

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
APPLICATION NO. 2198020  
BY TESCO STORES LIMITED TO REGISTER A  
TRADE MARK IN CLASSES 29,30 & 31**

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**DECISION**

**Background**

On 20 May 1999, Tesco Stores Limited of Cheshunt, Hertfordshire, applied for registration of the mark shown below in Classes 29,30 & 31:



The application form contained the following colour claim:

“The application is filed claiming the colours black and silver”.

The mark was applied for in respect of the following range of goods:

**Class 29:**

Meat, fish, seafoods, poultry and game; meat, fish, vegetable and fruit extracts; preserved, dried and cooked fruits and vegetables; meat products; sausages; prepared meals; snack foods; jellies, jams, fruit preserves, vegetable preserves; sauces; desserts; eggs; milk; dairy products; yoghurt, frozen yoghurt; edible protein derived from soya beans; edible oils and fats; nuts and nut butters; pickles; herbs; tofu; weed extracts for foods; food spreads consisting wholly or substantially wholly of vegetables, milk, meat, poultry, fish, seafoods or of edible fats; soups; bouillons.

**Class 30:**

Coffee, coffee essences, coffee extracts; mixtures of coffee and chicory; mixtures of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee; tea, tea extracts; cocoa; preparations made principally of cocoa; chocolate; chocolate products; sugar, maltose, rice, tapioca, sago, couscous; flour and preparations made from cereals and/or rice and/or flour; nut paste, confectionery and candy, breakfast cereals; pastry; pizza, pasta and pasta products; bread, sandwiches, filled rolls; snack foods; biscuits; cookies; cakes; ice, ice cream, water ices, frozen confections; preparations for making ice-cream and/or water ices and/or frozen confections; honey; preparations consisting wholly or substantially wholly of sugar, for use as substitutes for

honey; syrup, treacle, molasses; ketchup; sauces and preparations for making sauces; custard powder; prepared meals; mousses; desserts; puddings; yeast, baking powder; salt, pepper, mustard; vinegar; chutney; spices and seasonings; vegetal preparations for use as drinks; infusions (other than for medicinal use); pies; meat tenderizers for household purposes; royal jelly for human consumption (other than for medicinal purposes); natural and artificial sweeteners; syrups; salad dressings, mayonnaise.

### **Class 31**

Fresh nuts, fresh fruits, vegetables and herbs; dried flowers and plants.

Objection was taken to the application under paragraphs (b) and (c) of Section 3(1) of the Act, on the grounds that the mark consists exclusively of the laudatory word FINEST together with a non-distinctive device of a star, the whole being a sign that other traders may legitimately wish to use to designate the quality of the goods i.e. foodstuffs or other goods which are of a superior nature. Objection was also raised under Section 5(2) of the Act on the basis of an application pending before the Community Trade Marks Office. However, I note that application is now shown on the Community Register as status Dead and was waived as an objection against this application in the official letter of 1 December 1999. Consequently, I need make no further mention of it.

In their letter to the Registrar of 26 November 1999, the agents acting for the applicant indicated that it was their clients intention to support the application with evidence to show that the mark had acquired a distinctive character as a result of the use that had been made of it. Evidence of use of the mark was subsequently filed on 31 March 2000. However, the evidence filed was not considered sufficient to overcome the objections and a hearing was requested by the applicant.

### **Hearing and decision**

At a hearing at which the applicant was represented by Mr J A Groom of Trade Mark Owners Association Limited, the objections were maintained. Following the issue of the notice of refusal of the application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to provide a statement of the reasons for my decision.

The relevant parts of the Act under which the objections were taken are as follows:

Section 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.

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.”

**Section 3(1): Absolute grounds for refusal of registration**

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**The prima facie case for registration**

10 Although the agents acting for the applicant do not appear to have challenged the Registrar’s prima facie view of the mark, it is I think appropriate to consider whether the mark is acceptable under Section 3(1) of the Act, absent use.

15 The mark consists of the common dictionary word FINE in its superlative form, together with a device of a star and a claim to the colours black and silver. The meaning of the word FINEST is so well known as to require little explanation. However, for the sake of completeness, I note that the most pertinent reference to the word FINE appearing in the Collins English Dictionary (third edition) updated in 1994 is as follows:

*“1. Excellent or choice in quality;”*

20 From this reference one can easily deduce that in relation to the goods for which registration is sought (or indeed many other goods or services), the meaning the word FINEST is likely to convey to a potential purchaser, is that here we have a range of goods of excellent quality.

