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Jamaica Intellectual Property Office

IN THE MATTER OF APPLICATION NO. 55,219
BY BRITISH AMERICAN TOBACCO (BRANDS) INC.
TO REGISTER THE TRADE MARK



IN CLASS 34
AND IN THE MATTER OF OPPOSITION NO. 111/TM2010
BY PHILIP MORRIS PRODUCTS S.A.

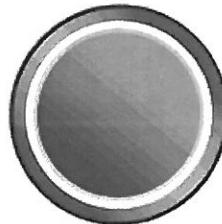
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DECISION AND REASONS FOR DECISION

The Application

1. On the 23rd day of February 2010, British American Tobacco (Brands) Inc., through its agents, Myers, Fletcher and Gordon, 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 following trade mark (which it refers to as “BULLS EYE Logo”):



2. The Application relates to the following class and goods:

34 - Cigarettes; tobacco; tobacco products; lighters; matches; smokers' articles.

3. As a result of the evidence submitted by the Applicant's Attorneys-at-Law, the Trade Marks Registry on the 3rd day of July, 2010, conditionally accepted the mark for publication. The application was subsequently published in the Jamaica Gazette dated the 2nd day of September, 2010.

Grounds of Opposition

4. A Form TM 4 - Notice of Opposition accompanied by a Statement of the Grounds of Opposition was filed on November 16, 2010 by Livingston, Alexander & Levy, Attorneys-at-Law, on behalf of Philip Morris Products S.A. (hereinafter referred to as “the Opponent”).
5. According to the Statement of Grounds filed, the Opponent opposes the proposed registration of the trade mark (which it refers to as “CIRCULAR Logo”) on the following grounds:
 - i. the trade mark is a simple and basic geometric form, and a generic shape which is commonly used on the labeling of goods. Unlike complex geometrical forms, simple and basic geometrical shapes such as squares, rectangles, triangles, oval and circles, cannot be registered as trademarks because they lack distinctive character, and do not qualify for trademark protection.
 - ii. The trade mark does not satisfy the definition of a “trade mark” set out in section 2 of the Act, as it is not capable of distinguishing the goods of the Applicant from those of another undertaking. Accordingly, the registration of the trade mark is prohibited by section 11 1(a) of the Act.
 - iii. The trade mark is devoid of distinctive character, and accordingly the registration thereof is prohibited by section 11 1(b) of the Act.
 - iv. The trade mark consists exclusively of a sign/indication which has become customary and common in the *bona fide* and established practices of the trade of goods in class 34. Accordingly, the registration of the mark is prohibited by section 11 1(d) of the Act.
6. A Form TM 5 - Counterstatement and Grounds in support of the Counterstatement with attached Exhibit B1 were filed on behalf of the Applicant on December 21, 2010.

7. The Applicant denied all the statements and allegations set out in the Opponent's Grounds of Opposition. In particular, the Applicant stated that:
- i. the trade mark is not a simple and basic geometric form, nor a generic shape, but "a design that has a number of peculiarities that make it identifiable as a trade mark and clearly identifiable as being associated with the Applicant's products and its corresponding business.;"
 - ii. the design of the mark comprises four concentric circles radiating from a central disc and that the variation in colour, width and shades demonstrate clear distinctive elements;
 - iii. the mark is entirely fanciful, arbitrary and unconventional, not indicative of the goods claimed and not commonplace, usual, descriptive or functional in the tobacco industry;
 - iv. the trade mark meets the definition of a "trade mark" under the Act;
 - v. the trade mark has acquired distinctiveness through use in Jamaica and in several countries around the world; the Applicant referred to its several registered trade marks designated "LUCKY STRIKE & device" (Exhibit B1) and stated that the device element of the "BULL'S EYE Logo" is a derivative and substantially similar to the device element of the "LUCKY STRIKE & device" mark which is highly recognizable to consumers of goods in Class 34;
 - vi. the "BULL'S EYE" device is not customary or common in the trade of Class 34 goods.

Evidence

Opponent's Evidence

8. On the 23rd day of September, 2011 the Opponent filed the Affidavit of Maximilien Yaouanc in support of the Opposition with attached Exhibits MY-1 through to MY-4.

