

O-291-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS 2531254 AND 2531068
IN THE NAME OF MONTE CRISTO LEISURE LTD
OF THE TRADE MARKS



(A SERIES OF TWO MARKS)

AND

STEIN BIER KELLER

IN CLASSES 25, 29, 30 AND 43

AND

THE CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS 100316 AND 100317
BY
RENE VON RETH BAVARIAN

**In the matter of application nos 2531254 and 2531068
in the name of Monte Cristo Leisure Ltd
of the trade marks**



(a series of two marks)

and

STEIN BIER KELLER

in classes 25, 29, 30 and 43

and

**the consolidated oppositions thereto
under nos 100316 and 100317
by Rene von Reth Bavarian**

Background

1. Trade mark applications 2531254 and 2531068 were made on 9 November 2009 by Monte Cristo Leisure Ltd ("the applicant"). Both applications were made for the following goods and services:

Clothing, footwear, headgear.

Meat; sausages, sausage products, foodstuffs consisting of sausages.

Pies; meat pies.

Services for the provision of food and drink; bar, restaurant and pub services.

The above goods and services fall in classes 25, 29, 30 and 43 respectively of the Nice Agreement concerning the International Classification of Goods and Services

for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2. The applications were published in the *Trade Marks Journal* on 5 February 2010 and 1 January 2010, respectively, following which partial oppositions to both applications were filed by Rene von Reth Bavarian (“the opponent”). The oppositions were then consolidated.

3. The oppositions are directed only at the class 43 services of the applications (*services for the provision of food and drink; bar, restaurant and pub services*). The opponent claims that the applications offend sections 3(1)(b), (c) and (d) of the Trade Marks Act (“the Act”), which state:

“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,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

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.”

4. The opponent’s claims are as follows:

- Section 3(1)(b): That Bierkeller is the name for part of a building and is well-known as a description for a restaurant/bar selling beer and food. Stein is a German sounding yet original English word for beer mug, which is used in bierkellers to sell beer. Bierkellers in the UK sell beer in steins to differentiate themselves from other restaurants but this is not something that differentiates them from each other. Stein Bier Keller is not distinctive for one individual outlet – it describes a whole category of restaurants. A lot of restaurants in the UK advertise that they sell beer in steins in a cellar. No one should be allowed exclusive use of these frequently used words. The opponent also claims that a simple web search in the UK shows a number of restaurants and bars using the word bierkeller and stein. It claims that the typeface and graphical representation do not detract from the above claims and that the marks are non-distinctive.

- Section 3(1)(c): That Stein is in the Oxford English Dictionary meaning beer mug. Bier Keller is well understood in the UK as a German Beer hall in a cellar. Stein Bier Keller means nothing but a beer hall selling beers in large mugs in a cellar. The opponent received examination advice from the Intellectual Property to abandon an application to register Bierkeller because Bierkeller is just a name for part of a building in which beer is sold. Even though it is the German spelling it is well understood in the UK because the pronunciation is similar. It is not enough to add a descriptive word which says the beer is sold in mugs. The German spelling of all the words also indicated that the restaurant has a German origin.
- Section 3(1)(d): That Stein is customary in English for a beer mug. It is not a German word, but is an English word which sounds German. In conjunction with a restaurant it indicates beer sold in big mugs of German origin. Bier Keller in its German spelling is customary in the UK for a restaurant or bar in a cellar selling beer and food with German origin.

5. The applicant filed counterstatements, denying the grounds and seeking an award of costs in its favour. Essentially, its case is that the combination of words, when viewed as a whole, are grammatically unusual/ambiguous and the marks are therefore distinctive. It is suggestive in meaning rather than a description of the services provided.

6. Neither side filed evidence of fact and only the opponent filed written submissions (I say more about this below). Both parties were given the opportunity to be heard, but neither requested a hearing. The opponent brought it to the attention of the Registrar that the applicant had been dissolved as a company on 18 January 2011, a fact confirmed by the applicant's trade mark attorney. No liquidator was appointed and there is no suggestion that the trade mark applications were assigned to a third party. The Registrar accordingly wrote to the Treasury Solicitor since the trade marks, as property, may be vested with the Crown by way of *bona vacantia*. The Treasury Solicitor confirmed that it would take no action to assert or defend the actions; it simply took any beneficial property and rights owned by the applicant at the date of its dissolution. The Treasury Solicitor does not wish to become involved in the proceedings, but has not disclaimed its rights in the mark. The proceedings themselves, therefore, still need to be determined. In doing so, I have taken into account the contents of the opponent's statements of case, the submissions within the counterstatements, and the opponent's written submissions.

