

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2042882A
IN THE NAME OF CARRICK JEWELLERY LIMITED**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 49005 IN THE NAME OF
SEA GEMS LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No 2042882A in the name of
CARRICK JEWELLERY LIMITED**

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and

**IN THE MATTER OF opposition thereto under No 49005
in the name of Sea Gems Limited**

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Background

On 28 October 1995, Carrick Originals Limited of 7 Buchanan Street, Glasgow, G1 3HL,
applied to register the following trade mark

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The application was made in Class 14 and in respect of the following goods:

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Watches.

The application proceeded on the basis of distinctiveness acquired through use. The applicants
voluntarily disclaimed any rights to the exclusive use of the words "RENNIE
MACKINTOSH".

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On 17 September 1998, Sea Gems Limited filed notice of opposition to this application. The
grounds of opposition are in summary:-

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1 Under Section 3(1)(a)(b)(c)(d)

Because the mark is not capable of distinguishing
the applicants' goods, is devoid of any distinctive
character, describes a characteristic of the goods
it is to be used in connection with and is in use in
the common language of the trade.

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2. Under Section 3(3)(b)

Because the mark would be likely to deceive the
public.

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3. Under Section 3(6)

Because the applicants cannot claim to be the
owners of the mark and have no intention of using
the mark in relation to all of the goods for which
registration is sought.

4. Under Section 5(4)(a) & (b) Because use of the mark by the applicants is liable to be prevented by virtue of any rule of law, in particular, the law of passing off.

5 The opponents ask that the application be refused in the exercise of the Registrar's discretion and that costs be awarded in their favour.

The applicants filed a counterstatement in which they deny all of the grounds of opposition and ask that costs be awarded in their favour.

10 Only the opponents filed evidence in these proceedings and as neither party has requested a hearing, acting on the Registrar's behalf and after a careful study of the evidence filed I now give this decision.

15 **Opponents' Evidence**

This consists of a Statutory Declaration dated 21 May 1999 by Anthony F Price, the Managing Director of Sea Gems Limited, a business established in 1971. Mr Price confirms that the information contained within his declaration comes from his own knowledge or has been obtained for him.

Mr Price says that since 1971 his company has carried on business in the design and marketing of gift items. He outlines their promotional activities and refers to exhibit AFP1 which consists of brochures relating to items of jewellery. The exhibit contains an introduction with a brief outline of the life of CHARLES RENNIE MACKINTOSH, the title being in a similar style to the typeface used in the mark applied for, and an indication that the designs are inspired by Charles Rennie Mackintosh, again using a similar typeface to that used in the mark applied for. Although there is no indication of the date from which they originate, Mr Price goes on to say that his company began to manufacture and advertise goods in the style of Charles Rennie Mackintosh in 1995 in preparation for a Charles Rennie Mackintosh Exhibition to be held in Glasgow in 1996. He goes on to give details of Charles Rennie Mackintosh and his work and to say that when the copyright on his works expired they were considered to be in the public domain. He next refers to exhibit AFP2 which consists of:

35 S brochures from companies producing jewellery and watches stated to be based on the designs of Charles Rennie Mackintosh, some using a similar typeface to that used in the representation of the mark applied for.

40 S copies of photographs of two posters said to date from the time of Charles Rennie Mackintosh, one clearly being of German origin, the other advertising THE SCOTTISH MUSICAL REVIEW published at a price of two pence. Both use a similar typeface to the mark applied for.

45 S a copy of a photograph of the front of an establishment called THE WILLOW TEA ROOM, the sign in similar lettering to the mark applied for.

S the cover and inside page of the publication "Charles Rennie Mackintosh,

Textile Designs” with the title represented in a similar typeface to that used in the representation of the mark applied for. The inside page shows the book to be the subject of copyright dating from 1993.

5 Mr Price goes on to say that in the 1960's the Head of Graphics at the Glasgow School of Art designed an alphabet based in part on Mackintosh drawings owned by the school which featured the stylised lettering of Rennie Mackintosh, and that the school used this lettering on its letterheads and advertising materials. He continues saying that the School was asked by
10 Letraset for permission to modify the typeface which was subsequently called the Mackintosh font, and that the parent company of Letraset, ITC has produced another variation. Mr Price says that he believes the fonts are in common use and refers to exhibit AFP3 which consists of:

15 **S** headed paper from the opponents bearing a picture of a building with the legend The Glasgow School of Art in a stylised typeface and endorsed “This shows the stylised letters used by the Glasgow School or Art”.

20 **S** a page from the Internet Web site of the International Typeface Corporation relating to a typeface described as “ITC RENNIE MACKINTOSH LIGHT” and said to be very close in weight and colour and to use the alternate characters and short word settings used in the handwriting of Charles Rennie Mackintosh and is similar to the typeface in which the mark is represented.

