O-1069-25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 4107201

BY Molkerei Gropper GmbH & Co. KG

TO REGISTER THE FOLLOWING MARK IN CLASSES 29, 30 and 33:

TASTY

Background

1. On 2 October 2024, Molkerei Gropper GmbH & Co. KG ('the applicant') applied to register the mark shown above, for the following goods:

> Class 29: Dairy products and dairy substitutes; milk; milk products; beverages having milk base; milk drinks with a predominant or high milk content; butter, yogurt; drinks based on yogurt, smetana [sour cream]; desserts made from milk products; condensed milk; drinks based on yogurt; kephir [milk beverage]; chilled dairy desserts; milk-based snacks; skyr; oat milk, soya milk; rice milk; cheese; milk substitutes
>
> Class 30: Ice creams, frozen yogurts, and sorbets; Coffee, teas and cocoa and substitutes therefore.
>
> Class 33: Alcoholic cocktails containing milk.

2. On 10 October 2024, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under Section 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act') against all goods of the application, which read as follows:

> **<u>Absolute grounds for refusal</u>**
>
> **Section 3(1)(b) and (c)**
>
> The application is not acceptable in Classes 29, 30 and 33. There is an objection under Section 3(1)(b) and (c) of the Act to the mark "Tasty". This is because the mark consists exclusively of a sign which may serve in trade to designate the kind and quality of the goods e.g. foodstuffs which are tasty.
>
> It is considered that the mark "Tasty" would be understood by the average consumer to designate that the goods on offer are tasty. It is plain descriptive language which merely serves to describe what the foodstuffs taste like.

3. The Section 3(1)(b) objection is not independent of the objection under Section 3(1)(c), and the finding of non-distinctiveness was an automatic consequence of the sign being considered as designating a characteristic of the goods. This is the approach I shall adopt throughout this statement of grounds.

4. In line with IPO procedure, a period of two months was allowed for the applicant to respond.

5. On the 2 December 2024, Appleyard Lees IP LLP ("The attorney"), acting on behalf of the applicant requested an extension of time of two months to consider their response to the objection further. This was duly accepted by the examiner.

6. On 7 February 2025 the attorney filed a request for a further three months to finalise considerations of the objection including a claim of acquired distinctiveness. In response the examiner granted a further period of two months to respond.

7. On 9 April 2025 the attorney filed a request for a further three months to finalise considerations of the objection including a claim of acquired distinctiveness. In response the examiner granted a further and final period of two months to respond.

8. On 6 June 2025 the attorney made written submissions in favour of accepting the sign in the *prima facie.* The attorney contended that the sign TASTY, does not immediately, without further thought describe the kind or quality of the goods applied for. In that regard it invites the consumer to question the meaning of tasty. Additionally, the attorney referred to the following earlier UK registered trade marks:

a. Registration no. UK00003972669 Tas-ty, in classes 30 and 43, filed 27 October 2023 and registered 19 January 2024;

b. Registration no. UK00003019433 TASTY B and TASTY-B (series of 2), in classes including 29 and 30, filed 29 July 2013 and registered 17 January 2014;

c. Registration no. UK00003545641 TASTY DZ, in classes 29, 30 and 43, filed 19 October 2000 and registered 26 January 2021;

d. Registration no. UK00003719965 TASTY LEAF and tasty leaf (series of 2), in classes including 30, filed 10 November 2021 and registered 4 February 2022;

e. Registration no. UK00003696047 Tasty Thais, in class 30, filed 16 September 2021 and registered 11 March 2022 and

f. Registration no. UK00003893964 TASTY BAKERIES in class 30, filed 28 March 2023 and registered 23 June 2023.

The attorney then made a plea of 'equal treatment'. Finally, if the examiner maintained the objection the attorney requested a hearing.

9. Having considered the attorney's submissions, the examiner was not convinced that the objection should be waived and responded to that effect on 4 July 2025. The case was then forwarded to the hearings clerk to arrange a hearing.

10. The hearing was held 30 July 2025 between me and Mr Vishal Dattani of Appleyard Lees IP LLP.

11. At the hearing Mr Dattani's submissions centred around the sign 'TASTY' on its own being vague and the relevant consumer would need to give further thought and imagination to arrive at a meaning. Mr Dattani then contended that some of the goods in question for example *soya milk* are purchased because of their health benefits, and in respect of such goods the sign does not have a descriptive meaning. Mr Dattani also referred me to the earlier registered trade marks cited in correspondence to the examiner and reiterated the plea of equal treatment. In the alternative Mr Dattani asked for an extension of time to consult with the applicant on a plea of acquired distinctiveness.

12. My hearing report and decision on inherent characteristics records that the word applied for would be seen as a description of the goods. In other words, the term is clearly descriptive and would describe goods which have a strong and pleasant taste. Thus, based purely on dictionary definition, the word would, or could designate a characteristic of all the goods applied for. I thus maintained the *prima facie* objection under section 3(1)(b) and (c) of the Act. However, I granted a period of two months for the applicant to submit evidence of distinctiveness acquired through use.

13. The applicant did not respond within the specified timeframe, and so on 8 October 2025, I issued a refusal letter in accordance with section 37(4) of the Trade Marks Act.

14. On 7 November 2025, the IPO received form TM5 requesting a statement of reasons for the Registrar's decision. I am now obliged to set out the reasons for my decision. No formal evidence of use has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, I only have the *prima facie* case to consider.

