

**IN THE MATTER OF ELEVEN APPLICATIONS
BY THE BLACK AND DECKER CORPORATION TO
REGISTER TRADE MARKS IN CLASS 7
CONSISTING OF, OR INCLUDING AS A FEATURE
OF THE MARK, THE COLOURS YELLOW AND
BLACK APPLIED TO THE GOODS**

The Applications

1. On the 15 January 1997 the Black and Decker Corporation of Maryland in the United States of America applied for the registration of the trade mark shown below.



2. The mark is described on the form of application in the following terms:-

“The mark consists of the colours yellow and black (as shown above) being the predominant colours applied to the visible surface of the goods. The rectangular representation of the colours does not form part of the mark”.

3. The application was made in Class 7 and was given the number 2120680. The specification of goods was originally:-

Manually operated portable electric power tools (excluding gardening tools); drills,

percussion drills, cutting tools, saws, jig-saws, circular saws, mitre saws, chop saws, routers, trimmers, planers, screwdrivers, drill/drivers, nailers, hammers, rotary hammers, pneumatic hammers, angle grinders, sanders; parts and fittings for all the aforesaid goods;

but was restricted during the examination of the application to:-

Manually operated portable electric cordless power tools with a battery voltage greater than 13V; battery powered drills, screwdrivers and combination drills/screwdrivers all with a battery voltage above 13V; battery powered percussion drills with a battery voltage above 20V; battery powered circular saws, reciprocating saws and jigsaws with a battery voltage greater than 12V; battery powered right angled drills, drywall screwdrivers and impact screwdrivers; mains powered impact screwdrivers, screwdrivers for self-drilling screws, drywall screwdrivers, right angle drills, percussion drills with motor powers greater than 1000W, diamond drills, pneumatic hammer drills for use with bits having diameters greater than 20mm, demolition hammers, large angle grinders suitable for 7 inch diameter and above grinding discs, diamond disc cutters, orbital sanders including random orbit sanders all with motor powers greater than 300W, belt sanders with motor powers greater than 1000W, plunge routers with motor powers greater than 1000W, laminate trimmers, biscuit jointers, dowel jointers and groovers, planers with a depth of cut greater than 2.5mm, jigsaws with a motor power greater than 500W, scroll saws, reciprocating saws with a stroke length greater than 20mm, circular saws with a motor power greater than 1500W, portable crosscut mitre saws, portable band saws, portable metal cutting mitre saws, portable compound mitre saws, portable combination mitre and bench saws, portable radial arm saws.

4. On 8 May 1997, the same applicant applied for the registration of three similar marks in Class 7. These applications were given the numbers 2132121, 2132123 & 2132125. Like application number 2120680 described above, each of these applications contained two rectangular samples of the colours yellow and black in section 2 of the application form where the representation of the trade mark would normally appear.

5. Application 2132121 contains the following description of the mark:-

“The mark consists of the colour combination of yellow and black (samples of which colours are shown in Section 2) when yellow is applied to the visible surfaces of the clamshell of a power tool and black is applied to the visible surfaces of the inserts and additions to the clamshell”.

6. Application 2132123 contains the following description of the mark:-

“The mark consists of the combination of the colours yellow and black (samples of which are shown in Section 2) as applied to the major part of the visible surfaces of the power tools listed in Section 7 of this form, with yellow being the predominant colour”.

7. Application 2132125 contains the following description of the mark:-

“The mark consists of the combination of the colours yellow and black (samples of which colours are shown in Section 2) as applied to the major part of the visible surfaces of the power tools listed in Section 7 of this form”.

8. The specification of goods of application No 2132125 (which has also been amended during prosecution) is identical to the specification of application No 2120680 set out above.

9. The specifications of application Nos 2132121 & 2132123 is:-

Manually operated portable electric power tools (excluding gardening tools); drills, percussion drills, cutting tools, saws, jig-saws, circular saws, mitre saws, chop saws, routers, trimmers, planers, screwdrivers, drill/drivers, nailers, hammers, rotary hammers, pneumatic hammers, angle grinders, sanders; parts and fittings for all the aforesaid goods.

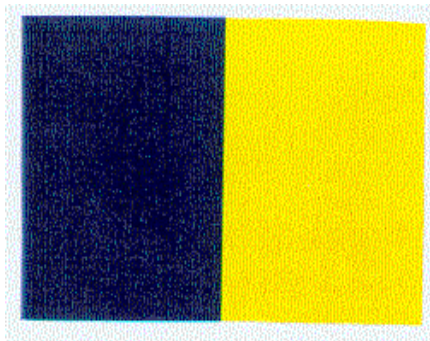
10. Also on 8 May 1997, the applicant filed a further application for the registration of a series of thirty-one trade marks, representations of which are shown in Annex A to this decision. This application, which was given the number 2132120, contains the following description of the marks:-

“The mark consists of the livery of the power tools (as shown in Section 2) in which the clamshell of the power tool housing is coloured yellow and additions and inserts to the clamshell are coloured black (as shown in Section 2).”

11. Subsequent to the filing of this application, the applicant requested that a number of the individual marks in the series be deleted. The marks in question are shown with a line through them in Annex A.

12. On 11 March 1997, the applicant filed two applications in Class 7, which were given the numbers 2126080 and 2126082, for the registration of the trade mark represented below.

