

O-116-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2462819
IN THE NAME OF CADBURY ENTERPRISES PTE LTD

AND

OPPOSITION THERETO UNDER NO 95827
BY SOCIÉTÉ DES PRODUITS NESTLÉ S.A.

Background

1. Application no 2462819 is for the mark THE NATURAL. It stands in the name of Cadbury Enterprises Pte Ltd (“Cadbury”) and has a filing date of 31 July 2007. The application seeks registration in respect of the following goods:

Class 30

Sugar confectionery

2. On 28 December 2007 Société des Produits Nestlé S.A. (“Nestlé”) filed notice of opposition to the application, the grounds of which were, in summary, as follows:

- under section 3(1)(a) in that the mark is not capable of distinguishing the goods of one undertaking from those of other undertakings;
- under section 3(1)(b) in that the mark is a combination of two non distinctive words which either separately or together cannot indicate that the goods come from one undertaking;
- under section 3(1)(c) in that the mark consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, intended purpose or other characteristics of the goods including that the goods sold under or by reference to the mark contain natural ingredients;
- under section (3)(3)(b) in that the mark would deceive the public if the goods sold under it do not contain any or a sufficient amount of natural ingredients; and,
- under section 3(4) of the Act in respect of goods which do not comply with the requirements of the Trade Descriptions Act 1968, The Food Labelling Regulations 1996, the Food Safety Act 1990 and the Food Standards Agency 2002 advice on “criteria for the use of the terms Fresh, Pure, Natural, etc. in food labelling”.

3. Cadbury filed a counterstatement in which it admits that the words “THE” and “NATURAL” are individually in common usage in the English language but otherwise it denies each of the grounds of opposition. It claims: “[the mark] comprises two elements: the definite article “THE” and the adjective “NATURAL”. The combination of the definite article “THE” (which usually suggests that a noun will follow) followed by the adjective “NATURAL” is syntactically unusual and inventive. It creates a memorable grammatical tension which results in the Application being clearly capable of distinguishing the goods of the Applicant from those of other undertakings”

4. Nestlé filed evidence in these proceedings and both parties filed written submissions. Neither party requested to be heard. I give this decision after careful consideration of all the material before me.

The evidence and submissions

5. In addition to its Notice of Opposition, Nestlé filed written submissions dated 1 December 2008 which made reference to, and was accompanied by, a witness statement from Richard James Wood dated 30 October 2008 and exhibits RJW1-3.
6. For its part, Cadbury filed written submissions dated 29 May 2009.
7. In response, Nestlé filed further written submissions along with a witness statement of Dale Carter and exhibits DC1-3, each dated 26 November 2009.
8. I do not intend to provide a full summary of either the evidence filed by Nestlé or the submissions filed by both parties as there is much which is duplicative, however I will refer to them as necessary within the body of this decision.
9. I intend to deal first with the objection founded on section 3(1)(a) of the Act.

The objection under section 3(1)(a)

10. Section 3(1)(a) states:

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

(a) signs which do not satisfy the requirements of section 1(1)”

11. For its part, section 1(1) states:

“1.-(1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.”

12. In its Notice of Opposition, Nestlé sets out its objection under section 3(1)(a) in the following terms: “it is a sign that is not capable of distinguishing the goods of one undertaking from those of other undertakings”. Whilst the Notice of Opposition contains no further explanation of the objection under this ground, in paragraph 8 of its written submissions of 1 December 2008 it states:

“Registration of The Mark is objectionable under Section 3(1)(a) of the Act because it is not capable of distinguishing the goods of one trader from those of others. The case in hand is one (sic) a par with the example given by Jacob J (as he then was) in Philips Electronics v Remington [1998] RPC 283, at 299-302, where the judge used the example of someone trying to obtain registration for the word SOAP for “soap”. NATURAL plainly describes natural confectionery. The addition of the definite article “The” no more gets NATURAL over the Section 3(1)(a) hurdle then (sic) it would SOAP”

13. In its written submissions of 26 November 2009 Nestlé states:

“In addition to the case law relied upon at paragraph 8 of the Opponent’s submissions dated 1 December 2008, the Opponent refers to the comments of Mr Geoffrey Hobbs QC sitting as the Appointed Person in AD 2000 Trade Mark where he stated:

“Section 3(1)(a) has the more limited effect envisaged by Article 3(1)(a) of the Directive of preventing the registration of “signs which cannot constitute a trade mark” at the time when they are put forward for registration”.

