

TRADE MARKS ACT 1994

AND

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996
IN THE MATTER OF INTERNATIONAL REGISTRATION No 892990
AND THE REQUEST BY C R MEDIA PTE LTD
TO PROTECT A TRADE MARK IN CLASS 16**

Background

1. On 22 December 2006 CR Media PTE Ltd, Block 1008, Toa Payoh North #07-11, Singapore 318996, Singapore, on the basis of International Registration 892990, requested protection in the United Kingdom under the provisions of the Madrid Protocol of the following mark:

AUGUST

2. Protection is sought in Class 16 in respect of:

Magazines, published and printed matter.

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 is devoid of any distinctive character for e.g. printed publications focussing upon past/future events occurring in the month of August and is therefore unlikely to be perceived by the average consumer as a sign which indicates trade origin. The minimal stylisation present in the mark is not considered to be sufficient to render it to be distinctive.

4. Following a hearing, which was held on 18 April 2007, at which the applicant was represented by Mr Halstead of Wynne-Jones, Laine & James, their trade mark attorneys, the objection under Section 3(1)(b) of the Act was maintained.

5. Notice of refusal was issued under Article 9(3) and I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

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

The Law

7. Section 3(1)(b) of the Act reads as follows:

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

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

The case for Registration

8. At the hearing, Mr Halstead submitted that the Section 3(1)(b) objection raised against the mark is unfounded and said that the average consumer would not expect a publication bearing the word August to relate to the month of August. My attention was drawn to the fact that the word August has two meanings and it was submitted that in practice, it is more likely that the average consumer would not perceive the mark to be a month of the year but rather that it would be perceived as the alternative meaning i.e. ‘dignified’ or ‘imposing’.

9. Additionally, extracts from the Internet relating to a publication titled “January” were provided by Mr Halstead at the hearing. My attention was drawn to the fact that this particular publication did not relate to the month of January and it was submitted that the word January functions as a distinctive trade mark in relation to the goods.

10. Mr Halstead finally submitted that one would not expect to purchase a magazine that related to the month of August and pointed out the fact that the examiner had not backed up the objection by showing examples of such use.

Decision

11. The approach to be adopted when considering the issue of distinctiveness 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 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 observed 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 or 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.”

12. Section 3(1)(b) of the Act prohibits (*prima facie*) the registration of trade marks which are devoid of any distinctive character. Its purpose is to prohibit registration of marks which do not fall foul of the clear parameters set by Sections 3(1)(c) and (d) of the Act but, nevertheless, still do not fulfil the function of a trade mark because they do not identify goods and services from one undertaking from those of other undertakings.

13. It is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the goods in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. In relation to these goods I consider the average consumer to be the general public and organisations of varying sizes. The purchasers, and potential purchasers, of the goods in question purchase them because they satisfy their own personal requirements regarding the benefits they offer.

14. In respect of the goods in class 16, I consider the objection under Section 3(1)(b) of the Act to be relevant. This is because in my view, the average consumer of these goods, on seeing the slightly stylised word AUGUST as the title of a publication would expect such a publication to be an August edition and to contain information relating to events taking place during that particular month of the year.

15. Mr Halstead has suggested that the average consumer would be more likely to see the word AUGUST as meaning ‘dignified’ or ‘imposing’ but I disagree with this view on the basis that use of the word AUGUST in this way appears to be somewhat archaic. With this in mind I maintain my view that it is far more likely that the mark would be perceived as a month of the year.

16. I am not persuaded by the Internet extracts relating to a publication titled ‘January’ which were intended to demonstrate that a calendar month is distinctive in relation to the goods and therefore capable of indicating trade origin. Although it has been pointed out to me that the publication in question does not actually relate to the month of January, I am of the opinion that the perception of the average consumer would be that it did.

17. Regarding Mr Halstead’s submission that the examiner has not backed up the objection by showing examples of use of the mark, I would say that it is not a requirement under Section 3(1)(b) of the Act to provide details of such use.

18. In my view, the relevant consumer of the goods would perceive this mark as no more than an indication of a monthly edition of a publication, specifically an August edition, which may contain information on events occurring during that month. I am not persuaded that the mark is bestowed with distinctive character to the extent that it becomes capable of performing the function of a trade mark. In order to do that the sign must guarantee that the goods originate from a single undertaking.

19. I am not persuaded that the trade mark applied for is distinctive in that it would serve in trade to distinguish the goods of the applicant from those of other traders. 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. I therefore conclude that the mark applied for is devoid of any distinctive character in respect of the goods applied for and is thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

Conclusion

20. In this decision I have considered all the documents filed by the applicants 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) of the Act.

Dated this 8th day of February 2008

**K J STEPHENS
For the Registrar
The Comptroller-General**