



**IN THE MATTER OF APPLICATION NO. 57,707  
BY BRITISH AMERICAN TOBACCO (BRANDS) LIMITED  
TO REGISTER THE TRADE MARK**

**SWITCH**

**IN CLASS 34  
AND IN THE MATTER OF OPPOSITION NO. 66/TM2011  
BY PHILIP MORRIS PRODUCTS S.A.**

**IN THE MATTER OF APPLICATION NO. 57,707  
BY BRITISH AMERICAN TOBACCO (BRANDS) LIMITED  
TO REGISTER A TRADE MARK IN CLASS 34  
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**DECISION AND REASONS FOR DECISION**

**The Application**

1. On the 17<sup>th</sup> day of March 2011, 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 mark “SWITCH”.
2. The Application relates to the following class and goods:  
  
*34 - Cigarettes; tobacco; tobacco products; lighters; matches; smokers’ articles.*
3. On the 6<sup>th</sup> day of May, 2011, the Registrar of Industrial Property at the Jamaica Intellectual Property Office (JIPO) accepted the mark for publication. The application was subsequently published in the Trade Marks Journal No. 001, Vol. 0003 dated the 27<sup>th</sup> day of June, 2011.

**Grounds of Opposition**

4. A Form TM 4 - Notice of Opposition accompanied by a Statement of the Grounds of Opposition was filed on August 2, 2011 by Livingston, Alexander & Levy, Attorneys-at-Law, on behalf of Philip Morris Products S.A. (hereinafter referred to as “the Opponent”).
5. According to the Statement of Grounds filed, the Opponent opposes the proposed registration of the trade mark on the following grounds:

- (1) the proposed trade mark “SWITCH” is a verb used to describe an action relative to a cigarette product which contains a flavoured capsule in the filter or other mechanism by which the consumer can "switch" the flavour of the cigarette being consumed.
- (2) "SWITCH" is an ordinary English word which means "to exchange" or "to change or transfer from one thing to another." This word is descriptive not only in connection with cigarettes as described in paragraph one, but also in the marketing of tobacco products and other products generally. By way of example, consumers are often encouraged by traders to "switch" from one product or brand to another.
- (3) The proposed trade mark “SWITCH” does not satisfy the definition of a "trade mark" set out in section 2 of the Act, as it not capable of distinguishing the goods of the Applicant from those of another undertaking. Accordingly, the registration of "SWITCH" is prohibited by section 11(1)(a) of the Act.
- (4) The proposed trade mark “SWITCH” is devoid of distinctive character, and accordingly the registration thereof is prohibited by section 11(1)(b) of the Act.
- (5) The proposed trade mark “SWITCH” consists 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 accordingly the registration thereof is prohibited by section 11(1)(c) of the Act.
- (6) The proposed trade mark “SWITCH” consists exclusively of a sign/indication which has become customary and common in the *bona fide* and established practices of the trade of goods in class 34. Accordingly, the registration of “SWITCH” is prohibited by section 11(1)(d) of the Act.
- (7) The proposed registration of the trade mark “SWITCH” by the Applicant in Jamaica would unfairly prejudice the lawful use of this descriptive term by traders in the normal course of business. The

Applicant's mark ought to be refused in the exercise of the Registrar's discretion having regard to the foregoing Grounds of Opposition.

