

O-471-17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3163637
IN THE NAME OF MANVERS ENGINEERING LIMITED

AND

OPPOSITION UNDER NO 407285 THERETO
BY FENTEX LIMITED

Background

1. Application No 3163637 has a filing date of 10 May 2016, stands in the name of Manvers Engineering Limited (“the applicant”) and seeks registration of **SPILL TRAPPER** in respect of the following goods:

Class 17

Membranes and semi-processed synthetic filtering materials

Class 20

Oil drip trays and containers made from plastics materials

Class 24

Filtering materials of textile

Class 27

Mats and cartridges formed from plastics materials for the collection and retention of oil spilled from or leaked from machinery; oil drip mats made from plastics materials.

2. Following publication in the *Trade Marks Journal* on 15 July 2016, a notice of opposition was filed by Fentex Limited (“the opponent”). The opposition was originally brought on grounds under sections 3(1)(b), (c), (d) and 3(6) of the Trade Marks Act 1994 (“the Act”) though the objection under section 3(6) was subsequently withdrawn. In respect of its objection under section 3(1)(b) of the Act the opponent claims the mark:

“SPILL TRAPPER is merely a term describing the function or purpose of the specified goods, or the function or purpose of the goods of which the specified goods form a part. The mark SPILL TRAPPER is hence inherently devoid of any distinctive character, and has not acquired significant distinctiveness as a result of the use made of it by the applicant.”

3. In respect of its objection under section 3(1)(c) of the Act the opponent claims the mark:

“...consists exclusively of the composite term SPILL TRAPPER, or of the individual terms SPILL and TRAPPER, which are readily and immediately recognisable within the composite terms by the relevant consumer. A “spill” is a discharge, overflow or escape, usually of liquid. A “trapper” is someone or thing that “traps” –i.e. that captures, re-captures, retains, restrains or collects something else –such as liquid. The composite term “spill trapper” has the immediately apparent meaning of something that collects or captures a discharge or overflow of liquid. The mark contains no unusual syntactic juxtapositions or other distinctive features. The mark SPILL TRAPPER thus consists exclusively of signs or indications that may serve in trade to designate the kind, quality, intended purpose, and other characteristics of the goods.”

4. Finally, in respect of its objection under section 3(1)(d) of the Act, the opponent claims:

“...the term “spill trapper” is in general use to describe various products used for containing or absorbing spills, such as products sold by the applicant and the opponent, which comprise trays that collect oil or the like dripping from machinery, whilst releasing water (such as rain) through their walls or floors. The term “spill trapper” is also one of the alternative names used for porous tubes of absorbent material that can be deployed around spills in shops, warehouses or laboratories to prevent them spreading and to absorb harmful components-these are also known as “absorbent snakes”, “absorbent booms” or “absorbent socks”, for example. Thus, the mark SPILL TRAPPER consists exclusively of signs or indications customary in the current language or in the bona fide and established practices of the trade for products corresponding or related to those of the application.

5. Thus the opponent claims the mark is not distinctive but consists exclusively of signs or indications which may serve to designate the kind, quality, intended purpose and other characteristics of the goods. Further, it claims the term is in customary use in the trade in relation to the goods for which registration is applied.

6. The applicant filed a counterstatement denying the grounds of opposition in their entirety. It claims, in essence, that as the mark has been through an examination process and was accepted for publication, it is not appropriate that it be refused on the grounds claimed. Whilst it is true that the application has been through an examination process, that examination is an administrative function made on an ex parte basis. Opposition actions are inter partes proceedings and decisions arising from such proceedings are quasi-judicial and made in light of the evidence filed. It is appropriate that the claims are considered afresh.

7. Both parties filed evidence. Both also filed written submissions and as neither party sought to be heard, I give this decision after careful consideration of all the material before me which I will not summarise but will refer to as necessary in this decision.

Decision

8. The opposition is brought under section 3(1) of the Act which states:

“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) 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.”

9. I note at this point that the applicant has not shown, nor did it claim, that it should benefit from the proviso that the mark has acquired distinctiveness through its use.

10. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 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, [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. 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, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) 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 *Mergel and Others v OHIM* (C-80/09 P), 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 38). 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).

And

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)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

11. I am also mindful of the comments of Mr Iain Purvis Q.C., sitting as the Appointed Person, in *PutterScope* BL O/96/11 where he said:

"8...Although I agree that it necessary for the purpose of explanation to break down the mark into its component parts, one must be aware of the danger that such an iterative approach may be unfair to the applicant. Each individual part of a mark may be non-distinctive, but the sum of the parts may have distinctive character – see *Satelliten Fernsehen GmbH v OHIM* [2005] ETMR 20 [SAT 1], at paragraph 28. Ultimately the decision making tribunal must stand back from the detailed breakdown of the mark and envisage how the entire trade mark would be understood by the public when applied to the goods of the specification. Would the average consumer consider that it was a trade mark indicating goods from a particular source or would they consider that it simply indicated the function of the goods?"

