

**TRADE MARKS ACT 1994
AND
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF INTERNATIONAL REGISTRATION No. 816934
AND THE REQUEST BY LOOK-O-LOOK INTERNATIONAL B.V. TO
PROTECT A TRADE MARK IN CLASS 30**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
AGAINST THE DECISION OF MR A. J. PIKE DATED 15 JUNE 2005**

DECISION

Introduction

1. This is an appeal against a decision of Mr A. J. Pike, the Hearing Officer acting for the Registrar, dated 15 June 2005 (BL O/160/05) whereby he refused protection in the United Kingdom under the provisions of the Madrid Protocol to International Registration number 816934 in the name of Look-O-Look International B.V. of Geurdeland 5, NL-6673 DR Andelst, Netherlands (“the Applicant”) for the trade mark:



2. As the Hearing Officer noted the request for protection dated 25 September 2003 relates to a figurative mark (paragraph 8):

“The mark does not consist solely of the words themselves. The letters are not uniform in their presentation and appear somewhat jumbled in what Mr Gold [the Applicant’s representative] referred to as “a dancing script”.

The two letter O’s have each been replaced by devices of eyes ...”

3. Protection was requested for the following goods:

Class 30

Cocoa and cocoa products; chocolate, chocolate products and chocolate drinks; pastry and confectionery, caramel and caramel products, mint for confectionery, peppermint sweets; sweets, liquorice (confectionery) and liquorice products (confectionery); ice; snacks not included in other classes.

4. The request for protection was refused for failure to comply with the entitlement conditions in Article 3 of the Trade Marks (International Registration) Order 1996 as amended in that the mark was excluded from registration under section 3(1)(b) of the Trade Marks Act 1994 (“TMA”) being a sign which is devoid of any distinctive character because it suggests products of exceptional quality and value.
5. On 12 July 2005, the Applicant filed Notice of Appeal to an Appointed Person under section 76 of the TMA. At the hearing of the appeal Mr Tibor Gold of Kilburn & Strode represented the Applicant (Mr Gold also represented the Applicant before the Hearing Officer). Mr Dave Morgan appeared on behalf of the Registrar.

The decision of the Hearing Officer and the grounds of appeal

6. Section 3(1)(b) of the Act states:

“3.–(1) The following shall not be registered –
(b) trade marks which are devoid of any distinctive character”

7. The Hearing Officer instructed himself that the relevant test was not whether the mark, in its totality, was a combination that was used in common parlance to describe the goods in question but whether the mark, again in its totality, was devoid of any distinctive character. He observed that the objective of section 3(1)(b) is to prohibit the registration of signs which although not excluded by section 3(1)(c) and (d) are nonetheless incapable of distinguishing the goods and services of one undertaking from those of other undertakings. He said that the approach for assessing distinctiveness under section 3(1)(b) of the TMA was that laid down by the Court of Justice of the European Communities (“ECJ”) under the equivalent Article 3(1)(b) of Council Directive 89/104/EEC (“the Directive”) in Joined Cases C-53/01, C-54/01 and C-55/01 *Linde* [2003] ECR I-3161 at paragraphs 37, 39 to 41 and 47:

“37. It must first of all be observed that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods or services of one undertaking from those of other undertakings.

[...]

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning 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 products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

[...]

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings."

8. Mr Gold preferred to refer me to Case C-136/02 P *Mag* [2005] ETMR 584 where the ECJ said in relation to the again equivalent Article 7(1)(b) of Council Regulation 40/94/EC ("CTMR") at paragraphs 19 – 20:

"19. The distinctive character of a trade mark within the meaning of Article 7(1)(b) of Regulation No 40/94 must be assessed by reference, first, to the goods or services in respect of which registration is sought and, secondly, to the perception of the relevant public. That means the presumed expectations of an average consumer who is reasonably well informed and reasonably observant and circumspect ...

20. As the Court has consistently held, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. Thus, in order to assess whether or not a trade mark has any distinctive character, the overall impression given by it must be considered ..."

