

O-308-09

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER M803195

BY HILTI AKTIENGESELLSCHAFT

TO REGISTER THE COLOUR RED (PANTONE C32)

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996
IN THE MATTER OF INTERNATIONAL REGISTRATION No 803195
AND THE REQUEST BY HILTI AKTIENGESELLSCHAFT
TO PROTECT A TRADE MARK IN CLASSES 7, 8, 9 and 20**

Background

1. On 12 February 2003, Hilti Aktiengesellschaft, zH Patentabteilung, Postfach 333, Feldkircher Strasse 100, FL-9494 Schaan (Lichtenstein) on the basis of International Registration 20020829 requested protection in the United Kingdom under the provisions of the Madrid Protocol of the following mark:

The colour red (Pantone C32)

2. Protection is sought in respect of:

Class 6 - *Containers of metal for storing and transporting equipment and apparatus mentioned in classes 7, 8 and 9.*

Class 7 - *Equipment, namely bolt, nail and clamp fixing tools, screwing tools, drilling tools, hammer drills, chipping hammers, separating tools, sawing tools, slot-making tools, grinding tools, more especially for working with stone, concrete, masonry, plastics material and wood; equipment for mixing and applying liquid, pasty or solid substances.*

Class 8 - *Hand tools, including bolt, nail and clamp fixing tools, drilling tools, separating tools, sawing tools, slot-making tools, grinding tools, more especially for working with stone, concrete, masonry, plastics material and wood; equipment for mixing and applying liquid, pasty or solid substances.*

Class 9 - *Electric, electronic, magnetic and/or photometric measuring, signalling, testing, positioning, searching and monitoring apparatus; apparatus for metering, dispensing and introducing liquid, pasty or solid substances.*

Class 20 - Containers not of metal for storing and transporting equipment and apparatus mentioned in classes 7, 8 and 9.

3. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and notice of refusal under Article 9(3) was given because the mark is excluded from Registration by Section 3(1)(b) of the Trade Marks Act 1994. This is because the mark consists exclusively of the colour red (Pantone C32) being devoid of distinctive character and not being recognisable as a badge of origin.

4. A further objection was raised under Section 3(6) in respect of class 9 because the specification is so wide that there is some doubt that the holder of the registration is using, or intends to use, the mark on all the goods indicated. The objection was raised because of the inclusion in the specification of the term “electric, electronic apparatus” at large. This was addressed when the agent requested limiting the goods covered by this application to rotary hammers and to cases.

5. After a number of extensions of time evidence of use was submitted with a view to overcoming the objection on the basis of distinctiveness acquired through use.

The Evidence

6. A witness statement was submitted on 14 October 2005. This was completed by Roland Wildi, the Senior Vice President of the Corporate Intellectual Property Division of Hilti Corporation. Details were given of trading area, turnover and advertising figures, together with literature in the form of promotional literature and brochures.

7. The evidence was rejected on the basis that although the sales and advertising figures are high, the mark has only ever been used in conjunction with the more dominant trade mark, namely the word HILTI, and that there was nothing to show that the mark applied for is seen in the market place as a badge of origin. The exhibits showing the mark in use were in the form of the applicants catalogues,

bound in red and displaying the prominent trade mark HILTI. The goods displayed within the catalogue are coloured red, but they too all display the trade mark HILTI in a prominent position on the goods.

8. Further time was agreed for the agents to submit additional evidence. This was filed on 14 July 2006 and was in the form of statements from relevant trade associations, namely, The Building Services Research and Information Association, The Association for Specialist Fire Protection, The Drilling and Sawing Association and the Constructions Fixings Association. These statements all comprised similar wording saying that the writer was well aware of the use of the colour red as a trademark by Hilti; that Hilti have used this colour in relation to their products for a great many years; and that they believe that this particular shade of red has become synonymous with the products they produce and acts as an indicator that products bearing that colour originate from Hilti AG.

9. This further evidence was also rejected as there was nothing to indicate that the mark would be recognised by a substantial percentage of buyers of the goods as a badge of origin. There was no indication that the goods bearing the mark are sold exclusively to the trade and they could just as easily be bought by DIY (do it yourself) enthusiasts.

10. The agent requested further time to submit additional evidence, pointing out that its client's target market consists essentially of professionals involved in the field of construction, demolition, civil engineering and related services and it is these areas that were going to be targeted in order to bolster the evidence already filed.

