

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. 2199175A
BY COMPASS GROUP PLC TO REGISTER
TRADE MARKS IN CLASS 30**

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NO 2199175A BY COMPASS GROUP PLC
5 TO REGISTER A TRADE MARK
IN CLASS 30**

DECISION

10 Background

On 4 June 1999, Compass Group plc of Chertsey, England, applied to register the following marks (as application no 2199175):

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The application was made in respect of the following goods and services:

Class 30:

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Prepared meals; sauces and condiments; hot and cold snacks; pizzas and pizza products; bread, rolls, filled rolls, sandwiches, baguettes, filled baguettes, cakes, buns, pastries, biscuits, confectionery; ices and ice cream products; cereals and cereal preparations; breakfast cereals; whole and ground coffee, coffee beans, coffee extracts, coffee essences, tea and drinking chocolate, beverages including the aforesaid goods.

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Class 42:

Catering services; restaurant, café, cafeteria, snack-bar and coffee-shop services; preparation of foodstuffs or meals or beverages for consumption on or off the premises.

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Objection was taken to the application under paragraph (b) of Section 3(1) of the Act on the grounds that the marks consist of the word TASTE together with a non-distinctive background, the whole being devoid of any distinctive character, for example, for goods or services of good taste.

5 **Hearing and decision**

At a hearing at which the applicant was represented by Ms Claire Lazenby of Sommerville & Rushton, the objection was maintained, but only in respect of the goods in Class 30. The application was subsequently divided into two parts and following refusal of the revised application bearing the suffix “A”, under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 (as amended) to provide a statement of the reasons for my decision.

At the hearing, Ms Lazenby put forward various arguments in support of acceptance of the mark as a totality. No claim was made that the word TASTE is distinctive per se. The case for registration may be summarised as follows:

- S the mark, as a whole, performed the function of a trade mark;
- 20 S the test for distinctiveness under Section 3(1)(b) and (c) was whether a mark tendered for registration would be perceived by the public as a badge of origin. In the case of the present marks, there would be immediate recognition as trade marks;
- 25 S if required, the applicant was prepared to delete the first mark in the series, the black and white version and allow the application to proceed with the colour version only.
- S it was not a relevant consideration that others would wish to use the word TASTE;
- 30 S various decisions in the United Kingdom and the Board of Appeal of the Office for Harmonisation of the Internal Market supported the view that the marks are prima facie distinctive;

These arguments did not persuade me that the marks are not devoid of any distinctive character.

35 The relevant part of the Act under which the objection was taken is as follows:

Section 3(1):

40 “The following shall not be registered-

- (b) trade marks which are devoid of any distinctive character,

45 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.”

No evidence of use has been put before me, therefore the proviso to this section of the act does not apply and I have only the prima facie case to consider.

The marks consists of various elements, namely:

5 1st mark:

the word “Taste” which is underlined, together with an exclamation mark, superimposed on two oval shaped devices. The second letter “t” in the word is highlighted by being represented on a contrasting white background.

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2nd mark:

the second mark differs from the first mark in matter of a non-distinctive nature in that it is represented in the colours purple and green which the applicant claims as an element of the mark.

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The word “taste” is given various definitions in the New Oxford Dictionary of English (1998) and Collins English Dictionary (Millennium edition). The meanings which are of particular relevance are:

20 S the ability to discern what is of high quality or of a high aesthetic standard

S the act of tasting

25 S a small amount eaten drunk, or tried on the tongue

S to take a small amount of (food, liquid etc) into the mouth, esp. in order to test the quality

S to have a specific flavour or taste

30 As Ms Lazenby pointed out, the marks do not comprise the word “taste” solus and it was common ground that I am bound to accept or reject the marks in their totality. However, I

cannot overlook the fact that TASTE! is the most prominent feature of both marks and I take the view that this word with its exclamation mark is likely to be perceived by the public as an exhortation to taste the food or drink products which are sold in connection with the mark.

35 Furthermore, the underlining of the word TASTE together with the exclamation mark serves to emphasise that the goods have a specific taste (as opposed to being bland). The remaining features of the marks comprise the highlighting of the second letter “t” and two oval shaped devices upon which TASTE! is superimposed. I take the view that these other elements, which are peripheral to TASTE! are devoid of any distinctive character.

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In consideration of all the individual elements when viewed in their totality, it is my opinion that both marks are devoid of any distinctive character. The test for distinctiveness was clearly set out by Mr Justice Jacob in the British Sugar PLC and James Robertson and Sons Ltd decision (1996) RPC 281, page 306, line 1 (referred to as the TREAT decision):

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5 “Next, is “Treat” within Section 3(1)(b). What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word inherently from the old Act but the idea is much the same) devoid of any distinctive character.”

10 Although Justice Jacob’s comments were made in relation to the word “Treat”, they equally apply to marks which are combinations of words and/or devices and/or colours. When all the component parts of the marks are viewed as a totality and in the context of the products provided under the mark, the overall message which is likely to be conveyed to potential customers is an exhortation to taste or that the goods have taste (in the sense that they are tasty).

15 Regarding the second mark in which claim is made to the colours purple and green, although this makes the mark more striking than the black and white version, I do not accept that the presence of these colours affect the question of overall distinctiveness. From my own knowledge it is not uncommon for businesses and advertisers to use bold colours in this manner, especially in order that their promotional materials are made eye-catching to the consumer.

20 In the Proctor & Gamble Ltd’s Trade Mark Applications (1999) RPC 673, page 680, line 42, Lord Justice Robert Walker said:

25 “Despite the fairly strong language of section 3(1)(b), “devoid of any distinctive character”-and Mr Morcom emphasised the word “any” -that provision must in my judgment be directed to a visible sign or combination of signs which can by itself readily distinguish one trader’s product - in this case an ordinary, inexpensive household product - from that of another competing trader. Product A and Product B may be different in their outward appearance and packaging, but if the differences become apparent only on close examination and comparison, neither can be said to be distinctive....”

30 Therefore I take the view that the marks, whether represented in colour or black and white, are devoid of any distinctive character and that the public would require educating that the marks tendered for registration are badges of origin.

35 Ms Lazenby drew my attention to various earlier registrations (by other proprietors) and decisions on marks such as MR LONG, TREAT, AD2000, PRESTIGE SYSTEMS and RENOWN. Ms Lazenby argued that the applicant’s marks were as equally distinctive as those which had been allowed in the past (in particular TASTE! registered in Class 35 for advertising and public relations services) and urged me to accept the application. Whilst I was persuaded to accept the applicant’s marks in respect of catering and the like services, I remain of the view that in relation to food and drink, the marks are devoid of any distinctive character.

Conclusion

In conclusion, in the absence of evidence that the mark has acquired a distinctive character by reason of the use made of it, it is debarred from registration under Section 3(1)(b) of the Act.

5 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 Section 3(1)(b) of the Act.

Dated this 7 day of April 2000

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Charles Hamilton
For the Registrar
the Comptroller General

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