9. Mr. Maximilien Yaouanc is the Senior Counsel Trademarks with PMI Global Services Inc., a US Corporation and affiliated company of the Opponent and is in charge of trademark matters for the Opponent in the Latin America & Canada Region, which includes Jamaica. In his Affidavit sworn to on the 7th of September, 2012 he states *inter alia* that:
- i. the Applicant's proposed trade mark "merely consists of shaded concentric circles" and is "nothing unusual, unconventional or distinctive", consisting of a "basic and unimaginative geometric figure which is inherently incapable of [indicating] source for consumers."
 - ii. the alleged "peculiarities" that exist on the mark would not be readily apparent to consumers;
 - iii. there are numerous print outs at the Jamaica Intellectual Property Registry showing circular devices, including those with concentric circles that are "extremely common features" of registered trademarks as displayed in Exhibit MY-1;
 - iv. Brascuba S.A., licensed by Habanos S.A., sells a tobacco product in Jamaica with a circular device as displayed in Exhibit MY-2;
 - v. other goods traded in class 34 of products have trade marks that utilize circular devices as part of their labeling and/or get up, as displayed in Exhibit MY-3;
 - vi. the Opponent has opposed the registration of the Applicant's mark in 33 countries and decisions were pending in all except Colombia where the Applicant's trademark was rejected because it "did not have the distinctive strength" to allow "the consumer to see such a graphic representation" and "determine a specific business origin." The Colombian decision was attached as Exhibit MY-4.
 - vii. the Applicant's proposed trademark has not acquired distinctive character. The reputation that the Applicant associates with its proposed mark is due to the prominent and distinctive "LUCKY STRIKE" word mark and without those words, the BULL'S EYE shape lacks distinctive character.

10. On the 19th day of September, 2012 the Opponent filed the Statutory Declaration of Maximilien Yaouanc, with attached exhibit MY-1, in response to the April 20, 2012 Statutory Declaration of Stuart Paul Aitchinson on behalf of the Applicant, wherein he states *inter alia* that:
- i. the Opponent had filed over fifty (50) oppositions against the Applicant's "CIRCULAR Logo" device worldwide, and had received a favourable decision in New Zealand where the New Zealand Intellectual Property Office found that "if the opposed mark were registered, honest traders would effectively be hindered in using any concentric circle(s);"
 - ii. although the Applicant indicates that the "BULL'S EYE Logo" is a derivative trademark from its device used along with the words "LUCKY STRIKE", the Opponent notes that the words "LUCKY STRIKE" were not used in the subject mark as depicted in the application;
 - iii. the Applicant offered circumstantial evidence as it relates to the LUCKY STRIKE name, or the LUCKY STRIKE brand only. The applicant failed to provide evidence proving that the relevant consumers in Jamaica will perceive the circular design, apart from the name and the overall architecture of the LUCKY STRIKE brand, as an indication of the Applicant's goods;
 - iv. also, the Applicant's evidence always features the mark in colour and not in the black and white tone of the mark which has been applied for registration;
 - v. the Applicant offers publications that assert the global reputation of the LUCKY STRIKE brand but does not state whether these publications were ever circulated in Jamaica. Also, the "LUCKY STRIKE" brand displayed contains the word mark and is displayed in brand colours and thus has no probative value;

- vi. the Applicant offers sales figures and advertisement expenditures for "LUCKY STRIKE" brand cigarettes, but these worldwide figures fail to show the extent to which sales and promotion concern the subject application per se;
- vii. the Applicant offers materials pertaining to its now defunct Formula 1 BAR Team which, in the vast majority of the evidence provided, features the "LUCKY STRIKE" brand with said word mark and in the brand colour; in addition the Applicant provides no evidence that the relevant Jamaican consumers were ever exposed to such material;
- viii. the mark should be denied registration on the ground that it is non-distinctive.

Applicant's Evidence

11. On the 20th day of April, 2012 the Applicant filed the Statutory Declaration of Stuart Paul Aitchinson, who is the Trademark Manager of the Applicant. In his Declaration signed on the 12th day of April, 2012 he states *inter alia* that:

- i. the Applicant is part of the British American Tobacco p.l.c (BAT) group which, through its affiliates, distributors, licensees and related companies, has been engaged in the manufacture, sale and distribution of cigarettes and tobacco products for over 100 years in over 180 countries;
- ii. the "BULL'S EYE Logo" has been assessed and accepted by Fifty-Five (55) trade mark examining and registration authorities across the world as displayed in Exhibit B1, including the United Kingdom and the European Community, who as parties to the Paris Convention for the Protection of Industrial Property have similar trademark jurisprudence regarding trade mark distinctiveness as Jamaica. Copies of Applicant's trade mark accepted for registration by the United Kingdom and European Community are attached as Exhibit B2.

