

O-304-06

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 2407455
BY HOLMESTERNE FOODS LIMITED
TO REGISTER A TRADE MARK
IN CLASSES 29 & 30

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BACKGROUND

1. On 24 November 2005 Holmesterne Foods Limited applied to register the following trade mark:

NO TIME TO COOK

2. The goods for which registration is sought are:

Class 29:

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats; prepared meals and snacks made of the aforesaid.

Class 30:

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice; prepared meals and snacks whose main ingredients are proper to this class; sandwiches, pizzas, pies and pasta dishes.

3. The application was initially filed as part of a series of trade marks, the above mark being accompanied by the mark TIME TO COOK. However, following an objection under Section 41(2) of the Act on the grounds that the marks did not constitute a series because they differed in their material particulars, the applicant requested that the mark TIME TO COOK be deleted from the application. This request was actioned by the Registry. This decision will, therefore, deal only with the mark NO TIME TO COOK.

4. An objection was raised against the mark NO TIME TO COOK under Section 3(1)(b) of the Trade Marks Act 1994 (“the Act”) on the grounds that it would be seen as a non-distinctive statement that would, for example, indicate to the consumer that the goods are already prepared for you when you have no time to cook. The objection was raised against all the goods in the application.

5. Following a hearing, at which the applicant was represented by Mr Francisco Pazo of Lawdit Solicitors, I maintained the above objection. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it. No evidence of use has been put before me. I have, therefore, only the *prima facie* case to consider.

The Law

6. Sections 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 applicant’s case for registration

7. At the hearing, Mr Pazo put forward a number of submissions to persuade me to waive the objection. He argued that the mark was not really descriptive and that there was an unusual juxtaposition between the words NO TIME TO and COOK. It was also argued that the mark was allusive and was on a par with those that the Registry has indicated as being acceptable in its Practice Amendment Notice 1/06 dealing with slogan marks.

8. It was also submitted that the objection raised went beyond the spirit of Section 3(1)(b) of the Act. Mr Pazo felt that Section 3(1)(b) objections should be reserved for marks that could never distinguish the goods of one trader from those of another – an example of the mark SHOES in respect of a specification reading “shoes” was given.

9. The final arguments centred on what Mr Pazo described as the numerous marks that have been accepted and registered that all contain the words TIME TO. It was argued that this pattern of acceptances meant that the Registry viewed these sorts of marks as acceptable and that it would be wrong for me to maintain the objection in the face of them.

10. I will deal with these submissions in more detail below when giving the reasons for my decision.

DECISION

Section 3(1)(b) objection

11. Mr Pazo has suggested that Section 3(1)(b) is only applicable to signs that could never perform the essential distinguishing function of a trade mark. I disagree. Marks that could never perform the essential distinguishing function (such as Mr Pazo’s shoes for shoes) would, in my opinion, be objected to under Section 3(1)(a) of the Act (although this is likely to be accompanied by objections under Section 3(1)(b), (c) and/or (d)). Section 3(1)(a) disqualifies from registration signs that do not meet the requirements of Section 1(1) which itself defines what a trade mark is. As part of this definition the statute requires that the sign must have the capacity to distinguish the goods or services of one undertaking from those of others; absence of such a capacity would result in an objection under this ground.

12. I have emphasised the word “capacity” as I consider this to be where Mr Pazo and I differ. If a mark is of such a nature that it could never, even through extensive use, perform the essential distinguishing function then a Section 3(1)(a) objection should be expected. The difference between Section 3(1)(a) and Section 3(1)(b) is that the proviso to Section 3 (relating to a mark acquiring distinctiveness) applies to Section 3(1)(b) but not to Section 3(1)(a). This results in a situation that a Section 3(1)(b) objection is valid in relation to a mark if it is of such a nature that it is, on face value, lacking distinctive character, but, that it has the capacity (through use of the mark and education of the consumer) to acquire one.

