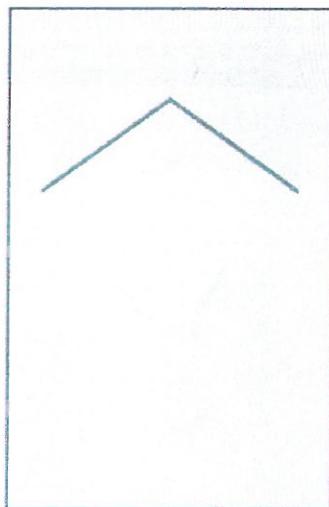




**IN THE MATTER OF APPLICATION NO. 53,135
BY PHILIP MORRIS PRODUCTS S.A.
TO REGISTER THE TRADE MARK**



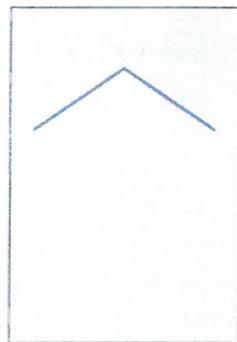
**IN CLASS 34
AND IN THE MATTER OF OPPOSITION NO. 32/TM2009
BY BRITISH AMERICAN TOBACCO (BRANDS) LIMITED**

IN THE MATTER OF APPLICATION NO. 53,135
BY PHILIP MORRIS PRODUCTS S.A.
TO REGISTER A TRADE MARK IN CLASS 34
AND IN THE MATTER OF OPPOSITION NO.32/TM2009
BY BRITISH AMERICAN TOBACCO (BRANDS) INC.

DECISION AND REASONS FOR DECISION

The Application

1. On the 10th of December, 2008, Philip Morris Products, S.A., through its agents, Livingston, Alexander & Levy, Attorneys-at-Law, (hereinafter referred to as “the Applicant”) applied under the Trade Marks Act 1999 (hereinafter referred to as “the Act”) for registration of the trade mark titled “Finger Print Label with the Roof”:



2. The Application related to class 34 in respect of:

“Tobacco, raw or manufactured; tobacco products, including cigars, cigarettes, cigarillos, tobacco for roll your own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, kretek; tobacco substitutes (not for medical purposes); smokers articles, including cigarette paper and tubes, cigarette filters, tobacco tins, cigarette cases and ashtrays, pipes, pocket apparatus for rolling cigarettes; lighters; matches.”

3. The Trade Marks Registry on the 24th of March, 2009 accepted the mark for publication. The application was subsequently published in the Jamaica Gazette dated the 4th of June, 2009, with an applicable publication date of July 21, 2009.

Grounds of Opposition

4. A Form TM 4 – Notice of Opposition accompanied by the Statement of Grounds of Opposition was filed on September 21, 2009 by Myers, Fletcher & Gordon, Attorneys-at-Law, on behalf of British American Tobacco (Brands) Inc. (hereinafter referred to as “the Opponent”).
5. According to the Statement of Grounds (hereinafter “the Opponent’s Grounds”) filed, the Opponent opposes the proposed registration of the trade mark on the following grounds:
 - i. the Applicant’s mark does not satisfy the definition of “trade mark” appearing in Section 2(1) of the Trade Marks Act, and so the Applicant’s mark is not registrable based on Section 11(1)(a) of the Act;
 - ii. The Applicant’s trade mark is devoid of any distinctive character and so is not registrable based on Section 11(1)(b) of the Act; and
 - iii. The Applicant’s trade mark consists of a sign which has become customary in the trade of goods covered by class 34, including tobacco, tobacco products, and accessories, and thus is not registrable based on Section 11(1)(d) of the Act.
6. Form TM 5 and Grounds in support of Counterstatement were filed on behalf of the Applicant on October 14, 2009.
7. The Applicant denied all the statements and allegations set out in the Opponent’s Grounds of Opposition. In particular, the Grounds stated that the Applicant’s “FINGER PRINT LABEL WITH ROOF”:

- i. is a graphically represented design, capable of distinguishing the goods of the Applicant from those of other traders with respect to goods in class 34;
- ii. is a distinctive trade mark, consisting of the unusual and imaginative combination of a finger print pattern together with the Applicant's signature "MARLBORO ROOF DEVICE" trademark, a trademark distinctive of no other trader but the Applicant and registered in Jamaica and the world over; and
- iii. is not, and contains no element which is customary to the trade of goods in class 34.

