

O-120-10

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 2487128
IN THE NAME OF TEGOMETALL (INTERNATIONAL) AG
IN RESPECT OF THE TRADE MARK "TEK" IN CLASSES 6 AND 20**

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 83401
BY WUPPERMANN AG**

TRADE MARKS ACT 1994

**IN THE MATTER OF Registration 2487128
in the name of Tegometall (International) AG
in respect of the trade mark TEK in Classes 6 and 20**

and

**An application for a declaration of invalidity thereto
under no 83401
by Wuppermann AG**

BACKGROUND

1) Tegometall (International) AG (“Tegometall”) is the proprietor of the above trade mark. It originally applied for a Community Trade Mark (“CTM”) on 2 July 1999. This was subsequently converted to a German national application and to a UK national application. The UK mark is registered and these proceedings relate only to this.

2) The registration is in respect of the mark TEK and it completed its registration procedure on 28 November 2008 and covers the following list of goods and services:

Class 06

Shelves and parts of shelves, in particular hanging baskets for shelves, all the aforesaid goods of metal and not of imitation wood.

Class 20

Shelves and parts of shelves, in particular hanging baskets for shelves, all the aforesaid goods not of wood or imitation wood.

3) On 30 January 2009, Wuppermann AG (“Wuppermann”) applied for the above registration to be declared invalid. Wuppermann’s claim is that the mark offends against Section 3(1) (b) and 3(1) (c) of the Trade Marks Act 1994 (“the Act”) on the grounds that it is phonetically and conceptually identical to the word TECH which is widely understood and appreciated by the average UK consumer as an abbreviation for the word “technology” and/or “technical”. It claims that the term TEK is also wholly non-distinctive because it is a commonly used abbreviation which other traders might legitimately wish to use to promote competing goods and is, therefore, not capable of distinguishing the goods of one party from those of another.

4) Both Tegometall and Wuppermann filed evidence and Wuppermann also made numerous submissions in its application to invalidate. I will refer to the evidence and submissions, as appropriate, in my decision. Both sides also seek an award of costs.

Neither party requested a hearing and, after a careful consideration of the papers, I give this decision.

DECISION

The legislation

5) Section 3(1) (b) and Section 3(1) (c) of the Act are relevant in invalidation proceedings in view of the provisions of Section 47(1) of the Act, the relevant parts of which read:

“**47.** - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

...

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.”

6) Section 3(1) (b) and Section 3(1) (c) of the Act read:

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

(a) ...

(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,

(d) ...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (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.

Section 3(1) (c)

7) There are now a number of judgments from the European Court of Justice (ECJ) which deal with the scope of Article 3(1) (c) of First Council Directive 89/104 (recoded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1) (c) of the Community Trade Mark Regulation (“the CTMR”), whose provisions correspond to Section 3(1) (c) of the UK Act. 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* – Case 191/01P (*Doublemint*) paragraph 30;

- thus Articles 7(1)(c) (Section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM*, paragraph 31;

- 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;

- an otherwise descriptive combination may not be descriptive within the meaning of Article 3(1) (c) of the Directive provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word trade mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark – *Postkantoor*, paragraph 99.

8) Section 3(1) (c) of the Act 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.

9) Julie Kay of Marks & Clerk LLP, Wupperman's representative in these proceedings, gave a witness statement dated 20 July 2009 and which provides evidence at Exhibit JK1 in the form of a printout from the website of the Office for Harmonization in the Internal Market (“OHIM”), the trade mark office of the European Union, showing that the base CTM, from which the UK registration has been derived, was cancelled following an

invalidation action before the OHIM. I note this, as I do the grounds for that invalidation, namely that the word TEK means "teakwood" in Italian and French. I must consider the mark as viewed by the relevant public in the UK and as such, the circumstances regarding the cancellation of the base CTM were different to the current proceedings.

10) Ms Kay submits that the goods, the subject of Tegometall's registration, are technical goods. She contends that shelves are, by definition, a physical set of components, mechanically joined, which fit together in a technical way and are, therefore, a mechanical system that has a technical nature or characteristic. In support of this contention, Ms Kay refers to the following text that appears in the Trade Marks Registry's Work Manual:

"TECH

An accepted abbreviation for "technology" (Collins English Dictionary) which is objectionable under Section 3(1)(b) and (c) when **used in combination** [my emphasis] which is an appropriate description. TEC and TEK should be similarly treated as they are phonetically identical. Acceptable in combination with non-technical goods. So POOLTEC (swimming pools), SEALTEC (seals) have been accepted. Has also been accepted for some technical goods where other word is not quite the name of the goods, eg TILLTEC (tilling machines). HI-TEC and NUTECH (new tech) have been refused. COMPUTER TEC, NETWORK TECH would also be refused."

