

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 9914
BY FERRERO S.P.A.
FOR A DECLARATION OF INVALIDITY
IN RESPECT OF TRADE MARK No 1369454
IN THE NAME OF ROBERT WISEMAN & SONS LIMITED

DECISION

1) Trade Mark No 1369454 is registered with a specification of goods which reads “Milk and milk products; cream; semi skimmed milk; dairy products; butter; butter cream; edible oils and fats, margarine; milk beverages; yoghurts; all included in Class 29”. The mark stands registered from the filing date of 6 January 1989 and is as follows:



2) By an application dated 10 December 1997 Ferrero SpA applied under section 47 of the Trade Marks Act 1994 for the registration to be declared invalid. The applicant’s grounds are that:

- a) The mark was registered contrary to sections 3(1) of the Act as it is devoid of any distinctive character nor has it become distinctive.
- b) The applicant has made substantial use of a trade mark and acquired considerable reputation in the goods sold under this mark. The proprietor’s mark in suit is confusingly similar to the applicant’s well known trade mark and also its registered trade marks, numbers 1373627 and 1390446. The proprietor’s mark therefore offends against sections 3(3), 5(2) and 5(4).
- c) The proprietor’s mark offends against section 3(4).
- d) The proprietor’s mark offends against section 3(6) as the mark is not the mark of the proprietor and infringes the applicant’s copyright.

3) The registered proprietor filed a counterstatement denying the grounds. Both sides ask for the Registrar to use her discretion in their favour. Both sides ask for an award of costs in their favour

5). Both sides filed evidence in support of their pleadings and the matter came to be heard on 12 February 2002. The applicant was represented by Mr Edenborough of Counsel instructed by Messrs Taylor Joynson Garrett, and the registered proprietor was represented by Dr Vittoria of Queens Counsel instructed by Messrs Fitzpatrick.

APPLICANT'S EVIDENCE

6) The applicant filed a witness statement, dated 27 June 2000, by David Corbet Connal the General Affairs Manager of Ferrero UK Limited, a member company of the Ferrero Group of which Ferrero SpA and Soremartec SA are also members. He provides at exhibit DCC1 two statutory declarations (dated 30 April 1997 and 5 November 1997) given by Vivienne Wooll in a related opposition action. Mr Connal states that he has read these statements and confirms the contents to be correct.

7) In her first declaration, dated 30 April 1997, Ms Wooll states that she is the Manager External Affairs of Ferrero UK Limited, a member company of the Ferrero Group of which Ferrero SpA and Soremartec SA are also members. She states that the opponents utilise a logo which is featured in the five registrations shown at Annex A. The logo is shown at exhibit VW1 and is reproduced below for ease of reference.



8) Ms Wooll states that there have been substantial sales in the UK of products bearing the logo since 1967. At exhibit VW3 she provides figures for sales bearing the logo as follows:

Year	Kinder Surprise Net Revenue £	Kinder Chocolate Net Revenue £	Kinder Maxi Net Revenue £	Kinder Bueno Net Revenue £
1991 / 92	5,437,866	180,736	80,356	964,261
1992 / 93	17,431,869	285,457	183,654	833,688
1993 / 94	11,176,706	244,685	1,625	643,858
1994 / 95	12,384,175	94,743	0	247,829

9) Ms Wooll states that the products have been promoted in the UK via advertisements in newspapers and magazines such as *The Grocer*, *Super Marketing* and *Independent Grocer* and also by television advertisements. Figures for promotion on KINDER CHOCOLATE goods in the UK are provided as follows although it is not stated whether these figures relate to expenditure in UK£ (this is confirmed in her later declaration):

Year	Expenditure
1991 / 92	52,101
1992 / 93	-
1993 / 94	9,333
1994 / 95	128,750

10) Ms Wooll states that “goods bearing the logo the subject of the application have been advertised and sold throughout Great Britain and Northern Ireland”. She lists principal towns and cities covering the whole of the UK. She also states that:

“I verily believe that the logo the subject of the above application is recognised throughout the trade as indicating the goods of the opponent”

11) In her second declaration, dated 5 November 1997, Ms Wooll provides at exhibit VW4 sample invoices showing sales of products which she claims bear the logo referred to at exhibit VW1 in her earlier declaration. These invoices show at least one sale of the various products in a number of years as shown below:

Product Name	Years
Kinder Surprise	1991 - 1997 incl.
Kinder Chocolate	1991 - 1997 incl.
Kinder Bueno	1991 - 1997 incl.
Kinder Maxi Bars	1991- 1993 incl. and 1997.

12) Ms Wooll reiterates her claim that the logo has been used on products labelled *Kinder Surprise*, *Kinder Chocolate*, *Kinder Bueno*, and *Kinder Maxi*. At exhibit VW5 she provides two copies of advertisements for *Kinder Bueno* although she does not state how, when or where they appeared. Ms Wool refers to other advertising material but this is not supplied as part of the declaration or its exhibits. Ms Wooll provides advertising figures for Kinder Surprise and Kinder Bueno as follows:

Year	Kinder Surprise £	Kinder Bueno £
1984 / 85	469,000	-
1985 / 86	388,000	-
1986 / 87	407,000	-
1987 / 88	376,000	-
1988 / 89	635,000	-

1989 / 90	421,000	-
1990 / 91	665,000	-
1991 / 92	584,000	-
1992 / 93	1,800,000	162,000
1993 / 94	2,700,000	0
1994 / 95	3,400,000	35,807
1995 / 96	2,900,000	38,348
1996 / 97	2,700,000	28,158

13) At exhibit VW6 Ms Wooll provides a copy of a statement of grounds in an application for rectification filed by Robert Wiseman Dairies Plc and Robert Wiseman and Sons Limited. At paragraph four of the statement Ms Wooll claims that it is admitted “that the mark and the published mark (which are the same as the mark a copy of which appears in VW1) are confusingly similar to the marks of Robert Wiseman Dairies Plc and Robert Wiseman & Sons Ltd (which include trade mark number 2038519 - the subject of this opposition).”

14) Ms Wooll makes a number of comments regarding a declaration by Mr Keane dated 22 July 1997. This declaration was filed as evidence in the other action, however it has been filed as an exhibit by the proprietor in this case. Ms Wooll points out that in his evidence there is no reference to when trade mark 2038519 was first used. She states that the trade marks mentioned in paragraph one of the declaration and the logos in exhibits 2.1, 2.2 and 2.3 are all different to the logo in application 2038519. On the turnover figures provided by Mr Keane she notes that there is no evidence to substantiate them nor show that they relate to goods sold or products provided under the mark at application 2038519.

15) Ms Wooll also claims that there is no evidence of extensive use of the trade mark in application 2038519, that the livery is recognised or that the livery features the trade mark in the said application.

PROPRIETOR’S EVIDENCE

16) The proprietor filed a declaration, dated 20 November 2000, by Alasdair Hume the proprietor’s Trade Mark Attorney.

17) Mr Hume refers to the comments of Ms Wooll regarding exhibit VW6. He points out that the grounds have been amended and refer to a number of trade marks and also a registered design owned by the proprietor in this case.

18) Mr Hume notes that in the opposition proceeding that some of Ms Wooll’s evidence was struck out. However, this occurred as those parts of her declaration were regarded as evidence in chief whereas the declaration was filed in reply. In the instant case the whole of the declaration is accepted.