Evidence

Opponent's Evidence

- 8. On March 9, 2010, the Opponent filed Statutory Declarations of Clyde Elliott Woods and Michael George Bernard in support of the Opposition.
- 9. Mr. Clyde Elliott Woods is an Authorised Attorney of the Opponent. In his first Declaration sworn to on the 8th of March, 2010 he states *inter alia* that:
 - i. The mark in question is a simple geometric form commonly used in relation to tobacco products both in Jamaica and worldwide, and as such cannot perform the function of a trademark as the consumer will not be able to perceive the mark as indication of the origin of the product;
 - ii. Trademarks of the Opponent and affiliate companies, registered around the world, contain a similar geometric shape in addition to a more distinctive element, most often a house mark/ brand name which clearly indicate the origin of the product;

- iii. Applicant's mark contains no distinctive elements which would distinguish it from other similar designs and thus, fails to indicate the origin of the product;
 - iv. The geometric mark registered by the Applicant should not be monopolized by a single trademark proprietor as others in the industry must remain able to use such a design and, more generally, it must remain available to the public;
 - v. The Applicant's monopolization of this geometric mark would hamper the development of brands in the Jamaican marketplace and confuse the public in relation to the ownership and source of origin of the trademark.
- 10. Attached to Mr. Woods' Declaration were the following exhibits:
 - i. An image on the Jamaican Trade Mark Application 53,135 for an "Inverted V Design" ("FINGER PRINT LABEL WITH ROOF") in the name of Phillip Morris Products S.A. (Exhibit A);
 - ii. Samples of trade mark registrations in Class 34, as registered by subsidiary companies of the British American Tobacco Group of companies (the "BAT Group") of which the Opponent is a member, all of which consist of similar geometric forms to the "FINGER PRINT LABEL WITH ROOF" (Exhibit B); and
 - iii. Samples of trade mark registrations in Class 34 in the name of different proprietors (external to the BAT Group) compiled through the trade mark search engine CT Corsearch as well as images of cigarette packs sold in different countries, all of which also consist of similar geometric forms to the "FINGER PRINT LABEL WITH ROOF" (Exhibit C).
- 11. Mr. Michael Bernard is the Managing Director of Carreras Limited of St. Catherine, Jamaica (hereinafter "Carreras"). In his Declaration sworn to on the 8th of March, 2010 he states *inter alia* that:

- i. Carreras is in the business of manufacture, importation and sale of cigarettes in Jamaica since 1963, and up to 2005, was the sole manufacturer of cigarettes in Jamaica until its manufacturing operations were transferred to Trinidad and Tobago;
- ii. Carreras' customers in Jamaica include wholesalers and retailers in all parishes of Jamaica;
- iii. He has been employed to Carreras for over 20 years, been Managing Director since 1995, assisted the Government in developing strategies for tobacco taxation and against illicit trade and that, by virtue of his work experience and responsibilities, he is an expert in matters related to the Jamaican market for cigarettes and related products and is recognised as Jamaica's primary source of information and expertise for the cigarette industry;
- iv. Carreras' sales income from cigarettes in Jamaica was \$11.625 billion in 2008;
- v. The Applicant's mark is very generic and totally unimaginative and will be ineffective in communicating any information to Jamaican consumers of cigarettes about the origin of the products;
- vi. The background to the Applicant's mark is not likely to have an impact on cigarette consumers, as such consumers usually focus on distinguishing and clear images; the faint background has no distinctive feature and neither does the two diagonal lines appearing in the foreground;
- vii. In Jamaica, the most important features of a trade mark for cigarettes are the word mark by which the product is identified and clear imagery; Jamaican consumers will not likely consider the trademark distinctive, nor will they have the ability to distinguish the goods of one trader from those of another;
- viii. Jamaican smokers will not be able to identify the Applicant's mark as a distinguishing mark for cigarettes and other tobacco products.

12. In his second Declaration sworn to on the 25th of July, 2011 in response to the Affidavit of Jan Vidjeskog for the Applicant, Mr. Clyde Woods states *inter alia* that:
- i. The mark as applied for bears very little similarity to the Applicant's "Roof Device" Trade Mark No. 53,261;
 - ii. The Affidavit of Jan Vidjeskog is misleading or otherwise incorrect in that it refers to characteristics of Trade Mark No. 53,261 and not the Application No. 53,135, which unlike Trade Mark No. 53,261 has no repeated waves as a background forming a distinctive fingerprint-like pattern;
 - iii. The average consumer does not observe each individual composite element of a trade mark but views the mark as a whole and consequently is not likely to associate the simple inverted "V" with the Applicant or the Applicant's Roof Device;
 - iv. The declaration by Mr. Vidjeskog as to the distinctive and famous nature of the Roof Device worldwide and in Jamaica is based on his personal view and not on any trade mark research.

