

O-072-07

TRADE MARKS ACT 1994

AND

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996
IN THE MATTER OF INTERNATIONAL REGISTRATION No 852022
AND THE REQUEST BY AUGUST STORCK KG
TO PROTECT A TRADE MARK IN CLASS 30**

Background

1. On 28 April 2005, August Storck KG, Waldstasse 27, 13403 Berlin, Germany, on the basis of International Registration 852022, requested protection in the United Kingdom under the provisions of the Madrid Protocol of the following mark:



2. The colours white, light blue and brown are claimed and protection is sought in Class 30 in respect of:

Confectionery, chocolate and chocolate products, pastries

3. 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 provisional total 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 essentially of the device of a mouse being a representation of the goods. This would not be seen as a trade mark as it is devoid of distinctive character for confectionery goods in the form of a chocolate mouse. The other figurative elements are considered to be non-distinctive and unlikely to change the average consumer's perception of the mark.

4. Prior to requesting the hearing written submissions were filed which, in summary, suggested that the designation was free from an objection on absolute grounds because the mark consists of more than just a device of a mouse; it is a pictorial caricature of a brown mouse having a humanised face set on a blue background with a white cloud formation across the middle: this cannot be considered to be devoid of distinctive character for confectionery products. Reference was made to paragraph 8.1 of Chapter 3 of the Trade Marks Work Manual, which indicates that a mark which strongly *alludes* to characteristics of goods/services is not a proper basis for a Section 3(1)(b) objection. Finally state of the register submissions were made. The examiner was not persuaded by the submissions to waive the objection and indicated that the 'precedents' quoted were not on all fours with the current application.

The Hearing

5. At the hearing the holder's trade mark attorney, Mr Peters of WaltherWolff and Co, explained that the mark is not a representation of the goods. He provided me with a sample of the goods; these are individual wrapped chocolates which have the outline of a mouse imprinted upon them. Mr Peters told me that the mark applied for will appear on the front of the outer packaging of the goods and he opined that although the mark alludes to a characteristic of the goods, it is clearly not a representation of them; on that basis he concluded that the mark was distinctive and that the designation should be protected in the UK.

6. Although it is now clear that the mark applied for is not an actual representation of the holder's goods, I nevertheless expressed reservations about the capacity of the sign to guarantee the trade origin of the goods. I informed Mr Peters that I took this view because I am aware that there is a vast trade in the manufacture of novelty [animal shaped/imprinted] confectionery. Such confectionery, in the prima facie, does not normally individualise one trader's goods from another: it is more likely to be taken by the average consumer as either merely decorative or indicative of the shape of the product. To substantiate this view I gave Mr Peters examples of novelty confections, including mouse shapes, which I had obtained from the Internet. These show chocolates being presented in novelty shapes, chocolates with animal imprints and also chocolate animal shapes appearing on the packaging of the goods. I questioned therefore whether consumers would simply take the mark on packaging as an indication of the likely content i.e chocolate imprinted with or shaped like a mouse, the white 'cloud' device, in

my view, adds no trade mark character to the mark as a whole. I accepted that the actual confection sold differs from the depiction on the packaging, but I did not consider the fact that the mark is not actually a faithful representation of the holder's goods affected the position of assessing its capacity to distinguish for the purposes of Section 3(1)(b) of the Act. However, before finally making my decision, I asked Mr Peters to supply examples of the mark in use, under the provisions of Rule 57 of the TMR.

Rule 57 evidence and additional written submissions

7. Examples of the mark in use were filed together with a letter from Mr Peters dated 22 August 2006. This letter contained further details of the product which is sold under the trade mark; further submissions as to why Mr Peters considered that the mark is distinctive; submissions regarding the eligibility of animal representations as registered marks for confectionery and finally comments relating to the protection of the mark in Australia, Ireland, Denmark and the US.

8. Having had an opportunity to view the mark in use I was not persuaded that it was distinctive in the prima facie: the additional written submissions did not persuade me that it was either. In a written response, dated 31 August 2006, I informed Mr Peters that the objection under Section 3(1) (b) was maintained for the reasons that I gave at the hearing.

9. With regard to the submissions relating to the Registry's position regarding the acceptance of animal devices for confectionery, I advised Mr Peters that the Registry had no specific practice. Each case is assessed individually and due regard is given to how faithfully the mark depicts a representation or characteristic of the product. In this particular case the mark, in my view, depicts a chocolate mouse which is not sufficiently different from the norm to be capable of prima facie acceptance.

10. With regard to his submissions relating to the protection of the mark in other countries I informed Mr Peters that while decisions from other national tribunals/courts within the EU *may* be of persuasive value they are not binding upon us [affirmed by the ECJ in Henkel KGaA v Deutsches Patent Und Markenamt (C-218/01)]. Further I informed him that I did not consider that a decision from outside the EU can be determined as anything other than a matter of interest. This is because the factual position surrounding such acceptances is unknown and moreover the law governing acceptance in countries outside the EU may be materially different.

Notice of Refusal

11. Notice of total 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 Mark Rules 2000, to state in writing the grounds of my decision and the materials used in arriving at it.

12. No evidence that the mark has acquired a distinctive character through the use made of it has been put before me. My decision is therefore based on the prima facie case for registration.

The Law

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

“3.-(1) The following shall not be registered-

(b) trade marks which are devoid of any distinctive character,”

Decision

14. In *Henkel KGaA v Deutsches Patent – und Markenamt C-218/01* the ECJ identified the essential purpose of a trade mark

“30 As in the case of every other mark, the sign of which registration is applied for must fulfil the mark's essential function, which is to guarantee the identity of the origin of the marked product or service 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. For a 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 (see, in particular, Case C-349/95 *Loendersloot* [1997] ECR I-6227, paragraphs 22 and 24, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, and *Philips*, cited above, paragraph 30).”

15. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in *Joined Cases C-53/01 to C-55/01 Linde AG, Winward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

“37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods or services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (*see Case C-210/96 Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings."

16. Further guidance regarding the appropriate test for assessing the distinctive character in relation to confection marks can be found in the Judgment of the Court of Justice when determining an appeal against a judgment of the Court of First Instance in *August Storck KG v OHIM*, Case C-25/05 P. The following paragraphs appear to have particular relevance:

- 26 According to equally established case-law, the criteria for assessing the distinctive character of three-dimensional marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade mark (*see Henkel v OHIM*, paragraph 38, Case C-136/02 P *Mag Instrument v OHIM* [2004] ECR I-9165, paragraph 30, and *Deutsche SiSi-Werke v OHIM*, paragraph 27).
- 27 None the less, for the purpose of applying those criteria, the relevant public's perception is not necessarily the same in the case of a three-dimensional mark, which consists of the appearance of the product itself, as it is in the case of a word or figurative mark, which consists of a sign unrelated to the appearance of the products it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (*see, inter alia, Henkel v OHIM*, paragraph 38, *Mag Instrument v OHIM*, paragraph 30, and *Deutsche SiSi-Werke v OHIM*, paragraph 28).
- 28 In those circumstances, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of

indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94 (see, in particular, *Henkel v OHIM*, paragraph 39, *Mag Instrument v OHIM*, paragraph 31, and *Deutsche SiSi-Werke v OHIM*, paragraph 31).

17. That case-law, which was developed in relation to three-dimensional trade marks consisting of the appearance of the product itself, also applies where, as in the present case, the trade mark applied for is a figurative mark consisting of the two-dimensional representation of that product. In such a case, the mark likewise does not consist of a sign unrelated to the appearance of the products it covers.

Assessment of the mark

18. At the hearing and in his written submissions the focus of Mr Peter's arguments centred around the fact that the mark is not a representation of the goods but a distinctive trade mark. He described the mark as a pictorial caricature of a brown mouse having a humanised face set on a blue background with a white milk spill [originally described as a cloud] formation across the middle.

19. Mr Peter's submissions did not persuade me that the mark has the requisite distinctive character to be prima facie acceptable. Paragraph 6 above explains my reasons for this. Mr Peters did not dispute the examples from the Internet which demonstrated there is a trade in novelty animal confection. I therefore assume that this was accepted by Mr Peters. It is my view that the mark applied for is typical of the type of image commonly found on the packaging of confectionery to indicate to the consumer the kind of product being sold. It is my view that only repeated use of this mark is capable of educating consumers to the perception that it guarantees the origin of the goods.

20. I note that the mark is more than solely a depiction of a chocolate confection. The mark consists of a number of constituent parts, a brown mouse, a blue rectangular background and a milk spill or cloud device. It is established case law that distinctiveness must be assessed on appraisal of the mark as a whole [SAT.1 *SatellitenFernsehen GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-329/02 P* the ECJ]. Therefore, even if individually each of the constituent parts within the mark are considered to be non-distinctive it does not necessarily follow that the mark as a whole will lack distinctive character.

21. With that in mind I therefore asked myself the question whether there is anything distinctive in the way the individual elements are brought together and arranged. The mark has been filed in colour; white, light blue and brown are the colours claimed, I therefore have also taken this into account in reaching my decision. It is my view that there is nothing distinctive in the colours or arrangement of the constituent parts. A brown mouse represents a chocolate mouse in the context of the goods; in this trade they often have humanised faces to appeal to children. The 'milk spill', in my view, looks like a frame or background for carrying other matter such as a trade mark, or in the case of cakes a child's name etc. But even if a consumer were to see it as a 'milk spill', then in the

context of these goods it would merely serve to indicate that the goods are made from milk chocolate; the blue background does not add distinctive character to the mark as a whole; it is common for packaging of novelty confection to be presented in different colours as it is often marketed to appeal to children. That takes me onto the next consideration.

Who is the average consumer?

22. It is established that the assessment must be determined by reference to the likely reaction of an average consumer of the goods in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. In relation to these goods I consider the average consumer will primarily be children or adults who will probably be buying for children. Although some confections may be bought with some care, it is my view that the kind of confection sold under the holder's mark will not be bought with a high degree of care; it will not be a considered purchase. Therefore it is necessary for the mark to immediately impact as a trade mark. I have no doubt that a consumer would be attracted to the product because of its child appealing packaging, however I do not consider that they will be attracted to the mark as conveying a trade origin message.

23. Assessed as a whole and through the eyes of the average consumer I consider that the mark, in the prima facie, does no more than inform the relevant consumer, by visual means, that the goods sold under it are chocolate mice, chocolates decorated with the image of a mouse or goods decorated with chocolate mice. Chocolate mice are common in this sector of the market. Only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character and I do not consider that to be the case here.

Conclusion

24. I have taken into account all the written and oral submissions which have been made to support the protection of this designation but, for the reasons given, I have not been persuaded that the mark is prima facie distinctive. The designation is therefore refused protection in the UK under the terms of Articles 3, 9(3) and 11(5) of the Trade Marks (International Registration) Order 1996 (as amended) because it fails to qualify under Section 3 (1)(b) of the Act.

Dated this 7th day of March 2007

**Lynda Adams
For the Registrar
The Comptroller-General**

