

1 THE PATENT OFFICE

2 Court Room 2,
3 Harmsworth House,
4 13-15 Bouverie Street,
5 London EC4Y 8DP.

6 Thursday, 22nd November 2001.

7 Before:

8 MR. S. THORLEY QC
9 (Sitting as the Appointed Person)

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11 In the Matter of the Trade Marks Act 1994
12 and

13 In the Matter of Trade Mark Application No: 2236189B in the
14 name of NICHOLAS ANDREW CLARKE & LESLEY ANNE GALE CLARKE to
15 register the mark BAGS OF STYLE in Classes 3, 8 and 21

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17 Appeal of the Applicants from the decision of
18 Mr. Charles Hamilton dated 11th July 2001 on behalf of the
19 Registrar.

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21 (Transcript of the Shorthand Notes of Marten Walsh Cherer
22 Ltd., Midway House, 27/29 Cursitor Street, London EC4A 1LT.
23 Telephone No: 020-7405 5010. Fax No: 020-7405 5026.)

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25 MR. H. N. MATTHEWS (of Messrs Prentice & Matthews, London SE1
IXN)
appeared as Agent on behalf of the Appellants/Applicants.

MR. A. JAMES (Principal Hearing Officer) appeared on behalf of
the Registrar.

DECISION
(As approved by the Appointed Person)

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1 MR. THORLEY: This is an appeal to the Appointed Person from a
2 decision of Mr. Charles Hamilton, the officer acting for the
3 Registrar, dated 11th July 2001. It arises in relation to an
4 application by Nicholas Andrew Clarke and Lesley Anne Gale
5 Clarke to register the trade mark BAGS OF STYLE in respect of
6 a number of goods falling within Class 3, Class 8 and Class
7 11, which have been referred to before me as being grooming
8 products. I shall so refer to them in this decision and
9 shall not therefore set out the entire description of goods
10 for which registration is sought.

11 Mr. Hamilton refused registration on the ground that
12 the mark BAGS OF STYLE, when used in relation to grooming
13 products, fell foul of section 3(1)(b) and section 3(1)(c) of
14 the Act. This is a case where there has been no use of the
15 mark which can be relied on for the purposes of the proviso
16 to section 3 and we are therefore faced with the prima facie
17 case.

18 Mr. Hamilton concluded as follows:

19 "The mark consists of the phrase "bags of style" which
20 does not require further definition by reference to a
21 dictionary. In correspondence I informed Mr. Matthews
22 that I thought it was clear that BAGS OF STYLE would
23 be used to convey something which has plenty of style.

24 I take the view that when the mark is viewed in the
25 context of the goods listed in the restricted

1 specifications, it designates various characteristics
2 of the goods. As well as denoting quality, the mark
3 also described the intended purpose of the goods in
4 the sense that it gives the impression that customers
5 who use the applicants' personal grooming products
6 will acquire "bags of style". Moreover, I cannot
7 overlook the use of such a phrase in the promotion of
8 the goods."

9 He thereafter cited some comments of mine in the **DAY BY DAY**
10 trade mark decision (Application No: 2068646 -- unreported)
11 which was not the subject of criticism by Mr. Matthews, who
12 appeared on behalf of the applicants.

13 Before I turn to consider the correctness or otherwise
14 of Mr. Hamilton's reasoning, I should deal with two
15 preliminary points. First, it is common ground that as this
16 is an appeal from an ex parte decision of the Registrar, I
17 should proceed by way of re-hearing rather than review, but
18 equally it is now commonly accepted that I do, in reviewing
19 any decision of the Registrar, attach such weight as I can to
20 the reasoning of the Registrar because of the extensive
21 experience of the hearing officers. Secondly, Mr. Matthews
22 urged me that there should be both a clarity and a
23 consistency in decisions of the Registry in relation to
24 registration of potentially laudatory marks such as these
25 otherwise, as he put it, chaos will reign and he therefore

1 urged me to follow precedents.

2 This is a matter which has to be approached with some
3 care. So far as the law is concerned, of course, I and
4 anyone sitting as the Appointed Person will have great regard
5 to decisions of the Registrar or of other Appointed Persons
6 which related to the correct interpretation of the law.

7 Equally I believe we are bound by the decisions of the High
8 Court and the superior courts, including the European Court
9 of Justice.

10 It is different when one comes to consider the
11 application of that law to the facts of any one case. As
12 Lord Oliver said in the **Jif Lemon** case, comparison with
13 earlier cases is of analogical value only. One has to be
14 careful when you cease to ask the question, "is the mark in
15 question registrable", and start to ask the question: "how
16 similar is this mark to one which has been registered or one
17 which has not been registered?"

