

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO.2191419 BY Southco, Inc TO REGISTER A TRADE MARK IN CLASS 6

DECISION AND GROUNDS OF DECISION

Background

On 10th March 1999, Southco, Inc 210 North Brinton Lake Road, Concordville, Pennsylvania 19331, United States of America, applied for registration of a trade mark in Class 6 for the following goods:

Metal fasteners consisting of metal screws and speed nuts for fastening doors, covers, panels, and the like; anchor nuts and couplings; rivets and door-retaining springs; hinges and pins; one-quarter turn aircraft type fasteners; butt joint fasteners; retractable panel screws; pawl fasteners; door panel cover and module latches; draw latches; push button fasteners; spring latches; handle-latch combinations; slam-generated latches; printed circuit board fasteners; threaded inserts; drive rivets; fractional-turn fasteners; captive screw fasteners, retainers and assemblies; adjustable grip latches; compression latches; flush (cup-type) latches; push-to-release slam latches; latch keepers; swell latches; one-quarter turn fastener receptacles; steel strikes; bail-handle latches; T-handle latches; flush latches; adjustable lever latches; leverage latches; paddle latches; slide latches; door latches and catches; hidden panel latches; table leaf hinges; lift-off hinges; adjustable door hinges; finishing strips; panel-retaining clips; door pulls; spacers; studs; access hardware, namely latches, screws, pulls and keys; decorative extrusions of metal for covering screw-heads, rivet heads, seams and the like.

The mark for which registration is sought is represented at Annex A.

The examination report was issued on 26th March 1999 and an objection was taken to the application under Section 3(1)(b) & (c) of the Act on the grounds that the mark was devoid of distinctive character and a sign which may serve in trade to designate the kind of goods.

On 30th March 1999 the Applicant's trade mark agent, Eric Potter Clarkson, sought clarification of the objection and on 21st September 1999 they provided an example of the manner in which the trade mark is used on one of the Applicant's "retractable screw fasteners".

On 8th October 1999 the examiner responded by maintaining the Section 3(1) Objection, but also raised a new objection under Section 3(1)(b)&(c) of the Act on the basis that the mark was devoid of distinctive character and consisted exclusively of characteristics of the

goods, i.e. decoration which would not appear to be unusual on goods such as retractable screw fasteners.

On 25th October 1999 the examiner waived the 3(1)(c) objection but maintained the 3(1)(b) objection because she considered that the mark would be seen as merely decorative material. The Applicant's Agents subsequently requested a hearing.

At the hearing, at which the applicants were represented by Mr D Minto of Eric Potter Clarkson, argument was made that the mark was distinctive for the goods as filed. He referred to the examples submitted with correspondence of 13th October 1999 and argued that this trademark was as distinctive as these examples.

Having considered Mr Minto's submissions, the objection under Section 3(1)(b) was maintained. Following refusal of the application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of the decision and the materials used in arriving at it.

Decision

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

Section 3(1):

The following shall not be registered-

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

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 test for distinctiveness was summarised by Mr Geoffrey Hobbs QC. in the Reemtsma Cigarettenfabriken GmbH case [2000] RPC, pages 7 & 8, when he said:

“In order to be free of objection under Sections 3(1)(a) to (d) of the Act (Articles 3(1)(a) to (d) of the Directive) a sign must possess enough of “a distinctive character” to be perceived as an indication of trade origin by “the relevant class of persons or at least a significant proportion thereof”:
paragraphs 44, 46 and 52 of the Judgement of the European Court of Justice in Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee Produktions- und Vertriebs v. Boots-und Segelzubehor Walter Huber and Franz Attenberger [1999] ETMR 585.

Paragraph 29 of the Judgement in the Windsurfing case confirms that the

“relevant class of persons” consists of “the trade and ... average consumers of that category of goods in the territory in respect of which registration is applied for”. The “average consumer” of the products concerned is to be regarded as “reasonably well-informed and reasonably observant and circumspect”: Case C342/97 *Lloyd Schuhfabrik Meyer GmbH v. Klijsen Handel BV* [1999] ETMR 690 paragraph 26.

