

O-102-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN APPLICATION NO 2496617**

**TO REGISTER A TRADE MARK**

**BY BIRDS EYE IPCO LIMITED**

**IN CLASSES 29, 30 AND 43**

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#### **DECISION AND GROUNDS OF DECISION**

##### **Background**

1. On 2nd September 2008 Birds Eye IPCO Limited of Building 5, New Square, Bedfont Lakes, Feltham, Middlesex, TW14 8HA applied under the Trade Marks Act 1994 to register the following trade mark:

FILL YOU FREEZER FOR A FIVER

2. Registration is sought for the following goods and services:

Class 29

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; frozen prepared meals; instant meals and snack products; chilled foods consisting predominately of fish; chilled meals made from fish; cooked meals consisting principally of fish; fish cakes; frozen fish cakes; fish fillets; frozen fish fillets; fish fingers; frozen fish fingers; fish products; fish products being fresh; fish products being frozen; fish products being preserved; fish with chips; frozen cooked fish, frozen fish, frozen prepared meals consisting principally of fish; pre-cooked dishes incorporating [predominantly] fish; processed fish; scampi; frozen scampi; steaks of fish; frozen steaks of fish; shelled prawns; chicken; chicken pieces; chicken products; cooked chicken; frozen chicken; deep frozen chicken; dehydrated chicken; fried chicken; frozen fried chicken; prepared meals containing [principally] chicken; pieces of chicken for use as a filling in sandwiches; chicken nuggets; frozen prepared meals consisting principally of chicken; chicken kiev; frozen chicken kiev; garden peas; green split-peas; marrowfat peas; peas, preserved; peas, processed frozen peas; soya beans; preserved soya beans; frozen soya beans; vegetarian frozen foods; frozen prepared meals consisting principally of vegetables; frozen vegetables; frozen vegetables packed in single portions; sweetcorn [cooked]; sweetcorn (preserved); sweetcorn [frozen]; burgers; frozen burgers; meat burgers; frozen meat burgers; meat products being in the form of burgers; vegetable burgers; frozen vegetable burgers; steaks of meat; frozen steaks of meat; chilled ready meals; frozen ready meals; individual ready meals; ready cooked meals consisting wholly or substantially wholly of fish; frozen ready cooked meals consisting wholly or substantially wholly of fish; ready cooked meals consisting wholly or substantially wholly of game; frozen ready cooked meals consisting wholly or substantially wholly of game; ready cooked meals consisting wholly or substantially wholly of meat; frozen ready cooked meals consisting wholly or substantially wholly of meat; ready cooked meals consisting wholly or substantially wholly of poultry; frozen ready cooked meals consisting wholly or substantially wholly of poultry; ready cooked meals consisting wholly or

substantially wholly of vegetables; frozen ready cooked meals consisting wholly or substantially wholly of vegetables; potato snack products in the form of fried pieces; frozen potato snack products in the form of fried pieces; potato snack products in the form of pieces capable of being fried; shepherd's pie; frozen shepherd's pie

#### Class 30

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sauces for frozen fish; sauces for chicken; frozen pastry stuffed with meat and vegetables; frozen pastry stuffed with vegetables; frozen prepared rice with seasonings and vegetables; bread rolls containing burgers; chilled ready meals; frozen ready meals; individual ready meals; ready cooked meals; pies containing fish; frozen pies containing fish; pies containing game; frozen pies containing game; pies containing meat; frozen pies containing meat; pies containing poultry; frozen pies containing poultry; pies containing vegetables; frozen pies containing vegetables; waffles; frozen waffles; deep frozen pasta; ready cooked meals consisting wholly or substantially wholly of pasta; frozen ready cooked meals consisting wholly or substantially wholly of pasta.

#### Class 43

Services for providing food and drink; temporary accommodation; catering services: provision of foodstuffs to restaurants; provision of foodstuffs to cafes; provision of foodstuffs to hotels; provision of foodstuffs to establishments that provide food and drink.

3. Objection was taken against the application under Section 3(1)(b) of the Act because the mark consists exclusively of the words **FILL YOUR FREEZER FOR A FIVER** being a sign which would not be seen as a trade mark as it is devoid of any distinctive character because the mark would be seen merely as a promotional and/or advertising statement in relation to cheap food for the freezer that does not offer any trade origin message to the consumer.

4. Following a hearing which was held on 02 July 2007 at which the applicant was represented by Mr Stobbs of Boulton Wade Tennant, their trade mark attorneys, the objection was maintained.

5. I am now asked under Section 76 of the Act and Rule 69(2) of the Trade Mark Rules 2008 to state in writing the grounds of my decision and the materials used in arriving at it.

6. No evidence 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. At the hearing Mr Stobbs described the trade mark as a slogan and referred me to the alliteration of the words FILL, FREEZER and FIVER. Mr Stobbs also suggested that the mark is fun and that although it may suggest a special or cheap promotion concerning the goods and services applied for, the general public are unlikely to take such a statement seriously or literally. Mr Stobbs pointed out that consumers would not expect to fill a freezer for £5 and suggested that the mark is merely allusive. Finally Mr Stobbs referred me to the registrar's published guidance on slogan marks and submitted that even if it may be categorised as a promotional statement, it is a memorable statement.

