

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
NO. 2125372 BY SWIZZELS MATLOW
LIMITED TO REGISTER A TRADE
MARK IN CLASS 30**

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DECISION AND GROUNDS OF DECISION

15 On 3 March 1997, Swizzels Matlow Limited of Carlton House, New Mills, Stockport, Cheshire, SK12 3HA, England, applied under the Trade Marks Act 1994 to register the following as a trade mark for “Non-medicated confectionery” in Class 30:-

20 The trade mark consists of a circular compressed tablet bearing a raised heart outline on both flat surfaces and containing within the heart outline on one side any one of several different words or phrases.

The form of application additionally indicated that the mark was 3-dimensional.

25 Objection was taken under Section 3(1)(a) of the Act on the grounds that the mark was not represented graphically, because it appeared to constitute an indefinite series of marks, and under Sections 3(1)(b) and (c) on the grounds that the mark was devoid of any distinctive character because it was the shape of the goods and a sign that other traders might legitimately wish to use.

30 On 4 July 1997, the applicant filed evidence of use of the mark comprising a Statutory Declaration by Trevor Jack Leslie William Matlow, the Joint Managing Director of the applicant company, and supported by exhibits illustrating the use of the mark on labels, packaging, advertisements and various sales aids. The evidence was deemed not to have demonstrated that the mark had in fact acquired a distinctive character as a result of the use made of it.

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At a Hearing at which the applicants were represented by Ms S J Barr of Wildbore & Gibbons the objections were maintained and following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it.

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Sections 3(1)(a), (b) and (c) of the Act read as follows:-

3(1) The following shall not be registered-

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(a) signs which do not satisfy the requirements of Section 1(1),

- (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.
- (d) [not relevant]

10 **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.**

15 Section 3(1)(a) bars registration of “signs which do not satisfy the requirements of Section 1(1)”, ie that “In this Act a trade mark means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.”

20 Section 3(1)(a) of the Act states that marks which do not meet the requirements of Section 1(1) shall not be registered. Section 37(1) of the Act requires the Registrar to examine applications and to determine whether they meet the requirements of the Act. The combined effect is that an applicant must demonstrate that the sign applied for is capable of being graphically represented by reference to the representation of the mark filed under Section 32(2)(d).

25 It is the Registrar’s view that a sign is graphically represented when:-

- a) it is possible to determine from the graphical representation precisely what the sign is that the applicant uses or proposes to use without the need for supporting samples etc;
- 30 b) the graphical representation can stand in place of the sign used or proposed to be used by the applicant because it represents that sign and no other;
- c) it is reasonably practicable for persons inspecting the register, or reading the Trade Marks Journal, to understand from the graphical representation what the trade mark is.

35 Having regard to the mark as applied for, firstly I do not believe it is defined with sufficient precision so that it is possible to determine precisely what the mark is. In particular, it is not clear from the description filed what is meant by “a circular compressed tablet”. Nor is it clear exactly what is meant by “a raised heart outline”. Admittedly there is a wide understanding of what is meant by “heart” shaped, but there is considerable room for variation within that description. And no doubt there are shapes that some people would regard as heart shaped which others would not. Further, it is not possible to be clear about the positioning or size of the “raised heart outline” and the circumference of the “circular compressed tablet”. No doubt it would be possible to point to further areas of uncertainty (what is meant by “compressed” for one), but I think the above is sufficient to show that the description is not capable of precisely representing

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the applicant's mark.

Secondly, I do not consider the description is capable of standing in place of the applicant's mark because it represents that sign and no other. On the contrary the description applied for could equally represent a significant number of other signs.

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Thirdly, I do not believe it is possible, let alone reasonably practicable, for anyone inspecting the register, or reading the Trade Marks Journal, to understand from the description what the trade mark is. The description which constitutes the applicant's sign includes the words "containing within the heart outline on one side any one of several different words or phrases." As these words are not specified they cannot form part of the mark. At best this appears to be an attempt to include within the mark material which is not defined and not part of the mark. If that is not so, it is an attempt to obtain registration for a sign which is open to endless permutations. I do not believe that it was the purpose of the Act to allow registration of a mark which lends itself to infinite permutations which substantially alter the character of the mark from one manifestation to another.

