyphen in “combi-steam”) to describe a type of convection oven in which steam can be injected into the oven cavity. In the printouts, this term is used as an alternative to the term “steam combination oven”, and appears in a list of other generic words for products: “refrigerators, freezers, microwave ovens, combi steam ovens, dishwashers, etc..”.

15. The operative part of the Decision was as follows:

13. The objection raised relates to all goods covered in the Class 11 specification:

‘Steam ovens and parts and fittings therefor’

14. The objection under Section 3(1)(b) is maintained against these goods. The descriptive message in the term ‘COMBI STEAM’ in relation to these goods is clear; ‘combi’ is a term used in trade as an abbreviation for ‘combination’ when used in conjunction with ovens, to describe an oven which cooks with a combination of dry heat and steam.

15. The relevant consumer of such products is the general public who wish to purchase an oven that will offer such cooking features.

16. Mr Alge has, in his submissions, mentioned the presentation of the marks in terms of the font, positioning of words and the wavy line devices. Whilst these elements could be considered by some relevant consumers as slightly unusual, I do not consider that these are sufficient to detract the consumer from the immediate descriptive message contained in the term ‘combi steam’. Indeed, the wavy line devices, described by Mr Alge as ‘alluding to a heat wave’, could be seen as reinforcing the descriptive message by imitating, or replicating, convective heat transfer. The positioning of the words, with the word ‘COMBI’ being placed directly over the word ‘STEAM’ does not affect the eye passing over the marks and they will still be immediately perceived as the term ‘combi steam’.

17. At the hearing of this application, Mr Alge proposed to disclaim the words ‘COMBI STEAM’ from the mark, however this was not accepted as a means of overcoming the objection, as the mark as a whole remains and is insufficiently distinctive to be able to act as an indication of sole trade origin.

18. The trade marks applied for consists of a term well used in trade, COMBI STEAM, which other traders are allowed to use freely within their legitimate course of trade to describe, for example, ovens. I consider that the additional elements of stylisation are not sufficient to render the entire marks distinctive and do not detract from the overwhelmingly descriptive message of the marks.

19. Consequently, I have concluded that the marks applied for consist exclusively of signs which may serve in trade to designate the kind [sic. presumably ‘kind’] of goods and are therefore excluded from registration under Section 3(1)(b) of the Act. For the reasons stated, the average consumer when encountering the marks is unlikely to give the presentation within the marks any significance and therefore the marks cannot act as an indication of sole trade origin without prior education to this fact.

16. The Hearing Officer therefore refused the Application under section 3(1)(b) pursuant to the Registrar's obligation under section 37(4) of the Act to refuse trade marks that do not satisfy the requirements for registration.

#### Approach to this Appeal

17. As accepted by the Applicant, an appeal from the decision of a Registry Hearing Officer is not a re-hearing, but a review. As a case in which there was no oral evidence, I should show "a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle": *REEF Trade Mark* [2002] EWCA Civ 763, [2003] RPC 5 at [28]. A decision does not contain an error of principle merely because it could have been better expressed.

#### Grounds of Appeal

18. Ms Lane helpfully summarised the Applicant's grounds of appeal as being that the Hearing Officer erred in the following four ways:

- (1) He set the threshold of distinctiveness too high.
- (2) He failed to consider the effect of the visual elements of the marks.
- (3) He failed to consider the actual goods applied for.
- (4) He wrongly refused to accept the disclaimer.

19. I consider each of the four alleged errors in turn.

#### ***The threshold***

20. In support of the submission that the Hearing Officer set the threshold of distinctiveness too high, the Applicant relied on the decision of the Court of First Instance ("CFI") in *EUROCOOL* (referred to above), in particular, the following extract:

[36] According to Article 7(1)(b) of Regulation No 40/94, 'trade marks which are devoid of any distinctive character' are not to be registered. ....

[37] The signs referred to in Article 7(1)(b) of Regulation No 40/94 are signs which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience if it proves to be positive, or to avoid it if it proves to be negative, on the occasion of a subsequent acquisition.

[38] The distinctiveness of a mark must be assessed, first, in relation to the goods or services for which registration of the sign has been requested (see Case T-345/99 *Harbinger v OHIM (TRUSTEDLINK)* [2000] ECR II-3525, paragraph 32) and,

second, in relation to the perception of the section of the public targeted, which is composed of the consumers of those goods or services.

[39] Finally, it is clear from the wording of Article 7(1)(b) of Regulation No 40/94 that a minimum degree of distinctive character is sufficient to render inapplicable the ground for refusal set out in that article.

