

O-143-16

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION 715628
IN THE NAME OF FENTON HOLDING S.A.
IN RESPECT OF THE FOLLOWING TRADE MARK IN CLASSES 5, 10 & 11:**

AIR-FLOW

AND

**AN APPLICATION FOR INVALIDITY (NO. 500693) BY
KONINKLIJKE PHILIPS N.V.**

Background and pleadings

1. The trade mark **AIR-FLOW** is an International Registration (IR) that was first registered in May 1999. However, it was not until 4 December 2013 that its Holder, Fenton Holding S.A., designated the UK for protection. Protection was subsequently conferred on 5 September 2014 in respect of the following goods:

Class 5: Pharmaceutical, veterinary and sanitary products and preparations; chemical products for dentists and dental technicians, particularly powders and abrasive products for removing tartar and for protecting the teeth.

Class 10: Surgical, medical, dental and veterinary apparatus and instruments; electrical medical apparatus; parts of the aforementioned goods; but not including any such apparatus or instruments for monitoring or controlling air flow to a patient's lung

Class 11: Apparatus for cleaning, disinfecting, sterilizing, drying and cooling surgical, medical, dental and veterinary apparatus and instruments as well as parts thereof; but not including any apparatus specifically for cleaning, disinfecting, sterilizing, drying or cooling any surgical, medical, dental or veterinary apparatus and instruments for monitoring or controlling air flow to a patient's lungs

2. The applicant for invalidity is Koninklijke Philips B.V. Three grounds are relied upon. The first two grounds are based on sections 3(1)(b) & (c) of the Trade Marks Act 1994 (the Act). The applicant claims that the words AIR-FLOW are descriptive and non-distinctive because they consist of ordinary English words which create a “normal term, perfectly understandable and grammatically correct” which, it is claimed, may serve in trade to designate the kind, intended purpose or other characteristics of the goods. The third ground is based on section 3(3)(b). It is claimed that if there are any goods in the IR's specification which do not use or relate to air flow, the mark is deceptive. I note the following points made by the applicant:

- The acceptance of the mark on the basis of excluding goods for monitoring or controlling air flow in a patient's lungs was erroneous.
- Air flow can be used in a wide variety of other goods in classes 10 and 11.
- The class 5 goods, including powders, can be used in close association with the class 10 goods which use air flow.
- The IR has been refused in Ireland for all goods in classes 5, 10 and 11 on a need to keep free basis.

3. The holder filed a counterstatement denying the claims. It states that for goods for which the meaning is not relevant, the mark is not descriptive, non-distinctive, nor mis-descriptive. In the alternative, the Holder claims that its mark has acquired a distinctive character through use, having been used in the UK since at least 1996.

4. Both sides have been professionally represented throughout the proceedings, the applicant by Elkington & Fife LLP, the holder by MJP Deans. Both sides filed evidence. A hearing took place before me on 4 March 2016 at which the applicant was represented by Mr Charlton and the holder by Mr Deans.

The evidence

5. Generally speaking, the evidence filed in the proceedings covers the following issues:

i. Earlier decisions

6. Both sides have made reference to a number of earlier decisions including decisions (and notices of provisional refusal) in relation to the designation of the IR in other territories. The applicant has highlighted that the IR has been refused in Ireland and at OHIM whereas the Holder has highlighted that proceedings against the IR in other territories have been rejected. Whilst I appreciate Mr Charlton's submission that

decisions from English speaking jurisdictions may have more weight, the weight that any of them have is of a fairly limited persuasive value. Therefore, whilst I have borne in mind the findings made, I must, of course, reach my own decision based on the material presented to the tribunal. I will, consequently, make no further reference to the other decisions.

ii. Use of the words AIR-FLOW in the medical field

7. On behalf of the applicant, Mr Charlton filed a witness statement attempting to show use of the words AIR-FLOW in the medical field. Exhibit PJCE2 contains the documents relied upon which include:

- An article from *Special Medical/Healthcare* entitled “Choosing airflow and pressure sensors for medical apps”. The article relates to airflow (and pressure) sensors used in devices such as anaesthesia machines, sleep apnea machines and, also, hospital diagnosis machines. Whilst the first two examples relate to machines used on patients, the third does not.
- An extract from the website www.cambridgeconsultants.com about Podhaler. The Podhaler is a device used to inhale drugs in powder form to treat lung conditions. It is designed to have “...low airflow resistance to allow patients to generate high airflow rates”.
- An extract from the website www.medicaldevice-developments.com about Porex. This is a material used in some way in medical devices (although it is not clear in what capacity). When dry, air and gas can pass freely through the material, but, when wet, “..the absorbent additives will block the liquids by forming a high viscosity solution or gel and retard the airflow”.
- An extract from the website www.summitmedicalusa.com about a product called Breeze. The product is described as a nasal splint which is placed into the nasal cavity to increase a person’s airflow.

- An extract from thefreedictionary.com about “chronic airflow limitation” a disease which results in increased airway resistance.

iii. The dentistry treatment known as air abrasion and the use (and potential for use) of the words AIR-FLOW (or similar language) in relation to this and in dentistry

8. Mr Charlton provides a number of exhibits which relate to the dental treatment known as air abrasion. Exhibit PJC3 contains articles from the dental field relating to the technique (page 11 of the exhibit). The documents show that the treatment is by no means a new one. It works by using a stream of aluminium oxide particles (or other powder) combined with compressed air, and sometimes water. Exhibit PCJ4 contains a definition of air-abrasion from an online medical dictionary which states that it is a “type of micro-abrasion in which a jet of air blows tiny particles against the tooth or cavity surface”.

9. Exhibit PCJ5 is an extract from the Holder’s website where its AIR-FLOW product is depicted. The extract includes the text “Free-Flow technology optimizes the aerodynamic flow of air and powder for improved reliability”. There are references to “air polishing” and it is clear that the device itself makes use of compressed air.

10. Exhibit PJC6 are examples of third party uses in the dentistry field relating to air-abrasion where the words air flow, or air flowing, are used. They consist of:

- A print from the website of a dental clinic in Bangkok headed “Air Flow Polishing”. It begins “Our airflow polishing treatment uses...” and two other uses of the words “airflow polishing”.
- A print from the website www.dentalgeek.com (which is clearly a US website) headed “Why Air Flow Polishing is Superior to Traditional Periodontal Treatment”. There are a further four references to “airflow polishing”. The technique makes use of a controlled jet of water, air and fine powder.

- A print from the website of the Haddenham [a town in England] Dental Clinic which contains the words “We offer a complimentary air flow treatment which?”. The statement, as can be seen, is truncated and ends with a question mark.
- A print from the website URGENT DENTAL CARE [in London] headed “Airflow polish” which uses “the sheer force of pressurised air to remove stains and marks from your teeth...”.
- A print from the website of Gidenta [the company is based in Vilnius] headed AIR-FLOW METHOD. It states that “our clinic’s hygienist uses air-flow, one of the most advanced teeth plaque removal methods”. It goes on to explain that “A strong flow of air, water and medical powder is directed vertically”.
- A print from the website www.dentaleconimics.com (which appears to be a US website) about a warm air tooth dryer. This is not an air abrasion device. In operation the device produces a “gentle flow of air”.
- A print from the website www.kavousa.com (a US website) about a portable dental air cleaning device. The device operates by a foot pedal which, when pressed “..compressed air flows into the powder container. It mixes uniformly with the powder, and the mixture flows to the exit of the cannule”.
- A print from the website of the Thonglor Dental Hospital (in Bangkok) headed “Air Flowing”. It begins “Air flowing or Air Polishing abrasion machines the instrument used for air abrasion...”.
- A print from the website of a US company called Crystal Mark about an Air Abrasion Device. The text includes “air pressure and powder flow allows for more visibility, control and patient comfort”. A booklet about the same product includes “The pressurized airflow into the chamber is mixed with the abrasive powder as it is vibrated into the air stream through the passages in the orifice plate”.