- iii. The Applicant's BULL'S EYE Logo is a derivative trade mark from its very reputable device usually used along with the words "LUCKY STRIKE". The BULL'S EYE device is a dominant feature of the "LUCKY STRIKE & Bull's Eye device" brand and has been an essential element of the trade mark since at least 1924. The Voges Tobacco Encyclopedia states LUCKY STRIKE is an American Blend cigarette that launched in 1916; see Exhibit B3.
- iv. The "LUCKY STRIKE" brand is sold in the Jamaican duty-free market and sales figures for the period July 2005 through to March 2012 are displayed at Exhibit B4.
- v. The "LUCKY STRIKE & Bull's Eye device" brand is renowned worldwide and in 1996 was listed as the third most famous tobacco brand in the world by "The World's Greatest Brands" with annual sales in excess of 21,000,000,000 cigarettes from 1997 to 2011; annual revenue in excess of 242 million pounds sterling from 2000 to 2009; and advertising and promotional expenditures in excess of 116 million pounds sterling from 1997 to 2002. (See Tables 1 - 3 in the body of the Declaration and Exhibits B5 and B6.)
- vi. The architecture of the LUCKY STRIKE brand has undergone various changes but despite these changes the BULL'S EYE device has always remained a distinguishing feature of the trade mark. (See Exhibit B7.)
- vii. Further, the device has been used as a standalone trade mark, as part of the sponsorship of the BAR Formula 1 Motor Racing team. The BULL'S EYE device was used in clothing designs and associated merchandise, as part of a 100 million pound promotional strategy geared at taking advantage of the massive worldwide event that is Formula 1 racing with aggregate global audiences estimated at around 600 million persons per race. (See Exhibits B8, B9, B10 and B11.)
- viii. The Applicant submits that the massive international use and exposure of the BULL'S EYE device has made it distinctive to consumers separate from the other elements in the "LUCKY STRIKE & Bull's Eye device" brand architectures of the Applicant's goods.

The Opposition Hearing

12. The Opposition Hearing was held on the 13th of October, 2013 before me acting for the Registrar of Industrial Property. Mrs. Andrea Scarlett-Lozer, Attorney-at-Law instructed by Myers Fletcher & Gordon, appeared for the Applicant. Mrs. Kathryn Pearson, Attorney-at-Law instructed by Livingston, Alexander & Levy, appeared for the Opponent. At the hearing both parties presented written as well as oral submissions and numerous authorities. Decision was reserved.
 13. Based on the Notice and Statement of Grounds filed by the Opponent, the Applicant's mark was opposed on the following four grounds:
 - i. it is comprised of simple, basic geometric shapes (circles) which cannot be registered because they lack distinctive character;
 - ii. pursuant to s. 11(1)(a) of the Act;
 - iii. pursuant to s. 11(1)(b) of the Act;
 - iv. pursuant to s. 11(1)(d) of the Act.
 14. In their written submissions presented before me at the Opposition Hearing, the Applicant combined the Opponent's first and second Grounds of Opposition as follows:
 - i. Section 11(1)(a) of the Act - Trade Mark Non-distinctive because:
 - (i) the trade mark consists of simple and basic geometric shapes commonly used on the labelling of goods;
 - (ii) trade mark is not capable of distinguishing the goods on trade from another
- and further described the Opponent's third Ground of Opposition as:

- ii. Section 11(1)(b) of the Act - devoid of distinctive character.
15. Honing in on a central theme, the Applicant describes in their Opening Statement that the core issue of this case is "essentially about distinctiveness."
16. The Opponent, in their written submissions, appeared to agree with the Applicant and considered the first three Grounds of their Opposition to be similar and inclusive of the same issue: "the existence of distinctiveness."

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

17. A trade mark 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:

- i. the mark must be a "*sign*";
 - ii. the mark must be "*capable of being graphically represented*"; and
 - iii. the mark must be "*capable of distinguishing the goods or services of one undertaking from another*".
18. 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)*".
19. The subject matter trademark of Application No. 55219, described by the Applicant as the BULL'S EYE Logo and by the Opponent as the

CIRCULAR Logo, passes the first two limbs of the trademark definition quite easily. It is a "sign" as it is a design with concentric circles of various widths, shaded in a grey range from light grey to white to dark grey and, as displayed in the application, it is obviously "capable of being graphically represented".

20. In support of their positions both parties rely on the wording of ss. 11(1)(a) and (b) of the Act which 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."