21. Ms Lane submitted that, by virtue of the very wording of the provision, to be caught by it a trade mark must be devoid of **any** distinctive character, and *EUROCOOL* is support for the proposition that all that is required is a minimal degree of distinctive character, just sufficient to get over the threshold of not having any distinctive character at all.
22. Dr Trott disagreed with Ms Lane's strong emphasis on the word "any" in section 3(1)(b) and doubted whether *EUROCOOL* could be relied on as authority for the proposition that there is a minimum threshold of distinctiveness, or an absolute line above which a mark must be accepted. In his submission, the word "any" should be given a purposive rather than a literal interpretation in the context of the overall objective of section 3(1)(b), which was to ensure that a trade mark could perform the essential function of guaranteeing the origin of the goods offered to consumers under it without the possibility of confusion with those of other undertakings. If it could not do so, then it would be considered to have no distinctive character.
23. Dr Trott described the role of the Registry in relation to section 3(1)(b) as follows:

The public interest issue is that we are a trade mark registry. We are not in the business of refusing marks. We like to accept marks and where we do not believe they contradict the requirements of the law, we will accept them. It comes down to the issue of the essential function of the trade mark.

(hearing transcript, p.13, lines 18-23).

24. The fact that the Hearing Officer did not specifically refer to *EUROCOOL* or any of the other cases in which the CFI referred to the sufficiency of "a minimum degree of distinctive character", or indeed that he did not use this terminology himself, does not of itself indicate to me that he fell into error. Even when considering cases on appeal from the CFI, the ECJ has not adopted the terminology, or attempted to define an appropriate threshold, but has instead emphasised the importance of the distinctive character requirement in barring the registration of trade marks that cannot fulfil the essential function of indicating origin.
25. It seems to me that the Hearing Officer had a clear understanding of this purpose of section 3(1)(b), and that he directed himself appropriately by reference to the guidance in *Linde et al* and *SAT.1*. There is nothing in the decision up to the point at which he applied this guidance which indicates to me that he misdirected himself or otherwise erred in principle.

### *The effect of the visual elements*

26. The second ground of appeal is related to the first, in that the Applicant argues that, if the Hearing Officer had properly considered the trade marks against the low threshold set by *EUROCOOL*, then it would have been obvious that they cleared the threshold. But Ms Lane did not limit this ground to reliance on *EUROCOOL*. She also submitted that the Hearing Officer had failed to take into account the following guidance of the ECJ in *SAT.1*:

[28] Finally, as regards a trade mark comprising words or a word and a digit, such as that which forms the subject-matter of the dispute, the distinctiveness of each of those terms or elements, taken separately, may be assessed, in part, but must, in any event, depend on an appraisal of the whole which they comprise. Indeed, the mere fact that each of those elements, considered separately, is devoid of distinctive character does not mean that their combination cannot present a distinctive character.

27. Ms Lane submitted that paragraph 16 of the Decision shows that the Hearing Officer failed to analyse the separate elements of the trade marks – in particular, failing to refer to the distinctive orange colour of the wavy line in the second mark of the series, and then failing to consider the combination of all the different elements. She also added that the Hearing Officer was wrong to regard the wavy line as reinforcing the descriptive character of the mark, since the average consumer would not necessarily perceive the wavy line in this way.

28. Taking the latter point first, it is apparent from paragraph 16 of the Decision that it was the Applicant's own representative at the first hearing, Mr Alge, who had described the wavy line device in each mark as "alluding to a heat wave". I do not read paragraph 16 as a firm acceptance of this point, but I understand the Hearing Officer to be saying that, in the event that the alleged allusion was perceived by the consumer, it could be taken as reinforcing the descriptive message inherent in the term 'combi steam'. It does not appear to me that he placed great emphasis on this message. On the contrary, his main point, as I read paragraphs 16 and 18, was that the wavy line was simply an additional element of stylisation which was insufficient to detract from the immediate descriptive message in the term 'combi steam'.

29. While *SAT.1* is undoubtedly authority for the proposition that the trade marks sought to be registered must each be considered as a whole, I do not accept the submission that the ECJ made it compulsory to analyse separately the distinctive character of each of the different elements making up the trade marks. In any event, the Hearing Officer separately itemised the words themselves, their positioning, the font used and the wavy line in each case. The only element that he did not explicitly list was the orange colour of the wavy line in the second mark in the series. However, having reproduced both marks in the series on the first page of his decision, in colour in the case of the second mark, I think it is highly unlikely that he ignored the colour



element in his assessment of the second mark. This objection is more about his manner of expression than the substance of the matter.

