

O-128-13

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NUMBER 2630004
BY GEO-MINERALS (HOLDINGS) LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 1:**

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Background

1. On 25 August 2009, Geo-Minerals (Holdings) Limited ('the applicant') applied to register trade mark application number 2630004 consisting of the word mark 'POTASH PLUS' for the following goods in class 1:

Chemicals used for agriculture; fertilizers; soil conditioners.

2. On 9 August 2012, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under section 3(1)(b) & (c) of the Act because the examiner, having ascertained that 'potash' is another name for 'potassium carbonate' believed that the sign would designate an essential characteristic of the goods e.g. those which offer something extra or something more than normal potassium carbonate alone. A period of two months was granted for the applicant to respond.
3. On 9 October 2012, Rouse & Co (the previous agent) filed a response to the objection. In that response, the agent argued that the sign's most distinctive element is the word 'plus', and further pointed out that this element has already been registered in the UK as trade mark registration number 630678 in respect of 'chemical products (other than insecticides and fungicides and preparations for killing weeds) for use in agriculture and horticulture, manures'. The agent claimed that the word 'plus' is fanciful when used in respect of class 1 goods, and that its combination with the word 'potash' resulted in a sign which was sufficiently distinctive for registration. The agent went on to highlight that the examiner had not provided any examples of what something '*more than potassium carbonate*' might be, reflecting the fact that the sign is vague, and does not enable potential customers to identify immediately and precisely the specific goods being offered or any of their essential characteristics.
4. The examiner responded on 12 October 2012, maintaining the objection and providing a further two month period for response from the agent. As nothing was heard from Rouse & Co on expiry of that response period, a notice of refusal was issued on 19 December 2012. Five days prior to this refusal, a form TM33 had been filed by Sipara (the current agent) requesting that it be recorded as the new representative for the application. As a consequence, the notice of final refusal was issued to Sipara, rather than Rouse & Co.
5. On 17 January 2013, Sipara submitted a form TM5 requesting a statement of reasons for the decision. 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 the decision and the materials used in arriving at it. The only substantive argument was that put

forward by Rouse & Co in their letter of 9 October 2012, and with no formal evidence having been put before me for the purposes of demonstrating acquired distinctiveness, I only have the *prima facie* case to consider.

6. 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 (subsequently codified as Directive 2008/95/EC of 22 October 2008) (the Directive). The proviso to Section 3 is based on the equivalent provision of Article 3(3).

Relevant authorities - general considerations

7. The Court of Justice of the European Union ('CJEU') 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 (subsequently codified as Council Regulation (EC) No 207/2009 of 26 February 2009) on the Community Trade Mark (the Regulation), in the light of the general interest underlying each of them (*Bio ID v OHIM*, C-37/03P, paragraph 59 and the case law cited there and, more recently, *Celltech R&D Ltd v OHIM*, C-273/05P).

8. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. For example, 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” (*Satelliten Fernsehen GmbH v OHIM* C329/02 (SAT. 1)). 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).

Section 3(1) (c)

9. There are a number of CJEU judgments which deal with the scope of Article 3(1)(c) of the Directive and Article 7(1)(c) of the Regulation, whose provisions correspond to section 3(1)(c) of the UK Act. 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*, C-191/01P (*Doublemint*), paragraph 30);
- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all (*Doublemint*, paragraph 31);
- It is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes (*Doublemint*, paragraph 32);
- 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 v Benelux Merkenbureau*, C-363/99 (*Postkantoor*), paragraph 57);
- An otherwise descriptive combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word trade mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark (*Postkantoor*, paragraph 99).

10. In *Matratzen Concord AG v Hukla Germany SA*, C-421/04, the CJEU stated that:

"...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, who are reasonably well informed and reasonably observant and circumspect, in the territory in respect of which registration is applied..."

I am also mindful of the decision of the General Court (formerly the Court of First Instance) in *Ford Motor Co v OHIM*, T-67/07 where it was stated that:

“...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.”

11. I must also be aware that the test is one of immediacy or first impression, as confirmed by the General Court which, in its decision on *Sykes Enterprises v OHIM (Real People Real Solutions)*, [2002], ECT II-5179, stated:

“...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin.”

