

TRADE MARKS ACT 1994.

IN THE MATTER OF:

APPLICATION No. 81895

IN THE NAME OF MILK LINK LTD

FOR A DECLARATION OF INVALIDITY

IN RESPECT OF

TRADE MARK REGISTRATION No. 2047388

IN THE NAME OF ALMIGHTY MARKETING LTD

D E C I S I O N

1. The designation **MOO JUICE** was registered under number 2047388 with effect from 4 December 1995 as a trade mark for use in relation to *‘milk; milk beverages; flavoured milk; milk products; yoghurt; drinking yoghurt; flavoured yoghurt’* in Class 29. The registration stands in the name of Almighty Marketing Ltd (*‘the Proprietor’*).

2. On 21 October 2004 Milk Link Ltd (*‘the Applicant’*) applied under Section 47 of the Trade Marks Act 1994 for a declaration that the Proprietor’s trade mark was invalidly registered:

(1) under Section 3(6) of the Act, on the ground that the request for registration had been made in bad faith;

- (2) under Section 3(1)(b) of the Act, on the ground that the designation **MOO JUICE** was descriptive of ‘milk’ and therefore ‘devoid of any distinctive character’
- (3) under Section 3(1)(c) of the Act, on the ground that the designation **MOO JUICE** was descriptive of and used in common parlance as slang for ‘milk’ and so consisted exclusively of a sign or indication which may serve in trade ‘to designate the kind of goods’ for which registration had been sought and obtained;
- (4) under Section 3(1)(d) of the Act, on the ground that the designation **MOO JUICE** was used in common parlance as slang for ‘milk’ and so consisted exclusively of a sign or indication which was in relevant respects ‘customary in the current language’.

3. Both sides filed evidence. Neither side requested a hearing. The application for a declaration of invalidity was therefore determined on the basis of the papers on file. The Registrar’s hearing officer, Mr. David Landau, rejected the application in its entirety for the reasons he gave in a written decision issued under reference BL O-070-06 on 15 March 2006. He ordered the Applicant to pay £1,750. to the Proprietor as a contribution towards its costs of the Registry proceedings.

4. The objection under Section 3(6) was not pursued. There was a suggestion on the part of the Proprietor that the Applicant had questionable motives for seeking a declaration of invalidity. The hearing officer dealt with that suggestion summarily: *‘There is no abuse of process in the application, as far as I can see’* (paragraph 15). He determined the application on the basis that the material date for testing validity was 4

December 1995, that being the date with effect from which the contested registration had been granted.

5. He summarised his findings with reference to the evidence in the following terms:

On the basis of the evidence before me I do not consider that MOO JUICE is in common parlance in the United Kingdom as a synonym for milk, and was not at the material date. Nor do I consider that MOO and JUICE, in the United Kingdom, have been established as synonyms for cow and milk respectively either with the average consumer or the trade. The evidence shows MOO JUICE is a phrase that has been used in North America; how pervasive that use is, I cannot tell. (paragraph 23)

In this case it has not been established that at the material date, or at the date of the completion of the registration process, that MOO JUICE has been used customarily in relation to milk and milk related products. Indeed, if a negative were to be proved, it is that MOO JUICE is not customarily used in relation to such goods. (paragraph 24)

Most of the evidence has dealt with American usage. American and British English do diverge; they may use the same words meaning different things. In such cases it may be necessary to view the languages as being different languages. Such is the case here. There is no indication that the British public has been exposed to the phrase MOO JUICE in such a manner that it will have seen it as a synonym for milk. The best that Link can muster to support its case is one incidence in one television programme. (paragraph 32)

6. The objection under Section 3(1)(d) necessarily failed in the light of these findings. With regard to the remaining objections under Sections 3(1)(c) and 3(1)(b) the hearing officer decided as follows:

....The trade mark takes the onomatopoeic sound of a cow's lowing with the word that, in the context of beverages, relates to the liquid extracted from fruits or vegetables. By consideration of the goods and the trade mark it will be seen

as an amusing, cryptic allusion to the goods. However, it is far more a crossword clue than anything approaching a description. In the absence of evidence of any knowledge in the trade of the term (as per the section 3(1)(d) of the Act analysis), I do not consider that the trade mark consists exclusively of a sign that designates some characteristic of the goods. In my view it is a clever trade mark that will gain immediate recognition as such (see *Quick restaurants SA v. Office de l'harmonisation dans le marche interieur (marques, dessins et modeles) (OHMI) T-348/02*). I see no reason that MOO JUICE should be left free for others to use and so there is no public interest argument for invalidation under this ground. The ground for invalidation under section 3(1)(c) of the Act is dismissed. (paragraph 27, 28)

....In relation to section 3 (1)(b) the average consumer must be considered. For the goods of the registration, this will be the public at large. I consider that MOO JUICE will readily fulfil the purpose of a trade mark - guaranteeing that all the goods bearing the trade mark originate under the control of a single undertaking. The trade mark will readily be able to repeat the experience of acquiring the goods sold under the trade mark, or readily avoid purchasing them. The ground of invalidation under section 3(1)(b) of the Act is dismissed. (paragraphs 29, 30).