### **Grounds of Counterstatement**

6. A Form TM 5 - Counterstatement and Grounds in support of the Counterstatement with attached Exhibit B1 were filed on behalf of the Applicant on December 21, 2010.
7. The Applicant denied all the statements and allegations set out in the Opponent's Grounds of Opposition. In particular, the Applicant stated that:
  - (1) Though the Applicant recognizes that the word 'switch' may have a common meaning in the English language, the trade mark must be assessed in respect of the goods for which the application has been filed. When assessed in that context, the trade mark "SWITCH" would not and cannot be perceived by the relevant public as describing of any well-known function or characteristic of a cigarette or tobacco product;
  - (2) SWITCH, in every respect, satisfies the definition of a "trade mark" under the Act, including the capacity to distinguish the goods of the Applicant from those of another undertaking;
  - (3) The trade mark "SWITCH" is not devoid of distinctive character. The Applicant's mark is distinctive in respect of goods for which it has applied for and accomplishes the essential function of a trade mark which is to distinguish the Applicant's products from those of third parties in the market.
  - (4) The Applicant's trade mark has acquired distinctiveness through use in a number of jurisdictions around the world. The mark is currently registered in Aruba, Austria, Bulgaria, Egypt, France, Germany, Italy, Japan, Korea, Lebanon, Liechtenstein, Morocco, United Kingdom and Vietnam. It is pending registration in Argentina, Brazil, Chile, Dominican Republic, New Zealand, Paraguay, Peru, Turkey, and Uganda, to name a few.

- (5) The "SWITCH" mark is not customary or common in the trade of Class 34 goods.

## Evidence

### Opponent's Evidence

8. On the 8<sup>th</sup> day of November, 2012 the Opponent filed the Statutory Declaration of Maximilien Yaouanc in support of the Opposition, with attached Exhibits MY-1 through to MY-7.
9. Mr. Maximilien Yaouanc is the Senior Counsel Trademarks with PMI Global Services Inc., a US Corporation and affiliated company of the Opponent and is in charge of trademark matters for the Opponent in the Latin America & Canada Region, which includes Jamaica. In his Statutory Declaration sworn to on the 18<sup>th</sup> of October, 2012 he states *inter alia* that:
  - (1) The word "switch" is wholly descriptive and non-distinctive in relation to cigarettes and tobacco products.
  - (2) According to the Oxford English Dictionary, 2nd Ed., pp 425-426, the word "switch" is an ordinary English word with the following meanings:
    - (a) Change or transfer position, subject, etc.
    - (b) To turn (an electrical device) on or off, etc.
    - (c) To reverse the positions of; exchange.
  - (3) Generally, the word "switch" is widely used in many industries meaning to operate a switching device or the result achieved by such an act. The term "switch" is also widely used by various traders in promotional literature to invite consumers to "switch" from brand A to brand B, or from product A to product B, which is the essence of commercial speech.

- (4) The Applicant and several of its competitors, including the Opponent, make and sell a type of cigarette with a capsule inserted in the cigarette filter. If the consumers choose, they can use the capsule, to "switch" the flavour from non-menthol to menthol or from menthol to a more intense menthol flavour. As applied specifically to tobacco products, particularly cigarettes, the term "switch" therefore designates the characteristics and/or intended purpose of the products for which registration is sought by the Applicant. See Exhibit MY-2.
- (5) In 2011, Philip Morris International ("PMI"), of which the Opponent is a part, sold nearly 5 billion units of MARLBORO cigarettes with a capsule in their filters in 25 markets worldwide. Additionally, PMI sells the brands LARK, L&M, PHILIP MORRIS and A FLAVA that all include the said capsule technology. In total, PMI sold 8.2 billion capsule cigarette units in 2011. See Exhibit MY-3 for selected examples of products using the capsule technology from the Opponent and several competitors.
- (6) "Switch", given the context, is not only inherently descriptive, but is necessary to accurately describe the characteristics and mode of operation of the goods sold and made by the Applicant, Opponent, and other competitors.
- (7) The Applicant themselves use the word "switch" in a descriptive manner to explain to consumers that by clicking the capsule they can switch flavour. See exhibit MY-4 ("click to switch" on the inner foil of DUNHILL cigarettes sold in South Korea and Malaysia; "crush to switch taste" on the inner lid of DUNHILL cigarettes in Taiwan; "fresh finish whenever you want. Click to switch", or "click to switch whenever you want", or "click & switch to experience a fresh finish" on retail leaflet and/or web site for DUNHILL cigarettes in Malaysia; "...choose to switch when it suits your taste" on the back panel of DUNHILL cigarettes in the United Arab Emirates; "new - switch from regular to menthol" on LUCKY STRIKE cigarettes in Hong Kong, and "can switch flavor" in Taiwan).