11. Following rejection of the trade evidence, survey evidence was filed on 29 March 2007. One hundred questionnaires were sent to companies obtained at random from the applicant's database. They had received 19 responses. (Please see Annex A to see an example of the questionnaire). 16 of the responses considered use of the colour mark to indicate Hilti, a claim by the agent of 84% recognition. This further evidence was rejected because the examiner considered the survey had been too restrictive in the range of people contacted and the examiner considered that there had only been 16% recognition from those responding.

The Hearing

12. On 1 February 2008 a hearing took place between Mr Grimshaw of the agents and the hearing officer Alan Pike. Mr Grimshaw pointed out that the specifications were likely to be limited to rotary hammers and also cases in classes 6 and 20. The Hearing Officer maintained the objection. Although, in reality, the goods are aimed at professional users, the Hearing Officer considered that rotary hammers are essentially hammer drills which exist in most households. The objection was maintained and time was allowed for further evidence to be filed.

Further correspondence

13. After the hearing, and before refusal of the application, correspondence took place between the agent and the Registry. It was put forward by the agent that rotary hammers above a certain weight are not made available to the general public through DIY outlets and they envisaged seeking registration in respect of rotary hammers with a weight in excess of 6kg. The Hearing Officer did not agree that the weight qualification removed the general public.

14. On 30 June 2008 the agent informed the Hearing Officer that an identical mark had been filed at OHIM and the mark had been objected to. After considering evidence of use OHIM were prepared to accept the application for “hammer drills for trade professionals in the construction industry; cases for the transport and storage of hammer drills for trade professionals in the construction industry, in particular made from metal or plastic”.

15. A translated copy of the Board of Appeal Decision, together with copies of the evidence submitted to OHIM in relation to the Community Application was received on 11 February 2009. The Hearing Officer did not agree that this enabled him to waive the objection in the United Kingdom. Although the OHIM Board of Appeal considered that there had been sufficient use of the mark throughout the European Territories he did not consider that there had been sufficient use in the United Kingdom; that nothing in the evidence showed that the average consumer would see

the colour red as indicating trade origin or that the applicants had actively promoted the colour red as indicating trade origin.

16. On 8 June 2009 a notice of refusal was issued.

The Decision

17. The only ground for refusal is section 3(1)(b) which reads:

“Grounds for refusal of registration

3- (1) The following shall not be registered –

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

18. Section 3(1)(b) has been summarised by the ECJ 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* [2003] RPC 45 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."

The prima facie case

19. Although colours *per se* are capable of being trade marks within the meaning of Section 1(1) of the Act, such signs are, in general, ill adapted for such a purpose because colour is routinely and almost unavoidably used for decorative and marketing purposes. In my experience the general public do not usually rely on colour for the purpose of distinguishing the trade origin of the goods.

20. The European Courts position regarding marks comprising a single colour has been summarised in Case C-104/01: Reference to the Court under Article 234 EC by the Hoge Raad der Nederlanden (Netherlands) for a preliminary ruling in the proceedings pending before that court between Libertel Groep BV and Benelux-Merkenbureau, on the interpretation of Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40,

1. A colour per se, not spatially delimited, may, in respect of certain goods and services, have a distinctive character within the meaning of Article 3(1)(b)

and Article 3(3) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, provided that, inter alia, it may be represented graphically

2. In assessing the potential distinctiveness of a given colour as a trade mark, regard must be had to the general interest in not unduly restricting the availability of colours for the other traders who offer for sale goods or services of the same type as those in respect of which registration is sought.

3. A colour per se may be found to possess distinctive character within the meaning of Article 3(1)(b) and Article 3(3) of Directive 89/104, provided that, as regards the perception of the relevant public, the mark is capable of identifying the product or service for which registration is sought as originating from a particular undertaking and distinguishing that product or service from those of other undertakings.

4. The fact that registration as a trade mark of a colour per se is sought for a large number of goods or services, or for a specific product or service or for a specific group of goods or services, is relevant, together with all the other circumstances of the particular case, to assessing both the distinctive character of the colour in respect of which registration is sought, and whether its registration would run counter to the general interest in not unduly limiting the availability of colours for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought.

5. In assessing whether a trade mark has distinctive character within the meaning of Article 3(1)(b) and Article 3(3) of Directive 89/104, the competent authority for registering trade marks must carry out an examination by reference to the actual situation, taking account of all the circumstances of the case and in particular any use which has been made of the mark.

