

Trade Mark Application
No. 15698 of 1996

IN THE MATTER of the Trade Marks
Ordinance (Cap. 43)

AND

IN THE MATTER of application No. 15698
of 1996 by N.V. Sumatra Tobacco Trading
Company of Indonesia to register the trade
mark "MEN" in class 34

**DECISION
OF**

Mr. Kestutis Stasys Kripas acting for the Registrar of Trade Marks after a request for Statement of Grounds of the Registrar's decision made by Messrs. Fairbairn Catley Low & Kong on behalf of the applicant.

1. On 13 December 1996, N.V. Sumatra Tobacco Trading Company of Indonesia ("the applicant") filed an application to register, in Part A of the Register, in class 34 the trade mark "MEN" in plain block capitals. After an authorised amendment to overcome a citation raised, the goods sought to be protected were :

Cigarettes, cigars; tobacco, excluding chewing tobacco; matches, lighters for smokers, smokers' articles; ashtrays not of precious metal for smokers; cigarette papers, tobacco pipes.

2. Objection was raised by the Registrar under the provisions of paragraphs (d) and (e) of section 9(1) of the Trade Marks Ordinance, Cap. 43 (the "Ordinance"), that the mark was indistinctive and descriptive of the goods. Furthermore it was determined that the mark was not inherently capable of distinguishing the applicant's goods from similar goods of others, contrary to section 10 of the Ordinance.

3. The applicant filed a considered reply arguing that the applied for goods are unisex products and unlike clothing, there is no distinction between cigarettes for men and cigarettes for women. That the word "MEN" does not convey any meaningful idea in relation to cigarettes and any reference [to the character or quality of the goods] is remote or indirect or not at all. The applicant argued that it was unlikely that other traders would use the word "MEN" in relation to cigarettes and the mark was therefore distinctive of the applied for goods. The Registrar did not agree and despite an informal discussion held on 18 November 1999, the Registrar maintained his objection. Pursuant to the provisions of section 13(4) and rule 20(2) of the Trade Marks Rules, the applicant has requested the Registrar to state in writing the grounds for his decision and the materials used by him in arriving at it. These are given as follows :

4. Section 9 is a restrictive provision. Registration in Part A can only be achieved if the mark contains or consists of at least one of the essential particulars listed in paragraphs 1(a) – (e) inclusive.

5. The word "MEN" is not the name of a company, individual or firm, represented in a special or particular manner within the meaning of section 9(1)(a) of the Ordinance; nor is it the signature of the applicant for registration or of some predecessor in his business within the meaning of section 9(1)(b) of the Ordinance. It is not an invented word within the meaning of section 9(1)(c).

6. I turn therefore to the question whether the word satisfies the requirements of section 9(1)(d) as "a word ... having no direct reference to the character or quality of the goods ...", the prohibition relating to the registration of geographical names or surnames not being relevant in the context of the mark applied for.

7. In *Mark Foy's Limited v Davies Coop and Company Limited* [1956] 95 C.L.R. 190 Dixon C.J. said "The test must lie in the probability of ordinary persons understanding the words, in their application to the goods, as describing or indicating or calling to mind either their nature or some attribute they possess" – p. 195.

8. In my judgment, the public at large, seeing or hearing "MEN" used in relation to cigarettes, cigars, tobacco and tobacco pipes might well understand it as indicating goods having real or imagined qualities rendering them suitable for men, such as the strength of the

cigarettes, the size of a cigar, the aroma of the tobacco or, in the case of a pipe, masculine styling. I have not seen how the mark is used, or is proposed to be used in relation to the goods and therefore have no reason to assume that the get-up of the goods would neutralize this ordinary signification of the word "MEN".

9. *Keystone Knitting Mills Ltd.'s Trade Mark* ("Charm") (1929) 45 R.P.C. 421 is authority for the proposition that, in considering whether a mark has reference to the character and quality of the goods, the mark must be looked at, "not in its strict grammatical signification, but as it would represent itself to the public at large" – Lord Hanworth M.R. at p. 426. The fact that a word is not adjectival in character does not indicate that it cannot be directly descriptive. The mark in that case was "charm" not "charming", yet attached to a packet of ladies stockings, Russell L.J. at p. 427 said, "it is quite impossible to say that the word "charm" has no direct reference to the character of the goods". To test this further, if a unisex sweatshirt was to be labelled "MEN", I have no doubt that an ordinary shopper would regard it as having been designed for the male physique and thus be unsuitable for woman. The mark here is "MEN" not "FOR MEN", nevertheless, applied to goods it would be understood by the ordinary shopper as if it were "FOR MEN", which of course is directly descriptive of the character of the goods.

10. The onus of establishing that the applied for mark has no direct reference to the character or quality of the goods lies with the applicant – Lloyd-Jacob J. in *American Screw Coy's Appln.* [1959] 14 R.P.C. 344. I am not satisfied that the mark does not have a direct reference to the character of the goods.

11. Even if I were wrong in the application of the correct legal principles to the question of the mark having no direct reference to the character or quality of the goods, nevertheless, before a word, can be accepted in Part A, it must not only qualify under paragraph (d), but it must also be distinctive. This principle is founded on the decision in *Fanfold Limited's Application* [1928] 45 R.P.C. 325, approved as recently as last year by the Court of Appeal in *Elvis Presley Trade Marks* [1999] R.P.C. 567. The principle was also succinctly stated in the "*Scotchlite*" case (*Minnesota Mining & Manufacturing Coy.'s Appln.* 65 R.P.C. 229) at page 232.

