

**O/1062/24**

**TRADE MARKS ACT 1994 (INTERNATIONAL REGISTRATION) ORDER 2008 (as amended)**

**IN THE MATTER OF INTERNATIONAL REGISTRATION WO0000001777962**

**BY COOPER-STANDARD AUTOMOTIVE INC.**

**TO REGISTER THE FOLLOWING MARK IN CLASS 17:**

**FLUSHSEAL**

### **Background**

1. On 29 February 2024, Cooper-Standard Automotive Inc. (“the applicant”) applied to register the above mark for the following goods:

*Class 17: Non-metal window seals for use in association with windows sold to manufacturers and their suppliers for automobile and vehicle manufacturing.*

2. On 15 March 2024 the Intellectual Property Office (“IPO”) issued an examination report in response to the application. In that report, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 (“the Act”) on the grounds that the mark consists exclusively of a sign which may serve in trade to designate the kind and characteristics of the goods e.g. window seals which are flush between the window or adjacent surface.

3. In line with standard IPO procedure, a period of two months was allowed for the applicant to respond.

4. On 15 May 2024 Murgitroyd & Company Limited made written submissions in favour of accepting the mark but the examiner could not respond until a Form TM33 had been received formally appointing them as attorney representing the holder. A Form TM33 was duly received on 3 June 2024.

5. Having considered the attorney’s submissions, the examiner was not convinced that the objection should be waived and responded to that effect on 25 June 2024.

6. On 16 July 2024 the applicant responded requesting a hearing.

7. The hearing was held on 4 September 2024 between me and Ms Annabel Hanratty of Murgitroyd & Company.

8. Ms Hanratty’s submissions centred around the various meanings of the word ‘FLUSH’, including one which refers to water and its ability to cleanse or flush out. In respect of the mark, Ms Hanratty contended that it was merely allusive; a play on words; and would require the relevant consumer to take a number of mental steps to reach any meaning for the mark. It was also Ms Hanratty’s submission that apart from use in respect of toilet seats, in the marketplace the sign is only used by the holder. Having considered the submissions made at the hearing, I was not persuaded that the sign was distinctive and consequently maintained the objection under section 3(1)(b)&(c). I was informed at the hearing by Ms Hanratty that the holder had not been using the mark for very long so she would not be filing evidence

with a view to demonstrating that the sign had acquired a distinctive character through use. The designation was therefore refused.

9. A form TM5 (Request for a statement of reasons for registrar's decision) was received on 1 October 2024.

10. Having received a request for a statement of reasons for the registrar's decision, I am now obliged to set out the reasons for my decision.

## **The Law**

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

*3(1) The following shall not be registered –*

*(a) ...*

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

*(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,*

*(d) ...*

*Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above 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.*

## **The relevant legal principles – section 3(1)(c)**

12. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires those applying assimilated law to follow assimilated EU case law. That is why this decision refers to some decisions of the EU courts which predate the UK's withdrawal from the EU.

13. There are a number of judgements of the Court of Justice of the European Union ("CJEU") which deal with the scope of Article 3(1)(c) of the Directive and Article 7(1)(c) of the Regulation, whose provisions correspond to Section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- The words 'may serve in trade' include within their scope the possibility of future use even if, at the material date of application, the words or terms intended for protection are not in descriptive use in trade (see, to that effect, CJEU Cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots and Segelzubehor Walter Huber* and others).

- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all. The provision therefore prevents such signs or indications from being reserved to one undertaking alone because they have been registered as trade marks (see judgment of 4 May 1999 in Joined cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH (WSC) v Boots-und Segelzubehör Walter Huber and Franz Attenberger (Chiemsee)* [1999] ECR I-2779, at paragraph 25).
- It is also a well-established principle that the Registrar's role is to engage in a full and stringent examination of the facts, underlying the Registrar's frontline role in preventing the granting of undue monopolies, see to that effect CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z.o.o. v OHIM* [2011] ECR I-1541 (Technopol).
- It is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods and services. The word 'exclusively' in paragraph (c) is not intended to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question (*Koninklijke KPN Nederland NV v Benelux Merkenbureau, C-363/99 'Postkantoor'*, paragraph 57);
- When determining whether a sign is devoid of distinctive character or is descriptive of the goods or services in respect of which registration is sought, it is necessary to take into account the perception of the relevant consumer who is reasonably well-informed and reasonably observant and circumspect (*Matratzen Concord AG v Hukla Germany SA, C-421/04*);
- There must be a sufficiently direct and specific relationship between the sign and the goods in question to enable the relevant consumer immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics (*Ford Motor Co v OHIM, T-67/07*);
- An otherwise descriptive combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word trade mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark (*Postkantoor*, paragraph 99).

14. It is clear from the aforementioned case law that I must determine whether or not the mark applied for will be perceived by the relevant consumer as a means of directly designating the kind or characteristic of the goods being provided. In order to do this, I must assess who I consider the relevant consumer to be.