25 Although the Registrar’s practice in relation to star marks (outlined in the Addendum to Chapter 6 of the Trade Marks Work Manual) does not specifically refer to the use of stars in relation to the goods for which registration is sought, it is clear that devices of stars are commonly used in trade in relation to a wide range of goods and services. Their use is often to indicate a particular level of service, or in my view as in this case, to highlight the premium quality nature of the products. Finally the applicants are claiming the colours black and silver as a feature of the mark. 30 Whilst colour can (and often does) constitute an important feature of many trade marks, it is in my own experience quite commonplace for traders to present designations with the lettering in one colour on a background of a contrasting colour. As such, I do not think that the presentation in two colours of what would otherwise be objectionable elements adds any distinctive character to the mark.

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In view of the above, I have reached the conclusion that the mark consists exclusively of a sign which may serve in trade to designate the quality of the goods and as such is debarred from registration under paragraph (c) of Section 3(1) of the Act. It follows that the mark is also devoid of any distinctive character under paragraph (b) of Section 3(1) of the Act.

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In this regard I take account of the comments made in the British Sugar PLC and James Robertson and Sons Ltd decision (1996) RPC 281, page 306, line 1 (referred to hereafter as the TREAT decision), in which Jacob J said:

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*“Next, is “Treat” within Section 3(1)(b). What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no*

5 *use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word inherently from the old Act but the idea is much the same) devoid of any distinctive character.”*

10 I do not consider that the average consumer would regard this mark as a trade mark until they had been educated to that perception. However that is not the end of the matter, as I now have to go on to consider the evidence filed in order to persuade me that the mark has acquired a distinctive character as a result of the use made of it by the applicant.

### **Acquired distinctiveness: the applicant’s evidence**

15 The evidence filed in support of the application comprises a statutory declaration dated 29 March 2000 by Martin John Field, accompanied by seven exhibits. Mr Field states that he is the Assistant Company Secretary of Tesco Stores Limited a position which he has held since 1989. He explains that he is authorised to make his declaration on behalf of the applicant and adds that the facts contained in his declaration are either from his own personal knowledge, or are derived from the records of the applicant to which he has full and free access.

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The main facts emerging from Mr Field’s declaration are as follows:

25 (i) the mark for which registration is sought was first used by the applicant in the United Kingdom in February 1998 in relation to a variety of food products and has been used continuously since that date. Exhibit MJF1 is an example of undated packaging used in relation to Grand Marnier Swiss Truffles on which the mark appears,

30 (ii) the mark was first launched on a range of approximately 100 products stocked by 120 stores, mainly in the south of England. Within 15 months of launch there were at least 350 different products in the range and this number continues to increase. All TESCO stores sell some products under the mark, with over half of all TESCO stores selling in excess of 150 products from the range,

35 (iii) goods bearing the mark have been the subject of a number of blind and open tastings organised by various publications. Having reviewed exhibit MJF2 which consists of a number of articles from a range of magazines, I note that the majority of the documents provided are after the material date of 20 May 1999,

40 (iv) the mark has been referred to extensively in published media. Exhibit MJF3 contains copies of the various references,

45 (v) goods bearing the mark were the overall winner of the 1999 British Meat Good Housekeeping Product of the year award based on a Beef Wellington product. Exhibit MJF4 which consists of extracts from the Evening Express and Daily Mail Weekend publications supports this contention. However, once

again, I note that the publications are after the material date,

(vi) turnover figures for the period March 1998 to April 1999 amounted to some £143 million pounds. Mr Groom indicated at the hearing that these figures did relate to sales under the mark, but this is not clear from the declaration,

(vii) goods sold under the mark in the United Kingdom have been widely promoted by means of television and press advertising and by mail shots to customers with loyalty cards. In the period March 1998 to April 1999, in excess of £2 million has been spent on advertising and promoting the mark. Examples of how the mark has been promoted on television and in the press are provided at exhibits MJF5 (which consists of a video showing how the mark was promoted on television in the Carlton, Meridian and Anglian regions in May 1998) and MJF6 which is a copy of an advertisement which appeared in the press. I note from the declaration that the press advertisement mentioned above ran in the press on 10 and 11 July 1999 i.e. after the material date,

(viii) goods bearing the mark are sold in display cases which prominently displays the mark. At exhibit MJF7 are photographs of such display cases, although the photographs provided do not appear to be dated.

That concludes my review of the evidence filed. I now go on to consider if in light of this evidence the mark applied for has acquired a distinctive character as a result of the use that has been made of it.