- (8) The word mark "SWITCH" contravenes section 11(1)(c) of the Act. The term is being used for its primary descriptive meaning - to describe the product and its functions. If the mark is registered in Class 34 it would be detrimental to the Opponent and other traders of Class 34 products. See Exhibit MY-5, where the capsule technology is described as ". . .probably the most important innovation in the cigarette industry since the introduction of filtered cigarettes" in the article "Branded New Kent Convertibles and two other cigarette brands added to our stock" extracted from the [www.mydiscountcigarette.com](http://www.mydiscountcigarette.com) website.
- (9) The Colombia Trademark Office, in similar proceedings, rejected the registration of the trade mark "SWITCH" in Class 34 because it found it to be non-distinctive and descriptive. See the decision in Exhibit MY-6. The Colombia Trademark Office held that ". . .the trademark applied for registration involves a word that describes one of the characteristics of the products to which it refers, since many cigarettes have as one their properties a [Capsule] device [. . .]. In consequence, the trademark applied for registration incurs in lack of distinctiveness and therefore, may not be considered a distinctive sign . . ."
- (10) It is critical to the Opponent, as a trader of goods in Class 34, to maintain its ability to convey accurate and relevant information to consumers, including the way in which to properly operate such products. See Exhibit MY-7 where the Opponent uses the term "SWITCH" in an informational and ordinary meaning in conjunction with its products "LARK FLAVOR" AND "LARK MINT-X", namely "Switch from full flavor to mint by crushing the mint capsule".
- (11) Allowing a single company to monopolize the term as a trademark would unduly deprive competitors of an effective word to accurately describe the characteristics and mode of operation of their products and put them at an unfair competitive disadvantage by requiring them to use less meaningful or effective words on pain of operating under a cloud of possible litigation from the Applicant.

10. On the 25<sup>th</sup> day of November, 2013 the Applicant filed the Statutory Declaration of Maximilien Yaouanc in response to the May 20, 2013 Statutory Declaration of Stuart Paul Aitchinson on behalf of the Applicant, wherein he states *inter alia* that:
- (1) Of the countries listed in paragraphs 3 and 4 of the Statutory Declaration of Stuart Paul Aitchinson, only six are English-speaking (Cayman Islands, New Zealand, BVI, UK, St. Maarten, and Singapore). Further, irrespective of other jurisdictions being members of the Paris Convention, each Registry functions independently and in accordance with their own standards and thresholds for distinctiveness. It is thus of little significance that the Applicant has succeeded in registering the "SWITCH" trade mark elsewhere, particularly in non-English-speaking jurisdictions.
  - (2) The argument put forward in paragraph 7 of the Statutory Declaration of Stuart Paul Aitchinson that verbs cannot be descriptive of goods, is not plausible. "Smoke" is a verb. "Inhale" is a verb. "Light", "exhale", and "puff" are all verbs. None of these verbs would qualify for trade mark protection. Furthermore, implicit in Mr. Aitchinson's statement is the fact that the word "switch" communicates information to consumers. Words which communicate information about a product to a consumer do not qualify for trade mark protection.
  - (3) In response to paragraph 8, even if the word "SWITCH" is not widely used, this would not be a basis upon which the word could become or has the possibility of becoming proprietary. What is required is that the word be capable of performing a trademark function, i.e., to distinguish the goods of a trader from those of other traders.

#### Applicant's Evidence

11. On the 27<sup>th</sup> day of May, 2013 the Applicant filed the Statutory Declaration of Stuart Paul Aitchinson, who is an Authorised Attorney of the Applicant. In



his Statutory Declaration made on the 20<sup>th</sup> day of May, 2013 he states *inter alia* that:

- (1) As of the date of the Jamaican application, the Applicant's "SWITCH" trade mark had been assessed for its capacity to perform a trade mark function and designate the origin of goods by thirty-four (34) trade mark examining and registration authorities across the world who accepted the "SWITCH" trade mark for registration. See Exhibit B-1, which is a list from the internal database of the Applicant indicating 38 registrations and 34 territories where the exact trade mark has already been registered.
- (2) Included among the 38 registrations are the following parties to the Paris Convention for the Protection of Industrial Property ("Paris Convention") that have similar trade mark jurisprudence to Jamaica: the United Kingdom, Republic of Korea, Japan, Mexico, New Zealand, Lebanon, and the European Community. See Exhibit B2 for registration certificates of the European Union, Japan, Lebanon, Mexico, New Zealand, the Republic of Korea and the United Kingdom.
- (3) The word "SWITCH" is currently being used in a trade mark sense only by the Applicant or under the Applicant's authority. The Applicant's "SWITCH" brand of cigarettes is currently being sold in the Middle East region, South Korea, Malaysia, Indonesia, Hungary, South Africa, the South American region and New Zealand.
- (4) There has been no evidence that traders have had difficulty describing their products due to the Applicant's use of the word "SWITCH". There is no evidence that traders in Jamaica will suffer any disadvantage where the trade mark "SWITCH" is used by the Applicant.
- (5) Further "SWITCH" in its ordinary English meaning 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. Thus, manufacturers and traders should be able to communicate with

consumers information regarding the description of Class 34 goods which feature the option of changing from one mode of cigarette to another, without infringing the Applicant's trade mark, which even if it is used would refer to an action to be performed by the consumer rather than a unique quality or characteristic of the goods.

- (6) "SWITCH" is inherently distinctive in relation to Class 34 goods. The word is not generally or widely used in relation to those goods. A Google search of the term reveals the most common use of the term in relation to cigarettes is in relation to the Applicant's cigarettes, namely, "DUNHILL SWITCH". See Exhibit B3.

### **The Opposition Hearing**

12. The Opposition Hearing was held on the 26<sup>th</sup> day of August, 2014 before me acting for the Registrar of Industrial Property. Mrs. Kathryn Pearson and Miss Kimberley Frith, Attorneys-at-Law instructed by Livingston, Alexander & Levy, appeared for the Opponent. Mrs. Andrea Scarlett-Lozer, Attorney-at-Law instructed by Myers Fletcher & Gordon, appeared for the Applicant. At the hearing both parties presented written as well as oral submissions and several authorities. Decision was reserved.
13. Based on the Notice and Statement of Grounds filed by the Opponent, the Applicant's mark was opposed on the following absolute grounds:
- (1) pursuant to s. 11(1)(a) of the Act;
  - (2) pursuant to s. 11(1)(b) of the Act;
  - (3) pursuant to s. 11(1)(c) of the Act; and
  - (4) pursuant to s. 11(1)(d) of the Act.

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

14. 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.

15. 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 mark qualifies as a sign under the Act, as its “SWITCH” mark consists of a word. The Applicant’s sign can be and has been graphically represented as contained in the Trade Mark Application No. 57,707. The question is whether the Applicant’s mark is capable of distinguishing the goods of the Applicant from those of other traders.

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

16. Counsel for the Opponent submitted that the Applicant’s proposed mark is unable to distinguish the goods of the Applicant from those of other traders as the mark is devoid of distinctive character. Holyoak & Torremans, *Intellectual Property Law*, 5<sup>th</sup> Ed., pages 380-382 lists salient considerations in determining whether a mark is devoid of distinctive character, namely:
- (a) What message does the trademark convey? Can the trademark convey that the relevant goods are that of a particular trader?
  - (b) 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?
  - (c) 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?
  - (d) Distinctiveness must be considered, specifically with regard to:

1. The nature of the goods in question; and
  2. The perception/presumed expectation of the relevant consumer (being reasonably circumspect, well informed and observant).
17. Applying the above considerations, Counsel for the Opponent submitted that the word 'SWITCH' conveys no message to the consumer and does not possess any character that is indicative of the Applicant or any particular trader. Counsel submitted that when a consumer sees this word, an ordinary English verb, it is difficult to imagine that they will perceive it as being anything other than (a) a description of what the capsulated filter will do; and (b) an instruction to 'switch' the flavour/intensity of the cigarette by clicking its filter.
18. The Opponent highlighted the importance of the usage of words for word marks, meaning usage by those engaged in the relevant trade, including the average consumer, as well as manufacturers, wholesalers and retailers (quoted from Holyoak & Torremans, *Intellectual Property Law*, 5<sup>th</sup> Ed., page 381). The Opponent argued that the ordinary meaning of 'switch' with its manner of usage in the trade, including the Applicant's own use, render this mark incapable of conveying any message to the consumer other than purely instructional information.
19. Counsel for the Opponent argued that the word 'SWITCH' cannot act as a trade mark and cannot communicate to the consumer and identify the origin of the good in the way which a trade mark must. Counsel cited Bentley & Sherman, *Intellectual Property Law*, 3<sup>rd</sup> Ed., page 822 and submitted that whether or not a sign can convey source must be determined by examining how the average consumer of the goods will perceive that sign.
20. The Opponent argued that the term 'SWITCH' is not proprietary and is commonly used descriptively by several traders in relation to this class to designate the intended purpose of the capsulated filter cigarettes. Therefore were a consumer to attempt to rely on the word "SWITCH" as a badge of origin, the consumer would fail. The Opponent relies on Exhibits MY-4 and MY-7 to make the point, which show selected samples of the Applicant's and Opponent's promotional literature and

packaging using the term “SWITCH” descriptively in several countries of the world in relation to capsulated filter cigarettes.

21. Counsel for the Opponent also submitted that the relevant consumer would be the average cigarette smoker in Jamaica who is deemed to be reasonably well informed, reasonably observant and reasonably circumspect, for whom cigarettes and other class 34 goods are non-luxury, everyday goods purchased routinely without any special care and attention. In that respect, Counsel submitted that the average consumer will perceive “SWITCH” as merely a description of how to use this relatively new product to switch the flavour or intensity of the cigarette.
22. Counsel for the Opponent cited the following cases under this ground of opposition:
  - (1) *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 goods 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.”
  - (2) *The Shervin-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, the mark was not 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.”

(3) *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.

23. The mark in question, “SWITCH” is said by the Opponent to allude to an action 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 that the word which makes up the mark is wholly descriptive and non-distinctive in relation to cigarettes and tobacco products.
24. As such, the Opponent claims that due to the common use of the type of technology used in the particular cigarettes the term “SWITCH” it will be very difficult to distinguish the Applicant’s products from that of other brands. Therefore the use of the word “SWITCH” in relation to Class 34 is merely informational thus making it purely descriptive.
25. The Applicant contends, however that the mark is inherently distinctive as it is not generally or widely used in relation to class 34 goods and can function as a badge of origin as it is not descriptive or customary. The Applicant relies on Exhibit B3 to make that point, which is a copy of Google search results for “switch cigarettes” which the Opponent argues shows that the most common use of the term in relation to cigarettes is in relation to the Applicant’s Dunhill cigarettes. It is noted however that Exhibit B3 is only page 2 of about 8,460,000 of the Google search results for “switch cigarettes” and shows several descriptive uses of the word “switch” by sources other than the Applicant in relation to cigarettes.

26. From the Opponent's Exhibits MY-4 and MY-7, we see that "switch" is used by the Applicant both as a trade mark SWITCH and descriptively in relation to its DUNHILL SWITCH cigarettes, the packaging of which explains that the capsule inside the filter "allows consumers to switch to menthol... by crushing the capsule." The varied packaging further explains that "Consumers can click to Switch" or "Click & Switch"; "crush to switch taste", "crush, switch, taste, or "can switch flavour". On its Lucky Strike cigarette packaging, the words "switch from regular to menthol" appear. A Japanese cigarette brand named Lark owned by the Opponent also uses "switch from full flavour to mint" and "switch from cooling to high cooling" on its packaging.
27. The Applicant argues that while other traders use the word SWITCH in a descriptive manner, it is only the Applicant who uses the word SWITCH in a trade mark sense. They argue that the word is a verb and therefore cannot be descriptive and that there has been no evidence of traders having difficulty describing their products because of the Applicant's use of the word SWITCH. They also point out that their SWITCH trade mark has been accepted for registration by thirty-four trade mark examining and registration authorities across the world.
28. The question therefore to be determined is whether the Applicant's SWITCH trade mark will enable the consumer to identify the source of its Class 34 goods and differentiate them from other Class 34 goods produced by other manufacturers.
29. 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.<sup>1</sup> Aldous L.J. in *Phillips v Remington*<sup>2</sup> 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.

