

O-176-09

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION NO 2449033

BY NMSI TRADING LIMITED

TO REGISTER A TRADE MARK

**IN CLASSES 3, 4, 8, 9, 12, 14, 16, 18, 21, 24, 25, 28, 29, 30, 31, 32,
33, 39, 41 AND 43**

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BY NMSI TRADING LIMITED
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43**

DECISION AND GROUNDS OF DECISION

Background

1. On 9 March 2007 NMSI Trading Limited of Science Museum, Exhibition Road, London, S7 2DD applied under the Trade Marks Act 1994 to register the following trade mark:



2. Registration is sought for the following goods and services:

Class 3

Cleaning, polishing, waxing and scouring preparations; soaps; pot pouri;
cosmetics; toiletries; fragrances; dentifrices; hair care and hair styling

preparations.

Class 4

Candles; fuels, oils and lubricants.

Class 8

Hand tools and implements; cutlery; razors; parts and fittings for all the aforesaid goods.

Class 9

Audio, video and data recordings; audio and video and data recording apparatus and equipment and parts and fittings therefore; computer games; computer gaming apparatus and parts and fittings therefore; records, tapes, cassettes, DVD's, CD's; magnetic data media; electronic publications; pre-recorded films and TV programs; downloadable music and ring tones; mobile telephone apparatus and equipment and parts and fittings therefore; optical apparatus and equipment and part and fittings therefore; photographic apparatus and equipment and parts and fittings therefore; spectacles and sunglasses, spectacle and sunglasses frames; credit cards; computer mouses and mats for use therewith.

Class 12

Vehicles; trains; apparatus for locomotion by land and rail; parts and fittings for all the aforesaid goods.

Class 14

Jewellery; precious metals and stones, and articles made from precious metals and stones and/or imitations thereof; horological or chronometric apparatus and instruments and parts and fittings therefore; pin and lapel badges.

Class 16

Printed matter; books; posters; photographs; stationery; office requisites; calendars; music; tissues; paper and paper goods; wrapping and packaging materials; postage stamps.

Class 18

Luggage; bags; purses and wallets; umbrellas; goods made from leather and/or imitations of leather.

Class 21

Household utensils; china; glassware; porcelain ware; earthenware; flasks.

Class 24

Textiles and textile goods; soft furnishings; bedding.

Class 25

Clothing, headgear, footwear.

Class 28

Toys, games and playthings; model and replica trains and model railways and accessories; sporting apparatus and equipment; parts and fittings for all the aforesaid goods; playing cards; balloons; Christmas crackers.

Class 29

Meat, fish, poultry and game, and products made from or containing the same; preserved, dried and cooked fruits and vegetables, and products made from or containing the same; prepared meals; jellies, jams; edible oils; eggs, milk; dairy products.

Class 30

Confectionery; bread and bread products; pastry and pastry products; ices; ice creams; desserts; snack foods; sauces and condiments; prepared meals; coffee, tea, cocoa; sugar; spices; cakes and biscuits; sandwiches; pies.

Class 31

Fresh fruit and vegetables; seeds; plants and flowers.

Class 32

Non alcoholic beverages; fruit juices; mineral and aerated waters; beers.

Class 33

Alcoholic beverages.

Class 39

Transport services; travel and transport arrangement services; storage services; vehicle rental services; advisory and consultancy services relating to all the aforesaid.

Class 41

Educational services; entertainment services; organisation of exhibitions, competitions, meetings and events; museum services; advisory and consultancy services relating to all the aforesaid.

Class 43

Restaurant services; bar services; café and café bar services; catering services; hotel services; hotel and accommodation reservation services; advisory and Consultancy services relating to the aforesaid.

3. Objection was taken to the mark in all classes under Sections 3(1)(b) and (c) of the Act because the mark consists exclusively of the words FLYING SCOTSMAN together with a device of the FLYING SCOTSMAN train, being a sign which may serve in trade to designate characteristics of the goods and services e.g. goods and services relating to the Flying Scotsman locomotive.

4. Objection was also taken in Class 33 under Section 3(3)(b) of the Act because the mark is evocative of Scotland and would be deceptive if used on whisky not produced in Scotland. However, I do not consider this objection to be sustainable. The mark is evocative of a famous locomotive and not of Scotland or goods manufactured in Scotland. This objection is therefore waived and I will make no further reference to it in this decision.