DECISION

The grounds and the average consumer

7. It is well established in law that the absolute grounds for refusing registration must be examined separately, although there is a degree of overlap between sections 3(1)(b), (c) and (d) of the Act. In *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] E.T.M.R. 57, the Court of Justice of the European Union ("CJEU") stated:

“67. As regards the first part of the question, it is clear from Article 3(1) of the Directive that each of the grounds for refusal listed in that provision is independent of the others and calls for a separate examination (see, *inter alia*, *Linde*, paragraph 67). That is true in particular of the grounds for refusal listed in paragraphs (b), (c) and (d) of Article 3(1), although there is a clear overlap between the scope of the respective provisions (see to that effect Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraphs 35 and 36).

68. Furthermore, according to the Court's case-law, the various grounds for refusing registration set out in Article 3 of the Directive must be interpreted in the light of the public interest underlying each of them (see in particular Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 77, *Linde*, paragraph 71, and *Libertel*, paragraph 51).

69. It follows that the fact that a mark does not fall within one of those grounds does not mean that it cannot fall within another (see to that effect *Linde*, paragraph 68).

70. In particular, it is thus not open to the competent authority to conclude that a mark is not devoid of any distinctive character in relation to certain goods or services purely on the ground that it is not descriptive of them.

71. Second, as has been observed in paragraph 34 of this judgment, whether a mark has distinctive character for the purposes of Article 3(1)(b) of the Directive must be assessed by reference to the goods or services described in the application for registration.

.....

75. As regards the second part of the question, whether a mark has distinctive character must be assessed, as has been observed in paragraph 34 of this judgment, first, by reference to the goods or services in respect of which registration of the mark has been sought, and, second, by reference to the way in which it is perceived by the relevant public, which consists of average consumers of those goods or services, reasonably well informed and reasonably observant and circumspect.”

8. I will therefore treat the assessment of the grounds separately, even though there will be overlapping aspects. I will make my assessment from the viewpoint of the average consumer who is reasonably well informed and reasonably observant and circumspect. The applicant's services which have been opposed are *services for the provision of food and drink; bar, restaurant and pub services*. The relevant public for these services is the general public in the UK. The general public comprises the average consumers for the services: this is the English-speaking public, as per the comments of Ms Amanda Michaels, sitting as the Appointed Person, in *Toppo Trademarks Limited v Cofra Holding AG*, BL O/092/11:

“25. What the Hearing Officer had to consider was how the mark would be perceived by the average UK consumer. Whilst of course there are many

persons whose mother tongue is not English who live and work in the UK, such persons are not the average UK consumer for the purposes of considering the pronunciation or meaning of a word.”

9. I will consider the position firstly in relation to the word-only application (2531068). If the opponent cannot succeed here, it will be in no better a position in relation to application 2531254 where the stylisation of the series of marks will come into play in the assessment.

10. Section 3(1)(d): trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

In *Telefon & Buch Verlagsgesellschaft mbH v OHIM*, Case T-322/03, the GC stated:

“49 Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50 With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51 Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52 Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).”

11. The enquiry is not whether the mark is descriptive of a characteristic of the services, although that could also apply to a mark which falls foul of section 3(1)(d). It is whether the mark (as opposed to the individual words) was customary in the current language (of the UK territory) or was customary in the bona fide and established practice of the trade (i.e. in the trade the subject of the opposed services) at the date of application. Proving this requires the filing of evidence of fact supporting the claim. It cannot be proved by supposition. The opponent has not provided any evidence of fact. It refers, in its statement of case, to conducting simple web searches. In its written submissions, it gives a list of what appear to be the URLs of search results which purport to show that German-themed restaurants sell beer in steins in bierkellers. However, the opponent has not adduced the results of its searches as evidence in these proceedings. The URLs may no longer be current or may not now produce the same results that the opponent found. These being *inter partes* proceedings, it is not for the adjudicating Tribunal (the Registrar) to look these up and fill in the gaps for the opponent. If a party wishes to rely on evidence of fact, those facts should be adduced (i.e. the pages from the searches should have been filed) in the proper evidential format (i.e. by way of a witness statement). Lists of URLs contained within written submissions carry no weight. The opponent has also referred in its submissions to “a popular dictionary in the internet”: examples.yourdictionary/stein, but does not show the entry, and to the Oxford dictionary (again, no references are shown), submitting that the word stein is sufficiently common in the English language to be in the dictionary. None of this comes close to establishing that the mark was, at the date of application, customary in the current language or in the bona fide and established practices of the trade. As there is no evidence against which the ground can be assessed, **the section 3(1)(d) ground of opposition fails.**