30. To test how far the Applicant's case went, I asked Ms Lane whether she conceded that the section 3(1)(b) objection would be a good one against the pure word mark "Combi Steam". She would not make this concession, though she indicated that the internet print-outs relied on by the Registrar might be sufficient evidence in relation to an objection under section 3(1)(c) of the Act (transcript, page 6, lines 1-6). I do not take her to be bound by that concession, but it does indicate at least some acceptance of the inherently descriptive nature of the word element of the trade marks.
31. My next question was what the position would be if the composite marks had comprised the same elements of stylisation, positioning and font, but with the word element being "Oven" instead of "Combi Steam". (Perhaps "Steam Oven" would have been a better example.) Ms Lane said that it would be wrong to suggest that "Combi Steam" was at the same low level of distinctiveness as "Oven" and argued that this fact should have been taken into account, along with the elements of stylisation, to reach a finding that the required level of distinctiveness was reached.
32. Dr Trott's position was that the non-verbal elements of the marks would be seen by the relevant public as no more than minor stylistic embellishments, which were not unusual in the marketplace, and which would have no more than a minimal impact in a retail context. This was the crux of the Hearing Officer's Decision and should be upheld.
33. An analogy to this case may be found in the *BioID* case, which went on appeal from OHIM through both the CFI and the ECJ: Case T-91/01 *BioID AG v OHIM* [2003] ETMR 60 (CFI); Case C-37/03 P *BioID AG v OHIM* [2005] ECR I-7975 (ECJ). This involved an application to register the following mark in respect of a variety of goods and services relating to biometrical identification:

The logo for BioID, featuring the word "BioID" in a bold, black, sans-serif font. The "Bio" is in a standard weight, while "ID" is significantly bolder. A registered trademark symbol (®) is positioned to the upper right of the "D". The logo is enclosed in a thin black rectangular border.

34. The CFI held that the word element "BioID" was non-distinctive since it was recognised as an abbreviation of "biometrical identification"; it then held that none of the Arial font, the bold text for "Bio", the full stop, or the ® symbol was distinctive; and finally it held that the combination of all the elements was not distinctive either, when used in trade in relation to the relevant goods and services, and the mark was therefore precluded from registration under article 7(1)(b) CTMR.

35. Although the CFI decision in *BioID* did not use the “minimum degree of distinctive character” wording, it was issued ten months after the decision in *EUROCOOL* and therefore can be assumed to have been issued in the knowledge of the adoption of that terminology in the past. More importantly, the ECJ upheld the CFI’s conclusion (albeit by substituting its own reasoning because the CFI was held to have placed too much reliance on the fact that the trade mark applied for was likely to be commonly used in trade, which the ECJ held was relevant to article 7(1)(c) rather than 7(1)(b)). The ECJ’s analysis was as follows:

[67] ... in order to ascertain whether the trade mark applied for guarantees the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin, it is appropriate to take the viewpoint of the relevant public.

[68] Thus, bearing in mind the goods and services covered by the trade mark application described in paragraph 5 of this judgment, it appears that the relevant public is one with experience in the sector of the goods and services in question, reasonably well-informed and reasonably observant and circumspect.

[69] The trade mark applied for contains the abbreviation BioID and figurative elements, namely the typographical characteristics of that abbreviation, and two graphic elements placed after the abbreviation BioID, namely a full stop (■) and a sign (®).

[70] As regards the said abbreviation, and as OHIM rightly found in the contested decision, the relevant public will understand BioID, in the light of the goods and services claimed in the trade mark application, as being made up of the abbreviation of an adjective ‘biometrical’ and of a noun (‘identification’), and thus, as a whole, as meaning ‘biometrical identification’. Therefore, that abbreviation, which is indistinguishable from the goods and services covered by the trade mark application, is not of a character which can guarantee the identity of the origin of the marked product or service to the consumer or end-user from the viewpoint of the relevant public.

[71] In addition, in the light of the recurrent nature of the typographical features of the abbreviation BioID and the absence of any particular distinctive element, the characters in ‘Arial’ typeface and characters of different boldness do not enable the trade mark applied for to guarantee, to the relevant public, the identity of the origin of the goods and services covered by the trade mark application.

[72] Furthermore, the two graphic elements placed after the abbreviation BioID, namely a full stop (■) and a sign (®), do nothing to enable the relevant public to distinguish, without any possibility of confusion, the products or services covered by the trade mark application from others which have another origin. It follows that those graphic elements are not capable of fulfilling the essential function of a trade mark, as described in paragraph 25 of the present judgment, in relation to the relevant goods and services.

[73] As pointed out by the Advocate General in point 105 of his Opinion, when the overall impression conveyed by the trade mark applied for to the relevant public is examined, the abbreviation BioID, which is devoid of any distinctive character, is the dominant element of that mark.

[74] Moreover, ..., the figurative and graphic elements are so minimal in nature that they do not endow the trade mark applied for as a whole with any distinctive character. Those elements do not possess any feature, in particular in terms of fancifulness or as regards the way in which they are combined, allowing that mark to fulfil its essential function in relation to the goods and services covered by the trade mark application.

[75] Accordingly, the trade mark applied for is devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94....