25 **S** a sheet headed FZ BASIC 30 (TRUE TYPE) depicting a typeface very similar to that in which the mark is represented, and bearing a copyright date of 1994.

Mr Price gives his views on the lack of distinctiveness of the trade mark for the goods for which registration is sought, and refers to Chapter 6 of the Trade Marks Registry Work Manual relating to trade marks which consist of the names of artists/designers. He comments on the evidence filed in support of the application, and the ex-parte hearing held in connection
30 with the application referring in particular to the weight given by the Hearing Officer to the typeface which he accepted could carry the mark if it could be shown to be exclusively associated with the applicants.

35 Mr Price goes on to refer to the disclaimer of the words RENNIE MACKINTOSH and the acceptance of the application on the strength of the stylisation of these words, stating that this is not distinctive of the applicants and that registration would affect the legitimate trade of other businesses.

40 That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

Turning first to consider the grounds under Section 3(1). That section reads as follows:

45 **3.(1)** The following shall not be registered -

(a) signs which do not satisfy the requirements of section 1(1),

- (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 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.

Section 1(1) in turn reads:

1-(1) In this Act “trade mark” means any sign capable of being represented graphically which is capable of distinguishing the goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

I begin by looking at how the law stands. In the *British Sugar Plc v James Robertson & Sons Ltd (TREAT)* trade mark case, (1996) RPC 9, Mr Justice Jacob said:

“...I begin by considering the “not a trade mark” point. Section 1(1) has two parts, *sign*, and *capable of distinguishing*. *Sign* is not an issue: a word is plainly included within the meaning of *sign* as the remainder of Section 1 indicates. But what about *capable of distinguishing*? Does this add any requirement beyond that found in section 3(1)? Section 3(1)(b) bars the registration of a mark which is *devoid of any distinctive character* unless it has *in fact acquired a distinctive character*. I cannot see that the closing words of the first sentence of section 1(1) add anything to this. If a mark on its face is non-distinctive (an ordinary descriptive and laudatory words fall into this class) but is shown to have a distinctive character in fact then it must be *capable of distinguishing*. Under section 10 of the old Act, for a mark to be registerable in Part B, it also had to be *capable of distinguishing*. But the *Pickwickian* position was that some marks, even though 100% distinctive in fact, were not regarded as *capable of distinguishing* within the meaning of that provision. I do not think the Directive and the 1994 Act takes a more limited meaning over.

Thus, *capable of distinguishing* means whether the mark can in fact do the job of distinguishing. So the phrase in Section 1(1) adds nothing to section 3(1) at least in relation to any sign within sections 3(1)(b)-(d). The scheme is that if a man tenders for registration a sign of this sort without any evidence of distinctiveness then he cannot have it registered unless he can prove it has a distinctive character. That is all. There

is no pre-set bar saying no matter how well it is proved that a mark has become a trade mark, it cannot be registered. That is not to say that there are some signs which cannot in practice be registered. But the reason is simply that the applicant will be unable to prove the mark has become a trade mark in practice - “Soap” for “Soap” is an example. The bar (no pun intended) will be factual not legal.

and

“Next is “Treat” within Section 3(1)(b). What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent from use and recognition as a trade mark, in itself (I hesitate to borrow the word *inherently* from the old Act but the idea is much the same) devoid of any distinctive character.”

I also have regard to the comments of Aldous LJ in the Phillips Electronics NV v Remington Consumer Products Limited case (1999) RPC 23 in which he stated:

“The more the trade mark describes the goods, whether it consists of a word or shape, the less likely it will be capable of distinguishing.”

The decisions above indicate that the correct approach is to start with the premise that a trade mark is capable of distinguishing insofar as it is not incapable. A trade mark which is found to have sufficient inherent distinctive character to be able to distinguish must be capable of distinguishing. A trade mark which does not have any inherent distinctive character may nonetheless acquire distinctiveness through the use made of it, and in doing so it must by inference be capable of distinguishing. In this particular case there is no evidence of anything inherent in the mark which leads me to believe that it is incapable of ever being regarded as a trade mark, and to that extent I dismiss the ground founded under Section 3(1)(a).

In looking at the grounds founded under Section 3(1)(b)(c) & (d) there are two aspects of this particular mark that need to be considered, namely, are the words RENNIE MACKINTOSH able to distinguish the applicants goods, and if not, is the stylisation of the typeface in which they are represented of a distinctive character and able to carry the mark.