However, I believe there is no difference between the parties that the Hearing Officer directed himself in accordance with the correct approach.

9. Moving from the general to the particular, the Hearing Officer drew guidance from the Registrar's Examination practice about Slogans at paragraph 32 of Chapter 6 of the Trade Marks Registry Work Manual. The text of that practice was updated on 14 February 2005 (PAN 2/05) in order to reflect the ECJ's judgment in Case C-64/02 P *OHIM v. Erpo Möbelwerk GmbH (DAS PRINZIP DER BEQUEMLICHKEIT)* [2005] ETMR 731 but the practice itself remained unchanged. One of the criticisms on appeal is that, although the Hearing

Officer acknowledges in his decision the ECJ judgment in *DAS PRINZIP DER BEQUEMLICHKEIT*, he mainly quotes from the judgment of the Court of First Instance (“CFI”) below, which Mr Gold says was “thoroughly disapproved of” by the ECJ on appeal.

10. The reason why the Hearing Officer refers to the CFI judgment in *DAS PRINZIP DER BEQUEMLICHKEIT* is that it was included in the Registrar’s Examination practice about Slogans, which had not yet been updated. The ECJ in *DAS PRINZIP DER BEQUEMLICHKEIT* disapproved of the ruling at paragraph 46 of the CFI’s judgment that a trade mark is not devoid of distinctive character within the meaning of Article 7(1)(b) of the CTMR unless it is demonstrated that the phrase concerned is commonly used in business communications and, in particular, in advertising. Otherwise, the ECJ confirmed, inter alia, that:
- (i) Every trade mark including those comprising slogans must be capable of identifying the product as originating from a particular undertaking and thus distinguishing it from those of other undertakings (paragraphs 33, 42).
 - (ii) The criteria for assessing distinctiveness are the same for the various categories of marks (paragraph 32).
 - (iii) It is inappropriate to apply to slogans criteria for assessing distinctiveness (e.g. a requirement for “imaginativeness” or “conceptual tension which would create surprise and so make a striking impression”) that are different/stricter than those applicable to other types of sign (paragraphs 31, 36).
 - (iv) Use in advertising may be taken into account (paragraphs 35, 38).

Points (i) – (iv) above, approved by the ECJ, coincide with those appearing in the version of the Registry’s guidance on the examination of slogans referred to by the Hearing Officer in this case. The disapproved ruling at paragraph 46 of the CFI’s judgment in *DAS PRINZIP DER BEQUEMLICHKEIT* is not mentioned¹. Rightly, Mr Gold did not pursue his criticism as leading the Hearing Officer into error.

11. The main ground of appeal centres on paragraphs 33, 34 and 35 of the ECJ’s judgment in *DAS PRINZIP DER BEQUEMLICHKEIT*, which the Hearing Officer mentions as having been brought to his attention (paragraph 8). At paragraphs 33 – 35 the ECJ said:

“33. It is clear from the case-law of the Court of Justice that, as far as assessing distinctiveness is concerned, every trade mark, of whatever category, must be capable of identifying the product as originating from a particular undertaking, and thus

¹ It controversially introduced a laxer test of distinctiveness. The revised version of the Registrar’s Examination practice about Slogans makes clear that the absence of use of the slogan in advertising by unrelated parties does not in itself mean that the mark is acceptable for registration.

distinguishing it from those of other undertakings (see, to that effect, in relation to Article 3(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), which is identical to Article 7(1)(b) of Regulation 40/94, *Linde and Others*, paragraphs 42 and 47).

