

O-293-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION No 838776  
AND THE REQUEST BY SANTELMO PTY LIMITED  
TO PROTECT THE TRADE MARK  
LICK ME ICE CREAM  
IN CLASS 30**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 71258  
BY MINGHELLA ISLE OF WIGHT LIMITED**

## **BACKGROUND**

1) On 5 November 2004, Santelmo Pty Ltd (hereinafter the applicant), of 32 Bettina Street, Burwood East Vic 3151, Australia on the basis of its international registration based upon its registration held in Australia, requested protection in the United Kingdom of the trade mark LICK ME ICE CREAM under the provisions of the Madrid Protocol. Protection was sought for the following goods in Class 30: “Ice cream; ice-cream products; ice-cream confectionery; ice-cream desserts; frozen confections, confectionery ices including frozen yoghurt, sherbets (ices), sorbets (ices), all other water ice products and all other frozen desserts in this class; prepared desserts in this class, other liquid preparations frozen in a form in this class; all the foregoing containing or including ice cream.”

2) The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.

3) On 14 November 2005 Minghella Isle of Wight Limited of The Minghella Centre, High Street, Wootten Bridge, Ryde, Isle of Wight, PO33 4PL filed notice of opposition to the conferring of protection on this international registration. The grounds of opposition are in summary:

a) The opponent contends that the mark offends against Sections 3(1)(b), 3(1)(c) and 3(1)(d) of the Trade Marks Act 1994. They state that the mark is entirely descriptive of the manner in which the goods are consumed and would not be seen as an indication of origin by consumers.

4) The applicant subsequently filed a counterstatement denying the opponent’s claims.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 26 September 2007 when the opponent was represented by Mr Buehrlen of Messrs Beck Greener. The applicant was not represented.

## **OPPONENT’S EVIDENCE**

6) The opponent filed a witness statement, dated 20 July 2006, by Christian Rowland Buehrlen, its Trade Mark Attorney. At exhibits CRB.1 and CRB.2 he provides print outs from Internet searches of the words “lick me” and “ice cream” and also randomly chosen websites. A number of these sites are clearly not UK based whilst for a large number it is not clear where they are based. Equally, a number of the “hits” seem to be for jewellery or of a sexual nature and have little to do with selling ice cream. Few have the four words of the mark in suit one after the other. Most have the terms “ICE CREAM” and “LICK ME” separated by words or sentences. Of those that do contain the trade mark in suit in full at least two are clearly linked to the applicant. Mr Buehrlen does not comment on his findings. At exhibit CRB.3 he provides a print out of a European Community Trade Mark Application for LICK-ME which was withdrawn before it reached publication. The company named on the documentation was Lick-Me Limited a UK company. The relevance of this exhibit is unclear. Lastly

at exhibit CRB.4 he provides correspondence between the UK Registry and the opponent relating to its application to register the mark “ONE LICK AND IT’S .. LOVE” which was refused. Again no comment is made by Mr Buehrlen as to the relevance of this exhibit.

### **APPLICANT’S EVIDENCE**

7) The applicant filed a witness statement, dated 20 October 2006, by Fernando Rodriguez a Director of the applicant company. He states that his company has been selling a range of ice creams under the mark in suit in Australia since 1998 and is the proprietor of an Australian Trade Mark for “LICK ME ICE CREAM”. He points out that a number of the Internet hits cited by the opponent are from outside the UK and indeed a number of them relate to the applicant. He also states that none of the sites use the words “LICK ME” and “ICE CREAM” next to each other.

8) That concludes my review of the evidence. I now turn to the decision.

### **DECISION**

9) At the hearing the ground under Section 3(1)(d) was withdrawn. The opposition is now under Section 3(1)(b) and (c) which read as follows:

“3.-(1) 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.”

10) The opponent’s case against each of these grounds is effectively the same, that the mark in suit “is entirely descriptive of the manner in which the goods are consumed”. They therefore contend that the average consumer would not view the mark as a badge of origin, that it is laudatory, that it is descriptive and consists of words which are common in the trade.

