



**IN THE MATTER OF APPLICATION NOS. 56, 881 and 56, 909
BY BRITISH AMERICAN TOBACCO (BRANDS) LIMITED
TO REGISTER THE TRADE MARKS**

CLICK & ROLL

AND

CLICK

IN CLASS 34

**AND IN THE MATTER OF OPPOSITION
NOS. 60/TM2011 and 61/TM2011
BY PHILIP MORRIS PRODUCTS S.A.**

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BY BRITISH AMERICAN TOBACCO (BRANDS) LIMITED
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DECISION AND REASONS FOR DECISION

The Applications

1. On the 11th of November, 2010 and 17th of November, 2010 respectively, British American Tobacco (Brands) Limited, 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 trade marks “CLICK & ROLL” and “CLICK” respectively.
2. The Applications (No. 56,881 and No. 56,909 respectively) related to class 34 in respect of :

“Cigarettes; tobacco; tobacco products; lighters; matches; smokers’ articles”
3. On the 22nd of February 2011, the Registrar of Industrial Property at the Jamaica Intellectual Property Office (JIPO) accepted the marks for publication. The applications were subsequently published in the Jamaica Gazette No. 17A (Extraordinary) dated the 2nd of May, 2011.

Grounds of Opposition

4. Notices of Opposition (Forms TM 4) accompanied by Statements of Grounds of Opposition were filed on July 28th, 2011 by Livingston, Alexander and Levy, Attorneys-at-Law, on behalf of Philip Morris Products S.A. (hereinafter referred to as “the Opponent”).

5. According to the Statements of Grounds (hereinafter “the Opponent’s Grounds”) filed, the Opponent opposes the proposed registration of the trade marks on the following grounds:

- i. The Applicant’s marks in class 34 in respect of “cigarettes; tobacco; tobacco products; matches; smokers’ articles” are comprised of verbs (“CLICK & ROLL”) and a verb (“CLICK”) respectively used to describe an action relative to a cigarette product which contains a mentholated capsule in the filter, the function of this capsule being to release an extra menthol sensation by clicking the said capsule, which can then be rolled through one’s fingers to reform the filter.
- ii. The Applicant’s marks do not satisfy the definition of a “trade mark” set out in Section 2(1) of the Trade Marks Act, and so, are not registrable based on Section 11(1)(a) of the Act;
- iii. The Applicant’s marks are devoid of distinctive character, and so, are not registrable based on Section 11(1)(b) of the Act;
- iv. The Applicant’s marks consist exclusively of a sign or indication which serves in trade to designate the kind, quality, intended purpose and/or other characteristics of the goods in question and are thus not registrable based on Section 11(1)(c) of the Act;
- v. The Applicant’s marks consist 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, and thus are not registrable based on section 11(1)(d) of the Act.

Grounds of Counterstatement

6. Forms TM 5 and Grounds in support of Counterstatement were filed on behalf of the Applicant on September 28th, 2011.

7. The Applicant denied all the statements and allegations set out in the Opponent's Grounds of Opposition. In particular, the Applicant stated that its marks:
 - i. must be assessed in respect of the goods for which the applications have been filed and when assessed in this context, the marks would not and cannot be perceived by the relevant public as being descriptive of any well known function or characteristic of a cigarette or tobacco product;
 - ii. satisfy the definition of a "trade mark" under the Trade Marks Act including the capacity to distinguish the goods of the Applicant from those of other undertakings;
 - iii. are distinctive in respect of goods for which it has been applied for and accomplishes the essential function of trade marks;
 - iv. have acquired distinctiveness through use in a number of jurisdictions around the world; the "CLICK" mark is commonly used in combination with other brand elements which form part of the Applicant's Brand Portfolio such as "CLICK & ROLL" and "CLICK SWITCH REFRESH";
 - v. are currently registered in several countries around the world and registration is pending in several other countries;
 - vi. are not customary or common in the trade of class 34 goods.

Evidence

Opponent's Evidence

8. On November 8th, 2012 the Opponent filed Statutory Declarations of Maximilien Yaouanc in support of the Oppositions.
9. Mr. Yaouanc is an Authorised Attorney of the Opponent. In his Declarations sworn to on the 18th of October, 2012, he states *inter alia* that:
 - i. Based on the *Oxford English Reference Dictionary, 2nd Ed. p. 272 and pp. 1248-1249*, the words "Click" and "Roll" have the following meanings:
 - a. *A slight sharp sound as of a switch being operated*
 - b. *Make a click*
 - c. *To cause to click*
 - ii. For "Roll":
 - a. *Move or go in some direction by turning over and over on an axis or by rotary movement*
 - b. *To cause to do this*
 - c. *Make by forming material into a cylinder or ball (rolled a cigarette; rolled a huge snowball)*
 - iii. The word "Click" is widely used in many industries for this common meaning as part of various user manuals or other instructions or directions to signal to the user to watch for a "click" sound to ensure that a switch has been properly activated or that a product packaging has been properly closed or to do something;
 - iv. The word "roll" is particularly used in respect of cigarettes as it is generally descriptive of the action of rolling a

cigarette, that is, to put a quantity of loose tobacco in a rolling paper to get a hand-rolled cigarette;