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<sup>1</sup> Kerly's (13<sup>th</sup> Ed.). para. 7-36

<sup>2</sup> [1999] R.P.C. 809 at 819

30. The case of *Windsurfing Chiemsee Produktions- und Vertriebs GmbH v Boots- und Segelzubehor Walter Huber & Franz Attenberger*<sup>3</sup> 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*.<sup>4</sup>
31. The following principles are instructive when assessing distinctiveness:
- (1) 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);
  - (2) the overall impression of the mark must be considered, as the average consumer normally perceives a mark as a whole and does not proceed to analyze its various details, though it may be useful to examine each of the constituent features of the trademark. (Case C-144/06 P *Henkel KgaA v OHIM* [2007] ECR I-08109, paragraph 39; Case C-286/04 P *Eurocermex v OHIM* [2005] ECR I-5797, paragraphs 22 and 23; Case C-251/95 *Sabel BV v Puma AG* [1997] ECR I-06191, paragraph 23);
  - (3) 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

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<sup>3</sup> [1999] ECR I-2779

<sup>4</sup> SRIS C/78/99



category of goods or services in question (see Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26).

32. 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].
33. 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 the mark is non-distinctive in relation to tobacco products and as such is incapable of distinguishing the Applicant’s goods from those of other traders.
34. 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 application 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 mark as distinctive enough as a badge of origin of the Applicant’s goods alone, as at the date of filing of the application for registration.
35. 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).

36. Examining Exhibits MY-3 and MY-4 attached to Statutory Declaration of Maximilien Yaouanc dated the 18<sup>th</sup> 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 mark 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.
37. Examining Exhibits MY-3 and MY-7, it would appear that very few of the Opponent's class 34 goods use the word "SWITCH". Examining how the Applicant uses the marks, as exhibited in MY-4, the Applicant uses the word "SWITCH" in both a descriptive and trade mark sense. It is worthy of note that, in determining which use of the word "SWITCH" by the Applicant is intended to be seen in a trade mark sense, it is the use of the word "SWITCH" alongside the "DUNHILL" mark that conveys and, indeed, is possibly capable of conveying an intended trade mark function of the otherwise common descriptive word as a badge of origin. This therefore highlights the overlap with the third ground of opposition, namely whether the mark as applied for is exclusively descriptive and ought to be refused registration by virtue of section 11(1)(c) of the Act.
38. When one looks at the "SWITCH" mark as applied for 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.
39. Although there is not much evidence of other traders of class 34 goods using the word "SWITCH" and it is not a sign which is necessary to be used by other traders of capsuled cigarettes, it is a sign which is common and non-distinctive, at least in relation to capsulated filtered cigarettes. The use by the Applicant of the word follows the rules of ordinary English grammar, syntax, spelling and meaning and therefore would be perceived by the average consumer as promotional or advertising

information related to a characteristic 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.

**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**

40. 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.”*

41. 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 sign is so used by the Applicant.

42. 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-4” and “MY-7”, that the word “SWITCH” is descriptive of the intended purpose of the product and a characteristic of the product, as it not only instructs the consumer how to use the product but also outlines what happens when the product is consumed.

43. In support of that point the Opponent relied on several cases including:
- (1) *Irwin Industrial Tool Co. v. OHIM – EU: Case T-61/03 Celex No. 603TO0061* – 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.”
  - (2) *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 was therefore refused 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”.
  - (3) *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”.

