

O/306/12

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2581706  
IN THE NAME OF AIMIA FOODS LIMITED

AND

OPPOSITION THERETO UNDER NO 102334  
BY WEETABIX LIMITED

## Background

1. Application no 2581706 seeks registration of the trade mark PORRIDGEBREAK in respect of *Porridge oats, cereals*. It stands in the name of Aimia Foods Limited (“Aimia”) and has a filing date of 18 May 2011.
2. Following publication of the application in the *Trade Marks Journal* on 10 June 2011, notice of opposition was filed on behalf of Weetabix Limited (“Weetabix”). The opposition is based on grounds founded upon sections 3(1)(b) and (c) of the Act. Weetabix claims the mark consists of generic words which do not create a trade mark which is sufficiently distinctive for the purpose of securing a trade mark registration and that it provides a clear descriptive meaning in relation to the goods applied for and would not indicate the commercial origin of the goods.
3. Aimia filed a counterstatement in which it denies each of the grounds of opposition.
4. Weetabix filed evidence and Aimia filed written submissions. Neither party sought to be heard and therefore I give this decision from the papers before me.

## The evidence

5. Weetabix filed evidence in the form of a witness statement, dated 2 February 2012, from Sonia Hill. Ms Hill is a trainee trade mark attorney with Marks & Clerk LLP, Weetabix’s legal representatives in these proceedings.
6. Ms Hill’s witness statement serves merely to introduce a number of exhibits:

SH1: This is an extract from a report published by South Downs College in Hampshire. It is entitled „Self-Assessment Report 2009-2010’. In paragraph 1 of the report, the college is described as the largest further education college in Hampshire. The extract from the report exhibited is taken from a section entitled “Be healthy. Are learners able to make informed choices about their own health and well-being?” At paragraph 48 is included the following: “Learners on Catering and Hospitality courses who start before 8.00am enjoy a mid-morning porridge break to increase stamina and motivation”.

SH2: An extract taken from the MailOnline blogsite-Femail Boards. The extract shows an entry posted on 27 February 2010. The (unidentified) poster has written “morning all. Just in for a much needed porridge break with a large coffee please....thats if any left...?”.

SH3: An extract taken from the blogsite urban75.net. Under the title “breakfast patrol-whatchoo having?” the blogger “sparkling” posted, on 3 February 2005, “Had a porridge break today and had a lovely organic egg with whole meal toasted soldiers....lovely”.

SH4: A newsletter dated May 2011 and taken from spambiking.co.uk (for members of the Salisbury Plain Area Mountain Bike Club). In an article reviewing a cycle ride, the author writes “Initial reluctance in the legs soon

eased and with a porridge break after lap 12, I managed to get my tally up to 14; which I was pretty pleased with.”

SH5: An extract from the blogsite “The Gastronomical Me-Russo-Soviet food, Voluptuous stories, fat and offal-from a Russian snuggled in the Big Old Smoke”. In a post dated 26 August 2010, „Alexei Evstafiev’ writes: “As ever, your post is something that goes so well with my tea and porridge break”;

SH6: An extract from the Ventnorblog.com website. In response to an article entitled “Richard Beardsall will attempt solo Round-Island Charity Swim tonight”, posted on 5 September 2009, „James P’ wrote, the following day: “It says he is doing zero knots. Does that mean he’s on a porridge break...?”

SH7: An extract from the educatethekids.com website which contains an article posted on 17 August 2010 entitled “Meet the Kids; Adam”. The article contains a sentence which reads “During porridge break this morning I sat under a tree doing some book work and when I looked up noticed this little one standing on his own staring at me.”

SH8: An extract taken from the digitalspy.co.uk website blog. Under the discussion thread entitled “gorgeous Mark Ramprakash (Part 8)”, „cc\$tom’ posted, on 12 March 2007, “Morning all-porridge break! Listening to Ride of the Valkyries and dreaming of sweeping Mark off on my horse (not Tess!!!) and carrying him off to Valhalla for some quaffing and roistering.”

