

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO: 2000169
BY JOHN LEWIS OF HUNGERFORD LIMITED
TO REGISTER A TRADE MARK IN CLASS 20

BACKGROUND

1. On 31 October 1994, John Lewis of Hungerford Limited of Unit 2, Limborough Road, Wantage, Oxfordshire, OX12 9AJ applied for the registration of a trade mark in Class 20 for the following goods:

Articles of furniture and parts and fittings therefor.

2. The mark for which registration is sought, is defined in the following terms:

“The trade mark comprises the smell, aroma, or essence of cinnamon”.

3. Objection was taken to the application under Sections 3(1)(a), (b) and (c) of the Act, as the mark was not considered to be graphically represented and was in addition a sign that other traders may legitimately wish to use.

4. Since the examination letter was issued (in March 1995), the question of what is (and what is not) an acceptable graphical representation of novel trade marks has continued to develop and a number of decisions have been issued which have provided guidance on this point. Although the applicant has filed both evidence of use of the sign and supporting evidence from the trade, the Registrar has throughout remained of the view that the representation of the mark is too ambiguous and imprecise to satisfy the requirements of the Act.

5. In the interim, the applicant has explored the possibility of supplementing the mark as filed with firstly a gas chromatograph, and more recently by representing the smell using “electronic nose” technology, but these proposals are no longer pursued.

6. Following the decision of Geoffrey Hobbs QC in *Ty Nant Spring Water Ltd's trade mark Application* [2000] RPC 55, the Registrar changed her practice in relation to marks which were not clearly defined and a Journal Notice to this effect was published in Trade Marks Journal 6291 on 25 August 1999. The gist of the change was that the question of whether or not a sign was adequately represented for the purposes of registration primarily fell to be determined under Section 32(2)(d) of the Act, and that in line with the Appointed Person's directions in the *Ty Nant* case, the Registrar would revisit other applications facing similar objections under Section 1(1) and 3(1)(a) of the Act and re-raise the issue as a filing deficiency objection under Section 32(2)(d). Subsequently, on 3 September 1999, the Registrar wrote to the agents acting for the applicant explaining that, in the Registrar's view, the application failed to satisfy the requirements of Section 32(2)(d) of the Act. Under the provisions of Rules 11 and 62(3), the applicant was allowed a non-extendible period of two months to remedy the deficiency.

7. On 3 November 1999, the agents acting for the applicant wrote to the Registrar asking for a hearing to be appointed. The hearing subsequently took place before me on 9 March 2000. The applicant was represented by Mr C Morcom of Her Majesty's Counsel. Having considered Mr Morcom's submissions, the objection under Section 32(2)(d) of the Act was maintained, and under the provisions of Rule 11 the application was deemed never to have been made.

8. Section 76 of the Act states that:

“An appeal lies from any decision of the registrar under this Act, except as otherwise expressly provided by rules.

For this purpose “decision” includes any act of the registrar in exercise of a discretion vested in him by or under this Act.”

This appears to me to be wide enough to include a decision made by the Registrar about the sufficiency of a representation of a trade mark for the purposes of Section 32(2)(d). In my view the applicant is entitled to challenge the Registrar's decision on this point. If I am wrong

about the applicant's failure to comply with the filing requirements, then it must follow that the consequences of failing to remedy the defect within the period allowed under Rule 11 cannot apply and should be reversed.

DECISION AND GROUNDS OF DECISION

9. Section 32(2) of the Trade Marks Act 1994 and Rules 11 and 62(3) of the Trade Mark Rules 1994 (as amended), which were the rules in force at the time of the hearing, read as follows:

- 32.** - (1)
- (2) The application shall contain-
- (a) a request for registration of a trade mark,
 - (b) the name and address of the applicant,
 - (c) a statement of the goods or services in relation to which it is sought to register the trade mark, and
 - (d) a representation of the mark.

The relevant paragraphs of Rule 11 read:

- 11** - Where an application for registration of a trade mark does not satisfy the requirements of section 32(2), (3) or (4) or rule 5(1) or 8(2) the registrar shall send notice thereof to the applicant to remedy the deficiencies or, in the case of Section 32(4), the default of payment and if within two months of the date of the notice the applicant-
- (a) fails to remedy any deficiency notified to him in respect of section 32(2), the application shall be deemed never to have been made.

