

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION Nos 2209963 &
2209491 BY BFS GROUP LTD TO REGISTER A MARK
IN CLASSES 29, 30, 31, 39 & 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER Nos 50783
& 50784 BY WOODWARD FOODSERVICE LTD**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application Nos 2209963 and 2209491
by BFS Group Limited to register a Mark
in Classes 29, 30, 31, 39 and 42**

and

**IN THE MATTER OF Oppositions thereto under Nos. 50783
and 50784 by Woodward Foodservice Limited**

BACKGROUND

1. On 24 and 29 September 1999 BFS Group Ltd applied to register two trade marks: "THREE SIX SIX THREE" in word form and the following trade mark in classes 29, 30, 31, 39 and 42.



2. Following examination the applications numbered 2209963 and 2209491 were accepted and published for the following goods and services:

Class 29:

Meat; fish; poultry; preserved, dried and cooked fruits and vegetables; snack foods and prepared meals; jellies; jams; dairy products; eggs; milk and milk based drinks; butter; cheese; yoghurt; cream; nuts and potato crisps; soups; spreads and pate; salads; edible oils, oils for use as salad dressings; pickles and preserves; frozen foodstuffs; frozen prepared meals.

Class 30:

Coffee, mixtures of coffee and chicory; drinking chocolate and cocoa; tea and herbal tea; sugar; rice; flour and preparation made of flour; bread; snack foods and snack food products; pastry and cakes; pasta; biscuits; chocolate and confectionary; ice creams and sorbets; sauces and spices; salad dressings and mayonnaise; frozen foodstuffs; frozen prepared meals.

Class 31:

Agricultural; horticultural and forestry products and grains; fresh fruits and vegetables; nuts, beans, herbs and seeds, crustaceans.

Class 39:

Transportation and distribution of goods; packing and crating of goods; refrigerated storage facilities; warehousing.

Class 42:

Catering services; preparation of foodstuffs.

3. On 1 March 2000 Woodward Foodservice Ltd, filed notices of opposition. The grounds of opposition pursued before me are in summary:

- (a) under Section 3(1)(b) of the Act, because the trade marks for which registration is sought are devoid of distinctive character, in that the numbers "3663" and the words "THREE SIX SIX THREE" spell "food" on a touch tone telephone key pad
- (b) under Section 3(1)(c) of the Act, because the trade marks consist exclusively of signs or indications which may serve in trade to designate the kind of goods and the intended purpose of the services sold and provided under the trade marks.

Grounds of opposition based upon Sections 3(6) and 5(4) of the Act which were pleaded but not pursued are dismissed.

4. On 18 July 2000 the applicants' filed Counterstatements in which the grounds of opposition are denied.

5. Both parties filed evidence in these proceedings and both sides ask for an award of costs. The matter came to be heard on the 15 January 2002. The applicants' were represented by Mr Mark Engelman of Counsel instructed by Pinsent Curtis and the opponents were represented by Mr Douglas Campbell of Counsel instructed by Potts Kerr & Co. The evidence in both cases is identical and though the cases were not consolidated, it was felt to be appropriate for a single decision to be issued, following single skeleton arguments and single submissions from Counsel.

OPPONENTS EVIDENCE

6. This consists of a Witness Statement dated 30 October 2000 by Paul Attwood. Mr Attwood explains that he is the Company Secretary of Woodward Foodservice Limited, a position he has held for at least the last three years.

7. The following points emerge from Mr Attwood's statement:

- Mr Attwood asserts that it is common practice for traders to use letters on a telephone keypad to assist customers with recollecting the traders telephone numbers. In support of this assertion, Mr Attwood refers to Exhibit PA1, which he says shows examples of such practice by traders. Included in the exhibit is a copy of the opponents' brochure dated October 1999-January 2000 which he says exemplify such practice.
- Mr Attwood further refers to the brochure at Exhibit PA1 which is evidence after the material date and therefore unhelpful, which he believes clearly substantiates the opponents use of "3663" as a trade mark within the UK prior to the filing date of the application being opposed.
- Mr Attwood refers to the opponents United Kingdom Trade Mark application No 2212379 and advises that he is of the understanding that the United Kingdom Registry is also aware of the practice mentioned above. This assertion is based on the fact that Section 3(1)(b)&(c) objections were raised against trade marks 1, 3 and 7 in a series of 8. The relevant trade marks are "3663"; "THREE SIX SIX THREE" and "3663(FOOD)". Exhibit PA2 is a copy of the Form TM3 of the said application, a copy of the Examiner's letter raising the aforementioned objection, together with a printout of the current status of the application.

APPLICANTS' EVIDENCE

8. This consists of a Witness Statement dated 30 January 2001 by Liam Taylor. Mr Taylor explains that he is the Marketing Controller for BFS Group Limited, a position he has held for the last four years. He confirms that he is authorised to speak on the applicants' behalf in these proceedings and the evidence given comes from his own knowledge or is extracted from the applicants' records.