7. The Applicant gave notice of appeal to an Appointed Person under Section 76 of the Act contending that in December 1995 **MOO JUICE** consisted exclusively of a sign or indication which could serve in trade to designate the kind of goods for which registration was requested, thus bringing it within the scope of the exclusion from registration in Section 3(1)(c) as interpreted by the ECJ in Case C-363/99 Koninklijke KPN Nederland NV -v- Benelux - Merkenbureau (POSTKANTOOR) [2004] ECR I-1619 at paragraphs 53 to 58 and 93 to 104. This contention was developed in argument at the hearing before me.

8. In particular, it was maintained on behalf of the Applicant that the hearing officer had assessed the evidence on file without due regard for the effect of people in the United Kingdom being linguistically, culturally, socially and economically prone to adopt and use words and expressions from 'American' English.

9. This echoes the argument considered by Evershed J. on appeal from the Registrar in La Marquise Footwear Inc's Application (1947) 64 RPC 27. In that case the Registrar had rejected an application to register the designation **OOMPHIES** as a trade mark for shoes in Class 25 by reason of the sexual connotations it was said to possess in accordance with the colloquial meaning of the word **OOMP** in 'American' English. With regard to the legitimacy of bringing 'American' English parlance into consideration Evershed J. observed (at p.31):

I should perhaps add this: much argument was addressed upon the footing that, after all, the word, in so far as it is in current use, however short and brutish a life it may have, is American slang rather than, as we would say, part of our own native tongue. That is a matter upon which one might have debate for hours – whether it is the fact that the English tongue as spoken in these islands and the English tongue as spoken in the United States or in Canada or in Australia or in other parts of the globe is or is not one and the same language. I do not propose to throw any light upon any possible answer to the question, save to say that, where, as here, the word is primarily employed in the film industry, and, as is well known, the products of the American film industry are shown and seen by hundreds of thousands of people throughout the whole of the English-speaking world, I think that it would be an affectation to say that a word which has gained any currency as an American slang word ought to be treated in these islands, in the absence of any evidence one way or the other, as a foreign word.

He decided that **OOMPHIES** should, in view of its apparent origins, be regarded not as an invented word, but as a word having an accepted meaning (p.31 lines 3 to 20). He nevertheless held that it lacked the degree of significance and circulation required to convey a ‘direct reference to the character or quality’ of the relevant goods in the United Kingdom (see Section 9(1)(d) of the Trade Marks Act 1938). The appeal was allowed and the application was permitted to proceed to registration.

10. I think it is likewise too expansive under the harmonised law of trade marks in the European Community for designations to be assessed for registrability in the United Kingdom simply by reference to the connotations they might be shown to possess in the United States according to their meaning in ‘American’ English. The assessment should always be localised by considering whether the relevant designation is caught by the cited exclusion(s) from registration as a result of the degree (if any) to which it was, at the relevant date, liable to be perceived and remembered according to its meaning in ‘American’ English, by reasonably well-informed and reasonably observant and circumspect consumers of the goods or services concerned in the United Kingdom. In some areas, notably areas of science and technology, there is a strong tendency for terminology to migrate from the United States to the United Kingdom. Generally, however, there is still considerable scope for the United States and the United Kingdom to be (in the words of the aphorism variously attributed to Oscar Wilde and George Bernard Shaw) two nations divided by a common language.

11. That matches the approach adopted in paragraphs 24 to 26 of the Judgment of the ECJ in Case C-421/04 Matratzen Concord AG v. Hukla Germany SA [2006] ETMR 48, p.58:

24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779 at [29]; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619 at [77]; and Case C-218/01 *Henkel* [2004] ECR I-1725 at [50]).
25. It is possible that, because of linguistic, cultural, social and economic differences between the Member States, a trade mark which is devoid of distinctive character or descriptive of the goods or services concerned in one Member State is not so in another Member State (see, by way of analogy, concerning the misleading nature of a trade mark, Case C-313/94 *Graffione* [1996] ECR I-6039 at [22]).
26. Consequently, Art. 3(1)(b) and (c) of the Directive does not preclude the registration in a Member State, as a national trade mark, of a term borrowed from the language of another Member State in which it is devoid of distinctive character or descriptive of the goods or services in respect of which registration is sought, unless the relevant parties in the Member State in which registration is sought are capable of identifying the meaning of the term.