11. Exhibits PJC7, 8, 9 & 10 contain copies of patent documents describing dental cleaning apparatus which use words such as air flowing or similar language. Some are patents belonging to the Holder (or a related company). The highlighted text includes “the powder is mixed with the air stream”, “powder air mixture”, the air is supplied via “a compressed air terminal”, “the gas, preferably compressed air, flowing in through the gas inlet”, “air flowing through the body of the powder and into the ports in the bottom of the tube”, “air flows through line 46 and a variable flow-restrictor”, “Flow of air and cleaning powder particles through line 66”, “the line serves both to filter air flowing into chamber 64”, other references are made to “air flowing” through various parts of the device, references are made to the “air flow volume”, “..a flow of air containing powder particles and a flow of water” and references to controlling the “flow of air”.

12. The Holder does not deal with these points in its evidence. Its evidence is mainly aimed, as set out below, at establishing acquired distinctiveness. I note, however, a comment made by one of its witnesses, Mr Philip Ower. Mr Ower states that he is a registered specialist in periodontics. It is not clear, however, if he is currently practicing. It is clear, though, that he lectures on periodontic issues. He states that he has never come across the words air flow being used as a descriptive term for dental products or techniques. All he could think of was the monitoring of a patient’s lungs during anaesthesia. As I will come on to later, Mr Ower is aware of the Holder’s trade mark in the UK.

iv. Potential for descriptive use on other goods

13. Mr Charlton comments on other goods in the non-medical/dentistry field. He states that it is within common knowledge that apparatus for drying and cooling use flowing air e.g. fans and, further, that apparatus for cleaning, disinfecting and sterilizing can use a flow of hot air, or air abrasion techniques such as sand blasting.

v. Use by the Holder for the purposes of acquired distinctiveness

14. The primary evidence on this comes from Mr Oultram, who works for Optident Ltd, one of the Holder’s UK distributors (there are two). Parts of his evidence have

been granted confidentiality so those parts will be redacted from the public version of this decision. Rather than summarise Mr Oultram's evidence here, I will return to it later, if it becomes necessary to so. At the hearing, Mr Deans also relied on the evidence of Mr Ower, I will also return to this. The only other evidence from the Holder is from Ms Andrea Menne who works for the Holder and, also, a wholly owned company called EMS. She explains the relationship between these companies and its two UK distributors.

Decision – sections 3(1)(b) and (c)

15. These two provisions prevent, respectively, registration of trade marks which are “..devoid of any distinctive character” or “..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”. The grounds can be relied upon to invalidate an existing registration (or in this case an IR which has had protection conferred) given the provisions of section 47(1) of the Act.

16. Even if a mark falls foul of these grounds, there is a proviso to section 3(1) which means that a registration shall not be refused if the trade mark has acquired a distinctive character through use; I will return to the proviso if it becomes necessary to so. The first question is whether the trade mark is, *prima facie*, objectionable under either section 3(1)(b) or (c).

17. It must be borne in mind that these grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under section 3(1)(b) of the Act. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union (CJEU) stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of

them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

18. In terms of section 3(1)(c), this is the equivalent of Article 7(1)(c) of the Community Trade Mark Regulation, the case-law of which was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C- 191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, *inter alia*, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P)

[2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkuniei*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

19. In terms of section 3(1)(b), this is the equivalent of article 7(1)(b) of the Regulation, the principles of which were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product

in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

20. In terms of distinctiveness and descriptiveness, this must be assessed via the perception of the relevant public – as well as average consumers of the goods, this also includes those in the trade. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, the CJEU held that:

"24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its

registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPNNederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I- 1725, paragraph 50).”

21. The questions relevant to these grounds of invalidation must be answered with reference to the goods for which the trade mark is protected. It is possible that different outcomes will apply. For this reason, I will break my decision down by class and, where necessary, by goods protected.