"So far as registrability under section 9 was concerned, the question for the Registrar were : (i) Whether the mark "Scotchlite" considered in relation to the goods in respect of which registration was sought (that is, "Non-metallic material in sheet form embedded with light – reflective substances") fell within any of the descriptions contained in Paras. (a), (b), (c) and (d) of section 9(1)? and if so; (ii) Whether considered in relation to those goods it was a distinctive mark?

If the Question to (i) was in the negative, Question (ii) did not raise, because having regard to the fact that there had been no user of the mark in the United Kingdom down to the date of the application no evidence of its distinctiveness was adduced, and accordingly it could not qualify for registration under section 9(1)(e). If the answer to Question (i) was in the affirmative, the Registrar had still to be satisfied before accepting the mark for registration that an affirmative answer should also be given to Question (ii)."

And later on the same page :

"As I have already mentioned, the absence of evidence of distinctiveness of the mark precludes it from being registrable under Para. (e) if it fails to qualify under Paras. (c) or (d). But Para. (e) is relevant as showing by its opening words 'any other distinctive mark' that the mark even if it does fall within paragraphs (c) or (d) must, in order to be registrable, still satisfy the overriding requirement that it should be a distinctive mark."

12. In *Elvis Presley Trade Marks* [1997] R.P.C. 543 at pages 548-9, Laddie J. explained "distinctiveness" in the following terms :

"The distinctiveness addressed by the Act is not a quality of the mark which exists in a vacuum. It is a particular type of distinctiveness, namely the ability to distinguish the proprietor's goods from the same or similar goods marketed by some one else. The more a proposed mark alludes to the character, quality or non-origin attributes of the goods on which it is used or proposed to be used, the lower its inherent distinctiveness."

13. No evidence of use has been filed nor have "any other circumstances" been brought to my attention so I am concerned solely with the prima facie case, or to use the language of the section, the extent to which the mark "MEN", in relation to the goods, is "inherently adapted to distinguish". In my judgment there are no origin attributes of the proposed mark whatsoever. Its only significance, in ordinary English is to its allusion of suitability to the masculine gender or to a body of men generally. The mark accordingly fails to comply with the requirements of section 9 of the Ordinance and can accordingly not be accepted for registration in Part A of the Register.

14. I must also consider, as I am permitted by section 13(3) of the Ordinance, whether the mark could be regarded as "capable of distinguishing" within the meaning of section 10. The generally accepted formulation of the test under section 10 can be found in the judgment of Lloyd - Jacob J. in *Henry Quennell's Trade Mark Appln. ("Pussikin")* (1955) 72 R.P.C. 34 at page 37.

"The requirements of section 10, shortly stated, to enable a trade mark to be registered are that the applicants must satisfy the tribunal that the mark is capable of distinguishing the goods to which it will be attached; and the section indicates that the nature of the investigation may fall into one or other of two specified inquiries. The first, set out under Sub-section 2(a), is that the trade mark is to be inherently capable of distinguishing; and in Sub-section 2(b) it is to be in fact capable of distinguishing.

So far as concerns the first of those requirements, in my judgment the matter falls to be considered solely by examination of the mark applied for; that is to say, that irrespective of the peculiarities, if any, of the trade (which may of themselves provide either capacity to distinguish or, alternatively, may limit the field in which distinctiveness requires to be examined), Sub-section 2(a), in my judgment, requires consideration solely of the mark itself. Putting it in another way, irrespective altogether of any peculiarities of the trade or the practice of other traders, is the word such that, on examination, it is shown to possess the capacity of distinguishing the goods to which it is applied? If, as in this case, the word is regarded as having a direct reference to the character of the goods, as at present advised I am unable to see how that conclusion enables any result favourable to the applicants to be arrived at so

far as concerns the first of the two methods of examining into the capacity to distinguish.”

15. I pause there to say that, for the reasons set out above, in my judgment the mark “MEN”, having as it does a direct reference to the character of the goods, has not been shown to possess the capacity of distinguishing the goods inherently.

A little later at page 38, the judgment continues :

“That leaves to be considered the second ground; namely, that the mark is in fact capable of distinguishing; and the sub-section provides that in that enquiry the applicant is entitled to obtain what assistance he can from either the use of the trade mark or any other circumstances which may be brought before the tribunal. In the present case the application is made before there has been any use of the trade mark; and accordingly that approach to the matter cannot avail this applicant. It remains to consider any other circumstances which the applicant is entitled to pray in aid.”

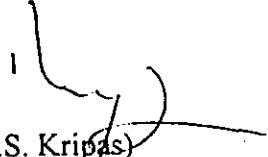
16. As I have said above, there has been no evidence of use filed, and in the absence of proof of any other circumstances, I am bound to conclude that the applicant has failed to establish that the mark could properly be placed upon the Register in Part B.

17. I refer briefly to the decision in *MADAME Trade Mark* [1966] R.P.C. 541 where the mark “MADAME” was determined to be unregistrable for “tobacco, raw or manufactured; smokers’ articles; matches”. In upholding the decision of the Registrar Tookey Q.C. said :

“A word like “woman” is in general a word which should be left open for traders to use freely not only in describing their goods but in framing publicity of a more general nature in connection with their goods. They should not be embarrassed in such use by having to exercise caution lest they use the word in a way which could be taken or being used as a trade mark or as indicating a connection in the course of trade with someone who has succeeded in getting the word registered for the goods concerned.”

18. I see no reason why these words are not equally applicable to the word “MEN” and accordingly adopt them.

19. In arriving at my decision I have considered all the written submissions made by the applicant; the record made of the applicant’s oral submissions made at the informal discussion; the statutory provisions of the Ordinance; and the authorities cited herein.


(K.S. Kripas)
p. Registrar of Trade Marks
25 April 2000