- v. As applied to tobacco products, particularly to cigarettes, the term “click & roll” serves to designate the characteristics and/or the intended purpose of the products for which registration is sought by the Applicant, that is, a certain type of cigarette featuring a capsule inserted in the filter portion of the cigarette which, if clicked, releases a mint flavour which changes the taste of the cigarette from a regular cigarette to a menthol one, or from a menthol cigarette to a more mentholated cigarette;
- vi. In respect of such cigarettes, the word “click” is onomatopoeic of the sound heard when the capsule is crushed;
- vii. Once the filter has been pressed, the word “roll” directly describes the act of rolling the filter to intensify the menthol flavour and/or to get the filter back to its original shape;
- viii. Cigarettes incorporating flavour capsules which involve the clicking of the filter to release the flavour, are common to the trade and are made available not only by the Applicant but also by the Opponent and/or related companies and other competitors (Exhibits “MY-3”). For example, the Opponent’s parent company, Philip Morris International, sold nearly 5 billion units of such cigarettes (Marlboro brand) in 25 markets worldwide in 2011 and a total of 8.2 billion units including other brands in 2011;
- ix. Given the common use of the capsule technology the term “Click & Roll” is descriptive of the characteristics and/or intended purpose of the cigarettes incorporating a flavour capsule in their filters and is unable to distinguish the Applicant’s products from that of others in class 34;

- x. The term “Click” is merely an informational designation using a common word employed in its ordinary meaning. The Applicant and its competitors use the words in a descriptive manner to inform consumers how to use their products;
- xi. The words “Click” and “Roll” or the phrase “Click & Roll” or similar phrases thereto are necessary to describe the characteristics and/or purpose of the products. It is essential that the Opponent should be allowed to advertise its goods under class 34 and convey information to its consumers. Section 11(1)(c) of the Act aims to protect traders in this respect;
- xii. Other traders of cigarettes including the Opponent also use the word “click” in its ordinary meaning to inform consumers how to use the product (Exhibits “MY-4”);
- xiii. The Applicant itself uses the words “click” and “roll” in a descriptive manner (Exhibits “MY-5”);
- xiv. Allowing a single company to monopolize the term would deprive competitors of an effective word to describe the characteristics and mode of operation of their products;
- xv. The Opponent has successfully opposed the trade mark applications for “CLICK” and “CLICK & ROLL” in other jurisdictions, on the basis that the marks were non-distinctive and descriptive (Exhibits “MY-6” and “MY-7”).

10. Attached to Mr. Yaouanc’s Declarations were the following exhibits:

- i. Photocopies of excerpts from the *Oxford English Reference Dictionary, 2nd Ed., p. 272 and pp. 1248-1249* (Exhibits “MY-1”);
- ii. Images of a cut cigarette filter showing a capsule (Exhibits “MY-2”);

- iii. Images showing use of the capsule products in respect of several of the Opponent's or related companies' brands of cigarettes (Exhibits "MY-3");
- iv. Images showing ordinary descriptive use of the term "Click" in respect of capsule products by tobacco companies other than the Applicant (Exhibits "MY-4");
- v. Images showing descriptive use of the terms "Click" and "Roll" by the Applicant in its promotional literature and packaging (Exhibits "MY-5"); and
- vi. Opposition decisions for the same marks from the Dominican Republic and Costa Rica (Exhibits "MY-6") and from New Zealand (Exhibits "MY-7") in which the Opponent was successful on the basis that the marks were descriptive and non-distinctive.

11. In his second set of Declarations made on the 21st of November, 2013 in response to the Declarations of Stuart Paul Aitchison for the Applicant, Mr. Yaouanc states *inter alia* that:

- i. In the list of countries where the trademark has been registered, only four are English speaking. Based on the fact that each trade mark Registry operates independently and in accordance with their own standards, it is of little significance that the Applicant has succeeded in registering this trade mark elsewhere, particularly in non-English speaking jurisdictions;
- ii. The argument that the term "Click" is a verb and does not by nature qualify as being descriptive of Class 34 goods is not plausible. Words and phrases that communicate information about a product to a consumer do not qualify for trade mark protection;
- iii. Despite the Applicant's claim that it is the sole trader in class 34 using the phrase "Click & Roll", that does not mean

- that the phrase is or has the possibility of becoming proprietary;
- iv. The basis upon which the terms “Click” and “Click & Roll” could become proprietary is that the words must be capable of performing the function of a trade mark. The terms “Click” and “Click & Roll” do not and cannot perform that function;
 - v. The capsule technology for class 34 goods is relatively new. The Application to trade mark the terms “CLICK” and “CLICK & ROLL” will essentially monopolize those words within the industry, which would be unfair to other traders;
 - vi. The “Click & Roll” phrase is not dominant in the Applicant’s packaging, nor does it suggest a source of origin to the consumer. Further, in the Applicant’s use of the words “Click” and “Roll”, there is no significance or prominence of these words over and above other descriptive words such as “change” and “taste”. Consumers do not see such phrases as trade marks, but as descriptions or instructions. Words and phrases such as “smoke”, “inhale”, “puff”, “exhale” are all verbs which would not qualify for trade mark protection. Words and phrases which communicate information about a product to a consumer do not qualify for trade mark protection;
 - vii. The fact of a word or phrase not being widely used, especially in the case of relatively new technology, does not render it distinctive; and
 - viii. in assessing the ruling of the Intellectual Property Office in Japan in favour of the Applicant, it ought to be considered that Japan is a non-English speaking country and that the ruling emphasised that “CLICK & ROLL” is not widely used and does not represent Class 34 goods.

