

TRADE MARKS ACT 1994

AND

THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

**IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. 708182
AND THE REQUEST BY BRAUN AKTIENGESELLSCHAFT
TO PROTECT A TRADE MARK IN CLASS 9**

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INTERNATIONAL REGISTRATION NO. 708182
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TO PROTECT A TRADE MARK IN CLASS 9**

DECISION AND GROUNDS OF DECISION

On 17 December 1998, Braun Aktiengesellschaft of Frankfurter Strasse 145, D-61476
Kronberg, Germany, on the basis of an International Registration, requested protection in the
5 United Kingdom under the provisions of the Madrid Protocol of the trade mark

Straight & Shape

The following words appear beneath the mark on the form of notification:

Indication relating to the nature or kind of mark: standard characters

The International Registration is numbered 708182 and protection is sought in the United
15 Kingdom in Class 9 in respect of:

"Hair care appliances operated by gas and also by catalytic combustion; parts of the
aforesaid appliances; electrically heated hair care appliances; parts of the aforesaid
appliance."

On 16 June 1999, the notification of a total refusal of protection by the United Kingdom
Patent Office was issued. Objection was taken to the mark under paragraphs (b) and (c) of
Section 3(1) of the Act on the grounds that the mark consists exclusively of words which are
devoid of any distinctive character and which may serve in trade to designate the kind and
intended purpose of the goods e.g. hair care appliances adapted or designed to straighten and
25 shape hair.

In correspondence, Prentice and Matthews (then known as R R Prentice & Co), the trade
mark agents acting on behalf of the applicants, argued that the applicants are seeking
registration of the combination only and offered to disclaim the right to the exclusive use,
30 separately, of the words "Straight" and "Shape" and submitted that with such disclaimers the
trade mark is acceptable for registration in the United Kingdom. The examiner rejected this
argument and with regard to the offer of a disclaimer said "..... this does not, of itself, make an
otherwise unregistrable trade mark registrable."

At the hearing at which the applicants were represented by Mr G Matthews of Prentice and Matthews, the objections under Sections 3(1)(b) and (c) were maintained. I indicated that the mark may be registrable if it had acquired a distinctive character through the use made of it prior to the filing date and a period of time was allowed for the agent to investigate the use of the mark. I was later advised by the agent that "there has been no substantial use of the trade mark in the United Kingdom prior to the filing of the application to extend this registration to the United Kingdom".

The application was, therefore, refused under Article 9(3) of the Trade Marks (International Registration) Order 1996 (as amended) and I am now asked under Section 76, Rule 56(2) of the Trade Marks Rules 1994 which applies by virtue of Article 32 of the Trade Marks (International Registrations) Order 1996 (as amended) to state in writing the grounds of my decision and the materials used in arriving at it.

Article 3 of the 1996 Order states that protection shall depend upon whether an equivalent national application would succeed.

The relevant part of the Act under which the objection was taken is as follows:

"3- (1) The following shall not be registered -

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

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services,

Provided that, a trade mark shall not be refused registration by virtue of paragraphs (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."

No evidence of use has been put before me, therefore the proviso to this Section of the Act does not apply and I have only the prima facie case to consider.

The mark consists of the words and symbol - Straight & Shape. Therefore, it consists, essentially, of ordinary dictionary words which, individually, are so well known that I believe I do not need to set out any dictionary references here. I am, in any case, bound to accept or reject the mark in its totality. I also note that no form of stylisation is claimed by the applicants in the form of notification. Therefore, acceptance relies on the ordinary words, when taken as a totality.

Turning to Section 3(1)(c) first, the goods specified are "hair care appliances" which I would submit must include "curlers" or goods for styling hair. As such I would consider that two purposes of such appliances would be to make the hair straight and shape it into a fashionable style. As such it would straighten and shape the hair. I consider the words do describe the intended purpose and are also close, visually and aurally, to the alternative wording of "straighten and shape".

5 It is for the above reasons that I also consider the mark is devoid of any distinctive character and is not acceptable, prima facie, for registration under Section 3(1)(b) of the Act. In this regard I am guided by the comments of Mr Justice Jacob in the British Sugar Plc and James Robertson and Sons Ltd case (the TREAT case), 1996 RPC 281, comments which also go to Section 3(1)(c) of the Act when he said.

10 "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 use and recognition as a trade mark, in itself (I hesitate to borrow the word from the old Act "inherently" but the idea is much the same) devoid of distinctive character. I also think 15 "Treat" falls within Section 3(1)(c) because it is a trade mark which consists exclusively of a sign or indication which may serve in trade to perform a number of the purposes there specified, particularly to designate the kind, quality and intended purpose of the product".

20 I therefore conclude that the mark applied for is devoid of any distinctive character and consists exclusively of a sign that other traders may use in the course of business to designate the kind and intended purpose of the goods and is thus excluded from protection in the United Kingdom under Sections 3(1)(b) and (c) of the Act.

25 In this decision, I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this designation and, for the reasons given, it is refused under the terms of Articles 3 & 9(3) of the Trade Marks (International Registrations) Order 1996 (as amended) because it would fail to qualify under Section 3(1)(b) and (c) of the Act. 30

Dated this 3 day of July 2000.

35
40 R A Jones
For the Registrar
The Comptroller General