It is also supported by the Judgment of the ECJ in Case C-192/03P Alcon Inc. v. OHIM [2004] ECR I-8993 at paragraph 42:

...the appellant submits that the Court of First Instance took into consideration, in [44] of the judgment under appeal, certain documents published in the United States. However, that circumstance does not establish that the Court of First Instance based its analysis on evidence that did not affect the target public. By stating in [42] of the judgment under

appeal that English was the technical language of specialists in the relevant field, and by referring in [43] of the judgment under appeal to the perception of the term BSS as a generic term by the 'scientific community', the Court of First Instance necessarily considered that those documents, although published outside the European Union, supported the conclusion that the target public regarded that term as having become customary. In so doing it made an assessment of pure fact, which the appellant cannot challenge on appeal.

The short point is that the Registrar must determine whether a request for registration is free of objection in the United Kingdom under the Trade Marks Act 1994 and should not treat the position that has been (or might be) adopted elsewhere as binding with regard to the position to be adopted in this country: see Case C-218/01 Henkel KGaA v. Deutsches Patent –und- Markenamt [2004] ECR I-1725 at paragraphs 59 to 65; Zurich Private Banking Trade Mark BL O-201-04 (24 May 2004).

12. There is, of course, a degree of foreseeability in the conclusion that a designation would be perceived and remembered either as origin specific, thus pointing to registrability, or as origin neutral, thus pointing to unregistrability. That enables a decision taker to allow for the advent of new forms of descriptive expression by finding under Section 3(1)(c) of the Act that a designation has the capacity to be used and understood purely descriptively going forward. And for that purpose it is open to the decision taker to find that evidence of the way in which a designation has been used and understood sheds light backwards on the question whether it had the capacity to be used and understood purely descriptively at an earlier date: see Case C-192/03P Alcon Inc (above) at paragraphs 41, 42 and Case T-168/04 L&D SA v. OHIM (7 September 2006) at paragraphs 81, 82. However, the process of looking forward and backward over time

(with due regard for any ‘American’ English usage that might be relevant) cannot alter the basic requirement for an objection under Section 3(1)(c) to be well-founded at the material date for testing validity, not at some free floating later date.

13. I think it is clear from the hearing officer’s decision that he was mindful of these considerations:

The prohibition under this section of the Act relates to signs that **may** serve in trade to designate some characteristic of the goods. It is necessary to consider the future as well as the present (paragraph 27).

Future use of an American phrase is covered by the need to leave free; and as I have stated I see no reason that there is any need to leave the phrase **MOO JUICE** free for use by others (paragraph 32).

Paragraphs 5 to 14 of his decision contain a comprehensive summary of the evidence that was before him. In later paragraphs he went on to explain why he regarded ‘American’ English usage of **MOO JUICE** as uninfluential in relation to the way in which the designation was likely to have been perceived and remembered in the United Kingdom in and after December 1995. His principal findings with regard to the capacity of the designation **MOO JUICE** to serve as a trade mark for the goods of interest to the Proprietor are noted in paragraphs 5 and 6 above.

14. In essence he held that the ‘American’ English expression **MOO JUICE** should not be taken to have had the capacity to be used and understood purely descriptively in relation to dairy products marketed in the United Kingdom, in the absence of any evident reason for expecting the average consumer of such products in the United Kingdom to go through the mental process of analysing and interpreting it simply as a quirky way of

referring to 'milk'. I think the hearing officer was entitled to conclude that the quirkiness of the designation was, from the perspective of the average consumer in the United Kingdom, sufficient to individualise such products to a single undertaking and that the Applicant's evidence of 'American' English usage did not weaken or alter that assessment. In my view, it follows that his decision and reasoning are not liable to be set aside or reversed on this appeal.

15. Those are my reasons for determining at the conclusion of the hearing before me that the appeal should be dismissed and that the Applicant should pay £1,100. to the Proprietor as a contribution towards its costs of the appeal in addition to the sum of £1,750. awarded by the hearing officer in respect of the Registry proceedings. That determination is hereby confirmed. If the sum of £1,100. has not yet been paid, it should be paid within 14 days of the date of this decision.

Geoffrey Hobbs QC

29 November 2006

Guy Tritton instructed by Messrs Burges Salmon LLP appeared as counsel for the Applicant.

Iain Purvis QC instructed by Messrs Brookes Batchellor LLP appeared as counsel for the Proprietor.

The Registrar was not represented.