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For all these reasons, I therefore conclude that the mark is not graphically represented, and so does not satisfy Section 1(1) of the Act, and as a consequence it is therefore debarred from registration by Section 3(1)(a) of the Act.

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Section 3(1)(b) bars registration of "marks which are devoid of any distinctive character".

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

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"What does *devoid of any 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?"

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In my view the sign is likely to be regarded by the public as mere decoration on the surface of a circular sweet, the outline of a heart being a commonplace device applied to many articles, to suggest, e.g., romantic connotations. The addition of different words or phrases, not specified in the application, might serve to emphasize, e.g. a romantic message or impression, but, because of the lack of precision used in describing the mark, could also give rise to the use of an infinite variety of other words. I do not consider that the public would, without education, regard the combination of a heart device plus unspecified words as an indication of origin of the goods. I therefore conclude that the sign is also debarred from registration by virtue of Section 3(1)(b) of the Act.

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Turning now to Section 3(1)(c), I believe the objection based on that section of the Act was not well founded, and I waive it accordingly.

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I now go on to consider the use which has been made of the mark and whether it has in fact acquired a distinctive character as a result of such use.

The statutory declaration by Mr Matlow testified to use of the mark since 1955 on the goods “confectionery with a fruit flavoured fizzy taste sold under the trade mark LOVE HEARTS”. The retail turnover for sales under the mark between the years 1993-96 was variously shown to be some £2.5 - 3.2 million per annum. Advertising was estimated at some £125,000 - £185,000 per annum. The mark was stated to have been used throughout the whole of the United Kingdom.

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Exhibits supporting the evidence showed use of the mark on:-

- (a) paper wrappers for the goods;
- 10 (b) cardboard packaging for the goods, which could be used as display boxes containing the goods at the point of sale;
- (c) Photocopies of various confectionery trade publications promoting the goods alongside other confectionery products made by the applicant
- 15 (d) printed sales aids promoting the goods both individually and alongside other confectionery products made by the applicant

The exhibits all illustrate the goods, both individually and in packets, but always with the trade mark LOVE HEARTS and the house mark SWIZZELS in script accompanying them.

It seems to me that the evidence has not established that the mark alone has acquired a distinctive character as a trade mark in its own right. The sign is never used alone; use has always been accompanied by the house mark SWIZZELS and the trade mark LOVE HEARTS. I therefore conclude that the applicant has failed to satisfy the proviso to Section 3 of the Act.

I am fortified in this belief by the following extract from the judgement of Mr Justice Jacob in the TREAT case [1996] RPC 281, page 302 lines 25-47:-

30 “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: the Canadian case is *The Canadian Shredded Wheat Co. Ltd. v. Kellogg Co. of Canada Ltd* in the Privy Council and the United Kingdom case *The Shredded Wheat Co. Ltd v. Kellogg Co. of Great Britain Ltd.* in the House of Lords. In 40 the former case 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.”

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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 is all the more so when the mark has been used in conjunction with what is obviously taken as a trade mark.”

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Following the hearing the applicant applied, on 24 November 1997, to change the details of the application by the addition of a limitation to be inserted at Section 10 of the Form TM3, the limitation to read:

10 The mark is limited to goods which are 19mm in diameter and 4.76mm in depth.

Section 39(2) of the Act reads as follows:-

15 **(2) In other respects, an application may be amended, at the request of the applicant, only by correcting -**

(a) the name or address of the applicant,

20 **(b) errors of wording or of copying, or**

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(c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

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I do not believe the change requested by the applicant falls within the provisions of this Section of the Act, and I do not therefore permit it. Even if I am wrong in this particular conclusion, I do not believe such a change is sufficient to overcome the objections under Section 3(1)(a) and (b) already addressed.

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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 is debarred from registration under Sections 3(1)(a) and 3(1)(b) of the Act.

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Dated this 24 day of July 1998

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ROGER G EVANS

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For the Registrar
The Comptroller General