12. It is clear from the aforementioned case law that I must determine whether, assuming notional and fair use, the mark in suit will be viewed by the average consumer as a means of directly designating essential characteristics - that is, in this case, the kind and the quality of the goods. The goods at issue are chemicals used for agriculture, fertilizers and soil conditioners. These are goods which could be used by both members of the general public who are interested in gardening, and those who are professionally involved in agriculture, such as farmers, groundskeepers and gardening staff. I consider that the level of attention given to the purchase of such goods would vary according to the user. The general, non-professional consumer, who just wants something to improve the appearance of his or her lawns and to help produce healthy plants, is likely to afford the purchase a lower level of attention than users such as farmers and professional gardeners. This latter group would be more likely to purchase in bulk, would be particularly concerned with getting the best possible deal and, as a result, are more likely to take greater care and attention when purchasing such goods.
13. In determining whether the grounds for objection under section 3(1)(c) apply, the Registrar is obliged to consider the semantic content of the sign. On that basis, I firmly believe that the mark conveys a clear message which would be understood by the relevant consumer as designating a characteristic and quality of the goods. The dictionary definition for ‘potash’ provided in Collins English Dictionary is as follows:

potash 1. another name for potassium carbonate, esp the form obtained by leaching wood ash; 2. another name for potassium hydroxide; 3. potassium chemically combined in certain compounds: *chloride of potash*

It would be well known in the agricultural world and to those interested in gardening that potash is used in gardening and agricultural services. Annex A shows internet pages from www.ukgardening.co.uk, www.growveg.com, www.ehow.com and www.gardeningtipsideas.com, all of which appear to be fairly well-used websites for providing gardening tips and advice, and all of which show that that term 'potash' is used extensively in respect of gardening and agriculture.

14. Turning to the second word 'plus', the same dictionary provides the following definitions:

plus 7. involving positive advantage or good: *a plus factor*; 8. postpositive (informal) having a value above that which is stated or expected: *she had charm plus*; 12. a positive quantity 13. (informal) something positive or to the good 14. a gain, surplus, or advantage

15. I have to take into account what the average consumer would consider when seeing the words 'Potash Plus'. If the sign were seen on potash itself, I consider it highly likely that the consumer would perceive it as indicating high quality potash, that is, potash products which are better than others on the market. The word 'plus', when added to the word which describes the goods in very literal terms, merely serves to highlight the positive aspects of those goods concerned. In totality, the sign has little which would enable the customer to remember and/or recall the product, or to perceive it as being an indication of commercial origin. In this respect I refer to the comments concerning immediacy and first impression made in the case of *Sykes Enterprises v OHIM (Real People Real Solutions, [2002], ECT II-5179*, referred to above, and also to the comments made in *Rewe Zentral AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (LITE) Case T-79/00 [2002] ETMR 91*:

"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."

16. If the sign was displayed more broadly on general agricultural products such as fertilisers and soil conditioners (i.e. products other than potash *per se*), then I consider the average consumer would see the words as indicating that those products contain potash *plus* other chemicals and/or ingredients which help to improve efficacy. Once again, I think it is highly unlikely that the sign would be taken to indicate the trade origin of the goods.
17. Notwithstanding the fact that IPO is *not* bound by decisions made at the OHIM Boards of Appeal, it is interesting to note that the Boards have taken a similar view regarding use of the word 'plus'. In decision R-521/2006-4 'GREEN PLUS', for chemical additives in class 1 and fuels and non chemical additives in class 4, the Fourth Board of Appeal stated at paragraph 36:

"In fact, with a view to the goods claimed, the addition of the term 'plus' only reinforces and further defines the descriptive notion of the term 'green'."

Further, in decision R-1158/2008-1 'FILM PLUS', paragraph 17, the First Board of Appeal found that:

"It is not relevant if 'FILM PLUS' is grammatically correct or not. To put 'PLUS' after the type of the product (in the present case 'FILM') is a very common way to describe a product, which has some extra value of one kind or another. Taking this

into consideration, it is also clear that the designation „FILM PLUS’ should be kept free for others traders to use when describing their products.”

