



**IN THE MATTER OF APPLICATION NO. 50745
BY PHILLIP MORRIS PRODUCTS S.A.
TO REGISTER A TRADE MARK IN CLASS 34**

**IN THE MATTER OF APPLICATION NO. 50745
BY PHILLIP MORRIS PRODUCTS S.A.
TO REGISTER A TRADE MARK IN CLASS 34**

DECISION AND REASONS FOR DECISION

1. On the 16th of August 2007, Phillip Morris Products S.A., through its agents, Livingston, Alexander and 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 **WIDES** in 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.”

2. The mark was accepted for publication by the Trade Marks Registry on November 15, 2007 and publication effected in the Jamaica Gazette on February 5, 2008.
3. A Form TM 4 - Notice of Opposition accompanied by the Statement of Grounds was filed on March 31, 2008 by Myers, Fletcher and Gordon, Attorneys-at-Law, on behalf of BATmark Limited (hereinafter referred to as “the Opponent”).
4. According to the Statement of Grounds filed, the Opponent opposes the proposed registration of the trade mark WIDES on the bases that the mark:
(i) contravenes Section 11(1)(a) of the Act in that it is incapable of distinguishing the goods or services of one undertaking from another;

- (ii) contravenes Section 11(1)(b) of the Act in that it is devoid of any distinctive character;
 - (iii) contravenes Section 11(1)(c) of the Act in that it consists exclusively of an indication which serves in the trade to designate the kind, quality, characteristic and properties of the goods;
 - (iv) contravenes Section 11(1)(d) of the Act in that it consists exclusively of indications which have become customary in the *bona fide* and established practices of the trade;
 - (v) is likely to deceive or cause confusion among the public; and
 - (vi) it would prejudice the Opponent's lawful use of the word 'WIDES' in the normal course of business.
5. Form TM 5 and Grounds in support of Counterstatement were filed on behalf of the Applicant on May 28, 2008.
6. The Applicant denied all the allegations set out in the Opponent's Grounds of Opposition. In particular, the Applicant stated that:
- (i) *'WIDES' is capable of distinguishing its goods and services from those of another;*
 - (ii) *'WIDES' is sufficiently distinctive;*
 - (iii) *'WIDES' is an unusual, invented word which does not exist in the English language and is neither common nor customary in the trade of goods in class 34.*
 - (iv) *'WIDES' is an unusual, invented word which does not exist in the English language and therefore is not wholly descriptive of the goods in class 34.*
 - (v) *'WIDES' is not likely to cause confusion among the public because it is an unusual invented word that is sufficiently distinctive to distinguish its goods from others.*
7. On the 28th July, 2008 the Opponent filed a Statutory Declaration of Clyde Elliott Woods, Trade Mark Counsel of the Opponent company, dated July 24, 2008. Mr. Woods' Declaration is to the effect that 'WIDES' is a generic, descriptive term which other tobacco manufacturers have used to market their cigarettes.

8. On the 22nd December, 2008 the Applicant filed Statutory Declarations of Maximilien Yaouanc, Senior Counsel at the Applicant Company and Howard Mitchell, Chairman of TM Traders Limited who operate a duty free store in Jamaica selling tobacco products. Mr. Yaouanc's Declaration is to the effect that 'WIDES' is an unusual, invented word that is not in the English dictionary, that it is distinctive, that it has absolutely nothing to do with class 34, and that the term is not in use in Jamaica. Mr. Mitchell's Declaration is to the effect that the term 'WIDES' is not used in Jamaica in respect of cigarettes and that no cigarettes are sold in Jamaica using that term.
9. On the 20th May, 2009 the Opponent filed another Statutory Declaration of Clyde Elliott Woods dated May 14, 2009 and a Statutory Declaration of Michael Bernard, Managing Director of Carreras Limited, which it is stated supplies approximately 98% of the Jamaican market with cigarettes.
10. In his second Statutory Declaration, Mr. Woods argues that, although an invented word, 'WIDES' is merely the pluralisation of the descriptive word, 'wide, as is commonly done in the tobacco industry', and that further, the fact that the word 'WIDES' is not in the Concise Oxford Dictionary does not mean that the term is non-descriptive. Mr. Woods exhibits additional online information to substantiate that the term 'WIDES' is used to describe types of cigarettes in the industry and concludes that were the registration of 'WIDES' simpliciter to be allowed it would result in the "unjust monopolisation of this descriptive term."
11. Mr. Bernard's Declaration is in response to that of Mr. Howard Mitchell and is to the effect that the term 'WIDES' is used to describe cigarettes which have a wider diameter than normal cigarettes and that "given the dynamic nature of the cigarette industry and the increasing demand for a diversified product offering to cigarette consumers, there is a strong possibility that cigarettes categorized as 'WIDES' will penetrate the Jamaican market in the near future."

