

THE PATENT OFFICE

Court Room 3,  
Harmsworth House,  
13-15 Bouverie Street,  
London, EC4Y 8DP.

Friday, 28th July 2000

Before:

**MR G HOBBS QC**  
(Sitting as the Appointed Person)

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In the Matter of the Trade Marks Act 1994

and

In the Matter of Trade Mark Application No: 2199175A by  
**COMPASS GROUP PLC** to register trade marks in class 30

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An appeal to the Appointed Person from the decision of  
Mr C Hamilton of 7th April 2000

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(Transcript of the Shorthand Notes of Marten Walsh Cherer Limited,  
Midway House, 27/29 Cursitor Street, London EC4A 1LT.  
Telephone No: 020 7405 5010. Fax No: 020 7405 5026.)

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**MISS D McFARLAND** (instructed on behalf of Messrs Sommerville &  
Rushton) appeared as Counsel on behalf of the Applicant.

**MR A JAMES** appeared on behalf of the Registrar, the Comptroller  
General.

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**D E C I S I O N**  
(As approved by the Appointed Person)

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MR HOBBS: On 4th June 1999 Compass Group Plc applied to register a series of two device marks for use as trade marks in relation to certain goods specified in class 30 and certain services specified in class 42. Representations of the device marks in question are shown in the appendix to this decision.

The goods of interest to the applicant in class 30 were:

"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."

The services of interest to the applicant in class 42 were:

"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."

As can be seen from the appendix to this decision, the second mark in the series featured a colour combination. The colours were described as the colours purple and green in the form of application for registration and in the form of application for registration there was a colour claim in respect of that combination in the conventional form of wording used for such purposes.

The marks in question were unused marks at the date of

1 the application for registration. The Registrar's examiner  
2 objected to registration, both in relation to class 30 and in  
3 relation to class 42, on the ground that the marks consisted  
4 essentially of the descriptive or laudatory word TASTE with  
5 the addition of non-distinctive background matter, the whole  
6 being devoid of distinctive character. Objection was taken  
7 under 3(1)(b) of the Trade Marks Act 1994.

8 A hearing was appointed to enable the applicant to make  
9 representations with regard to the registrability of the  
10 marks. That hearing took place on 11th November 1999 before  
11 the Registrar's hearing officer, Mr Hamilton.

12 Some time shortly after the hearing, the hearing officer  
13 indicated that the objection to registration in relation to  
14 the class 42 services would be waived. He nevertheless  
15 maintained the Registrar's objection to the application for  
16 registration of the marks in class 30.

17 In order to give effect to the hearing officer's  
18 decision, the application was divided with the application for  
19 registration in class 30 proceeding to rejection under number  
20 219917524 and the application for registration in class 42  
21 proceeding to advertisement under number 2199175B.

22 The hearing officer's formal written decision was issued  
23 on 7th April 2000. In that decision he noted that no claim to  
24 distinctiveness was made in relation to the word TASTE per se.  
25 He rejected the black and white representation in the series  
26 on the basis of the previously raised objection under section  
3(1)(b) of the Act. In relation to the colour representation,

the second mark *in* the series, he observed as follows on page 4 of his decision at line 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 affects 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."

The applicant now appeals to me against the rejection of the application for registration in class 30. On this appeal the applicant has made clear that it is willing to refine and further define the identity of the mark put forward for registration. For that purpose the applicant has indicated unconditionally that it is willing to amend application 2199175A to delete the black and white representation from the series, secondly, the applicant has indicated that it would unconditionally offer a disclaimer in relation to the use separately of the word TASTE-and a device of an exclamation mark and, thirdly, the applicant has offered unconditionally to limit the registration of the mark to the use of the colours purple and blue/green, as shown in the representations accompanying the form of application for registration. The reference to blue/green is intended to accurately describe the nature of the particular colour shown in the form of

1 application for registration, bearing in mind that some people  
2 may see it more as a blue colour than green and other people  
3 may see it to the opposite effect.

4 The question I have to consider on this appeal is whether  
5 the disclaimed word TASTE is graphically represented in a  
6 visually distinctive manner sufficient to indicate that the  
7 goods, with reference to which is to be used recurrently, come  
8 from one and the same undertaking. It is clear from the case  
9 law I am bound to apply that I must answer that question by  
10 reference to what I believe could be the perceptions of the  
11 average consumer.

12 With the benefit of the limitations and disclaimers,  
13 serving, as I think they do, to define a particular form of  
14 mark, that is to say a logotype mark, my conclusion is that  
15 the mark is susceptible of registration on the basis of the  
16 test I have just referred to. I think there is just enough  
17 visual elaboration of the word in the context of the logo as a  
18 whole to give it (i.e. the Logo as a whole) the Look and feel  
19 of a trade mark. I also think that that is the factor which is  
20 most likely to have influenced the hearing officer to accept  
21 the mark for registration in relation to the class 42  
22 services, for which it is now proceeding to advertisement and  
23 possibly beyond to registration.

24 For these reasons shortly stated, I propose to reverse  
25 the rejection of the application that is before me, remit the  
26 application to the Registry for further processing in  
accordance with the limitation, disclaimer and the proposed

amendment that I have outlined and on that basis to allow the appeal.

MISS MCFARLAND: I am grateful, sir.

MR HOBBS: You are not asking for costs and so we will continue the usual practice of treating this as a continuation of the ex parte procedure.

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**Taste!**

**Taste!**