21. 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 (hereinafter referred to as "the EU Act") and Subsections 3(1)(a) and (b) of the United Kingdom Trade Marks Act 1994 (hereinafter referred to as "the UK Act") as part of the global efforts to harmonize trademark laws. Consequently, case law decided under both legislations is persuasive.
22. Section 11(1) and the subsections included therein, are referred to collectively as absolute grounds for refusal, similar to 7(1) of the EU Act and 3(1) of the UK Act. According to *Kerly's Law of Trade Marks and Trade Name*, 13th ed., para. 7-28, page 149. These absolute grounds are exclusionary such that if a trade mark fails under any of those grounds, then the mark is non-registrable

unless saved by the section 11(2) proviso. The opposite, as the Applicant suggests, however is not true. It does not follow that if the Opponent fails under at least one of these grounds, the trade mark is then registrable. I am guided by *Kerly's Law of Trade Marks and Trade Names*, 13th ed. at para. 8-057 in relation to the interplay of the several absolute grounds as adopted in the JIPO Decision of *In the Matter of Application No. 50745 by Philip Morris Products S.A. To Register a Trade Mark in Class 34* JIPO [July 20, 2012](the "WIDES" case):

- i. each ground of refusal or invalidity operates independently of the others and calls for separate examination (the "POSTKANTOOR" case, paras. 67, 85);
 - ii. the applicability of any one of the specified ground is sufficient to prevent registration (the "COMPANYLINE" case, para 29);
 - iii. the inapplicability of one ground may coincide with the applicability of another (the "POSTKANTOOR" case, paras. 69).
23. Elucidating the above interplaying principles, if a mark consists exclusively of signs which are descriptive under section 11(1)(c) or 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). Conversely, a mark that is devoid of distinctiveness will not necessarily fall afoul of section 11(1)(d). Additionally, it is recognized that if a mark is distinctive, then it would be treated as capable of distinguishing the goods or services of one undertaking from another.
24. As a result, the examination of grounds for refusal under sections 11(1)(a) and 11(1)(b) may be conflated to a determination of whether the mark is devoid of distinctive character. Nevertheless, I will approach each ground of refusal separately, recognising that it is equally possible to read and combine the sections together as they are not mutually exclusive. Therefore, consistent with the approach taken by me in *In the Matter of Application No. 50745 by*

Phillip Morris Products S.A. (the WIDES case), I will determine the section 11(1)(b) and (d) grounds before determining the section 11(1)(a) ground.

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

25. It is well settled in the 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).
26. The essential function of a trademark, as delineated by the above test of distinctiveness, is to serve as an indicator of trade origin or as both parties have alluded to in their submissions, as a "badge of origin". Whether the mark is distinctive inherently then involves the corollary question: whether the mark is capable of conveying a message to the average consumer that the goods to which the mark is attached originated from a particular manufacturer. As such, the mark must be sufficiently memorable and eye-catching to enable the average consumer to repeat their purchasing experience if it was positive or avoid it, if it was negative, on occasion of subsequent acquisition.
27. Assessing the distinctive character of a mark begins, 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).
28. The standard for passing 11(1)(b) of the Act is low as it is clear from the legislative wording 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).

29. 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).
30. The average consumer is reasonably well informed and reasonably observant 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).
31. The mark in question is described by the Applicant as the "BULL'S EYE Logo" device. It has four concentric circles of various widths radiating outward from a central circular disc. Across the mark, the circles are shaded in varying grades of grey and white from dark to light to dark. The "BULL'S EYE Logo" device is a feature of the Applicant's famous composite "LUCKY STRIKE & bull's eye device" trade mark. Essentially, the Applicant seeks a trade mark in the device without the word mark.

32. The Opponent describes the Applicant's mark as a "CIRCULAR Logo" device that is a basic geometric shape and excessively simple. The Opponent further argues that it is merely a background device that functions as an outline or border for some other distinctive feature, specifically the word mark "LUCKY STRIKE" and that without said distinctive feature, the device by itself is not distinctive enough to pass the 11(1)(b) threshold.
33. The Applicant's mark is a figurative device and though it is comprised of a particular shape, that being multiple concentric circles, it must be noted that this circular shape is a 2-dimensional (2-D) shape design and not a 3-dimensional (3-D) shape design. While it is appreciated that it is not appropriate to apply more stringent criteria when assessing the distinctiveness of 3-D marks comprising the shape of the goods themselves or the shape of the packaging of those goods than in the case of other categories of marks (*T-88/00 Mag Instrument v OHIM* (Torch shape) [2002] ECR II-467, paragraph 32; and *Nestle Waters France v OHIM* [2004] ETMR 566, paragraph 35), it is accepted that it is more difficult to establish distinctiveness in relation to a 3-D shape of product mark than it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it denotes. That is because the perception of the average consumer is not necessarily the same in relation to a 3-D mark consisting of the appearance of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it denotes, as average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element (see *Henkel KgaA v OHIM* [2007] para. 36 and page 312 of *Bongrain South Africa's Trade Mark Application* [2005] R.P.C. 306 discussed further below).
34. The relevant goods in question for purposes of assessing distinctiveness are *cigarettes; tobacco; tobacco products; matches; smokers' articles* all found within class