### **Application of legal principles – Section 3(1)(c)**

15. As mentioned at paragraph 1, the goods upon which the mark is to be used are:

*Non-metal window seals for use in association with windows sold to manufacturers and their suppliers for automobile and vehicle manufacturing.*

When considering the description of these goods it is my view that the relevant consumer is not the general public but will be businesses who manufacture windows for use in the automobile and vehicle industry. I consider these to be specialist goods for which the relevant consumer would pay a relatively high level of attention.

16. Having considered the kind of goods encompassed within the specification, identified the relevant consumer, and established their likely level of attention, I must now determine how the average consumer will perceive the mark when used in respect of the goods claimed. I consider the mark FLUSHSEAL to be a neologism consisting of the words 'FLUSH' and 'SEAL'. These individual words are defined in Collins Online Dictionary as:

*flush* – adjective: *If one object or surface is flush with another, they are at the same height or distance from something else, so that they form a single smooth surface.*

*seal* – countable noun: *a seal is a device or a piece of material, for example in a machine, which closes an opening tightly so that air, liquid, or other substances cannot get in or out.*

17. I acknowledge that each of the words may have multiple meanings, but when used in respect of the goods, namely, '*Non-metal window seals.....*' I have no doubt that the relevant consumer will immediately understand the words in accordance with the dictionary meanings of the individual words shown above.

18. When considering the mark in relation to the goods it is my view that the meaning of FLUSHSEAL will be readily understood and comprehended by the relevant consumer as describing e.g a seal to enable the window to sit flush with the body of the vehicle in which it is to be used. Consequently, the mark would be perceived as nothing more than a sign designating e.g., the intended purpose, kind, or characteristic of the goods. It is not uncommon for vehicles to be designed in a way that facilitates smooth aerodynamics which will in turn enhance its fuel efficiency and performance, therefore, a window that is flush with the vehicle body will serve to enhance that performance. Moreover, the visual design and aesthetic of a vehicle is often a consideration of the end user of the vehicle during their selection process so windows that have a flush seal that provides a seamless transition between the window and body will be a desirable characteristic of the vehicle.

19. In reaching this conclusion I have considered the decision in the BIOMILD case, C-265/00, which states:

*39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which*

*registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive, even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.*

*40. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition will have to be satisfied as regards both the aural and the visual impression produced by the mark.*

*41. Thus, a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.*

20. It is my opinion that the two elements FLUSH and SEAL are both clearly descriptive of the e.g. the intended purpose, kind or characteristic of the goods, and bringing these elements together without introducing any unusual variations, in particular as to syntax or meaning, has not resulted in anything other than a mark consisting exclusively of a sign which may serve, in trade, to designate a characteristic of goods concerned, namely 'a non-metallic window seal' that enables the window to sit flush and seamlessly with the vehicle body in which it is used. Furthermore, the combination has not created an impression that is sufficiently far removed from that of a flush seal.

21. The next part of my analysis takes in the nature of the goods upon which the sign will be used. I am mindful that refusal is only justified in relation to those goods in respect of which the sign designates its kind or characteristic. In this case, the Class 17 specification includes 'Non-metal window seals for use in association with windows sold to manufacturers and their suppliers for automobile and vehicle manufacturing'. When used in respect of these goods the mark FLUSHSEAL clearly describes a characteristic of the goods.

22. I have considered the guidance set out in relevant case law and I consider that the average consumer of the relevant goods will not perceive the sign as indicating trade origin of the goods. I therefore conclude that the mark consists exclusively of a sign which may serve, in trade, to designate the kind and characteristic of the goods. It is, therefore, excluded from registration by section 3(1)(c) of the Act.

23. It is my view that conjoining the two words does not add any inherent distinctiveness to the mark. The conjoined presentation would be perceived as nothing more than a minor (and inherently non-distinctive) presentational variation of the term 'FLUSH SEAL'. Furthermore, and in direct response to the submissions made by the attorney, the case law makes clear that an objection under section 3(1)(c) and (b) is made in the public interest and it is not relevant that others may not be currently using the term in the marketplace. I have already determined that I do not consider any supposed ambivalence in the individual word 'flush' to disturb my finding.

### **Conclusion**

24. I have taken into account the guidance set out in relevant case law and I consider that the average consumer of the relevant goods will, absent education through use, not perceive the mark as indicating trade origin of the goods. I therefore conclude that the mark consists exclusively of a sign which may serve, in trade, to designate kind and characteristic of the goods and is therefore excluded from registration by section 3(1)(c) of the Act.

25. Any mark found to be unacceptable under 3(1)(c) will automatically be found to be non-distinctive. The objection taken under 3(1)(b) is solely on the basis that the mark designates the kind and characteristic of the goods and for no other reason. In other words, the objections under section 3(1)(b) and (c) in this case are co-extensive; there is no independent, contingent or separate rationale required under section 3(1)(b).

**Dated this 8<sup>th</sup> day of November 2024**

**Linda Smith  
For the Registrar  
The Comptroller-General**