19) With regard to the claims made by the applicant Mr Hume makes the following points:

- a) There is no evidence that the logo exhibited at VW1 has been used on any products in the UK.
- b) The logo exhibited at VW1 cannot be seen in any of the five registrations provided at exhibit VW2.
- c) The evidence of use provided relates primarily to use on chocolate confectionery products.
- d) The proprietor's registration 1369454 is effective as of 6 January 1989, which predates the effective dates of the applicant's registrations, and that the specifications of the applicant's registered marks are not similar to the specification of the proprietor's mark. Hence the applicant does not have an "earlier right".
- e) No evidence has been filed in relation to the claim of copyright.
- f) The proprietor's mark is inherently distinctive and due to the substantial use of the mark it has acquired distinctiveness.
- g) The proprietor accepts that the logo shown at exhibit VW1 is similar to their registered mark, but deny that the applicant has provided evidence of use of the logo, and certainly no use on goods which are similar to those for which the proprietor's mark is registered.

20) Mr Hume also provides at exhibits FITZ1 and FITZ3 copies of declarations made in relation to other actions between the parties. At exhibit FITZ1 is a copy of a declaration, dated 22 July 1997, together with its exhibits. This declaration is by William G Keane the Secretary and Finance Director of Robert Wiseman Diaries Plc. He states that the applicant company is a wholly owned subsidiary of Robert Wiseman Diaries Plc.

21) Mr Keane states that the applicant is also the proprietor of other similar registered trade marks. A detailed list is provided at Annex B. He states that these marks have been in continuous use in the UK "for many years". At exhibit WGK2 he supplies items of packaging, labels and also brochures many of which show use of the marks at annex B. Only one item, a brochure, shows any dates. There is a reference to the sales in the years to March 1991 and also 1992.

22) Mr Keane supplies turnover figures as follows, although what these marks and goods these refer to is not specified:

Year	Turnover £
1992	39,000,000
1993	46,036,000
1994	59,743,000
1995	107,935,000

23) Mr Keane states that the applicant has used their trade marks extensively in the UK and that its reputation is "especially established because of the very distinctive livery of the applicant's transport fleet and the heavy promotion of its distinctive corporate identity". He continues:

“The applicant’s transport services include the local collection of milk from farms as well as delivery, distribution and transport of the full range of the applicant’s products to numerous retailers, diverse customers, major supermarkets as well as to the ordinary household. ”

24) Mr Keane states that the applicant’s products and services are also promoted by advertising. At exhibit WGK3 he provides three press articles from 1993 - June 1995 which show pictures of the applicant’s mark on vehicles.

25) Mr Keane also comments on the opponents’ evidence. He points out that the opponents do not provide examples of use of the logo, or examples of advertisements. Regarding the sales figures he states that it is not possible to establish whether the sales are of goods bearing the logo, or how the goods are sold.

26) At exhibit FITZ3 is a copy of a declaration, dated 26 June 2000, by Mr Hume together with its exhibits and also a copy of a declaration, dated 26 June 2000, by William G Keane together with its exhibits. In his declaration, Mr Hume provides at exhibits AH1 and AH2 copies of correspondence from the file relating to registration number 2114332 in the name of Ferrero SpA and also a copy of the trade mark from the Registry Journal.

27) Mr Hume claims that the mark, as published, is confusingly similar to a number of the proprietor’s marks and that the specifications are similar. As such he states that the mark should be declared invalid. He also claims that whilst certain aspects of the specification of Trade Mark 2114332 are not similar to those for which the trade marks of Robert Wiseman Ltd are registered, the dissimilar goods (chocolate, bakery products and snacks) are sold in the same outlets as Wiseman products. He therefore seeks to have application 2114332 declared invalid having regard to Section 5(3) and Section 47(2)(a) of the Act.

28) The declaration by William G. Keane provides details of trade marks and their specifications which are owned by Robert Wiseman & Sons Ltd. These are detailed at Annex B. He also provides turnover figures under the various marks from 1993 - 1997. However, the figures for 1993- 1995 have been shown earlier in this decision. I will record only the new figures here:

Year ending 31 March	Turnover £
1996	148,274,000
1997	192,904,000

29) Mr Keane states that the transport services are provided by vehicles which carry the distinctive black and white livery. He claims that this “Friesian cow” marking has become well known and has featured in the press.

