

O-490-12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2611130
BY MR SOCRATES CAMENON
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 29:**

CLASSIC DONNER

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Background

1. On 18 February 2012, Mr Socrates Camenon ('the applicant') applied to register trade mark application number 2611130 for the mark 'CLASSIC DONNER' in relation to the following goods:

Class 29: Food - fresh and frozen donner kebab.

2. On 2 March 2012, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act') on the basis that the mark (in the examiner's words) "*consists exclusively of the expression „CLASSIC DONNER’, being a sign which may serve in trade to designate the quality and a characteristic of the goods e.g. classic donner kebabs made to the highest quality and established as the best example of its kind... the mark merely describes a characteristic of the goods concerned and therefore it is incapable of acting as a badge of sole trade origin. The mark could equally apply to any undertaking and the mark should be kept free for all traders who wish to label their donner kebabs as classic*". The examiner included a dictionary definition of the word 'classic' to support the objection. In line with routine IPO procedure, a period of two months was granted for the applicant to respond.

3. Following the absence of any response to the examination report, a notice of refusal was sent to the applicant on 12 June 2012. A form TM5 was subsequently received at IPO on 22 June 2012. I am now asked, under section 76 of the Trade Marks Act 1994 and rule 69 of the Trade Marks Rules 2008, to state in writing the grounds of my decision and the materials used in arriving at it.

The applicant's case for registration

4. Together with the form TM5, the applicant included a letter putting forward arguments for acceptance of the application. I will take this letter into account in my decision, notwithstanding the fact that it was filed *after* formal refusal of the application. Mr Camenon referred me to the previous acceptances of two marks which include the word 'Classic', namely Madrid (EU) Registration Number 941964 'IPOD CLASSIC' and UK Registration Number 1246572 'COCA-COLA CLASSIC', submitting that acceptance of these two marks should lead to our acceptance of his mark. The applicant also referred to a US-based company called 'Grecian Delight' which has registered the trade mark 'Classic Gyro' in respect of donner kebabs, where 'gyro' is the Greek word for 'kebab'. Mr Camenon did not indicate *where* this particular mark has been registered (it is not registered in the UK), but

one presumes that it is probably the United States. Mr Camenon also asked whether amending the application to read 'DONNER CLASSIC' would be an acceptable action, and whether it might result in waiver of the objection.

Decision

5. Section 3(1) of the Act reads as follows:

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 indications 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.

The above provisions mirror Article 3(1)(b) and (c) of First Council Directive 89/104 of 21 December 1988 (subsequently codified as Directive 2008/95/EC of 22 October 2008) (the Directive). The proviso to Section 3 is based on the equivalent provision of Article 3(3).

Relevant authorities – general considerations

6. The Court of Justice of the European Union ('CJEU') has repeatedly emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 (subsequently codified as Council Regulation (EC) No 207/2009 of 26 February 2009) on the Community Trade Mark (the Regulation), in the light of the general interest underlying each of them (*Bio ID v OHIM*, C-37/03P, paragraph 59 and the case law cited there and, more recently, *Celltech R&D Ltd v OHIM*, C-273/05P).

7. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. For example, in the case of the registration of colours *per se* not spatially delimited, the Court has ruled that the public interest is aimed at the need not to restrict unduly the availability of colours for other traders in goods or services of the same type. Also, in relation to section 3(1)(b) (and the equivalent provisions referred to above) the Court has held that “...the public interest... is, manifestly, indissociable from the essential function of a trade mark” (*Satelliten Fernsehen GmbH v OHIM* C329/02 (SAT.1)). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark 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 (see paragraph 23 of the above mentioned judgment).

Section 3(1) (c)

8. There are a number of CJEU judgments which deal with the scope of Article 3(1)(c) of the Directive and Article 7(1)(c) of the Regulation, whose provisions correspond to section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- Subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (*Wm Wrigley Jr & Company v OHIM, C-191/01P (Doublemint)*, paragraph 30);
- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all (*Doublemint*, paragraph 31);
- It is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes (*Doublemint*, paragraph 32);
- It is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word 'exclusively' in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question (*Koninklijke KPN Nederland NV v Benelux Merkenbureau, C-363/99 (Postkantoor)*, paragraph 57);
- An otherwise descriptive combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word trade mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark (*Postkantoor*, paragraph 99).