2126080

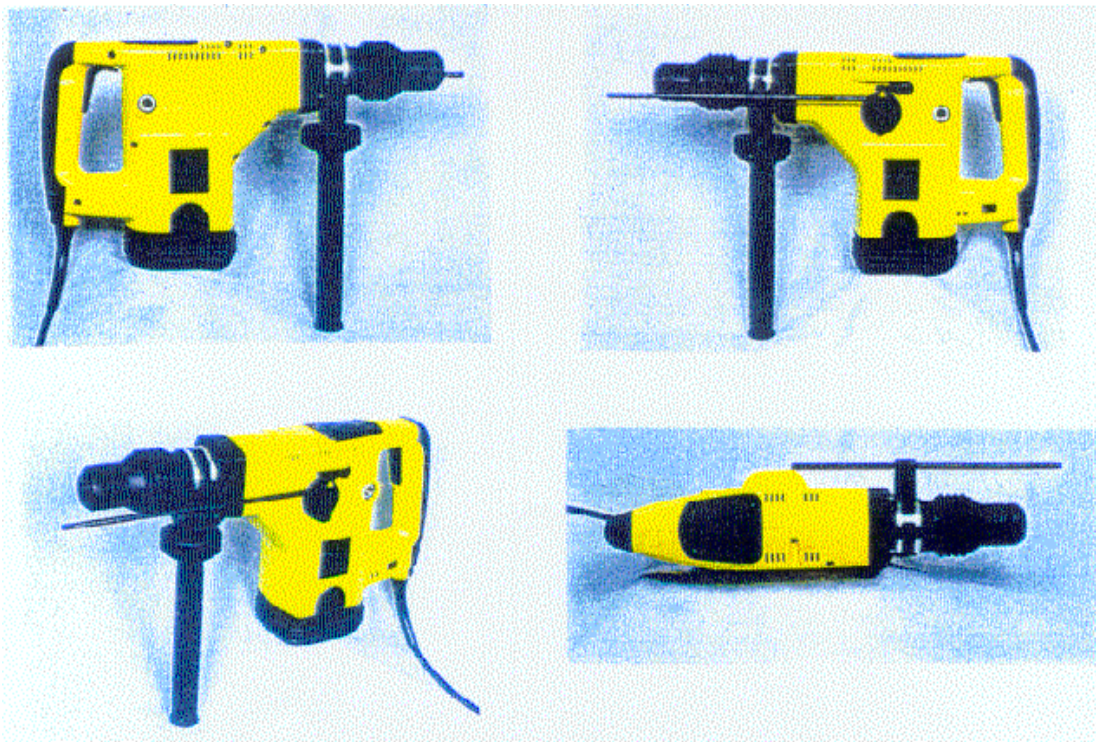


2126082



13. Applications 2126080 and 2126082 are for trade marks which consist of a two dimensional coloured representation of the goods. In each case the application form contains a claim that the colours yellow and black is a feature of the trade mark.

14. On 8 May 1997 the applicant filed an application in Class 7, which was given the number 2132082, for the registration of the trade mark shown below.



15. The application form contains the following description of the mark:-

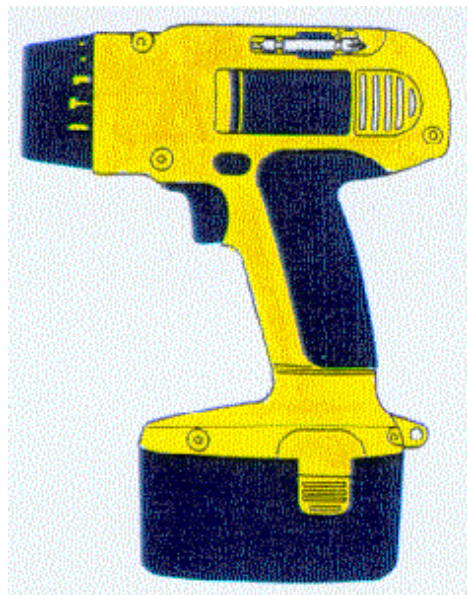
“The mark consists of the combination of the shape of the tool and the yellow and black colours applied to the surface of the tool as shown in Section 2”.

16. The specification of goods of application numbers 2126080, 2126082 & 2132082 (which has also been restricted during prosecution) is as follows:-

Hammers, rotary hammers, pneumatic hammers; parts and fittings for all the aforesaid goods.

17. On 11 March 1997, the applicant filed an application in Class 7, which was given the number 2126084, for the trade mark shown below. On 12 March 1997, the applicant filed an application in Class 7, which was given the number 2126517, for the trade mark also shown below.

2126084

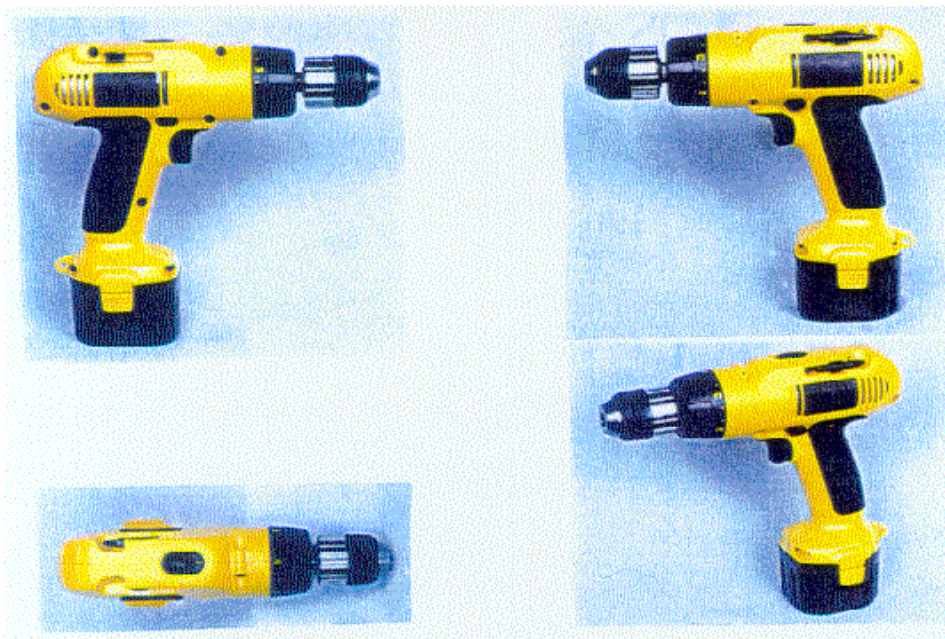


2126517



18. Applications 2126084 and 2126517 are for trade marks which consist of a two dimensional coloured representation of the goods. In each case the application form contains a claim that the colours yellow and black is a feature of the trade mark.

19. On 8 May 1997, the applicant filed a further application in Class 7, which was given the number 2132081, for the trade mark represented below.