12. The opponent has filed evidence in the form of a witness statement of Mr Jonathon Banford, a Chartered Trade Mark Attorney in the employ of its legal representatives in these proceedings. Mr Banford refers to claims made by the applicant in its counterstatement as to the meaning of the words SPILL and TRAPPER and its denial that “the word ‘trapper’ can also refer to ‘something’ as well as ‘someone’ as the Opponent asserts”. At JB01, Mr Banford exhibits extracts taken from the Concise Oxford English Dictionary (“OED”), 11th edition, showing entries for the words “spill”, “trap” and “trapper”. Also included within this exhibit is an extract from the website Dictionary.com referring to “trapper”.

13. The extract from the OED includes the following definitions:

SPILL

“n. 1 a quantity of liquid that has spilled or been spilt. ■ an instance of a liquid spilling or being spilt

TRAP

“n. 3 a container or device used to collect specified things

v. 2 prevent from escaping. ■ catch (something) somewhere so that it cannot be freed.

The extract from Dictionary.com includes the following definition:

“trapper

noun

1. A person or thing that traps...”

14. Mr Colin Ibbotson is a Director of the applicant company. In his evidence he states that he:

“strenuously [denies] that the SPILL TRAPPER mark describes the product...”.

Mr Ibbotson also states that his company:

“...has developed a unique product to prevent the escape of oil in case of a leak. That product is called SPILL TRAPPER”.

15. The applicant submits that:

“i) the Mark as a whole has sufficient distinctive character, notwithstanding the presence in the Mark of indications that may be objectionable, as argued by the Opponent and ii) the Mark has a material or tangible part to it which does not designate a characteristic of the goods, i.e. it does not consist *exclusively* of an objectionable indication.”

16. The mark consists of the two ordinary words SPILL TRAPPER presented in plain block capitals. Whilst the extract from the Concise OED does not refer to the word TRAPPER as pertaining to an object, the extract from Dictionary.com does and this accords with my own view that the word is one which describes someone or something that traps. In this case, the word TRAPPER comes after the word SPILL, a combination that is not grammatically unusual and defines what is intended to be trapped. I find that when applied to the goods covered by the application, the relevant public would not consider the mark would indicate the goods as coming from a particular source but would consider that the mark SPILL TRAPPER simply indicates a function of the goods. I find the mark SPILL TRAPPER consists exclusively of words which clearly serve, in trade, to designate the intended purpose of such goods as are intended to trap spills.

17. Whilst the specification of the application could be said to cover goods which are not spill trappers the applicant has not taken up the opportunity to limit its specification by way of a fall-back position and it is clear from Mr Ibbotson’s evidence that these goods are the applicant’s area of interest. The objection under section 3(1)(c) of the Act succeeds in full.

18. Given that the mark has fallen foul of section 3(1)(c), it follows that it will also fall foul of section 3(1)(b) of the Act and the opposition under this ground also succeeds.

19. In view of my very clear findings in relation to the above objections, I do not intend to consider the objection under section 3(1)(d) in any detail. Had I done so, the claim would have failed as the only evidence filed by the opponent which goes to the matter, is that contained in Exhibit PRB02 to Mr Bassitt's witness statement. This consists of some 8 undated pages from 5 websites. Four of these pages are taken from two American websites with the price of goods shown in US\$ which do not reflect the market in this country. In addition, neither refer to the mark in issue in these proceedings. Of the remaining pages, only one refers to "Spill Trapper". In reaching this conclusion I have not overlooked the evidence of Mr Samuel Liam Pedwell who is a part-qualified Patent and Trade Mark Attorney and employed as a technical assistant at the opponent's legal representative. He states that between May 2009 and September 2013 he had employment with two major supermarkets and that in the course of his duties he recalls "being requested or instructed by colleagues on several occasions to urgently locate a 'spill trapper'". I do not consider any of this evidence goes to show the mark had become customary in the current language or in the bona fide and established practices of the trade.

Summary

20. The opposition succeeds in full under sections 3(1)(b) and (c) of the Act.

Costs

21. The opponent, having succeeded, is entitled to an award of costs in its favour. I make the award on the following basis:

For filing a notice of opposition and considering the counterstatement:	£300
Evidence:	£500
Written submissions:	£200
Fees:	£200
Total	£1200

22. I order Manvers Engineering Limited to pay Fentex Limited the sum of £1200. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of October 2017

Ann Corbett

For the Registrar

The Comptroller-General