11) I shall first consider the ground under 3(1)(b). I approach this ground of objection on the basis of the following principles derived from the ECJ cases referred to below:

- an objection under Section 3(1)(b) operates independently of objections under

Section 3(1)(c) – (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Journal Cases C-53/01 to C-55/01, paragraphs 67 to 68);

- for a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- a mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Koninklijke KPN Nederland v Benelux Merkenbureau*, paragraph 86);
- a trade mark’s distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public’s perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);
- the relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

12) I also take note of the comments of Mr G Hobbs QC acting as the Appointed Person in “Cycling IS.....” trade mark, BL O/561/01. The opponent also referred me to a number of OHIM cases. However, I did not find that these were on all fours with the instant case. The opponent contended that the mark in suit is “made up of a combination of English words which simply produces a statement which is nothing more than the sum of its parts. It is an unambiguous message understood without any particular mental exertion and brings a simple, direct, informative and laudatory message which does not constitute an indication of the origin of a given business”. It is claimed that the term “lick me” in the context of the goods would be understood in accordance with their normal dictionary meaning. It is claimed that this meaning is devoid of any origin function in the context of ice cream. Whilst I accept that the words “LICK ME” would indeed be understood as an invitation to consume the product it is unusual in that it is the product itself which is extending the invitation. In addition the mark in suit is grammatically incorrect and although it is easily understood it is also syntactically unusual. To my mind the average consumer would take the term “LICK ME” to be the badge of origin just as it would “Ben and Jerry’s”. The ice cream in question is LICK ME ice cream and so the consumer can easily repeat the experience if it enjoyable or avoid it if it is unfavourable. The mark in suit initially sounds slightly risqué but having seen evidence of the packaging as filed by the opponent it does not appear to be used as a euphemism. To my mind, the mark is distinctive and so the opposition under Section 3(1)(b) fails.

13) I now move to consider the other ground of opposition under Section 3(1)(c). There are a number of European Court of Justice judgments which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), whose provisions correspond to Section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted 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* Case 191/01P (Doublemint) paragraph 30;
- thus 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 – *Wm Wrigley Jr v OHIM*, paragraph 31;
- it is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes – *Wm Wrigley Jr v OHIM*, paragraph 32;
- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, Case C-363/99 (Postkantoor), paragraph 57;
- if a mark which consists of a word produced by a combination of elements is to be regarded as descriptive for the purposes of Article 3(1)(c) it is not sufficient that each of its components may be found to be descriptive, the word itself must be found to be so – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, paragraph 96;
- merely bringing together descriptive elements without any unusual variations as to, for instance, syntax or meaning, cannot result in a mark consisting exclusively of such elements escaping objection – *Koninklijke Nederland v Benelux Merkenbureau*, paragraph 98;
- however such a combination may not be descriptive if it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements – *Koninklijke Nederland NV v Benelux Markenbureau*, paragraph 99.

14) The mark in suit consists of the words “LICK ME ICE CREAM”. It is well established that the distinctive character of a mark must be assessed in relation to the goods for which registration is sought. In the present case, that is for, broadly speaking, ice cream and frozen confectionery in Class 30. The mark must also be assessed by how it is likely to be perceived by the average consumer which, in this case, I consider to be the general public.

15) Whilst I accept that the words “ICE CREAM” describe the products I do not accept the contention that the words “LICK ME” are a sign or indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods, or other characteristics of the goods. I accept that licking an ice cream is one method of consuming it, but this does

not describe the product as was contended at the hearing. It alludes to the quality being so good that you will want to lick it in order to prolong the experience but this is not a usual method of describing such products. In my opinion, it does not offend against Section 3(1)(c), and so this ground of opposition is dismissed.

## **COSTS**

16) As the opponent was unsuccessful the applicant is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £500. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 4th day of October 2007**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**