18 In the present case, Mr. Matthews urged upon me the
19 reasoning of Hugh Laddie QC (as he then was) sitting in his
20 capacity as acting on behalf of the Secretary of State for
21 Trade in the **KUDOS** trade mark case [1995] RPC 242. Mr.
22 Laddie was considering an appeal in relation to the rejection
23 by the Registry of registration of the word mark KUDOS in
24 respect of various paper articles in Class 16.

25 In relation to that case, Mr. Laddie concluded as

1 follows:

2 "In my view this is a borderline case. In the end,
3 however, I have come to the conclusion that Mr. Hume
4 [the agent acting on behalf of the applicant] is right
5 and that this mark does not have a direct reference to
6 the character or quality of the goods in respect of
7 which registration is sought. In my view it does
8 qualify for registration in Part A".

9 That was, of course, a case being prosecuted under the 1938
10 Act.

11 Mr. Matthews urged me that the words "bags of style"
12 were equivalent, when used in relation to the goods for which
13 registration is sought in this case, to the use of the word
14 "kudos" in relation to paper goods.

15 On the other hand, Mr. James, who appeared for the
16 Registrar, drew my attention to a decision of Mr. Matthew
17 Clarke QC (as he then was) sitting as the Appointed Person on
18 30th December 1999 (unreported) when he concluded that the
19 mark AN EYE FOR DETAIL had to be considered to be entirely
20 laudatory in character when used in relation to Class 25
21 clothing goods for which registration was sought.

22 I first have to identify the correct legal approach to
23 assessing registrability. I then have to apply that approach
24 to the facts of this case. The fact that one mark has been
25 registered and another one has been refused cannot assist me

1 in approaching the question of law. It may be of assistance
2 in approaching the question of fact although, in many cases I
3 suspect, it will simply serve to take one's eye off the
4 correct target.

5 The correct approach in law is not in doubt. It is set
6 out in the recent judgment in the European Court of Justice
7 in the **Baby-Dry** case. I quote from paragraph 42 of that
8 judgment where the court stated:

9 "The determination to be made depends on whether the
10 word combination in question may be viewed as a normal
11 way of referring to the goods or of representing their
12 essential characteristics in common parlance."

13 The question therefore is whether BAGS OF STYLE, as a
14 combination of words, will be viewed as a normal way of
15 referring to an essential characteristic of the goods to be
16 the subject of registration, that is grooming products.

17 Although Mr. Matthews accepted that the expression
18 "bags of style" was a very commonly used expression, he
19 submitted that style is something which is possessed by a
20 user. It is not something that goods can give you. You
21 either have it or do not. The suggestion therefore that
22 goods have a quality of bags of style is not a proper use of
23 language.

24 Mr. James suggested to me that the term was equally
25 applicable to be used in relation to the goods as it was to

1 the people using the goods. In this respect he drew my
2 attention to the reasoning of Mr. Clarke in the **AN EYE FOR**
3 **DETAIL** case. Mr. Clarke stated as follows:

4 "The phrase AN EYE FOR DETAIL must, in my view, be seen
5 as entirely laudatory in character. This can be read
6 no doubt in two particular senses, the first being
7 that the words refer back to the maker of the goods,
8 the second being that they refer forward to the
9 purchaser of those goods but, in both senses, it seems
10 to me that their use in relation to goods can be seen
11 to be intended to convey directly the high or special
12 quality or characteristics of the goods."

13 Those words express in, I suspect, far more eloquent
14 form than I could, thoughts which were passing through my
15 mind during the submissions that were made to me. The word
16 "style" is particularly associated with grooming products.
17 One talks about hair style. One talks about hair stylists.
18 The expression "bags of style" is not an expression newly
19 coined by the applicants. It is a commonly used expression.

20 I believe that the approach of Mr. Clarke is directly
21 applicable to the facts of this case. "Bags of Style" is an
22 expression which has entered into the vernacular. It can be
23 equally commendatory of the quality of goods, as it can be of
24 the quality of the person who has used those goods. I do not
25 believe that the distinction that Mr. Matthews urged me to

1 draw can properly be drawn.

2 In my judgment Mr. Hamilton reached the right
3 conclusion for the right reasons. I would therefore dismiss
4 this appeal.

5 Normal rule, no costs?

6 MR. JAMES: We are not asking for costs.

7 MR. THORLEY: No order as to costs.

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