

THE HIGH COURT

BETWEEN:

MILLER BREWING COMPANY

PLAINTIFFS

AND

THE CONTROLLER OF PATENTS DESIGNS AND
TRADE MARKS

DEFENDANT

Judgment of Mr. Justice Costello delivered on the 28th day of
October, 1987. *Mary P. O'Donoghue*
Rep.

Appeal against refusal of Controller to register (a) the words "Miller Lite" in Part B of the Trade Mark register in respect of light beers and (b) the word "Lite" over a device in Part B of the register in respect of light beers. Appeals dismissed.

By this summons the plaintiffs appeal against the refusal of the Controller to register two marks; one (in application No.3033/79) being in respect of the words "MILLER LITE" and the other (in application No.3032/79) a mark consisting of a device and with certain words over which the word "LITE" is written. Both applications were originally for registration in Part A of the Register for a specification of goods referred to as "Beers". But the plaintiffs were prepared to have the marks registered in Part B and so applied to the Controller. This was refused. On this appeal their case has been limited to a claim to a Part B registration.

In respect of "MILLER LITE" the main objection to a Part A registration was taken under section 17 (an objection under section 19 having been overcome). The hearing officer held that "Miller" is a surname appearing over one hundred times each in telephone directories in Ireland, London, New York and elsewhere; that the word "lite" is phonetically equivalent to "light" and he held that in the absence of use or any other circumstances a combination of a common surname and a directly descriptive word cannot satisfy the requirements of section 17. I agree with that conclusion and no attempt to challenge it has been made on this appeal.

As an alternative to refusal the hearing officer considered (under section 25(3)) whether the mark was registrable in Part B. He decided that it was not, concluding that the combination of "Miller" and "Lite" did not constitute a mark "capable of distinguishing" light beer with which the applicant may be connected in the course of trade from goods where no such

connection subsists. The plaintiffs were prepared to disclaim (under section 22 of the Act) the exclusive use of the word "Lite" and argued on this appeal that although the word "MILLER" had a surnominal significance it also had another significance, namely that of a person who mills. It is urged that there is no specific bar to the registration in Part B of marks which have two significations one of which is surnominal, and that it cannot be said that a mark such as "Miller" with two significations is inherently incapable of distinguishing the plaintiffs' goods.

I cannot agree, I think the plaintiffs' approach to how the significance of the mark is to be judged is not the correct one as I do not think I should avoid considering the effect of the word "Lite" in the propounded mark "Miller Lite" merely because the plaintiffs have agreed under section 22 to disclaim the exclusive use of this part of the mark.

The effect of a disclaimer in Part A applications was considered by Lloyd Jacob, J. in In the matter of Ford-Werke A.G.'s application (72 RPC p.191 at p.195) when considering an application to register the letters "F" and "W" in a scroll. He said:

"Nor would the position be any different were the Applicants' offer to enter a disclaimer to the exclusive right to the use of these letters to be accepted. Such a disclaimer, while affecting the scope of the monopoly conferred by the registration, could not affect the significance which the mark conveyed to others when used in the course of trade. If it be right to conclude that it is the letters "F" and "K" which constitute the feature of the mark which would strike the eye and fix the recollection, this cannot be affected by what is or is not entered upon the register housed in the Patent Office. Attention must, therefore, be focused upon the content of the mark, and not upon the content of the protection sought for the mark".

I therefore think that for the purpose of considering the application for a Part B registration I must look to the mark as a whole and ignore the fact that if registered the plaintiffs' monopoly to part of it will be restricted. Considering the mark as a whole it seems to me that "Miller Lite" when used in this country on and in connection with beers will be taken to signify the light beer of a firm with the name of Miller. In the absence of evidence of use establishing factual distinctiveness I cannot hold that these words have the inherent capacity to distinguish which the section requires and I think the Controller was right in refusing to register the mark. So, I will dismiss this part of the appeal.

The second part of the appeal relates to a mark with two main features. The first is the word "LITE" which is placed over the second which comprises a device consisting of sheaves and ears of barley and of hops and hop leaves around and in a device of an oval border on which the words "A fine Pilsner Beer" is written.

The applicants amended their application to one for registration in Part B and indicated that they were prepared to disclaim the exclusive right to the word "Lite" and the words "A fine pilsner beer" and to disclaim also the exclusive use of the devices of sheaves of barley, ears of barley and of hops and hop leaves. This meant that they had disclaimed all the features of the mark, save the oval border.

Registration in Part B was refused, the hearing officer concluding that the mark contained no distinctive element and that the combination of non-distinctive elements did not constitute a mark which is capable of distinguishing light beer

with which the applicant may be connected in the course of trade from goods where no such connection subsists. I think he was correct.

By their disclaimer the plaintiffs have accepted that (a) the word "Lite" is not distinctive and (b) that the other words on the mark and the device of the barley and hops are matters common to the trade and are also non-distinctive. What remains, the oval border, is clearly also non-distinctive. I do not think that by combining these non-distinctive features the plaintiffs have produced a mark that is inherently capable of distinguishing their goods from the goods of other traders. Again, looking at the mark as a whole its most prominent feature is the word "Lite", the other features having no inherent qualities, even when combined, to attract the eye and the memory of ordinary customers and serve to distinguish the plaintiffs' goods from those of other traders. The word "Lite" by itself has not the inherent capacity to distinguish which the section requires and does not acquire it by being associated with the other non-descript features of the mark. I must therefore dismiss this part of the appeal also.

Approved

JL

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