The class 10 goods

22. The IR is protected for the following goods in class 10:

Class 10: Surgical, medical, dental and veterinary apparatus and instruments; electrical medical apparatus; parts of the aforementioned goods; but not including any such apparatus or instruments for monitoring or controlling air flow to a patient's lung

23. Mr Charlton noted during his submissions that upon examination an objection under section 3(1)(b) and (c) was raised. The examiner explained the objection by using the example of goods for monitoring or controlling air flow to a patient's lungs, but, despite this being just an example, the examiner waived the objection based upon the exclusion at the end of the above specification. Put simply, Mr Charlton felt that the examiner had got it wrong and that there were many other goods in class 10 for which the objection was relevant, including the goods of primary interest to the Holder (dental air abrasion apparatus). Mr Deans felt that the examiner had been correct and had excluded the only goods which could possibly be objectionable. In terms of Mr Charlton's evidence, Mr Deans submitted that the only use he had presented was on

goods that were the subject of the exclusion and that the evidence from the dental field was not compelling (I will say more on this submission later).

24. As a starting point, I accept Mr Charlton's submission that the words AIR FLOW create an understandable and clear combination of words. The relevant public (which in this case would be medical, dental and veterinary professionals) would understand them to mean, as Mr Charlton submitted, a flow of air. This could have two applications for the goods being considered. The words could indicate (as per the examiner's example) a person's air flow i.e. the flow of air which circulates through the respiratory system to facilitate breathing. The words could also indicate that a particular medical, dental or veterinary device uses air flow as part of its operation. In relation to the former, Mr Deans highlighted the exclusion that had already been applied to the goods. Whilst I note this, it seems to me that the exclusion has, perhaps, not gone far enough. There may be many more functions that apparatus and instruments in this field may perform with regard to a person's breathing which go beyond mere control or monitoring and for which, consequently, the mark would be perceived as a description of its intended purpose e.g. its purpose is to help or facilitate air flow. Whether such a finding can be overcome by a better exclusion is something I will return to later, if need be.

25. The second potential objection relates more to the apparatus or instrument itself making use of air flow as part of its operation. Mr Charlton relied on his evidence from the general medical field and, also, the evidence from the dental field, including evidence in relation to the goods on which the Holder actually uses its mark (air abrasion dental apparatus). Mr Charlton stressed that he did not need to show actual descriptive use in trade, but, nevertheless, his evidence showed the propensity of the words air flow to be used in a descriptive manner. Mr Deans was highly critical of the evidence. He submitted that the applicant must have scoured the Internet to find descriptive use and that it was telling that so little evidence was found. He submitted that the evidence from the general medical field related to the excluded goods. In relation to the evidence from the dental field he highlighted that most of it was from overseas, that the use may have been the result of misuse of the Holder's trade mark, and that much of it did not even use the words air flow.

26. Mr Charlton is clearly correct in his submission that actual descriptive use is not required to sustain an objection under section 3(1)(c) of the Act. This has been established in a number of cases including *Doublemint* (Case C-191/01). As I have already stated, the meaning of the words is obvious. This is so whether they are hyphenated or not. I am satisfied that there would be a number of apparatus and instruments within the medical field that would utilise air flow in their operation. This could be something as simple as an instrument which uses a flow of air to clean something out during surgery. Of course, there will no doubt be many things in the specification that do not make use of air flow. Mr Deans submitted that the actual goods on which the mark is used is one such example. I will return to those goods shortly. For the time being, I uphold the ground under section 3(1)(c) to the extent that it is directed at the general terms (including dental apparatus and instruments) of which the specification is composed because those general terms include goods which may utilise air flow in their basic operation. The mark is descriptive to that extent.