12. Opposition Hearing was held on the 3rd February, 2011 before Miss Kai-Saran Davis, Manager of the Trade Marks, Designs and Geographical Indications Directorate acting for the Registrar of Industrial Property. Miss Kathryn Cousins, Attorney-at-Law of the Firm Livingston, Alexander & Levy, appeared for the Applicant and Mrs. Andrea Scarlett-Lozer, Attorney-at-Law of the Firm Myers, Fletcher and Gordon, appeared for the Opponent.
13. At that hearing Mrs. Scarlett-Lozer presented written as well as oral submissions. Miss Cousins presented only oral submissions. Decision was reserved. Miss Kai-Saran Davis subsequently in August 2011 demitted office and I assumed duties as Manager of the Trade Marks, Designs and Geographical Indications Directorate in December 2011. As such, this Opposition fell to me to consider.
14. In that regard, I asked counsel for both parties whether they would like the opportunity to be heard before me, or to submit their arguments in writing to me, prior to my decision in this matter. Both counsel declined the opportunity to be heard before me but agreed to submit and/or resubmit their arguments to me in writing. I received written submissions from counsel for the Applicant on February 27, 2012 and written submissions including Rebuttal Submissions from counsel for the Opponent on March 14, 2012. The totality of the submissions and authorities presented by both counsel have been helpful for which I thank them.
15. I will commence by assessing whether the Applicant's mark is unregistrable by virtue of the absolute grounds outlined in section 11 of the Trade Marks Act 1999. I am guided by *Kerly on Trademarks and Tradenames at paragraph 8-057* in relation to the interplay of the several absolute grounds:
 - each ground for refusal or invalidity operates independently of the others and calls for separate examination (*POSTKANTOOR*, paras 67, 85);

- the applicability of any one of the specified grounds is sufficient to prevent registration (*COMPANYLINE* , para 29);
 - the inapplicability of one ground may coincide with the applicability of another (*POSTKANTOOR* , para69);
 - a mark can accordingly be devoid of any distinctive character without also being unduly descriptive (*POSTKANTOOR* , para 70, *BIOMILD* , para 19);
 - however, a mark which is unduly descriptive is necessarily devoid of distinctive character (*BIOMILD* , para.19);
16. It is to be noted that the provisions of section 11 of our Trade Marks Act 1999 are the same as or very similar to the apposite provisions of the UK Trade Marks Act, the EC Trademarks Directive and the Community Trade Marks Regulations, those provisions all having their common origin in the Paris Convention. Therefore if a mark consists exclusively of signs which are descriptive under section 11(1)(c) or 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)(c) or (d). Additionally, it is recognised that if a mark is distinctive, then it would automatically be treated as capable of distinguishing the goods or services of one undertaking from another.
17. However, as stated by the European Court of Justice (ECJ) in *Philips v Remington*, the question whether the mark is capable of distinguishing the goods and services of one undertaking from another, is a preliminary question which should be answered before an examination of the distinctiveness of the mark. As opined in Bentley and Sherman's Intellectual Property Law (3rd Edition) at page 815, the several sections also need to be read together. It is recognized therefore that the sections are not mutually exclusive and may be applied in combination (*Holyoak and Torremans, Intellectual Property Law, 5th Edition, at page 379*). I will thus consider subsection 11(1)(a) first. As stated in *Kerly on Trademarks and Tradenames at paragraph 8-058*, the logical order to consider the other absolute grounds is in reverse.