9. The following points emerge from Mr Taylor's statement:

- That the applicants' have used the 3663 (stylised) trade mark since the rebranding of the company in November 1999. The mark was chosen because it has a striking name, chosen to represent a progressive company and is intended to symbolise the applicants' intention to create a stir in the market place, bringing fresh ideas to food service distribution. Exhibit 2 consists of copies of news pages taken from the applicants' website together with details of the applicants' services and brands.
- That the applicants' provide both services and goods under the 3663 (stylised) mark on a nationwide basis and have a range of up to 15,000 lines including frozen and chilled foods, groceries, cleaning materials, disposables and other non-food products.
- That the range of goods provided under the 3663 (stylised) mark includes cheese, frozen vegetables, meat, poultry, ready meals, bread, pastries, canned fruit and vegetables, coffee, biscuits, cereals, stuffings, mixes, nuts, pasta, rice, pickles, preserves, dressings, sauces, soups, herbs and spices.

- At Exhibit 3 are details of the half year results for the applicant as at 31 December 1999 as shown on their website. The approximate total turnover in goods and services under the 3663 (stylised) mark in the United Kingdom to date can be broken down for the respective financial years as follows("3663" being introduced in November 1999):

Year	Turnover
1999	£1 Billion
2000	£950 Million

- It is said that substantial amounts have also been spent on advertising and promoting the services under the 3663 (stylised) trade mark in the United Kingdom and the approximate amount spent to date amounts to:

Year	Advertising/Promotional Spend (£)
1999/2000	£3 Million

- That the 3663 (stylised) trade mark has been promoted throughout the UK by way of stationery, depot livery and signage, vehicle livery, price lists, portfolio, trade press advertisements, packaging, promotional leaflets, promotional magazines, exhibitions, videos, websites and corporate giveaways. Exhibit 4 is a selection of such advertising and promotion.
- Mr Taylor asserts that the evidence shows that there is no direct association between the trade mark and any telephone number and that the trade mark is distinctive in its own right. Further, if one were to use the equivalent of the numeric mark 3663 on an alpha numeric key pad it would not only spell "FOOD" but other words such as "DONE" and "FOND".
- Mr Taylor confirms that the applicants' have no intention to obtain exclusive protection for part of any telephone number incorporating the numerals "3663". The applications, the subject of the oppositions are for a stylised representation of the numerals 3663 and the word equivalent and not for the representative numerals alone.
- That the opponents have not provided any supporting evidence of their reputation in the trade mark "3663(FOOD)" in the UK and particularly, they have provided no details of turnover or advertising spend since the trade mark was first used. Further there is no evidence to show that they have actively marketed 3663 as a brand. Referring to Exhibit PA1, the opponent appended a copy of their October 1999/January 2000 brochure. This evidence post dates the applicants' date of application.
- That the applicants' have built up a substantial goodwill and reputation in the 3663 (stylised) trade mark in the 15 months since trading first commenced under the trade mark and Mr Taylor confirms that from the date of first use of the 3663 (stylised) trade mark, there have been no recorded instances of confusion with the alleged use of "3663" (FOOD) by the opponent.

10. That concludes my review of the evidence in so far as I think it necessary.

Decision

11. Though I have included in this decision a comprehensive summary of the evidence for the benefit of any appellate tribunal, I do not consider much of it relevant to these proceedings, which was acknowledged by both Counsel. I have therefore taken particular cognisance of the submissions of learned Counsel and the extensive number of authorities upon which they relied, in particular the applicants. Not all are specifically referred to below.

12. The proceedings are based upon section 3(1)(b) and (c). The statutory provisions state as follows:

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

(a)

(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,

(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”.

13. In this case the applicants seek registration of the following trade marks: “3663” plus a device and the words “THREE SIX SIX THREE”. The opponents argue that the trade marks are objectionable in that the numbers 3663 and their word equivalent spell out the word “food” on an alpha-numeric telephone key pad. At the hearing, Mr Campbell sought to rely on the Court of Appeal decision in 800 Flowers Trade Mark (2000) FSR 697. In that case the Court found that a significant proportion of people would make the connection between letters and numerals on an alpha numeric telephone key pad. In relation to these cases Mr Campbell further suggested that I should consider whether the trade marks are “freighted with telephone significance”. Mr Campbell argued that either presentation of the term “3663” was so freighted in the context of ordering of food by telephone.

