

O-259-05

TRADE MARKS ACT 1994

AND

THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

**IN THE MATTER OF INTERNATIONAL REGISTRATION No 809523
AND THE REQUEST BY AUGUST STORCK KG
TO PROTECT A TRADE MARK IN CLASS 30**

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MARK IN CLASS 30**

Background

1. On 11 August 2003 August Storck KG of Waldstrasse 27, D-13403 Berlin, Germany, on the basis of International Registration 809523, requested protection in the United Kingdom under the provisions of the Madrid Protocol of the mark:



The following words appear beneath the mark on the form of notification:

Indication relating to the nature or kind of mark: Mark in colour. Three-dimensional mark.

Colours claimed: Caramel, brown, beige.

2. Protection is sought in Class 30 in respect of :

Confectionary, chocolate and chocolate products, pastries.

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 representations of devices of confectionery being devoid of distinctive character for the goods claimed and not being recognisable as a badge of origin.

4. At a hearing, at which the applicants were represented by Mr Peters of DR Walther Wolff & Co, their trade mark attorneys, the objection under Sections 3(1)(b) of the Act was maintained.

5. Notice of refusal was issued under Article 9(3) and I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

The Law

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,”

The case for registration

7. In correspondence prior to the hearing the following submissions were made in support of the application:

“We feel that the mark as a whole has very distinct characteristics, i.e. its shape with a specific form of radial pattern at one end and adjoining circumferential ribbing in conjunction with three claimed colours, and we believe that the combination of these characteristics supports our view that that the mark has sufficient distinctive character to enable it to be protected in the United Kingdom.....

If the mark were a pictorial device of either a specific radial pattern (for example, Nos M756941, M756942 and M756943, copies of which are enclosed) and ribbing, with or without additional colours, or just colours applied to a device (for example, No M729778), in our opinion, the Registry would have no hesitation in accepting it. The shape of the remainder of the product combined with the colour combination, which is clearly visible, should, we feel, afford the mark a greater degree of distinctive character and in our opinion, is quite capable as performing as a trade mark, i.e. indicating the origin of the goods.

In this respect we also attach copies of other three-dimensional shape marks, for example Nos M692501, M666764, M666313 and M666295, all of which have been permitted registration by the Registry and feel that the mark of No 809523 is, at least, on all fours with these registered marks.”

Copies of the accepted marks referred to are attached at Annex A.

“The mark of M809523 has been permitted registration in Germany (No 30320655.1) - which is the parent registration upon which the International registration was based – and a copy of the data sheet from the German Patents and Marks Office is enclosed for you information. In this respect we refer to Chapter 6 of the Trade Marks Registry Work Manual (page 26) which we understand to indicate that although, in general, findings of foreign courts or examination offices are not binding upon the Trade Mark Registry, the decision in a member state of the EU relating to the interpretation of Article 3(1)(b) of the EU Directive (Section 3(1)(b) of the Trade Marks Act 1994) may be of persuasive value in interpreting the term “trade marks which are devoid of distinctive character”.”

A copy of this document is attached at Annex B.

8. At the hearing Mr Peters advised me that the mark is a representation of a single poppy seed. Mr Peters also referred me to six previously accepted shape marks which, he claimed, support his view that this application should be accepted. After considering these submissions I advised Mr Peters that the objection was to be maintained. Copies of these marks are attached at Annex C.

Decision

9. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in *Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

“37. It is to be observed at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods or services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking,

and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and *circumspect* (see *Case C-210/96 Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings."

10. The specification of goods for which registration is sought includes the term "confectionery". The word "confectionery" is defined in Collins English Dictionary Millennium Edition as:

1 sweets and other confections collectively.

11. Although the specification of goods contains goods other than sweets I consider the trade mark applied for to be a shape which is not dissimilar to many other shapes used for confectionery. Although sweets may be available in a variety of shapes, some of the shapes in which sweets are available have been in existence for many years. One of these shapes is that of a nut or small sweets of a similar shape. Mr Peters advised me at the hearing that the mark is intended to be a representation of a single poppy seed but, by itself, I consider it doubtful that this mark will be perceived as such. The goods in question are everyday product which are often purchased on impulse. They are relatively low cost items and purchasers do not usually take a great deal of care and consideration in their purchase. They are purchased by the general public and by all ages, by children and adults alike. In my view purchasers of these goods are likely to perceive it as being a small sweet consisting of or incorporating chocolate. I find nothing unusual or striking about this shape and consider it to be similar to many other shapes used for such goods.