5. Further objections were taken under Section 5(2) of the Act. These objections were subsequently converted into notifications and will be processed as such, should this application proceed to advertisement in classes 39 and 43.

6. A hearing was held before Mr R Jones on 5 July 2008 at which the applicant was represented by Mr Marsh of Wilson Gunn, their trade mark attorneys. Following the hearing the objection was maintained and Notice of Final Refusal was subsequently issued.

7. I am now asked under Section 76 of the Act and Rule 69(2) of the Trade Mark Rules 2008 to state in writing the grounds of my decision and the materials used in arriving at it.

8. No evidence of acquired distinctiveness has been put before me or Mr Jones. I have, therefore, only the prima facie case to consider.

The Law

9. Section 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, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services.”

The case for registration

10. In correspondence prior to the hearing, reference was made to advice provided by the registry's Search and Advice Service. The advice was provided prior to this application being filed and, as Mr Marsh points out in his letter of 2 August 2007, there are clear discrepancies between the advice provided in the Search and Advisory Service report and the objections raised in the official examination report. The objections raised under section 3(1)(b) and (c) were subsequently reconsidered and maintained, but only for specific goods in classes 9,16 and 28. The objections are now maintained only in respect of the following goods:

Class 9

Audio, video and data recordings; records, tapes, cassettes, DVDs, CDs; magnetic data media; electronic publications; pre-recorded films and TV programs.

Class 16

Printed matter; books; posters; photographs; calendars.

Class 28

Toys, games and playthings; model and replica trains and model railways and accessories.

11. In his letter of 15 April 2008, Mr Marsh draws attention to the fact that the sign for which registration is sought consists of a combination of the words FLYING SCOTSMAN and "a stylised device of a train". Mr Marsh continues by advising that the applicant is the actual owner of the original locomotive named "FLYING SCOTSMAN". Mr Jones' hearing report indicates that these submissions were re-iterated at the hearing. However, the objections were maintained and a further period of time was allowed for the applicant to submit revised specifications.

12. In his letter of 24 June 2008 Mr Marsh requested that consideration be given to allowing the application to proceed for revised specifications in classes 9, 16 and 28. In support of this Mr Marsh refers to an earlier registered mark (2057869) which is another composite mark which incorporates the words FLYING SCOTSMAN, and is registered for the goods in these revised specifications (For convenience a copy of this registered mark is at Annex A). However, Mr Jones maintained the objections and consequently the specifications of goods and services remain as originally filed.

13. Finally, examples of use of the sign by the applicant were provided under cover of Mr Marsh's letter dated 26 November 2008. I note that these documents are examples of how the sign is used by the applicants and they do not constitute evidence that the mark has acquired a distinctive character through its use as a trade mark.

14. Mr Jones did not consider that it was appropriate to allow the objection to be waived and maintained the objection for the reasons set out in his report of the hearing. Mr Jones allowed further time for formal evidence of acquired

distinctiveness to be filed but no such evidence has been received.

Decision

15. 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 C - 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, geographical 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).”

16. 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.

17. A trade mark's distinctiveness must be assessed by reference to the goods or services in respect of which registration is sought and the perception of the relevant persons, namely the consumers of the goods or services. This means the presumed expectations of an average consumer of the category of goods in question, who is reasonably well informed and reasonably observant and circumspect. In my view the consumers of such goods may include corporate and other professional users but the end consumer of these goods is more likely, in this case, to be the general public.

18. In relation to the goods for which the objection has been maintained the mark in question will be perceived as no more than subject matter in relation to a very famous locomotive and will not be perceived, by the relevant consumers, as a sign indicating that the goods are supplied by, or are under the control of, a single undertaking. I note that there are some broad terms remaining in the specifications, for example: "electronic publications" in class 9, "printed matter" in class 16 and "toys, game and playthings" in class 28. Although the objection may not be relevant for all goods covered by these broad terms such terms will all encompass goods for which the trade mark will be perceived as subject matter or the shape of the goods. For these reasons I consider the objection to be valid for all of the goods identified.

19. I note the 2009 calendar and the packaging of a fridge magnet which was sent under cover of Mr Marsh's letter of 26 November 2008. The objection no longer relates to fridge magnets but it is maintained against calendars. However, this use of the mark, even in respect of calendars is, in my view, no more than an indication of subject matter.

