

O-208-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 2540272

BY JOHN MYLAND LIMITED

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 2:

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Background

1. On 26 February 2010, John Myland Limited ('the applicant') applied to register trade mark application number 2540272, for the mark BESPOKE, for the following goods:

Class 2: Paints, varnishes, lacquers, colorants, natural resins, emulsions and enamels; wood finishing preparations; wood preservatives and wood stains.

2. On 10 March 2010, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In the report, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act'), on the basis that the mark consists exclusively of the word "bespoke", being a sign which may serve in trade to designate the kind of the goods e.g. paints which have been made or arranged according to a users particular requirements.

3. On 16 March 2010, a hearing was requested by Mr Jennings of Chancery Trade Marks acting on behalf of the applicant. At that hearing, held on 27 July 2010, the objection was maintained, and further time was granted for Mr Jennings to explore whether his client had any evidence of use.

4. On 29 September 2010, Mr Jennings requested that the notice of refusal should be issued as the applicant wished to file a form TM5 seeking a statement of reasons for the Registrar's decision. A TM5 was duly received at IPO on 18 October 2010.

5. I am now asked under section 76 of the Trade marks Act 1994 and rule 69 of the Trade Marks Rules 2008, to state in writing the grounds of my decision and the materials used in arriving at it. No formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, I have only the *prima facie* case to consider.

The applicant's case for registration

6. Prior to setting out the law in relation to Section 3(1)(b) of the Act, I must emphasise that the following decision will set out my reasons for maintaining the objection by reviewing and assessing the mark applied for. I have noted the fact that Mr Jennings made reference to earlier 'bespoke' marks which have been accepted

by IPO, and note that much of his claim regarding alleged distinctiveness has been based upon earlier acceptances. Whilst I acknowledge Mr Jennings' submissions, I have maintained the objection by assessing the *mark applied for*, rather than by comparing its relative merits against earlier accepted marks.

7. As regards the earlier marks registered by IPO, I am unaware of the circumstances surrounding their acceptance, and consider them to be of little assistance in determining the outcome of this application. I draw support for this from the judgement of Jacob J in *British Sugar* [1996] RPC 281 at 305 where he stated the following:

"Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual enquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME* Trade Mark and the same must be true under the 1994 Act. I disregard the state of the register evidence."

Decision

8. Section 3(1) of the Act reads as follows:

"3.-(1) The following shall not be registered –

(a)

(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)

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."

The above provisions mirror Article 3(1)(b) and (c) of First Council Directive 89/104 of 21 December 1988. The proviso to Section 3 is based on the equivalent provision of Article 3(3).

Relevant authorities – general considerations

9. The European Court of Justice (ECJ) has repeatedly emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (Case C-37/03P, *Bio ID v OHIM*, paragraph 59 and the case law cited there and, more recently, Case C-273/05P *Celltech R&D Ltd v OHIM*).

The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. Thus, in the case of the registration of colours per se, not spatially delimited, the Court has ruled that the public interest is aimed at the need not to restrict unduly the availability of colours for other traders in goods or services of the same type. Also, in relation to Section 3(1)(b) (and the equivalent provisions referred to above) the Court has held that “...the public interest ... is, manifestly, indissociable from the essential function of a trade mark” (Case C-329/02P, *SAT.1 SatellitenFernsehen GmbH v OHIM*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark 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 (see paragraph 23 of the above mentioned judgment).

The Mark

10. The mark consists of the word 'BESPOKE', defined in Collins English Dictionary as meaning:

adjective (esp. of a suit, jacket, etc.) made to the customer's specifications.

Section 3(1)(c)

11. There are now a number of judgments from the ECJ which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), whose provisions correspond to Section 3(1)(c) of the UK Act. In terms of the issues before me in this case I derive the following main guiding principles from the cases noted below:

- subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – *Wm Wrigley Jr & Company v OHIM – (Doublemint)* paragraph 30;
- 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 – *Ford Motor Co v OHIM, Case T-67/07*;
- a sign’s descriptiveness may only be assessed, first, in relation to the goods or services concerned and, secondly, in relation to the perception of the target public, which is composed of the consumers of those goods or services – *Ford Motor Co v OHIM*;
- It is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word “exclusively” in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question – *Koninklijke KPN Nederland NV and Benelux-Merkenbureau, Case C-363/99 (Postkantoor)*, paragraph 57;
- It is in principle irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary – *Postkantoor*, paragraph 102.