The relevant paragraphs of Rule 62 read as follows:

- 62** - (1) The time or periods -

(a) prescribed by these Rules, other than the times or periods prescribed by the rules mentioned in paragraph (3) below, or

(b) specified by the registrar for doing any act or taking any proceedings, subject to paragraph (2) below, may, at the written request of the person or party concerned, be extended by the registrar as he thinks fit and upon such terms as he may direct.

(2).....

(3) The rules excepted from paragraph (1) above are rule 10(6) (failure to file address for service), rule 11 (deficiencies in application), Rule 13(1) (time for filing opposition), rule 13(2) time for filing counter-statement), rule 23(4) (time for filing opposition), rule 25(3) (time for filing opposition) rule 29 (delayed renewal), rule 30 (restoration of registration) and rule 41 (time for filing opposition).

10. In determining whether an application contains a representation of the mark within the meaning of the Act, I am guided by the decision of Geoffrey Hobbs QC sitting in his role as the Appointed Person in the *Ty-Nant Spring Water Ltd's trade mark application* [2000] RPC 55. After considering related decisions in *CREOLA Trade Mark* [1997] RPC 507, Case R4/97-2 *Antoni & Allison's Application* [1998] ETMR 460, Case R7/97-3 *Orange Personal Communications Ltd's Application* [1998] ETMR 460 and the decision of Mr Simon Thorley QC (also sitting as the Appointed Person) in *Swizzels Matlow Ltd's Application* [1999] RPC 879 and Case R156/1998-2 *Venootschap onder Firma Senta Aromatic Marketing's Application* [1999] ETMR 429, Mr Hobbs reached the following conclusions:

(1) that the process of examination cannot begin until the registrar has been provided with a "representation" of the sign for which registration is sought (Section 32(2)(d));

(2) thereafter the scope for amendment of the filed representation is strictly limited, and can only be made if the amendment does not substantially affect the identity of the trade mark (Sections 39 and 44 of the Act refer);

(3) this indicates that a representation filed under Section 32(2)(d) must, from the outset, disclose the identity of the sign which is said to be registrable and which may in due course be accepted for registration;

(4) it must do so graphically because that is the only form of representation that can be entered in the register which the registrar is required to maintain under Section 63 of the Act;

(5) the degree of precision with which the sign is represented must be sufficient to permit full and effective implementation of the provisions of the Act relating to absolute unregistrability (Section 3) relative unregistrability (Section 5), infringement (Section 10) and public inspection of the register (Section 63). These provisions call for a fixed point of reference; a graphic representation in which the identity of the relevant sign is clearly and unambiguously recorded;

(6) that the scheme of rights and liabilities established by the Act cannot be implemented fully and effectively in relation to a graphic representation which fails to disclose the identity of the sign it purports to represent or to do so clearly and unambiguously.

11. Mr Hobbs QC concludes that where a sign fails to satisfy the requirements of (3) to (5) above:

“ such representations are, in my view, incapable of fulfilling the legal and administrative requirements of the Act and therefore cannot be accepted under Section 32(2)(d) ”.

12. With this background to the development of case law in relation to graphical representation established, I now go on to consider Mr Morcom’s submissions’ at the hearing. During his submissions, Mr Morcom referred me to a number of the cases mentioned by Mr Hobbs in the Ty-Nant decision, drawing particular support from the comments of Simon

Thorley QC in *Swizzels Matlow Ltd's Application* [1999] RPC 879 to the effect that there is no reason why, as a matter of law, a trade mark cannot be represented in words alone. Mr Morcom also referred me to the decision of the Second Board of Appeal of the Community Trade Marks Office in Case R156/1998-2 *Venootschap onder Firma Senta Aromatic Marketing's Application* [1999] ETMR 429. This case concerned an application for an olfactory mark in Class 28 (for tennis balls) identified by the words "The smell of fresh cut grass". Having decided that (unlike applications to register colour or three dimensional shapes as Community trade marks) there is no requirement arising from the Implementing Regulation to represent smell marks pictorially, the Second Board of Appeal decided that

“13. The question then arises whether or not this description gives clear enough information to those reading them to walk away with an immediate and unambiguous idea of what the mark is when used in connection with tennis balls.