Applicant's Evidence

13. On the 2nd of December, 2010, the Applicant filed the Affidavit of Jan Vidjeskog. Mr. Vidjeskog is Senior Counsel of the Applicant. In his Affidavit sworn to on the 15th of November, 2010 he states *inter alia* that:
- i. The Applicant's mark includes the Applicant's famous MARLBORO Roof Device trademark, a sign which has been registered in Jamaica under number 48,542 since April 26, 2006, and which has been and continues to be used extensively in Jamaica and worldwide by the Applicant, its affiliates or licensees, and is in and of itself a distinctive trademark. Consequently, the result of adding other distinctive elements to this trademark in the form of the "FINGER PRINT LABEL WITH THE ROOF" must necessarily be the creation of another distinctive mark;

- ii. The Applicant's mark is complex and distinctive as the design consists of repeated waves as a background forming a distinctive fingerprint-like pattern, and the 'Inverted "V"' is a highlighted segment of the Applicant's MARLBORO trade mark, being the downward pointing peak of the five sided device. There are two sides extending vertically from the outermost tips of the peak to a flat, horizontal top which encloses the 5 sided shape being the Roof device;
- iii. The roof design is clearly visible when the "FINGER PRINT LABEL WITH THE ROOF" trade mark is looked at as a whole, and therefore consumers would associate this trade mark with the Applicant and its famous MARLBORO Roof Device;
- iv. The Roof device can be seen in constant use by itself, as it is a distinctive house mark of the Applicant, and has become so famous in Jamaica and worldwide that it does not have to be used in conjunction with the trademark MARLBORO or any other MARLBORO branding in order to signify the Applicant to the public as the source of origin of the goods;
- v. The Applicant's "FINGER PRINT LABEL WITH THE ROOF" trade mark is not, and contains no element which is customary to the trade of goods in class 34, because the Roof device element of the Applicant's "FINGER PRINT LABEL WITH THE ROOF" is in fact distinctive of the Applicant and no other trader;
- vi. The Applicant's mark has been deemed distinctive in several countries across the world as is evidenced by the Applicant's registration of the mark in countries around the world, including Anguilla, Argentina, Armenia, Aruba, Australia, Bolivia, British Virgin Islands, Chile, Dominica, Honduras, Hong Kong, Japan, Mexico, Montserrat, New Zealand, Philippines, Russia, Saudi Arabia, St. Kitts-Nevis, St. Lucia, St. Vincent, Switzerland, Turkey, Turks & Caicos and WIPO, and receipt of an official examination letter from

- the Community Trademark Registry confirming that this mark has been accepted as inherently distinctive in the European Union;
- vii. There is absolutely no need for any other trader of goods in class 34 to remain free to use any element of the Applicant's "FINGER PRINT LABEL WITH THE ROOF" trade mark;
- viii. The Applicant's mark satisfies all criteria for registration under the Trade Marks Act and accordingly, the Opposition filed herein is without merit, and ought to be dismissed.
14. Attached to Mr. Vidjeskog's Affidavits were the following exhibits:
- i. Copies of the "FINGER PRINT LABEL WITH THE ROOF" trademark and the incorporated MARLBORO Roof Device (Exhibit A);
 - ii. Photographs taken at promotional events in Jamaica which prove that the device is used by itself (Exhibit B);
 - iii. A full list of cigarette packs which are currently on the market in Jamaica (Exhibit C);
 - iv. The Applicant's Trademark Status Report by Jurisdiction (Exhibit D); and
 - v. Copies of the official registration certificates for the "FINGER PRINT LABEL WITH THE ROOF" trade mark from Anguilla, Argentina, Armenia, Aruba, Australia, Bolivia, British Virgin Islands, Chile, Dominica, Honduras, Hong Kong, Japan, Mexico, Montserrat, New Zealand, Phillipines, Russia, Saudi Arabia, St. Kitts-Nevis, St. Lucia, St. Vincent, Switzerland, Turkey, Turks & Caicos and WIPO, and the official examination letter from the Community Trademark Registry confirming that this mark has been accepted as inherently distinctive in the European Union (Exhibit E).