Applicant's Evidence

12. On the 29th of May, 2013, the Applicant filed the Statutory Declaration of Stuart Paul Aitchison. Mr. Aitchison is an Authorised Attorney of the Applicant. In his Declarations made on the 20th of May, 2013, he states *inter alia* that:

- i. He is employed by the Applicant and is responsible for matters concerning the trade marks owned by the Applicant and the subsidiaries of the Applicant;
- ii. The unique phrase "CLICK & ROLL" was coined by the Applicant and alludes to actions that consumers may do while using cigarettes or tobacco products designed to allow them to be able to change the flavours of their cigarette. However the words together are not a term of art in the trade, nor are they descriptive or customary;
- iii. The Applicant is the only known trader that uses that unique combination of words "CLICK & ROLL" in relation to its tobacco products;
- iv. The Applicant uses the term "CLICK & ROLL" purely in a trade mark sense, as part of a tag-line that consumers will and have identified as a unique reference to the Applicant's goods;
- v. "Click" and "Roll" are separate words in the English language and are not customarily used together. Each word is a verb and so could not by nature qualify as being descriptive of Class 34 goods or the nature, quality or characteristics of those goods;
- vi. Other manufacturers can use the term without infringing the trade mark of the Applicant, once it is used to refer to an action to be performed by the consumer, and not a unique quality or characteristic of the goods. This "click" action is not unique to goods in class 34;

- vii. "CLICK & ROLL" and "CLICK" are inherently distinctive in relation to Class 34 goods. The terms are not generally or widely used in relation to those goods. A google search of the terms reveals that the words have no unique references or usage specifically related to Class 34 goods, except as used as a trade mark by the Applicant;
- viii. The Applicant's "CLICK & ROLL" mark has been accepted for registration by twenty-eighty trade mark authorities across the world and the Applicant's "CLICK" mark has been accepted for registration by nineteen trade mark authorities across the world in jurisdictions which have a similar trade mark jurisprudence regarding distinctiveness of trade marks as Jamaica; the Applicant has also submitted 57 other applications for registration of "CLICK" in countries across the world;
- ix. The Opponent was unsuccessful in Australia in opposing the Applicant's trade mark application for "CLICK & ROLL" where they argued that the mark did not possess sufficient inherent adaptation to distinguish the goods for which the protection was sought (class 34) and was capable of distinguishing such goods;
- x. The Applicant also received a favourable opposition decision in Japan.

13. Attached to Mr. Aitchison's Declarations were the following exhibits:

- i. A list from the internal database of the Applicant indicating the countries in which the "CLICK" and "CLICK & ROLL" marks have already been registered (Exhibits B1);
- ii. Copies of the registration certificates of the marks in countries which are parties to the Paris Convention (Exhibits B2);

- iii. Compilation from the Applicant's internal database of basic details regarding the applications related to Exhibits B2 (Exhibits B3);
- iv. Copy of Google search results for the term "CLICK" and "CLICK & ROLL" revealing that the terms have no unique references or usage specifically related to Class 34 goods excepting as used as a trade mark by the Applicant in relation to its "Lucky Strike Click & Roll" brand of cigarettes (Exhibits B4);
- v. A copy of the decision from Australia which denied the opposition by the Opponent to the registration of the "CLICK & ROLL" mark (Exhibit B5); and
- vi. A copy of the decision from Japan which also denied the opposition by the Opponent to the registration of the "CLICK & ROLL" mark (Exhibit B6).

The Opposition Hearing

14. By consent, the Opposition Hearing for both marks was held on August 21, 2014 before me, acting for the Registrar of Industrial Property. The Opponent was represented by Mrs. Kathryn Pearson, instructed by Livingston, Alexander & Levy, Attorneys-at-Law and the Applicant was represented by Mrs. Andrea Scarlett-Lozer, instructed by Myers, Fletcher & Gordon, Attorneys-at-Law.
15. Based on the Notices and Statements of Grounds filed by the Opponent, the registration of the Applicant's marks were opposed on the following grounds:
 - i. pursuant to s.11(1)(a) of the Act;
 - ii. pursuant to s.11(1)(b) of the Act;
 - iii. pursuant to s.11(1)(c) of the Act; and
 - iv. pursuant to s.11(1)(d) of the Act.

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

16. 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 trade mark 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.

17. A sign is defined by section 2 (1) of the Act to include “*a word (including a personal name), design, letter, numeral, colour, combination of colours or a combination of the foregoing or the shape of goods or their packaging*”. It is clear that the Applicant’s marks qualify as signs under the Act, as its “CLICK & ROLL” mark consists of two words and a design and its “CLICK” mark consists of a word alone. The Applicant’s signs can be and have been graphically represented as contained in the Trade Mark Application Nos. 56,881 and 56,909. The question is whether the Applicant’s marks are capable of distinguishing the goods of the Applicant from those of other traders. In answering that question, I will assess whether the marks are, as alleged, devoid of distinctive character or exclusively descriptive or customary.

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

18. Holyoak & Torremans, *Intellectual Property Law*, 5th Ed., page 380-382 lists salient considerations in determining whether a mark is devoid of distinctive character, namely:

- i. What message does the trademark convey? Can the trademark convey that the relevant goods are that of a particular trader?

- ii. Does the trade mark perform the essential function of a trade mark?
Can it identify the origin of the goods so as to enable the consumer to repeat or avoid the experience he/she has had with the goods?
- iii. From the point of view of the relevant public, is the trade mark commonly used for the presentation of the goods in question, and is there concrete evidence to justify a conclusion that the trade mark is capable of being used in this way?
- iv. Distinctiveness must be considered specifically with regard to:
 - (a) The nature of the goods in question; and
 - (b) The perception/presumed expectation of the relevant consumer (being reasonably circumspect, well informed and observant).

19. Applying the above considerations, Counsel for the Opponent submitted that the word 'CLICK' conveys no message to the consumer and does not possess any character that is indicative of the Applicant or any particular trader.