34. The Court of Justice has also held that, although the criteria for assessing distinctiveness are the same for the various categories of marks, it may become apparent, in applying those criteria, that the relevant public's perception is not necessarily the same for each of those categories and that, therefore, it may prove more difficult to establish distinctiveness for some categories of mark than for others (see Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraph 38; Joined Cases C-468/01 P to C-472/01 P *Procter & Gamble v OHIM* [2004] ECR I-0000, paragraph 36; and Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* [2004] ECR I-0000, paragraph 36).
 35. The possibility cannot be excluded that the case-law mentioned in the foregoing paragraph of this judgment is also relevant to word marks consisting of advertising slogans such as the one at issue in this case. That could be the case in particular if it were established, when assessing the distinctiveness of the trade mark in question, that it served a promotional function consisting, for example, of commending the quality of the product in question and that the importance of that function was not manifestly secondary to its purported function as trade mark, namely that of guaranteeing the origin of the product. Indeed, in such a case, the authorities may take account of the fact that average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogans (see, to that effect, *Procter & Gamble*, paragraph 36)."
12. Mr Gold emphasised the words "*not manifestly secondary to its purported function as a trade mark*" and submitted that the Hearing Officer erred in not fully giving weight to the guidance provided by the ECJ at paragraph 35. In particular, the Hearing Officer did not consider whether a mark which has both functions, that of distinguishing (the essential function) and that of an element of promotion or more or less disguised self-praise, can nevertheless serve aptly and well as a badge of origin despite the added promotional function. Mr Gold criticises the lack of a statement by the Hearing Officer that he has considered both functions. Mr Gold surmises that the Hearing Officer in effect simply decided: "[The sign] has a promotional function. Therefore, it cannot be a trade mark." To the contrary, Mr Morgan counters that the Hearing Officer did not fall into error but correctly applied the approach set out by the ECJ in *DAS PRINZIP DER BEQUEMLICHKEIT*. Mr Morgan especially highlights paragraphs 14 and 15 of the Hearing Officer's decision, which I consider below. As to Mr Gold's difficulty with the Hearing Officer's

finding that the public would perceive the mark as a promotional or advertising slogan commending the quality/value of the goods, Mr Morgan adds that “quality” would include novelty, e.g., chocolate novelties.

13. The relevant findings of the Hearing Officer were as follows:

“12. It is essential that the distinctive character of a trade mark is assessed in relation to the goods for which the applicant seeks registration. The specification for which registration is sought covers a range of goods in Class 30 which are essentially edible products.

13. I must, of course, assume fair and notional use of the mark in relation to the provision of the goods applied for. Such use includes use in advertising wherein it is customary for advertisements to use abbreviated language, a notion endorsed by Mr Simon Thorley QC sitting as the Appointed Person in “Where all your favourites come together” – see BL O/573/01.

14. I accept that the test for registering slogans is no different than for any other type of marks but as slogans are often used for advertising purposes they may not be so readily accepted by the general public as an indication of trade source as would more traditional signs such as words, brands, logos and figurative marks (see the Judgment of the court of First Instance in “REAL PEOPLE REAL SOLUTIONS” – Case T-130/01 5 December 2002). I also accept that lack of originality per se is not fatal to the outcome of the application for registration.

15. The trade mark applied for must be assessed by reference to how the mark is perceived by the relevant consumer who, in respect of the goods contained within the specification applied for are, in my view, the general public including confectionery buying children.

16. The words themselves are common dictionary words which are in everyday use within the United Kingdom. Mr Gold has suggested that these words would not be used, in trade, in relation to the goods applied for but I do not accept this. The goods, which include confectionery, are goods which may easily be promoted and advertised through the use of slogans. The average consumer, who I consider to be both adults and children, when encountering this mark used in relation to the goods applied for are likely to perceive the mark as a slogan indicating something of exceptional quality or value is being offered.

