

**TRADE MARKS ACT 1994**

**AND**

**THE TRADEMARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF**

**INTERNATIONAL REGISTRATION NO. 734783**

**AND THE REQUEST BY SONAFI, SOCIÉTÉ ANONYME**

**TO PROTECT A TRADE MARK IN CLASS 30**

1. On 11 May 2000, SONAFI, Société Anonyme of 42, rue Rieussec, F-78220 VIROFLAY, France, on the basis of international registration no. 734783, requested protection in the United Kingdom, under the provisions of the Madrid Protocol, of the mark:

**SAY IT WITH A CHOCOLATE**

2. The International Registration is numbered 734783 and protection is sought in Class 30 in respect of:

Cocoa, chocolate, confectionery and chocolate products.

3. 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 under Article 9(3) was given because the mark is excluded from registration by Section 3(1)(b) of the Trade Marks Act 1994. This is because the mark consists of the words SAY IT WITH A CHOCOLATE, the whole being devoid of any distinctive character for chocolate goods.

4. At a hearing, at which the applicants were represented by Mr Hackney of Mewburn Ellis, their Trade Mark Attorneys, the objections were maintained. Notice of final refusal under Article 9(3) was issued on 16 January 2002. 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 the decision and the materials used in arriving at it.

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

6. 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,

7. The mark consists of ordinary dictionary words which are so well known that I believe I do not need to set out any dictionary references for all the individual components of the mark. I am, in any case, bound to accept or reject the mark in its totality. I must, therefore, consider the meaning of the mark in its totality.

8. The phrase SAY IT WITH A CHOCOLATE is not invented. It is a sequence of ordinary dictionary words that come easily to mind in order to convey a promotional message in respect of the goods applied for. The goods in question include chocolate products. Such goods are offered for sale in a variety of shapes, sizes and flavours. They are goods which are often provided as gifts and may, in such circumstances, be adorned with additional material such as ribbon.

9. In support of the application the trade mark attorneys representing the applicants provided examples of the mark applied for in actual use. Details of these are attached at Annex A. The mark is used on the exterior of the packaging used to contain the goods in question. I note that the mark is used beneath the distinctive mark RÉVILLON which is itself accompanied by a logo. The packaging in question incorporates visual and written messages which indicate that the goods contained within the packaging are appropriate for use in romantic situations. In my view the mark would be seen by the relevant public as being no more than a promotional statement that if a prospective purchaser of the goods wishes to convey a romantic message to another person then that message may be conveyed by the provision of a chocolate as a gift. I accept that the words SAY IT WITH CHOCOLATES are, perhaps, a more appropriate form of words to express the same message. Nevertheless, I consider that the relevant public would identify this mark as an alternative way of expressing the words SAY IT WITH CHOCOLATES and would not identify this particular wording as having any trade mark significance. In my view the mark SAY IT WITH A CHOCOLATE would be perceived by the relevant public as a promotional statement that the goods, which are chocolate products, may be provided as a gift in order to convey a particular message. I accept that the specific message intended to be conveyed to the recipient of the goods is not spelt out in the mark, but I say that the message conveyed to the potential purchaser of the goods is unequivocal. The mark promotes chocolate by pointing out to the average consumer that it can be used as a gift to send a romantic or emotional message to the recipient of such goods.

10. The trade mark attorneys representing the applicants have also drawn attention to the registration of the mark SAY IT WITH FLOUR for flour and other goods in Class 30. I do not accept that this acceptance has any relevance to the trade mark being considered in this decision. The comments made in the MADAME case (1996) RPC page 545 were re-stated by Mr Justice Jacobs in the TREAT trade mark case (1996) RPC page 281:

“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. Madame TM and the same must be true under the 1994 Act.

11. In this decision I have born in mind the comments in the unreported decision on the DAY BY DAY (Application No 2068646 dated 12 April 1994) appeal in which Simon Thorley QC in his role as The Appointed Person said:

“In my judgement, Mr James correctly submitted that I should have regard not only to natural use on packaging but also to natural use in the context of advertising .....”.

12. In correspondence subsequent to the hearing I was asked to reconsider my decision to maintain the objection under Section 3(1)(b) of the Act in light of the decision taken by the European Court of Justice in Proctor & Gambol Company v OHIM ( the BABY-DRY case). However I was aware of this decision at the hearing and took full account of it when I concluded that the objection under section 3(1)(b) of the Act should be maintained. The relevance of the BABY-DRY decision in relation to marks consisting of slogans or straplines was commented on by Simon Thorley QC in the unreported decision on the WHERE ALL YOUR FAVOURITES COME TOGETHER (Application No 2206477 dated 28 August 1999) appeal in his role as The Appointed Person where he said:

“Of course, in BABY-DRY, the mark that was being considered was a plain word mark and not a slogan or strapline as in the present case. It was again common ground that this mark was of the nature of a slogan or strapline and that, therefore, consideration of its use in advertising was particularly appropriate.

13. I therefore consider that the mark SAY IT WITH A CHOCOLATE consists of a sign which is devoid of distinctive character and is excluded from registration by Section 3(1)(b) of the Act.

14. In this decision I have considered all the documents filed by the holder and for the reasons given the notice of refusal was upheld.

**Dated this 28 day of February 2002**

**A J PIKE**  
**For the Registrar**  
**The Comptroller General**

Annex A: Available as order a copy