20. The Opponent highlighted the importance of the usage of words for word marks. 'Usage' here meaning usage by those engaged in the relevant trade and includes the average consumer, as well as manufacturers, wholesalers and retailers. The Opponent argues that the ordinary meaning of 'click' with its manner of usage in the trade, renders this mark incapable of conveying any message to the consumer other than purely instructional information.

21. Counsel for the Opponent also argued that the word 'click' cannot act as a trade mark and cannot communicate to the consumer and identify the origin of the goods in the way which a trade mark must. The Opponent argues that if a consumer were to rely on 'click' as a badge of origin, the consumer would fail. He could purchase from any of the Applicant's competitors.

22. The Opponent argued that 'click' is currently being used by several traders in relation to this class and it is an instructional word relating to those types of cigarette products, as well as a common word, which should remain available for use by others in the industry.

23. The Opponent argues that the mark 'click' and whether or not it is distinctive must be considered from the standpoint that the relevant consumer would be the average smoker in Jamaica. They argue that the consumer will perceive 'click' as merely instructional.

24. Counsel for the Opponent cited *inter alia* the following cases:

- a. *Wella AG v OHIM [2010] E.T.M.R. 27* – “TAME IT”, a trade mark for hair products and cosmetics, was refused because it lacked distinctive character. It was held that “the consumer will immediately perceive it as promotional or advertising information, inciting him to use those products and/or informing him about the desired effect of using those goods rather than as an indication of their commercial origin”. The Court ruled that “registration of a trade mark which consisted of signs or indications that were also used as advertising slogans was permitted only if the mark in question would be perceived immediately as an indication of the commercial origin of the good or services so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the proprietor of the mark from those of a different commercial origin.”
- b. *The Sherwin-Williams Company v OHIM EU: Case T-190/5, Celex No. 605TJ0190* – concerned an application to register the mark “TWIST & POUR” for handheld plastic containers sold as an integral part of a liquid paint containing storage and pouring device. The Court ruled that as the two common English words convey information about how to use the product and as “the use of the ampersand “&” meaning “and” does not add anything in terms of the distinctiveness of the sign, since use of that typographical sign is

commonplace in the English language... the syntactic structure of the word mark TWIST & POUR must be regarded as straightforward and normal in the English language". Therefore the structure of that sign and the bringing together of the two words by linking them by means of the typographical sign '&' are not, as a whole, so perceptibly different from terms used in the ordinary language of the relevant public as to confer on the sign a distinctive character within the meaning of *Procter & Gamble v OHIM* (the *BABY-DRY Case*), [2001] ECR I6251. The Court also affirmed that "the sign was composed of generic terms which merely designated a characteristic of the product, concerning in particular its method of use."

- c. *MLP Finanzdienstleistungen AG v OHIM* [2006] – the mark "BESTPARTNER" was refused on the ground that the terms 'best' and 'partner' are generic words which simply denote the quality of services supplied by an undertaking to its clients. The Court ruled that it would be different only if the term resulting from the two words being coupled together meant something other than the meaning denoted by the two terms placed side by side.

25. The marks in question, "CLICK" and "CLICK & ROLL" are said by the Opponent to allude to actions that consumers may do while using cigarette or tobacco products that are designed to allow them to be able to change the flavours of their cigarette. The Opponent claims therefore instead that the words which make up the mark are wholly descriptive and non-distinctive in relation to cigarettes and tobacco products.

26. As such, the Opponent claims that, due to the common use of the type of technology used in the particular cigarettes, the terms, it will be very difficult to distinguish the Applicant's products from that of other brands by use of the words "Click" and "Click & Roll". Therefore the use of the words "Click" and "Click & Roll" in relation to capsuled cigarettes is merely informational thus making them purely descriptive. The Opponent

asserts that the marks are therefore not registrable due to lack of distinctiveness and likens the marks to the use of “tear here” on a packet of ketchup or similar product. The Opponent exhibits examples of the mark “Click” being used by other brands (see MY-4; MY-5), in order to show the common use of the mark within the product field.

27. The Applicant contends, however that on close examination of the exhibited evidence, one can see that the use of the term “Click & Roll” as such is exclusively used by the Applicant. Other brands separate the phrase and use the words individually. Furthermore the Applicant seeks to distinguish how it uses the “CLICK” and “CLICK & ROLL” marks from that of its competitors, that is, that other traders use the marks in a descriptive manner whereas the Applicant says it uses the marks in an uncommon trade mark sense.

28. The Applicant denies the Opponent’s allegation that the words “click” and “roll” are used by the Applicant in a descriptive sense and argues that there is a perceptible difference between the “CLICK & ROLL” trade mark and the use of those words in common parlance, in that the combination of the two words as well as the use of the ampersand is unique. The Applicant thus argues that their “CLICK” and “CLICK & ROLL” marks are inherently distinctive, satisfying the minimum degree of distinctive character required by the Act for registration. The Applicant claims the marks can function as badges of origin and are not descriptive or customary.

29. The respective goods for which the applications are sought to cover are tobacco, tobacco products and accessories. The question that follows then is whether the Applicant's trade mark will enable the consumer to identify the source of the above named goods and differentiate those from other class 34 goods produced by other manufacturers.

30. According to *Kerly’s*, in order to determine distinctiveness, one must consider the consumer’s view of the origin of the trade mark, as well as

the use of the mark within the industry to indicate origin.¹ Aldous L.J. in *Phillips v Remington*² noted that a trade mark is distinctive once its character enables it to be distinct from that of another trader's goods as it relates to the origin of the goods.