30) Mr Keane also states that it is his view that the mark applied for by Ferrero SpA (application number 2114332) if used in black and white (or even in very dark and light contrasting colours) would be confused for one of his company’s marks. He also claims that the products in the specifications of both parties are similar.

31) That concludes my review of the evidence. I now turn to the decision.

DECISION

32) At the hearing Mr Edenborough stated that he would not be pursuing the applicant's grounds for invalidation under Sections 3(3), 3(4), 3(6), 5(2) and 5(4). The ground requesting the Registrar to use her discretion was also not being pursued. Whilst he could not formally withdraw the grounds as he had no such instruction from his client he accepted that these grounds "must fall". Thus the only ground to be considered was that under Section 47(1) in relation to 3(1)(b).

33) Section 47(1) of the Trade Marks Act 1994 states:

47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

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.

34) Section 3(1) of the Act is in the following terms:

3 (1) The following shall not be registered -

- (a)*
- (b) trade marks which are devoid of any distinctive character,*
- (c)*
- (d)*

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.

35) The objection relates to the inherent capacity of the mark to distinguish the applicant's goods. The question is whether the mark in suit is descriptive of the animal from which the goods specified originate. In considering this question I have regard to the comments of Aldous L.J. in *Philips Electronics NV v. Remington Consumer Products Ltd* [1999 RPC 809 at 818]:

"The more the trade mark describes the goods, whether it consists of a word or shape, the less likely it will be capable of distinguishing those goods from similar goods of another trader. An example of a trade mark which is capable of distinguishing is WELDMESH, whereas WELDED MESH would not be. The former, despite its primary descriptive meaning, has sufficient capricious alteration to enable it to acquire a secondary meaning, thereby demonstrating that it is capable of distinguishing. The

latter has no such alteration. Whatever the extent of use, whether or not it be monopoly use and whether or not there is evidence that the trade and public associate it with one person, it retains its primary meaning, namely mesh that is welded. It does not have any feature which renders it capable of distinguishing one trader's mesh from another trader's welded mesh."

36) I also have regard to the comments of Morritt L.J. in the *Bach and Bach Flower Remedies Trade Marks* case [2000 RPC 513 at page 526 line 10]:

"The question is whether or not the word BACH had, by 1979, acquired such a meaning so as to be incapable, without more, of affording the requisite distinction. If it had then section 1(1) is not satisfied, the word BACH cannot be a capricious addition so that registration of the sign would be in breach of paragraph (a); if it had not then the word BACH is an addition to the words FLOWER REMEDIES which is 'capricious' because it is not purely descriptive, so that both the expression BACH FLOWER REMEDIES and the word BACH are capable of affording the necessary distinction. Accordingly I accept the submission that it is both permissible and necessary in considering the application of paragraph (a) to determine the meaning of the word as used at the time of the application for registration. I do not understand Aldous L.J. in *Philips v. Remington* in the passage I have quoted, to have been considering the relevance of use to the meaning of the word."

"The usage in question must be by those engaged in the relevant trade or activity. Normally that will be the usage of the average consumer of the goods in question as described in *Lloyd Schuhfabrik* [European Court of Justice, *Lloyd Schuhfabrik Meyer v. Klijsen Handel BV* 1999 ETMR 690]. Obviously the evidence on that question is not limited to those who are consumers or end-users but may extend to others concerned in the trade such as manufacturers, wholesalers and retailers."

37) I also look to the case of *Cycling IS* dated 28 November 2001 (as yet unreported) where Geoffrey Hobbs QC acting as Appointed Person commented:

"66. That brings me to the question of whether the signs possess a distinctive character enabling them to fulfil the essential function of a trade mark in relation to goods and services of the kind specified in the application for registration.