12. Section 3(1)(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.

In *Linde* [2003] RPC 45, the CJEU stated:

74 The public interest underlying Article 3(1)(c) of the Directive implies that, subject to Article 3(3), any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all and not be registrable.

75 The competent authority called upon to apply Article 3(1)(c) of the Directive to such trade marks must determine, by reference to the goods or services for which registration is sought, in the light of a concrete consideration of all the relevant aspects of the application, and in particular the public interest referred to above, whether the ground for refusing registration in that provision applies to the case at hand.”

I also note *Ford Motor Co v OHIM*, case T-67/07, in which the General Court (GC) stated:

“22 Article 7(1)(c) of Regulation No 40/94 refers to signs that are incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquires the goods or service covered by the mark to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (Case T-219/00 *Ellos v OHIM (ELLOS)* [2002] ECR II-753, paragraph 28, and judgment of 22 May 2008 in Case T-254/06 *Radio Regenbogen Hörfunk in Baden v OHIM (RadioCom)*, paragraph 27).

23 The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are those which may serve in normal usage from the point of view of the target public to designate, either directly or by reference to one of their essential characteristics, goods or services in respect of which registration is sought (Case C-383/99 P *Procter & Gamble v OHIM* [2001] ECR I-6251, paragraph 39, and *RadioCom*, paragraph 22 above, paragraph 28).

24 It follows that, for a sign to be caught by the prohibition set out in that provision, 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 (Case T-19/04 *Metso Paper Automation v OHIM(PAPERLAB)* [2005] ECR II-2383, paragraph 25, and *RadioCom*, paragraph 22 above, paragraph 29).

25 A sign’s descriptiveness may only be assessed, first, in relation to the goods or services concerned and, secondly, in relation to the perception of the target public, which is composed of the consumers of those goods or services (Case T-34/00 *Eurocool Logistik v OHIM (EUROCOOL)* [2002] ECR II-683, paragraph 38, and *RadioCom*, paragraph 22 above, paragraph 33).

.....

32 However, according to the case-law, to come within the scope of Article 7(1)(c) of Regulation No 40/94, a word mark must serve to designate in a specific, precise and objective manner the essential characteristics of the goods and services at issue (see, to that effect, Case T-334/03 *Deutsche Post EURO EXPRESS v OHIM(EUROPREMIUM)* [2005] ECR II-65, paragraph 41 and the case-law cited).

.....

35 Accordingly, it must be held that the link between the word ‘fun’, on the one hand, and land motor vehicles, on the other hand, is too vague, uncertain and subjective to confer descriptive character on that word in relation to those goods.”

13. The public interest underlying section 3(1)(c) of the Act is that marks which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all (i.e. the trade). I have to assess whether the mark identifies the commercial origin of the services or whether there is instead a

direct and specific relationship between the words and the services so that the relevant public will only see, without further thought, a description of the category of services in question or one of their characteristics.

14. The applicant, in its counterstatement, submits that the mark alludes to characteristics of the applicant's services but does not describe them, the conjunction of the three words being unusual and striking in the English language. The applicant submits that, in order to reach a descriptive meaning, the opponent has had to add explanation, claiming "*Stein Bier Keller in other words mean nothing but a beer hall selling beers in large mugs in a cellar.*" The applicant contends that this shows the lengths to which a consumer would have to go to reach a descriptive meaning. The applicant also points out that, in the UK, the average consumer might also see STEIN as a surname; however, I mention here that if I were to find the mark to be a descriptive term, the surnominal meaning of STEIN would not, of itself, save the mark¹.