31. The oft cited case of *Windsurfing Chiemsee Produktions- und Vertriebs GmbH v Boots- und Segelzubehor Walter Huber & Franz Attenberger*³ indicated that a mark could acquire distinctiveness through use if it initially lacked distinctiveness. This would therefore constitute an exception to the rule that a mark cannot be registered if it lacks distinctiveness as its secondary distinctive meaning would displace the primary descriptive meaning as was observed by Chadwick L.J. in *Bach Flower Remedies*.⁴

32. The following principles are instructive when assessing distinctiveness:

- a. a minimum degree of distinctive character is sufficient to avoid refusal on that ground; 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);
- b. the overall impression of the mark must be considered, as the average consumer normally perceives a mark as a whole and does not proceed to analyze its various details, though, it may be useful to examine each of the constituent features of the trademark. (Case C-144/06 P *Henkel KgaAv OHIM* [2007] ECR I-08109, paragraph

¹ Kerly's, para. 7-36

² [1999] R.P.C. 809 at 819

³ [1999] ECR I-2779

⁴ SRIS C/78/99

39; Case C-286/04 P *Eurocermex v OHIM* [2005] ECR I-5797, paragraphs 22 and 23; Case C-251/95 *Sabel BV v Puma AG* [1997] ECR I-06191, paragraph 23);

- c. the average consumer is reasonably well informed and reasonably 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).

33. It is not necessary to show that a mark has a particular level of creativity or originality in order to establish distinctive character: Case C-329/02P SAT.1 *Satelliten Fernsehen GmbH v OHIM* [2005] ETMR 20 (ECJ) at [41]. While the Court of First Instance ("CFI") has repeatedly referred to "a minimum degree of distinctive character" the ECJ has not adopted this wording and has deemed it unnecessary to give any more precise definition to the possible dividing line between lack of distinctiveness and the minimum distinctiveness to which the CFI refers: *Deutsche Krankenversicherung AG v OHIM ("COMPANYLINE")* [2002] ECR I-7561 at [20].

34. Given that the average consumers of the Applicant's products are cigarette smokers, one must determine how they view the Applicant's marks. The Applicant has not provided any data to show the brand perception in the Jamaican market. The Opponent maintains that both marks are non-distinctive in relation to tobacco products and as such are incapable of distinguishing the Applicant's goods from those of other traders.

35. It is worthy to note that the particular capsuled filter cigarettes are not available in Jamaica as of the relevant date which is the date of filing of the applications for registration. Hence the average Jamaican consumer of class 34 goods may not be familiar with the capsuled filter technology. Nevertheless, the Registrar must assess the extent to which the average Jamaican smoker of cigarettes would be able to perceive the Applicant's marks as distinctive enough as badges of origin of the Applicant's goods alone, as at the date of filing of the applications for registration.
36. The question for determination therefore is whether other traders are likely, in the ordinary course of business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods (*W&G du Cros Ltd's Application* (1913) 30 RPC 660 at 671-672).
37. Examining Exhibits MY-3 and MY-4 attached to Statutory Declaration of Maximilien Yaouanc dated the 18th of October 2012, said to be some examples of the use of capsuled products in class 34 by several of the Opponent's or related companies' brands, and other tobacco companies other than the Applicant, it is clear that the use of capsuled filters in cigarettes is quite common in the international tobacco industry today. The question however is whether the marks used by the Applicant for which it has applied for registration, ought to be registered in Jamaica in relation to those capsuled types of cigarettes.
38. Examining Exhibits MY-3, it is clear that few of the Opponent's class 34 goods use the words "CLICK" and/or "CLICK & ROLL". Those that do include the "Marlboro Blue Ice" which includes on its packaging the instructional steps to 1. Press the filter 2. change the flavour and 3. Listen for the click; and the "A FLAVA CLICK MINT" which also includes instructions to "click for mint" and to "experience the innovation of click mint" by squeezing the filter, hearing the click and changing the flavour.

39. Examining Exhibits MY-4, it is clear that among other traders of class 34 goods (apart from the Applicant) who have capsuled filters, RJ Reynolds' 'Camel Crush' brand uses the term 'crush' while inviting consumers to "squeeze, click, change!; squeeze the capsule, hear the click and change the taste." Imperial Tobacco's 'Fortuna Bi Arom' Clic' uses the term "choose with a click" and "click it." in its advertising and includes a click sign on its packaging and capsuled cigarettes. 'New Marlboro Beyond' cigarettes use "A change in a click" in their advertising. Imperial Tobacco's 'West Duo' brand of cigarettes include on their packaging instructions to 1. Crush the capsule... 2. Hear the click and 3. Enjoy...
40. Examining how the Applicant uses the marks, as exhibited in MY-5, the Applicant also uses the word "click" on its 'Lucky Strike' packaging, informing customers to "click the capsule to change the taste, and then roll it around to turn it up." On its Dunhill Switch brand promotional literature the Applicant uses "click to switch" and answers "how does it work" by explaining that "consumers can click to switch by simply crushing the capsule between their fingertips until they hear the "click"..". On its Lucky Strike advertising, the Applicant uses "CLICK the capsule, CHANGE the taste, ROLL your lucky for more intensity" and "CLICK the capsule, CHANGE the taste, INCREASE the intensity". The Applicant also uses "click here" and "click & roll" in its "Nuevo Lucky Strike Click & Roll 10". This therefore brings into play an overlap with the third ground of opposition, namely whether the marks as applied for are exclusively descriptive and ought to be refused registration by virtue of section 11(1)(c) of the Act.
41. When one looks at the "CLICK & ROLL" mark in question and the manner in which it is used by the Applicant, it is difficult to identify a minimum level of distinctiveness required for registration. I find that the mark is descriptive of functions or instructions related to the goods, which functions or instructions ought to be available to be used by other traders of capsuled filter cigarettes.