SH9: An article from the Wakefield Express website. The article, entitled “Teacher bound for Africa”, published on 30 January 2007, has been printed in such a way that part of the text is missing which leads to it being difficult, in places, to understand. A sentence in the article reads as follows: “The pupils over there have a totally different regime from children here, including sta porridge break at 10am, and leaving school at 11am”)

SH10: An extract taken from a blog entitled “Monday morning” posted on the Weightwatchers.co.uk website. On 23 January 2012, “Mrsstoves” posted “hi peeps. working today – just stopped for a porridge break :-)”

SH11: An extract from the flickr.com photosharing website. The extract shows a photograph taken on 8 July 2007 in “Eastern KE” and posted under the heading “Porridge break for several classes this morning”.

SH12: Another extract from the flickr.com photosharing website. The photo, taken on 6 November 2009 in “Kamuli UG” is posted under the heading “Porridge Break”.

7. No further evidence was filed.

## Decision

8. The opposition is brought on grounds under section 3 of the Act, the relevant parts of which state:

“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 indication 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.”

9. In its notice of opposition, Weetabix state, in relation to its objection under section 3(1)(b) of the Act:

“...the trade mark applied for consists of generic words which do not create a trade mark which is sufficiently distinctive for the purpose of securing a trade mark registration.

The applicant’s mark does not contain any additional distinctive element or a figurative element, which may have elevated the trade mark to an acceptable level of distinctiveness. Furthermore, the goods in question are not such that the average consumer will take their time when considering purchasing the product offered by the applicant and they will not recognise the trade mark as indicative of the trade origin of the goods in question as originating from the Applicant. The average consumer will merely perceive the mark PORRIDGEBREAK as referring to “porridge to eat during a break” and the trade mark applied for is, therefore, unable to fulfil its essential trade mark function: to indicate the origin of the goods.

10. In relation to its objection under section 3(1)(c) of the Act, in its statement of grounds, Weetabix says:

“8. The trade mark applied for consists of two elements which are defined in the Oxford English Dictionary as follows:

*“PORRIDGE –A dish consisting of oatmeal or another meal or cereal boiled in water or milk to a thick consistency.*

BREAK –*A short spell of recreation or refreshment in a period of work, etc.*”

9. Accordingly, the trade mark applied for indicates that the product is a dish consisting of oatmeal or another meal or cereal boiled in water or milk to a thick consistency, to consumer during a short spell of refreshment in a period of work.

10. The Opponent submits that for a finding that a trade mark is descriptive in relation to the specific goods or services, there must be a sufficient direct and specific relationship between the sign and the goods and services in question to enable the relevant public concerned to immediately, without further thought, perceive a description of the category of goods and services in question or one of their characteristic (Case T-67/07, *Ford Motor Co v OHIM*). In this instance, the Opponent submits that there is a clear relationship between the mark PORRIDGEBREAK and the goods “Porridge oats, cereals”, which immediately informs the relevant public that the goods in question is porridge to consume during a break from work, etc.

11. The Opponent submits that the trade mark applied for provides a clear descriptive meaning in relation to the goods applied for and is not able to fulfil the basic function of the trade mark, namely to indicate the commercial origin of the goods.

12. The public interest underlying s 3(1)(c) is that no exclusive rights should be created in purely descriptive terms which other traders might wish to use and that terms which have a purely informational value, should not be reserved for one single trader. The trade mark applied for conflicts with the public’s interest in this instance and, consequently, falls foul of s 3(1)(c).

13. It is conceivable that other traders may wish to use the trade mark applied for to refer to their particular goods. The term “Porridge break” is an ordinary way of referring to the consumption of the goods in question. The mark PORRIDGEBREAK is not a syntactically unusual juxtaposition, but is a familiar expression within the English language. The fact that the words “PORRIDGE” and “BREAK” are conjoined does not endow the trade mark with the minimum degree of distinctiveness required for registration.

14. It should also be borne in mind that it is not necessary for a sign to be in current use as a description before it is susceptible to a descriptiveness objection. It is sufficient that a sign is capable of being used as a designation of the goods or services .... Thus, it should also be considered whether third parties are likely to use the trade mark applied for in order to describe the characteristics of the goods or services covered by the trade mark applied for.