The Opposition Hearing

15. The Opposition Hearing was held on the 6th of December, 2012 before me acting for the Registrar of Industrial Property. Mrs. Kathryn Pearson, Attorney-at-Law instructed by Livingston, Alexander & Levy, appeared for the Applicant. Mrs. Andrea Scarlett-Lozer, Attorney-at-Law instructed by Myers Fletcher & Gordon, appeared for the Opponent. At the hearing both parties presented written as well as oral submissions and several authorities. Decision was reserved.
16. Based on the Notice and Statement of Grounds filed by the Opponent, the Applicant's mark was opposed on the following three grounds:
 - i. pursuant to s. 11(1)(a) of the Act;
 - ii. pursuant to s. 11(1)(b) of the Act;
 - iii. pursuant to s. 11(1)(d) of the Act.

s. 11(1)(a) and (b) – signs which do not satisfy the definition of “trade mark,” and trade marks devoid of any distinctive character respectively

17. In relation to the first and second Grounds of Opposition, ss. 11(1)(a) and (b) provide that:

“Subject to subsection (2), the following are not registrable under this Act –

- (a) signs which do not satisfy the definition of “trade mark” appearing in Section 2(1);*
- (b) trademarks which are devoid of any distinctive character;”*

Section 11(2) provides that:

“A trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) of subsection (1) 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.”

18. Subsections 11(1)(a) and (b) of the Act are equivalent to Article 7(1)(a) and (b) of Council Regulation (EC) 40/94 of the European Union and Subsections 3(1)(a) and (b) of the United Kingdom Trade Marks Act 1994 as part of the global efforts to harmonize trademark laws. Consequently, case law decided under both legislations is persuasive.
19. If a mark consists exclusively of signs which are customary under section 11(1)(d), it would necessarily be devoid of distinctiveness under section 11(1)(b) and incapable of satisfying the definition of a trade mark under section 11(1)(a). However a mark that is devoid of distinctiveness will not necessarily fall afoul of section 11(1)(d). Additionally, it is recognised that if a mark is distinctive, then it would be treated as capable of distinguishing the goods or services of one undertaking from another.

Section 11(1)(a): Does the mark satisfy the definition of a trademark?

20. A trademark is defined by section 2 (1) of the Act as "*any sign that is capable of being graphically represented and of distinguishing the goods or services of one undertaking from another.*" In order to satisfy the definition of a trademark therefore, three elements must be satisfied:
 1. the mark must be a sign;
 2. the mark must be capable of being graphically represented; and
 3. the mark must be capable of distinguishing the goods or services of one undertaking from another.
21. A sign is defined by section 2 (1) of the Act to include "*a word (including a personal name), design, letter, numeral, colour, combination of colours or a combination of the foregoing or the shape of goods or their packaging*". It is clear that a sign can consist of a letter alone or a combination of a letter and design. The Applicant's sign can be and has been graphically represented as contained in the Trade Mark Application No. 53,135. The question is whether the Applicant's mark is capable of distinguishing the goods or services of one undertaking from another.

22. As stated in *Kerly's Law of Trade Marks and Trade Names* (13th ed.) at paragraph 7-36, if the trade mark is devoid of distinctive character, then it is incapable of distinguishing the goods of one undertaking from another. As a result, the examination of the conformity of Applicant's mark to both sections 11(1)(a) and 11(1)(b) may be conflated to a determination of whether the mark is devoid of distinctive character.

Section 11(1)(b): Is the Applicant's mark devoid of distinctive character?

23. A mark is “devoid of any distinctive character” if it is not inherently distinctive or it has not acquired distinctiveness through use. The Applicant sought registration for the mark on a *bona fide* intention to use basis and there is no evidence of use of the mark prior to the date of application or registration in Jamaica. Therefore, it is not necessary to analyze whether the mark has acquired distinctiveness through use.
24. It is well settled in the European case law that a mark is distinctive when it serves to identify the product, for which registration was sought, as originating from a particular undertaking, and, consequently, distinguishing that product from products of other undertakings. (Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* [2004] ECR I-5173, paragraph 32; Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 46).
25. Distinctive character must be assessed, first, by reference to the products or services in respect of which registration has been applied for and, second, by reference to the perception of the relevant public (see Joined Cases C-473/01 P and C 474/01 P *Procter & Gamble v OHIM*, paragraph 33; and Case C 25/05 P *Storck v OHIM* [2006] ECR I 5719, paragraph 25).

