

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2206477 BY AUGUST STORCK KG TO REGISTER A TRADE MARK IN CLASS 30

DECISION AND GROUNDS OF DECISION

On 28 August 1999, August Storck KG of Waldstrasse 27, 13403 Berlin, Germany applied to register as a series of two the trade mark WHERE ALL YOUR FAVOURITES COME TOGETHER in respect of:

Class 30 Confectionery; chocolate; chocolates; chocolate products; pralines, chewing gum; bubble gum; candies, sweets; cakes; pastries; bakery products; desserts; frozen and chilled confectionery products.

Objection was taken under Sections 3(1)(b) and (c) of the Act on the grounds that the mark consists of the phrase "Where all your favourites come together" being a sign that other traders may legitimately wish to use.

At a hearing, at which the applicants were represented by Mr D N Peters of Dr. Walter Wolff & Co, their trade mark agents, the objections were maintained. Following refusal of the application under Section 37(4) of the Act, I am now asked under Sections 76 of the Act and Rule 56(2) of the Trade Mark Rules 1994 to state in writing the grounds of the decision and the materials used in arriving at it.

No evidence of use has been put before me. I have therefore, only the prima facie case to consider.

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

"The following shall not be registered:-

- (b) trade marks which are devoid of any 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,

The mark consists of ordinary dictionary words which are so well known that I believe I do not need to set out any dictionary references for all the individual components of the mark. I am, in any case, bound to accept or reject the mark in its totality. I must, therefore, consider the meaning of the mark in its totality. However, I consider it pertinent to emphasise dictionary definitions of the words FAVOURITE and TOGETHER Collins English Dictionary (Third Edition Updated 1994) defines the word FAVOURITE as:-

1. (prenominal) most liked: preferred above all others.

and the word TOGETHER as:-

3. In or into one place or assembly: with each other.

The phrase WHERE ALL YOUR FAVOURITES COME TOGETHER is not invented and in my view is just a sequence of common ordinary dictionary words that would easily come to mind in order convey a promotional message in respect of the goods applied for. The goods specified in the application include “chocolate and confectionery”. Traditionally such goods have been sold in boxes or other packaging which contain a variety of differing flavours or fillings. Most consumers of these goods will identify one or more of this variety as a favourite. Therefore I consider that the mark WHERE ALL YOUR FAVOURITES COME TOGETHER as a whole would be perceived by the relevant customer as no more than a promotional statement of the package contain a variety of confectionery items which sales or other research had identified as consumer favourites.

Following the hearing the agent proposed a number of amendments to the specification including:

“Confectionery in the form of coated hazelnuts”.

The specification was also formally amended to:

“Confectionery in the form of packaged quantities of products, the products in each packaging unit having the same recipe”.

I have taken full account of all of the proposed specifications but remain of the view that the objections must be maintained. Both of these specifications highlight a particular element which may be identified as a favourite with some consumers i.e either the filling in the form of hazelnuts or the recipe of the confectionery.

In this decision I have born in mind the comments in the decision on the DAY BY DAY appeal in which Simon Thorley QC in his role as the Appointed Person commented:

“In my judgement, Mr James correctly submitted that I should have regard not only to natural use on packaging but also to natural use in the context of advertising”.

I also bear in mind the comments of Geoffrey Hobbs QC in the AD2000 decision (1997 RPC 168) at page 176, lines 9 to 23:

“Although section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse registration of signs which are excluded from registration by the provisions of section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacob Esq, QC, in his decision on behalf of the Secretary of State in *Colorcoat Trade Mark* [1990] RPC 511 at 517 in the following terms:

“That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see e.g. *Yorkshire Copper Work Ltd' s Trade Mark Application* (1954) RPC 150 at 154 lines 20-25 per Viscount Simonds LC. Essentially the reason is that the privilege of a monopoly should not be conferred where it might require “honest men to look for a defence”.”

I therefore consider that the mark WHERE ALL YOUR FAVOURITES COME TOGETHER consists exclusively of a sign which is devoid of any distinctive character and is excluded from registration under Sections 3(1)(b) and (c) 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 under Sections 3(1)(b) and (c) of the Act.

Dated this 28TH day of July 2001

CRAIG REDMORE
For the Registrar
The Comptroller General