34. The relevant public comprising the average consumer would be Jamaican cigarette smokers. As cigarettes are an "everyday, low-priced, convenience item purchased for immediate consumption" it can be assumed that the average cigarette smoker would pay a low level of attention to their purchases (see Case R-513/2011-2 *Societe des Produits Nestle S.A. v Cadbury Holdings Limited* [2012] OHIM Second Board of Appeal).
35. The Opponent has argued that the Applicant's trade mark is a mere background device to its "LUCKY STRIKE" word mark and is not distinctive on its own. Based on my reading of the cases however, the law does not suggest that a device is not distinctive simply because it appears to serve as the background in a composite mark. Also, the analysis of a composite mark being split into its component parts is apposite to the required analysis here. The law requires me to look at the overall impression of the mark as applied for and the message it conveys to the average consumer.
36. The Opponent further suggests that the Applicant's mark should be tested under the "significant departure test" as espoused by Bentley & Sherman in *Intellectual Property Law*, 3rd ed., pgs. 825 - 826. While this test does reinforce many of the principles mentioned above, it is unnecessary to apply it in this instance. The test as described in the *Bentley & Sherman* is most accurately applied to 3-D or the "shape of the goods" trade marks. In addition, as decided in the WIDES case "there is no requirement that the sign...differ from those which the relevant public view as being common in the trade. The sole question is whether the mark would be seen as a badge of origin...the standard is low."
37. The Opponent argues that the mark does not possess any memorable characteristics and that the "BULL'S EYE Logo" device is the non-distinctive feature of the "LUCKY STRIKE & Bull's Eye device" brand. The Opponent referred me to the 1996 UK Trade Marks Registry Work Manual

page 35 where it explains that a background comprising a simple diamond shape would not be accepted as distinctive because it is a mere diamond. The Opponent also directed me to a series of cases where the figurative device of a composite mark was viewed as being non-distinctive.

38. In *Electrical Protection Company (Proprietary) Limited's Application* [1967] R.P.C. 261, the UK Registrar dismissed the applicant's figurative device as being non-distinctive, stating at paragraph 11 of the judgement that "[t]he circle device, or device of circles, I am unable to regard as distinctive in itself in view of the common use by traders of circles as borders or outlines within which to display their trade mark or other matter." The Registrar's decision was notably overruled by the Board of Trade, who thought the composite mark was distinctive enough to be registered, a position they noted the Registrar agreed with before he inexplicably separated the mark into its component parts.
39. In *Elliot Machine Tools Ltd.'s Application* [1970] R.P.C. 79, the finding of the Registrar and the Board of Appeal revolved around what they considered to be the dominant feature of Elliot Machine Tools Ltd.'s composite mark, the "EME" word mark and not the background circular device, which was a single circular outline filled in with black. The Registrar dismissed the background because it was overshadowed by the "EME" word mark and analyzed the distinctiveness of the word mark alone. That case is however markedly different from the instant, in that the circular device there was a mere black circle, whereas the Applicant's mark here is a series of concentric circles of varying sizes and shading.
40. The other cases cited by the Opponent were *Bach and Bach Flower Remedies Trade Marks* [1999] R.P.C. 1, *Bongrain South Africa's Trade Mark Application* [2005] R.P.C. 306, *Union Laitiere Normande's Trade Mark Application* [1993] R.P.C. 87, *In Re Diamond T Motor Car Company* [1921] 2 Ch. 583 and *In the Matter of Ford-Werke AG's Application for A Trade Mark* (1995) 72 R.P.C. 191.

41. In *Bach and Bach Flower Remedies Trade Marks* [1999] R.P.C. 1, although the Judge found that there was “nothing particular remarkable” about the roundel device, he nevertheless found that it was capable of being a badge of origin. Again, the shapes in that mark were three simple perimeter circles and not multiple concentric circles with varied sizes and shading.
42. *Bongrain South Africa's Trade Mark Application* [2005] R.P.C. 306, mentioned earlier, involved an application for registration of a particular shape for cheese. It was refused which was upheld on appeal. That case differs from the instant in that it was a 3-D shape of goods mark. The case importantly is authority for the point that an unusual shape for the kind of goods concerned did not mean that the public would automatically regard it as denoting trade origin as the public is not used to shapes conveying trade mark significance; what matters is the presumed expectation of the average consumer.
43. The case of *Union Laitiere Normande's Trade Mark Application* [1993] R.P.C. 87 is helpful. There the applicants sought to register a device consisting of a pastoral landscape scene for dairy products. The application was refused on the basis that such scenes were commonly depicted in advertisements for the sale of dairy products and therefore were not inherently distinctive. Those facts are clearly distinguishable from this case as concentric circles are not commonly used by traders of class 34 goods in Jamaica (see paras. 55 and 66-68 below).
44. That case can be contrasted with *In Re Diamond T Motor Car Company* [1921] 2 Ch. 583 where the mark to be registered comprised the word “diamond” and the letter “T” in a diamond-shaped device, but there were already six marks on the register in the same class with diamond shaped borders. The Court found that although the diamond-shaped border was common to the trade, the mark was overall distinctive. In those circumstances the court disclaimed any exclusive rights to the simple diamond-shaped border.

