

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2206281  
BY UNILEVER PLC  
TO REGISTER A SERIES OF TRADE MARKS  
IN CLASSES 29, 30, 32 AND 42**

**AND IN THE MATTER OF AN APPEAL  
TO THE APPOINTED PERSON  
BY THE APPLICANT  
AGAINST THE DECISION OF MR A. J. PIKE  
DATED 17 SEPTEMBER 2001**

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**DECISION**

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**Introduction**

1. This is an appeal to the Appointed Person from a decision of Mr. A. J. Pike, acting for the registrar of Trade Marks, dated 17 September 2001 in which he refused a request by Unilever PLC (“the applicant”) to register a series of trade marks in respect of tea and tea related products and services.
2. The series applied for comprises the two figurative trade marks represented below:



3. The sole difference between the two marks in the series is that the first mark is shown in colour. However, since the form of application contained no colour claim, Mr. Pike disregarded the colours in the first mark pursuant to Rule 5(3) of the Trade Marks Rules 2000. In any event, he found nothing unusual about the colours used in the first mark. The applicant makes no appeal against that part of Mr. Pike's decision.
4. The applicant specified for protection a wide range of goods and services in Classes 29, 30, 32 and 42. On appeal before me, the applicant confirmed that its only interest lay in tea and tea related products and services for which partial refusal had been issued by the registrar.
5. The applicant supplied purported examples of the marks in use. The examples did not concern the series of trade marks applied for and Mr. Pike afforded them no weight. Again, the applicant makes no appeal against that aspect of Mr. Pike's decision.
6. Since no evidence of use was adduced in support of the application, the hearing officer had only the prima facie case to consider.

### **Refusal of the Application**

7. The application was considered objectionable by the hearing officer under section 3(1)(b) of the Trade Marks Act 1994 ("the TMA") in so far as it related to tea and tea related products and services. Whilst the specifications included tea or tea related products or services the objection under section 3(1)(b) must be maintained.
8. Mr. Pike assessed the series as follows:

The two trade marks consist of processed tea leaves arranged in a shape reminiscent of a leaf. In both marks the arrangement of the leaves and the shapes that they form are identical ...

It is not clear if the leaf shape is intended to represent leaves from any particular plant but I do not consider that there is any relevance in such distinction. Members of the public, on encountering these signs, would simply see tea leaves. On closer inspection they may notice that the individual leaves have been arranged in a shape that is reminiscent of a leaf. In my view they will not attempt to identify the leaf with the intention of identifying the species of plant that it would come from. I believe that members of the public, when encountering these signs in relation to tea or tea related products or services i.e. tea rooms, would simply see them as indications that the aforesaid goods and services are provided at a particular type of establishment.

9. Citing now familiar passages on the tests for distinctive character from the judgments of Jacob J. in *British Sugar PLC v. James Robertson & Sons Ltd* [1996] RPC 281 at 306 and Walker L.J. in *Procter & Gamble Ltd's Trade Mark Applications* [1999] RPC 673 at 680, Mr. Pike concluded:

In my view, anyone encountering these marks for the first time, will see them as non-distinctive devices and they will not be taken as trade marks without first educating the public that they are trade marks. It follows that the application is debarred from prima facie acceptance by section 3(1)(b) of the Act.

### The Appeal

10. On 17 October 2001, the applicant gave notice of appeal to an Appointed Person under section 76 of the TMA. At the hearing of the appeal, the applicant was represented by Mr. Mark Hickey of Castles, its trade mark attorneys and Mr. Allan James, Principal Hearing Officer appeared on behalf of the registrar.
11. Mr. Hickey took me to recent judgments of the Court of Justice and the Court of First Instance of the European Communities on distinctive character including *Procter & Gamble Company v. OHIM (BABY-DRY)*, Case C-383/99 P [2002] All ER (EC) 29, *Henkel KGaA v. OHIM (WASHING TABS)*, Cases T-30/00 and T-335/99 – T-337/99, 19 September 2001 and *Bank für Arbeit und Wirtschaft AG v. OHIM (EASYBANK)*, Case T-87/00 [2001] ETMR 761.
12. He summarises the effect of these judgments for present purposes at paragraph 8 of his skeleton argument as follows:

In summary, therefore, with respect to the application of Section 3(1)(b) of the Trade Marks Act 1994, decisions handed down from the courts tell us that the test for registration requires the Tribunal to consider whether or not a mark will act as an indication of origin; that the test in question does not differ just because the mark in question is a device mark as against an invented word, and that in the context of the specific consideration of Article 7(1)(b) [Community Trade Mark Regulation 40/94, the equivalent of section 3(1)(b) TMA] a mark should not be refused simply because it lacks an additional element of imagination or does not look unusual or striking.

13. Mr. James agreed that paragraph 8 of Mr. Hickey's skeleton argument provided a helpful summary of the applicable law in this case with the exception of the final phrase "does not look unusual or striking". He pointed out that the Court of First Instance uttered those words in *EASYBANK*, supra., in the context of word marks. Where, as here, the tribunal was considering the registrability of figurative marks it was important to bear in mind that the perceptions of the relevant public might differ according to the subject matter of the figurative mark. Mr. James referred me to the following statements by the Court of First Instance in *Henkel KGaA v. OHIM*, Case T-30/00 [2002] ETMR 25 at paras. 48 – 49:

Article 7(1)(b) of Regulation No. 40/94 does not distinguish between different categories of trade marks. The criteria for assessing the distinctive character of figurative marks consisting of the

representation of the product itself are therefore no different from those applicable to other categories of trade marks.

Nevertheless, when those criteria are applied, account must be taken of the fact that the perception of the relevant section of the public is not necessarily the same in relation to a figurative mark consisting of a faithful representation of the product itself as it is in relation to a word mark or a figurative or three-dimensional mark not faithfully representing the product. Whilst the public is used to recognising the latter marks instantly as signs identifying the product, this is not necessarily so where the sign is indistinguishable from the appearance of the product itself. It follows that an assessment of distinctive character cannot result in different outcomes for a three-dimensional mark consisting of the design of the product itself and for a figurative mark consisting of a faithful representation of the same product.

14. In the end, the differences between the parties to this appeal lay not in the applicable legal principles but in the likely perceptions of the trade marks in the minds of the relevant public. Mr. Hickey acknowledged that the trade marks were composed of collections of individual tea leaves but claimed that distinctive character resided first, in the arbitrary shapes of the trade marks and second, in the intricate arrangements of individual tea leaves within those shapes. Mr. James, on the other hand, thought that when viewed in relation to tea or tea related products or services the trade marks would be regarded as nothing more than small piles of loose tea.
15. In assessing how the public concerned may react to the trade marks applied for, I bear in mind that the average consumer is reasonably well-informed and reasonably observant and circumspect and that their level of attention may vary according to the category of goods or services in question (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, Case 342/97 [1999] ECR I-3819, para. 26).
16. Tea and tea related products and services are everyday items. I accept Mr. James' contentions that the public concerned is all consumers and that the level of attention paid by the average consumer to the appearance of such everyday items is not high (see by analogy, *Henkel*, supra. at para. 50 – 51).
17. Both Mr. Hickey and Mr. James advised that in the absence of evidence of use I should approach the matter as one of first impression. My first impression when I read these papers was the same as that of the hearing officer.
18. Despite Mr. Hickey's persuasive arguments, I believe that the purchasing public when encountering the trade marks in relation to tea or tea related products or services would simply see tea leaves and would not take those representations as indications of the origin the goods or services in question.

19. In my judgment, Mr. Pike was right to conclude that the series of trade marks failed to qualify under section 3(1)(b) of the TMA to the extent that the specifications included tea or tea related products or services. The appeal is accordingly dismissed and, as agreed, there will be no order as to costs.

Professor Ruth Annand, 15 April 2002

Mr. Mark Hickey, Castles, appeared on behalf of the applicant

Mr. Allan James, Principal Hearing Officer, appeared as the registrar's representative