- (4) *Procter & Gamble v OHIM (the BABY-DRY Case)* [2001] ECR I6251 - concerned an application to register the trade mark *BABY-DRY* for disposable diapers. 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).

44. 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).

45. Counsel for the Applicant argued that the word “switch” is a verb that refers to actions which cannot be said to constitute descriptions of cigarettes. Counsel for the Applicant also relied on the *BABY-DRY case*, on the *ratio decidendi* that whilst the word combination BABY-DRY unquestionably alluded to the function which the goods are supposed to fulfil, it did not satisfy the disqualifying criteria of exclusively descriptive, due to their syntactically unusual juxtaposition which did not represent a familiar expression for designating the goods or describing their essential characteristics.
46. Counsel submitted thus that (1) while “SWITCH” may allude to features associated with capsule filled cigarettes, it does not form a part of the expression used in everyday language or reference to those goods and (2) the perceptible differences between the trade mark and the ordinary usages of the word are adequate to bestow distinctive character on the mark. Counsel for the Applicant also submitted, quoting the ECJ in the *BABY-DRY case*, that “the modern view underlying [s. 11(1)(c)] excludes monopoly rights in signs or indications constituting trade marks, so that third parties are entitled to go on making normal use of them.”
47. Therefore the determination to be made depends on whether the word in question may be viewed as a normal way of referring to the goods or of representing their essential characteristics in common parlance (*BABY-DRY case*, para. 42).
48. 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.”

49. 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.

50. The Opponent claims that the word “SWITCH” is used to describe the intended purpose of the cigarettes and this is seen in their exhibits (“MY-4” and “MY-7”). This evidence shows the word “SWITCH” used in descriptive and instructional ways by traders including the Applicant. However the examples do not show use of “SWITCH” as a trade mark separate and apart from the Applicant’s word mark “DUNHILL”.
51. It is also useful to note the case of *BioID AG v OHIM*<sup>5</sup> 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.
52. The “SWITCH” mark is a simple word mark and is not represented or used in any particularly creative or unusual manner to 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 word mark does not reveal 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 sign as it does not diverge from but actually complies with English word composition and meaning. As such, the mark is contrary to section 11(1)(c) in that the mark consists exclusively of a sign or indication which may serve in trade to designate the kind, quality, purpose or other characteristics of the goods.
53. As held in the “TAME IT” case, registration of a mark which consists of signs or indications that are also used as advertising slogans is permitted only if the mark in question would be perceived immediately as an indication of the commercial origin of the goods 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.
54. The mark “SWITCH” does not create an impression on the part of the target public sufficiently removed from the ordinary, descriptive meaning or scope. The mark

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<sup>5</sup> Case C-37/03 P



- conveys a message which is immediately understandable and which can serve, in trade, to indicate the quality, purpose and intended use, and therefore the characteristics of the goods in question.
55. Therefore the mark as applied for does not fall within the registrable category which was found in the *BABY-DRY* case, as there is no corresponding syntactical juxtaposition in the instant mark to displace the ordinary, usual, descriptive meaning.
  56. There is no likelihood of acquired distinctiveness in Jamaica and no evidence of same was presented.
  57. As a result the Opposition to the registration of “SWITCH” 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.
  58. Counsel for the applicant submitted that if found descriptive, non-distinctive and unregistrable, the mark 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 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 mark in relation to tobacco.
  59. The registration of the mark is also refused in relation to the following goods on the basis of contravention of section 11(1)(b) of the Act, in that the mark is devoid of distinctive character in respect of those goods - cigarettes, tobacco, tobacco products and smokers’ articles.
  60. As a result, the mark is also refused registration in relation to those goods by virtue of section 11(1)(a) of the Act, in that the mark is incapable of distinguishing the

abovenamed goods of the Applicant from those of other traders and therefore the mark does not satisfy the definition of a trade mark in respect of those goods.