45. *In the Matter of Ford-Werke AG's Application for A Trade Mark* (1995) 72 R.P.C. 191, the mark had the letters “F” and “K” written fancily, enclosed in two interlaced oval-shaped devices. The devices were held to be non-distinctive. Again, the instant case can be distinguished as the device in the instant case is not a simple geometric circle but has significant embellishments which in my opinion render it distinctive over and beyond the simple geometric circle.
46. Both parties are correct in asserting that basic geometric shapes are non-distinctive because they are excessively simple, a position the case law equally supports. See case T-304/05 *Cain Cellars, Inc. v. OHIM* [2007] ECR II-00112 where the European Court of Justice upheld the non-registrability of a mark that was simply the outline of a pentagon. In Case R-1483/2012-1 *Johnson Controls Technology Company v. OHIM* [2013], the OHIM First Board of Appeal upheld the non-registrability of a figurative mark in the shape of a slanting rain drop that the Board of Appeal described as having two straight lines that were cut from a rectangle placed in the upper left hand side of a circular line.
47. An excessively simple geometric shape such as a circle, a line, a rectangle or a conventional pentagon cannot perform the essential function of a trademark as being an indicator or a badge of origin. Rightfully so, there is nothing memorable about simple circles or rectangles that will allow a consumer to identify a good as originating from a particular manufacturer. It simply states to the average consumer, here is a circle or a square which, without more, is generally not distinctive.
48. A simple geometric shaped device, whether a background or not, with nothing more featured in its design, will not stand on its own, but a more elaborate and complex geometric design quite possibly could stand on its own if it were shown to be eye-catching and memorable (see *Johnson Controls Technology Company v. OHIM* [2013]). In *Nestle Waters France v OHIM* [2004] ETMR 566 it was stated at para. 40 that “a sign consisting of a combination of elements, each of which is devoid of any distinctive character, can be

distinctive provided that concrete evidence, such as, for example, the way in which the various elements are combined, indicates that the sign is greater than the mere sum of its constituent parts.”

49. The dicta of the court in *Bongrain South Africa's Trade Mark Application* [2005] R.P.C. 306 is useful. In a case that involved a trade mark application for the "shape of the goods", the Court of Appeal of the United Kingdom opined that there was a spectrum of distinctiveness for trademarks and that it was more difficult to register a trademark in the shape of a good because it lay at the end of the spectrum. However, invented words and fancy devices would be opposite as they were the "most distinctive", followed by semi-descriptive words and other devices.
50. I note also that in Case R 1176/2011-5 *Viatemis v Kissling Swiss Watches*, a 2013 Decision of the Fifth Board of Appeal of OHIM referred to by Counsel for the Applicant, a figurative sign comprising of a semicircle, a circle and a square, was described as “a complex geometric pattern” that was “original and fanciful and likely to make a strong impression on the mind of the consumer” (para. 43) as a result of the size and positioning of the shapes (para. 48). It was also held that since the figurative sign had no meaning in relation to the goods, it enjoyed average distinctiveness (para. 48). The case emphasised that where a sign consists of both figurative and verbal elements, it does not automatically follow that it is the verbal element which must always be considered to be dominant (para. 40).
51. The Applicant's mark is not merely a simple circle. It is a combination of different sized circles, with differing degrees of lined shading, ranging from dark grey to light grey to white to light grey to dark grey. The several concentric circles of varied sizes with varied shading, clearly renders the device distinguishable from a mere simple circle. I find the Applicant's device falls closer to the distinctive end of the spectrum, as it is clearly not the shape of the goods in question and is clearly a more fanciful device than a basic geometric shape. I thus find that the Applicant's BULL'S EYE logo device

mark, in and of itself and without the "LUCKY STRIKE" word mark, meets the minimum degree of inherent distinctiveness to be registered. The device is therefore capable of standing on its own as a badge of origin.