42. Although there is no evidence of other traders of class 34 goods using the words “click” and “roll” together or using the sign “CLICK & ROLL” and it is not a sign which as a whole is necessary to be used by other traders of capsuled cigarettes, it nevertheless remains true (as it was in the “*TAME IT*” case) that the semantic content of the sign follows the rules of ordinary English grammar, syntax and spelling and therefore would be perceived by the average consumer as promotional or advertising information related to characteristics of the goods and as an order or invitation to use the goods in that manner and according to those instructions, rather than as an indication of the commercial origin of those goods. This is especially so as the use of verbs in the imperative is customary in the field of advertising (see the “*TAME IT*” case, para. 32). The overall impression of the mark therefore would give no different perception than the ordinary English reading and interpretation of it does.

43. Similarly, the evidence shows that the word “click” is used widely in the international market by traders of capsuled cigarettes in class 34, including the applicant, in a descriptive and instructional manner, precisely in the way that the word is ordinarily perceived and interpreted in the English language.

Section 11(1)(c): 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

44. Section 11(1)(c) of the Act provides that:

“Subject to subsection (2) the following are not registrable under this Act:...

(c) 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;”

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.”

45. The Opponent relied on Bentley & Sherman, *Intellectual Property Law*, where it is stated that “to avoid objection under section 3(1)(c) the applicant will need to establish that the sign is not used (and unlikely to be used in the future) as a description of the characteristics of the goods or services.” The Opponent submitted that the evidence shows conclusively that the signs are so used by the Applicant.

46. Counsel for the Opponent quoted Bentley and Sherman to submit that the section prohibits the use of a word as a trade mark which “describes what the product does, suggests what the consumer is to do with the product, or outlines what happens when the product is consumed”. The Opponent submits, based on exhibits “MY-1”, “MY-3”, “MY-4” and “MY-5”, that it is clear that the words “CLICK” and “CLICK & ROLL” are descriptive of the intended purpose of the product and a characteristic of the product, as it instructs the consumer how to use the product.

47. In support of that point the Opponent relied on several cases including:

- a. *Finanzdienstleistungen AG v OHIM (BESTPARTNER case) [2006] ETMR 20* – discussed above under s. 11(1)(b).
- b. *The Sherwin Williams Co. v OHIM (TWIST & POUR case) (2007)* – discussed above under s. 11(1)(b).
- c. *Irwin Industrial Tool Co. v. OHIM – EU: Case T-61/03 Celex No. 603T00061* – This case concerned the “QUICK-GRIP” trade mark which failed at examination. It was held that “the choice of the words ‘quick’ and ‘grip’ by no means requires a leap of imagination

or arbitrary decision on the part of the consumer” and that as there was “nothing unusual about the structure of the sign” as it did not diverge from but actually complied with English word composition rules, it was not registrable, because “it will not be perceived as unusual by the consumer concerned. The Opponent argues that “CLICK” and “CLICK & ROLL” like ‘QUICK-GRIP’ enable the targeted public to ascertain immediately that the cigarette’s filter can be clicked to achieve a result and does not require a leap of imagination.

- d. *Streamserve Inc v OHIM [2005] E.T.M.R. 57* – this case concerned an application to register “STREAMSERVE” for a variety of goods. The Court found that the word referred to a technique for transferring digital data from a server, enabling that data to be processed as a steady and continuous stream, thereby designating a characteristic of most of the goods and it was therefore refused registration on that basis. It was held that “the word STREAMSERVE, being made up of two English words without any additional unusual or innovative element, was descriptive of the intended use of the goods concerned... and devoid of distinctive character”.
- e. *Duro Sweden AB v OHIM (EASYCOVER case) [2009] ETMR 22* – concerned an application to register “EASYCOVER” for building materials, textiles, mats and related goods. The Court noted that structurally the sign is not unusual, as it consists of coupling together two words that are common in the English language and complies with the English rules of syntax and grammar. The Court thus ruled that “the sign does not create an impression on the part of the target public sufficiently removed from that produced by the mere juxtaposition of the words to change their meaning or scope” and concluded that “the sign applied for conveys a message which is immediately understandable and which can serve, in trade, to indicate the quality or intended use, and therefore the characteristics of the goods in question”.

48. The general principle highlighted by the cases cited is that descriptive signs that relate to multiple characteristics of goods, or that denote geographical origin etc. in respect of which registration as a mark is sought, should be available to be freely used by any trader who so wishes to use the mark in the promotion of their good/service. This is so unless the sign creates an impression on the part of the target public that is sufficiently removed from that produced by the mere juxtaposition of the words to change their meaning (*Duro Sweden AB v OHIM* [2009] ETMR 22).
49. Counsel for the Applicant argued that the words “click” and “roll” are verbs that refer to actions which cannot be said to constitute descriptions of cigarettes and that, applying the *ratio decidendi* from the *BABY-DRY* case, the Applicant’s “CLICK & ROLL” mark may be treated as a “lexical invention or unusual juxtaposition” that is not descriptive.
50. *Procter & Gamble v OHIM* (the *BABY-DRY Case*) [2001] ECR I6251, concerned an application to register the trade mark *BABY-DRY* for disposable diapers. OHIM’s examiner refused the mark as exclusively descriptive and non-distinctive. OHIM’s First Board of Appeal dismissed the appeal on the same basis. The Court of First Instance agreed on that aspect with the Board of Appeal. The European Court of Justice (ECJ) stated that the purpose of the prohibition of registration of purely descriptive signs as trade marks is to prevent registration as trade marks of signs which could not fulfil the function of trade marks and are devoid of distinctive character, because they are no different from the usual way of designating the relevant goods or services or their characteristics (para. 37). Such signs are those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought (para. 39). Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of

consumers to designate the goods or services or their essential characteristics, is apt to confer distinctive character on the word combination, enabling it to be registered as a trade mark (para. 40).