12. In relation to this I refer to a decision by the European Court of Justice in case C-218/01 *Henkel KGaA v. Deutsches Patent-und Markenamt* at paragraph 49 where the court said:

"49. It follows that a simple departure from the norm or customs of the sector is not sufficient to render inapplicable the ground for refusal given in Article 3(1)(b) of the Directive."

13. The trade mark applied for is not simply the three-dimensional shape. There are the colours caramel, brown and beige which serve to identify the components within the mark. However, the overall effect of these colours applied to this particular shaped confection is one which consists of or incorporates chocolate and caramel. The colours will be perceived by the average consumer of such goods as an indication of flavour and they will, in my view, place no trade mark significance upon them.

14. One of the most important considerations when purchasing such goods is their flavour. Sweets and other items of confectionery possess a variety of flavours. What is an attractive flavour to one purchaser may not be attractive to others. Tastes vary from person to person so it is important that the flavour of the product is known to the purchaser at the point of sale. One way to do this is with words, but colour may also be used as a means of providing such information. Whereas the colour yellow may indicate a lemon flavour the colour brown is invariably used to indicate the flavour of chocolate and the colour caramel indicates caramel itself. It is possible, of course, that some consumers will not perceive the combination of the colours caramel, brown and beige as denoting particular flavours. However, this does not automatically result in such consumers placing any trade mark significance upon the mark. Sweets are usually, if not always, produced in one or more colours. A combination of three colours is not particularly memorable or striking. In this particular mark the colours may be visible within the mark but whether the colours are perceived as an indication of a combination of flavours or simply as an attractive feature of the goods, I am of the view that this combination will not be perceived as a sign guaranteeing goods from a single undertaking.

15. Attached to this decision at Annexes A, B and C are the various documents to which reference was made during written submissions in support of this application. Essentially these are details regarding the acceptance of similar marks by both the United Kingdom and by other European trade mark registries. However, I am not aware of any of the circumstances surrounding any of these acceptances and I do not accept that they are influential in deciding the issues of this application. Furthermore, I have taken due account of my personal knowledge of the general nature of sweets and other items of confectionery within the United Kingdom but I have no information as to the nature of such products in other European countries.

16. I find support for this in a decision by the European Court of Justice in Case C-218/01 *Henkel KGaA v. Deutsches Patent-und Markenamt* at paragraphs 61 to 65:

“61 The competent authority of a Member State may take account of the registration in another Member State of an identical trade mark for products or services identical to those for which registration is sought.

62 However, it does not thereby follow that the competent authority of a Member State is bound by the decisions of the competent authorities of the other Member States, since the registration of a trade mark depends, in each specific case, on specific criteria, applicable in precise circumstances, the purpose of which is to demonstrate that the trade mark is not caught by any of the grounds for refusal of registration set out in Article 3(1) of the Directive.

63 In that connection, whilst registration of an identical trade mark for identical goods or services effected in one Member State constitutes a circumstance which may be taken into consideration by the competent authority of another Member State among all the facts and circumstances which it is appropriate to take into account, it cannot, however, be decisive as regards the latter authority's decision to grant or refuse registration of a given trade mark.

64 As to whether it is necessary, when distinctive character is assessed under Article 3(1)(b) of the Directive, to undertake administrative investigations to determine whether and to what extent similar trade marks have been registered in other Member States, it need merely be borne in mind that 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 mark for goods or services similar to those in respect of which the first trade mark was registered (judgment delivered today in Case C-363/99 *KPN* [2004] ECR I-0000, paragraph 44).

65 The answer to the third question must therefore be that the distinctive character of a trade mark within the meaning of Article 3(1)(b) of the Directive may be assessed solely on the basis of national trade usage, without any need for other administrative investigations to be undertaken in order to determine whether and to what extent identical trade marks have been registered or have been refused registration in other Member States of the European Union.

The fact that an identical trade mark has been registered in one Member State as a mark for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

On the other hand, 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.”

17. I am not persuaded that the trade mark applied for is distinctive in that it would serve in trade to distinguish the goods of the applicant from those of other traders. In reaching this conclusion I have considered the mark in its totality placing due weight on the shape of the mark in conjunction with the colours caramel, brown and beige. In my view the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark. I therefore conclude that

the mark applied for is devoid of any distinctive character and is thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

Conclusion

20. In this decision I have considered all the documents filed by the applicants and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) and (c) of the Act.

Dated this 16th day of September 2005

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

The Annexes are not attached