27. Prior to the hearing, Mr Deans wrote to the tribunal setting out the Holder's fall-back position. In class 10 it is stated that should the objection be upheld then the mark had acquired a distinctive character in relation to "Dental apparatus and instruments, electrical-medical apparatus; parts of the aforementioned goods; but not including any such apparatus and instruments for monitoring or controlling air flow to a patient's lungs.". Whilst the fall-back specification is put forward with regard to acquired distinctiveness (which I will come on to), I should stress that I have considered whether the limited specification assists on a *prima facie* basis. My view is that it does not. The goods could still make use of air flow in its basic operation. To illustrate the point, the instrument highlighted in Mr Charlton's evidence from the website www.dentaleconimics.com is an air tooth dryer. It operates by providing a gentle air flow over the tooth. The fall-back specification is, as Mr Charlton submitted, still quite general in its construction and would still include goods for which the objection is relevant.

28. I have also considered whether the objection can be overcome by a wider exclusion than presently exists. Whilst there may have been potential to do so with regard to the objection based on a person's air flow, I do not consider that it would have been possible to do so with regard to the second type of objection. This is

because the only potential way of achieving this would be to exclude goods which make use of air flow. This would be impermissible because one would be excluding a characteristic of the goods, an approach which the CJEU has indicated as not being appropriate (see, for example, *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* C-363/99). The correct approach in a case such as this would be to consider a positive limitation of the goods. The Holder has been given an opportunity to put in a revised list of goods as a fall-back, however, as indicated above, what it has put forward does not overcome the objection. That being said, given that it is clear that the Holder uses its mark on dental air abrasion apparatus, I will consider whether, if the goods were positively limited to such things, the objection applies to those goods.

29. It is clear from the evidence that air abrasion apparatus makes use of compressed air which is combined with a powder in some form of chamber. Some devices also use water in that combination, the resulting mix is then blasted (as in sand blasting) on to the teeth for cleaning purposes. In some of the Internet extracts and the patent documents reference is made to the compressed air flowing into the chamber or other parts of the device. Whilst this is so, I am not persuaded that this equates to the words air flow being descriptive of a characteristic of the goods. That compressed air flows into part of the device (which is then mixed with other things) means, in my view, that the designation air flow loses what is often referred to as a sufficiently direct relationship with the goods. For example, in the decision of the General Court in *Ford Motor Co v OHIM*, T-67/07 it was stated: "... there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics". Put simply, an air abrasion device does not use air flow *per se*, but instead a combination of air, powder and sometimes water, and rather than a flow of air being used in its application it is more likely to constitute a jet or pressurized application. This suggests to me that the mark is more suggestive than descriptive and, as Mr Deans submitted, suggestiveness is not sufficient to uphold the objection.

30. I am mindful, of course, that some of the evidence from Mr Charlton does refer to air flow polishing. However, the evidence is sparse, mainly comes from overseas (so linguistic issues may be relevant) and, whilst there is no evidence to show that it is a

misuse of the Holder's mark, I do not rule out such a possibility. Without more compelling evidence, my view expressed in the previous paragraph is not overcome. Thus, bearing in mind the specification as it now stands, I would reject the invalidation in relation to the following goods:

Class 10: Dental air abrasion apparatus and instruments; electrical medical dental air abrasion apparatus; parts of the aforementioned goods; but not including any such apparatus or instruments for monitoring or controlling air flow to a patient's lung

31. I have focused so far on section 3(1)(c). In terms of the ground pleaded under section 3(1)(b), the case-law for which I set out earlier, I see no reason, absent a successful pleading under section 3(1)(c), why the mark would be devoid of any distinctive character. Mr Charlton did not advance a materially different basis for the objection and so, my finding is that the section 3(1)(b) ground succeeds and fails to the same extent as already set out.

The class 5 goods

32. The Holder's goods in class 5 read:

Class 5: Pharmaceutical, veterinary and sanitary products and preparations; chemical products for dentists and dental technicians, particularly powders and abrasive products for removing tartar and for protecting the teeth.

33. Such goods present different considerations to those already assessed. It is highly unlikely that the goods incorporate an air flow. Mr Charlton's submission was that the goods would/could be used in conjunction with goods for which air flow is used. To the extent that the goods are used with dental air abrasion apparatus, the findings made already mean that such an objection does not get off the ground. In relation to more general goods which may use powder etc, I consider the use in relation to the pharmaceuticals/powder is a step removed. It is not as though there is a specific category of air flow goods for which closely allied goods may also be descriptive (or lack distinctiveness). Any objection based upon the goods in class 5 being used in

conjunction with a device which uses air flow is, therefore, rejected under both section 3(1)(c) and (b).