52. For those reasons and others I am not persuaded by the judgement of the Colombian Intellectual Property Office. In their opinion the Applicant's mark is a simple circular mark, when it clearly is not. How much this factored into their reasoning is unclear, as the description of the mark in their opinion did not match the illustration. What is obvious though is that the subject mark is not excessively simple: though it contains a geometric shape, it is designed in such a way as to not be basic.
53. The Colombian IP office believes the mark did not have the distinctive strength to be registered, as the average consumer would not see the figure as specific to a business origin and that it lacks the capacity to create a memory in relation to the products it claims it supports. As the standard for distinctiveness is low, I think a device with several concentric circles and varying tonalities meets such a low standard and is capable of performing the essential functions of a trade mark. I think the way in which the various elements are combined indicates that the sign is greater than the mere sum of its constituent parts. For that reason I disagree with the Colombian IP office's decision.
54. The decision of the New Zealand Intellectual Property Office ("NZIPO") in denying registrability of the Applicant's trademark stated that "the average consumer would need to be educated that the subject mark was a trade mark and was in fact the Applicant's trade mark." I disagree with the NZIPO as, in relation to Jamaica, I do not think that the BULL'S EYE device is so non-distinctive that the average Jamaican consumer would have to be educated first that such a mark could possibly be a trade mark. It does not strike me as the type of device that is only decorative in function.

55. Although in the Affidavit of Maximilien Yaouanc sworn to on the 20th of September 2011 the Opponent exhibited as "MY1" many trade marks from the Trade Marks Register in Jamaica which comprise circles, of 44 such marks exhibited (which include registered as well as removed marks), only two relate to class 34 goods (TM#14222 and TM#14223) and of those two, TM#14222 is owned by the Applicant and was removed from the Register in 2004 and TM#14223 was removed from the Register in 2005. It is clear therefore from the evidence presented by the Opponent that, unlike the device in *In Re Diamond T Motor Car Company*, circles are not a common device to class 34 goods in Jamaica. Similarly, Exhibit "MY2" of a circular device mark being used on Cuban tobacco products in Jamaica does not prove that the circular device is common to class 34 goods in Jamaica. The circular device marks used on tobacco products as exhibited in "MY3" also do not prove that the circular device is common to the trade in Jamaica.
56. The NZIPO in its Decision also stated that "if the opposed mark were registered, honest traders would effectively be hindered in using any concentric circle(s)". The NZIPO found, based on evidence provided, that prospective cigarette manufacturers are likely to use concentric circles of the type presented by the Applicant's mark. I am unconvinced by the lack of evidence presented before me that there are prospective cigarette manufacturers who use concentric circles designed similar to the Applicant's mark who may be hindered in using them.
57. I also do not accept that the registration of the Applicant's mark would necessarily prevent the registration by other cigarette traders of devices comprising circles. I do not agree that were other traders to seek to use or register their circular device marks in Class 34, they would be hindered in doing so by the Applicant's registration. Just as many registered marks have circular devices, as exhibited by the Opponent, each with its own sometimes distinctive sometimes generic look, none looking identical or similar to the Applicant's, similarly no trader has a monopoly in using circular devices for

its registered marks, so long as the same is not identical or too similar to existing marks which have circular devices therein.

58. I therefore agree in this regard with the reasoning of the Judge in *In Re Diamond T Motor Car Company* that “[i]t is in no sense a mark which would convey to the eye or ear of a purchaser that it is being used in a descriptive or laudatory sense, nor is it one which might reasonably be supposed to apply to [class 34 goods] generally. No person seeing it affixed to a [class 34 good] could in my opinion reasonably come to the conclusion that it was so affixed for any purpose other than to indicate that the [class 34 good] was manufactured by the proprietor of the mark and not by some other manufacturer.” (see pg. 590). Following the Judge’s reasoning, the use of similar devices on other marks “does not prevent the applicant’s mark... from being a mark which is likely to be actually distinctive of the applicant’s [goods]” (pg. 591).
59. Although there was no other ‘Diamond T’ mark in use in the trade, the Judge expressly rejected the argument that the registration of the mark would lead the public to believe that the applicant had obtained a monopoly in the use of that type of device (pg. 592-3). He reasoned that traders are unlikely, in the ordinary course of business and without any improper motive, to desire to use a ‘Diamond T’ mark identical with or resembling the Applicant’s mark, upon or in connection with the same class of goods as the Applicant (pg. 591 and 593). I similarly find that while it seems that some traders in Class 34 goods use circles in their trade marks, it is not a common practice in Jamaica and certainly no other marks comprising shaded concentric circles are registered in Jamaica in class 34.
60. Granting the Applicant registration of its mark is not to grant a monopoly in circular devices to the Applicant. However, it is unlikely that, in the ordinary course of business and without any improper motive, other traders of class 34 goods would use a circle device identical with or resembling the Applicant’s mark, upon or in connection with the same class of goods as the