9. In *Matratzen Concord AG v Hukla Germany SA, C-421/04*, the CJEU stated that:

"...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, who are reasonably well informed and reasonably observant and circumspect, in the territory in respect of which registration is applied..."

I am also mindful of the decision of the General Court (formerly the Court of First Instance) in *Ford Motor Co v OHIM, T-67/07* where it was stated that:

“...there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics”.

10. I must also be aware that the test is one of immediacy or first impression, as confirmed by the General Court which, in its decision on *Sykes Enterprises v OHIM (Real People Real Solutions)*, [2002], ECT II-5179, stated:

“...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin.”

11. It is clear from the aforementioned case law that I must determine, assuming notional and fair use, whether the mark will be viewed by the average consumer as a means of exclusively designating a characteristic of the goods for which registration is sought.

12. The goods at issue are fresh and frozen donner kebabs. The average consumer of such products does not need to possess any specialist knowledge in order to consider and/or make the purchase, and it is therefore reasonable to assume that any assessment of the mark's distinctiveness needs to be made in the context of the general public *at large*. These are inexpensive 'everyday' products, and so the level of consumer attention is likely to be fairly low.

13. In determining whether the grounds for objection under section 3(1)(c) apply, the Registrar is obliged to consider the semantic content of the sign. On that basis, I firmly believe that the mark conveys a clear message, which would be understood by the relevant consumer as designating a characteristic of the goods i.e. the *type* or *kind* of goods involved. The mark in question consists of the words 'classic donner', where Chambers 21st Dictionary defines the word classic as follows:

classic *adjective* 1. made of or belonging to the highest quality; established as the best; 2. entirely typical; 3. simple, neat and elegant, especially in a traditional style; 4. an established work of literature; 5. an outstanding example of its type

14. Meanwhile, the Oxford Dictionary defines the term 'doner kebab' as follows:

doner kebab *noun* 1. a Turkish dish consisting of spiced lamb cooked on a spit and served in slices, typically with pitta bread.

I should indicate here that 'donner' (as defined in the Oxford Dictionary) is a common and recognised alternative spelling of 'doner' (as contained in the mark). Strictly for information purposes, Annex A contains some website examples which demonstrate the extent to which the spellings 'donner' and 'doner' are interchangeable. I should also point out that the Registrar makes little distinction between the term 'donner' *solus*, and the more complete

term 'donner kebab'. In the context of the goods applied for, the word 'donner' would undoubtedly be perceived as an abbreviation for 'donner kebab'.

15. In this case, I consider that the average consumer (i.e. the general public), when seeing the phrase 'classic donner' being used in respect of donner kebabs, would simply see it as denoting high quality donner kebabs made to a traditional recipe. A search of the Internet has revealed third party use of the term 'classic' to describe the type of kebabs for sale and, again solely for information purposes, some of my findings in that respect are shown at Annex B. This list is not exhaustive, but provides a fairly typical representation of materials found on the Internet.

16. As regards the earlier marks referred to by the applicant, I consider them to be of little assistance in determining the outcome of this application. The trade marks 'COCA-COLA CLASSIC' and 'IPOD Classic' do contain, in addition to the word 'classic', other inherently distinctive and registrable elements such as the words 'IPOD' and 'COCA-COLA'. In respect of the third earlier mark mentioned by Mr Camenon i.e. 'Classic Gyro', this mark is not registered in the UK, I have no information surrounding its registration, and so I can make no further comment as to its relevance.

17. Regarding Mr Camenon's request to change his trade mark from 'CLASSIC DONNER' to 'DONNER CLASSIC', I should point out that this is not permissible. Even if the request had been made *prior* to formal refusal, section 39(2) of the Trade Marks Act 1994 only allows for the amendment of an application in a very limited set of circumstances, namely, where the name or address of the applicant is incorrect; *or* where there is an error of wording or of copying; *or* where an obvious mistake has been made; and only then when such a change does not affect the identity of the trade mark. Mr Camenon's request does not fall into any of the aforementioned categories, and so would not have been permitted prior to the refusal.

18. Taking into account all of the above, I have concluded that the mark applied for consists exclusively of a sign which may serve, in trade, to designate the kind or type of goods, namely donner kebabs cooked to a traditional recipe. It is therefore excluded from registration by section 3(1)(c) of the Act.

19. Having found that to be the case, it effectively ends the matter. However, in case I am found to be wrong in this regard, I will go on to determine the matter under section 3(1)(b) of the Act.