It is the Opponent’s submissions that the Applicant’s mark falls squarely within this category of mark, being a mark that is incapable of distinguishing the goods of the Applicant from those of other undertakings.

In addition or in the alternative, the Opponent submits that the Applicant’s mark is not a “sign” within the meaning of Section 3(1)(a). The ECJ has provided guidance on what constitutes a “sign” within the meaning of Section 3(1)(a) (see Cases C49-02 *Heidelberger Bauchemie GmbH* and C321/03 *Dyson Ltd v Registrar of Trade Marks*) and it is understood that the underlying purpose of the requirement to be a “sign” is to prevent the abuse of trade mark law by obtaining an unfair competitive advantage.”

14. Whilst any objection should be set out in full in the pleadings at the outset of proceedings rather than in written submissions filed later, Cadbury has not taken issue with the objection being made on the basis set out in the written submissions. In any event, the matter can be dealt with fairly promptly.

15. Section 1(1) defines a trade mark and requires a sign to be capable of being represented graphically. It also requires a sign to be capable of distinguishing goods of one undertaking from another. The mark the subject of this application consists of two words which clearly, *are* represented graphically and thus the first requirement is met. As to the second requirement and the analogy with registration of the word SOAP for “soap”, I do not consider the analogy is well made as the mark applied for is THE NATURAL whereas the goods are sugar confectionery.

16. Also in *AD 2000 Trade Mark* Mr Hobbs Q.C. said:

“Section 3(1)(a) prohibits the registration of “signs” which do not satisfy the requirements of section 1(1) (because they are incapable of being represented graphically and/or are incapable of distinguishing goods or services of one undertaking from those of other undertakings) whereas the prohibitions in sections 3(1)(b), 3(1)(c) and 3(1)(d) are applicable to “trade marks”, i.e. signs which satisfy the requirements of section 1(1), but nonetheless lack a distinctive character in the absence of appropriate use. This implies that the requirements of section 1(1) are satisfied even in cases where a sign represented graphically is only “capable” to the limited extent of being “not incapable” of distinguishing goods or services of one undertaking from those of other undertakings. Such signs are not excluded from registration by section 3(1)(a). Section 3(1)(a) has the more limited effect

envisaged by article 3(1)(a) of the Directive of preventing the registration of “*signs which cannot constitute a trade mark*” at the time when they are put forward for registration. It is clear that signs which are not objectionable under section 3(1)(a) may nevertheless be objectionable under other provisions of section 3 including sections 3(1)(b), 3(1)(c) and 3(1)(d).”

17. In my view the objection under section 3(1)(a) is not well founded. The mark is represented graphically and is one which is capable, in appropriate circumstances and if only “to the limited extent of being “not incapable””, of distinguishing the goods of one trader from another. That being the case, the opposition based on the grounds of section 3(1)(a) is dismissed.

The objection under section 3(1)(b) and (c)

18. Section 3(1) also provides that 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 characteristic of goods or services,

(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.”

19. It is possible that the trade mark could have benefitted from the proviso to rule 3(1) if, by the date of application, it had acquired a distinctive character as a result of the use made of it. As Cadbury has not filed any evidence of use however, it cannot therefore derive any such benefit.

20. I will first consider the ground under subsection (c) of the Act. Nestlé submits that the mark applied for is not inherently distinctive. It submits the mark is made up of a combination of two non-distinctive words and sounds like the opening words of an emphatic statement. That combination is not, it says, an unusual one nor does it constitute an unusual juxtaposition of words. The mark is merely the sum of its parts with the dominant part of the mark being the word NATURAL. The word NATURAL sends a clear and unambiguous message to consumers to indicate the goods contain natural ingredients. The addition of the word THE before NATURAL does not detract from this. The word NATURAL is a word with informational value and is descriptive of natural confectionery i.e. confectionery made without artificial colours or flavours. In a time of increasing consumer demand for foodstuffs to contain fewer synthetic ingredients, the average consumer would immediately and without reflection take goods sold under the mark to be a natural product. In Nestlé’s view the mark applied for lacks distinctive character and is origin neutral.