Finally, in decision R-273/2007-2 'PENSION PLUS', paragraph 12, the Second Board of Appeal stated that:

“If they want at the same time to make their offer more attractive they might wish to add on the laudatory adjective ‚plus’. The meaning of the mark is manifestly too concrete and immediate to excite ‚curiosity’. It is not ‚suggestive’ but plainly descriptive. In other words, the mark consists exclusively of terms which designate in a laudatory way the nature of the investment service...”

18. These decisions confirm my belief that the word ‘plus’ appearing with the name of the goods would merely emphasise the positive aspects of the goods and would not indicate trade origin to the consumer of those goods.
19. Rouse & Co originally submitted that the acceptance of earlier UK Registration Number 630678 indicates that the word ‘plus’ is distinctive. In response to this point, I should point out that this particular earlier mark was registered in 1944, and it is a known fact that the use and application of language will change over time - particularly when that time spans decades. Back in 1944, the word ‘plus’ is unlikely to have had the exact same meaning, interpretation, and use in common parlance that it enjoys today. Notwithstanding the fact that the Registrar is *not* bound by precedent anyway, I am not persuaded that the *prima facie* acceptance and registration back in 1944, of one element found in the current mark, and for goods similar or identical to those now seeking protection, has any impact or relevance upon the application in suit.
20. Taking into account all of the above, I have concluded that the mark applied for consists exclusively of a sign which may serve, in trade, to designate the kind or type of goods, and is therefore excluded from registration by section 3(1)(c) of the Act.
21. Having found that to be the case, it effectively ends the matter. However, in case I am found to be wrong in this regard, I will go on to determine the matter under section 3(1)(b) of the Act. I should at this point stress that since objection has been made under section 3(1)(c), this automatically engages section 3(1)(b). However, it can be useful to also consider section 3(1)(b) in its own right - the scope of the two provisions is not identical, and marks which are not descriptive under section 3(1)(c) can nonetheless be devoid of any distinctive character.

Section 3(1)(b)

22. 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);

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- 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*).

23. Furthermore in relation to section 3(1)(b) it was held in *Postkantoor* that:

"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" (paragraph 86)

24. I do not consider that an application should necessarily 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. I have indicated in paragraph 15 how I feel the average consumer will perceive the mark. I do not believe that the sign would 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 the mark to be that of any particular manufacturer or supplier of chemicals used in agriculture, fertilisers or soil conditioners, it could properly be at home on any of them.

25. Anna Carboni, sitting as the Appointed Person in *COMBI STEAM*, O-363-09, conveniently summarised the leading case law in respect of this part of the Act:

"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): Koninklijke KPN Nederland BV v Benelux-Merkenbureau Case C-363/99 (POSTKANTOOR) [2004] ETMR 57 (ECJ) at [86]”.

26. For reasons already given, the Registrar considers the sign to be descriptive of specific characteristics of the goods. It is clear from the above guidance that if a mark is entirely descriptive of characteristics of goods or services, it will also be devoid of any distinctive character under section 3(1)(b). As I have found that the mark in question is open to objection under Section 3(1)(c) of the Act, it follows that it is also open to objection under Section 3(1)(b) of the Act.
27. I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is an indication of trade origin. I must therefore therefore also 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