13. I consider the mark NO TIME TO COOK to be a mark that could, through use, acquire distinctiveness. But, as indicated in paragraph 5 above, no evidence has been put before me. The real question I must therefore answer is whether, on face value, the mark will perform the essential distinguishing function or whether it lacks the distinctiveness to do so? The approach to be adopted when considering this question was summarised by the ECJ in paragraph 37, 39 to 41 and 47 of its Judgment in Joined Cases C-53/01 to C-55/01 *Linde AG, Winward Industries Inc and Rado Uhren AG* (8 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”.

14. From the above, I am therefore aware that the mark’s distinctiveness must be assessed in relation to the goods sought by the applicant and that I must also have regard to the perception of the average consumer who is deemed to be reasonably well informed and reasonably observant and circumspect.

15. The applicant’s mark has been applied for in respect of a range of food products in Classes 29 & 30. This is not a specialist or technical field and the average consumer will therefore be the general public. The question I must therefore answer is whether the mark would serve to indicate, when encountered by a member of the general public, that the goods sold under it originate from a particular trader and, thus, distinguishes their goods from those of other traders. I must, of course, assume notional and fair use of the mark in relation to the goods applied for. This would include use of the mark on the packaging of the goods as well as use in advertising materials.

16. Mr Pazo suggested that the sign NO TIME TO COOK comprised an unusual juxtaposition of words and, furthermore, that it was an allusive concept with little direct meaning. I can see nothing unusual in the composition or construction of this phrase. Indeed, it seems to me to be a quite natural construction of words that is not only grammatically correct but I am sure is also an expression that is used in common parlance by the general public. It follows that I see nothing allusive in the phrase either. The phrase would, in my view, send a quite clear and obvious meaning to anyone seeing it. The meaning that would be taken from the phrase is of a statement relating to the absence of time for conducting culinary activities; the words NO TIME TO COOK appear to me to be the most simple, apt and direct way of saying this.

17. Identifying the meaning behind the mark is not the end of the question. To decide whether a mark lacks the distinctiveness for it to perform the distinguishing function I must assess the impact that the sign will have on the average consumer of the goods at issue. In my view, the average consumer encountering this sign will see the words NO TIME TO COOK as a simple promotional statement informing the consumer that if they have “no time to cook” then the applicant’s goods are the ones for them. The phrase, therefore, sends a promotional message of convenience, speed and ease of use. The promotional message is direct and clear and the sign would not be seen as anything other than a simple promotional statement.

18. The promotional nature of the mark becomes all the more apparent when one considers the type of message being sent. There is a large market in the sale of foodstuffs that are convenient and easy to use and that therefore fit into the modern busy lifestyles that many people adopt. This message of convenience is therefore an attractive selling point to promote such goods and it is this selling point that the sign is promoting to the consumer. In summary, the sign is not unusual in its construction, its meaning is readily apparent and the consumer will see it as purely a promotional statement, a statement that

could equally apply to any other undertaking wishing to send a similar promotional message.

19. Mr Pazo did inform me of a number of “TIME TO” marks that have previously been accepted by the Registrar. Whilst I agreed to have sight of them I am, of course, conscious of the comments of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281:

“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.”

20. I responded to Mr Pazo’s precedents by stating that I did not consider them to be on all fours with the application in suit and that, in any event, they were not binding upon me. I must make a decision on the merits of the case before me and the reasoning and explanations given above stands as such. In the circumstances, I do not intend to say any more about the precedents quoted. Similarly, Mr Pazo’s reference to the Registrar’s Practice Amendment Notice is dealt with in a similar manner. Whilst the notice is intended to represent the Registrar’s general practice on particular types of mark, I am still required to decide the merits of the application in suit on the basis of the Act and the case-law that supplements it. Again, the reasoning above represent this.

21. For all the reasons given above, I am not persuaded that the mark NO TIME TO COOK is distinctive in that it would serve in trade to distinguish the applicant’s goods from those of other traders.

CONCLUSION

22. 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.

23. In this decision I have considered all the documents filed by the applicant 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 the mark fails to qualify under Sections 3(1)(b) of the Act.

Dated this 24th day of October 2006

OLIVER MORRIS
For the Registrar
the Comptroller-General