67. The case for allowing registration rests upon the proposition that the signs are cryptic to a degree which makes it more likely than not that they would carry connotations of trade origin (whatever other connotations they might also carry) in the minds of the relevant class of persons or at least a significant proportion thereof.

68. The case for refusing registration rests upon the proposition that the signs are visually and linguistically meaningful in a way which is more likely than not to relate the goods and services to the activity of cycling without also serving to identify trade origin in the minds of the relevant class of persons.

69. The difference between these two positions resides in the question whether the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin specific or origin neutral.

70. The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect.

71. I do not suppose that such a person would pause to construe the signs when encountering them in any of the different settings (including advertising and promotional settings) in which they might be used. Even so, the degree of attention required to take note of the signs in the first place would be sufficient, in my view, to leave a well-informed and reasonably observant and circumspect person with the clear impression that the signs were being used with reference to goods and services related to cycling.”

38) Later, Mr Hobbs observed:

“73. Doing the best I can on the materials before me, I think that the signs in question would be perceived by the relevant class of persons as pronouncements in identifying cycling as the *raison d’être* for the marketing of the goods and services to which they are related. That is a message that the members of a consortium of bicycle retailers might naturally be interested in putting across to customers and potential customers. I do not think that the nature of the pronouncement or its presentation can in either case be regarded as sufficiently striking to function as an indication of trade origin in relation to goods or services of the kind specified in the application for registration that is now before me.

74. It seems to me that the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin neutral (relating to the general commercial context of the relevant trading activities) rather than origin specific.”

39) Mr Edenborough contended that:

- a) the applicant was primarily involved in the collection, transportation and sale of liquid milk.
- b) The mark in suit was designed to allude to a Friesian cow and therefore by connection to the product of a Friesian cow, namely milk.
- c) The mark was filed in black and white in order to evoke such imagery in the minds of the consuming public.
- d) As a result of a-c the mark in suit offends against Section 3(1)

40) Mr Edenborough referred me to the applicant’s evidence which shows road tankers painted in “Friesian livery”. However, this is not use of the mark sought to be registered but use of other registered marks which (broadly) have irregular patterns of black on a white background (see annex B).

41) The applicant is seeking to register a panel divided almost into three unequal segments by two wavy lines. The two lines are different, but each consists of a repeating pattern. The top

forty percent, approximately, of the panel is coloured black, the next forty percent, approximately, is white, with the bottom twenty percent, approximately, being black. The mark may cause the average consumer to equate this mark with the skin of a Friesian cow, it then requires the consumer to conjure up an image of the whole animal. From this point the connection then has to be made with the product. In my opinion the average consumer will not analyse the mark to this extent. The mark merely alludes to the hide of a Friesian cow; it does not depict the animal.

42) I take the view that the mark in suit would be perceived by the average consumer as being origin specific rather than origin neutral. I do not consider the mark to be devoid of distinctive character, nor do I consider that it serves in trade to designate the kind, quality, value, or any other characteristic of the goods. Nor has any evidence been provided that the mark is a sign which is commonly used in the trade.

43) Mr Edenborough further asserted that the mark in suit offended against Section 3(1) of the Act in “the same way that attempting to register the colour “pea green” for peas would be offensive.” The specification for the mark in suit consists of what might loosely be referred to as milk or dairy products in Class 29. I am not aware that these products are usually coloured black and white. The opposition under Section 3(1) fails.

44) The application for invalidity having failed the proprietor is entitled to a contribution towards costs. At the hearing Dr Vittoria requested that, if I found in her favour, that I award costs above the normal scale. She contended that following an earlier decision in a similar case between the two parties that the applicant had an unarguable case. Dr Vittoria also questioned the relevance of much of the applicant’s evidence, and pointed out the amount of work she had been forced to carry out in preparation for the hearing in addition to her actual attendance.