14. The smell of freshly cut grass is a distinct smell which everyone immediately recognises from experience. For many, the scent or fragrance of freshly cut grass reminds them of spring, or summer, manicured lawns or playing fields, or other such pleasant experiences.

15. The Board is satisfied that the description provided for the olfactory mark sought to be registered for tennis balls is appropriate and complies with the graphical representation requirement of Article 4 of the CTMR”.

13. I accept that, as a matter of law, there is no objection to an applicant representing a trade mark in words alone. The matter to be decided is whether the words included in the application form constitute an adequate representation of the sign put forward for registration for the purposes of the Act.

14. In this connection, Mr Morcom likened the application to the smell mark accepted as adequately represented by the Second Board of Appeal. I note that in *Swizzels Matlow Ltd's*

Application, Mr Thorley stated (1999 RPC page 887 at lines 13-16) that:

“I cannot accept that the description as it stands on the Form TM3 is sufficient to enable a trader to determine precisely what the sign is. It seems to me that the description pre-supposes a knowledge on the part of the trader of the Love Hearts product as sold over the years and as is shown in Mr Matlow’s declaration. This cannot be a correct approach. The description must stand on its own to identify the trade mark.”

15. It seems to me that the description put forward in this case suffers from a related defect in that it pre-supposes that the reader already knows what cinnamon smells like. The description does not stand on its own but relies upon the reader’s previous experience of the sign. In the case of an unknown smell the only way to really find out what it smells like from the name of the compound is to obtain a sample from which the smell can be appreciated. But in that event it is the sample which reveals the identity of the sign, not the representation of it that will appear on the register.

16. Mr Morcom compared this to musical notation, which the Registrar accepts as an adequate representation of a sound mark. He said, rightly, that such a representation means nothing to the person who cannot read music. The person concerned has to find someone with the appropriate skills in order to identify the sign at issue. That is so but anyone with the necessary skill in reading music would be able to identify the sign directly from the musical notation whether or not that person had any previous experience of the music concerned. All the necessary information is contained within the representation that is to be placed upon the register. The fact that some people will not have the necessary technical skills to interpret the representation does not necessarily mean that the representation is inadequate. That is why musical notation can stand on its own to identify a sound mark. The same would apply to technical drawings of a three dimensional mark. I do not therefore believe that the analogy suggested by Mr Morcom stands up to close examination. A better analogy would be between a written description of the smell of a substance (like cinnamon) and the name or title of a piece of music. Like the smell of the substance, the title of a piece of music means nothing to

someone who is not already familiar with the piece of music associated by them with the title. The sign cannot therefore be identified from the name or title alone and, for this reason, is unacceptable as a representation of a sound mark. In principle, I can see little difference between this type of application and someone seeking to register “the shape of the well known Love Hearts sweet.” To those who already know what the sweet looks like the words are sufficient to bring to mind the representation of the article already held in their memory. In the case of a person without the necessary experience of the article the sign cannot be identified no matter what technical skills they possess or bring to bear. In my view, whether a “representation” can stand on its own to identify a sign marks the boundary between a true “representation” of a sign and something which is simply the name or title given to it.

17. This view may not entirely accord with the reasoning of the Second Board of Appeal in the *Venootschap onder Firma Senta Aromatic Marketing’s Application* case, who appear to have taken the view that a representation of a smell mark can rely upon the reader’s personal experience of the sign concerned provided that most people can be assumed to have had experience of the sign and be clear about what it is. I can see the force of this when it comes to the smell of fresh cut grass, but I believe that this is an approach that should be viewed with caution. It should be remembered that trade mark registrations can last an indefinite period of time and signs that are well known today may be less well known in years to come.