### **Decision**

9. 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* (8<sup>th</sup> 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 1 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.”

10. I must determine whether the trade mark applied for is capable of enabling the relevant consumer of the goods and services in question to identify the origin of the goods and services and thereby to distinguish them from other undertakings. In *OHIM v SAT.1* (Case C-329/02) the European Court of Justice provided the following guidance at paragraph 41:

“41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings.”

11. At the hearing Mr Stobbs sought to persuade me that the trade mark in question is not devoid of any distinctive character. Although he partly conceded that the mark may be viewed as a promotional statement it is, nevertheless, a memorable one and will be perceived as such by consumers of the goods and services applied for.

12. However this is not the test required under section 3(1)(b) of the Act. 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. In *Libertel* (Case C 104/01) the ECJ said at paragraph 46:

“In the absence of any indication to the contrary in the order for reference, it must be considered that the case in the main proceedings relates to goods and services intended for all consumers. Accordingly, the relevant public in this case must be deemed to be composed of the average consumer, reasonably well-informed and reasonably observant and circumspect (see Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26).

13. This 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.

14. Typically they will be familiar with promotional material and general advertising, especially at the point of sale. Such activity does not necessarily equate to trade mark use and the consumer’s perception of such is unlikely to result in them perceiving such promotional statements as trade marks. In considering the use of this mark in relation to advertising I bear in mind the comments of Mr S Thorley QC, sitting as the Appointed Person, in the *WHERE ALL YOUR FAVOURITES COME TOGETHER* appeal:

“Mr. Redmore, in reaching his decision, bore in mind some comments that I made in a decision on the *DAY BY DAY* trade mark (Application No.

2068646 - unreported) and also some observations of Mr. Hobbs Q.C., sitting as an Appointed Person, in AD2000 [1997] R.P.C. 168. Mr. Chapple did not suggest that he fell into any error by bearing those comments in mind and I therefore shall proceed on the basis that in reaching a conclusion in this case, it is correct that I should have regard to the natural use of the mark applied for, not only on packaging of goods, but also in the context of advertising (see my decision in DAY BY DAY).”

15. I accept that they may find this mark quite strange and may look further to see how they can fill their freezer for the sum of five pounds but, in my view, they will perceive this trade mark as a promotional statement, one which merely brings products to the attention of the consumer without indicating to them the origin of the goods or services. For example, they may expect a one off promotion of a range of goods which are offered for sale at extremely low prices thus allowing consumers to fill their freezers with the promoted goods. They may expect the opportunity to enter a prize draw or, in some other way, compete for the prize of purchasing enough food to fill an average domestic freezer for five pounds. However, what they will not do is identify any trademark message from this mark.

16. At the hearing Mr Stobbs referred to this mark as a slogan and it is perfectly reasonable to assume that some, if not the majority, of consumers will view the mark as such.

17. This is a combination of words which, when encountered in its totality, will not be perceived as a trade mark because, it is incapable of functioning as a trade mark. It fails to provide the required guarantee that the goods and services in question are provided by a single undertaking.

18. Another point made by Mr Stobbs is that the mark contains three words which start with the letter “F”. These are Fill, Freezer and Fiver. This is of course true, but I must consider the effect of this alliteration in the context of the mark as a whole. Again, I must consider how relevant consumer, when purchasing such goods or receiving these services, will perceive this trade mark. They will encounter the mark as a whole and consider it to be a non distinctive promotional statement with no trade mark message at all. The alliteration present in this mark has no effect if the slogan is not perceived immediately as a trade mark – See the decision of the Court of First Instance (T-88/06) in *Dorel Juvenile Group, Inc v OHIM*.

19. The specifications of goods in classes 29 and 30 may be wide ranging, but in my view the objection is equally valid for all of the goods applied for. However, I do not consider the objection to be for the case for all of the services applied for in class 43. In my view the objection does not apply to the following:

“temporary accommodation; services for providing drink”.

20. For the reasons set out above I have concluded that the relevant consumer of the goods and services identified would not consider this mark to denote trade origin. The average consumer of these goods and services will, upon encountering the words FILL YOUR FREEZER FOR A FIVER, perceive them as no more than an indication that the applicant is promoting goods suitable for freezing or being stored

in a freezer. That is why it will not be seen as a sign which guarantees that the goods and services emanate from a single undertaking. I am not persuaded that the trade mark applied for is sufficient, in terms of bestowing distinctive character on the sign as a whole, to conclude that it would serve, in trade, to distinguish the goods and services of the applicant from those of other traders.

21. I have concluded that 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 applicant 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 Sections 3(1)(b) of the Act.

23. Consequently, I have concluded that the mark applied for consists exclusively of signs which may serve, in trade, to designate the kind of services and is, therefore, excluded from registration by Section 3(1)(b) of the Act.

**Dated this 22<sup>nd</sup> day of April 2008**

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