34. That leaves the air flow to the lungs. It is clear to me that certain pharmaceuticals will be intended to facilitate a better air flow to the lungs. Asthma medication springs to mind, there are no doubt many other examples. Therefore, I uphold the objection to this limited extent. The fall back specification provided in class 5 does not deal with such an implication. Nevertheless, I believe that such an objection can be overcome by excluding goods which relate to respiratory complaints, but will revert to the parties, if necessary, to take submissions on this point. I will return to this later.

The class 11 goods

35. The Holder's goods in class 11 read:

Class 11: Apparatus for cleaning, disinfecting, sterilizing, drying and cooling surgical, medical, dental and veterinary apparatus and instruments as well as parts thereof; but not including any apparatus specifically for cleaning, disinfecting, sterilizing, drying or cooling any surgical, medical, dental or veterinary apparatus and instruments for monitoring or controlling air flow to a patient's lungs

36. Mr Charlton's submission was that such goods could obviously include goods which utilise a flow of air. One must bear in mind, though, that the goods are specified as performing their various functions on surgical, medical, dental and veterinary apparatus and instruments. That being said, apparatus for drying and cooling anything is something which will obviously have the potential to utilize air flow. I uphold the opposition for such goods. However, in relation to cleaning, disinfecting and sterilization, I am less convinced. An air flow is less likely to be used. I am not persuaded that sand blasting apparatus would fall within these goods, but, even if they did, my finding would be on a par with air abrasion goods in class 5 so would not face an objection. Given this, my finding is that the objection succeeds for some goods but not others, meaning that the objections under both sections 3(1)(c) and (b) does not apply to:

Class 11: Apparatus for cleaning, disinfecting and sterilizing surgical, medical, dental and veterinary apparatus and instruments as well as parts thereof; but not including any apparatus specifically for cleaning, disinfecting, sterilizing any surgical, medical, dental or veterinary apparatus and instruments for monitoring or controlling air flow to a patient's lung.

Acquired distinctiveness

37. Even though I have refused the invalidation for certain goods, and that certain of those goods equate to the goods on which the mark has been used, I will nevertheless give my views on the acquired distinctiveness point. This is for two reasons. First, the Holder claims a wider specification on use under classes 10 and 11 than I have currently permitted and, furthermore, it is useful to give my view on the matter in case of appeal.

38. The proviso to section 3 which reads:

“Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

39. Given that this is an invalidation case, the proviso to section 47 is also relevant, which reads:

“Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

40. The impact of the above is that if at the date of filing the mark had already acquired a distinctive character through use then the proviso to section 3 is applicable. However, even if this were not the case, and the subject mark acquired a distinctive character since it was registered, the proviso to section 47 is applicable.

41. The CJEU provided guidance in *Windsurfing Chiemsee*, Joined cases C-108 & C-109/97, about the correct approach with regard to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37).”

42. The Holder’s witness, Ms Menne, explains that a company called EMS is a wholly owned subsidiary of the Holder. EMS appears to be the manufacturing company and is regarded as the user of the mark. EMS has two distributors in the UK, Optident Limited and Henry Schein UK Holding Ltd. Ms Menne states that the former has distributed the goods in the UK for at least 10 years (before the date of UK designation)

and the latter for a period of 5 years. There is nothing else in Ms Menne's evidence that I need to refer to.

