

O-105-14

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO 2 640 249
IN THE NAME OF QA SALES LLP
TO REGISTER IN CLASS 19 THE TRADE MARK: FINEFLOOR**

AND

**OPPOSITION THERETO UNDER NO 104 542
BY FINANCIERA MADERERA S.A.**

Background and pleadings

1. On 29 October 2012, QA Sales Llp (the applicant) applied to register FINEFLOOR under No 2640249. The application was accepted and published for opposition purposes on 30 November 2012 for the following goods in Class 19:

Flooring underlay, tiles; flooring accessories; parts and fittings for the aforesaid.

2. On 27 February 2013, Financiera Maderera S.A (the opponent) filed a notice of opposition directed against all of the goods applied for. Amongst other grounds, the opposition is based upon Section 3(1)(b)&(c) of the Trade Marks Act 1994 (the Act). The opponent argues that the Trade Mark applied for describes the characteristics of the goods in question as being “good quality” or, alternatively, “thin”.
3. QA Sales (the applicant) filed a counterstatement denying all of the grounds of opposition.
4. The opponent filed evidence. Both parties filed written submissions which are detailed further below. Neither party requested a hearing and so this decision is taken following a careful perusal of the papers.

DECISION

5. The opposition is based upon sections 3(1)(b) and (c) of the Act which state:

“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.”

6. It is well established that the absolute grounds for refusing registration must be examined separately, although there is a degree of overlap between sections 3(1)(b), (c) and (d) of the Act: see Koninklijke KPN Nederland NV v Benelux-Merkenbureau [2004] E.T.M.R. 57, the Court of Justice of the European Union (“CJEU”), paragraphs 67 to 70. In *Starbucks (HK) Limited, PCCW Media Limited, UK Broadband Limited v British Sky Broadcasting*

Group plc, British Sky Broadcasting Limited, Sky IP International Limited [2012] EWHC 3074, Arnold J referred to summaries of the law in two decisions from the CJEU in relation to Articles 7(1)(b) and (c) of the Community Trade Mark Regulation, which correspond to sections 3(1)(b) and (c) of the Act:

7. The principles to be applied under Article 7(1)(b) of the CTM Regulation were conveniently summarised by the Court of Justice of the European Union in Case C-265/09 P *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* [2010] ECR I-8265 as follows:

“29. ... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v. OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes 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 those of other undertakings (*Henkel v. OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v. OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v. OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v. OHIM*, paragraph 25; *Henkel v. OHIM*, paragraph 35; and *Eurohypo v. OHIM*, paragraph 67).

45. As is clear from the case-law of the Court, the examination of trade mark applications must not be minimal, but must be stringent and full, in order to prevent trade marks from being improperly registered and, for reasons of legal certainty and good administration, to ensure that trade marks whose use could be successfully challenged before the courts are not registered (see, to that effect, *Libertel*, paragraph 59, and *OHIM v. Erpo Möbelwerk*, paragraph 45).”

8. The principles to be applied under Article 7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in Case C-51/10P *Agencja Wydawnicza Technopol sp. z o.o. v OHIM* [2011] ECR I-0000, [2011] ETMR 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the

purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), see, by analogy, Case C-265/00 *Campina Melkunie* [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 30, and the order in Case C-150/02 P *Streamserve v OHIM* [2004] ECR I-1461, paragraph 24).

...

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, *inter alia*, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 45, and Case C-48/09 P *Lego Juris v OHIM* [2010] ECR I-0000, paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in Case C-80/09 P *Mergel and Others v OHIM*, paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 58). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

...

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that

regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No 40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

9. In addition, a sign is caught by the exclusion from registration in Article 7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see Case C-191/01 P *OHIM v Wm Wrigley*

Jr Co [2003] ECR I-12447 at [32] and Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619 at [97].

10. Neither side filed evidence in respect of Section 3. Both however filed submissions, which are outlined below.

11. In its notice of opposition and in its submissions, the opponent states in respect of Section 3(1)(c):

“The Trade Mark is not acceptable for registration in Class 19 for “flooring underlay, tiles, flooring accessories, parts and fittings for the aforesaid” as the Mark consists entirely of two ordinary English words “fine” and “floor” which when combined present a sign which would not be seen as a trade mark as it is wholly descriptive of the goods applied for such as their quantity and size. The combination of the words FINE and FLOOR allows the consumer to know that the flooring products are either of good quality or are thin in thickness. The combination of the two ordinary words FINE and FLOOR provides a meaningful expression which directly provides information about characteristics of the goods.”

