

DECISION AND GROUNDS OF DECISION

Background

1. On 31 January 2007 House of Cheatham, Inc., of 1550 Roadhaven Drive, Stone Mountain, Georgia 30083, United States of America applied to register trade mark 2445286 under the provisions of the Trade Marks Act 1994. The mark consists of the word AFRICA'S BEST.

2. The mark was applied for in respect of the following goods:

Class 3: Health and beauty care products; hair care products, including hair conditioners, shampoos, hair moisturizers, creams and soaps; skin care products, including body lotions, creams and soaps.

3. An examination report detailing the examiner's view of House of Cheatham, Inc's application was issued on 16 March 2007. In this report an objection was taken against the application under Section 3(1)(b) and (c) of the Act because the mark was deemed to consist "exclusively of the words "AFRICA'S BEST", being a sign which may serve in trade to designate the quality and geographical origin of the goods." An objection under Section 3(3)(b) of the Act was also taken on the basis "that the mark would be deceptive if used on goods not originating from Africa".

On 15 June 2007, the agent filed detailed written submissions contesting the validity of the Section 3(1)(b) and (c) objection and the Section 3(3)(b) objection:

- The provisions of the Trade Mark Act have not been correctly applied and that the competent authority has not proved the facts on which they have relied in its finding that the mark is descriptive;
- Africa is not associated with cosmetics nor is it likely to be in the future;
- Marks referring to geographical areas are commonly used legitimately in the marketing of cosmetics and details of similar registered trade marks considered to be on a par with the subject application were referred to;
- The word BEST is commonplace as a component of trade marks and as such consumers would not perceive the term as an indication of quality. There are numerous "XXXX BEST" marks on the register and as a result of this consumers confronted with such a mark will perceive it as a trade mark;

- In respect of the Section 3(3)(b) objection, it is highly unlikely that a consumer would be deceived as to the origin of the goods if they did not originate from Africa.

5. On 25 July 2007, in response to the agent's submissions, the examiner waived the objection under Section 3(1)(c) and 3(3)(b) of the Act. The objection under Section 3(1)(b) was maintained as the mark was considered to be devoid of any distinctive character.

6. On 13 August 2007 the agent filed further detailed submissions arguing that the objection under Section 3(1)(b) had not been fully supported and that the mark is capable of distinguishing the goods. The agent argued that:

- There is no threat to the public interest by registration of this mark;
- Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings;
- Widespread use of the "XXXX BEST" form as a trade mark demonstrates that marks in this form generally have sufficient distinctive character to function as trade marks;
- The present application does not fit within any of the examples given in the IPO Work Manual relating to Section 3(1)(b) objections and the term is allusive;
- The Office has maintained the Section 3(1)(b) objection for reasons which differ from those relating to the original Section 3(1)(c) objection. It therefore appears that the Office has now introduced new reasons for its objection which were not stated in the Examination Report and which have not been supported with reasoning;
- The mark AFRICABEST has been accepted in Classes 29 and 30 and the mark AFRICA'S BEST is similarly registerable.

7. On 2 October 2007 the examiner responded maintaining the Section 3(1)(b) objection on the basis that the sign would be perceived as a promotional statement and drew support from CFI in *Real People Real Solutions Case* (T-130/01).

8. On 14 January 2008 the application was refused following an error in the Registry. The action was rescinded and the application reinstated. An extension of time was granted until 2 March 2008.

9. On 21 February 2008 by way of email the agent requested a further extension of time in which to gather evidence of use. By way of official letter of 22 February the extension was granted until 2 April 2008.

10. On 31 March 2008 the agent requested a third extension of time to assemble the evidence of use. The reason for the request was due to staff shortages resulting in difficulties in finalising the evidence. A further two months was granted until 2 June 2008.

11. The evidence of use was submitted on 28 May 2008 along with further arguments as to why the mark was not devoid of any distinctive character. The evidence and arguments were rejected on 3 June 2008 and a period of two months until 3 August 2008 was granted in which to allow the applicant to respond.

12. On 18 August 2008 the application was refused as no response had been received and the objections remained.

13. On 5 September 2008 the agent filed a Form TM5.

DECISION

The Law

14.. Section 3(1)(b) Act reads as follows:

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

(a).....

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

15. Section 3(1)(b) has been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in Joined Cases C-53/01 to C-55/01 *Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 003) in the following terms:

“37 It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which

registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, para 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of relevant persons, namely the consumers of the goods or services. According to the Court's case law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, para 31 and *Philips*, para 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from other undertakings."

