TRADE MARKS ACT 1994

IN THE MATTER OF
APPLICATION NO. 2236189B
BY NICHOLAS ANDREW CLARKE & LESLEY ANNE GALE CLARKE
TO REGISTER A
TRADE MARK IN CLASSES 3, 8 AND 21

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DECISION AND GROUNDS OF DECISION

On 15th June 2000, Nicholas Andrew Clarke & Lesley Anne Gale Clarke applied under the Trade Marks Act 1994 under application no 2236189 in classes 3, 8, 9, 10, 11, 16, 18, 21 and 26, to register the following four trade marks as a series:

BAGS OF STYLE

Bags of Style by Nicky Clarke

NICKY CLARKE
BAGS OF STYLE

BAGS OF STYLE
NICKY CLARKE

Objections were taken against the marks under the following sections of the Act:

Section 41(2):

because the marks do not form a series;

Section 3(1)(b) and (c):

because the first mark consists of the words "bags of style" being a sign which may serve in trade to designate, for example, very stylish goods;

Section 5(2):

This objection was overcome by assignment action and I need make no further mention of it in this decision.

A hearing was appointed at which the applicant was represented by Mr H Nicholas Matthews of Prentice & Matthews and the objections were maintained.

Subsequent to the hearing, the application was divided into two parts, namely 2236189A and 2236189B. Application no 2236189A proceeded in respect of the three marks which included the name "Nicky Clarke" whilst application no 2236189B was limited to the first mark BAGS OF STYLE and its statement of goods was limited to as follows:

Class 3:

Soaps; perfumery, essential oils, cosmetics, hair lotions, dentifrices; toilet preparations; preparations for the care of the skin, scalp and the body; suntanning preparations; preparations for reinforcing and strengthening nails; preparations for use in the bath; oil, gel and foam preparations for use in the shower and the bath; preparations for toning the body; all being non-medicated; milks, oils, creams, gels, powders and lotions; shaving foams; toilet waters; shampoos; preparations for use on or in connection with the hair; depilatories, cleansing masks for the face; reconditioning phials; eyestylers; eye make-up remover; nail polish, nail base coat, nail varnish remover; cuticle lotions, nail revitalising lotions, bronzing creams, conditioners, dyes, colourants, tints, bleaching preparations; preparations for the care and beauty of the hair, hair waving and hair-setting preparations.

Class 8:

Non-electric hair care products; hair clippers; non-electric hair curling implements; scissors; non-electric hair styling implements; non-electric hair waving apparatus; hair removing devices; hair cutting apparatus.

Class 21:

Combs and sponges; brushes; comb cases, soap boxes and toilet utensils.

The division of the application enabled me to waive the objection raised under Section 41(2) and I need make no further mention of it in this decision.

Following refusal of application no 2236189B under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to provide a statement of the reasons for my decision.

Mr Matthews argued at the hearing that whereas the mark might be an apt description for articles of clothing or used to describe a person, one would not use BAGS OF STYLE when referring to, for example, shampoos or hair products. Although the mark appears superficially descriptive, it does not say anything about the goods. Mr Matthews contended that the decision in the CHIN CHIN trade mark (1965 RPC 136) supported the case for acceptance.

These arguments did not persuade me that the mark is of sufficient distinctive character to qualify for registration.

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

The relevant part of the Act under which the objection was maintained is as follows:

> *Section 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 mark consists of the phrase "bags of style" which does not require further definition by reference to a dictionary. In correspondence I informed Mr Matthews that I thought is was clear that BAGS OF STYLE would be used to convey something which has plenty of style. I take the view that when the mark is viewed in the context of the goods listed in the restricted specifications, it designates various characteristics of the goods. As well as denoting quality, the mark also describes the intended purpose of the goods in the sense that it gives the impression that customers who use the applicant's personal grooming products will acquire "bags of style". Moreover, I cannot overlook the use of such a phrase in the promotion of the goods. In this regard, I take particular note of the comments in the unreported decision of Simon Thorley QC (as appointed person) in the DAY BY DAY trade mark (application no 2068646). He commented:

> *"In my judgement, Mr James correctly submitted that I should have regard not only to natural use on packaging but also to natural use in the context of advertising ....."*.

and

> *"The hearing officer was satisfied that the mark might serve to designate the time of delivery of goods or their qualitites. I have concluded that this objection to registration is well founded since I am satisfied that the expression "Day by Day" could naturally be used by traders descriptively to indicate those attributes. I believe the examples referred to above demonstrate this. I accept that these are examples of non-trade mark use but that is precisely what section 3(1)(c) is directed against. Put compendiously, this sub-section is directed against the registration of descriptive marks"*.

Furthermore, in the AD2000 trade mark (1997) RPC 168, Geoffrey Hobbs QC said:

> *"Although section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse registration of signs which are excluded from registration by the provisions of section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the*

1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacob Esq QC in his decision on behalf of the Secretary of State in Colorcoat Trade Mark [1990] RPC 511 at 517 in the following terms:

"That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see eg Yorkshire Copper Work Ltd's Trade Mark Application (1954) RPC 150 at 154 lines 20-25 per Viscount Simonds LC. Essentially the reason is that the privilege of a monopoly should not be conferred where it might require "honest men to look for a defence"."

Having decided that the mark fails to qualify under Section 3(1)(c) of the Act, it follows that the mark is devoid of any distinctive character and also fails to qualify under Section 3(1)(b) of the Act. The test for distinctiveness was clearly set out by Mr Justice Jacob in the British Sugar PLC and James Robertson and Sons Ltd (TREAT) decision (1996) RPC 281:

"Next, is "Treat" within Section 3(1)(b). What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned ("North Pole" for bananas) can clearly do. But a common laudatory word such as "Treat" is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word inherently from the old Act but the idea is much the same) devoid of any distinctive character."

In my opinion the public would require educating that the phrase BAGS OF STYLE is a badge of origin.

Mr Matthews referred to the registration of the mark CHIN CHIN (for alcoholic beverages) and contended that it supported the case for acceptance of his client's mark. I did not accept that argument. In the CHIN CHIN decision (1965 RPC 136), on appeal to the Board of Trade, Dr Atkinson (for the registrar) conceded that the mark was registrable in Part B of the register but Mr S E Matthews (representing the applicant) pursued Part A acceptance. G W Tookey QC, hearing the appeal, noted the registrar's discovery of a label mark for CHIN CHIN which had been registered for over fifty years and it appears that this had some influence on the acceptance of the mark. In any event, each case must be dealt with on its own merits. Mr Justice Jacob in the British Sugar PLC and James Robertson and Sons Ltd (TREAT) decision (1996) RPC 281 said:

"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 that 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 MADAME trade mark (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence."

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) and (c) of the Act.

Dated this 11TH day of July 2001.

Charles Hamilton
For the Registrar
the Comptroller General