14. Mr Engelman, on the other hand sought to argue that the average well informed consumer does not carry around the knowledge of the alpha-numeric key pad foremost in their mind (as they would not walk around with a dictionary). In relation to the 800 Flowers decision and the concept of “freighted with telephonic significance”, Mr Engelman submitted that it was only plausible in relation to the juxtaposition of 800, the numbers, and the word flowers (or

something similar) and which clearly had and would have telephonic significance. Telephone numbers such as these were rightly cordoned off by the Trade Marks Registry and the Courts because they were a generic digit code for national free phone dialling whereas four digit numbers such as "3663" meant nothing to the average well-informed consumer. Mr Engelman referred to paragraph 119 in the 800 flowers case:

"These observations demonstrated, if demonstration were needed, that the mark 800-flowers was selected in the context of, and is inextricably linked with, the operation of the applicant's free phone business in the USA. Were that not so, it would be difficult to think of a style and company less apt to distinguish the business of an ordinary florist than a number apparently chosen at random followed by a word describing the industry's product. It is this association between the mark and the phone number that has overlaid the whole of this case"

15. Both Mr Campbell and Mr Engelman went on to address me on the decision in *Procter & Gamble v OHIM ('BABY DRY')*, Case C-383/99P, where the Court of Justice said:

"The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to none of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.

As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.

It is true that Article 7(2) of Regulation No 40/94 states that Article 7(1) is to apply notwithstanding that the grounds of non-registrability obtain in only part of the Community. That provision, which was rightly cited at paragraph 24 of the contested judgement, implies that, if a combination of words is purely descriptive in one of the languages used in trade within the Community, that is sufficient to render it ineligible for registration as a Community trade mark.

In order to assess whether a word combination such as "BABY-DRY" is capable of distinctiveness, it is therefore necessary to put oneself in the shoes of an English-speaking consumer. From that point of view, and given that the goods concerned in this case are babies nappies, the determination to be made depends upon whether the word combination in question may be viewed as a normal way of referring to the goods

or of representing their essential characteristics in common parlance.

As it is, that word combination, whilst it does unquestionably allude to the function which the goods are supposed to fulfil, still does not satisfy the disqualifying criteria set forth in paragraph 39 to 42 of this judgement. Whilst each of the two words in the combination may form part of expressions used in everyday speech to designate the function of babies' nappies, their syntactically unusual juxtaposition is not a familiar expression in the English language, either for designating babies' nappies or for describing their essential characteristics".

16. There is evidence that the applicants and the opponents both use full telephone numbers which incorporate the numerals 3663 and that they are directing their respective customers to the alpha equivalent of the numbers. But, as far as the evidence is concerned there is no widespread use of the alpha numeric term 3663 (FOOD) within any of the trades relevant to the specification of goods and services set out in the application, though I do not ignore the future tense attached to the word 'may' in Section 3(1)(c) see the comments in *Windsurfing Chiemsee Produktions-und Vertriebs GmbH (WSC)* in *Joined Cases C-108/97 and C-109/97*.

17. The Trade Marks Registry Practice Circular (05/00) to which I was referred in the course of the Hearing indicates that the practice is to allow, for example, four numbers to be registered (even if they have a descriptive alphabetical equivalent) where they appear to be chance numbers. This is because, I assume, the general public do not seek to impart as a matter of course a letter of the alphabet, by reference to an alpha-numeric telephone key pad, to a short numerical string. Thus, for example the public would not, and do not, as far as I am aware, seek to translate the trade mark '4711' (used on toilet water) into its alphabetical equivalent. They only seek to do so when there is obviously a telephone number there, as in '800 Flowers'. In the applicants' case one of their telephone numbers is 0870 3663 000; and one of the opponents' is 0845 600 3663. But it seems to me that the terms 3663 and THREE SIX SIX THREE on their own are not ones which would be used by themselves to indicate the telephone number of the supplier of food or services alluding to that activity. The two terms therefore do have some distinctive character. The objection based upon Section 3(1)(b) must be dismissed and, as I have already indicated, the respective signs here do not of themselves indicate anything within the relevant trades which would render the trade marks objectionable under Section 3(1)(c), therefore the opponents' objection under that head too should be dismissed.

18. At the hearing, I heard submissions from Mr Engelman with regard to costs. He sought to persuade me that costs should be awarded off the scale. Mr Engelman argued that the opponents were aware that they were unable to sustain the grounds of opposition based upon section 5(4)(a) and section 3(6), but these grounds were not dropped from the opposition until the last moment ie. it was clear from Mr Campbell's skeleton argument that these grounds were no longer to be pursued. However, I note that while Mr Engelmans skeleton argument comprises seventeen pages, only two are concerned with the grounds of opposition based on section 3(6) and section 5(4)(a). Thus I do not think that the applicants' were put to any significant extra cost at this final stage. But there is no doubt that they had to address the grounds in their perusal of the opponents' evidence and in their own evidence. In the

circumstances I am prepared to award them an additional £500 in costs to reflect the additional work and cost imposed upon them.

19. As the opposition has failed, I order the opponents to pay to the applicants' the sum of £1800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the determination of this case if any appeal against this decision is unsuccessful.

Dated this 30 day of April 2002

**M KNIGHT
For the Registrar
the Comptroller-General**