15. I note that in *Koninklijke KPN Nederland NV*, the CJEU stated,

"98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark."

100. Thus, a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods and services in respect of which registration is sought, is itself descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that, because of the unusual nature of the combination in relation to the goods and services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components."

¹ As per *Wm. Wrigley Jr. Company v. OHIM*, Case C-191/01 P ("Doublemint") [2004] E.T.M.R. 9.

The above judgment is relevant here because the applicant claims that the combination of elements creates a distinctive whole, whilst the opponent claims the opposite i.e. that putting the descriptive words STEIN and BIER KELLER together still creates a description which should be left free for others in the trade. In assessing the impact of the combination of STEIN, BIER and KELLER in the UK, I must also factor in a further aspect which is relevant; namely, the foreign nature of the words in the UK and the influence of this on the perception of the relevant public.

16. In this respect, I turn to the decision of Ms Amanda Michaels, referred to above, in *Topy Trademarks Limited v Cofra Holding AG*, BL O/092/11:

“25. Secondly, the evidence goes to the question of how Topy’s sign might be pronounced by Germans, Poles, etc resident in the UK and whether Yessica would be recognised as a name. However, again, it does not seem to me that this would have been a relevant point for the Hearing Officer to consider. What the Hearing Officer had to consider was how the mark would be perceived by the average UK consumer. Whilst of course there are many persons whose mother tongue is not English who live and work in the UK, such persons are not the average UK consumer for the purposes of considering the pronunciation or meaning of a word.

26. The position seems to me to be analogous to that considered by the European Court of Justice in Case C-421/04, *Matratzen Concord AG v Hukla Germany SA*, Case, [2006] E.C.R. 10 I-2303; [2006] E.T.M.R. 48 in relation to marks consisting of descriptive terms in a foreign language. In that case, the question was whether a mark registered in Spain for a variety of bedding goods including mattresses was invalid because it consisted of the German word “Matratzen,” which means mattress. The position under Spanish law is (or was) that names borrowed from foreign languages are seen as fanciful, unless they resemble a Spanish word, so that the average consumer would understand their meaning, or the mark had acquired a genuine meaning on the national market. The ECJ essentially approved that position. The UKIPO’s position, as set out in Practice Amendment Notice 12/06 after *Matratzen*, is that marks consisting of a descriptive word in another European language will be refused registration only if the average UK consumer is likely to recognise them as such:

“In general, the most widely understood European languages in the UK are French, Spanish, Italian and German. The majority of UK consumers cannot be assumed to be fluent in any of these languages, but most of them will have an appreciation of some of the more common words from these languages, particularly common French words. So it may be assumed that the meaning of ‘Biscuit pour Chien’ (dog biscuits) will be known to the average UK customer for dog biscuits. Similarly, it may be assumed that traders in and/or average UK consumers of cosmetics (who will be accustomed to seeing French descriptions on the packaging of cosmetics) will know the meaning of ‘lait’ (milk) and will be able to decipher the meaning of ‘Lait hydratant’ as being moisturising milk (or similar).”

27. Hence, following *Matratzen*, marks consisting of foreign words may be registered if they are not likely to be recognised as descriptive. In BL O/25/05, *Acqua di Gio*, Mr Geoffrey Hobbs QC sitting as the Appointed Person said at paragraph 29 “the impact of a word mark on speakers of English should be used to determine whether it is acceptable for registration in the United Kingdom on absolute and relative grounds” and at paragraph 41 he said “it is impermissible for the English equivalents of foreign words to be used for the purpose of testing issues relating to the distinctiveness, descriptiveness or deceptiveness of such words in the United Kingdom in the absence of good reason for thinking that a significant proportion of the predominantly anglophone public in the United Kingdom would understand the meaning of the word(s) in question.” In my judgment, the position is that even though many people live in the UK whose native tongue is not English, that does not mean that such individuals are to be treated as the relevant “average” consumers for the purpose of deciding what a word means, or how a word would be pronounced, in the United Kingdom. In the absence of special circumstances, the average public is the “predominantly anglophone public.”