11) Firstly, the work manual is intended to be a guide for trade mark examiners during the initial examination of trade mark applications and the guidance provided may not be appropriate for inter parte proceedings such as this. I am, therefore, not bound by it. Secondly, the practice referred to relates only to the use of TECH, TEC or TEK *in combination* with an appropriate description. The mark at issue in these proceedings is the word TEK solus. It is not in combination with another word, descriptive or otherwise. As such, the practice is not relevant to these proceedings. Thirdly, I note Ms Kay's contention that shelves are technical products. I do agree that shelves are a physical set of components mechanically joined to fit together, but despite having some technical aspects, they are not the type of goods that consumers regard as being technological. The consumer is familiar with making a distinction between goods that are low-tech, such as the goods at issue here, and goods that are high-tech in nature. Shelves are made from simple structures that are fastened together and/or to walls by means of mechanical fixings and the term TECH or its phonetic equivalents such as TEK will not have any meaningful significance in respect of designating a characteristic of the goods as it would when used in respect of high tech goods such as computers for example. Further, no evidence has been put forward to support the contention that the goods in question are technical in nature. Finally, the misspelling will not go unnoticed by the consumer and neither will the fact that TEK appears alone and in abstract and not in combination with descriptive matter.

12) The remainder of Ms Kay's evidence takes the form of identifying earlier cases, some of which have resulted in marks including the term TEK being refused registration. I summarise these cases below:

Case details	Mark details	Relevant findings
UK Opposition No. 46425	JET-TEK	<i>"TECH, TEC or TEK will be understood by most consumers to be an abbreviation of the word "technical"</i>
OHIM Board of Appeal Case R 826/2004-1	CYBERTEK	<i>"...the term TEK is a misspelling of the English abbreviation TECH, which is the abbreviation for TECHNICAL or TECHNOLOGY... The misspelling of that term will not affect the attitude of the average general consumer, who, in the present context, will immediately and directly remark the association of the term TEK with the word TECHNICAL and TECHNOLOGY... ...THE TERMS cyber and TEK, either separately or combined, must remain unhindered and free so that suppliers and competitors on the market may at any time promote and market their own goods by means of a descriptive reference to the kind and purpose of their goods using a combination of terms and in the claimed sign..."</i>
OHIM Board of Appeal Case R 391/2004-4	TRACETEK	<i>"...the combination of the two elements "TRACE" and "TEK" each of which lacks distinctive character individually, is nothing more than the sum of its two component parts"</i>

13) I am not bound by such case law. Nevertheless, I will make some general comments. Firstly, I note that all these cases relate to marks consisting of TEK in combination with other material and, as such, are not on "all fours" with the current case. Secondly and significantly, the context in which the OHIM's Board of Appeal found TEK to be descriptive was different than in the current case. This is because, in the case of the decision relating to the CYBERTEK mark, the goods claimed were computers, computer programs and related apparatus. In the TRACETEK case, the goods included various electronic test and measurement devices. In respect to the UK proceedings regarding the mark JET-TEK, I note that the attack based upon Section 3 of the Act was unsuccessful. In all three of these cases, the goods concerned can be described and understood by the consumer as being high-tech goods where, undoubtedly, the term TEK may have a more descriptive significance.

14) In summary, I am not persuaded by these earlier refusals. Further, the term TEK solus is more abstract than when combined with an additional and descriptive element, the misspelling of TECH is noticeable and, in respect of the relevant goods, memorable given that the relevant goods are not high tech products. Taking all of this into account, I

find that the word TEK, when used in respect of the goods listed in Tegometall's specifications, does not designate a characteristic of those goods. The ground of invalidation based upon Section 3(1) (c) of the Act is therefore dismissed.

Section 3(1) (b)

15) The approach to be adopted when considering the issue of distinctiveness under Section 3(1) (b) of the Act has been summarised by the ECJ in its judgment in *Linde AG, Windward Industries Inc and Rado Uhren AG* Joined Cases C-53/01 to C-55/01:

“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*, 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.”

16) There is no requirement for a mark to possess a specific level of linguistic or artistic creativity or imaginativeness. 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 services and thereby to distinguish them from other undertakings. In *SAT.1 Satelliten Fernsehen GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-329/02* the ECJ provided the following guidance:

“41 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.”

17) In paragraph 70 of *Cycling Is... Trade Mark*, [2002] R.P.C. 37, Mr Hobbs QC indicated that:

“The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect”.

18) I must, therefore, put myself in the place of someone who encounters the mark TEK, used in relation to the goods listed in paragraph 2 and determine how they would react. TEK is, as demonstrated in the evidence, a recognised abbreviation of the ordinary English words “technology” and “technical” but in respect of the relevant goods, I have already concluded that they are not high tech in nature and would not be perceived, by the relevant consumer, as being “technological” . As such, the word TEK does not convey any specific meaning. Such a conclusion also takes account that the mark is a misspelling of the word TECH and that the mark consists of the term alone and not in combination with descriptive matter which may, in certain circumstances, reduce or remove any distinctive character that resides in the term TEK alone.

19) I am inevitably drawn to the conclusion that the average consumer “who does not know there is a question” would not consider TEK to be devoid of any distinctive character for this limited list of goods and would have no reason to suppose that it could not function as an indication of origin. As such, I find that the grounds based upon Section 3(1) (b) of the Act must also be dismissed.

20) Wuppermann’s invalidation action therefore fails in its entirety.

Costs

21) The invalidation action having failed, Tegometall is entitled to a contribution towards its costs. I take account of the fact that no hearing has taken place but that it did file written submissions in lieu of attendance. I award costs on the following basis:

Considering Notice of invalidation and statement of case in reply	£300
Preparing evidence & considering other side's evidence	£750
Filing written submissions	£400
TOTAL	£1450

22) I order Wuppermann AG to pay Tegometall International AG the sum of £1450. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20 day of April 2010

**Mark Bryant
For the Registrar
The Comptroller-General**