

O-260-05

**TRADE MARKS ACT 1994**

**AND**

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF INTERNATIONAL REGISTRATION No 796738  
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 16 January 2003 August Storck KG of Waldstrasse 27, D-13403 Berlin, Germany, on the basis of International Registration 796738, 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:* three-dimensional mark.

*Colours claimed:* White, red.

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 Sections 3(1)(b) and (c) of the Trade Marks Act 1994. This is because the mark consists of the three dimensional shape of a confectionary being a sign which is devoid of distinctive character and which may be used in trade to designate a quality of the goods e.g. sweets with two flavours.

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

5. Following the hearing, survey evidence was filed with the purpose of demonstrating that the mark is capable of indicating a badge of origin. However, this evidence was not considered sufficient to overcome the objection which was maintained.

6. 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**

7. Section 3(1)(b) and (c) of the Act reads as follows:

“3.-(1) 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 characteristics of goods or services,”

### **The case for registration**

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

“We feel that the mark as a whole consists of several distinct characteristics, i.e. a three-dimensional shape, a swirl pattern and the colours white and red, and we believe that the combination of these characteristics supports our view that that the mark does have sufficient distinctive character to enable it to be protected in the United Kingdom. We note that there are other marks which consist of a three-dimensional shape with the addition of coloured features

appearing on the Register, for example No 2254885, and a copy of the Trade Marks Journal advertisement for this registration is attached for your information.”

A copy of this advertisement is attached at Annex A.

“Furthermore, the fact that the trade mark claims the colours white and red does not, in our opinion, designate a certain quality of the goods; colour does not automatically equate with flavour. Although the existence of certain colours on a product, or on its packaging, may allude to the fact that the product may contain specific flavours, it is not necessarily so and should not be regarded as so.”

“We believe that if the mark were a simple device containing a swirl pattern, either with or without additional colours, the Registry would have no hesitation in accepting it and to confirm this opinion, we attach Trade Marks Journal advertisements for various marks of this nature which have been registered, for example Nos 2282092, 2270662, 2277741, 2280982, 2288181B, M763593, M763631 and M763596. The marks of these registrations/designations all contain a similar “swirl” pattern, registered for various goods and services, some having colour claims and others not. The addition of the three-dimensional shape in the mark of the present designation should, we feel, serve to afford the mark greater, rather than lesser, distinctive character.”

Copies of these advertisements are attached at Annex B.

“The mark of M796738 has been protected in Ireland and is also registered in Germany under No 30206982.8 – which is the parent registration upon which the International registration was based – and copies of the data sheet from the Irish Patent Office and the German Patents and Marks Office are enclosed for your 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”.”

Copies of these documents are attached at Annex C.

9. Subsequent to the hearing the applicants provided details of a market study in the United Kingdom. This was conducted by GfK Marktforschung who are described as a professional survey and marketing company. This was conducted during the period 21 March to 27 March 2002 and targeted 2,000 consumers aged over 15 years. At the end of the study a total of 1,993 results were processed.

10. At the hearing Mr Peters suggested that the trade mark applied for satisfies the requirements of the Act but the objection was maintained.

## Decision

11. Following a review of this application I have concluded that the objection under Section 3(1)(c) of the Act is unsustainable and I therefore waive this objection and will make no further reference to it in this decision.

12. 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* (8<sup>th</sup> April 2003) in the following terms:

“37. It is to be noted 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.”

13. 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.

14. Although the specification of goods contains goods other than sweets I consider that the trade mark applied is a shape which is not dissimilar to many other shapes used for confectionery. Sweets are available in a variety of shapes and some of these shapes have been in existence for many years. One of these shapes is the ellipsoid which is the name given to three-dimensional ellipses. I find nothing unusual or striking about this shape and from my personal knowledge of the goods in question consider it to be similar to many other shapes used for such goods.

15. 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.”

16. The trade mark applied for is not simply the three-dimensional shape. The surface of the shape contains a swirl pattern in contrasting colours of white and red. I must consider the combination of the shape together with the white and red swirl pattern. At the hearing I reached the conclusion that the colours themselves, within the confines of the swirl pattern, will either be viewed as an attractive feature or as an indication of a particular combination of flavours. I remain of that view.

17. 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. One of the most important considerations when purchasing such goods is their flavour. Sweets and other items of confectionery often contain fruit flavourings or are flavoured by mint. 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 is also used as a means of providing such information. Whereas the colour yellow may indicate a lemon flavour different shades of the colour red may be used to indicate the flavour of strawberries or raspberries. The colour white is often used to indicate the flavour of vanilla or, when in combination with a shade of red which is indicative of the flavour of strawberries, perhaps it will indicate cream or ice cream. It is possible, of course, that some consumers will not perceive the combination of the colours white and red 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 two colours

is not particularly memorable or striking. In this particular mark the colours are visible within the confines of a swirling pattern and I am of the view that this combination within the overall shape will be perceived as a sweet with a particular combination of flavours or simply as a sweet with an attractive appearance.

18. 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.

19. 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.”

20. I must also take due account of the results of the market study conducted on behalf of the applicants by GfK Marktforschung. I note that the first question was preceded by the interviewer handing 3 items of candy to the respondent. The respondent is then asked the following question:

“Here you see specific design. Do you know this design in regard to candies?”

21. In my view this completely undermines the results of the survey. Not only is this question leading the respondent there is no indication whatsoever that any of the three candies handed to the respondent consisted of one in the same format as the trade mark applied for. There is nothing to confirm that this survey relates to the trade mark applied for and as such I conclude that it cannot be influential on the outcome of this decision.

22. 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 swirl pattern and the colours white and red. 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**

22. 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 Section 3(1)(b) of the Act.

**Dated this 16<sup>th</sup> day of September 2005**

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

**The Annexes are not attached**