Section 3(1)(b)

20 Ms. Anna Carboni, sitting as the Appointed Person in *COMBI STEAM*, BL O-363-09, conveniently summarised the leading case law in respect of this part of the Act when, at paragraph 7 of that decision, she stated the following:

"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): Koninklijke KPN Nederland BV v Benelux-Merkenbureau Case C-363/99 (POSTKANTOOR) [2004] ETMR 57 (ECJ) at [86]”.

21. Given the meanings of the words contained within the mark, it is my view that, even if a specific genus of kebab known as the 'classic' does *not* exist, the phrase would nonetheless be unpossessed of distinctive character. That is to say, the average consumer would not see the words as signifying the origin of the product, but as a generally laudatory and/or descriptive designation. By analogy, if I were to walk into a well-known hamburger restaurant and see the words 'Classic Burger' in plain view, they would tell me no more than that particular burger is a traditional burger without trimmings or special features. In contrast, a term such as 'Big Mac', encountered in that same restaurant, would resonate as being a trade mark which serves to denote the specific commercial origin of that product.

22. On the basis that the mark 'Classic Donner' is not capable of denoting trade origin, it is also excluded from registration under section 3(1)(b) of the Act..

Conclusion

23. 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. Having done so, and for the reasons given above, the application is refused under the terms of section 37(4) of the Act because it fails to qualify under sections 3(1)(b) and 3(1)(c) of the Act.

Dated this 10th day of December 2012

**Linda Smith
For the Registrar
The Comptroller-General**

ANNEX A - Examples showing the use of 'donner' as an alternative spelling for 'doner'

Taken from: www.urbandictionary.com/define.php?term=donner

Urban Dictionary: donner - Windows Internet Explorer provided by IPO

http://www.urbandictionary.com/define.php?term=donner

URBAN DICTIONARY DONNER

random A B C **D** E F G H I J K L M N O P Q R S T U V W X Y Z # new favorites tv

most popular

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[nnibal](#)

[ner](#)

[nner meat](#)

1. donner 52 up, 35 down

Donner (also donner kebab, donner meat) is a 'meat' served in take-aways across the United Kingdom. It is often characterised by the image of a large slab of unrecognisable greasy brown meat turning slowly on a heated grill, often accompanied by a pair of large sweating onions.

The reasoning behind it's name is unknown, but it is thought that the term 'Donner' is of greek descent, but it's meaning remains a mystery. Others believe that it got it's name from the first ever batch created, which was by a cannibalistic man who mudedred his wife (donna) and turned her into a kebab.

Donner meat is a firm favourite with the drunken hoards which amass from various student bars after closing time, for example 'Footage'. Due to it's

1 Trick To Look Years Younger?

BEFORE

Taken from: www.divandonner.co.uk/products/donner-kebabs.htm

Divan Donner Kebabs, Doner Kebab, doner meat, HMC Approved, high quality halal meat - Windows Internet Explorer provided by IPO

http://www.divandonner.co.uk/products/donner-kebabs.htm

divan donner kebabs

This website wants to run the following add-on: 'acroRd32.exe' from 'Adobe Systems, Incorporated'. If you trust the website and the add-on and want to allow it to run, click here...

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Donner Kebabs


Only the best ingredients are used for our special Divan donner kebabs. We are HMC approved, assuring you of high quality genuine halal meat. Weight ranges from 5kgs to 40 kgs blocks and we also cater for customers who wish to use their own blend of herbs and spices.

For delicious doner kebabs, look no further that Divan Doner. Contact us on +44 (0) 1204 540011.