The Law

15. Section 3(1) of the Act reads as follows:

> *3(1) The following shall not be registered –*
>
> *(a) …*
>
> *(b) trade marks which are devoid of 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) …

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.
The relevant legal principles – section 3(1)(c)

Relevance of EU Law

16. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to some decisions of the EU courts which predate the UK's withdrawal from the EU

The relevant legal principles – Section 3(1)(c)

17. The main guiding principles are shown below:

• Subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (Wm Wrigley Jr & Company v OHIM, C-191/01P 'Doublemint', paragraph 30)

• Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all (Doublemint, paragraph 31);

• When determining whether a sign is devoid of distinctive character or is descriptive of the goods or services in respect of which registration is sought, it is necessary to take into account the perception of the relevant consumer who is reasonably well-informed and reasonably observant and circumspect (Matratzen Concord AG v Hukla Germany SA, C-421/04);

• I have also considered the consequences for third parties of granting the applicant a monopoly. In Linde A.G. v Rado Uhren A.G. Case C-53/01 the following guidance was given at paragraphs 73 – 74:

"*73. According to the Court's case-law "Article 3(1)(c) of the Directive 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 applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see to that effect, Windsurfing Chiemsee, paragraph 25).

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"

Application of the legal principles

18. From the aforementioned case law, it is clear I must determine whether or not the mark applied for will be perceived by the relevant consumer as a means of directly designating characteristics of the goods specified, in this case the characteristics would be kind and quality of the goods specified in classes 29, 30 and 33. To do this, I must first assess who I consider the relevant consumer to be.

19. I consider the relevant consumer to be the general public at large seeking to purchase the food and drink products for their own consumption, albeit that the relevant consumer for the class 33 goods, namely *alcoholic cocktails containing milk* will be the adult general consumer. These are not specialist goods, with many of the goods in question being everyday consumables.

20. Having established the relevant consumer, I must assess how they would perceive the sign 'TASTY' in relation to the goods claimed. I have taken the following definition from Collins English Dictionary:

Tasty: adjective

Having a pleasant flavour.

21. I must determine, assuming notional and fair use in trade, whether the sign in suit would be viewed by the relevant consumer as designating a characteristic of the goods for which registration is sought. The dictionary excerpt given above defines the word 'tasty' as describing something that has a pleasant flavour. Thus, the meaning of the sign will be readily understood and comprehended by members of the general public as describing *foodstuffs* and *alcoholic milk cocktails* that have a pleasant flavour. At the hearing Mr Dattani argued that the sign 'TASTY' on its own is vague and the relevant consumer would need to give further thought and imagination to arrive at a meaning. I do not concur. It is obvious to me, based on the dictionary definition alone that the sign would be perceived as nothing more than designating the kind and quality of the goods applied for. Furthermore, I do not accept Mr Dattani's contention that

healthy foodstuffs cannot be tasty, I see no reason why foodstuffs cannot have the dual characteristics of being both healthy and tasty.

22. It is clear from the aforementioned case law that section 3(1)(c) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all. The sign 'TASTY' is a term that others in the same field of business should be free to use when conveying that their products have a pleasant flavour. The acceptance of this word as a trade mark for one undertaking is likely to disadvantage other undertakings and in my view the need to keep free is clear.

The question of prior acceptances and 'equal treatment'

23. For the sake of completeness, I wish to deal, briefly, with the contention, frequently made, that the registry has accepted other, similar marks and this should, at least, be factored into my assessment. It is a well-established principle that such prior acceptances create no binding precedent on the registrar. This principle has been expressly made in Appointed Person ('AP') decision BL O/262/18 'BREXIT', see para 9 and following, and more recently, APdecision BL O/431/24 'THINKING OF YOU', see para 28. Whilst this decision was in respect of Section 3(1)(b), I believe its guiding principles to be relevant also to section 3(1)(c):

> "It is because bare "state of the register" evidence is so rarely helpful to a tribunal that it is often said to be "irrelevant" (BREXIT (O/262/18), [10]; British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281 at 305) or even "worthless": Lifestyle Equities CV v Royal County of Berkshire Polo Club Ltd [2022] EWHC 1244 (Ch). In short, the assessment under section 3(1)(b) is not about assessing the sign against other marks on the register, but against the statutory standard."

24. In the same case, THINKING OF YOU, the AP notes that the principles of 'equal treatment' and 'sound administration' are not free-standing requirements of UK domestic public law (although 'equal treatment' may be an element of legitimate expectation). That is, in contrast to the position in the EU whereby competent bodies of the EUIPO are injuncted to take 'especial care' where there may be potentially inconsistent findings as compared to earlier acceptances. The AP notes however that even if UK competent bodies are equally injuncted (without confirming they are) it is hard to see what exactly 'especial care' actually amounts to in a given case where the BREXIT principle above plainly applies. Each case, in other words, demands careful examination based upon the statutory requirements rather than what exists on the register.

25. Finally, I also confirm that the 3(1)(b) objection raised in respect of this case is co-extensive with the objection raised under 3(1)(c) and as a result, there is not a separate or independent 3(1)(b) objection to be considered in this case.

Conclusion

26. In this decision, I have carefully considered all the submissions and arguments made during the proceedings and, having done so, concluded that for the reasons set out above, the application is refused in respect of the goods applied for because it fails to qualify for registration under Section 3(1)(b) and (c) of the Act.

Dated this 17th day of November 2025

Lee Scott
For the registrar
The Comptroller General