20. I also note Mr Marsh's comment that the "actual physical locomotive known as "FLYING SCOTSMAN" is actually owned by the applicant." However, I do not see that this can have any bearing whatsoever on how the sign applied for will be perceived by the relevant consumer in relation to the goods in question.

21. The trade mark consists of the words FLYING SCOTSMAN together with a device of the famous steam locomotive so named. There are to my knowledge many rail enthusiasts throughout the United Kingdom, especially in respect of famous and historic steam locomotives. This particular locomotive is very famous, and in respect of the goods identified it will do no more than indicate a characteristic of them. For these reasons I am satisfied that the objection must be maintained for all goods identified at paragraph 10 of this decision.

22. The only remaining question is whether this combination of words and device create a whole greater than the sum of its parts and that it will overcome the descriptive nature of the word combination and the device of a steam locomotive. I do not see how they can. The device supports the meaning of the words, but adds nothing to them. There is a degree of stylisation to the device but it is clearly a steam locomotive and, in conjunction with the words, it will be perceived as a slightly stylised representation of the steam locomotive named FLYING SCOTSMAN.

23. I find support of this conclusion from the comments made by Richard Arnold QC,

sitting as the Appointed Person, in an appeal of the decision to refuse application 2428182 by British American Tobacco (Brands) Inc. to register the mark SUN RIPENED TOBACCO with device (BL O/200/08). He said:

"13. The impact of the words in the mark are clear, namely that of a reference to the goods as described above. It is also clear that the presence of the sun device has a relationship to these words and, to some extent, may re-enforce or supplement their meaning; in other words, the sun device, in the context of the mark as a whole, is not an arbitrary or fanciful inclusion. Despite all this, will the overall impression, as the attorney would have me believe, strike the consumer as a badge of origin?"

14. I am mindful of the comment of Mr Hobbs QC sitting as the Appointed Person in Quick Wash Action [BL O/205/04]: 'I do not think that the hearing officer was guilty of excision or dismemberment in his assessment of the present mark. Devices can be distinctive or nondistinctive, just like any other kind of sign. What matters are the perceptions and recollections that the sign in question is likely to trigger in the mind of the average consumer of the goods concerned and whether they would be origin specific or origin neutral. I think that the verbal elements of the mark I am considering speak loud and clear. It seems to me that the message they convey is origin neutral. The artistic presentation neatly and skilfully builds upon and reinforces the origin neutral message in a way that makes it even more effective than the words alone might have been for that purpose. I think that net result is a well-executed, artistically pleasing, origin neutral device.'

15. Applying similar reasoning to the mark at issue here, it strikes me that the words SUN RIPENED TOBACCO also speak loud and clear and that they do so in a descriptive and therefore origin neutral manner. The presentation incumbent in the sun device (and the overall presentation of the words), despite having an element of artistic nature, merely build upon and re-enforces the message behind the mark. This all leads, in my judgment, to a mark that fails to strike the consumer as a badge of origin."

24. Consequently, I have concluded that in respect of the goods identified at paragraph 10 the mark consists exclusively of a sign which may serve, in trade, to designate the kind of and is, therefore, excluded from registration by Section 3(1)(c) of the Act.

25. I now turn to Section 3(1)(b) of the Act. This objection also relates only to the goods in classes 9, 16 and 28 which are identified at paragraph 10 of this decision.

26. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently 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 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.”

27. I must determine whether the trade mark applied for is capable of enabling the relevant consumer of the goods in question to identify the origin of the goods and thereby to distinguish them from other undertakings.

28. For the same reasons for which I found the mark is to be excluded 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 this mark to denote trade origin. The average consumer of these goods will, upon encountering the words FLYING SCOTSMAN, together with the slightly stylised representation of the steam locomotive named FLYING SCOTSMAN, perceive this sign as no more than an indication that the goods in question contain information about this locomotive, are replica or other representations of this locomotive or are recordings of the locomotive. The sign is likely to be taken as a reference to the subject matter of the goods thus branded. 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 goods of the applicant from those of other traders.

29. I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

Conclusion

30. 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 Sections 3(1)(b) and 3(1)(c) of the Act.