21. For its part, Cadbury admits the words making up the mark are common words in the English language but submits that the combination of the definite article THE followed by an adjective NATURAL is syntactically unusual and inventive. The words in combination create a memorable grammatical tension. The mark is not merely NATURAL but is instead THE NATURAL and would not therefore indicate that the goods contain natural ingredients and so would not be descriptive. Whilst a person may be called “a natural”, the same does not apply to goods. The words THE NATURAL would not commonly be used in relation to products. In Cadbury’s view the mark has the minimum degree of distinctive character required for it to be registrable.

22. Nestlé refers me to the case of *OHIM v Wm Wrigley Jr Company (Doublemint)* [2004] RPC 18 wherein it was stated:

“By prohibiting the registration as 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 the 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).”

23. I note the comments made in *Matratzen Concord AG v Hukla Germany SA* Case C-421/04) where the ECJ stated:

“In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, who are reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

24. I am also mindful of the decision of the General Court (formerly CFI) in *Ford Motor Co v OHIM*, Case T-67/07 where it was stated:

“there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics.”

25. There is no dispute that the mark is made up of two common English words, words which are likely to be well known to consumers of sugar confectionery. The Oxford Dictionary of English, 2nd ed. provides the following definitions:

THE: denoting one or more people or things already mentioned or assumed to be common knowledge: *what's the matter, call the doctor, the phone rang.*

used with an adjective to refer to something of the class or quality described: *they are trying to accomplish the impossible.*

(pronounced stressing "the") used to indicate that someone or something is the best known or most important of that name or type: *he was **the** hot young piano prospect in jazz.*

NATURAL: existing in or derived from nature: not made or caused by humankind; *carrots contain a natural antiseptic.*

having had a minimum of processing or preservative treatment: *natural food; our nutritional products are completely natural*

26. Mr Wood is a Regulatory Affairs Manager at Nestlé. He is a professionally qualified Food Technologist and has been an advisor on food law for over ten years. He sits on a number of Trade Association technical and regulatory committees and is Chair of the Regulatory and Scientific Committee for CAOBISCO, the Association of the Chocolate, Biscuits and Confectionery Industries of the EU. In his evidence he states:

"Owing to consumer demand for fewer synthetic ingredients, the European confectionery industry has been developing products free from artificial colours and flavours and/or with natural colours and flavours-which normally bear such claims. Whilst sugar confectionery is increasingly free from artificial colours and flavours, only a limited number of products will be truly made from all natural ingredients and/or be considered natural products. For example, jelly confectionery is often based on glucose syrup, which is industrially manufactured by conversion of cereal starches to sugars-a practice which could not be considered as natural. In addition, sugar confectionery often contains acids, used to increase acidity or impart taste; additives which have been synthesised could not be considered as natural."

27. Mr Wood exhibits, at RJW2, the Food Standards Agency Guidance on "Criteria for the Use of the Terms Fresh, Pure, Natural etc. in food labelling". Although shown to be a July 2008 revision, the document indicates its origins date back to 2001. Referring to the conclusions of a Food Advisory Committee review from 2001, it states:

"Natural" means essentially that the product is comprised of natural ingredients, e.g. ingredients produced by nature, not the work of man or interfered with by man."

It goes on to say that:

“Within the context of the health and nutrition claims legislation it is suggested that “naturally/natural” means that either nothing has been removed or nothing has been added to the food, and additionally that the food has not been subjected to any processes or treatment to render it such that it meets the condition.”

28. Whilst Cadbury has not challenged any of the above evidence, it submits that “it is unusual for a definite article and an adjective to be combined” and that the mark is “a distinctive and unusual phrase which does not carry any descriptive quality”.

29. Cadbury has also referred me to an earlier registration of the mark THE NATURAL by the Irish Patents Office and submits an extract from the Irish register of trade marks showing the registration of the same mark in respect of confectionery. The extract does not appear to be complete (it is marked page 1 of 2 and the text at the end of the extract seems to cut off mid-sentence). I have no evidence before me which gives any indication of the basis of the acceptance for registration of the mark by the Irish Patents Office but in any event whilst the fact that an identical trade mark has been registered for identical goods in another Member State may be taken into account when under consideration by the competent authority, it is not determinative of the outcome of that consideration. As was stated in *Henkel KGaA v Bundespatentgericht*, Case C-218/01:

“...the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered.”

