

O-071-06

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

**IN THE MATTER OF INTERNATIONAL REGISTRATION  
NO 815783 AND THE REQUEST TO PROTECT A TRADE MARK IN  
CLASSES 7, 9, 11, 21 & 30**

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**BACKGROUND**

1. On 25 September 2003 Kraft Foods Schweiz Holding AG made a request under the provisions of the Madrid Protocol for protection in the United Kingdom of International Registration 815783. The trade mark's details are:

Trade mark: **THE ART OF THE PERFECT CUP**

Specifications: **Class 07:** Electromechanical apparatus for preparing and dispensing hot and cold beverages.

**Class 09:** Automatic coffee and tea dispensing machines.

**Class 11:** Electric apparatus for preparing hot and cold drinks; electric coffee-making and tea-making machines, electric coffee machines, electric coffee percolators.

**Class 21:** Non-electric coffee percolators; non-electric coffee-making machines.

**Class 30:** Coffee, coffee extracts; coffee, cocoa and chocolate substitutes, beverages made with cocoa, chocolate or coffee and preparations therefor; tea; bakery, pastry and confectionery products, particularly sweet goods and chocolate confectionery, dough for bread or cake mix, cereal preparations, edible ice.

2. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and notice of refusal was given because the mark was excluded from registration by Section 3(1)(b) & (c) of the Trade Marks Act 1994 because it is a sign which may serve, in trade, to designate the intended purpose of the goods e.g. goods for use in making beverages of the highest quality.

3. At a hearing, at which the applicant was represented by Ms Tania Clark of Haseltine Lake, the objection was maintained. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of

my decision and the materials used in arriving at it. No evidence of use has been put before me. I have, therefore, only the *prima facie* case to consider

### **The Law**

4. Sections 3(1) (b) & (c) of the Trade Marks Act 1994 read as follows:

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

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

### **The applicant’s case for registration**

5. Prior to the hearing, Ms Clark’s written response to the objections raised in the examination report was to suggest that the words making up the mark, although a slogan, could not be regarded as the normal way of referring to the goods nor ones that could represent their essential features. The words, it was argued, were merely illusory and did not describe, in plain language, the intended purpose of the goods. It was also argued that the slogan was ambiguous and could allude to a number of interpretations.

6. At the hearing, Ms Clark argued strongly that the mark was merely allusive and was not directly descriptive. Although she conceded that the term “the art of..” was a known and used term, she felt that its combination with the words “perfect cup” was sufficiently novel for the consumer to recognise the totality as a distinctive slogan in relation to the goods covered by the application.

7. I referred to the judgment of the Court of First Instance in *REAL PEOPLE, REAL SOLUTIONS* (T-130/01) where in paragraph 29 it was stated that:

“Since the relevant consumer is not very attentive if a sign does not immediately indicate to him the origin and/or intended use of the object of his intended purchase, but just gives him purely promotional, abstract information, he will not take the time either to enquire into the sign’s various possible functions or mentally to register it as a trade mark”.

8. In light of the above, I suggested that the average consumer of the goods were unlikely to afford this mark with trade mark significance. Ms Clark, however, took the opposite view and felt that the mark was distinctive and would strike the average consumer and would, therefore, designate origin. Despite Ms Clark’s submissions I maintained the objections under Section 3(1)(b) and (c).

## DECISION

### Section 3(1)(c)

9. An objection under this ground relates to the aptness of the mark in question to designate or describe a characteristic of the goods or services in question. In a judgment issued by the ECJ on 23 October 2003, *Wm. Wrigley Jr. Company v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case 191/01, (the DOUBLEMINT case), the Court gave guidance on the scope and purpose of Article 7(1)(c) of the Community Trade Mark Regulation (equivalent to Section 3(1)(c) of the Trade Marks Act). Paragraphs 28-32 of the judgment are reproduced below:

“28. Under Article 4 of Regulation No. 40/94, a Community trade mark may consist of any signs capable of being represented graphically, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

29. Article 7(1)(c) of Regulation No. 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or of rendering of the service, or other characteristics of the goods or service are not to be registered.

30. Accordingly, signs and indication which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No. 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under Article 7(3) of Regulation No. 40/94.

31. By prohibiting the registration of Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No. 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) 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), *Windsurfing Chiemsee*, paragraph 25, and *Joined Cases C-53/01 to C-55/01 Linde and Others* [2003] ECR I-3161, paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No. 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article

actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

10. The nub of the issue is, therefore, whether the mark is one that other traders of the goods or services in issue would legitimately require in order to describe the goods or services or a characteristic of them. If this question is answered positively then the mark should be refused registration (unless, of course, the mark has acquired a distinctive character through its use). It should also be noted that there is no requirement that the mark be in current use by other traders, nor is there a requirement that the mark should designate a single or exclusive characteristic; it is sufficient that at least one of its meanings is descriptive.