15. Consequently, the Opponent submits that the trade mark PORRIDGEBREAK, taken as a whole, is devoid of any distinctive character and will be perceived as descriptive and non-distinctive in respect of the goods covered. As such, it is not capable of distinguishing the goods for which

registration is sought from those of other undertakings and should be refused registration pursuant to s 3(1)(b) and s 3(1)(c) of the Trade Marks Act 1994”.

11. For its part, Aimia states, in its counterstatement:

“The fact that the words “porridge” and “break” taken as separate elements have a meaning in the English language is irrelevant because when they are combined together they have no meaning. The word “porridge has absolutely no relationship with the word “break” and the trade mark PORRIDGEBREAK is a fanciful combination of words.”

12. It goes on to say:

“The trade mark consists of one fanciful word and the fact that it consists of one word adds to its distinctive character. The Opponent asserts that the trade mark consists of a term that is an ordinary way of referring to the consumption of the goods in question. However the Applicant strongly disagrees with this view as there is no such phrase or term in the English language as “porridgebreak....”

13. In its written submissions, Aimia comments on the exhibits attached to Ms Hill’s witness statement and notes that they amount to “*12 alleged descriptive uses of the mark in suit in between the period 2005-2012*” and contends that twelve incidents over an eight year period is “*insufficient to demonstrate that use of the mark in suit is devoid of any distinctive character or may serve in trade to designate a characteristic of the goods*”. It submits that exhibits SH4, SH7, SH10, SH11 and SH12 should not be taken into account as they either date from after the relevant date or refer to activities outside the UK. Excluding those documents, it submits, leaves “*evidence that the mark in suit may have been used once a year in an allegedly descriptive manner by an organisation or individual [which] is insufficient to support*” an objection under section 3(1)(b) or (c) of the Act.

14. Whilst the opposition is based on grounds under section 3(1)(b) and (c), I intend to consider the objection under section 3(1)(c) in the first instance.

15. In *JanSport Apparel Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-80/07*, the General Court (GC) gave a helpful summary of the considerations to be taken into account in relation to Article 7(1)(c) of the regulation (that being the equivalent of section 3(1)(c) of the Act. It said:

“18 Under Article 7(1)(c) of Regulation No 40/94, „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 or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’ are not to be registered. In addition, Article 7(2) of Regulation No 40/94 (now Article 7(2) of Regulation No 207/2009) states that, „paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community’.

19 By prohibiting the registration of such signs, that article pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 31).

20 Furthermore, the signs covered by Article 7(1)(c) of Regulation No 40/94 are signs regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquired the product or service to repeat the experience, if it proves to be a positive, or avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (Case T-219/00 *Ellos v OHIM (ELLOS)*[2002] ECR II-753, paragraph 28, and Case T-348/02 *Quicj v OHIM (Quick)* [2003] ECR II-5071, paragraph 28).

21 The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought (see the judgment of 9 July 2008 in Case T-323/05 *Coffee Store v OHIM (THE COFFEE STORE)*, not published in the ECR, paragraph 31 and the case-law cited). Accordingly, a sign's descriptiveness can only be assessed by reference to the goods or services concerned and to the way in which it is understood by the relevant public (Case T-322/03 *Telefon & Buch v OHIM-Herold Business Data (WEISSE SEITEN)* [2006] ECR II-835, paragraph 90).

22 It follows that, for a sign to be caught by the prohibition set out in that provision, there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see Case T-19/04 *Metso Paper Automation v OHIM (PAPERLAB)* [2005] ECR II-2383, paragraph 25 and the case-law cited).

23 It must finally be pointed out that the criteria established by the case-law for the purpose of determining whether a word mark composed of several word elements is descriptive or not are identical to those applied in the case of a word mark containing only a single element (Case T-28/06 *RheinfelsQuellen H. Hövelmann v OHIM (VOM URSPRUNG HER VOLLKOMMEN)* [2007] ECR II-4413, paragraph 21).

