

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2405309B**

**BY VENTURA CORPORATION LTD**

**TO REGISTER A TRADE MARK IN CLASSES 20 AND 24**

**DECISION AND GROUNDS OF DECISION**

**Background**

1. On 31 October 2005, Ventura Corporation Ltd of Ventura House, 27-29 Denmark Street, Wokingham, Berkshire, RG40 2AY applied under the Trade Marks Act 1994 to register the following series of two marks:

**NANO SILVER**

***nano silver***

2. Registration is sought for the following goods:

Class 20 beds; mattresses

Class 24 bed and table covers; bed linen; pillow covers.

3. An objection was taken against the application originally under Section 3(1)(b) and (d) of the Act, as the words 'NANO SILVER' were considered to be a sign which has become customary in trade. The objection was revised at hearing to Section 3(1)(b) and (c) of the Act because the marks consist exclusively of the words 'NANO SILVER', being a sign which may serve in trade to designate the nature of the goods e.g. beds, mattresses, table and bed linens which contain nano silver. 'Nano silver' is a recognised technology which utilizes particles of silver measured in nanometres which is used in relation to electronic goods, clothing and textiles and medical products etc., to kill bacteria and viruses.

4. At the time of examination, an objection was taken under Section 41(2) of the Act in respect of the original series of marks applied for, being eight in total. This objection was conclusively dealt with by reducing the marks to an acceptable series of two, therefore I will make no further comment upon the same in this decision.

5. Post examination submissions in respect of the Section 3(1)(b) and (c) objection were made by the applicant's trade mark attorney, Mr Julius Stobbs of Boulton Wade Tennant. However these were not considered to be sufficiently compelling by the examiner responsible for the case and a request for a hearing was made.

## **The Hearing**

6. A hearing was held on 23 November 2007 at which the applicant was represented by Mr Stobbs. The objection raised under Section 3(1)(b) and (c) of the Act was maintained. A request was thereafter made by Mr Stobbs for a Statement of Grounds under Section 76 of the Act and Rule 69(2) of the Trade Mark Rules 2008 to state in writing the grounds for the decision and the materials used in arriving at it.

7. No evidence has been put before me, therefore I only have the prima facie case to consider.

## **The Law**

8. Sections 3(1)(b) and (c) of the Act reads 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, quality, intended purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of the goods and services,

## **The case for registration**

9. Prior to the hearing, Mr Stobbs made submissions in correspondence to support the application. In his letter of 2 March 2006, Mr Stobbs stated that the term nano silver ... *'is extremely unusual in the context of the goods identified'*.

10. These submissions were considered at hearing and in correspondence, however it was determined that the term 'nano silver' is used descriptively in trade in conjunction with many types of goods, including woven and non-woven materials (supported by extracts from the Internet showing the mark used in this context), which would constitute at least part of the goods covered by the specifications herein in Classes 20 and 24. I consider this objection to be correct and the marks to be objectionable prima facie under Section 3(1)(b) and (c) of the Act.

## **Decision**

11. In a judgement issued by the European Court of Justice on 23 October 2003, *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case - 191/01 P, (the DOUBLEMINT case), the Court gives guidance on the scope and purpose of Article 7(1)(c) of the Community Trade Mark Regulation (equivalent to Section 3(1)(c) of the Trade Marks Act). Paragraphs 28 - 32 of the judgement are reproduced below:

“28. Under Article 4 of Regulation No 40/94, a Community trade mark may consist of any signs capable of being represented graphically, provided that they are capable of

distinguishing the goods or services of one undertaking from those of other undertakings.

29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which “consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or rendering of the service, or other characteristics of the goods or service” are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.

