

O-242-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2520505
BY ROBERT WISEMAN & SONS LIMITED TO REGISTER THE TRADE MARK**



IN CLASSES 29 AND 39

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 99934
BY DAIRY CREST LIMITED**

TRADE MARKS ACT 1994

IN THE MATTER OF application No. 2520505

by Robert Wiseman & Sons Limited to register the trade mark



and

IN THE MATTER OF Opposition thereto under No. 99934

by Dairy Crest Limited

BACKGROUND

1) On 6 July 2009, Robert Wiseman & Sons Limited (“Wiseman”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the above shown trade mark in respect of the following goods and services:

Class 29

Milk; milk beverages; milk products; beverages derived from milk; beverages with a milk element, all being the produce of Cornwall.

Class 39

Collection and delivery of goods, milk, milk beverages and milk products.

2) The application was published in the Trade Marks Journal on 25 September 2009 and on 23 December 2009, Dairy Crest Limited (“DCL”) filed notice of opposition to the application. The grounds of opposition are based upon Section 3(1)(b) and Section 3(1)(c) of the Act. DCL claims that Wiseman’s mark is not capable of distinguishing Wiseman’s goods and services from those of other undertakings as the mark is little more than the words CORNISH MILK which should be free for use by all traders. The slight stylisation is not sufficient to distract from the fact that the essential feature of the mark is the words CORNISH MILK. Further the words serve in trade to designate the geographical origin of milk produced or sourced in Cornwall. The stylisation present in the mark is not sufficient to distract from the words CORNISH MILK being the essential feature, particularly as the stylisation represents either the top of a glass of milk or the pattern on a Friesian cow.

3) Following this, Wiseman added a disclaimer to the application which reads:

Registration of this mark shall give no right to the exclusive use of the words "Cornish milk".

4) Wiseman subsequently filed a counterstatement denying DCL's claims and points out that the mark is primarily its black and white label mark that is subject of its registration no. 2038519, amongst others. It also accepts that the words CORNISH MILK serve in trade to designate the geographical origin of milk produced or sourced in Cornwall. It claims that the mark consists of the distinctive black and white label combined with a description of the goods.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 14 June 2011 when DCL was represented by Lorna Hobbs for Cleveland and Wiseman represented by Alasdair Hume for Ancient Hume Limited.

Opponent's Evidence

6) This takes the form of a witness statement, dated 23 June 2010, by Andrew Money, Deputy Company Secretary of DCL. In addition to providing a history of the business, he states that it is his understanding that Wiseman's branding is designed to bring to mind cows.

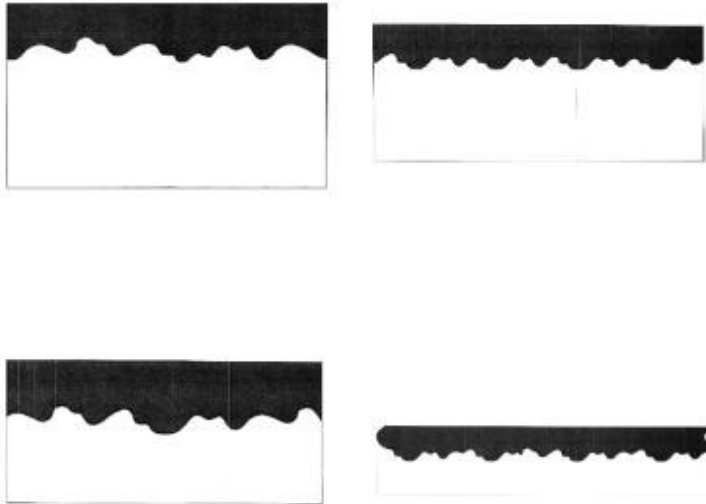
7) Mr Money explains that DCL purchases over 300 million litres of Cornish milk a year, which he estimates to be more than half the total volume of milk produced in the county. He states that Cornish milk is supplied by his company as fresh milk and also it is a component of other milk based products such as dairy spreads and cheeses.

8) Mr Money suggests that, in addition to the claim in the statement of case that the device element represents the pattern on a Friesian cow, it may alternatively represent milk having been poured into a container. He provides pictures of glasses of milk, at Exhibit AM3, obtained from conducting a *Google* search for "glass of milk". He hypothesises that were the words CORNISH MILK added to any of these pictures the UK courts may hold that such a combination infringes Wiseman's rights that would reside in its mark.