20. The application form contains the following description of the mark:-

“The mark consists of the combination of the shape of the tool and the yellow and black colours applied to the surface of the tool as shown in Section 2”.

21. The specification of goods of application numbers 2126084, 2126517 and 2132081 (which was amended during prosecution of the applications) is:-

Cordless drills, cordless percussion drills, cordless screwdrivers; parts and fittings for all the aforesaid goods.

22. Two of the applications contained a priority claim on the basis of an earlier filing at the Benelux Trade Mark Office at 10 December 1996. However, nothing appears to turn on this.

The Objections

23. An objection under Section 3(1)(b) of the Act was raised to each of the applications on the grounds that the marks were devoid of any distinctive character. In some cases objection was also taken under Section 3(1)(c) of the Act on the grounds that the mark consisted exclusively of a sign which may serve in trade to designate a characteristic of the goods. I do not consider this objection to be relevant and I will say no more about it.

24. In the case of application No. 2132120 there was a further objection that the thirty-one trade marks originally included under the application did not form a series within the meaning of Section 41(2) of the Act.

The Evidence

25. The applicant filed evidence in an attempt to overcome the objections under Section 3(1) of the Act. The evidence includes a Statutory Declaration dated 12 January 1998 by Simon Laurence Kinder, who is the Director of Marketing for Black and Decker’s professional power

tools division in the UK.

26. Mr Kinder explains that the Black and Decker Corporation is a long established company in the power tools market and that it has traditionally focussed its activities on the DIY end of the market. He explains that the applicant wished to increase its market share in the professional power tools market. For reasons for which I need not go into here, the Black and Decker house brand was not thought to be the most appropriate choice for a new range of professional power tools. The European arm of the applicant's organisation originally settled on the trade mark ELU, which it had acquired some ten years or so earlier. The American arm of the organisation adopted the trade mark DeWalt. Mr Kinder explains that the ELU products were given a grey colour scheme whereas the DeWalt products were given a yellow and black colour scheme. However, the DeWalt name and yellow and black colour scheme used by the American arm of the applicant's organisation was eventually preferred and yellow and black DeWalt products were formally launched in the United Kingdom on 11 August 1995. DeWalt product were marketed in parallel with the applicant's ELU professional power tools for some time, but the ELU products had been phased out by the date of Mr Kinders' declaration in January 1998.

27. Mr Kinder says that the applicant offered its goods for sale through 'B & Q Warehouses' (which serve the trade and the general public) and specialist retail power tool outlets. In addition to the specialist retailers of professional power tools and B & Q Warehouses, Mr Kinder states that there are other channels of distribution of professional power tools and he provides a list of these together with his understanding of the market share they represent. The list is as follows:-

- (i) builders merchants / 8% ;
- (ii) the hire industry / 8% ;
- (iii) mail order / 7% ;
- (iv) direct sales to the customer (example on building sites) / 10% ;
- (v) wholesalers / 13% ; and
- (vi) the "modern channels" (e.g. Argos, Do-It-All etc.) / approximately 3%.

28. Mr Kinder provides a description of the applicant's promotional methods, which he characterises as "belly to belly" selling. This involves the applicant's salesmen travelling around the UK demonstrating the yellow and black DeWalt products full-time in retail stores, at construction sites and also in schools and colleges. The vans used to visit these sites bore the yellow and black colour scheme of the applicant's goods, as did the clothes worn by the demonstrators, who gave out yellow and black promotional material at such events, including hats, t-shirts, pens and mugs.

29. Mr Kinder indicates that in August 1995, at the time of the launch of the yellow and black products, there were six DeWalt vans, each staffed by a full-time salesman. It is claimed that the number of vans was increased to eight in May of 1996 and then to twenty-one vans in April 1997 in order to increase the amount of time spent face-to-face with potential users. Mr Kinder explains that this method of promotion was chosen in preference to TV advertising because it was considered that tradesmen were averse to such advertising, which they were thought to consider more appropriate for DIY products.

30. Mr Kinder provides the following figures for the amount spent by the applicant on the promotion of the goods in the years 1995 to 1997:-

[Details withheld at applicant's request]

31. It is said that the figures for promotion include literature (brochures and leaflets), point of sale material, t-shirts, caps, mugs, pens and such like. The figures for advertising include advertisements, mainly in the trade press. The figures for sponsorship include the sponsorship of a racing super bike in the yellow and black DeWalt colours and also the cost of sponsorship for a touring car which, whilst not carrying the yellow and black colours on the car itself, allowed DeWalt to have an event at all touring car race meetings to demonstrate the yellow and black DeWalt products.

32. Mr Kinder also provides annual sales figures for products bearing the yellow and black DeWalt colour scheme in the UK. He says that these have been approximately as follows:-

[Details withheld at applicant's request]

33. Exhibit SK1 to Mr Kinder's declaration consists of a selection of promotional brochures produced by eight suppliers of professional and consumer power tools (including the applicant's ELU brand) showing the colours applied to them. Mr Kinder notes that Bosch use what he regards as a distinctive green colour for its DIY power tools and a blue colour for its professional range. Another company called Kango uses a red colour and another company called Makita uses a lighter blue livery. Mr Kinder states, that with a possible exception of the

red used by Kango, most of the power tool manufacturers, whether of professional or DIY products, choose cool conservative colours which suggest to the consumer that the products offer solid reliable performance. This is clearly a subjective matter. In my view, the rather striking green colour used by Hitachi is at least as eye catching as the bright red used by Kango. However, I think it is fair to say that the majority of power tools shown in the exhibit bear a more conservative livery, with green and blue being particularly common.

34. I note from these brochures that inserts and additions to the power tools in these brochures are generally coloured black. The variation of colour between the tools of the various manufacturers is therefore largely confined to the colour or colours applied to the clamshell of the product. Mr Kinder explains that until the advent of the use of moulded plastic clamshells, power tool products tended to be predominantly silver/metallic in colour. Since the advent of plastic clamshells, Mr Kinder says that colours have become more important in the trade and he claims it is now common for the products of the market leader, Bosch, to be referred to as “Bosch green” or “Bosch blue” as opposed to “Bosch DIY” or “Bosch professional range”.