Thereafter, I will therefore proceed to assess the section 11 absolute grounds separately and in reverse order, that is, by reference to section 11(1)(d), then 11(1)(c), 11(1)(b), and then back to 11(1)(a).

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

18. A trademark is defined by section 2 of the Trade Marks Act 1999 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.

19. A sign is defined by section 2 of the Trade Marks Act 1999 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)”. Based on that definition of a “sign”, it is clear that that the word mark “WIDES” falls within the definition of a sign under the Act. It is also clear that the mark can be graphically represented by letters. Those points were never in contention before us. The contention by the Opponent is that the “WIDES” mark is incapable of distinguishing the goods or services of one undertaking from another, because the mark is descriptive (contrary to section 11(1)(c)) and customary/generic (contrary to section 11(1)(d)) and therefore non-distinctive (contrary to section 11(1)(b)).

20. The Opponent argued that the proposed mark contravenes Section 11(1)(a) of the Act in that it is incapable of distinguishing the goods or services of one undertaking from another. The question to be asked in answering the question of whether the mark satisfies the definition of a trademark are whether the mark is capable of attracting the consumer’s attention in the

right trade-origin message manner. In other words, is the mark by itself capable of functioning as a badge of origin to the average consumer, in relation to the goods and/or services for which the mark has been applied to be registered for?

21. Following the Judgment of the English Court of Appeal in *West (t/a Eastenders) v Fuller Smith & Turner plc* [2003] FSR 816, the second half of the definition of “trade mark” (in section 2 of the Jamaican Trade Marks Act 1999,) that is, “capable of distinguishing the goods and services of one undertaking from those of another undertaking” must be viewed as imposing no distinctiveness requirement separate from that imposed by (section 11(1)(b), (c) and (d) of the Jamaican) Trade Marks Act. Therefore in assessing whether the mark is capable of distinguishing the goods and services of one undertaking from those of another undertaking, I shall consider the several issues and aspects under section 11(1)(b), (c) and (d) of the Trade Marks Act 1999 separately but holistically as they relate to distinctiveness.

Section 11(1)(d)

22. The Opponent argues that the proposed mark contravenes Section 11(1)(d) of the Act in that it consists exclusively of indications which have become customary in the *bona fide* and established practices of the trade. This section has been described as involving the language and practice of the relevant trade. Section. 11(1)(d) refers to the meaning of the word that has developed at the time of registration. However, for ordinary consumer items, the current language of consumers will be important (*Kerly on Trademarks and Tradenames, paragraph 8-110*).
23. I deem cigarettes to be ordinary consumer items. Therefore the current language that will be important is that of the consumers of cigarettes and not of manufacturers or traders.