30. I also note the following comments of Geoffrey Hobbs Q.C. in *Telewest Communications plc's Trade Mark Application* [2003] RPC 26:

“I do not doubt that there is a need for consistency of approach to the registration of trade marks under the applicable provisions of Community law. However, differences of approach may result from the fact that the correct approach continues to be the subject of analysis in the case law of the supervising courts in Luxembourg. And tribunals adopting the correct approach may nevertheless arrive at different conclusions as to the registrability of a particular trade mark on an overall assessment of the circumstances prevailing in the territory to which their jurisdiction extends.”

31. I have to consider the mark before me on the basis of the market in the United Kingdom and the evidence which is before me. Having done so, I consider that whilst it may be that the word NATURAL is more commonly used as an adjective, it can also function as a noun (e.g. “he was a natural”) or as an adverb (e.g. “just act natural”). And, whilst the word THE is most often used as a determiner and therefore is used in conjunction with a noun (e.g. “the phone”) the dictionary reference set out above makes it clear that it is also used with an adjective (e.g. “the impossible”).

32. The word NATURAL is an ordinary dictionary word used in everyday language. Practices in the marketplace are a relevant consideration (*Sat. 2.* paragraph 43). The evidence clearly shows that the word NATURAL is used directly in relation to foodstuffs. Furthermore, that guidance on the use of the word NATURAL has been issued by the Food Standards Agency shows that the word is recognised as meaningful in the food industry both from the view of food producers and consumers. The use of the word in marketing through the broadcast media is also subject to restrictions as is shown by the Notes for Guidance published by Clearcast and exhibited at RJW3 is further evidence of the fact that the word is meaningful. Put simply, this regulation of the word NATURAL is in place to protect the consuming public from being misled because of the likelihood that it will take the word as saying something definite about foodstuffs including confectionery.

33. Taking all the evidence into account, I am of the view that the word NATURAL is one which serves to indicate a characteristic of the goods in that it sends out a clear message to the consumer that the goods sold under it are either made from natural ingredients or, alternatively, are made with the minimum amount of processing or treatment. It is a word which traders may well wish to use to market such goods or use in the normal course of their businesses and, that being the case it would struggle to demonstrate any distinctive character absent use.

34. The mark applied for is not, of course, the word NATURAL but THE NATURAL. In my view, the addition of the definite article would have little if any effect on the perception of the consumer. On the contrary, if the word THE is given any prominence or emphasis in use, it is likely to add further strength to the objection to the extent that it suggests a laudatory connotation i.e. that the goods are the pre-eminent or leading ones of their type. Alternatively, it poses a question or statement: "The natural...?" inviting the consumer to fill in the remainder which, if anything, throws the focus firmly back on the word NATURAL.

35. The opposition based on section 3(1)(c) succeeds.

36. If a trade mark is entirely descriptive of a characteristic of the goods, and is prohibited from registration under the provisions of section 3(1)(c) of the Act, it will also be devoid of any distinctive character under section 3(1)(b) (see: *Koninklijke KPN Nederland BV v Benelux-Merkenbureau (Postkantoor)* [2004] ETMR 57. That being the case, the opposition also succeeds under section 3(1)(b).

37. The opposition having succeeded under sections 3(1)(b) and (c), I see no need to consider the grounds of opposition under sections 3(3)(b) and (3)(4) of the Act.

Costs

38. Nestlé having been successful in its opposition is entitled to an award of costs in its favour. Neither party made any specific submissions on costs. No hearing took place. I therefore award costs on the following basis:

Preparing a statement and reviewing the other side's statement	£300
Official fee	£200
Preparing/reviewing evidence and submissions	£800
Total	£1300

39. I order Cadbury Enterprises Pte Ltd to pay Société des Produits Nestlé S.A. the sum of £1300. This sum is 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 15 day of April 2010

**Ann Corbett
For the Registrar
The Comptroller-General**