35. Exhibit SK3 to Mr Kinders’ declaration consists of a large collection of copies of press cuttings relating to the DeWalt products. These are dated between September 1995 and the end of 1997. Nearly all the extracts are from adverts or articles that have appeared in the trade press. Most of the extracts relate to the applicant’s saws, sanders, drills and combination drill and screwdrivers, which are generally shown in their yellow and black livery. Mr Kinder draws particular attention to nine specific adverts and articles from magazines such as ‘Woodworking News’, ‘DIY Superstore’ and ‘Executive Hire News’ which refer to the yellow or yellow and black livery of the applicant’s products. It is clear that the writers of at least five of these articles considered the colour yellow, or the colour combination yellow and black, to be distinctive for industrial power tools. Two of the articles refer to the colour of the applicant’s products as industrial yellow with black highlights. There is little doubt that the applicant’s products received considerable coverage in the trade press during 1995, 1996 and that this continued during 1997.

36. Finally, Mr Kinder exhibits at SK13 to his declaration a table showing the results of a recognition survey conducted by Eversheds, solicitors, in the UK. Mr Kinder states that the overall recognition rate of the applicant's products revealed by this survey, which was conducted in April/May 1997, is 42.78%. He further states that if the responses of professional users only are taken into consideration the recognition rate is 57.22%. Mr Kinder notes that there are regional variations in the level of recognition and says that this can be explained by variations in the rate of change over from ELU products to the yellow and black DeWalt power tools.

37. The applicant's evidence also includes a Statutory Declaration dated 13 December 1997 by Paul Andrew Harris who is a partner at Eversheds, solicitors for the Black and Decker Corporation. Mr Harris explains that between the 16 April 1997 and the 22 May 1997 various persons whom he identifies, working for or on behalf of Eversheds, conducted a public survey to evaluate the level of recognition of the colours yellow and black in relation to the origin of professional power tools. To this end the survey was conducted in the vicinity of retailers who specialised in the sale of professional power tools.

38. Exhibit PAH1 to Mr Harris' declaration consists of a questionnaire which sets out the questions that were put to the participants in the survey. The participants were asked whether they used power tools and, if they said yes, were asked whether they used them at work or at home or both. If the participant indicated that they did not use power tools the interview was terminated. If they indicated that they did use power tools the interviewer asked them a further question about the kind of power tools that they used. They then showed the interviewees coloured pictures of ten different power tools. Any word mark that would normally be visible on the tool was covered up so that only the livery of the tool was evident. The interviewee was given around ten seconds to look at each of the pictures and asked whether they could tell the interviewer whether they recognised the make of tool. The interviewer cautioned the interviewee not to try to guess the answer; if they did not know they were to say so. If the interviewee identified any of the pictures on the list as being a DeWalt product they were asked to give their reasons. They were then asked whether they would mind being contacted again and if possible their home address and name was recorded and

they were asked to sign the interview sheet recording their answers at that time.

39. Exhibit PAH4 to Mr Harris' declaration contains an analysis of the results of the survey. Of the ten pictures of power tools shown to the interviewees, four consisted of photographs of power tools with yellow and black livery. Two of these were the applicant's products. The third was a power tool produced by Peugeot in yellow and black colours. I understand that this power tool is on sale in France and possibly elsewhere, but is not yet available in the UK. The fourth yellow and black power tool is produced by a company called Kango. I was informed at the hearing that this company introduced yellow and black livery on some of their products in the UK around the time that the applicant's survey was being conducted.

40. The survey results show that of the two hundred and fifty seven people interviewed eighty-nine correctly identified the applicant's yellow and black drill as a DeWalt product. Thirty-three people identified it as the product of another manufacturer. One hundred and thirty-five people were unable to identify the source of goods. Eighty-eight people identified the Peugeot product as a DeWalt product. Twenty-three people identified it as the product of another company. One hundred and forty-six people were unable to identify the source of the product. Eighty people identified the Kango power tool as the product of DeWalt. Nineteen people identified it as the product of another company; two of these correctly identified it as a Kango product. One hundred and fifty-eight people were unable to identify the source of the product. Eighty-two people correctly identified the photograph of the second DeWalt power tool, which was a rotary hammer, as the product of the applicant. Twenty-one people identified it as the product of another company. One hundred and fifty-four people were unable to identify the source of the product.

41. The applicant filed further Statutory Declarations from the persons who conducted the survey. Attached to these are the original interview sheets that were completed during the course of the survey. The applicant was also able to file 41 declarations from participants in the survey confirming the accuracy of the answers attributed to them in the questionnaires.

42. Mr Harris further explains that, on 12 September 1997, he visited Colin Elcock, David

Allen Mather and Kevin Davies in order to ascertain the opinion of power tool retailers on the impact of black and yellow DeWalt products. He says that these retailers were selected because they are geographically spread, yet enabled him to visit them relatively easily. The addresses provided indicate that the persons concerned reside in York, Harrogate and Oldham.

43. The applicant has provided a Statutory Declaration from each of the persons named above. Mr Mather of Oldham Power Tools states that “There is no doubt in my mind that the colour combination yellow and black, but particularly the bright yellow gets a reaction from my customers. Lots of people ask for the yellow and black DeWalt power tools, frequently by reference to the colour”. He further states that “If I saw the yellow and black power tool I would think it came from DeWalt”.

44. Mr Kevin Davies of Wrayways states that he is a Director of the company and that Wrayways is a specialist power tool retailer whose customers are primarily in the trade, although he does get some non-trade custom. Mr Davies notes that the applicant’s products are an extremely bright colour. He considers this to be very important when compared to the other products on the market which, in his opinion, use dull colours. He states that this is important because it attracts people to the product, although trade customers are knowledgeable enough not to buy the product on colour alone but do so because they know that the product itself and the back-up service is of a good quality. He further states that “If I saw a yellow and black power tool from a distance, I would know it came from DeWalt”.