17. I find support for this in a decision by the Court of First Instance – Case T-281/02, *Norma Lebensmittelfilialbetrieb GmbH & Co KG v. OHIM (Mehr für Ihr Geld)* at paragraphs 31 and 32:

“31. In that regard, the applicant’s argument that the consumer is told nothing about the content or nature of the goods offered under the mark is irrelevant, because he does not know to what

the word “more” relates. For a finding that there is no distinctive character, it is sufficient to note that the semantic content of the word mark in question indicates to the consumer a characteristic of the product relating to its market value which, whilst not specific, comes from promotional or advertising information which the relevant public will perceive first and foremost as such, rather than as an indication of the commercial origin of the goods (see, to that effect, REAL PEOPLE, REAL SOLUTIONS, paragraphs 29 and 30). In addition, the mere fact that the word mark “Mehr für Ihr Geld” does not convey any information about the nature of the goods concerned is not sufficient to make that sign distinctive (see, to that effect, BEST BUY, paragraph 30).

32. Furthermore, there is nothing in the mark applied for “Mehr für Ihr Geld”, that might, beyond its obvious promotional meaning, enable the relevant public to memorise it easily and instantly as a distinctive trade mark for the goods designated. Even if the mark applied for were used alone, without any other sign or trade mark, the relevant public could not, in the absence of prior knowledge, perceive it otherwise than in its promotional sense (REAL PEOPLE, REAL SOLUTIONS, paragraph 28).”

18. I acknowledge that this mark is more than plain words. I must consider the stylisation which is present in this mark. The letters vary in their presentation and the two letter Os are replaced by two devices of eyes. The question to be answered is – “Is the stylisation sufficient to bestow distinctive character upon this mark?” In assessing this I bear in mind that advertisements promoting goods such as confectionery are often directed at children in order that they will persuade the third party to purchase the goods in question. I do not consider that the presentation of the letters within the words are particularly different or memorable. The two devices of eyes seem to reinforce the meaning of the words and link back to the final word EYES. The mark is easily interpreted as being YOU WON’T BELIEVE YOUR EYES and the devices do not detract from the message provided by the words, they merely reinforce that meaning. In my view this perception will not be changed by the presence of the stylisation which I accept is present in this mark.

[...]

21. I am not persuaded that the trade mark applied for is distinctive in that it would serve in trade to distinguish the goods and services of the applicant from those of other traders. In reaching this conclusion I have considered the mark in its totality placing due weight on the letters and words themselves in conjunction with the stylisation which is present in the mark. In my view the mark applied for will not be identified as a trade mark without first educating the public that it is a

trade mark. I therefore conclude that the mark applied for is devoid of any distinctive character and thus is excluded from prima facie acceptance under Section 3(1)(b) of the Act.”

14. It will be remembered that in the statement from *DAS PRINZIP DER BEQUEMLICHKEIT*, which Mr. Gold relies on, the ECJ refers to the mark at issue’s purported function as a trade mark. I have reviewed the decision and the arguments carefully but I do not accept that the Hearing Officer erred in failing fully to consider in accordance with the ECJ’s guidance the purported guarantee of origin function as well as the promotional function of the mark applied for. This is clear not only from paragraphs 14 and 15 of the decision but also the passages from which the Hearing Officer drew support in *Mehr für Ihr Geld*. I accept that the Hearing Officer made no express statement to that effect but I bear in mind the direction of Robert Walker L.J. in *REEF Trade Mark* [2003] RPC 101 at 110:

“The appellate court should not treat a judgment or written decision as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed. The duty to give reasons must not be turned into an intolerable burden ...”

In his opening argument, Mr Gold acknowledged that an element of subjectivity is involved in the assessment of distinctive character (see, *Clearer it could be! Some comments on recent European case law on slogans as distinctive trade marks*, David T. Keeling, Member OHIM Boards of Appeal in *Harmonisierung des Markenrechts*, Carl Heymanns Verlag, ISBN 3-452-26084-4 (2005)). In my judgment, the Hearing Officer was entitled to arrive at the decision he did.

Conclusion

15. In the result the appeal is dismissed. In accordance with usual practice, I direct that there be no order as to the costs of this appeal.

Professor Ruth Annand, 6 January 2006

Mr Tibor Gold, Kilburn & Strode, appeared on behalf of the Applicant, Look-O-Look International B.V.

Mr Dave Morgan appeared on behalf of the Registrar