Admittedly, this probably does not apply to freshly cut grass. In *Swizzels Matlow Ltd’s Application*, Mr Thorley held that decisions of the OHIM Boards of Appeal, although of persuasive value, are not binding upon the Appointed Person. The same must apply to the Registrar. To the extent that my decision differs from the reasoning of the OHIM Board of Appeal, I prefer not to follow their reasoning. As an aside, I note with some interest that the Community Trade Mark Office has not yet indicated that it intends to amend its practice on filing requirements in the light of this decision of the Second Board of Appeal, and I understand that it may not do so.

18. If I wrong in concluding that applicants cannot rely on assertions of the public’s existing familiarity with the sign as a means of “representation”, I nevertheless believe that the case before me can be distinguished on its facts from the case before the Second Board of Appeal.

Mr Morcom sought to persuade me that the cases were on all fours. He pointed out that cinnamon is a single compound which, like the smell of freshly cut grass, is well known. No evidence was provided to support this claim, and for my own part, I do not believe that the smell, aroma, or essence of cinnamon is universally recognised in the way the smell of fresh cut grass might be said to be. Further, even though many people would probably say that they know what cinnamon smells like, that does not mean that those people would necessarily have the same smell in mind. The smell of cinnamon is probably open to a wider degree of interpretation than fresh cut grass because a person's perception of the smell is likely to be influenced by the circumstances in which they have appreciated it. So, for example, a cook's perception of what cinnamon smells like may be different to that of a consumer whose perception is based upon the smell of confections or drinks containing cinnamon. There is also the question of whether the "essence" of cinnamon is any different to the smell or aroma of cinnamon. In my view this adds to the ambiguity present in the description of the mark.

19. I do not believe that the representation tendered for registration is sufficiently precise to allow the Registrar's Examiners to compare the sign with other potentially confusingly similar signs for the purposes of Section 5 of the Act, without the use of samples. For example, how else would someone who does not know what cinnamon smells like, compare the sign with other applications to register (say) the smell of cloves or cassia? The purpose of a graphical representation is to avoid the need for samples of goods, smells, music etc having to be stored on or in relation to Trade Marks Registers, which are inevitably paper or electronic based records. In this case the problem may be a practical one as well as one of principle. The applicant's own promotional material describes the sign as "smelling (of) the delicious spices reminiscent of a wonderful country kitchen." It is therefore quite easy to imagine why other traders in kitchen furniture may adopt similar smells in the marketing of such goods .

20. In the course of his submissions, Mr Morcom drew my attention to the existence of two marks which are registered in the UK and which consist of smells represented solely by means of a textual description. These registrations are, No: 2001416 in Class 12, in respect of "tyres for vehicle wheels", and No: 2000234 in Class 28 in respect of "flights for darts". The marks are defined in the following terms:

No: 2001416: “The trade mark is a floral fragrance/smell reminiscent of roses as applied to tyres”.

No: 2000234 “The mark comprises the strong smell of bitter beer applied to flights for darts”.

21. It is of course well settled that each case must be considered on its merits. See the comments of Mr Justice Jacob in the British Sugar Plc and James Robertson and Sons Ltd case (the “TREAT” case) [1996] RPC 281 at page 305, lines 13-16. This confirms that the state-of-the-register, is in principle, irrelevant when considering a particular mark tendered for registration.

22. I note that both registrations were applied for on 31 October 1994 (the first day of the coming into force of the 1994 Trade Marks Act), and as such, would possibly have been the first marks of this type encountered by the Registrar. As mentioned above, practice has developed considerably since these early acceptances based upon the authorities listed above, and I have reached my decision in this case on the basis of these authorities and my own reasoning.

23. For the reasons indicated, I have come to the conclusion that the representation of the mark filed does not satisfy the requirements of Section 32(2)(d) of the Act. The Registrar notified the applicant of the defect in the representation of the mark in March 1995. The formal notice under Rule 11 drawing the applicant’s attention to the deficiency in the application was issued on 3 September 1999. The deficiency having not been corrected in the period allowed, the application is deemed under Rule 11 never to have been made.

Dated this 16 Day of June 2000.

ALLAN JAMES

For the Registrar

The Comptroller General