

O-045-18

In the matter of UK Trade Mark Application No.3100534 ('Eden Chocolat be more chocstanza' (word & device)) in Class 30 in the name of Duebros Limited (the Applicant)

and

Opposition No. 404645 by Heirler Cenovis GmbH (the Opponent)

and

In the matter of an Appeal to the Appointed Person by the Applicant against the Decision of the Hearing Officer O-181-16 for the Registrar, The Comptroller General dated 8 April 2016

FINAL DECISION

1. In my interim decision O-547-17 dated 27th October 2017 I reached a concluded view as to whether the Opposition succeeded or failed in relation to the majority of the goods in issue.
2. At §87 I stated my conclusion that the opposition succeeded in relation to the following goods: *cocoa, and, in so far as the following goods contain or are flavoured chocolate: preparations made from cereals and confectionery, prepared meals (desserts), pies (desserts), edible ices; preparations made from pastry.*
3. At §88, I stated my conclusion that the opposition failed in relation to the following goods: *coffee, sugar, artificial coffee, honey, treacle, tea, rice, tapioca, sago, vinegar, sauces (condiments), mustard, flour, yeast, baking powder, sandwiches, prepared meals (savoury), pizzas, pies (savoury) and pasta dishes; preparations made from bread; ice, salt, spices.*
4. That left, in §89, a limited but general category of goods in respect of which I considered there was no objection under either ss.5(2) or 5(3) of the Act namely: *preparations made from cereals and confectionery; prepared meals (desserts); pies (desserts); edible ices; preparations made from pastry; where such goods neither contain chocolate nor are flavoured chocolate.*
5. I then said this:

O-045-18

89.In Case C-363/99 POSTKANTOOR at [117] the CJEU ruled that the Trade Marks Directive prevents a trade mark registration authority from registering a mark for certain goods and services on condition they do not possess a particular characteristic.

90. It seems to me there are two ways to avoid the POSTKANTOOR problem in this case. First, the Appellant/Applicant may be able to propose more specific goods which (a) fall into the general category specified in Paragraph 89 above (b) avoid the application of my finding of indirect confusion above and (c) avoid being specified by reference to a characteristic that they do not possess.

6. Accordingly I invited the Applicant, if it so wished, to propose a specification of which met those three conditions and set a timetable for submissions from the Applicant and Opponent. That timetable expired without any communication from the Applicant. However, just as I was embarking on writing my final Decision, I received reasoned submissions from the Applicant dated 17th December 2017. According to my timetable, the Opponent then had 2 weeks to respond but the Opponent's representatives were kind enough to pass a message before the Christmas break that they had no observations to make on the Applicant's submissions. Accordingly, I turn to consider the Applicant's proposal.
7. In essence, the Applicant's submission makes a two part proposal:
 - 7.1. To amend the specification to the following: *prepared meals (especially cake and truffle shaped desserts with a base of rare exotic beans and seeds extract, woody flavours and spices), edible ices (especially those containing extracts from exotic beans and seeds, woody flavours and spices) and confectionery made from rare exotic beans and seeds, with base of woody flavours and spices.*
 - 7.2. To remove from the application the following goods: *cocoa, preparations made from cereals and confectionery, prepared meals (desserts), pies (desserts), edible ices, preparations made from pastry;*
8. This imaginative proposal suffers from a number of problems:
 - 8.1. First, the use of the word 'especially' does not limit 'prepared meals' or 'edible ices' in any way. However, in view of the second part of the proposal, I go on to consider the position if the word 'especially' was replaced by 'namely'.

O-045-18

- 8.2. Second, although ‘confectionery’ is limited by ‘made from rare exotic beans and seeds, with base of woody flavours and spices’, this qualification embraces at least some if not all cocoa beans, which are, of course, used to make chocolate. So the emphasis in the proposed amended specification on ‘rare exotic beans and seeds extract, woody flavours and spices’ embraces at least goods which contain chocolate or are flavoured chocolate. This problem applies to ‘prepared meals’ and ‘edible ices’ whether I replace ‘especially’ with ‘namely’ or not.
9. It will be recalled that the invitation I extended to the Applicant was to propose more specific goods which (a) fell into the general category I mentioned in §89, namely: *‘preparations made from cereals and confectionery; prepared meals (desserts); pies (desserts); edible ices; preparations made from pastry; where such goods neither contain chocolate nor are flavoured chocolate’*; (b) avoided the application of my finding of indirect confusion (in §§82 & 84 i.e. cocoa and goods which contained or were flavoured chocolate) and (c) avoided being specified by reference to a characteristic they do not possess. Whilst the Applicant’s proposal fulfils condition (c), it plainly does not fulfil either conditions (a) or (b). Indeed, the Applicant’s proposal is the very antithesis of what conditions (a) and (b) required.
10. As I stated at the end of §90, if or to the extent that the Applicant does not specify specific goods which meet conditions (a) (b) and (c) above, then the opposition will succeed in relation to the category of goods in question.
11. Accordingly, this Appeal fails and the opposition succeeds in relation to the following goods: coffee, cocoa, sugar, artificial coffee, honey, preparations made from cereals and confectionery, prepared meals (desserts), pies (desserts), edible ices; preparations made from pastry; treacle.
12. In accordance with §88 of my interim decision, this Appeal succeeds and the opposition fails in relation to the following goods: tea, rice, tapioca, sago, vinegar, sauces (condiments), mustard, flour, yeast, baking powder, sandwiches, prepared meals (savoury), pizzas, pies (savoury) and pasta dishes; preparations made from bread; ice, salt, spices.

O-045-18

Costs

13. In §91 of my interim decision, I made a preliminary indication of what I was minded to order by way of the costs of this Appeal. In the Applicant's submission of 17th December 2017, exception was taken to my statement that the Applicant was not professionally represented, as if this was a slight on the Messrs Stancu. As I said in §6 of my interim decision, the Applicant was ably represented by Mr Stamate Iulian Stancu, assisted by his brother, Mr Cornel Stancu, so no slight was intended or should have been perceived. Leaving those matters aside, in its submission, the Applicant did not suggest any specific award of costs. Instead, I was invited to consider the amounts stipulated in TPN 4/2007, Annex A.

14. I have come to the clear conclusion that none of the submissions made by the Applicant cause me to depart from my preliminary indication. Accordingly, I make no order as to the costs of this Appeal.

JAMES MELLOR QC

The Appointed Person

19th January 2018