45. Mr Colin Elcock of Elcock Power Tools (Yorkshire) Ltd states that his company is a specialist power tool retailer and that approximately 90% of his customers are in industry with the remaining 10% falling into the category of DIY users. In Mr Elcock’s view the colour of the DeWalt power tools is very distinctive. He says that he is aware of power tools with blues, greens, a red and a grey but not of another yellow and black product. He says that the colour has undoubtedly been part of the success of the sales of the yellow and black DeWalt products. He further says that he recently watched a television programme which featured the renovation of a house. The builders were using a yellow and black power tool

and although he could not see the name of the power tool because of the way it was being used he knew it was a DeWalt power tool because of the yellow and black colouring.

46. The applicant filed a further Statutory Declaration dated 5 January 1998 by Rajni Patel who states that he is a Director of Monarch Electro Diesel Limited, a specialist power tool retailer, whose customers are primarily professional. Mr Patel says that “Everyone talks about the yellow colour of DeWalt. In my view, the colour attracts people. People walk into the shop and notice it.” He further states that a lot of his business is done over the telephone and that when people telephone they often ask for the tools by their colour because they cannot recall the name. He further states that if he saw a yellow and black power tool he would recognise it as coming from DeWalt. And if a customer were to ask for a yellow and black, or yellow power tool, then he would assume that they were asking for a DeWalt product.

47. Despite this evidence, the objections to the application were maintained and the applicant asked to be heard. The matter came before me on 30 October 1998 when the applicant was represented by Mr Daniel Alexander of Counsel instructed by Carpmaels & Ransford, Trade Mark Attorneys. At that hearing I heard submissions from Mr Alexander which went to the registrability of the trade mark and also the question of whether application number 2132120 consisted of a series of 31 trade marks. As a result of discussion at the hearing, Mr Alexander asked for more time to file further evidence in order to deal with some ambiguities and anomalies that had become apparent in the evidence already filed and for the applicant to consider deleting some of the marks from application number 2132120. I agreed to allow the applicant a further period of time for these purposes.

48. On 27 November 1998, the applicant’s Trade Mark Attorneys proposed to amend application number 2132120 by deleting 6 of the original marks in the series of 31 in order to overcome the objection under Section 41(2) of the Act that the marks did not constitute a series.

49. They also filed a further Statutory Declaration dated 26 November 1998 by Simon Lawrence Kinder. Mr Kinder’s second declaration contains sales volume figures for DeWalt

Power Tools from the launch of the products in the UK in 1995 up until 1998. The figures are set out below:-

[Details withheld at applicant's request]

50. Mr Kinder explains that these figures vary from the figures given in his previous declaration because his previous figures included the financial value for tools and accessories whereas the figures provided in his second declaration relate only to tools. Mr Kinder also makes it clear that the sales figures provided are based upon the price of the goods as charged to the retailer and not the price that the end user of the tools will pay. He explains that the power tools represented by the sales figures shown above would not have been sold to the end users immediately. Rather they would be sold on by the retailer over a period of time. Most retailers are likely to keep a three months supply of stock.

51. Mr Kinder also provides market share figures for DeWalt products as a percentage of the UK professional power tools market. The source of these figures is Deloitte Touche. These figures indicate that in 1995 DeWalt had 2.6% of the UK market in professional power tools by volume, representing 1.1% of the market in value terms. The market share had increased to 2.7% by volume during 1996 with the value share increasing to 2.6%. The market share figure increased again in 1997. This time more significantly. The market share measured in volume had increased to 7.9% by 1997, which represented 8.5% of the market in terms of value. There is no indication as to the time of year that these various market share figures are calculated. Further figures are provided for 1998 which do indicate the position on a quarterly basis. I therefore take it that the position with regard to 1995 to 1997 represents the position at the end of each of these years. Mr Kinder explains that these figures were obtained by way of a quarterly survey conducted by Deloitte Touche. Information is provided by 13 professional power tool manufacturers who are estimated together to have 95% of the professional power tool market in the UK.

52. Mr Kinder also provides sales volumes and value figures for mid- handle cordless drills, percussion drills, screwdrivers and combinations thereof, a representation or the shape of which comprises a part of the trade marks in application numbers 2126084, 2132081 and 2126517. The figures are as follows:-

[Details withheld at applicant's request]

53. Figures are also provided for volumes and sales of mid-size hammers and demolition hammers, a representation or the shape of which comprise a part of the trade marks in application numbers 2126080, 2132082 and 2126082. The figures are as follows:-

[Details withheld at applicant's request]

54. Mr Kinder further states that he has considered the revised specification of goods put forward in respect of application numbers 2120680 and 2132125, both of which are effectively applications to register the colours yellow and black *per se*, and he provides further sales values and volumes figures in respect of the proportion of the DeWalt range of tools covered by this revised specification of goods. The figures are as follows:-

[Details withheld at applicant's request]

55. Mr Kinder also provides some further information with regard to the recognition survey conducted in support of the application. He says that the survey distinguished between those people who used power tools at work or at work and at home, and those people who only use power tools at home. Of the one hundred and eighty-seven people who indicated that they use power tools in work (or at home and at work), eighty people identified at least one of the pictures shown to them of a yellow and black power tool as a DeWalt product. Mr Kinder states that this results in a recognition rate of 42.78% amongst what he regards as professional users. In relation to the non-professional users (that is those people who only used power tools at home) fifteen people identified at least one of the pictures shown to them as a DeWalt product, giving a recognition rate of 21.43% amongst non-professional users. Mr Kinder indicates that the claim in his previous Statutory Declaration to a recognition rate for professional users of 57.22% was in error. This figure in fact represented the percentage of professional users who did **not** identify any of the products as originating from the applicant.

56. Exhibit SLK2 to Mr Kinders' second declaration consists of a table showing a number of members of the public who identified one or more pictures showing the yellow and black power tool as a DeWalt product and the reasons given for doing so. It shows that eighty-five out of the ninety-five people who identified one or another of the pictures shown to them as a DeWalt product gave colour as their reason. I mention here that the answers itemised in Exhibit SLK2 show that, of those people who mentioned the specific colour or colours which identified the product or products to them as being of DeWalt origin, thirty-five people mentioned only the colour yellow, whereas only eight referred to the yellow and black colour combination.