51. Therefore the determination to be made depends on whether the word combination in question may be viewed as a normal way of referring to the goods or of representing their essential characteristics in common parlance (para. 42). The ECJ found that although each of the two words may form part of expressions used in everyday speech to designate the function of babies' nappies and although the combination of words *BABY-DRY* unquestionably alluded to the function which the goods are supposed to fill, it still did not satisfy the disqualifying criteria of the law, as "their syntactically unusual juxtaposition is not a familiar expression in the English language, either for designating babies' nappies or for describing their essential characteristics" (para. 43).

52. The case of *Koninklijke KPN NV v Benelux-Merkenbureau (POSTKANTOOR case)* [2006] Ch. 1, makes mention of how the rule in the EU is generally applied. The court stated that :

"54. As the Court has already held (*Windsurfing Chiemsee*, para.[25], *Linde*, para.[73], and *Libertel*, para.[52]), Art. 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that such signs or indications may be freely used by all. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

55. That public interest requires that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods. Therefore, marks

consisting exclusively of such signs or indications are not eligible for registration unless Art. 3(3) of the Directive applies.

56. In those circumstances, the competent authority must, under Art.3(1)(c) of the Directive, determine whether a trade mark for which registration is sought currently represents, in the mind of the relevant class of persons, a description of the characteristics of the goods or services concerned or whether it is reasonable to assume that that might be the case in the future (see to that effect *Windsurfing Chiemsee*, para.[31]). If, at the end of that assessment, the competent authority reaches the conclusion that that is the case, it must refuse, on the basis of that provision, to register the mark.

57. It is irrelevant whether there are other, more usual, signs or indications for designating the same characteristics of the goods or services referred to in the application for registration than those of which the mark concerned consists. Although Art. 3(1)(c) of the Directive provides that, if the ground for refusal set out there is to apply, the mark must consist exclusively of signs or indications which may serve to designate characteristics of the goods or services concerned, it does not require that those signs or indications should be the only way of designating such characteristics.”

53. The several cases discussed above provide a thorough framework for analysing the “CLICK” and “CLICK & ROLL” marks.

54. The most decisive way to approach this matter is from the perspective of “the relevant class of persons” who would be the average cigarette smoker in Jamaica who is deemed to be reasonably well informed, reasonably observant and reasonably circumspect. For that class of

persons, cigarettes and other class 34 goods are non-luxury, everyday goods purchased routinely without any special care and attention.

55. The Opponent claims that the words “Click” and “Click & Roll” are used to describe the intended purpose of the cigarettes and this is seen in their exhibits (MY-5). This evidence shows the words “Click” and “Roll” used separately in descriptive and instructional ways by traders including the Applicant. However the examples provided differ from the manner in which the Applicant uses its “CLICK & ROLL” mark.

56. It is also useful to note the case of *BioID AG v OHIM*⁵ where it was stated that for a mark to be deemed descriptive of characteristics of goods and services, there must be a direct and specific relationship between the sign and the goods/services to lead to public perception of the description of the goods based on the sign.

57. Neither the “CLICK & ROLL” nor the ‘CLICK” mark is particularly creative nor do they create a distinctive impression of the goods beyond the descriptive. Just as in the “QUICK-GRIP”, “TWIST & POUR”, “BESTPARTNER”, “STREAMSERVE” and “EASYCOVER” cases, the choice of words by no means reveals any innovation nor requires a leap of imagination or arbitrary decision on the part of the consumer and there is nothing unusual about structure of the signs as they do not diverge from but actually comply with English word composition rules. As such, the marks are contrary to section 11(1)(c) in that the marks consist exclusively of signs or indications, which may serve, in trade to designate the kind, quality, purpose or other characteristics of the goods.

58. As held in the “TAME IT” case, registration of marks which consist of signs or indications that are also used as advertising slogans is permitted only if the marks in question would be perceived immediately as an indication of the commercial origin of the goods or services so as to enable the relevant

⁵ Case C-37/03 P

public to distinguish, without any possibility of confusion, the goods or services of the proprietor of the mark from those of a different commercial origin.

59. Neither of the applied for marks creates an impression on the part of the target public sufficiently removed from that produced by the mere juxtaposition of the words to change their ordinary, descriptive meaning or scope. The marks convey a message which is immediately understandable and which can serve, in trade, to indicate the quality, purpose or intended use, and therefore the characteristics of the goods in question. Coupling the two terms together in “CLICK & ROLL” without any graphic or semantic modification, does not imbue them with any additional characteristics such as to render the sign, taken as a whole, capable of distinguishing for the relevant public the applicant’s services from those of other undertakings.

60. It is also very persuasive to note that in *Sherwin Williams Co. v OHIM* (TWIST & POUR case) (2007), the Court ruled that as the two common English words convey information about how to use the product and as “the use of the ampersand “&” meaning “and” does not add anything in terms of the distinctiveness of the sign, since use of that typographical sign is commonplace in the English language... the structure of that sign and the bringing together of the two words by linking them by means of the typographical sign ‘&’ are not, as a whole, so perceptibly different from terms used in the ordinary language of the relevant public as to confer on the sign a distinctive character” within the meaning of the *BABY-DRY* case.