24. In the Statutory Declarations of Clyde Woods in support of the Opponent, usage of “WIDES” in the cigarette trade outside of Jamaica is relied upon. This includes use of the term as applied to cigarettes by Reynolds American (Camel Wides and Camel Wides Filters) and by the Opponent itself (Lucky Strike Wides). It is accepted by both parties that the term “WIDES” as applied to cigarettes is not used in Jamaica at present, that is, there are no cigarettes currently sold in Jamaica which use the term “WIDES”. It is therefore incontrovertible that the term is not customary in the current language or in the bona fide and established practices of the cigarette trade in Jamaica.
25. However the Opponent is asking the Registrar not to disregard the customary nature of the term “WIDES” in the global cigarette trade, particularly in light of the fact that there is “heavy traffic of persons between the United States of America and Jamaica” which, as in the case of *Kaymart Ltd & Ors. v K-Mart Corporation* (1998) 35 JLR 617, was the basis for a finding of “familiarity and knowledge” of the respondent’s K-Mart Corporation in the USA. The Opponent argues that the cigarette trade is not restricted to geographical borders and that by virtue of the traffic of persons between Jamaica and the USA, there is familiarity and knowledge of Jamaicans of the term “WIDES” as a generic term to describe types of cigarettes.
26. I accept the fact that the term “WIDES” is not customary in the current language or in the bona fide and established practices of the cigarette trade in Jamaica at present. I cannot accept the arguments of the Opponent that customary use of the term in the global cigarette trade is relevant under this section, as the relevant language and trade must be in Jamaica where the consumers who are the likely users of the goods in class 34 are. Though there is heavy traffic of persons between the USA and Jamaica, the relevant trade with which the Registrar is concerned is that in Jamaica. I therefore find that the Opponent fails under section 11(1)(d) of the Trade Marks Act 1999.

Section 11(1)(c)

27. The Opponent argues that the proposed mark contravenes Section 11(1)(c) of the Act in that it consists exclusively of an indication which may serve in the trade to designate the kind, quality, characteristic and properties of the goods.
28. The Opponent argues that “WIDES” is nothing more than a pluralization of the common, descriptive word “wide”, which without more, would fall foul of section 11(1)(c). The Applicant argues that by the use of the letter “s” at the end of the word “wide”, the term “WIDES” has that capricious addition and alteration that renders it distinctive and not descriptive. The Applicant relied on the BABY DRY Judgment to argue that the addition of the “s” is unusual and thereby transforms the descriptive word “wide” into an *“invented word which does not exist in the English language”*.
29. Though no surplus or capricious addition is required, it is clear that without something more, the word “wide” is not registrable by virtue of section 11(1)(c). The question therefore is whether the addition of the “s” is sufficiently more to render the word mark “WIDES” distinctive and non-descriptive.
30. In my opinion, the mere addition of the letter “s” is insufficient to give the common, descriptive word “wide” a distinctive, non-descriptive meaning. The addition of the “s” nevertheless communicates to the consumer an intrinsic description, quality, kind and type of cigarette to the consumer. There is practically no additional mental effort required to make the obvious connection between the word “WIDES” and “wide”. Whether the word is written in common or capital letters, the message to the consumer is clearly a descriptive one, in the absence of any secondary meaning or acquired distinctiveness as a trade mark.

31. The fact that the “WIDES” mark may serve in the trade to designate the kind, quality, characteristic and properties of the goods is also borne out by the fact that the term “WIDES” is commonly used in the global cigarette trade to refer to the wide characteristic kind of cigarettes. It is therefore very indicative and highly likely that the term “WIDES” *may* serve in the Jamaica cigarette trade to designate the wide characteristic kind of cigarettes, even though it does not at present serve that purpose in Jamaica. This is the compelling view of Mr. Michael Bernard, Managing Director of Carreras Limited, the leading cigarette manufacturer in Jamaica with 98% market share.
32. I therefore find that the mark as applied for, in relation to the goods as applied for in Class 34, falls foul of Section 11(1)(c) of the Trade Marks Act 1999, in that it consists exclusively of an indication which may serve in the trade to designate the kind, quality, characteristic and properties of the goods.

Section 11(1)(b)

33. The Opponent argued that the proposed mark contravenes Section 11(1)(b) of the Act in that it is devoid of any distinctive character. As said by the ECJ in *Linde, Winward & Rado*, the focus is on how the trademark would be perceived by the relevant public which consists of average consumers of the goods or services in question. According to the ECJ, under this section of the law, there is no requirement that the sign be particularly original, inventive or artistically creative, or that it 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. As both parties accepted, the standard is low.
34. As found in the *BIOMILD* case (para. 19), a mark which is unduly descriptive is necessarily devoid of distinctive character. In light of my finding that the

Applicant's mark is exclusively descriptive and there being no other word or figurative element to render the mark inherently distinctive, I find that the mark is therefore devoid of any inherent distinctive character. As stated above, the addition of an "s" at the end of the word "wide" is not sufficient in my opinion to give the mark a distinctive character. The mark therefore also falls foul of Section 11(1)(b) of the Trade Marks Act 1999.