11. The mark consists of the phrase “THE ART OF THE PERFECT CUP”. From my own general knowledge I am aware that the expression “THE ART OF..(something)” is a term used in a number of fields; Ms Clark did not dispute this fact. The art of something is an expression normally utilised to indicate the skilful creation or making of the particular thing in question. The words “perfect cup” leave little to the imagination, thus, the phrase in totality signifies the skilful creation of the perfect cup of something.

12. Having come to conclusions as to the meaning that would be derived from the mark, I now assess its potential to function as a descriptor of characteristics of the goods. The majority of the goods cover devices for making drinks and beverages and also the constituent ingredients of beverages. It seems to me that one of the most desirable qualities of these goods would be their ability to produce a beverage of the highest quality. A message of the nature I have just described would, I feel, be caught by the provisions of section 3(1)(c) of the Act as it would describe the intended purpose of the goods, namely that the intended purpose of the goods is to provide the consumer with the skilful creation of the perfect cup of their chosen beverage. Having come to these conclusions, I am solely left to consider whether the mark simply alludes to this characteristic (as Ms Clark would have me believe) or whether the term is directly descriptive and, thus, one that needs to be kept free for use by other traders?

13. Ms Clark contends that the combination created by the mark is not the natural way of referring to the goods or a characteristic of them. I disagree. The mark may have a degree of eloquence, but this does not equate to it being unnatural. Nor does the combination of the words “the art of the” and “perfect cup” seem unusual. On the contrary, the words strike me as quite a natural expression particularly given the aim and desire of consumers of beverages (e.g. tea and coffee drinkers) who often strive to make the best (or perfect) cup of their beverage of choice. I therefore reach the conclusion that the mark designates a characteristic of the goods and is debarred from registration under Section 3(1)(c) of the Act.

### Section 3(1)(b) objection

14. Having found that the mark fails the test for registration under Section 3(1)(c) of the Act, I now go on to consider whether it also fails the test under Section 3(1)(b). The purpose of Section 3(1)(b) is to prohibit registration of signs which are incapable of distinguishing the goods and services of one undertaking from those of other undertakings. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act was summarised by the ECJ in paragraph 37, 39 to 41 and 47 of its Judgment in Joined Cases C-53/01 to C-55/01 *Linde AHG, Windward Industries Inc and Rado Uhren AG* (8<sup>th</sup> April 2003) in the following terms:

“37. It is to be noted at the outset 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”.

15. From the above, I am therefore aware that the mark’s distinctiveness must be assessed in relation to the goods sought by the applicant. I must also have regard to the perception of the average consumer (who is deemed to be reasonably well informed and reasonably observant and circumspect). As I have already stated, the majority of the goods relate to devices for making beverages and the constituent ingredients of certain beverages; this is not a technical or specialist area and the average consumer will, therefore, be the general public. The question I must therefore answer is whether the mark would serve to indicate, when encountered by a member

of the general public, that the goods sold under the mark originate from a particular trader and, thus, distinguishes their goods from the goods of other traders.

16. I must, of course, assume notional and fair use of the mark in relation to the goods applied for. This would include use of the mark on the packaging of the goods as well as use in advertising materials. I feel that in either of these forms of use the phrase “THE ART OF THE PERFECT CUP” sends a direct descriptive message (as I have described in my findings under the Section 3(1)(c) ground) and, therefore, the mark would not be taken by the average consumer as a sign of origin in one particular trader.

17. However, in the event that I am found to be wrong on my assessment of the directness of the descriptive message, or in the event that I am found to be wrong on my finding that a characteristic of the goods is being described by the mark, I will also assess whether the mark itself, regardless of whether it is descriptive or not, would nevertheless still fall foul of the test under Section 3(1)(b).

18. To the average consumer the mark would, when used in trade, be seen as a slogan (Ms Clark referred to the mark as a slogan, albeit a distinctive one, during the hearing). Slogans are commonly used as an advertising or promotional tool often to highlight the virtues of the particular trader or the goods that they are selling. The test for registering slogans is no different than for any other type of mark 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 Judgement of the Court of First Instance in “REAL PEOPLE REAL SOLUTIONS” – Case T-130/01 5 December 2002).

19. I am not persuaded that the mark THE ART OF THE PERFECT CUP is distinctive in that it would serve in trade to distinguish the applicant’s goods from those of other traders. The mark would, even if it does not describe a particular characteristic of the goods, be seen as a simple promotional statement informing potential consumers that the undertaking responsible for the mark have mastered the production of high quality beverages or that purchasers of the goods themselves would obtain this attribute through the use of their goods. I have already said that I do not consider the language used in the mark to be unnatural or unusual. The mark would, in my view, be seen as a simple promotional statement that could apply equally to any other undertaking to send the same positive promotional message.

20. 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**

21. In this decision I have considered all the documents filed by the applicant 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 the mark fails to qualify under Sections 3(1)(b) and (c) of the Act.

**Dated this 15<sup>th</sup> day of March 2006**

**Miles Rees  
For the Registrar  
the Comptroller-General**