

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
APPLICATION No 2319763  
BY MATTHEWS FOODS PLC  
TO REGISTER A TRADE MARK  
IN CLASS 29**

**DECISION AND GROUNDS OF DECISION**

**Background**

1. On 28 December 2002 Matthews Foods plc of The Healey Complex, Healey Road, Ossett, West Yorkshire, WF5 8NE applied to register the following trade mark in Class 29.

**GO COOK!**

2. The application was made in respect of the following goods:

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats.

3. Objection was taken under Section 3(1)(b) of the Act because the mark consists of the words “Go Cook!”, the combination being devoid of any distinctive character as it does not fulfil the function of a trade mark, it is merely a non-distinctive phrase which is origin neutral in relation to the goods.

4. At a hearing, at which the applicants were represented by Mr P B Dyson of Bailey Walsh & Co, their trade mark attorneys, the objection was maintained.

5. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

6. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

**The Law**

7. Section 3(1)(b) of the Act reads as follows:

“3.-(1) The following shall not be registered-

(b) trade marks which are devoid of any distinctive character”

## The Decision

8. At the hearing Mr Dyson argued that the presentation of the mark, ie the words GO COOK plus the exclamation mark, was registrable; there was no direct connection between the word and the goods. He referred to GO+ marks on the register, and argued that these precedents could not be disregarded if consistency was to be maintained.

9. I maintained that the precedents were not on a par with this mark, which had to be examined on its own facts and with regard to current law and case law.

10. The question to be decided with regard to this application is not whether the mark, in totality, is a normal combination used in common parlance to describe the goods applied for, and thereby prohibited from registration by Section 3(1)(c) of the Act, but rather whether it is devoid of any distinctive character, which falls to be decided under Section 3(1)(b). Section 3(1)(b) must be considered separately from Section 3(1)(c), and marks must be refused registration if they cannot do the job of a trade mark which is to identify the goods of one trader from those of other traders.

11. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in Joined Cases C-53/01 to C-55/01 *Linde AG, Windward Industries Inc and Rado Uhren AG* (8<sup>th</sup> April 2003) in the following terms:

“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 and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule 1 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* [2002] ECR I-5475, 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.

12. I must assess the mark's distinctiveness in relation to the goods for which the applicant seeks registration, which are the range of foodstuffs, both raw and processed, listed above. I must also have regard to the perception of the relevant consumers of foodstuffs, in my view the general public.

13. Assuming notional and fair use of the mark, which includes use on the packaging of the goods as well as in advertising, it seems unlikely to me that the relevant consumer would consider this mark to denote trade origin because it will simply be seen as an invitation to buy the goods and "Go cook!" with them. The elliptical nature of the mark does not make it any more likely to denote that the goods originate from one particular trader, because the public are used to seeing shorthand used in the promotion of goods and the exclamation mark, if anything, simply reinforces the message.

14. I am not persuaded that the mark GO COOK! in totality is distinctive in that it would serve in trade to distinguish the applicant's goods from those of other traders. In my view the mark applied for will not be identified as a trade mark without first educating the public that it is one. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

### **Conclusion**

15. In this decision I have considered all the documents filed by the applicants and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 3(1)(b) of the Act.

**Dated this 23<sup>rd</sup> day of January 2004.**

**Anne Pritchard  
For the Registrar  
The Comptroller-General**