

O-160-05

**TRADE MARKS ACT 1994
AND
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 816934
AND THE REQUEST BY LOOK-O-LOOK INTERNATIONAL B.V.
TO PROTECT A TRADE MARK IN CLASS 30**

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Background

1. On 25 September 2003 Look-O-Look International B.V. of Geurdeland 5, NL-6673 DR Andelst, Netherlands on the basis of International Registration No. 816934 requested protection in the United Kingdom, under the provisions of the Madrid Protocol, of the trade mark:



2. The application was made in respect of the following goods:

Class 30 Cocoa and cocoa products; chocolate, chocolate products and chocolate drinks; pastry and confectionery, caramel and caramel products, mint for confectionery, peppermint sweets; sweets, liquorice (confectionery) and liquorice products (confectionery); ice; snacks not included in other classes.

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 Refusal was given because the mark is excluded from registration by Section 3(1)(b) of the Trade Marks Act 1994 because the mark is a sign which is devoid of any distinctive character because it suggests products of exceptional quality and value.

4. At a hearing, at which the applicant was represented by Mr Gold of Kilburn & Strode, their trade mark attorneys, the objection was maintained.

5. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

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

The Law

7. 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,”

The case for registration

8. In correspondence prior to the hearing and at the hearing itself Mr Gold made the following submissions in support of this application:

The words YOU WON'T BELIEVE YOUR EYES constitute a phrase which is well known within the United Kingdom but that the use of the phrase in relation to the goods for which registration is sought is unusual.

The mark does not consist solely of the words themselves. The letters are not uniform in their presentation and appear somewhat jumbled in what Mr Gold referred to as "a dancing script".

The two letter O's have each been replaced by devices of eyes which enhances the effect of the stylisation.

The same mark has been accepted by the Irish Patents Office and the foreign language equivalents have been accepted by the trade mark registries in Benelux, France and Switzerland (in German).

Mr Gold referred me to the ECJ's decision in Case C-64/02, *OHIM v. Erpo Möbelwerk*, often referred to as "The Principle of Comfort" case. In particular Mr Gold drew my attention to paragraphs 33, 34 and 35 which indicates that the same test must be applied to all types of marks but emphasises that the relevant public's perception is not necessarily the same for all categories of marks.

Decision

9. The test to be applied in respect of this application is not whether the mark, in its totality, is a combination which is used in common parlance to describe the services applied for but whether the mark, again in its totality, is devoid of any distinctive character. The whole purpose of Section 3(1)(b) of the Act is to prohibit registration of signs which, although not caught by the clear parameters set out by Section 3(1)(c) and (d) of the Act are, nevertheless, incapable of distinguishing the goods and services of one undertaking from those of other undertakings.

10. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently 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, Windward 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 and 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).
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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."

11. Guidance on the examination of slogans is available in Chapter 6 of Trade Mark Registry Work Manual at paragraph 32 where it states:

Slogans are registrable as trade marks provided that they have the capacity to individualise the goods or services of one undertaking because they are not comprised of signs or indications which directly describe the goods or services or their essential characteristics, and are not devoid of distinctive character for any other reason.

In assessing whether "Das Prinzip Der Bequemlichkeit" ["The Principles of Comfort"] is devoid of any distinctive character, the CFI stated that:

".....it is clear from the case-law of the Court of First Instance that lack of distinctiveness cannot be found because of lack of imagination or of an additional element of originality.....Furthermore, it is not appropriate to apply to slogans criteria which are stricter than those applicable to other types of sign."

The CFI confirmed, in paragraph 46 of its judgement, that it is appropriate in determining whether the slogan mark is devoid of any distinctive character, to consider, in particular, the use of the mark in advertising the goods or services listed in the application.

In this regard, the CFI also found the trade mark REAL PEOPLE, REAL SOLUTIONS, T-130/01, to be open to objection under Article 7(1)(b) of Regulation 40/94 (corresponding to Section 3(1)(b) of the Act) because the relevant public would not perceive the mark as indicating the goods and services of an individual undertaking, but merely as promotional information. The average consumer for the services in this case (for computer services) is likely to be attentive and, therefore, it follows that if a mark fails to strike more than a merely promotional chord in the attentive average consumer's consciousness, it will not do so either in areas of trade where less attention is likely to be given. The Court said that the average consumer will not pay attention or enquire into a mark's possible meanings if, on first impression, the slogan presents simply a promotional abstract message, in this case *real* [computing] *solutions* designed by [or for] *real people*.

12. It is essential that the distinctive character of a trade mark is assessed in relation to the goods for which the applicant seeks registration. The specification for which registration is sought covers a range of goods in Class 30 which are essentially edible products.

13. I must, of course, assume fair and notional use of the mark in relation to the provision of the goods applied for. Such use includes use in advertising wherein it is customary for advertisements to use abbreviated language, a notion endorsed by Mr Simon Thorley QC sitting as the Appointed Person in "Where all your favourites come together" – see BL 0/573/01.

14. I accept that the test for registering slogans is no different than for any other type of marks but as slogans are often used for advertising purposes they may not be so readily accepted by the general public as an indication of trade source as would more traditional signs such as words, brands, logos and figurative marks (see the Judgement of the Court of First Instance in "REAL PEOPLE REAL SOLUTIONS" – Case T-130/01 5 December 2002). I also accept that lack of originality per se is not fatal to the outcome of the application for registration.

15. The trade mark applied for must be assessed by reference to how the mark is perceived by the relevant consumer who, in respect of the goods contained within the specification applied for are, in my view, the general public, including confectionery buying children.

