

1 THE PATENT OFFICE

The Conference Room,
Harmsworth House,
13-15 Bouverie Street,
London EC4Y 8DP.

2
3
4 Wednesday, 17th April

2002

5 Before:

6 MR. S. THORLEY QC
(Sitting as the Appointed Person)

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8 IN THE MATTER of the Trade Marks Act 1994

9 and

10 IN THE MATTER of Trade Mark Application No.
11 2,158,336 for a device mark in Classes
12 3, 5, 39 and 42 now in the name of Lloyds
Pharmacy Limited as assignee of the
13 application from GEHE UK Plc.

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15 Appeal of Applicant from the decision of Mr. A.J.
16 acting on behalf of the Registrar, dated 9th
17 November,
2001.

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19 (Transcript of the shorthand notes of Marten Walsh Cherer

Ltd.,

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23 MR. J. MELLOR (instructed by White & Case) appeared on behalf
24 of the Applicant.

25 MR. D. MORGAN appeared on behalf of the Trade Marks Registry.

D E C I S I O N
(As Approved)

1 THE APPOINTED PERSON: 1. This is an appeal to the Appointed
2 Person from a decision of Mr. Pike, the Hearing Officer
3 acting for the Registrar, dated 9th November 2001, which
4 followed a hearing on 21st July 2001. It was an ex-parte
5 hearing in relation to an application no. 2,158,336 by a
6 company called GEHE UK Plc to register a trade mark in
7 Classes 3, 5, 39 and 42 in relation to goods of a nature
8 which would be sold in a chemist's shop, to transport
9 relating to pharmaceutical products and to pharmacy services.

10 2. The mark in question is a stylised form, which is shown
11 in paragraph 1 of Mr. Pike's decision. It consists of what
12 is plainly intended to be a pestle and mortar surrounded by a
13 circle.

14 3. The objection with regard to Class 39 was withdrawn,
15 and this appeal is not concerned with that part of the
16 application.

17 4. In his decision, Mr. Pike maintained an objection taken
18 under section 3(1)(b) of the Act on the basis that the mark
19 consists of "the device of a mortar and pestle which was
20 devoid of distinctive character"; for example, for goods
21 which are mixed together using this method and services
22 relating thereto.

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

24 "3(1) The following shall not be registered.

25 "(b) trade marks which are devoid of any distinctive

1 character".

2 6. This was a mark which was unused as at the date of
3 application, which was 14th February 1998, and therefore
4 there was no question of considering whether or not the mark
5 had become distinctive as a result of use made of it, and
6 therefore registrable by virtue of the proviso to section 3.

7 7. Mr. Pike stated the test for distinctiveness pursuant
8 to section 3(1)(b) by reference to that laid down by
9 Jacob J. in the TREAT case [1996] RPC 281, page 306, when he
10 said: "What does 'devoid of distinctive character' mean? I
11 think the phrase requires consideration of the mark on its
12 own, assuming no use. Is it the sort of word (or other sign)
13 which cannot do the job of distinguishing without first
14 educating the public that it is a trade mark?"

15 8. Mr. Pike then considered the facts of the case, and he
16 concluded as follows in paragraphs 10 and 11:

17 "10. This application is for a sign which appears to
18 be a representation of a mortar and pestle contained within a
19 circle. A mortar is a vessel in which substances are ground
20 or crushed with a pestle, a pestle being the tool used to
21 crush, mash or grind materials in a mortar. To my own
22 knowledge the mortar and pestle has been in use as a tool by,
23 inter alia, pharmacists and chemists for many years. Whilst
24 I accept that in these days there may well be more modern and
25 more efficient tools available for such activities I am of

1 the view that the device of a mortar and pestle remains as a
2 symbol which indicates the nature of the goods and services
3 provided by pharmacists and chemists."

4 "11. The representation of the mortar and pestle
5 contained in this application is in outline and it is
6 represented in such a way that it may be described as one
7 being superimposed on the other. The representation has the
8 effect of portraying a pestle placed inside a mortar, this
9 being enclosed within a circle. In my view the circle itself
10 is a simple geometric device which does no more than provide
11 a basic border to the more substantial elements of the mark."

12 9. As a result of this, he concluded that the degree of
13 stylisation was so small and insignificant that the mark
14 would be seen by any prospective purchaser as an ordinary
15 representation of a mortar and pestle, which he considered to
16 be totally non-distinctive. He, therefore, refused the
17 registration.

18 10. Against that decision the assignees of the application,
19 Lloyds Pharmacy Limited, have appealed by a notice of appeal
20 dated 6th December 2001, and they have been represented at
21 the hearing of this appeal by Mr. Mellor of Counsel. Mr.
22 Mellor supplied me with a very full skeleton outlining the
23 points which were to be taken on this appeal, and I think I
24 can, without injustice, summarise them as being two. First,
25 he said that Mr. Pike on 21st July 2001 did not have the

1 advantage of being able to consider the judgment of the Court
2 of Justice of the European Communities in the Baby-Dry case
3 -- Procter & Gamble Company v. Office for Harmonisation in
4 the Internal Market [2002] ETMR 22. This Judgment was given
5 on 20th September 2001. It was Mr. Mellor's contention that
6 this Judgment had introduced a test which was very different
7 to that of the test laid down by Jacob J. in the TREAT case,
8 so, he contended, the Hearing Officer had approached the
9 question of registrability on the wrong basis.