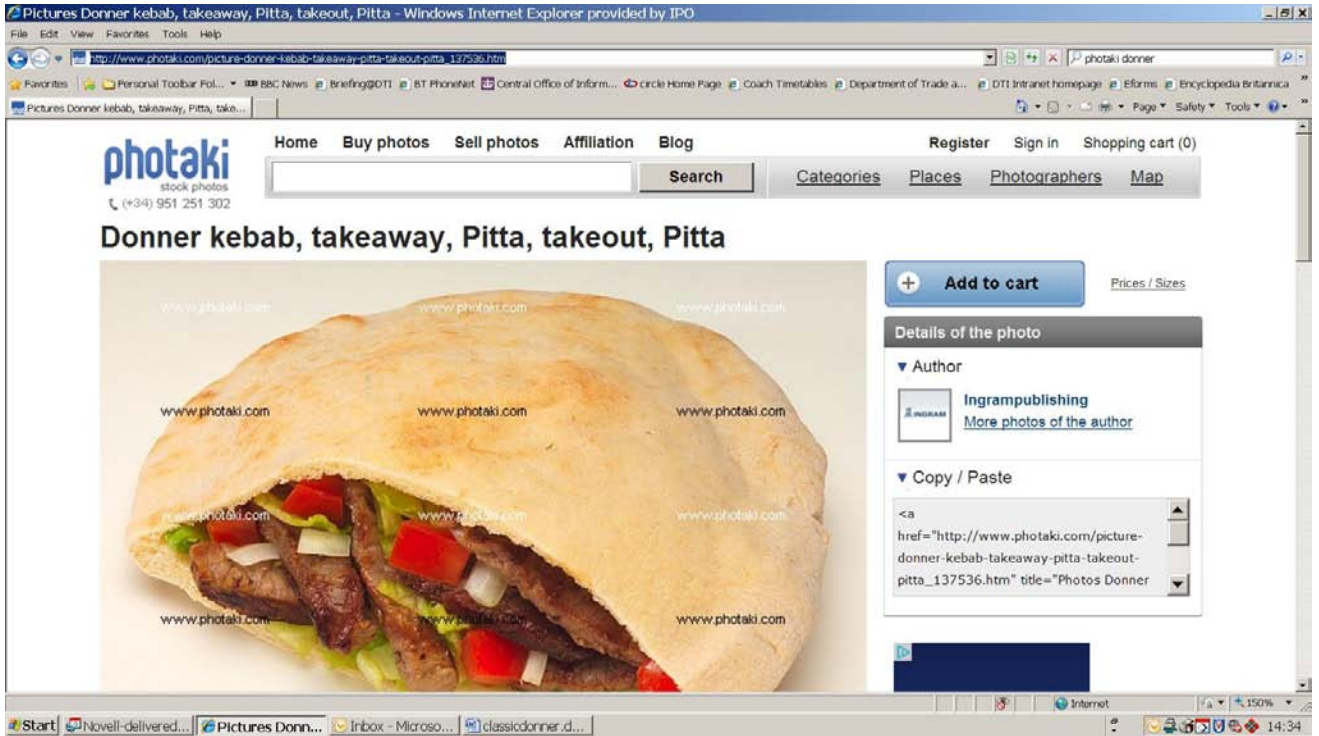








Taken from: www.photaki.com/picture-donner-kebab-takeaway-pitta-takeout-pitta_137536.htm



Taken from: www.visiteastlothian.org/assets/hba_brochure_spreads.pdf



ANNEX B - Examples showing third-party use of the phrase 'Classic Doner Kebab'

Taken from: www.jjfoodservice.com/product.cfm/Ali-Baba-Halal-Classic-Doner-Kebab-1x10kg/DON051

DON051: Ali Baba Halal Classic Doner Kebab-1x10kg

Price & Discounts		
List Price	Collection Price	Buy 2+ Save 10%
£30.99	£26.99	£27.89
Online Collection		Online Delivery
£24.99		No Online Delivery Offer

Meat, Doner
Classic Doner Kebab 10kg

Sales Information
Selling Points: GMO Free.

Cooking Instructions: Cook on a doner kebab machine until light brown and slice thin strips from top to bottom.

Logistics and Distribution

Net Weight:	10.00 Kg
Size or Cut:	1x10kg

Taken from www.mrts-scarborough.co.uk/menu-new-with-pizzas/kebabs/

MR T'S Continental Cafe & Grill

Kebabs

	Regular	Large
1 Simply doner (portion of doner meat)	£2.99	£3.99
Standard kebabs		
<i>Standard kebabs are served with mixed salad, onion, pitta bread, garlic mayonnaise and hot & spicy sauce</i>		
Doner kebabs		
2 Classic doner kebab	£3.99	£4.99
3 Mediterranean doner kebab	£4.49	£5.49
4 Hot & Spicy doner kebab (h)	£4.49	£5.49
5 Doner Delight kebab	£4.99	£5.99

Address
Mr. T's
Continental Cafe & Grill
43 Castle Road
Scarborough
YO11 1BG

Opening times
Wednesdays to Mondays:
until 11 pm
Closed on Tuesdays

Taken from www.olivetreeuk.com/products-page/kebabs/template-kebab/