### **Acquired distinctiveness: decision on the evidence**

A trade mark which is deemed to lack the necessary inherent distinctive character can acquire a distinctive character through its use as a trade mark. The European Court of Justice laid down the legal requirements in this respect in *Windsurfing Chiemsee Produktions v Huber* 1999 ETMR 585. The relevant part of the court's decision is reproduced below:

*"51. In accessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account. The market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.*

*"52. If, on the basis of these factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied".*

From my summary of the evidence above, it can be seen that the applicant has some fifteen months use of the mark prior to the date of application. Whilst I accept that the turnover and the extent to which the applicant has promoted the mark is impressive, one must not lose sight of the highly descriptive and laudatory nature of the essential element of the mark i.e. the word FINEST. In addition, the evidence filed in support of the application suffers from a number of serious defects. These are:

- although the applicant claims to have used the mark on a wide range of goods in the various classes, the exhibits provided do not support such a claim,
- a significant number of the documents the applicant relies upon to support their claim to distinctiveness are either undated or after the material date and as such can not be taken into account in relation to this application,
- the applicant's use of the mark is almost exclusively in combination with the TESCO trade mark.

In so far as the latter is concerned the TREAT decision mentioned above is particularly relevant. Jacob J made the following comments (page 299, line 36):

*"I turn to consider how the word "Treat" is used here. I have no evidence from the public in relation to this question. I have some evidence of internal thinking at Robertson's, but the most important thing of all must be my own impression from the label and all the surrounding circumstances. Looking at the label I think the average customer would not see "Treat" used as a trade mark. It is true that it is written as part of a phrase "Toffee Treat" but this is done in a context where the maker's name is plain. It is of course the case that you can have two trade marks used together ("Ford Prefect"), but whether the secondary word is used as a trade mark is a question of fact. If it is a fancy word, then obviously it is a trade mark because it could not be taken as anything else. But where it is highly descriptive I see no reason why a member of the public should take the mark as a badge of origin."*

Many of the comments of Jacob J mentioned above are directly relevant to this application. For example, I have information from Mr Field on TESCO's thinking in adopting the mark. At paragraph 5 of his declaration Mr Field says:

*"My Company first developed the trade mark FINEST\* as a means of creating a totally new concept: FINEST\* is a cohesive range of quality products and my Company sought to distinguish the specialness of these food products by creating an exclusive look to the presentation. The silver and black lettering and the word FINEST\* itself with the asterisk all serve to distinguish these products from my Company's standard range and other manufacturer's goods".*

However as guided by Jacob J, in the absence of compelling evidence from the public, the most important consideration, is my own impression of the mark from the way that it is used on the packaging. Looking at the packaging, I do not think that the average consumer would see the word FINEST together with a device of a star (and not an asterisk as Mr Field suggests)

presented in the colours silver and black being used in a trade mark sense. They would instead, in my view, simply see these elements as indicating products which are of a higher (or of the highest) quality when compared to the company's standard range, a view which appears to be supported by Mr Field's comments above. In addition, the mark is almost exclusively used with the well known TESCO house mark. Whilst I accepted at the hearing that one can, of course, have two trade marks used together, when deciding if the secondary mark is performing a trade mark function, one has to look closely at the nature of the mark. In this case the word FINEST (and device) when presented in the colours silver and black remains highly descriptive and laudatory and I see no reason to assume that a member of the public should take the combination as indicating anything other than a premium range of goods.

At the hearing, I informed Mr Groom that for the reasons indicated above and notwithstanding that the use of the mark applied for had been substantial (in monetary terms), I took the view that it was unlikely that the public would perceive it as a badge of trade origin. I am fortified in this view by the comments made by Jacob J, again in the TREAT decision (page 302, line 22):

*"I have already described the evidence used to support the original registration. It was really no more than evidence of use. Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that "use equals distinctiveness". The illogicality can be seen from an example: no matter how much use a manufacturer made of the word "Soap" as a purported trade mark for soap the word would not be distinctive of his goods. He could use fancy lettering as much as he liked, whatever he did would not turn the word into a trade mark. Again, a manufacturer may coin a new word for a new product and be able to show massive use by him and him alone of that word for the product. Nonetheless the word is apt to be the name of the product, not a trade mark. Examples from old well known cases of this sort of thing abound. The Shredded Wheat saga is a good example. Lord Russell said:*

*"A word or words to be really distinctive of a person's goods must generally speaking be incapable of application to the goods of anyone else".*

*It is precisely because a common laudatory word is naturally capable of application to the goods of any trader that one must be careful before concluding that merely its use, however substantial, has displaced its common meaning and has come to denote the mark of a particular trader. This all the more so when the mark has been used in conjunction with what is obviously taken as a trade mark."*

## **Conclusions**

For the reasons indicated, the mark is not acceptable prima facie because it is debarred from registration under paragraphs (b) and (c) of Section 3(1) of the Act (a view which does not appear to have been contested by the applicant);

The evidence filed to substantiate the claim that the mark has acquired a distinctive character is insufficient to satisfy the proviso to paragraphs (b), (c) and (d) of Section 3(1) of the Act.

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 it fails to qualify for registration under paragraphs (b) and (c) of Section 3(1) of the Act.

5 Dated this 20 day of November 2000.

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**Christopher Bowen**  
**For the Registrar**  
**The Comptroller General**

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