26. Jacob J. in *British Sugar v. James Robertson & Sons* [1996] R.P.C. 281 at 306 illustrated the above test by asking the following question: Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public?
27. The following principles are instructive when assessing distinctiveness:
 - (a) It is clear from the wording of 11(1)(b) that a minimum degree of distinctive character is sufficient to avoid refusal on those grounds; therefore, it is only necessary to examine whether the mark is capable of enabling the public concerned to identify the manufacturer of the product and differentiating the same product from other products of different manufacturers. Furthermore, it is not necessary for a mark to convey exact information about the identity of the manufacturer (Case C-144/06 P *Henkel KgaA v OHIM* [2007] ECR I-08109, paragraph 25; *Unilever NV v OHIM* [2004] E.T.M.R. at page 18, paragraph 43 it is not necessary for the mark);
 - (b) the overall impression of the mark must be considered as the average consumer normally perceives a mark as a whole and does not proceed to analyze its various details, though, it may be useful to examine each of the constituent features of the trademark. (Case C-144/06 P *Henkel KgaA v OHIM* [2007] ECR I-08109, paragraph 39; Case C-286/04 P *Eurocermex v OHIM* [2005] ECR I-5797, paragraphs 22 and 23; Case C-251/95 *Sabel BV v Puma AG* [1997] ECR I-06191, paragraph 23);
 - (c) The average consumer is reasonably well informed and reasonably observent and circumspect (Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraphs 30 to 32). The way in which the public concerned perceives a trade mark is influenced by the average consumer's level of attention, which is likely to vary according to the

category of goods or services in question (see Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26).

28. The mark in question, a “FINGER PRINT LABEL WITH THE ROOF”, is described by the Applicant as a composite of a “complex and distinctive” finger print design and the Applicant’s famous MARLBORO “5-sided rooftop design”.
29. The Opponent disagrees with the Applicant’s description of the mark and categorizes it instead as an “Inverted-V” design. The Opponent also argued that, unlike Trade Mark No. 53,261 which has repeated waves as a background forming a distinctive fingerprint-like pattern, Trade Mark Application No. 53,135 does not have that fingerprint background.
30. In addition, the Opponent asserted that the ‘fingerprint label’, which at the hearing the Opponent referred to as “spotted background design” is not registrable as it is devoid of distinctiveness; that it looks like a feature of the paper or packaging material that would be used for the products but not as an indication of trade origin; is so faint that a consumer may on occasion not even notice its presence; and is likely to serve only an ornamental or functional purpose in the trade. The Opponent cites *Glaverbel v OHIM* [2002] ALL ER (D) 111 in support of its position. The Opponent thus argued that the substance of the Applicant’s trademark is the ‘Inverted V’ which is devoid of distinctive character as it is a geometric shape which lacks creativity, imagination, originality with no capricious addition or other characteristic.
31. The Applicant, however, states that the Opponent's categorization is incomplete because the "Inverted-V" is in actuality a part of the Applicant's trademarked "Roof" design, which itself does not exist on the Applicant's subject trademark application without the fingerprint pattern that forms the background of the figurative mark. The two vertical sides and the horizontal

top are made visible by the contrasting directionality of the fingerprint pattern which flows away from and to each vertical side and the horizontal top.

32. The respective goods for which the application is sought are tobacco, tobacco products & accessories. The question that follows then is whether the Applicant's trade mark will enable the consumer to identify the source of the above named goods and differentiate those from other goods produced by other manufacturers in class 34.
33. The Opponent has chosen to place emphasis on the "Inverted-V" because it is highlighted on the Applicant's figurative design by bold lines. These bold lines when analyzed in part form a 'V 'with its apex pointed upward, hence the "Inverted-V" description. In contrast, the purported other 3 sides of the "5-sided figure" are not emboldened. However, there are three identifiable features of the Applicant's trademark: the emboldened inverted-V, the curved lines as a wavy "fingerprint" background, and the contrasting curved lines surrounding the Applicant's 5-sided roof design.
34. I understand the Opponent's comparison of the Trade Mark application No. 53,135 and Trade Mark No. 53,261, as the latter does more clearly show the fingerprint background. Nonetheless, the fact is that Trade Mark application No. 53,135 does have a fingerprint background as well, albeit not as clearly defined as in Trade Mark No. 53,261.
35. What then is the perception of the average consumer? The average consumers for the respective goods are cigarette smokers. The Opponent asserts that the Jamaican cigarette smoker will not be able to use the Applicant's trademark to identify the manufacturer of the product or differentiate the product from other cigarette packets in the market because it is too simple and because the word mark is important to the perceptions of the Jamaican cigarette smoker.