57. Exhibit SLK3 to Mr Kinders' second declaration consists of a table showing the number of people who identified at least one tool to which the yellow and black colours were applied as originating from a source other than the applicant. He notes that nineteen people identified a yellow and black power tool as an ELU product, which is also manufactured by the Black and Decker Corporation and which is substantially identical in appearance to the DeWalt tools except for the colour. Mr Kinder states that in the light of the phasing out of ELU tools in the UK, the applicant sought to educate the end user that DeWalt power tools were the same as

ELU power tools in order to ensure that customer loyalty would switch from ELU to DeWalt. He believes that this accounts for those people who misidentified one or more of the pictures shown to them of a yellow and black power tool as an ELU product. Mr Kinder states that, disregarding the people who identified yellow and black power tools as ELU, only twenty-nine people out of two hundred and fifty-seven interviewed identified one or more of the yellow and black power tools as a brand other than DeWalt. And out of all the people questioned, only one person identified a tool which did not bear the yellow and black colours as a DeWalt tool.

Reasons for Refusal

58. I maintained the objections and refused the applications. The following are my reasons for doing so.

Section 41(2)

59. One of the objections to application 2132120 is that the marks do not form a series within the meaning of Section 41(2) of the Act, which is as follows:-

A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

60. The marks are said to consist of the livery of the goods depicted in the marks where the clamshell cover is yellow and additions and inserts black. At the hearing I indicated that marks within the series with large areas of bare metal, whilst only varying in matters of a non-distinctive character, nevertheless had a sufficiently different identity to prevent them from forming a series with the majority of marks where the coloured clamshell and inserts and additions formed the major part of the visible surfaces of the goods.

61. As indicated above, the applicant subsequently deleted six marks from the series in order

to overcome the objection. Unfortunately, one of the marks subject to this objections remains and another, which was not subject to such an objection, was deleted. The offending mark is circled in Annex A. This is almost certainly the result of a misunderstanding and capable of being overcome if I am found to be wrong on the principal ground for refusal, which is Section 3(1)(b) of the Act.

Section 3(1)(b)

62. Section 3(1)(b) is as follows:-

3(1) The following shall not be registered:

(b) trade marks which are devoid of any distinctive character

63. The proviso to Section 3(1) is also relevant because the applicant has filed evidence to support its claim that the mark has acquired a distinctive character through use. I will return to this later. I first consider the *prima facie* case for registration in respect of application No 2120680, which is effectively for the colours yellow and black *per se* applied to the power tools.

64. In Procter and Gamble Limited's application (1996 RPC 281), Walker L J said that:

“Despite the fairly strong language of s 3(1)(b), ‘devoid of any distinctive character’ - and Mr Morcom emphasised the word ‘any’ - that provision must in my judgement be directed to a visible sign or combination of signs which can by itself readily distinguish one traders's product.....from that of another competing trader.”

65. Although colours *per se* are capable of being trade marks within the meaning of Section 1(1) of the Act, such signs are, in general, ill adapted for such a purpose because colour is routinely and almost unavoidably used for decorative and marketing purposes. In my experience the public do not usually rely on colour for the purposes of distinguishing the trade

source of goods.

66. The applicant's evidence suggests that colour may play a supporting role (to a word mark) in identifying the trade origin of power tools, but there is nothing which suggests to me that colour alone is the normal means to identify the origin of these goods. The first question, therefore, is whether there is anything exceptional about the colours applied for which gives the mark the necessary distinguishing power.

67. As I noted earlier, the applicant's evidence reveals that it is common if not universal practice for the inserts and additions to the clamshell on power tools to be coloured black. The relevant public may be expected to be aware of this. The capacity of the trade mark to perform its essential function of identifying the trade origin of the goods therefore appears to depend substantially on the distinctiveness of the contrasting colour yellow.

68. The applicant points out that:

1. There is no evidence of any earlier use of yellow and black on power tools;
2. Other manufacturers generally use cool conservative colours;
3. There is evidence that the applicant's colours make an impact of retailers and users.

69. I accept the first point, although I note that a number of the extracts from articles in the trade press refer to the applicant's goods as "industrial yellow" or "industrial yellow and black." This no doubt reflects the common use in the UK of bright yellow on industrial equipment and plant. I think this is significant in the light of the applicant's contention that their goods are targeted at 'professional' users who are likely to be in the building industry. Indeed the applicant states that one of the methods chosen to promote their goods is by way of demonstrations at building sites. It appears to me that the common use of bright yellow on other industrial equipment is a relevant factor to be considered when assessing the *prima facie* distinctiveness of the colour yellow when applied to power tools.

70. There is also some support for the applicant's second and third points, although as I noted above, there is also some evidence of other manufacturers using vivid red and green colours in the UK. It may be that the use of bright colours is becoming more popular because manufacturers of power tools have recognised the role that such colours can play in attracting customers to their goods. In this connection I note that the Peugeot power tools sold in France also have a bright yellow livery. Unless colour can, by itself, readily serve as a badge of origin, there is no basis for registering it as a trade mark simply because one trader adopted the colour or colours first in the UK for marketing purposes.

71. In my view the colours yellow and black *per se* are devoid of any distinctive character for power tools. This finding effectively decides the *prima facie* case for applications 2120680, 2132121, 2132123 and 2132125, all of which consist exclusively of the colours yellow and black as applied to the goods at issue.

72. Applications 2132120, 2126080, 2126082, 2126084 and 2126517 consist of representations of these colours applied in particular configurations to specific power tools. I see nothing distinctive about the configurations in question. In each case the plastic clamshell is coloured yellow and the inserts and additions are coloured black, which as I have already noted is a common practice in the trade. It could be argued that the design of the clamshell could be varied but this appears to me to be the sort of variation that only becomes clear on close examination and comparison. I conclude that *prima facie* these marks are also devoid of any distinctive character.

73. This leaves applications 2132081 and 2132082, which consist of the colours yellow and black and the shape of the specific power tools. The shapes concerned appear to me to be functional and in my view add nothing to the *prima facie* case for registration. I conclude that these marks are also devoid of any distinctive character.