31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

12. There are now a number of judgments from the ECJ which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), whose provisions correspond to Section 3(1)(c) of the UK Act. In terms of the issues before me in this case I derive the following main guiding principles from the cases noted below:

- subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – *Wm Wrigley Jr & Company v OHIM – (Doublemint)* paragraph 30;

- there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics – *Ford Motor Co v OHIM*, Case T-67/07;

- a sign's descriptiveness may only be assessed, first, in relation to the goods or services concerned and, secondly, in relation to the perception of the target public, which is composed of the consumers of those goods or services – *Ford Motor Co v OHIM*;

- it is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes – *Wm Wrigley Jr v OHIM*, paragraph 32;

- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word 'exclusively' in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question – *Koninklijke KPN Nederland NV and Benelux-Merkenbureau*, Case C-363/99 (*Postkantoor*), paragraph 57;

- it is in principle irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary – *Postkantoor*, paragraph 102.

13. Section 3(1)(c) of the Act has common roots to Art. 7(1)(c) of the CTMR, and is substantially identical to that provision. Accordingly, the ECJ's guidance with regard to that provision may be taken to apply equally to Section 3(1)(c) of the Act. The provision excludes signs which may serve, in trade, to designate the kind of goods or other characteristics of goods. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the goods in question.

14. The objection under Section 3(1)(c) is maintained against the following goods:

Class 20        beds; mattresses

Class 24        bed and table covers; bed linen; pillow covers

15. The meaning of the term 'NANO SILVER' in relation to these goods is clear; the consumer of such products, being the general public, would expect them to incorporate the benefits of 'nano silver'.

16. This nano silver technology is applied widely in trade where nano-sized silver particles are inter- woven with yarn, which produce an end product with anti-microbial, bacterial and fungicidal properties. During examination, various extracts from the Internet were provided which demonstrated this generic use in trade upon a wide range of woven materials and products.

17. Mr Stobbs submitted at the hearing that the marks refer to a 'high tech' application of technology to non technical goods and that the average consumer be aware of this fanciful

application and would perceive the mark as an indicator of trade origin and not a descriptive reference to goods incorporating nano silver.

18. I remain unconvinced upon this declaration, given the wide use in trade. Evidence found on the Internet shows the term ‘nano silver’ used on a diverse range of quotidian, commonplace goods, similar to that specified with the applicant’s marks. The goods cited use as part of their composition woven materials (e.g. beds and mattresses) or be made wholly or substantially from woven materials (e.g. bed and table covers, bed linen and pillow covers) that incorporate nano silver. An anti-bacterial function will be highly desirable for reasons of hygiene; indeed, the applicant’s own website refers to products under the ‘Night Therapy’ range which categorically states that:

*‘all Night Therapy memory foam mattress toppers are treated with naturally anti-bacterial **Nano Silver** [my emphasis] technology. Naturally anti-mite, anti-mould and anti-microbe for a safer sleep experience.’*

19. The average consumer is therefore likely to be made clearly aware of the significance of nano silver, designating a quality in the goods, and this use will therefore negate any potential trade mark significance.

20. Consequently, I have concluded that the mark applied for consists exclusively of a sign or indication which describes a characteristic of the goods.

21. Having found that the marks are to be excluded from registration by Section 3(1)(c) of the Act, that effectively ends the matter, but in case I am found to be wrong in this decision, I will go on to determine the matter under section 3(1)(b) of the Act.

22. The approach to be taken when considering the issue of distinctive character under Section 3(1)(b) of the Act has been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 in its Judgement in Joined Cases C-53/01 to C-55/01 Linde AD, Windward Industries Inc and Rado Uhren AG (8 April 2003) 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 1 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*, paragraph 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 the 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, paragraph 31, and *Philips*, paragraph 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 those of other undertakings.”

23. For the same reasons that I found the marks to be excluded from registration by the provisions of Section 3(1)(c) of the Act, I have concluded that the relevant consumer of the goods in question would not consider that this mark can denote trade origin. The average consumer of these goods will, upon encountering the word ‘NANO SILVER’, perceive them as no more than an indication that they contain nano silver. I am not persuaded that the trade mark applied for is sufficient in terms of bestowing distinctive character on the sign as a whole, to conclude that it would serve in trade to distinguish the applicant’s goods from those of other traders.

### Conclusion

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

Dated this 27<sup>th</sup> day of May 2009

Jane Hallas  
For the Registrar