43. No evidence is provided by anyone connected with Henry Schein UK Holding Ltd. However, evidence does come from Mr Oultram of Optident. Some of the key points that Mr Oultram makes are that:

- He has worked for Optident for 23 years and they were already distributing AIR-FLOW products when he joined.
- He believes that distribution started earlier than this, since the later 80s or early 90s.
- The products sold include a "number of model of electrical apparatus used in dental practice to remove plaque and clean and polish the teeth and implants, The products also include dental instruments that couple to the apparatus, and powders for use in the apparatus. In use, the apparatus utilises a stream of powder, air and water to achieve cleaning and polishing effects".
- Optident distribute other brands for EMS, it is not possible to break down promotional expenditure between brands. Some advertising materials and brochure are provided as follows.
- There is an advertisement said to date from 1996 for a range of goods distributed by Optident. Mr Oultram states that although not clear, one of the products (on the left) is the Air-Flow product.
- There is a brochure said to date from 2000. The second page includes an Air-Flow Handy Kit, and reference is made to the Air-Flow System and Air-Flow powder.
- There is a brochure said to be from 2001. The heading states "Air Flow = Cash Flow". The page depicts an "Air Flow S11" and "Air Flow Powder Sachets".

- There is a Optident catalogue said to date from 2004. It includes a picture of an “air-flow s 1&2”
- There is an Optident catalogue said to be from 2006. It uses the words “ems air-flow” and depicts the device.
- There is an Optident catalogue from Autumn 2006 showing an EMS Airflow Handy 2+ and EMS Airflow 1.
- Another brochure from Autumn 2006 shows an EMS Airflow 1.
- There is advertising matter said to have been prepared for the British Dental Trade Association Conference in 2008. Amongst other goods there is an “airflow master perio”.
- There is an extract from a spring/summer 2011 newsletter called *Word of Mouth*. This appears to be an Optident newsletter. It depicts an Airflow Master and an Airflow Handy Perioflow.
- An extract from the Autumn/Winter version of the same publication with references to the Airflow Handy Perioflow. A satisfied user states “I love my Perioflow...”.
- An extract from the Spring/Summer 2013 version of the same newsletter depicting three different Airflow products.

44. Two exhibits have been granted confidentiality as follows:

- Exhibit DO2 contains sales figures. [REDACTED]

Exhibit DO3 contains a selection of sales invoices issued throughout the UK between 2007 and 2013.

45. Mr Oultram completes his evidence by stating that “..from the responses I have received from dentists [etc.] at the venues [such as the conference mentioned earlier]..to promote the Air-Flow branded products, that these products and their AIR-FLOW brand are widely known and well thought of. AIR-FLOW is a distinctive brand with a reputation”.

46. I also mentioned earlier the evidence of Mr Ower. He knows of the brand name AIR-FLOW and has been aware of it for at least 5 years. He knows it as the leading product for devices for “cleaning and air polishing technique in which a powder mixed with water is blown against the surfaces of the teeth or dental implants”. He adds that in his experience the mark has achieved a significant reputation amongst dental surgeons. In his teaching, if AIR-FLOW is mentioned, it is clear to Mr Ower that everyone present recognises this as a reference to EMS’ products.

47. Mr Charlton was highly critical of the evidence. He submitted that the factors referred to in paragraph 51 of *Chemisee* had simply not been met, he highlighted that there had been inconsistent use of the mark, that no promotional spend had been shown, that no circulation figures for any of the publications had been provided, that the turnover was not that great and had not been broken down. Mr Charlton criticised the evidence of Mr Ower as being of just one person (an academic rather than someone in practice) and that he could not speak for the profession. Mr Deans accepted that the evidence could have been better. He stated that Mr Oultram was something of a reluctant witness and the Holder had done its best to get out of Mr Oultram what they did. Nevertheless, he felt it sufficient to prove acquired distinctiveness. Mr Deans also felt Mr Ower’s evidence was useful.

48. I agree that the evidence could have been better. However, the absence of direct evidence matched to the *Chemisee* factors is not fatal. The job of the tribunal is to consider the whole picture of the evidence and determine, bearing in mind the

Chemisee factors, to decide whether the mark indicates trade origin to at least a significant proportion of the relevant public.