74. Although I have considered the *prima facie* case, the applicant's primary case, as I understand it, is that the respective marks have acquired a distinctive character through use. This is clearly the conclusion that the evidence is intended to support.

75. The proviso to Section 3(1) of the Act provides 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.

76. The critical dates are therefore the dates of the applications for registration. The applications were filed on 15 January 1997, 11 March 1997, 12th March 1997 and 8 May 1997. I will again consider first the position with regard to the first filed application - No 2120680.

77. The applicant first offered power tools for sale under its yellow and black livery in August of 1995 some 17 months before the date of application 2120680. According to Mr Kinder's second declaration, by the end of December 1996, the applicant had sold * power tools in the UK bearing the colours, although a proportion of these would not have been sold to end users for up to three months later. However, only * of these power tools would fall within the restricted specification of goods of application 2120680 (and 2132125) which is intended to cover only those tools which would be purchased exclusively by 'professional' power tool users. By the end of 1996 the applicant had * by volume of the 'professional' power tools market in the UK.

78. During 1995 and 1996 the applicant spent * promoting the goods, mainly by way of demonstrations provided from eight touring vans. Conventional advertising was conducted on a more limited scale (*) in the trade press.

79. The length of use before the relevant date is short. The applicant's case, as put to me by Mr Alexander at the hearing, is that the effectiveness of the promotion of the mark and the market share achieved compensate for the limited length of use with the result that the mark became factually distinctive unusually quickly. That is not self evident from the scale of the promotion of the mark before 15 January 1997, which does not appear to be exceptional.

* Details withheld at applicant's request

80. Further, the weight that I should attach to the evidence of use of the mark must be adjusted to take account of the fact that all of the use has been in conjunction with the word mark “DeWalt.” In the well known Treat case (1996 RPC 281), Jacob J cautioned against the assumption that use equals distinctiveness. All the more so when the use there has been of the sign has been in conjunction with a word that will obviously be taken as a trade mark.

81. Mr Alexander accepted this point, and it was no doubt with this in mind that the applicant collected and filed supporting evidence from the trade and from the public survey. I will deal first with the survey evidence.

82. The applicant initially submitted that the survey conducted in April/May 1997 showed that, by that time, 57% of ‘professional’ power tool users recognised a photograph of a yellow and black power tool as a DeWalt product. This was subsequently accepted to be an error. The most favourable recognition rate amongst ‘professional’ users that one can justify on the basis of the survey is around 43%. This is still not an insignificant figure in my experience of such surveys. However, as always, one needs to look carefully at the basis of the survey and the raw data as well as the ‘headline’ figures.

83. The applicant’s figure of 43% is achieved by isolating the ‘professional’ power tool users from others involved in the survey. The applicant is not completely without justification for focussing on the views of tradesmen. There is some evidence that other traders see the trade and DIY markets as different to some extent and the market leader, Bosch, appears to have separate ranges for the respective sectors. Further, the applicant’s promotion of its DeWalt range has concentrated on the trade sector of the market. This is no doubt why, despite the fact that its goods are sold through ‘B & Q Warehouse’ stores as well as specialised power tool retailers, the survey was directed at people entering the latter where a greater concentration of tradesmen could be expected to be found.

84. In this context it appears to me to be going much too far to then exclude the views of non-trade users entering such specialist retail outlets. I also note that some interviewees who identified one yellow and black photograph of a power tool as a DeWalt product failed to

identify other power tools with the same colours as of DeWalt origin, suggesting that either the shape of the tool played a part in their recognition or they were guessing or unsure. Further, of the 95 people who identified any of the 4 pictures shown to them as depicting a DeWalt product, only 85 mentioned colour when asked why. Taking the last figure as a guide it appears to me that real recognition rate of the colours is around 33%.

85. I also bear in mind that the evidence indicates that the applicant stepped up their marketing efforts in April 1997 increasing the number of their touring vans from eight to twenty-one. This was just before the survey was conducted but three months after the date of application 2120680.

86. Of more importance is the validity of the applicant's basic assertion that there is a sharp distinction between the market for 'DIY' power tools and 'professional' power tools. This goes further than the issue of whether non-trade users entering specialist power tool suppliers should be excluded from the recognition survey. If the relevant public includes all users of power tools then the actual rate of recognition of the applicant's yellow and black products in April/May 1997 would have been less (possibly a lot less) than 33% because the applicant's marketing effort up until then had been directed at the trade or 'professional' user.

87. In this connection I find it particularly interesting that in revising the specification of application 2120680 (and 2132125) to cover only those power tools which the applicant contends are exclusively intended for 'professional' users, the applicant has had to provide separate sales figures which reveal that only 40% of the total sales of power tools claimed under the mark fall within this limited specification. The remainder would, I assume, be of a type that may be used by professional and non-professional users, although in the latter case, probably by those looking for a high specification power tool.

88. There is also some doubt in my mind about whether the applicant's classification of goods is entirely accurate in classifying all the tools in the revised specification as being of the type exclusively used by tradesmen. The first item mentioned is "Manually operated portable electric cordless power tools with a battery voltage greater than 13V." However, I note that

both the green and blue versions of the Bosch cordless drill (which the applicant claims signifies Bosch's DIY and professional ranges) featured in the (same) brochure in exhibit SK1 to Mr Kinder's first declaration, have a battery voltage of 14.4V, although the 'blue' (DIY) version also offers a 12V version.

89. In my judgement, although there are, without doubt, power tools mainly intended for DIY and 'professional' users, it is more appropriate to think of these as two ends of the same market rather than as separate markets. I do not therefore accept that there is sharp distinction between these goods or the markets for them.

90. That conclusion is important when one comes to consider the effect of the proposed registration. Registration under the Act provides an exclusive right to use the mark in respect of the goods for which it is registered. However, Section 10(2) of the Act also provides the proprietor with additional protection with regard to the use of an identical or similar sign on similar goods, to the extent that such use is likely to result in confusion. In the circumstances described above, it appears to me that the question of whether use by another party of the colours bright yellow and black on a cordless drill would constitute an infringement would be unlikely to turn on whether the drill in question was of 12V or 14V. The proposed registration is likely to affect the availability of these colours for use throughout the power tools market. That confirms my view that the 'relevant public' in this case consists of users of, and traders in, power tools. The applicant's attempt to limit the enquiry to 'professional' users, whilst not completely without foundation, is somewhat artificial and must be rejected.

