

**TRADE MARKS ACT 1994 and  
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF  
INTERNATIONAL REGISTRATION NO: 806541  
AND THE REQUEST BY CORDIER MESTREZAT & DOMAINES  
TO PROTECT A TRADE MARK IN CLASS 33**

**Background**

1. On 27 June 2003, Cordier Mestrezat & Domaines of 109, Rue Achard, Bordeaux, France F-33300, on the basis of International Registration number 806541, requested protection in the United Kingdom, under the provisions of the Madrid Protocol, of the following mark:

**SENSUAL FRUIT**

Protection is sought in Class 33 in respect of:

“Wines and other alcoholic beverages (except beer)”.

2. 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) and (c) of the Trade Marks Act 1994. This is because the mark consists exclusively of the words “Sensual Fruit” being devoid of distinctive character and being a sign which may serve in trade to designate the kind of goods e.g. those containing sensual fruit.

3. At a hearing, at which the applicants were represented by Ms Alison Cole of Urquhart-Dykes & Lord, their trade mark attorneys, the objection under Section 3(1)(b) and (c) of the Act was maintained. 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.

4. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

**The Law**

5. Sections 3(1)(b) and (c) of the Act read 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, geographic origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,”

### **The case for registration**

6. In correspondence prior to the hearing Ms Cole submitted that the term SENSUAL FRUIT has no direct meaning in the English language; there is no one set of fruit which is collectively referred to as “sensual fruit”, unlike for example “fruits of the forest” etc; even if this was the case, the term has no meaning in relation to the goods in the specification, particularly wine; and using the criteria set out in the ECJ decision C-191/01 *Doublemint* and adopted by the Trade Mark Registry in PAN 1/04, there is no reasonable likelihood that the sign in question would serve a descriptive purpose in the ordinary course of trade since it does not designate any immediately recognisable characteristic of the goods. At the hearing she reiterated these submissions and argued that the results of an internet search conducted by the examiner did not show that the term had any meaning in relation to wine.

### **Decision**

#### **Section 3(1)(c)**

7. The mark consists of the words SENSUAL FRUIT which is not a phrase that may be found in dictionaries. It is, nonetheless, a combination of two words which may serve in trade to designate characteristics of the goods covered by the application and is therefore debarred from registration under Section 3(1)(c) of the Act. Although the original objection focussed on the kind of goods, and gave as an example “those containing sensual fruit”, I am of the view that the mark is equally open to objection because it may serve in trade to designate other characteristics of the goods, for the reasons which I state below.

8. Collins English Dictionary (5<sup>th</sup> Ed. 2000) provides the following definitions for the word SENSUAL:

- “1. of or relating to any of the senses or sense organs; bodily.
2. strongly or unduly inclined to gratification of the senses.
3. tending to arouse the bodily appetites, especially the sexual appetite.
4. of or relating to sensualism.”

9. In the flowery hyperbole used by wine tasters and reviewers it is common to attribute to wines the flavour and smell of various fruits such as “blackcurrant” or “raspberry”, and also to employ other descriptions such as “deep”, “fluid”, “vivacious”, “glossy”, “elegant”, which can appear far-fetched to the non-aficionado. In this context it appears to me that the word “sensual” is an entirely apt description for wines which appeal to the senses of flavour and smell. Indeed, as shown in the results of the internet search conducted by the examiner (see Annex), the words “sensual” and “fruit” are used, both separately and together, to describe characteristics of wines. It seems to me that other alcoholic beverages, such as alcopops which can also have fruit-like flavours and smells, could be described in the same way. There is therefore nothing about the

combination SENSUAL FRUIT as it appears in the applicants' mark that is any different from the usual way of designating the relevant goods or their characteristics.

10. Recent decisions of the European Court of Justice make it clear that there remains a public interest in keeping free certain words or combinations of words which others may wish to use. For example in the judgement of the European Court of Justice in the *Doublemint* Case C191-01 (*Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr* 2003 WL 101985) which said:

“31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.”

11. As I stated earlier in this decision, the original objection placed emphasis on the mark being open to objection because it is descriptive of the kind of goods e.g. those containing sensual fruit. The possibility that SENSUAL FRUIT may be interpreted ambiguously and therefore have more than one meaning is not a relevant consideration in assessing whether the mark is descriptive. In the *DOUBLEMINT* decision the court also indicated that the test is not whether the mark is exclusively descriptive; it is sufficient if one of the meanings of the mark designates a characteristic of the goods. And the court confirmed its earlier judgement in *Windsurfing Chiemsee* to the effect that it is not necessary for a sign to be in current use as a description before it is susceptible to an objection under Article 7(1)(c). It is sufficient that the sign is capable of being used as a designation of the goods.

“32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

12. It appears to me, therefore, that the mark consists exclusively of a sign which may serve, in trade, to designate characteristics of the goods at issue, and so does not qualify under Section 3(1)(c) of the Act.

### **Section 3(1)(b)**

13. The *Cycling IS...* case [2002] R.P.C. 37 advanced the notion that Section 3(1)(b) has separate and independent scope from section 3(1)(c), an approach since reinforced both in the European Court of Justice, in its judgement on *Companyline* [2003] E.T.M.R. 20 and by the English High Court in *Have A Break* [2002] EWHC 2533 (Ch). Therefore, having found that the mark is

debarred from registration under Section 3(1)(c) of the Act, I now go on to consider whether the mark is devoid of any distinctive character under Section 3(1)(b).

14. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act was 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 must first of all be observed 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 and 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* [2002] ECR I-5475, 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”.

15. I must of course assess the mark’s distinctiveness in relation to the goods for which the applicants seek protection, which are “Wines and other alcoholic beverages (except beer)”. I must have regard to the perception of the relevant consumers of the goods, who, in my view, are the general public. I must also assume notional and fair use of the mark in relation to the goods applied for, which includes use on the packaging of the goods as well as use in advertising.

16. If the applicants’ mark is used on the label of a bottle of wine in particular or alcoholic beverages in general, or in advertising any of these goods, it seems to me that the phrase SENSUAL FRUIT is so typical of the type of language commonly used to describe characteristics of wine that it will not give a trade mark message to the average consumer of the goods at issue, because it will simply convey the message that these are characteristics of the goods.

17. I am not persuaded that the mark SENSUAL FRUIT in totality is distinctive in that it would serve in trade to distinguish the applicants’ goods from those of other traders. 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**

18. 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 Articles 3 and 9(3) of the Trade Marks (International Registration Order 1996 (as amended) because it fails to qualify under Sections 3(1)(b) and (c) of the Act.

Dated this 6<sup>th</sup> day of December 2004.

**ANNE PRITCHARD**  
**For the Registrar**  
**The Comptroller-General**

**THE ANNEX IS NOT ATTACHED**