21. In considering the above I do not consider the case for prima facie registration of the mark has been made. The purchasing public, whether for specialised goods or

those routinely used in homes, do not normally rely on colour to indicate a trade source of goods. All goods are produced in a certain colour, or colours, but this does not mean that those colours will distinguish those goods as originating from a particular trade source. At the point of sale the average consumer is likely to ask for goods by their trade name and not their colour. In my view the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark

The case for acquired distinctiveness

22. The guiding principles to be applied in determining whether a mark has become distinctive through use are to be found in *Windsurfing Chiemsee Produktions v Huber* [1999] E.T.M.R. 585.

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that 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 hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

23. I also bear in mind Morritt LJ's observation in *Bach and Bach Flower Remedies Trade Mark* [2000] RPC 513 at para 49 stating that:

“..... use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have any materiality.”

24. The question therefore is not the quantitative amount of use made by an applicant, but whether that use generates customer recognition of the sign as an indicator of trade origin.

The initial evidence

25. The initial evidence submitted included a witness statement which showed that sales figures of the goods sold under the mark are substantial (the turnover in 2002 was in excess of £41,000,000). But mere use alone does not suffice. Has the use been ‘material’ in terms of transforming the colour red from just a colour used on the goods to an indication of origin recognised by the average consumer? The literature provided, in the form of the applicant’s brochures and promotional material, show that the goods and much of the literature is coloured red, but it also shows that the goods have the trade mark HILTI prominently placed upon them. There was nothing in the evidence to show that the applicants have promoted the colour red as an indicator of trade origin and the examiner did not consider the mark had become distinctive because of the use made of it.

Trade Evidence

26. Following rejection of the initial evidence the agent went on to submit trade evidence in the form of letters from various trade organisations. All these letters are very similarly worded and claim that the particular colour red (pantone C32) has become synonymous with the goods sold by Hilti. The examiner did not consider this helped the case as it only shows that the colour is recognised by trade associations, who should be knowledgeable of their particular market. It does not indicate that the average consumer recognised the colour as being a trade mark of Hilti.

Survey Evidence

27. The agent then submitted survey evidence. A questionnaire was sent to 100 people taken from the applicant's own data base. 19 of those contacted responded, of which 16 indicated that they recognised that where the colour was used in relation to tools (or related goods) – the goods originated from Hilti. The agent claims that this is an 84% recognition rate which is "impressive". However the response rate was not high, and as those contacted were already on the applicant's database one would expect them to be aware that Hilti used the colour red on their goods. This further evidence was not considered by the examiner to indicate that the average consumer would be aware that Hilti used the colour red on their goods or that the average consumer would consider the colour red to indicate the trade source of the goods. The examiner maintained the objection.

Acceptance at OHIM

28.. The identical mark has been accepted at OHIM (3425311) on the basis of distinctiveness acquired through use at the first Board of Appeal. Decisions of other national tribunals/courts within the EU may be of persuasive value in determining the registrability of a particular trade mark. This has been affirmed by the ECJ in [Henkel KGaA v Deutsches Patent und Markenamt \(C-218/01\)](#) where it was stated that:

“ The fact that an identical trade mark has been registered in one Member State for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark. On the other hand, the fact that a trade mark has been registered in a Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark application for registration of a similar mark for goods or services similar to those for which the first mark was registered.”

29. The evidence submitted to OHIM confirmed that there has been considerable turnover generated throughout the EU countries and in certain areas (Germany for example) advertising expenditure was considerable. This may have led the Board of Appeal to accept the mark on the basis of distinctiveness acquired through use. I do not think that this shows that the average consumer, who could be the trade but also the general public, in the United Kingdom recognises the colour red as indicating trade origin.

Conclusion

30. 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 and that the evidence submitted has failed to do this. I therefore conclude that the mark applied for is devoid of any distinctive character and is excluded from prima facie acceptance under Section 3(1)(b) of the Act.

32. 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 6th day of October 2009

Linda Smith
For the Registrar
The Comptroller-General

SAMPLE QUESTIONNAIRE

Name

Company

Position in Company

Please look at the trade mark shown below



- i) a) Would you consider the use of colour in relation to tools (or related equipment) to indicate that they originate from any particular company

.....

b) If so which company

.....

---- ii) How long have you known of this trade mark

- iii) Do you feel that use of this trade mark in relation to tools (or related equipment) by a different company to that named above would be likely to cause confusion to consumers?

.....

iv) What specific type of products do you associate with this mark?