91. I conclude that the survey shows a level of recognition of the colours yellow and black of (at most) 33% of the users of high specification power tools interviewed, as a sign used by the applicant for their DeWalt range of power tools, but that this represents the level of recognition amongst only one section of the relevant circles.

92. There is also the matter of whether the level of recognition revealed by the survey amounts to recognition of the colours yellow and black as a trade mark. This is always a difficult matter to resolve where the sign at issue has been used in a supporting role to a distinctive

word mark. The question is whether, to the persons who recognised the colours, yellow and black had come to positively identify the applicant's products or simply that DeWalt power tools were the only ones they knew at that time coloured yellow and black. It seems to me that an inherently non-distinctive sign has become a trade mark at the point when the recognition of the sign matures into a reliance on that sign as a means of identification of the origin of the products in question.

93. The survey does not greatly assist me, one way or the other, on this point. The evidence from retailers of power tools is of more assistance. Mr Mather of Oldham Power Tools states that "Lots of people ask for the yellow and black DeWalt power tools, frequently by reference to the colour." It is not entirely clear to me from that whether he means people ask for the goods simply by reference to the colour or by the colour and the name DeWalt. He probably means the former. The evidence of Mr Patel of Monarch Electro Diesel Limited is clear. He says that "when people telephone they often ask for the tools by their colour because they cannot recall the name." By contrast Mr Davies of Wrayways states that "trade customers are knowledgeable enough not to buy the product on colour alone.." I find it hard to accept that knowledgeable trade customers considering purchasing a relatively expensive power tool would often be unable to recall the name of the manufacturer and therefore rely on colour for source identification. Nevertheless, taken together with Mr Elcock's declaration, I think the evidence shows that trade users were, to some extent, coming to rely on the colour of the products as one means of source identification. The declarations of these traders were made in September 1997 some nine months after the date of application. The position in January 1997 was, if anything, likely to have been a little less favourable to the applicant.

94. Taking account of:-

1. The limited length of use of the mark before the relevant date;
2. The scale of the applicant's promotion of the mark before that date was unexceptional;

3. The promotion that did occur was directed at only one section of what I have found to be the relevant public;

4. It is doubtful whether the 33% recognition revealed by the trade survey in April/May 1997 was sufficiently 'firm' to indicate an equivalent level of recognition as a trade mark in January 1997;

5. My finding that only part of the relevant public were included in the applicant's survey;

6. The high probability that the level of recognition amongst the whole of the relevant public would have been less than that suggested by the applicant's survey;

- I find that the mark had not, by 15 January 1997, come to identify the goods at issue as the products of a particular undertaking to a significant proportion of the relevant public. The mark therefore fails to qualify for registration under the proviso to Section 3(1) of the Act with the result that it must be refused registration under Section 3(1)(b).

95. Applications 2132120, 2132121, 2132123 and 2132125 consist of minor variations to the trade mark which is the subject of application 2120680. The date of application of these marks is 8 May 1997. At that date the applicant is entitled to the benefit of the additional use and promotion of the mark that took place between 15 January 1997 and the later date.

96. However, the length of the additional use concerned is not great and, to a large extent, I have already considered the position at the date of the applicant's survey in April/May 1997 and found it wanting.

97. There is a further point against these applications. The photographs shown to the participants in the public survey included one of a yellow and black power tool produced by a company called Kango. I was advised at the hearing that this tool became available in the UK around the time that the survey was conducted. In fact a couple of participants in the survey

correctly identified it as a Kango product even though it had apparently only just been launched and it did not carry the Kango name.

98. If earlier application 2120680 had been successful, this later use by Kango would be irrelevant. However, in the light of my findings with regard to application 2120680, I consider the fact that another trader had a power tool with a yellow and black livery on the market by the time of these later applications to present a further problem with the applicant's contention that these colours were in fact distinctive of their products at the relevant date. I find that the trade marks which are the subject matter of applications 2132120, 2132121, 2132123 and 2132125 are devoid of any distinctive character and had not acquired a distinctive character at the date of the applications.

99. Applications 2126084 and 2126517 were filed on 11 March and 12 March 1997. The marks in question consist of a two dimensional representation of cordless drill/screwdriver with a yellow and black livery. Application 2132081 was filed on 8 May 1997 and is for a similar mark except that the three dimensional shape of the goods forms part of the mark. However, colour is clearly the principal feature of each of these marks which is claimed to be distinctive. I have already dealt with the *prima facie* case for the registration of these marks. I do not consider that the evidence filed shows that the marks had acquired a distinctive character before the dates of these applications. In this respect I note in passing that the applicant has not restricted the specifications of these applications to what it classifies as 'professional' power tools and that none of the participants in the applicant's survey identified the particular arrangement of the colours yellow and black as a distinctive feature.

100. Applications 2126080, 2126082 and 2132082 are similar marks. The representation or shape of goods included in these marks is of a rotary hammer. Colour is again the feature claimed to be distinctive. I dealt with the *prima facie* case earlier. I do not consider that the evidence filed shows that the marks had acquired a distinctive character before the dates of these applications. In this respect I note in passing that Mr Kinder's second declaration indicates that the applicant did not sell any such goods until 1997, and only 431 were sold during that year. The shape or outline of the goods, which in any event appears wholly

functional, cannot have added anything to the distinctive character of the marks in these circumstances.

101. I have considered all the evidence, documents and arguments put to me and, for the reasons given above, applications 2120680, 2126080, 2126082, 2126084, 2126517, 2132081, 2132082, 2132120, 2132121, 2132123 and 2132125 are refused under Section 37(4) of the Act because the marks are debarred from registration by Section 3(1)(b) of the Act and do not qualify for registration under the proviso to Section 3(1).

Dated this 9 Day of July 1999

Allan James

For the Registrar

The Comptroller General

ANNEX A