28. 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 19th day of March 2013

**Linda Smith
For the Registrar
The Comptroller-General**

ANNEX A

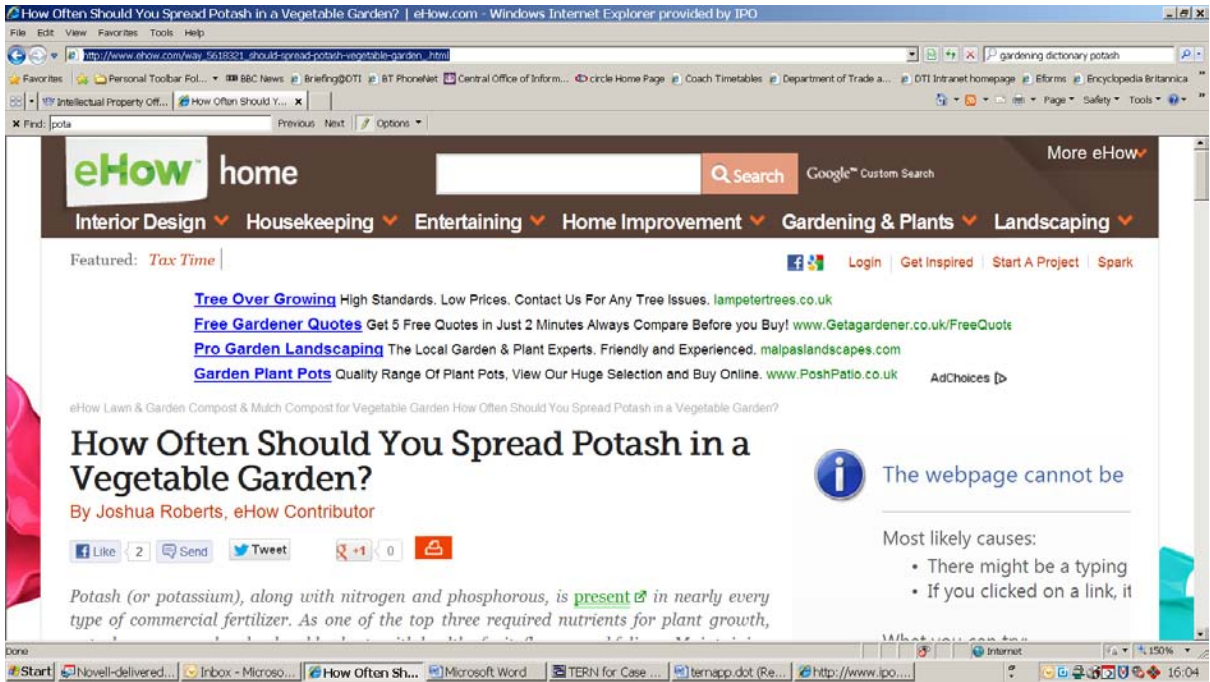
http://www.ukgardening.co.uk/basics_fertile.asp

The screenshot shows a Windows Internet Explorer browser window displaying the UK Gardening website. The page title is "UK Gardening - Basics of Gardening - fertilisers". The URL in the address bar is http://www.ukgardening.co.uk/basics_fertile.asp. The page features a navigation menu with options like Home, Basics, Design, Tips, Projects, Pruning, Pests & diseases, Gallery, and Support us. A sidebar on the left lists "Other gardening basics pages" including Introduction, Planting seasons, Plant characteristics, Plant naming, Common plant names, Botanic plant names, Weeds and weeding, Plant watering, Seed propagation, Vegetable growing, Garden fertilisers, and Feeding lawns. The main content area is titled "Garden fertilisers" and explains that plants need three main nutrients: Nitrogen (N), Phosphorus (P), and Potassium (K). It provides details for each: Nitrogen is used for green up and shoots; Phosphorus provides a great start for newly planted shrubs and vegetables; Potassium is required for flowering and fruit development. A sub-section for Potash (K₂O - Potassium oxide) notes it is regularly used in gardening. A Google search box is visible on the right side of the page.

<http://www.growveg.com/growblogpost.aspx?id=217>

The screenshot shows a Windows Internet Explorer browser window displaying the Growveg website. The page title is "Using Wood Ash in the Vegetable Garden". The URL in the address bar is <http://www.growveg.com/growblogpost.aspx?id=217>. The page features a navigation menu with options like Home, Basics, Design, Tips, Projects, Pruning, Pests & diseases, Gallery, and Support us. A sidebar on the right lists "Categories" including Allotments - Apples - Artichokes - Basil - Berries - Brussels Sprouts - Cats - Children - Cold Frame - Comfrey - Companion Planting - Compost - Cover Crops - Crop Rotation - Disease - Fall/Winter Planting - Fertiliser - Food Miles - Fruit - Fungi - Garlic - Gifts. The main content area is titled "Using Wood Ash in the Vegetable Garden" and discusses the benefits of wood ash as a garden fertilizer. It explains that wood ash contains potassium or potash, which is a vital nutrient for crops. It also notes that potassium regulates plants' water balance and has a part in transporting food within the plant. A photograph of a pile of wood ash is shown. The page also includes a "Back to the growblog index" link and a "Categories" sidebar.

http://www.ehow.com/way_5618321_should-spread-potash-vegetable-garden_.html



http://www.gardeningtipsideas.com/2007/03/what_is_potash.html