49. The evidence of Mr Oultram supports a long standing form of use. There are inconsistencies in the use, but the absence of a hyphen has, in my view, little impact. I accept from the brochures and material filed that AIR-FLOW is the primary sign used in relation to the particular goods being considered even if various sub designations have been used (such as Perioflow). One can clearly see AIR-FLOW used on the goods themselves even if this is not visible in each depiction. That one of the customers refers to Perioflow as opposed to Air-Flow does not weaken this. She is simply using the sub-brand in that instance. I accept, though, that it is not clear what impact the advertisements have had because one does not know how widely they were circulated.

50. The proof of the pudding is often in the eating. This is where the sales figures are relevant

[REDACTED]

. I agree with Mr Charlton that little weight ought to be placed on the evidence of Mr Ower – he is just one person – nevertheless, I am satisfied that the evidence establishes that a significant proportion of the relevant public will know of AIR-FLOW as an origin indicating sign in relation to both the powders and the apparatus itself.

51. However, irrespective of the above, I do not consider that the evidence establishes acquired distinctiveness beyond the scope of the goods for which I have already refused the invalidation. Class 5 is already fairly broad. Class 10 already covers dental air abrasion apparatus (and parts) which, in my view, mirrors the goods on which use has been shown. In class 10 there is no evidence of use in relation to drying and cooling apparatus. I should flag, though, that if my primary finding in class 10 is overturned in relation to cleaning, disinfecting and sterilizing apparatus then the evidence would not assist because there is no evidence of use in relation to such

goods. Therefore, my finding is that the acquired distinctiveness issue is only relevant in the event that my primary finding is overturned on appeal.

Outcome under section 3(1)(b) and (c)

52. The IR is invalid for certain goods and is deemed never to have been protected. However, the IR may remain protected for:

Class 5: Pharmaceutical, veterinary and sanitary products and preparations; chemical products for dentists and dental technicians, particularly powders and abrasive products for removing tartar and for protecting the teeth; [but not including any goods for the treatment of respiratory complaints]

Class 10: Dental air abrasion apparatus and instruments; electrical medical dental air abrasion apparatus; parts of the aforementioned goods; but not including any such apparatus or instruments for monitoring or controlling air flow to a patient's lung

Class 11: Apparatus for cleaning, disinfecting and sterilizing surgical, medical, dental and veterinary apparatus and instruments as well as parts thereof; but not including any apparatus specifically for cleaning, disinfecting, sterilizing any surgical, medical, dental or veterinary apparatus and instruments for monitoring or controlling air flow to a patient's lung.

53. Before confirming this decision I will, though, allow the parties to comment upon the exclusion in class 5. I will set out the mechanism for this later.

The section 3(3)(b) ground

54. Section 3(3)(b) of the Act states that a mark shall not be registered if it is:

“of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

55. Section 3(3)(b) of the Act derives directly from article 3(1)(g) of Directive. In *Elizabeth Florence Emanuel v Continental Shelf 128 Ltd* Case C-259/04 the CJEU stated:

“47 Nevertheless, the circumstances for refusing registration referred to in Article 3(1)(g) of Directive 89/104 presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived (Case C-87/97 *Consorzio per la tutela del formaggio Gorgonzola* [1999] ECR I-1301, paragraph 41).”

56. Put simply, Mr Charlton submitted that for any goods I determined were not objectionable under section 3(1), the mark would, effectively, be mis-descriptive and that members of the relevant public would be deceived into believing that the goods did make use of air flow, or were related to goods which made use of air flow. I reject this submission. The relevant public is wise enough to understand that for goods which do not have the characteristic put forward, then the mark is not making any direct form of promise. They may see the mark as allusive or suggestive, but no deception will arise. Although shortly stated, the ground is refused.

Outcome

57. The resulting specifications are set out in paragraph 52. The Holder is permitted 14 days to comment in writing on how the exclusion in class 5 should read. The applicant will then be given 14 days to respond. I will then issue a supplementary decision which will also trigger the appeal period.

Costs

58. The net effect of what has been won/lost is that this is something of a score-draw. Neither party will be favoured with an award of costs.

Dated this 16th day of March 2016

Oliver Morris

For the Registrar, The Comptroller-General