The evidence establishes that the words RENNIE MACKINTOSH are descriptive of goods made in the style of the designs of CHARLES RENNIE MACKINTOSH and that prior to the application being filed a number of traders were using some, or all of the name to describe such goods. Consequently I cannot see how the words RENNIE MACKINTOSH can be distinctive of any particular trader. I have no difficulty in finding the words RENNIE MACKINTOSH to be devoid of any distinctive character in relation to the goods for which registration is sought and am fortified in this view by the fact the applicants volunteered to disclaim any rights in the words RENNIE MACKINTOSH.

Turning to the question of the stylisation of the lettering in which the mark is represented.

The opponents state that this is a recognised typeface based on the hand drawn lettering used on architectural drawings by Charles Rennie Mackintosh, and that it is commonly used by traders in relation to goods based on his designs. Exhibit AFP2 which records that in 1973 the copyright to a very similar typeface was vested in Letraset. The exhibit also contains a copy of the cover of a publication entitled THE SCOTTISH MUSICAL REVIEW, the title being represented in a similar typeface to that used in the mark applied for. The opponents say that this dates from the time of Rennie Mackintosh and given the cover price of two pence I consider it is reasonable to infer that it pre-dates the application.

Exhibit AFP3 is a sheet headed FZ BASIC 30 (TRUE TYPE) and depicts a typeface very similar to that in which the mark is represented and is shown to be the subject of copyright dating from 1994. A number of exhibits show that traders are using a very similar style of typeface and although these are in the main undated or dated after the relevant date, the number of instances and the fact that the typeface was available some years prior to the application being made leads me to the view that there is a reasonable likelihood that the typeface was in common use at the date of application.

I find the evidence sufficient to establish that at the date of application the style of typeface used in the representation of the mark was not exclusive to the applicants, although I cannot say that it establishes that the mark consists exclusively of signs or indications which at the relevant date had become customary in the trade. Therefore it appears that the typeface in which the trade mark is represented further associates the mark as whole with the noted designer and designates the goods sold under it accordingly. Consequently, I find the opposition to be successful under Section 3(1)(b) and (c) but dismiss the ground under Section 3(1)(d).

Turning to the ground founded under Section 3(3)(b). That section reads as follows:

(3) A trade mark shall not be registered if it is-

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

The opponents do not say why they consider the trade mark is likely to deceive the public. It may well be that they are saying that the consumer will be deceived if the trade mark is used in relation to goods not based on the designs of Charles Rennie Mackintosh. The evidence shows there to be a style associated with Charles Rennie Mackintosh but that each trader produces their own designs based on his work and in that respect the consumer is unlikely to have a fixed idea of what to expect. Also the selection and purchase of jewellery and watches is in my experience unlikely to take place without the consumer seeing the goods beforehand which significantly reduces the likelihood of deception. I therefore dismiss the ground founded under Section 3(3)(b).

The remaining ground is founded on Section 5(4)(a) and (b). That section reads as follows:

5.(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- S by virtue of an earlier right other than those referred to in subsection (1) to (3)
S or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

Subsection (a) of Section 5(4) implements Article 4(4)(b) of the Directive which provides that a trade mark shall not be registered if it conflicts with an earlier non-registered trade mark or other sign used in the course of trade which confers on its proprietor the right to prohibit use of a later trade mark. Subsection (b) implements Article 4(4)(c) of the Directive which allows for registration to be refused where the use of the mark applied for could be prevented by virtue of any other right, in particular under copyright or design law.

Both subsections are based on what is generally referred to as relative grounds for refusal.

The opponents do not give the basis on which they object nor any details of any rights in an earlier trade mark, sign or otherwise that they or anyone else is entitled to protect. Consequently this ground of opposition must fail.

Turning to the ground founded under Section 3(6). That section reads:

3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

The opponents say that the applicants cannot claim to be the owners of the mark, and do not have the intention to use it on all of the goods for which registration is sought. A claim that an application was made in bad faith implies some deliberate action by the applicants which they know to be wrong, or as put by Lindsay J in the GROMAX trade mark case (1999) RPC 10 “..includes some dealings which fall short of the standards of acceptable commercial behaviour..”. It is a serious objection which places an onus of proof upon the party making the allegation.

While it seems feasible that the applicants knew that other traders used the name and/or the style of typeface, there is nothing in the evidence which establishes this or that in seeking to register their mark they were knowingly trying to deny traders use of a sign which they were legitimately entitled to use. Nor does the evidence establish that the applicants did not intend to use the mark on all of the goods claimed. Accordingly, the objection under Section 3(6) is dismissed.

Finally, the Registrar has no discretion to refuse an application which meets the requirements for registration set out in the Act, and consequently, this final ground cannot succeed.

The opposition having been successful I order the applicants to pay the opponents the sum of £635 as a contribution towards their costs. This sum is to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

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Dated this 27 day of April 2000

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15 **Mike Foley**
for the Registrar
The Comptroller General