61. The mark “CLICK & ROLL” comprising the words “click” and “roll” used in combination with the common device of an ampersand, would give no greater meaning to the average consumer beyond instructional, promotional, advertising information and therefore would not be perceived by the average consumer as indicating origin from the Applicant. The semantic content of the sign follows the rules of ordinary

English grammar, syntax and spelling and therefore would be perceived by the average consumer as promotional or advertising information related to characteristics of the goods and as an order or invitation to use the goods in that manner and according to those instructions, rather than as an indication of the commercial origin of those goods. The marks as applied for do not fall within the context which was found in the *BABY-DRY* case as there is no corresponding syntactical juxtaposition in the instant marks.

62. There is no likelihood of acquired distinctiveness in Jamaica and no evidence of same was presented.

63. As a result the Opposition to the registration of “CLICK & ROLL” succeeds under section 11(1)(c) of the Act, on the basis that the mark consists exclusively of a sign or indication which may serve in trade, to designate the kind, quality, intended purpose, value, or other characteristics of the goods applied for.

64. In relation to the mark “CLICK”, the evidence shows that the word “click” is used by several traders of cigarettes in class 34 including the applicant in a descriptive and instructional manner, precisely in the way that the word is ordinarily perceived and interpreted.

65. As a result, the Opposition to the registration of “CLICK” succeeds under section 11(1)(c) of the Act, on the basis that the mark consists exclusively of a sign or indication which may serve in trade, to designate the kind, quality, intended purpose, value, or other characteristics of the goods applied for .

66. Counsel for the applicant submitted that if found descriptive, non-distinctive and unregistrable, the marks should only be refused in relation to cigarettes but not in relation to tobacco, tobacco products, lighters, matches and smokers’ articles. Counsel for the Opponent submitted that tobacco products and smokers’ articles would also be affected. I also

agree with Counsel for the Opponent on that point, as smokers' articles could include cigarette tips, filters and rolling paper. However I consider that as cigarettes are comprised mainly of tobacco and as tobacco could ostensibly include cigarettes, I will also refuse registration of the marks in relation to tobacco.

67. The registration of both marks is therefore also refused in relation to cigarettes, tobacco, tobacco products and smoker's articles, on the basis of contravention of section 11(1) (b) of the Act, in that the marks are devoid of distinctive character.

68. As a result, the marks are also refused registration in relation to those goods by virtue of section 11(1) (a) of the Act, in that they are incapable of distinguishing those goods of the Applicant from those of other traders of the abovenamed goods and therefore the marks do not satisfy the definition of a trade mark in respect of those goods.

Section 11(1)(d): Signs which have become customary in the current language or in the *bona fide* and established practices of the trade

69. Section 11(1)(d) of the Act 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 bona fide 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."

70. In deciding whether at the relevant date, which is the date of the applications, "CLICK" and "CLICK & ROLL" had become "customary in the current language or in the bona fide and established practices of the trade", it is important to determine how consumers perceive the marks in Jamaica.

71. The Opponent claims that the words "click" and "roll" are used within the cigarette trade as descriptive of various actions related to the use of cigarettes and that these words are even more customary in the sector of the cigarette trade that produces a certain type of cigarette that features a capsule inserted in the filter portion of the cigarette which, if clicked, the capsule releases a mint flavour which changes the taste of the cigarette from a regular cigarette to a menthol one, or increases the strength of the menthol flavour. The "Click" is onomatopoeic of the sound made when pressing the capsule and the word "Roll" describes the way in which the filter is to be rolled to intensify the menthol flavour.

72. The Opponent also references the widespread use of these specialty cigarettes in the international market, citing graphical examples of how the cigarettes are used in respect of several competitor companies (Exhibit 'MY-3'). This evidence presented shows use by some competitors of only the term "Click".

73. While it is evident that the technology is widely used in trade and one cannot ignore the use of the word "Click", this does not show an established use of the signs "Click" and "Click & Roll" in Jamaica.

74. Overall there is no evidence to establish that the terms have become customary in the current language or in the established practices of the trade in Jamaica at the relevant date. Though persons in Jamaica travel

overseas from time to time and may have become exposed to the capsuled filter technology, those types of cigarettes are not and have never been available in Jamaica and therefore it is unlikely that the words “Click” and “Click & Roll” are generally known to the average consumer of class 34 goods in Jamaica. It is therefore highly unlikely that the words “Click” and “Click & Roll” would have become customary in the current language or in the bona fide and established practices of the trade of class 34 goods in Jamaica. As stated previously, no evidence of this in Jamaica was presented.

75. There is also no likelihood of acquired distinctiveness in Jamaica and no evidence of same was presented.

76. The s. 11(1)(d) ground of opposition therefore fails.

Conclusion

77. In respect of cigarettes, tobacco, tobacco products and smoker’s articles, Trade Mark Application Nos. 56,881 and 56,909 to register “CLICK & ROLL” and “CLICK” respectively are refused and Opposition Nos. 60/TM2011 and 61/TM2011 are upheld on the bases that:

- i. the marks consist exclusively of a sign or indication which may serve in trade, to designate the kind, quality, intended purpose, or other characteristics of those goods and therefore contravene section 11(1)(c) of the Act in respect of those goods;
- ii. the signs are devoid of distinctive character in respect of those goods and therefore contravene sections 11(1)(b) of the Act in respect of those goods; and

- iii. the signs do not satisfy the definition of a trade mark in respect of those goods and therefore contravene sections 11(1)(a) of the Act in respect of those goods.

78. There is no order as to costs.

Marcus Goffe
for Registrar of Industrial Property
March 1, 2016