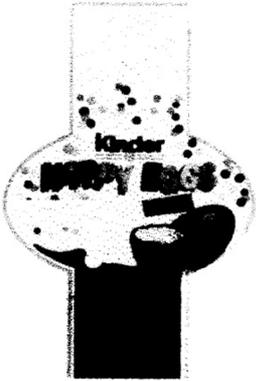
45) I do not accept these contentions. Clearly the applicant believed that they had a tenable argument, although in the light of my decision in the earlier case perhaps their confidence was less than high. As to the preparation for the hearing I am conscious that the skeleton arguments of both sides bear more than a passing resemblance to those used in the previous case whilst the evidence would have been read in preparation for the revocation action between the parties due to be heard immediately after the instant case. In the circumstances I do not believe that it is appropriate to go beyond the normal scale of costs.

46) I order the applicant to pay the proprietor the sum of £1535. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12 day of March 2002

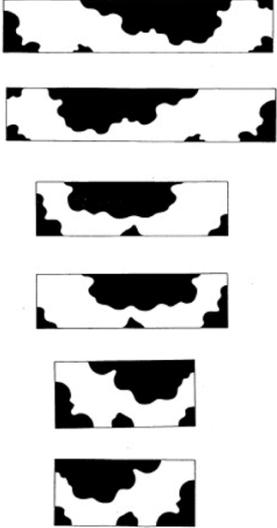
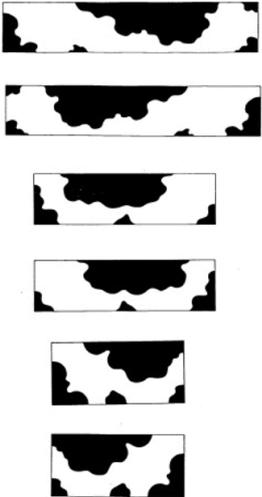
George W Salthouse
For the Registrar
The Comptroller General

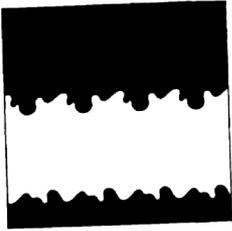
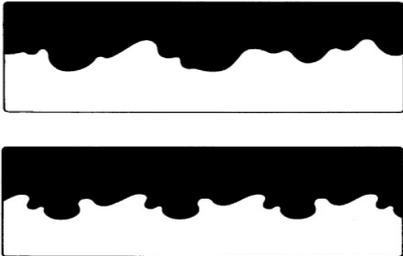
ANNEX A

Mark	Number	Effective Date	Class	Specification
	1525450	1.2.93	30	Chocolate and chocolate products; all included in Class 30.
	1529878	16.3.93	30	Cold pastry products with filling comprising milk, cocoa and/or other ingredients enrobed with chocolate or chocolate flavoured with or without granulated covering; all included in Class 30.
	1561631	8.2.94	30	Chocolate, chocolate products and confectionery; all being shaped in an egg form and all with a creamy filling; all included in Class 30.

	1569173	19.4.94	30	Products consisting of hazelnut milky filling surrounded by wafer and coated with chocolate.
	1390446	5.7.89	30	Milk chocolate bars; all included in Class 30.

ANNEX B

Mark	Number	Effective Date	Class	Specification
	1511963	3.9.92	39	The delivery of goods and transport of goods by road; all included in Class 39
	1511962	3.9.92	29	Milk, milk beverages and milk products; all included in Class 29.

	B1369454	6.1.89	29	Milk and milk products; cream; semi skimmed milk; dairy products; butter; butter cream; edible oils and fats, margarine; milk beverages; yoghurts; all included in Class 29.
 <p data-bbox="300 1059 603 1072">The mark consists of the pattern on the packaging.</p>	2044276	10.11.95	29	Milk, milk beverages, milk products; dairy products; yoghurt; cream; edible oils and edible fats; butter.
	2038519	27.9.95	29	Milk, milk beverages, milk products; dairy products; yoghurt; cream; edible oils and edible fats; butter.
			39	Collection and delivery of goods, milk, milk beverages and milk products.