16. This case reiterates the important principle that 'devoid of any distinctive character' must be assessed by reference to the perceptions of the average consumer in relation to the goods and services applied for. In this particular case the goods are essentially health, beauty and hair products and the relevant consumer who, in respect of the goods contained within the specification applied for are, in my view, the general public.

17. In addition to the *Linde* case, we now have a body of case law in relation to promotional marks. It is helpful also to refer to some of this case law.

18. The importance of the average consumer's point of view in relation to slogans has been illustrated by the Court of First Instance – Case T-281/ 02, *Norma Lebensmittelfilialbetrieb GmbH & Co KG v. OHIM - Mehr Für Ihr Geld* [meaning: 'if you buy this from us, you will get more for your money!'].

"31. In that regard, the applicant's argument that the consumer is told nothing about the content or nature of the goods offered under the mark is irrelevant, because he does not know to what the word "more" relates. For a finding that there is no distinctive character, it is sufficient to note that the semantic content of the word mark in question indicates to the consumer a characteristic of the product relating to its market value which, whilst not specific, comes from promotional or advertising information which the relevant public will perceive first and foremost as such, rather than as an indication of the commercial origin of the goods (see, to that effect, *REAL PEOPLE, REAL SOLUTIONS*, paragraphs 29 and 30). In addition, the mere fact that the word mark "Mehr Für Ihr Geld" does not convey any information about the nature of the goods concerned is not sufficient to make that sign distinctive..."

19. It is generally accepted that the test for the registrability of a slogan is no different than for any other type of mark. However, in REAL PEOPLE REAL SOLUTIONS –Case T-130/01 of 5 December 2002 the Court of First Instance stated that:

“29. Since the relevant consumer is not very attentive if a sign does not immediately indicate to him the origin and/or intended use of the object of his intended purchase, but just gives him purely promotional, abstract information, he will not take the time either to enquire into the sign’s various possible functions or mentally to register it as a trade mark.”

20. Further in DAS PRINZIP DER BEQUEMLICHKEIT - (Case C-64/02P) the European Court of Justice stated that:

35 The possibility cannot be excluded that the case-law mentioned in the foregoing paragraph of this judgment is also relevant to word marks consisting of advertising slogans such as the one at issue in this case. That could be the case in particular if it were established, when assessing the distinctiveness of the trade mark in question, that it served a promotional function consisting, for example, of commending the quality of the product in question and that the importance of that function was not manifestly secondary to its purported function as a trade mark, namely that of guaranteeing the origin of the product. Indeed, in such a case, the authorities may take account of the fact that average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogans (see, to that effect, *Procter & Gamble*, paragraph 36).

21. Promotional marks can still fulfil the function of a trade mark, but only if the mark is capable of being perceived immediately as an indication of origin of the goods or services. In other words, the essential origin function is immediately recognisable alongside the other function of promotion.

22. In this case the mark applied for consists of the words Africa’s Best. When considered in relation to the goods in question the average consumer of the same would merely perceive that the goods either originate from Africa, and are the finest that do so or (alternatively) that they are a best selling brand in Africa. As cited above in *Mehr Für Ihr Geld*, “it is sufficient to note that the semantic content of the word mark in question indicates to the consumer a characteristic of the product relating to its market value which, whilst not specific, comes from promotional or advertising information which the relevant public will perceive first and foremost as such, rather than as an indication of the commercial origin of the goods.” And from REAL PEOPLE REAL SOLUTIONS, also cited above: “...[s]ince the relevant consumer is not very attentive if a sign does not immediately indicate to him the origin and/or intended use of the object of his intended purchase, but just gives him purely promotional, abstract information, he will not take the time either to enquire into the sign's various possible functions or mentally to register it as a trade mark.”

23. These findings are reinforced by the fact that, given the nature of purchasing process in relation to what are relatively low priced and common place goods, the average consumer of the same has no reason to dwell on the mark or consider it in any detail.

24. As regards the earlier marks registered by the UK-IPO, I am unaware of the circumstances surrounding their acceptance, and consider them to be of little assistance in determining the outcome of this application. I draw support for this from the judgement of Jacob J in *British Sugar* [1996] RPC 281 at 305 where he stated the following:

"Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual enquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. 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 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 e.g. *MADAME* Trade Mark and the same must be true under the 1994 Act. I disregard the state of the register evidence."

25. For these reasons I maintain the objection under Section 3(1)(b) of the Act.

EVIDENCE OF USE

The Law

26. The proviso to section 3(1) of the Act permits the registration of marks which have 'acquired distinctive character through use' stating that:

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

Applicant's Evidence

27. On the 3rd June 2008 the applicant provided evidence in the form of two witness statements. The first from Julius Ceaser Douglas, a Director of JCD International Brokerage who is responsible for managing the export of the applicant's products to the United Kingdom, and the second from Hollie Bennet, an account executive of Freebournes Limited, who are responsible for the sale of advertising space in Black Hair Magazine.