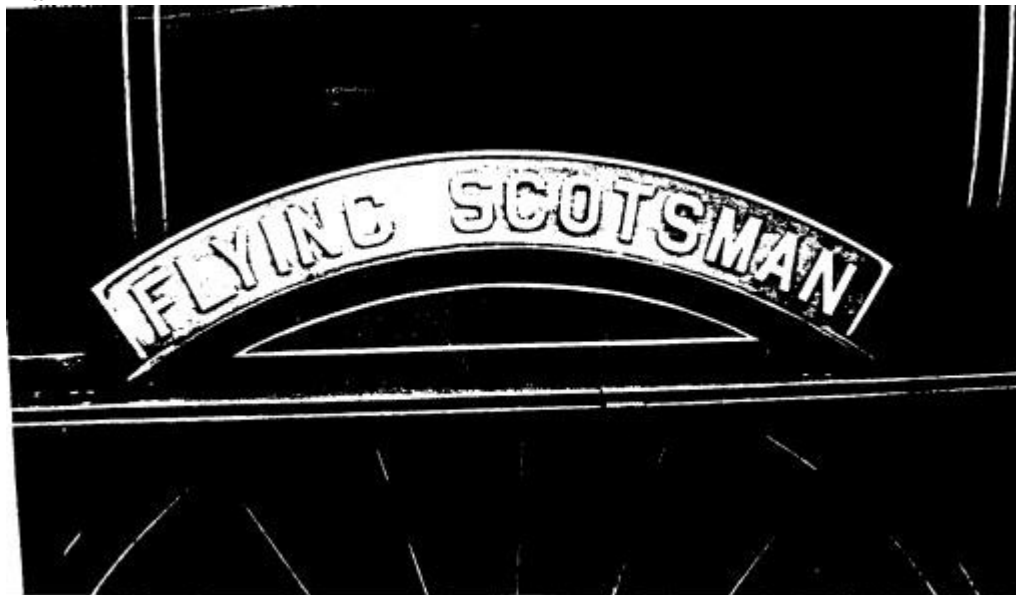
Dated this 24th day of June 2009

**A J PIKE
For the Registrar
The Comptroller-General**

ANNEX A

Case details for Trade Mark 2057869

Mark



Mark text:

FLYING SCOTSMAN

Status

Status:

Registered

Classes:

09, 16, 18, 21, 25, 28, 35

Status before death:

Registered

Relevant dates

Filing date:

23 February 1996

Next renewal date:

23 February 2016

Registration date:

07 June 2002

Progress stopped:

24 February 2006

Publication in Trade Marks Journal

First advert:

Journal:

6131

Page:

7637

Publication date:

26 June 1996

Registration:

Journal:

6438

Publication date:

10 July 2002

Renewal:

Journal:

6627

Publication date:

31 March 2006

Expiry:

Journal:

6626

Publication date:

24 March 2006

Assignment:

Journal:

6619

Publication date:

03 February 2006

List of goods or services

Class 09:

Video tapes, audio tapes, films, spectacle cases; all relating to the famous, historic steam locomotive Flying Scotsman.

Class 16:

Postcards, stationery, playing cards, jigsaw puzzles, pens, pencils, tablemats, stamps, posters, printed matter, publications; all relating to the famous, historic steam locomotive Flying Scotsman.

Class 18:

Leather articles, umbrellas, bags; all relating to the famous, historic steam locomotive Flying Scotsman.

Class 21:

Glassware, china mugs, porcelain giftware, miniature souvenir locomotive nameplates; all relating to the famous, historic steam locomotive Flying Scotsman.

Class 25:

Men's, ladies' and children's hats, scarves, sweaters, shirts, vests, jackets, coats, gloves, shorts, trousers, socks, footwear; all relating to the famous, historic steam locomotive Flying Scotsman.

Class 28:

Games, balloons, playthings, sporting articles, scale models; all relating to the famous, historic steam locomotive Flying Scotsman.

Class 35:

Advertising, promotions, posters, all to promote the activities of Flying Scotsman; all relating to the famous, historic

steam locomotive Flying Scotsman.

Names and addresses

Proprietor:

MSI Trading Limited

Science Museum, Exhibition Road, London, SW7 2DD

Incorporated country:

Great Britain

Residence country:

Great Britain

Effective assignment date:

22 November 2005

ADP number:

0683743001

Service:

Jane Kennedy NMSI Trading Ltd

Science Museum, Exhibition Road, South Kensington, London, SW7 2DD

ADP number:

0879539001