12. Section 3(1)(c) of the Act excludes signs which may serve, in trade, to designate the kind of goods or other characteristics of goods. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the goods in question. It appears reasonable when applying the normal rules of English language and grammar, that the word is descriptive of goods which are made to the customer’s specifications. The goods at issue are ‘paints, varnishes, lacquers, colorants, natural resins, emulsions and enamels; wood finishing preparations; wood preservatives and wood stains.’ In relation to identifying the relevant consumer, it is reasonable to assume that the goods claimed will be used by the general public, who would purchase such goods with a moderate level of attention and knowledge.

13. In my view, the relevant consumer of the goods in question would see the word ‘BESPOKE’, on first impression, as a normal means of designating a characteristic of the goods for which registration is sought i.e. paints, varnishes, lacquers, colorants,

natural resins, emulsions and enamels; wood finishing preparations; wood preservatives and wood stains', that are custom made.

14. At the hearing, I pointed out to Mr Jennings that the term is used in trade in relation to 'paints' and other paint associated goods and provided internet references with the post-hearing report to support my findings. Five references were sent with the hearing report as an example of use in trade by others. In respect of these references, the term is used in trade in relation to paints which are all available to order and which meet the consumer's specific requirements. The first Internet reference demonstrates that Farrow & Ball, one of the UK's oldest paint manufacturers offer a bespoke paint service to consumers. Francesca's Paints Ltd, similarly offers paints from the UK's leading bespoke paint producer. M2 Design Solutions designs customised walls and furniture using different bespoke paint textures. Vernicci are an Industrial Paint Coatings division who utilise computerised paint mixing facilities for bespoke paint coatings colour matching. I consider that these references demonstrate the term is clearly used in trade in relation to 'paints', 'paint finishes' and 'paint textures', and this supports a natural extension of the objection to the other very closely related goods in the specification being 'varnishes, lacquers, colorants, natural resins, emulsions and enamels; wood finishing preparations; wood preservatives and wood stains'.

15. Consequently, I have concluded that the mark applied for consists exclusively of a sign which may serve, in trade, to designate the kind of the goods and which is therefore excluded from registration by Section 3(1)(c) of the Act. Having found that to be the case, it effectively ends the matter. However, in case I am found to be wrong in this decision, I will go on to determine the matter under section 3(1)(b) of the Act.

Section 3(1)(b)

16. In relation to section 3(1) (b), it was held in *Postkantoor* that:

"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."

17. I approach this ground of objection on the basis of the following principles derived from the ECJ cases referred to below:

- an objection under Section 3(1)(b) operates independently of objections under Section 3(1)(c) – (*Linde AG (and others) v Deutsches*

Patent-und Markenamt, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);

- for a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- a mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86);
- a trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);
- the relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

18. Section 3(1) (b) includes within its scope those marks which, whilst not designating a characteristic of the relevant goods will nevertheless fail to serve the essential function of a trade in that they will be incapable of designation origin. I do not consider that an application may escape objection if it is considered too imprecise a term to indicate a direct and specific relationship with the goods or services at issue without further thought, but is, in some sense, more generally non-distinctive.

19. Even if the mark falls short of conveying the requisite level of specificity to support an objection under section 3(1)(c) I would nevertheless hold that it would not be capable of performing the essential function of a trade mark without the relevant public being educated into seeing it that way. In my view consumers would not consider that the mark to be that of any particular manufacturer or supplier of 'Paints, varnishes, lacquers, colorants, natural resins, emulsions and enamels; wood finishing preparations; wood preservatives and wood stains', it could properly be at home on the goods of any of them. On this basis the (b) objection is also made out.

20. I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from *prima facie* acceptance under Section 3(1)(b) of the Act.

Conclusion

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is refused under the terms of section 37(4) of the Act because it fails to qualify under sections 3(1)(b) and 3(1)(c) of the Act.

Dated this 16 day of June 2011

**Bridget Whatmough
For the Registrar
The Comptroller-General**