Applicant. The dicta in *In Re Diamond T Motor Car Company* to that effect is exemplified in the case submitted by Counsel for the Applicant, *Prenatal S.P.A. via Tornese v Agatha Ruiz de la Prada*, where it was held that a mark comprising of a white heart within a black heart was distinctive enough to be registrable, despite the prior existence on the Register of a mark comprising a red heart with a white outline against an orange-coloured rectangular background. Therefore marks comprising geometric shapes can be distinctive from other marks comprising similar geometric shapes and can be registered. The public will not overlook the differences in how each mark and device is presented.

61. Having found that the Applicant's mark meets the minimum degree of inherent distinctiveness, there is no need to assess whether the mark has acquired distinctiveness through use as the Applicant also argued.
62. As a result of the foregoing reasons the Opposition fails under s. 11(1)(b).

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

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

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

(d) "trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bonafide and established practices of the trade."

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."

64. Whether a mark is customary can only be assessed by first, reference to the class of goods or services for which registration is sought and second, on the basis of the target public's perception of the sign (Case T-237/01 *Alcon Inc. v OHIM* [2003] ECR II-00411, [2004] ETMR 6 at para. 37; Case C-517/99 *Merz & Krell* [2001] ECR I-6959 at para. 31).
65. The target public's perception must be assessed by taking into account the level of attention that the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is likely to pay to the type of goods in question (see Case T-237/01 *Alcon Inc. v OHIM* [2003] ECR II-00411, [2004] ETMR 6, paragraph 38; Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26; Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraphs 30 to 32).
66. The targeted public comprises cigarette consumers in Jamaica and thus, the relevant trade in question is specific to Jamaica. The mark in question relates to cigarettes; tobacco; tobacco products; lighters; matches; smokers' articles in class 34 and the question whether the Applicant's mark is customary must be assessed in relation to those goods. As discussed earlier, of the numerous trademarks registered or formerly registered in Jamaica that the Opponent submitted through the affidavit of Maximilien Yaouanc, only two relate to class 34 goods. No evidence however, was led by the Opponent that these goods were in fact being sold in Jamaica under those marks. As stated previously, both those marks expired and were removed in 2004 and 2005 respectively.
67. There is therefore no evidence to prove that the Applicant's mark consists exclusively of a sign that has become customary in the current language or in the bona fide and established practices of the trade of class 34 goods in Jamaica. There is no evidence to suggest that there are other traders in Jamaica of class 34 goods who use circles, let alone the concentric circles of the type presented by the Applicant's mark. There is no evidence of the

concentric circle device being perceived by the public as customary in the trade of class 34 goods.

68. There were no sales figures presented as were used to invalidate Rugby Football Union's trade mark in *RFU & Nike v. Cotton Traders [2002] ETMR (76) 861*, where evidence of the sale of shirts bearing a rose crest indicated that it was customary to associate the rose with the England Rugby Team. Nor were there any representative customer surveys or even an opinion from a member of trade. Although such evidence would have low probative value if it came from the party making the claim, it has been held to be an underpinning minimum to show that a mark has likely become customary in the trade. See *In the Matter Of Application No. 299563 by the Number UK Limited to Register a Trade Mark in Classes 16 and 38*.
69. As a result the Opposition fails under section 11(1)(d) of the Act.

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

70. In light of my earlier findings that the mark is a sign, that is capable of being graphically represented, that is not devoid of distinctive character and has not become customary in the bona fide and established practices of the trade, I find that the mark is capable of distinguishing the goods of one undertaking from those of another and therefore does satisfy the definition of a trademark.
71. As a result the Opposition fails under section 11(1)(a) of the Act.

Conclusion

72. The Opposition is therefore refused on the basis that:
 - i. The mark is not devoid of distinctive character and therefore does not contravene section 11(1)(b) of the Act;

- ii. The mark has not become customary in the current language or in the bona fide and established practices of the trade in Jamaica and therefore does not contravene section 11(1)(d) of the Act; and
 - iii. The mark satisfies the definition of a trade mark and therefore does not contravene section 11(1)(a) of the Act;
73. The Applicant's mark shall be registered in class 34 for the goods specified in the Trade Mark Application No. 55,219.
74. There is no order as to costs.

Marcus Goffe
for Registrar of Industrial Property
December 29, 2014

**JAMAICA INTELLECTUAL
PROPERTY OFFICE**