36. A similar approach was adopted, and outcome reached, in *Hormel Foods Corp v Antilles Landscape Investments NV* [2005] EWHC 13 (Ch); [2005] ETMR 54 in relation to a stylised and colour version of the mark SPAMBUSTER for “computer programming”. Although the judge (Mr Richard Arnold QC, sitting as a deputy) focused primarily on section 3(1)(c) in his decision, he stated in relation to section 3(1)(b) that the use of fancy fonts and colours was fairly common on websites and that the degree of stylisation of the mark was insufficient to make the average consumer perceive it as origin specific rather than origin neutral without being educated through exposure to use of the mark.
37. Of course, the outcome of both the *BioID* and *SPAMBUSTER* cases turned on the particular impressions deemed by the tribunals concerned to be given by the respective marks to the relevant average consumer. But they do provide general support for the proposition that the addition to descriptive words of common fonts, colours and stylistic elements will not necessarily be sufficient to imbue distinctiveness on the resultant mark. It is a matter of judgment in each case, bearing in mind the goods or services concerned and their average consumers, and the purpose of the exclusion of non-distinctive marks, as described above.
38. Taking all these matters into account, I do not find any material error in the Hearing Officer’s assessment of the lack of distinctive character of each of the trade marks in the series as a whole.

### ***The actual goods***

39. The Applicant’s third ground of appeal was that the Hearing Officer erred by assessing the distinctiveness of the marks by reference to combination ovens rather than by reference to the goods in the specification, which were “steam ovens and parts and fittings therefor”. That he took this approach was evident from paragraph 14 of the decision (reproduced above).
40. Dr Trott submitted that either “steam ovens” is an over-arching category of goods that includes combination steam ovens, or alternatively combination steam ovens and steam ovens are very similar and would be sold side by side such that trying to distinguish between the two categories was hopeless for the purpose of overcoming the descriptiveness of the words “combi steam”.

41. It appears to me that the Hearing Officer treated combination steam ovens as being a subset of steam ovens, when he said (at paragraphs 14-15) that the relevant consumer was the general public who wish to purchase an oven that will offer the facility of cooking with a combination of dry heat and steam. In the absence of any evidence other than the internet printouts, which point towards combi steam ovens as being treated sometimes as a subset of conventional convection ovens, sometimes as a subset of steam ovens, and sometimes as a new category of oven, this was a reasonable approach. Further, it seems unlikely that the Applicant intended to apply the trade marks to pure convection or pure steam ovens, given the descriptiveness of the words “Combi Steam”. So it is reasonable to suppose that the Applicant intended the term “steam ovens” to encompass combi steam ovens. I therefore reject the third ground of appeal.

### *The disclaimer*

42. The Applicant’s fourth and final ground was that the Hearing Officer should have accepted the Applicant’s offer to disclaim entitlement to use of the words “Combi Steam”, leaving only the distinctive elements of the trade marks protected.

43. As can be seen from the way in which this ground was framed, it was dependent on my concluding that the non-verbal elements of the trade marks were themselves distinctive and were sufficient to make the marks as a whole distinctive. Having concluded that there is no reason to overturn the Decision in relation to overall distinctiveness, I do not need to consider the offer of a disclaimer any further. The Hearing Officer was right to reject it.

### Representation of the Registrar on Appeals to the Appointed Person

44. Dr Trott invited me to comment on whether I considered it helpful for the Registrar to be represented on appeals to the Appointed Person by disappointed trade mark applicants, or whether it was preferable for the first instance decision to be allowed to stand on its merits without further comment.

45. I am aware that the practice of the Registry sending a representative to appeal hearings in support of the rejection of trade mark applications has gone on for several years, and I see no reason to discontinue this practice. It can be particularly helpful to hear from a Registry representative if an application is an example of an issue that arises commonly or alternatively is highly unusual. In this case, it was helpful (albeit not determinative) to be able to gauge the extent of the objection to the Applicant’s appeal, based on the Registrar’s experience of assessing trade marks under section 3(1)(b) of the Act. Further, in some cases, matters of practice or queries on the file contents can be explained, which might not always be evident to the applicant or the Appointed Person.

46. As I observed at the hearing, it would be helpful if both the applicant and the Appointed Person could be given reasonable notice that a Registry representative is to appear. Also, in order to ensure fair play to the applicant, I suggest that a skeleton argument should be submitted on behalf of the Registry where oral submissions are to be made at the appeal hearing. This could be very brief if the Registrar merely wishes to emphasise particular points that are explained fully in the first instance decision.

#### Conclusion

47. I conclude that the Hearing Officer made no material error in reaching his Decision and I dismiss the appeal.

48. As is the norm in a case such as this, I make no order as to costs.



ANNA CARBONI

7<sup>th</sup> April 2009

Ms Lindsay Lane (instructed by Marks & Clerk) appeared for the Applicant (Appellant).  
Dr Bill Trott appeared for the Registrar.