16. The Court of Justice of the European Union (CJEU) in *Koninklijke KPN Nederland NV v Benelux Merkenbureau* Case C-363/99 stated:

“98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the

purposes of Article 3(1)(c) of the Directive. Merely bringing together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.”

“102. It is also irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. The wording of Article 3(1)(c) of the Directive does not draw any distinction by reference to the characteristics which may be designated by the signs or indication of which the mark consists. In fact, in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially.”

17. In support of its objection under section 3(1)(c) of the Act, Weetabix has provided dictionary references for the words porridge and break. There is no dispute as to these separate definitions, however, establishing these definitions separately is not decisive. In *PutterScope* BL O/96/11, the appointed person said:

“8.....Although I agree that it necessary for the purpose of explanation to break down the mark into its component parts, one must be aware of the danger that such an iterative approach may be unfair to the applicant. Each individual part of a mark may be non-distinctive, but the sum of the parts may have distinctive character – see *Satelliten Fernsehen GmbH v OHIM* [2005] ETMR 20 [SAT 1], at paragraph 28. Ultimately the decision making tribunal must stand back from the detailed breakdown of the mark and envisage how the entire trade mark would be understood by the public when applied to the goods of the specification. Would the average consumer consider that it was a trade mark indicating goods from a particular source or would they consider that it simply indicated the function of the goods?”

18. Establishing a descriptive meaning for the words porridge and break separately, therefore, does not mean that Weetabix’s opposition to the application automatically succeeds. I have to consider whether „the sum of the parts’ has a distinctive character to the average consumer, who in this case, given the goods involved, will be a member of the general public.

19. Finally, in *Alcon Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-192/03 P* it was held that use after the date of the application could be used to draw conclusions as to the position at the date of application. Such use can also go to the issue of foreseeability in relation to use of the term (see *Wm Wrigley Jr Company Case C-191/01P*).

20. Whilst there is no evidence that porridgebreak is a dictionary word, Weetabix submit the mark is descriptive of “porridge to consume during a break from work”. The difficulty with this submission is that porridge is a foodstuff with a very long tradition of being eaten for breakfast. Breakfast is not a meal described in ordinary language for consumption during „a break’ but is, instead, the first meal eaten after



waking and before the active part of the average consumer's day begins. The average consumer will be aware of, and indeed familiar with this. Whilst „coffee break' and „tea break' are well established terms, the same cannot be said for the mark in suit.

21. Weetabix has filed evidence in support of its claims, however, some date from after the relevant date (SH10), others refer to activities outside the UK (e.g. SH7 and SH9) or its country of origin is not clear (e.g. SH11). Many of the extracts are taken from weblogs, some of them particularly obscure (e.g. SH3 and SH5). In any event, each of the exhibits do not show the mark as applied for but instead show the words porridge and break separately and none show that use specifically in relation to the goods of the application (SH3, for example, refers to the blogger having egg and soldiers). I do not consider the evidence is in any way sufficient to make good the claims made by Weetabix and thus the objection to the application founded on section 3(1)(c) of the Act fails.

### **The objection under section 3(1)(b) of the Act**

22. Weetabix's objection under this ground is based on no wider an objection than that which is raised under section 3(1)(c) of the Act: it claims that the average consumer will perceive the mark as referring to "porridge to eat during a break". Weetabix's position is no stronger under this ground and, in view of my finding in relation to the objection under section 3(1)(c) of the Act, I find it also fails under this ground.

### **Summary**

23. The opposition fails on each of the grounds under which it has been brought.

### **Costs**

24. Aimia has been successful and is entitled to an award of costs in its favour. I take into account that it filed no evidence itself, and the evidence filed by Weetabix was brief in the extreme. I also note that no hearing took place. I make the award on the following basis:

Preparing a counterstatement and considering the statement of case:	£400
Filing submissions:	£300
<b>Total:</b>	<b>£700</b>

25. I order Weetabix Limited to pay Aimia Foods Limited the sum of £700. This sum should 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 7<sup>th</sup> of August 2012**

**Ann Corbett  
For the Registrar  
The Comptroller-General**