Applicant's Evidence

9) This is in the form of a witness statement, dated 14 September 2010, by Maureen Burnside, Company Secretary of Wiseman. At Exhibit MB2 and Exhibit MB3, Ms Burnside provides copies of the details of Wiseman's UK and Community Trade Mark (CTM) registrations showing its "black and white brand". I reproduce the representation of the marks covered by registration 2314765B,

by way of illustration, because the first in the series of four marks appears most closely matched to the device element of the current mark:



Opponent's Evidence in reply

10) This takes the form of a further witness statement, dated 15 November 2010, by Mr Money. This contains a number of submissions that I will not detail here but will bear in mind.

DECISION

11) Section 3 of the Act states:

"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.”

12) There are two points I need to comment on before going on to assess whether the mark in question falls foul of Section 3(1)(b) and (c) of the Act. The first of these is the impact of Wiseman’s voluntary disclaimer. This can be dealt with briefly in that such disclaimers are not in the public domain and therefore do not influence the average consumer in respect of how the mark is perceived. Therefore, whilst such a disclaimer may assist in clarifying the legal rights claimed in the mark, it does not assist in defining how the average consumer will perceive the mark.

13) The second point is that Wiseman has existing registrations for marks that, if not identical, are virtually identical to the device element incorporated in the current mark. What is the impact of such registrations upon my considerations here? My answer to this is that I must consider the mark as a whole and not dissect it into its constituent parts. I must consider whether the mark, as a whole, is capable of distinguishing the goods and services of one trader from those of others. Therefore, whilst I note Wiseman’s registrations, the mere fact that a mark is registered, that is identical or virtually identical to the device element of the current mark, does not lead to an automatic finding that the current mark does not fall foul of Section 3(1)(b) and (c) of the Act.

Section 3(1)(c)

14) I find it convenient to consider this ground of opposition first. As explained by the Court of Justice of the European Union (“the CJEU”) in *DOUBLEMINT* Case C-191/01 at paragraphs 30 and 31, the purpose of this exclusion from registration of such signs is the public interest in precluding any individual trader from obtaining a monopoly in a sign which other traders might legitimately wish to use because of its descriptiveness.

15) The proviso to section 3(1) of the Act provides an exception to this exclusion. If a trader can demonstrate that through the use made of it his mark has become sufficiently distinctive so that it does in fact serve as an indication of origin in the minds of the relevant public or a significant proportion thereof (see *Windsurfing Chiemsee* C-108/97) then registration may be granted. However, Wiseman does not rely upon this exception and I only have the *prima facie* case to consider.

16) In *POSTKANTOOR* C-363/99 and in relation to Article 3(1)(c) (the equivalent of section 3(1)(c) of the Act), the CJEU stated;

“97... A word must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned...”

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 purpose of Article 3(1)(c) of the Directive. Merely bringing those elements 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.”

17) There is no dispute between the parties that the words CORNISH MILK are words that designate the geographical origin and type of the products claimed. Where the party’s views diverge is in respect of the impact of the device element present in Wiseman’s mark. Wiseman argues that it is a distinctive device as illustrated by its numerous registrations for similar devices. On the other hand, DCL argument, as put forward by Mr Money in his witness statement, is that the addition of the words CORNISH MILK to the registered device mark alters it in such a way that the wavy line clearly represents milk having been poured into a container and therefore the device reinforces the meaning of the words making them the dominant feature of the mark.

18) Ms Hobbs developed this argument further at the hearing and argued that whilst the device element may be “artistically pleasing”, it is not distinctive and designates the goods themselves. It was also pointed out that the word CORNISH is in the colour green and that this colour is used in the trade to identify semi-skimmed milk. This is supported by Wiseman’s own evidence where, at Exhibit MB1, there is a photograph of various milk containers bearing the mark. The colour of the word CORNISH is shown in either red, green or blue depending on whether it is on packaging of skimmed, semi-skimmed or full-fat milk.

19) As a counter-argument Mr Hume contended that as the words CORNISH MILK are descriptive then the rest of the mark takes on higher level of importance in identifying trade origin in the minds of the consumer. He also contended that the device element was not a picture of milk, as suggested by Ms Hobbs, but rather a pattern inspired by the look of a Friesian cow.