*A sign possesses a “distinctive character” if goods identified by it would be thought by “the relevant class of persons or at least a significant proportion thereof” to have come (directly or indirectly) from one and the same undertaking as envisaged by the Judgement of the European Court of Justice in Case C-39-97 *Canon Kabushiki Kaisha v. Metro-Goldwyn Mayer Inc.* [1999] ETMR 1:*

A sign which cannot be expected to perform that “essential function” to the required extent is liable to be excluded from registration by one or more of the provisions of Sections 3(1)(a) to (d) of the Act (Articles 3(1)(a) to (d) of the Directive).

The mark consists entirely of a basic geometric shape made up of six devices which together create the appearance of a segmented circle. From my own knowledge and experience of metal fasteners, such as metal screws and rivets, their heads are commonly circular in shape.

An example of the mark in use was submitted by the applicants and I consider that where there is evidence of how the applicant has used the mark, it is appropriate to consider that to be the paradigm case of normal and fair use.

In *OPEN COUNTRY* (2000 RPC 477) page 482 lines 1-7, ALDOUS L.J. said:

*The test laid down in *Smith Hayden*, adapted in accordance with the speech of Lord Upjohn in *BALI*, is the test applicable whether the applicant has or has not used his trade mark. However, no court would be astute to believe that the way that an applicant has used his trade mark was not a normal and fair way to use it, unless the applicant submitted that it was not. It does not follow that the way that the applicant has used his trade mark is the only normal and fair manner. However in many cases actual use by an applicant can be used to make the comparison.*

The example of the mark in use supplied by the applicant, shows that the mark appears as a series of small indentations around the neck of a retractable screw fastener. In use these indentations appear to be part and parcel of the structure of the screw housing. They appear on the top of the structure surrounding the opening in which the head of the screw is held. The segmented circle of indentations appears only on close examination of the product and appears to be one of a number of design features of the product. There is nothing about it which suggests it has a trade mark significance.

The Court of First Instance in *Procter & Gamble Company -v- Office for Harmonisation in the Internal Market* Case T-117/00, in paragraph 55, made reference to the question of use of a

sign where that sign is indistinguishable from the appearance of the product itself.

Nevertheless, when those criteria are applied [Article 7(1)b of Regulation No 40/94], account must be taken of the fact that the perception of the relevant section of the public is not necessarily the same in relation to a three-dimensional mark consisting of the shape and the colour of the product itself as it is in relation to a word mark, a figurative mark or a three-dimensional mark not consisting of the shape of the product. Whilst the public is used to recognising the latter marks instantly as signs identifying the product, this is not necessarily so when the sign is indistinguishable from the appearance of the product itself.

Furthermore, in Yakilt Honsha KK's application (2001 RPC 756), paragraph 11, Laddie J. said:

Like Mr James, I can see nothing which would convey to someone who was not a trade mark specialist that this bottle was intended to be an indication of origin or that it performed that function. Even were it to be recognised as of different shape to other bottles on the market, there is nothing inherent in it which proclaims it as having trade mark significance.

Mr Minto drew my attention to numerous previous registrations (by various other proprietors) and argued that the applicant's mark was as equally distinctive and urged me to accept the application for this reason. I am not aware of the circumstances surrounding the acceptance of the marks that Mr Minto referred to and, in any event, each case must be dealt with on its own merits. The Hon. Mr Justice Jacob in the TREAT decision (1996) RPC 281 said:

"In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the Register. It has long been held that under the old act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see MADAME trade mark (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence."

Conclusion

In my view, anyone encountering this mark for the first time, will see it as a non-distinctive device and it will not be taken as a trade mark without first educating the public that it is a trade mark. It follows that this application is debarred from prima facie acceptance by Section 3(1)(b) of the Act.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application, and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 3(1)(b) of the Act.

Dated this 31ST day of January 2002.

Miles Rees
For the Registrar
the Comptroller General

ANNEX A

