

O-254-03

TRADE MARKS ACT 1994

AND

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996
IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 715985
AND THE REQUEST BY SCHÖLLER LEBENSMITTEL GMBH AND CO KG
TO PROTECT A TRADE MARK IN CLASS 30**

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Background

1. On 9 June 1999, Schöller Lebensmittel GmbH & Co KG, 137 Bucher Strasse, D-90419 Nürnberg (Germany), on the basis of International Registration 715985 requested protection in the United Kingdom under the provisions of the Madrid Protocol of the mark:



The following words appear beneath the mark on the form of notification:

Colours claimed: Red, dark pink, white, green.

Protection is sought in class 30 in respect of:

Edible ice, preparations mainly containing edible ice.

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) of the Trade Marks Act 1994. This is because the mark consists of the

laudatory slogan "Our ice cream of the year" and a non-distinctive device the whole being devoid of distinctive character for e.g. top quality ice cream.

3. At a hearing, at which the applicants were represented by Ms M Marshall of J A Kemp & Co, their trade mark attorneys, the objection under Section 3(1)(b) of the Act was maintained.

4. Following the hearing, evidence of use of the mark was filed with the purpose of showing that the mark had acquired a distinctive character as a result of that use. However, this evidence was not considered sufficient to overcome the objection which was maintained.

5. 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 Marks Rules 2000 to state in writing the grounds of my decision and materials used in arriving at it.

The Law

6. The relevant parts of Section 3(1) of the Act are as follows:

"The following shall not be registered -

- (a)
- (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)

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 Prima Facie Case for Registration

The Law

7. The test for distinctiveness was laid down by Mr Justice Jacob in the TREAT case [1996] RPC 281 page 306 lines 2-5 when he said:

"What does *devoid of distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no 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?"

In the Proctor & Gamble Limited's application (1996 RPC 281), Walker LJ said:

"Despite the fairly strong language of Section 3(1)(b), "devoid of any distinctive character" - and Mr Morcom emphasised the word "any" - that provision must in my judgment be directed to a visible sign or combination of signs which can by itself readily distinguish one trader's product - in this case an ordinary, inexpensive household product - from that of another competing trader. Product A and Product B may be different in their outward appearance and packaging, but if the differences become apparent only on close examination and comparison, neither can be said to be distinctive"

A definition of what is meant by distinctive character and what is required of it can also be found in the European Court of Justice judgement on the *Philips* case [2003] R.P.C. 2, at paragraphs 30 and 47:

"Moreover, according to the case-law of the Court, 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, and for the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality ..."

"... it is clear from Article 2 of the Directive that a trade mark has distinctive character if it serves to distinguish, according to their origin, the goods or services in respect of which registration has been applied for. It is sufficient, as is clear from paragraph 30 of this judgment, for the trade mark to enable the public concerned to distinguish the product or service from others which have another commercial origin, and to conclude that all the goods or services bearing it have originated under the control of the proprietor of the trade mark to whom responsibility for their quality can be attributed."

8. In correspondence and at the hearing the agent argued that the Section 3(1) objection was unjustified. She maintained that when the mark is considered as a whole it is an unusual and distinctive mark which contained stylistic and artistic aspects. In particular she referred to the combination of colours claimed and the artistic aspects which she argued gave the mark as a whole an unusual and distinctive quality. This argument did not persuade me that the mark was not devoid of any distinctive character.

9. The application is for a sign which is a device of a scoop of ice cream. It is represented in a specific combination of the colours red, dark pink, white and green with the addition of a slice of fruit and the words "Our Ice Cream of the Year".

10. I have considered the individual elements of the mark, and even when taken in combination, I take the view that the mark as a whole is devoid of any distinctive character.

11. At the hearing, I advised Ms Marshall that the objection under Section 3(1)(b) of the Act was maintained. However, I agreed to allow the applicants further time to consider the position and submit evidence of acquired distinctiveness.

The Case for Registration based on Acquired Distinctiveness

The Law

12. In the *Windsurfing Chiemsee* case, the ECJ ruled on the nature of the enquiry as to whether a mark has acquired a distinctive character under Article 3(3) (Section 3(1) proviso). It held that the national authorities may take into account evidence from a variety of sources, but a finding that the mark has come to denote the goods as coming from a particular undertaking must necessarily mean that the provisions of Article 3(3) are met. The Court held:

"In assessing 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" (paragraph 51).

"If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify the 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" (paragraph 52).

The Evidence

13. Evidence in support of this application was filed. The evidence consists of a Statutory Declaration by Michael James Godwin the Managing Director of Schöller Ice Cream Limited together with supporting exhibits. Mr Godwin declares that the trade mark in question was first used in the United Kingdom in 1989. Mr Godwin states that part of the applicants' marketing strategy is to promote ice creams each year under the banner "Our Ice Cream of the Year". The trade mark applied for (with raspberry garnish) was marketed as "Our Ice Cream of the Year" in 1995. Thus the mark has been used with and without the "Our Ice Cream of the Year" promotion. Turnover for the period 1996 - 1999 is set out below:

TURNOVER

Year	£
1996	86,624
1997	80,836
1998	99,495
1999	89,667

14. Mr Godwin further declares that the annual marketing expenditure in connection with Schöller ice cream as a whole is in the region of £200,000 and covers advertising, attendance at exhibitions, the provision of brochures, menus and point of sales promotional material.

15. Exhibit MJG1 is a selection of brochure material and exhibit MJG2 provides copies of

photographs of exhibition stands.

16. In my view, the evidence filed has not established that the mark applied for has acquired a distinctive character as a trade mark in its own right. The exhibits do not show trade mark use of the mark. They show the device used in a brochure as one of a range of flavoured ice creams marketed by the applicants and used in conjunction with the words Mövenpick and/or Schöller. I consider that this reinforces the idea that the device itself would purely be seen as an ordinary representation of the goods using decoration and garnishes typical of the way in which the goods can be made to look more appetising rather than an indication of trade origin.

17. In particular, I do not consider the relevant public would attach trade origin significance to the mark applied for when used in this way. In addition the turnover figure is low.

18. I do not consider the evidence proves the mark applied for has acquired a distinctive character as a result of the use made of it and I conclude that the applicant has failed to satisfy the proviso of Section 3(1) of the Act.

19. In relation to the words "our ice cream of the year" present in the mark, again, I do not consider the public are likely to attach trade origin significance to these words. Furthermore, according to the information provided by the agent the words were applied for only one year i.e. 1995. Therefore, the evidence relating to the words is insignificant.

20. I am fortified in this conclusion by the following extract from the judgement of the Hon Mr Justice Jacob in the "TREAT" case (1996 RPC 281 at page 299) where he said:

"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. And that is particularly so where the product is a new sort of product, as here. The public are apt to take the name of a novel product as a description rather than a trade mark, particularly where the name is not fancy but is descriptive or laudatory. I do not think Robertson's use is as a trade mark."

Conclusions

21. The mark is not acceptable prima facie because it is debarred from registration under Section 3(1)(b) of the Act.

22. The evidence filed to substantiate the claim that the mark has acquired a distinctive character is not sufficient to satisfy the proviso to Sections 3(1)(b)(c) and (d) 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 above it is refused under Section 37(4) of the Act.

Dated this 20th day of August 2003

R A JONES
For the Registrar
The Comptroller General