20) Section 3(1)(c) of the Act prohibits marks which consist **exclusively** of signs or indications designating characteristics of the goods and services from being registered. The current mark consists of the words CORNISH MILK set against the device. Therefore, the word element and the device element must, together, convey a message to the consumer that designates characteristics of the goods and services.

21) The device consists of a wavy line that divides the mark approximately 20/80 with the top 20% being coloured black and the bottom 80% being coloured white. I should say at this stage that, despite the disclosed inspiration for such a design, I do not see how the average consumer would see the device as some allusion to Friesian cows. There is nothing to suggest this to the consumer other than the colour combination. The pattern is not similar in any other way to the pattern that appears upon Friesian cows.

22) However, I find Ms Hobbs' contention that the device represents milk having been poured into a container as more persuasive. It is known from the guidance of the General Court (GC) that it is necessary to consider whether the relevant consumer will perceive a sufficiently direct and specific association between the mark and the relevant goods and services (see, for example, Case T-356/00 *Daimler Chrysler v OHIM (CARCARD)*, paragraph 25 and Case T-355/00 *DaimlerChrysler v OHIM (TELE AID)*, paragraph 28). Further, the GC has provided guidance on the type of marks prohibited by Article 7(1)(c) of Regulation No 40/94 (from which Section 3(1)(c) is derived). Marks that may serve in normal usage from the point of view of the intended public to designate, either directly or by reference to one of their essential characteristics, the goods or services in respect of which registration is sought are excluded from registration (Case C-383/99 *P Procter and Gamble v OHIM*, paragraph 39). Accordingly, a mark's descriptiveness can only be assessed by reference to the goods or services concerned and to the way in which it is understood by a specific intended public.

23) Taking this guidance into account, the words CORNISH MILK will alert the consumer to the nature of the goods and services with the device element merely supporting this meaning. Therefore, even if it can be argued that the artistic get-up is such as to create doubt in the minds of the consumer as to what is being represented by the device, this is dispelled by the addition of the words CORNISH MILK. As such, the mark, when viewed as a whole, designates milk originating from Cornwall. There is no other message that would be perceived by the average consumer.

24) Taking all of the above into account, I find that the mark designates a characteristic of all the goods and services claimed, namely products in the form of, or derived from, milk originating in Cornwall and services relating to the collection and delivery of such goods. It falls foul of Section 3(1)(c) and therefore the opposition based upon these grounds is successful.

Section 3(1)(b)

25) Anna Carboni, sitting as the Appointed Person in O-363-09 COMBI STEAM, conveniently summarised the leading case law in respect of this part of the Act:

7. It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs “a residual or sweeping-up function”, backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: *Procter & Gamble Ltd’s Trade Mark Application* [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): *Case C-363/99 Koninklijke KPN Nederland BV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] ETMR 57 (ECJ) at [86]. However, the converse is not true: a mark which is not descriptive may nevertheless be devoid of distinctive character for other reasons (*ibid.*).

8. When a trade marks examiner assesses the distinctiveness of a trade mark within the meaning of section 3(1)(b), s/he must do so firstly by reference to the goods or services listed in the specification, and secondly by reference to the perception of the mark in relation to such goods or services by the relevant public, which consists of average consumers of the goods or services in question, who are deemed to be reasonably well informed, observant and circumspect: *Joined Cases C-53/01 to C-55/01 Linde AG, Winward Industries Inc and Radio Uhren AG* [2003] ETMR 78 at [41].

9. It is not necessary to show that a mark has a particular level of creativity or originality in order to establish distinctive character: *Case C-329/02P SAT.1 Satelliten Fernsehen GmbH v OHIM* [2005] ETMR 20 (ECJ) at [41]. While the Court of First Instance (“CFI”) has repeatedly referred to “a minimum degree of distinctive character” as being sufficient to avoid article 7(1)(b) of the CTMR/article 3(1)(b) of the Directive (for example, *Case T-34/00 Eurocool Logistik GmbH & Co. KG v OHIM (“EUROCOOL”)* [2003] ETMR 4 at [39]; *Case T-128/01 Daimler Chrysler Corp v OHIM* [2003] ETMR 87 at [33]; *Case T-320/03 Citicorp v OHIM (“LIVE RICHLI”)* at [68]), the ECJ has not adopted this wording and has deemed it unnecessary to give any more precise definition to the possible dividing line between lack of distinctiveness and the minimum distinctiveness to which the CFI refers: *Deutsche Krankenversicherung AG v OHIM (“COMPANYLINE”)* [2002] ECR I-7561 at [20].