The opponent has not provided any evidence as to the position of the words in the mark in relation to the perception of the average, predominantly anglophone public. The opponent submits that the word STEIN is sufficiently common in the English language to be included in the dictionary (this submission comes after the URL for the “oxford dictionaries”). I note that Collins English Dictionary (2000 edition) gives a definition for STEIN as “an earthenware beer mug, especially of a German design” and “the quantity contained in such a mug”. In the UK, beer is traditionally sold in pint measures. Many words are included in dictionaries, but this does not mean that the average UK consumer is aware of them or of their meanings². I should be wary of assuming too much knowledge on the part of the average consumer³. I should not use the English equivalents (beer mug) to test whether the anglophone public would understand the meaning of STEIN (adopting the *Acqua di Gio* principle above). This is also relevant in relation to BIER KELLER. For the average consumer to import the meaning of a bar/restaurant in the style of a ‘bier keller’, he or she would first need to know that the words BIER and KELLER form a single phrase, with the meaning of a bar/restaurant. I am unconvinced that this will be the immediate impression upon the mind of the average UK consumer. The opponent claims that the words sound very similar to ‘beer cellar’. In the UK ‘cellar’

² Although I have commented above that it is not for the Tribunal to delve into the Internet, the Tribunal may consult a standard English dictionary for the meaning and use of words, as per *FOREX* BL O/100/09, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person. Whether there is a meaning which has a bearing on section 3(1)(c) must still be analysed in relation to the average consumer.

³ As per the comments of Ms Anna Carboni, sitting as the Appointed Person, in *CHORKEE Trade Mark*, O-048-08: “Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute...37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a native American tribe. This is a matter that can easily be established from an encyclopaedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this.” Although a relative grounds case, the logic would seem applicable to judicial notice in absolute grounds.

commences with a sibilant sound, not a hard ‘K’, but even if the opponent is right and bier keller will be approximated to beer cellar, a beer cellar in the UK is somewhere where beer is stored, not a bar/restaurant.

17. I am unconvinced that, for the average consumer of bars and restaurants in the UK, the words will convey the meaning of a Germanic style of bar/restaurant where beer is sold and/or served in steins. Even if the meaning of stein is understood, I do not think that the meaning of bier keller will be understood and so the mark will not send a descriptive message. However, even if I am wrong in drawing this conclusion and that the opponent is right that the average UK consumer will understand the mark to be a reference to beer in steins in a particular type (Germanic) of bar/restaurant, I also consider that the mark as a whole will not fall foul of section 3(1)(c). This is because I also have to consider the effect of the combination of words; i.e. whether the mark as a whole is more than the ‘sum of its parts’.

18. In *Celltech R&D Ltd v OHIM*, Case C273-/05 P, the CJEU stated:

“77 As OHIM pointed out, it follows from the Court’s case-law that, as a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 7(1)(c) of Regulation 40/94 (*Koninklijke KPN Nederland*, paragraph 98, and *Campina Melkunie*, paragraph 39).

78 However, the Court added that such a combination may not be descriptive, within the meaning of that provision, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements (*Koninklijke KPN Nederland*, paragraph 99, and *Campina Melkunie*, paragraph 40).

79 Accordingly, whilst, as regards a trade mark comprising words, its distinctive character may be assessed, in part, in relation to each of its elements, taken separately, it must, in any event, depend on an appraisal of the whole which they comprise (see, by analogy, concerning Article 7(1)(b) of Regulation No 40/94, *SAT.1 v OHIM*, paragraph 28, and *BioID v OHIM*, paragraph 29).

80 It follows from the foregoing considerations that, contrary to OHIM’s contention, it does not follow from the Court’s case-law that the prior analysis of each of the elements of which a mark is composed is an essential step. On the contrary, OHIM’s Boards of Appeal and, where an action is brought, the Court of First Instance are required to assess the descriptiveness of the mark, considered as a whole.”