16. The words themselves are common dictionary words which are in everyday use within the United Kingdom. Mr Gold has suggested that these words would not be used, in trade, in relation to the goods applied for but I do not accept this. The goods, which include confectionery, are goods which may easily be promoted and advertised through the use of slogans. The average consumer, who I consider to be both adults and children, when encountering this mark used in relation to the goods applied for are likely to perceive the mark as a slogan indicating that something of exceptional quality or value is being offered.

17. I find support for this in a decision by The Court of First Instance – Case T-281/02, *Norma Lebensmittelfilialbetrieb GmbH & Co KG v. OHIM (Mehr fur Ihr Geld)* at paragraphs 31 and 32:

“31. In that regard, the applicant’s argument that the consumer is told nothing about the content or nature of the goods offered under the mark is irrelevant, because he does not know to what the word “more” relates. For a finding that there is no distinctive character, it is sufficient to note that the semantic content of the word mark in question indicates to the consumer a characteristic of the product relating to its market value which, whilst not specific, comes from promotional or advertising information which the relevant public will perceive first and foremost as such, rather than as an indication of the commercial origin of the goods (see, to that effect, REAL PEOPLE, REAL SOLUTIONS, paragraphs 29 and 30). In addition, the mere fact that the word mark “Mehr fur Ihr Geld” does not convey any information about the nature of the goods concerned is not sufficient to make that sign distinctive (see, to that effect, BEST BUY, paragraph 30).

32. Furthermore, there is nothing about the mark applied for “Mehr fur Ihr Geld”, that might, beyond its obvious promotional meaning, enable the relevant public to memorise it easily and instantly as a distinctive trade mark for the goods designated. Even if the mark applied for were used alone, without any other sign or trade mark, the relevant public could not, in the absence of prior knowledge, perceive it otherwise than in its promotional sense (REAL PEOPLE, REAL SOLUTIONS, paragraph 28).”

18. I acknowledge that this mark is more than plain words. I must consider the stylisation which is present in this mark. The letters vary in their presentation and the two letter O’s are replaced by two devices of eyes. The question to be answered is - “Is the stylisation sufficient to bestow distinctive character upon this mark?”. In assessing this I bear in mind that advertisements promoting goods such as confectionery are often directed at children whether they are the final purchaser of the product or not. Even if a third party is actually purchasing the goods it is well known that advertisements are often directed at children in order that they will persuade the third party to purchase the goods in question. I do not consider that the presentation of the letters within the words are particularly different or memorable. The two devices of eyes seem to reinforce the meaning of the words and link back to the final word EYES. The mark is easily interpreted as being YOU WON’T BELIEVE YOUR EYES and the devices do not detract from the message provided by the words, they merely reinforce that meaning. In my view this perception will not be changed by the presence of the stylisation which I accept is present in this mark.

19. Mr Gold provided me with details regarding the acceptance of this mark in English and in other languages by other European trade mark registries. However, I am not aware of any of the circumstances surrounding any of these acceptances and I do not accept that they are influential in deciding the issues of this application. Furthermore, I have found that the words YOU WON’T BELIEVE YOUR EYES constitute a well known phrase within the United Kingdom but there is no information as to how well known this phrase is, either in English or other languages, in other European countries.

20. I find support for this in a decision by the European Court of Justice in Case C-218/01 *Henkel KGaA v. Deutsches Patent-und Markenamt* at paragraphs 61 to 65:

- “61 The competent authority of a Member State may take account of the registration in another Member State of an identical trade mark for products or services identical to those for which registration is sought.
- 62 However, it does not thereby follow that the competent authority of a Member State is bound by the decisions of the competent authorities of the other Member States, since the registration of a trade mark depends, in each specific case, on specific criteria, applicable in precise circumstances, the purpose of which is to demonstrate that the trade mark is not caught by any of the grounds for refusal of registration set out in Article 3(1) of the Directive.
- 63 In that connection, whilst registration of an identical trade mark for identical goods or services effected in one Member State constitutes a circumstance which may be taken into consideration by the competent authority of another Member State among all the facts and circumstances which it is appropriate to take into account, it cannot, however, be decisive as regards the latter authority’s decision to grant or refuse registration of a given trade mark.
- 64 As to whether it is necessary, when distinctive character is assessed under Article 3(1)(b) of the Directive, to undertake administrative investigations to determine whether and to what extent similar trade marks have been registered in other Member States, it need merely be borne in mind that the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar mark for goods or services similar to those in respect of which the first trade mark was registered (judgment delivered today in Case C-363/99 *KPN* [2004] ECR I-0000, paragraph 44).
- 65 The answer to the third question must therefore be that the distinctive character of a trade mark within the meaning of Article 3(1)(b) of the Directive may be assessed solely on the basis of national trade usage, without any need for other administrative investigations to be undertaken in order to determine whether and to what extent identical trade marks have been registered or have been refused registration in other Member States of the European Union.

The fact that an identical trade mark has been registered in one Member State as a mark for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is

not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered.”

21. I am not persuaded that the trade mark applied for is distinctive in that it would serve in trade to distinguish the goods and services of the applicant from those of other traders. In reaching this conclusion I have considered the mark in its totality placing due weight on the letters and words themselves in conjunction with the stylisation which is present in the mark. In my view the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

Conclusion

22. In this decision I have considered all the documents filed by the applicants 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 Section 3(1)(b) of the Act.

Dated this 15th day of June 2005

**A J PIKE
For the Registrar
The Comptroller-General**