35. As stated in *Kerly* at paragraph 7-112, "If the sign in question has very limited 'surplus' or 'capricious addition' over the purely descriptive term, then very extensive use of the sign will be required and in a distinctive sense, so that the primary descriptive meaning of the sign is substantially displaced by the secondary distinctive meaning." In relation to the "WIDES" mark in question, there has been no use of the mark in Jamaica and so it has not acquired any distinctiveness through use that is capable of displacing the primary descriptive meaning. I therefore find that the mark is devoid of any inherent or acquired distinctive character and is therefore not registrable by virtue of Section 11(1)(b).

Section 11(1)(a)

36. I therefore go back now to the question of whether the mark as applied for satisfies the definition of a trade mark, particularly is it capable of distinguishing the goods or services of one undertaking from another. In light of my findings above that the mark consists exclusively of an indication which may serve in the trade to designate the kind, quality, characteristic and properties of the goods and is devoid of any inherent or acquired distinctive character, I find that the mark is incapable of distinguishing the goods or services of one undertaking from another and therefore does not satisfy the definition of a trade mark.

The public interest

37. The European Court of Justice has made it clear that public interest considerations underlie each of the absolute grounds in the provisions equivalent to our section 11(1), to ensure that generic and descriptive terms may be freely used by all. Alternatively, the public interest lies in the fact that marks caught by these provisions are not capable of functioning as trade marks and therefore do not deserve to be protected.
38. In this matter, the public interest lies in the fact that exclusive rights ought not to be granted in respect of wholly descriptive terms. That is the public interest that specifically underlies section 11(1)(c). In light of the finding that the mark consists exclusively of an indication which may serve in the trade to designate the kind, quality, characteristic and properties of the goods, and that without more the mark is devoid of distinctive character, I find that it is in the public interest that the mark not be allowed to be registered, as the exclusively descriptive term “WIDES” is not capable of functioning as a trade mark and should be available to be freely used by all.

Likelihood of Confusion

39. The Opponent argued that the proposed mark is likely to deceive or cause confusion among the public because the average consumer would be unable to associate the mark with the trade of particular goods or services. Insufficient argument or evidence was presented under this head. In those circumstances I am not able to find that there is a likelihood of confusion.

Prejudice/Restraint of trade

40. The Opponent argued that the proposed mark would prejudice the Opponent’s lawful use of the word ‘WIDES’ in the normal course of business. This is supported by the Statutory Declarations of Clyde Elliot Woods dated July 24, 2008 and May 14, 2009 respectively. In light of the

finding under the public interest heading above, it follows that to allow the Applicant to be granted exclusive rights over the word “WIDES” would prejudice other traders in Class 34 and operate as a restraint of trade and unfair competition in that respect.

41. In the circumstances the Opposition is upheld, on the basis that:
- (i) the mark contravenes Section 11(1)(c) of the Trade Marks Act 1999 in that it consists exclusively of an indication which may serve in the trade to designate the kind, quality and characteristic of the goods applied for in Class 34;
 - (ii) the mark contravenes Section 11(1)(b) of the Act in that it is devoid of any inherent or acquired distinctive character;
 - (iii) the mark contravenes Section 11(1)(a) of the Act in that it is incapable of distinguishing the goods or services of one undertaking from those of another in relation to the goods for which it was applied for in Class 34; and
 - (iv) it would not be in the public interest to grant exclusive rights to the Applicant to the word ‘WIDES’ in respect of the goods applied for in Class 34.

42. There is no Order as to costs.

Marcus Goffe
for Registrar of Industrial Property
July 20, 2012