12. In respect of Section 3(1)(b), the opponent utilises the same reasoning to assert that FINEFLOOR is also devoid of distinctive character.

13. The applicant, in its written submissions stated:

“The word FINE can indeed mean good, small, thin and not coarse but when combined with the word FLOOR is totally meaningless in the context of the goods for which registration is sought.....which are not floors as such. The mark indirectly alludes to a characteristic of the floors that might be produced using the goods and therefore provides a very distinctive impression to the public and does not provide any direct reference to characteristics of the goods themselves”.

14. The opposition based upon Section 3(1)(c) of the Act will be considered first. In line with the decision of the Appointed Person in FOREX¹, it is accepted that the Tribunal is able to consult a dictionary during its decision making process. It is noted that the meaning of the word FINE is agreed by the parties'. The meaning agreed corresponds with the Tribunal's own understanding of the word and the entries that appear in Collins English Dictionary namely “excellent or choice in quality; very good of its kind” and also “very thin or slender”. There are also other notable entries, such as “of delicate composition or careful workmanship” and “ornate, showy or smart”. FLOOR means “the inner lower surface in a room” or “A flat bottom surface in or on any structure”.

¹ BL O/100/09

15. The applicant's view is that FINEFLOOR is not directly descriptive as the goods are not floors as such. However, it is noted that the specification applied for includes *tiles* which are defined as "a flat thin slab of fired clay, rubber, linoleum, etc, usually square or rectangular and sometimes ornamental, used with others to cover a roof, floor, wall, etc." (Collins English Dictionary). Tiles are therefore, a type of floor.
16. It is considered that the relevant public for tiles will be both the trade and the public at large. A characteristic directed to the quality of such products will be desirable in the minds of such consumers. It is considered that FINEFLOOR as attached to tiles can only lead to one conclusion. That is that there is a direct and specific relationship between this and the goods leading the consumer to immediately perceive that the tiles on sale comprise good quality flooring or that they are thin in appearance (i.e. thinner than other floor tiles). The conjoining of FINE and FLOOR do not help the applicant as the descriptive meaning conveyed by the combination is considered to be clear. The opposition under Section 3(1)(c) of the Act therefore succeeds in respect of *tiles*.
17. This leaves the remaining items to consider, namely *flooring underlay; flooring accessories; parts and fittings for the aforesaid*.
18. These are all products which will be used in the process of laying or fitting a floor and ensure the correct insulation and finish. When viewed in a commercial context, it is considered that a consumer is likely to view these goods collectively, as floor or flooring products. The following guidance provided in BL O/240/02, is borne in mind where Mr Geoffrey Hobbs QC said:
- "Having listened with care to the arguments that have been addressed to me on this appeal, I have come to the conclusion that cooker hoods and extractors are closely connected items of commerce, and that they are both so closely connected with cookers that it would be unrealistic to treat the words FOURNEAUX DE FRANCE as descriptive of the character of the latter but not the former. The expression "cookers from France" is descriptive at a high level of generality. That makes it suitable, in my view, for descriptive use in the marketing of units of equipment of the kind found in modern cooker installations including not only grilling and roasting units, but also hood and extractor units".

19. It is considered that this decision is analogous to the situation in the proceedings here. The remaining goods are so closely connected to floors and flooring that it would be unrealistic for FINEFLOOR to be descriptive of tiles as a type of flooring and then not for the remaining goods. The opposition as it is based upon Section 3(1)(c) of the Act also therefore succeeds here.
20. As it is successful in this respect, it is also successful as regards Section 3(1)(b) as a sign that is descriptive is also, by definition, devoid of distinctive character.

Final Remarks

21. It is noted that a negative finding under Section 3(1)(b) and (c) can be avoided provided an applicant can demonstrate that, before the date of application for registration, that it has acquired a distinctive character as a result of the use made of it. There is no such evidence here and so this consideration is set aside.
22. This means that the opposition succeeds in its entirety under Section 3. As such, there is no need to consider the remaining grounds relied upon.

COSTS

23. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £750 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Statutory fee for filing opposition - £200

Filing notice of opposition and considering counterstatement- £300

Filing evidence and submissions - £250

Total - £750

24. I therefore order QA Sales to pay Financiera Maderera S.A. the sum of £750.
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 6th day of March 2014

Louise White

**For the Registrar,
The Comptroller-General**