

## **TRADE MARKS ACT 1994**

### **IN THE MATTER OF APPLICATION 2206281 BY UNILEVER PLC TO REGISTER A TRADE MARK IN CLASSES 29, 30, 32 AND 42**

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

On 18 August 1999 Unilever PLC of Port Sunlight, Wirral, Merseyside, L62 42A applied under the Trade Marks Act 1994 for registration of a series of two trade marks in Classes 29, 30, 32 and 42 for the following goods:

- Class 29 Meat, fish, seafood, poultry and game, preparations made from the aforesaid; charcuterie; paté; sausages; preserved, dried and cooked fruits and vegetables; jellies, jams, marmalades, preserves; pickles; chutneys; eggs; milk and milk products; edible oils and fats; meat and vegetable extracts; gelatine; mushrooms; nuts; snackfoods; sauces for use in cooking; prepared meals.
- Class 30 Tea, coffee, cocoa, drinking chocolate, coffee essence, coffee extracts, mixtures of coffee and chicory, chicory and chicory mixtures; all for use as substitutes for coffee; non-medicated confectionery; pastries, cakes, biscuits; ices, ice cream, ice cream products, frozen confections; chilled desserts, mousses, sorbets; bread; pastry; drinks, fillings; honey, treacle and sweet spreads; savoury spreads; snack foods, prepared meals and constituents for meals; chocolate; pizzas; pizza bases; sauces and toppings for pizzas; sauces for pasta and rice; salad dressings; mayonnaise; sauces; dips.
- Class 32 Beers, mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
- Class 42 Catering for the provision of food and drink for consumption on or off the premises; self-service restaurants; café, cafeteria, canteen, restaurant, snack bar, bar, food bar, wine bar services; preparation and catering for the provision of food and drink, catering services; rental of food and drink preparation and catering services; rental and leasing of vending apparatus and drink dispensing apparatus; advice, enquiry, consultancy and information services all relating to nutrition, food and beverages and products thereof; information and advisory services relating to health and healthcare.

The marks for which registration is sought are represented at Annex A.

Objection was taken to the marks under Sections 3(1)(a) and 3(1)(b) of the Act because the marks are incapable of distinguishing the goods and services of one undertaking from another.

At a hearing, at which the applicants were represented by Mr Hickey of Castles, their trade mark attorneys, the objection under Section 3(1)(a) was waived but the objection under Section 3(1)(b) of the Act was maintained and notice of refusal was issued on 16 May 2001.

Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

No evidence has been put before me. I have, therefore, only the prima facie case to consider.

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

3.-(1)

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

The test for distinctiveness was laid down by Mr Justice Jacob in the TREAT case [1996] RPC 281 page 306 lines 2-5 when he said:

“What does *devoid of 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?”

On the form of application, the representations of the marks consists of two devices. These marks appear to be identical in shape but differ in that the first mark is represented in various colours whereas the second mark is represented in black and white.

The marks applied for appear to consist of representations of loose particles arranged in a shape reminiscent of a leaf. In correspondence Mr Hickey submitted that the marks resemble an apostrophe mark but I do not accept that there is anything in these marks to support such a claim. In subsequent correspondence Mr Hickey advised that the marks are composed of collections of individual processed tea leaves.

At the hearing I accepted that the marks applied for may be interpreted as being the devices of tea leaves arranged in the shape of a leaf. Mr Hickey submitted that because the signs are not readily identified as being representations of anything in particular and that this uncertainty contributes to the inherent distinctiveness of the marks.

In subsequent correspondence Mr Hickey provided examples which purported to show how the signs are actually used in trade. Mr Hickey acknowledged that “there are some marginal distinctions between the mark filed and the examples of usage enclosed.”. In my view there are more than marginal differences involved. The signs represented in this evidence are not the same as the signs applied for and I can give no weight to this evidence.

The two trade marks consist of processed tea leaves arranged in a shape reminiscent of a leaf. In both marks the arrangement of the leaves and the shapes that they form are identical. The only difference between the two marks is that the first mark is filed in various colours. I note that the form of application does not contain a colour claim and, in accordance with Registry practice, and Rule 5(3) of the Trade Marks Rules 2000, I can take no account of the fact that the first mark is filed in various colours. However, it is worth noting that I do not consider that there is anything unusual about the colours used in the first mark.

It is not clear if the leaf shape is intended to represent leaves from any particular plant but I do not consider that there is any relevance in such a distinction. Members of the public, on encountering these signs, would simply see tea leaves. On closer inspection they may notice that the individual leaves have been arranged in a shape that is reminiscent of a leaf. In my view they will not attempt to identify the leaf with the intention of identifying the species of plant that it would come from. I believe that members of the public, when encountering these signs in relation to tea or tea related products or services i.e. tea rooms, would simply see them as indications that the aforesaid goods and services are provided at a particular type of establishment.

In the Proctor & Gamble Limited's application (1999 RPC 673), Walker L J said:

“ Despite the fairly strong language of s. 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”

The application has been filed in respect of a wide range of goods and services in Classes 29, 30, 32 and 42. The evidence already submitted in support of this application indicates that the signs are used in relation to tea or tea related products or services.

It is my view that the signs applied for are non-distinctive in relation to such goods and services. The remaining goods and services are clearly different and I accept that the objection is not valid in respect of them. However, as long as the specifications include tea or tea related products or services the objection under Section 3(1)(b) of the Act must be maintained.

In my view, anyone encountering these marks for the first time, will see them as non-distinctive devices and they will not be taken as trade marks without first educating the public that they are trade marks. It follows that the application is debarred from prima facie acceptance by Section 3(1)(b) of the Act.

In this decision I have considered all of the documents filed by the applicants 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 in that it fails to qualify under Section 3(1)(b) of the Act.

**Dated this 17 day of September 2001**

**A J PIKE**

**For the Registrar  
The Comptroller General**

ANNEX A

