

O-045-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2429824
BY PAVEL MASLYUKOV
TO REGISTER THE TRADE MARK:**



IN CLASSES 33 AND 43

AND

**THE OPPOSITION THERETO
UNDER NO 96608
BY
HAYMAN LIMITED**

Trade Marks Act 1994

**In the matter of application no 2429824
by Pavel Maslyukov
to register the trade mark:**



**in classes 33 and 43
and the opposition thereto
under no 96608
by Hayman Limited**

1) On 13 September 2006 Pavel Maslyukov applied to register the above trade mark (the trade mark). The trade mark was published for opposition purposes on 14 December 2007 with the following specification:

gin; prepared alcoholic cocktails containing gin; gin-based liqueurs;

services for providing temporary accommodation; services for providing drinks from a vending machine.

The above goods and services are in classes 33 and 43 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The application contains the following disclaimer:

“No claims to use the words TOM and OLD TOM for designation of beers, wines, ales and all products in the 32 international class of goods.”

2) On 13 March 2008 Hayman Limited (Hayman) filed a notice of opposition to the registration of the trade mark. Hayman claims that OLD TOM is a sign that is used in trade for a particular style of gin. It claims that OLD TOM has become customary in the bona fide and established practices of the trade and that it is a sign that is used to designate the characteristics of the goods covered by the application. Hayman claims that the trade mark should be refused in respect of the class 33 goods of the application as the registration would be contrary to sections 3(1)(a), (b), (c) and (d) of the Trade Marks Act 1994 (the Act). Section 3(1) of the Act states:

“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.”

3) Mr Maslyukov filed a counterstatement in which he denies the grounds of opposition.

4) Both parties filed evidence. I have considered the evidence but for reasons that will become obvious I have not summarised it.

5) The basis of the case, and the evidence of Hayman, is that OLD TOM is descriptive of a type of gin and is a term used in the trade. Sections 3(1)(c) and (d) of the Act require that the trade mark consists “exclusively” of a particular sign. The trade mark includes a large device of a cat on a barrel with various other elements. There is neither claim nor evidence that this is device is non-distinctive. I note that exhibit JH12 to the evidence of Mr James Hayman shows a picture of a bottle which shows this device and, indeed, would appear to be the original for the trade mark. However, nothing in this exhibit indicates that this is generic use of the device and no similar devices are shown in the evidence. The device element is quite clearly not de minimis. **The trade mark does not consist exclusively of a sign that falls foul of sections 3(1)(c) and (d) of the Act and so the grounds of opposition under these sections of the Act must be dismissed.**

6) The grounds of opposition under section 3(1)(b) of the Act are based on the non-distinctiveness of the OLD TOM element of the trade mark. The European Court of Justice (ECJ) stated in *Eurocermex SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-286/04* :

“22 As the Court has consistently held, and as the Court of First Instance indeed recalled in paragraph 25 of the judgment under appeal, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. Thus, in order to assess whether or not a trade mark has any distinctive character, the overall impression given by it must be considered (see, inter alia, Joined Cases C-468/01 P to C-472/01 P *Procter & Gamble v OHIM* [2004] ECR I-5141, paragraph 44, and Case C-136/02 P *Mag Instrument v OHIM* [2004] ECR I-0000, paragraph 20).”

In *Procter & Gamble Company v OHIM* Joined Cases C-468/01 P to C-472/01 P the ECJ stated:

“44 As the Court has consistently held, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see *SABEL*, paragraph 23, and *Lloyd Schuhfabrik Meyer*, paragraph 25). Thus, in order to assess whether or not a trade mark has any distinctive character, the overall impression given by it must be

considered (see *SABEL*, paragraph 23, and, in relation to a word mark, *DKV v OHIM*, paragraph 24).

Consequently, it is necessary to consider the trade mark as a whole, not one single element. In *BioID AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-37/03 P the ECJ commented:

“74 Moreover, as OHIM observed in paragraph 21 of the contested decision, 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.”

The device element of the trade mark cannot be considered to be minimal in nature. It is a strong, distinctive and large element. The device does give the trade mark distinctive character. In *Rewe Zentral AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (LITE)* Case T-79/00 the General Court stated:

“26. 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 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.”

Whether OLD TOM is distinctive or not the device element will allow the consumer to purchase the goods, in relation to which the trade mark is used, again or avoid them. **The trade mark as a whole is not devoid of any distinctive character. The objection under section 3(1)(b) of the Act is dismissed.**

7) In *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* Case C-299/99 the ECJ stated:

“36. It is true that Article 3(1)(a) of the Directive provides that signs which cannot constitute a trade mark are to be refused registration or if registered are liable to be declared invalid.

37. However, it is clear from the wording of Article 3(1)(a) and the structure of the Directive that that provision is intended essentially to exclude from registration signs which are not generally capable of being a trade mark and thus cannot be represented graphically and/or are not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

38. Accordingly, Article 3(1)(a) of the Directive, like the rule laid down by Article 3(1)(b), (c) and (d), precludes the registration of signs or indications which do not meet one of the two conditions imposed by Article 2 of the Directive, that is to say, the condition requiring such signs to be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

39. It follows that there is no class of marks having a distinctive character by their nature or by the use made of them which is not capable of distinguishing goods or services within the meaning of Article 2 of the Directive.

40. In the light of those considerations, the answer to the first question must be that there is no category of marks which is not excluded from registration by Article 3(1)(b), (c) and (d) and Article 3(3) of the Directive which is none the less excluded from registration by Article 3(1)(a) thereof on the ground that such marks are incapable of distinguishing the goods of the proprietor of the mark from those of other undertakings.”

As the opposition has failed under sections 3(1)(b), (c) and (d) of the Act the ground of opposition under section 3(1)(a) of the Act must fall. The trade mark is clearly capable of fulfilling the function of distinguishing the goods of one undertaking from those of another in relation to the goods which are the subject of the opposition. **The grounds of opposition under section 3(1)(a) of the Act are dismissed.**

Costs

8) Mr Maslyukov having been successful is entitled to a contribution towards his costs. Mr Maslyukov has not been legally represented in these proceedings; it is the registrar’s practice to award costs to litigants in person at half the rate that he awards them where a party has had legal representation.

9) I award costs upon the following basis:

Preparing a counterstatement and considering the statement of Hayman:	£200
Preparing evidence and considering the evidence of Hayman:	£200
Total:	£400

I order Hayman Limited to pay Pavel Maslyukov the sum of £400. This sum is 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 09 day of February 2010

**David Landau
For the Registrar
the Comptroller-General**