36. As evidence for this assertion, however, the Opponent relies only on the Statutory Declaration of Michael Bernard as a purported expert on the Jamaican cigarette industry. There is no marketing study or consumer survey though, that displays the opinions of the Jamaican cigarette smoker themselves. Consequently it is not verifiable whether the Jamaican cigarette smoker will not be able to perceive the Applicant's figurative mark as a trademark of MARLBORO.
37. In light of the well-informed and circumspect competency of the Jamaican cigarette smoker, and in the absence of evidence to the contrary, I am unable to find that the Jamaican cigarette smoker would not be able to differentiate the Applicant's product from other cigarette packets in the market.
38. Even if the Jamaican cigarette smoker would not be able to recognise or identify the Opponent's rooftop mark with the mark as applied for, the Opponent has not shown where the Opponent's fingerprint design is devoid of distinctiveness in the eyes of the average consumer. In the *Glaverbel* case the examiner and the Court of First Instance of the European Communities refused the application on the basis that the mark lacked inherent and acquired distinctiveness. The mark in that case was applied to glass which formed part of the product's surface and which altered depending on the angle it was viewed. The Court found that while the public is accustomed to perceiving word or device marks as instantly identifying trade origin, the public is not accustomed to regarding designs applied to the surface of glass as an indication of trade origin and that therefore the mark would not be recognisable by the public as an indication of origin but a functional component. The case is therefore distinguishable from the instant case.
39. There is no rule that geometric shapes are not registrable. Section 11(3) prohibits the registration of shapes which are wholly descriptive of the goods themselves, or functional, or have eye appeal (see Kerly's 13th Ed., para. 7-09). It is noted that the Opponent did not oppose the application on any of

those grounds. Neither is any particular creativity, imagination, originality, capricious addition or other characteristic necessary to ground distinctiveness. As already stated, letters by themselves are signs. However, as already emphasised, the instant mark does not consist exclusively of the 'Inverted V'.

40. When one looks at the overall impression of the mark, including the fingerprint design and the 'Inverted V', and the five-sided figure which is apparent as a result, there is definitely a more than minimum level of distinctiveness that would enable the consumer of cigarettes to identify the product as originating from the Applicant and which would enable the mark to be registrable. Even looking at the individual components of the mark, I find that the fingerprint component alone could be seen by the public as an indication of trade origin.I do not agree that it looks like a feature of the paper or packaging material that would be used for the products and that it is likely to serve only an ornamental or functional purpose in the trade, nor is there evidence from consumers that they would see it that way. I find that in light of the extensive use of the 'V' and the 'Inverted V' in the industry, then it alone may not be registrable and I say "may" cautiously as I have not been asked to decide on the registrability of a mark consisting exclusively of an 'Inverted V' in Class 34. That is not the mark before us.

s. 11(1)(d) –signs or indications which have become customary in the *bona fide* and established practices of the trade

41. In relation to the third Ground of Opposition, s. 11(1)(d) provides that:

"trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade."

42. In support of this ground, the Opponent exhibited many images of cigarette packaging which includes a ‘V’ or an “Inverted V” along with other distinctive elements. However the Applicant’s mark does not simply consist of an “Inverted V” as the Opponent suggests. The Opponent argued that based on the customary nature of the ‘Inverted V’ and the faint background fingerprint design being hardly noticeable, the mark was caught by section 11(1)(d). However, as explained above, although faint, the fingerprint design is recognisable and distinctive and therefore the mark overall is distinctive and registrable. The Opponent has not shown where the fingerprint design is customary in the bona fide and established practices of the trade in Jamaica.

Conclusion

43. The Opposition is therefore refused, on the basis that:
- i. the mark is capable of distinguishing the goods of one undertaking from those of another, in relation to the goods for which it was applied for in Class 34 and therefore does not contravene section 11(1)(a) of the Act;
 - ii. the mark is not devoid of distinctive character and therefore does not contravene section 11(1)(b) of the Act;
 - iii. the mark is not customary in the bona fide and established practices of the trade in Class 34 goods and therefore does not contravene section 11(1)(d).
44. The Applicant’s mark shall be registered in Class 34 for the goods specified in the Trade Mark Application No. 53,135.
45. There is no Order as to costs.

Marcus Goffe
for Registrar of Industrial Property
April 28, 2014