It is clear from this judgment that, whatever the distinctiveness/descriptiveness of the elements taken separately, the bottom line is the appraisal of the whole. I return to the CJEU’s words in *Koninklijke KPN Nederland NV*, and assess whether the combination of STEIN, BIER and KELLER or STEIN and BIER KELLER, creates a whole in which there is a perceptible difference between the words and the mere sum of the mark’s parts. My conclusion is that the combination of words makes little sense without further explanation. The combination in relation to the services is both

unusual and creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements. The UK consumer will not immediately see a description of the services, or of characteristics of the services which make immediate sense when presented as they are in the mark. There is not a “sufficiently direct and specific relationship between the sign and the ... services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of ... services in question or one of their characteristics”. The mark, as a whole, does not represent in a “specific, precise and objective manner the essential characteristics of the ... services at issue” (as above, *Ford Motor Co v OHIM*). Accordingly, there is no reason to keep the precise combination of words free for other traders. **The section 3(1)(c) ground of opposition fails.**

19. Section 3(1)(b): trade marks which are devoid of any distinctive character

The purpose of section 3(1)(b) is to prohibit registration of signs which may not fall foul of the clear parameters set by sections 3(1)(c) and (d), but nevertheless do not fulfil the function of a trade mark in identifying the goods and services of one undertaking from those of other undertakings. The CJEU said in *SAT.1 Satellitenfernsehen GMBH v OHIM*, case C-329/02 P [2005] E.T.M.R. 20:

“23 First, the essential function of a trade mark is to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see, in particular, Case 102/77 *Hoffmann-La Roche* [1978] ECR 1139, paragraph 7, and Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 30). Article 7(1)(b) of the regulation is thus intended to preclude registration of trade marks which are devoid of distinctive character which alone renders them capable of fulfilling that essential function.

24 Secondly, in order to determine whether a sign presents a characteristic such as to render it registrable as a trade mark, it is appropriate to take the viewpoint of the relevant public. Where the goods or services with which the registration application is concerned are intended for all consumers, the relevant public must be deemed to be composed of the average consumer, reasonably well-informed and reasonably observant and circumspect (see Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26, and Case C-104/01 *Libertel* [2003] ECR I-3793, paragraph 46).

.....

27 Furthermore, in view of the extent of the protection afforded to a trade mark by the regulation, the public interest underlying Article 7(1)(b) of the regulation is, manifestly, indissociable from the essential function of a trade mark, as observed in paragraph 23 above.”

20. The public interest role underlying section 3(1)(b) is about what the average consumer thinks, in this case the general public. Does the mark have the capacity to identify the origin of the goods and services thereby enabling the average consumer to repeat the purchasing experience or to avoid repeating it? Whether the trade

mark performs this essential function will be a matter of first impression because the average consumer does not analyse trade marks beyond what is usual for a reasonably well-informed and reasonably observant and circumspect person in the ordinary course of purchasing the relevant goods and services.

21. Although marks which do not fall foul of section 3(1)(c) can nevertheless be refused registration under section 3(1)(b) because they are devoid of any distinctive character and therefore cannot fulfil the essential role referred to above, there is a degree of overlap between these grounds, as set out in *Koninklijke KPN Nederland NV* (paragraph 7 of this decision). The opponent claims that STEIN BIER KELLER describes a category of restaurants and so does not differentiate one undertaking from another. This is tantamount to a claim that the mark is descriptive of a certain type of service-provider. As I have dealt with the claim that the mark is generic (section 3(1)(d)) and descriptive (section 3(1)(c)) and have rejected those claims, there is little to add; however, following the line of reasoning in *SAT.1 Satellitenfernsehen GMBH v OHIM*, it is the overall impression on the average consumer that matters. There is no other reason put forward as to why the mark lacks distinctiveness above and beyond the claim that it is descriptive and therefore fails to perform a trade mark function. For the reasons I have already given, I consider that the mark as a whole is not devoid of any distinctive character for the services which are opposed. **The section 3(1)(b) ground of opposition fails.**

22. As the opponent has been unsuccessful against the word-only mark, it will not be in any better a position against the stylised versions because i) the stylisation may take the marks outside of consideration of section 3(1)(c) and (d) (because the marks do not consist exclusively of the words claimed to be generic/descriptive) and ii) in relation to section 3(1)(b), the stylisation in the marks has a positive effect on, rather than detracting from, their distinctive character.

23. Both of the applications may proceed to registration for all the goods and services.

Costs

24. In the ordinary course of events, the applicant would be entitled to a contribution towards its costs, the oppositions having failed. However, the applicant is dissolved and the trade mark applications are *bona vacantia*. The Treasury Solicitor has played no part in these proceedings and would not have incurred any costs. The net result is that there is no cost award to make.

Dated this 17th day of August 2011

**Judi Pike
For the Registrar,
the Comptroller-General**