10. The ECJ approaches the issue of distinctiveness by reference to the underlying purpose of article 3(1)(b) of the Directive / 7(1)(b) CTMR, which in the Court’s view is to preclude registration of trade marks that are incapable of performing the essential function of guaranteeing the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the

product or service from others which have another origin: *SAT.1 v OHIM* at [23]; Case C-37/03 P *BioID AG v OHIM* [2005] ECR I-7975 (ECJ) at [27].

26) It is clear from the above guidance that if a mark is entirely descriptive of characteristics of goods or services, it will also be devoid of any distinctive character under section 3(1)(b). As such, as I have found that the mark in question is open to objection under Section 3(1)(c) of the Act, it follows that it is also open to objection under Section 3(1)(b) of the Act. At the hearing, Ms Hobbs drew my attention to a number of earlier decisions of other hearing officers and by the Appointed Person. In particular, she referred to *Quick Wash Action O-205-04* where Geoffrey Hobbs QC, sitting as the Appointed Person, commented that “[t]he artistic presentation neatly and skillfully builds upon and reinforces the origin neutral message [of the words] in a way that makes it more effective than the words alone... I think that the net result is a well-executed artistically pleasing, origin neutral device.” Whilst not quite on “all-fours” with the current case, I believe parallels exist. The device element of milk in a container builds upon and reinforces the message contained in the descriptive words CORNISH MILK. Therefore, in the absence of being educated to recognise the device as indicating trade origin, it will be seen as only providing some origin neutral artistic background embellishment reinforcing the descriptiveness of the words CORNISH MILK.

27) However, in case I am found to be wrong in respect of my findings relating to Section 3(1)(c), I will comment on the impact such a finding would have upon the acceptability of the contested mark in respect of Section 3(1)(b). If the device element is not perceived as a device of milk in a container (as I found earlier), then it is my view that there is no conceptual hook providing the device with any impact upon the mind of the consumer. Further, the visual impact of the device, which is only minimal anyway, is diluted when used as a background. The result of this is that, when viewing the mark as a whole, it does no more than convey a descriptive and, therefore, non-distinctive message that is presented by the word element CORNISH MILK. This message is not altered by the addition of the device and, in the absence of evidence of acquired distinctiveness, it fails to function as a badge of origin in the mind of the consumer. The device element, if noticed at all, will detract the consumer from the immediate descriptive message contained in the words CORNISH MILK.

28) The CJEU has provided guidance to the effect that where the dominant element of a mark is non-distinctive (as are the words CORNISH MILK in the current mark) and the device elements do not possess features which would allow the mark to fulfil its essential function then the mark, when considered as a whole, is devoid of any distinctive character (see Case C-37/03 P, *BioID AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*).

29) Taking this into account, even if I am wrong regarding the grounds based upon Section 3(1)(c) of the Act, the mark, nevertheless, falls foul of Section 3(1)(b) because, when viewed as a whole, it is not capable of distinguishing the goods and services of any one undertaking from those of other undertakings. In reaching such a conclusion, I have given due consideration to the relevant goods or services and the perception of the relevant persons, namely the consumers of the goods or services.

30) In light of the above comments, it follows that the ground of opposition based upon Section 3(1)(b) of the Act succeed in its entirety, even if I were found to be wrong in respect of my findings in respect to Section 3(1)(c) of the Act.

COSTS

31) The opposition having been successful, Dairy Crest Limited is entitled to a contribution towards its costs. I take account that a hearing has taken place and that evidence was filed by both parties. I award costs on the following basis:

Notice of Opposition and considering statement of case in reply	£400
Preparing and filing evidence and considering evidence in reply	£500
Preparing for, and attending hearing	£600
TOTAL	£1500

32) I order Robert Wiseman & Sons Limited to pay Dairy Crest Limited the sum of £1500. This sum is to 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 this 8th day of July 2011

**Mark Bryant
For the Registrar,
the Comptroller-General**