61. In light of the findings that the mark is not registrable by virtue of s. 11(1)(c), 11(1)(b) and 11(1)(a) of the Act and in keeping with the public policy behind said provisions, I find that the registration of the mark “SWITCH” and the ASCRIPTION of exclusive rights to the word ‘SWITCH’ for Class 34 goods, especially those of the capsulated nature, would unfairly prejudice the lawful use of that descriptive term by traders in the normal course of business. I acknowledge the point made by Counsel for the Applicant, citing the ECJ in the *BABY-DRY case*, that third parties are entitled to go on making normal use of words constituting trade marks, despite registration. However, where a word mark consists exclusively of a common, descriptive, non-distinctive word and which, for that reason and in relation to the particular goods, is not capable of distinguishing the goods of the Applicant from other traders, the public interest is best served by not allowing registration of and exclusive rights in that mark, as the mark would not serve the purpose of a trade mark in the eyes of the average consumer. Such a mark cannot be subject to a disclaimer, as after disclaimer there would be nothing registrable left and therefore the registration of such marks must be refused. As Kerly’s explains, in relation to the equivalent section of the UK Trade Marks Act, the registration of such marks is not allowed because there would be no policy justification, that is, “[t]here is nothing for such protection to attach to or bite upon when a sign only serves to designate characteristics other than origin.”<sup>6</sup>

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

62. 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*

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<sup>6</sup> Kerly’s (13th Ed.), para. 7-62

*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.”*

63. In deciding whether at the relevant date, which is the date of the application, “SWITCH” 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 mark in Jamaica.
64. The Opponent claims that the word “SWITCH” is commonly used within the cigarette trade as descriptive of various actions related to the use of cigarettes and that the word is even more customary in the sector of the cigarette trade that produces the capsulated type of cigarettes that feature a capsule inserted in the filter which can be clicked to switch or increase the flavour of the cigarette.
65. While it is evident that the technology is widely used in the cigarette trade internationally, this does not show an established use of the sign “SWITCH” in Jamaica.
66. Overall there is no evidence to establish that the term has 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 capsulated filter technology, those types of cigarettes are not and have never been available in Jamaica and therefore it is unlikely that the word “SWITCH” is generally known to the average consumer of class 34 goods in Jamaica. It is therefore highly unlikely that the word “SWITCH” 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 at the date of the application.

67. There is no likelihood of acquired distinctiveness in Jamaica and no evidence of same was presented.
68. The s. 11(1)(d) ground of opposition therefore fails.
69. Before parting with this matter, it should be noted that both sides submitted several decisions of IP offices and other trade mark examining and registration authorities from around the world, which either refused or accepted the applications for registration of the same mark in those jurisdictions. In that respect it is appropriate to reiterate that Jamaica's trade mark system is an autonomous system to be applied independently of any other trade mark system and therefore the registrability of a sign as a trade mark in Jamaica must be assessed by reference to the examination of the sign in Jamaica, against the Trade Marks Act and Rules of Jamaica, and in light of the perception of the average consumer in Jamaica. In that respect, while the several decisions from other jurisdictions submitted by the respective parties and their counsel were considered to the extent that there is evidence that similar standards of registrability exist in those jurisdictions, the examiner in Jamaica must, for each application, make his own assessment of the existence of absolute grounds of refusal (see *Cosmedent Inc's Application* [1998] ETMR 658; *USA Detergents Inc's Application* [1998] ETMR 562; and *Duro Sweden AB v OHIM* [2009] ETMR 22).

### **Conclusion**

70. In respect of cigarettes; tobacco; tobacco products; and smoker's articles, Trade Mark Application No. 57,707 to register "SWITCH" is refused and Opposition No. 66/TM2011 is accepted on the bases that:
- (a) the mark consists 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 contravenes section 11(1)(c) of the Act in respect of those goods;

- (b) the sign is devoid of distinctive character in respect of those goods and therefore contravenes sections 11(1)(b) of the Act in respect of those goods; and
- (c) the sign does not satisfy the definition of a trade mark in respect of those goods and therefore contravenes sections 11(1)(a) of the Act in respect of those goods.

71. There is no order as to costs.

Marcus Goffe  
for Registrar of Industrial Property  
March 1, 2016