28. The witness statement from Julius Ceaser Douglas states that the mark has been used in the UK since the year 2000. Mr Douglas states that the goods are designed principally for use by individuals of Afro-Caribbean and Afro-American origin.

The turnover and advertising figures are as follows:

| Years | Annual Sales (US\$) | Marketing Expenditure (US\$) |
|--------------|----------------------------|-------------------------------------|
| 2000 | 43,692 | 3,000 |
| 2001 | 99,991 | 7,000 |
| 2002 | 146,656 | 10,000 |
| 2003 | 227,734 | 16,000 |
| 2004 | 385,089 | 25,000 |
| 2005 | 359,180 | 25,000 |
| 2006 | 259,693 | 25,000 |
| 2007 | 507,993 | 35,000 |

29. The evidence states that the market share is 2% and that the principal retail channels for minority hair care and cosmetic products are not large supermarket chains and pharmacies but rather the goods are distributed through specialist retailers (a list of which is provided).

30. In the second witness statement from Hollie Bennet , it is stated that the mark has been regularly advertised in Black Hair Magazine which has a circulation of 30,000 per year for the last five years. This witness statement is accompanied by exhibits of the magazine showing how the mark has been advertised. The Exhibits show use of the mark in advertising in the Black Hair magazine dating from 2002 until 2003. However no exhibits have been provided in relation to the wide specifications claimed but merely in relation to hair care products. There do not appear to be any exhibits showing use of the mark prior to 2002 or after 2003.

Relevant Authorities

31. First, it is clear from the case-law that the acquisition of distinctiveness through use of a mark requires that at least a significant proportion of the relevant section of the public identifies the products or services as originating from a particular undertaking because of the mark. However, the

circumstances in which the condition as to the acquisition of distinctiveness through use may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data, such as specific percentages (see, by analogy, Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* paragraph 52, and Case C-299/99 *Philips* paragraphs 61 and 62)

32. Second, in order to have the registration of a trade mark accepted under Article 7(3) of Regulation No 40/94 (the Regulation mirrors the proviso to Section 3(1) of the Act) the distinctive character acquired through the use of that trade mark must be demonstrated in the part of the European Union where it was devoid of any such character under Article 7(1)(b) to (d) of that regulation (Case T-91/99 *Ford Motor v OHIM(OPTIONS)* paragraph 27).

33. Third, in assessing, in a particular case, whether a mark has become distinctive through use, account must be taken of factors such as, *inter alia*:

- a. the market share held by the mark,
- b. how intensive, geographically widespread and long-standing the use of the mark has been,
- c. the amount invested by the undertaking in promoting the mark,
- d. the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking, and
- e. statements from chambers of commerce and industry or other trade and professional associations.

If, on the basis of those factors, the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must be concluded that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied (*Windsurfing Chiemsee*, paragraphs 51 and 52; *Philips*, paragraphs 60 and 61).

34. Fourth, according to the case-law, the distinctiveness of a mark, including that acquired through use, must also be assessed in relation to the goods or services in respect of which registration is applied for and in the light of the presumed perception of an average consumer of the category of goods or services in question, who is reasonably well-informed and reasonably observant and circumspect (see, to that effect, *Philips*, paragraphs 59 and 63).

Decision

35. The sales figures are low and whilst the attorney argues that this is a niche market the applicant only holds a 2% share of that market.

36. The evidence does not provide any exhibits of the actual goods applied for but merely advertisements of a small range of hair care products in one magazine. No invoices have been provided demonstrating that the goods are actually sold throughout the UK to the list of retailers provided.

37. In my opinion the evidence submitted is not sufficient to justify accepting the mark of distinctiveness acquired through use. The exhibits provided only show use of the mark in one magazine during the period 2002 to 2003. The applicant claims that the mark has been used for eight years but has not provided any evidence of this eight year period by way of dated exhibits.

38. It is not clear that the term has been used widely in the market place as a badge of origin and there is no clear indication as to the geographical extent of the use. In my opinion the evidence of use provided is insufficient in detail. In fact nothing submitted suggests that the term Africa's Best is understood by the relevant public to be an indication of trade origin.

Conclusion

39. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from *prima facie* registration on the grounds of Section 3(1)(b) of the Act.

40. In this decision, I have considered all the documents filed by the applicant and all the argument submitted to me in relation to this application and, for the reasons given, it is consequently refused under the terms of Section 37(4) of the Act.

Dated this 8th day of April 2009

**Bridget Whatmough
For the Registrar
The Comptroller-General**