10 11. Secondly he contended that in any event the degree of
11 stylisation in this mark was sufficient to warrant
12 registration even on the somewhat stricter test that he felt
13 Jacob J. had set.

14 12. I turn, first, to the Baby-Dry case. This case has
15 already been the subject of a number of comments both in the
16 courts in this country and before the Appointed Persons. I
17 do not propose in this Judgment to set out the whole of
18 paragraphs 35-43, which embody the substance of the Judgment.
19 Mr. Mellor is entirely correct that in paragraphs 35 and 36
20 the court drew attention not only to the requirement of
21 distinctiveness under Art. 7.1 of Regulation 40/94, the
22 equivalent of section 3 of our Act, but also to Art. 12,
23 which equates to the defences available to infringement.
24 Hitherto in this country, it was customary to consider the
25 question of registrability without regard to the possibility

1 that once registered a party may be able to plead a defence
2 to infringement by reason of a non-trade mark use. It is
3 plain from Baby-Dry that that consideration now carries less
4 weight.

5 13. The Judgment in Baby-Dry, however, sets out the manner
6 in which registrability is to be tested and this can, in my
7 judgment, best be identified from the language of paragraph
8 42, where, dealing with word marks, the Court stated: "The
9 determination to be made depends on whether the word
10 combination in question may be viewed as a normal way of
11 referring to the goods or of representing their essential
12 characteristics in common parlance." Plainly, the test can
13 be re-stated to deal with device marks of the sort we have
14 here.

15 14. Can the device in question be viewed as a normal way of
16 referring to the goods or services in question, or of
17 representing their essential characteristics? As a matter of
18 wording, I do not perceive that there is any difference
19 between that approach and the approach of Jacob J., who posed
20 the question: Is the word or other sign one which cannot do
21 the job of distinguishing?

22 15. The difference, if there be one, I think, is a
23 difference of degree. Mr. Mellor submitted that Baby-Dry
24 would never have been registered as a trade mark without
25 evidence of distinctiveness by the UK Registry prior to the

1 Baby-Dry mark. I think there is substance in his submission.
2 Therefore, in approaching the registrability of a mark after
3 Baby-Dry I do not think that it is correct to conclude that
4 the approach to testing for distinctiveness is different.
5 However, it may well be that on the facts of a particular
6 case a mark which previously would not have been registrable
7 may now be registrable if one asks the question that one is
8 required to ask, namely, "Is the mark a normal way of
9 referring to the goods?"

10 16. Each case must be a question of fact and degree, and
11 any attempt on my part to lay down strict guidance is fraught
12 with difficulty. I do not propose to do so.

13 17. I turn then to the facts in this case. The device is,
14 undoubtedly, a device which shows a pestle and mortar. It is
15 a stylised pestle and mortar. It is a very simple
16 stylisation. Mr. Mellor suggested in his skeleton that it
17 was "minimalist" -- I agree -- but the fact that it is
18 minimalist does not mean that it is not eye-catching and does
19 not mean that it is incapable of distinguishing.

20 18. Mr. Mellor criticised Mr. Pike for adopting what he saw
21 as an old-fashioned view of the significance of a pestle and
22 mortar, and in particular criticised his conclusion that the
23 device of a pestle and mortar remained a symbol which
24 indicated the nature of goods and services provided by
25 pharmacists.

1 19. This raises a difficulty which not infrequently occurs
2 in ex-parte proceedings. The Hearing Officer has to use his
3 own judgement in default of evidence as to what a word or a
4 device means or would indicate to the relevant consumer.
5 Hearing officers have significant experience in performing
6 this task and it is plainly right that they should do so
7 without, in every case, placing a burden upon the applicant
8 of adducing evidence designed to assist the Registrar in
9 reaching a decision. It would be an intolerable burden on
10 the system if that had to be done in each case.

11 20. Mr. Morgan, who appeared on behalf of the Registrar
12 before me, suggested that if a challenge of this nature were
13 to be mounted on appeal, (it apparently not having been at
14 any rate at the forefront of the argument on the hearing) it
15 would be right to remit the matter to the Registry for
16 relevant evidence to be filed. This, of course, is a step
17 which is open to me, but it is a step which I would take with
18 the greatest reluctance. The mark was applied for in
19 February 1998, over four years ago, and there is a public
20 interest in ensuring that marks be registered or rejected as
21 early as possible. Therefore, it is only in an exceptional
22 case that I would adopt the course of remitting a matter.

23 21. In the present case, I do not believe that it is
24 necessary for me to remit this case. I have felt able to
25 come to a conclusion on the matter as it stands before me.

1 22. Although there are three classes of goods and services,
2 I do not believe that any logical distinction can be drawn
3 between them. The Class 42 Pharmacy services mark relates to
4 the services of an ordinary chemist and the goods in question
5 are, in general terms, goods which would be sold through a
6 chemist's shop. Undoubtedly, in the past, as Mr. Mellor
7 accepts, a device of a pestle and mortar was a symbol which
8 was used in relation to the pharmacy profession, and he told
9 me that in Boots in High Holborn there is still a
10 representation of a pestle and mortar on the shelf above the
11 pharmacy department. He does not, therefore, quarrel with
12 the fact that a pestle and mortar might be a symbol which
13 could indicate the nature of goods and services provided by
14 pharmacists and chemists, but what he does say is that,
15 having regard to the language of Baby-Dry, a pestle and
16 mortar is not a normal way of referring to pharmaceutical
17 goods or services or of representing their essential
18 characteristics in common parlance. I agree.

19 23. I have come to the conclusion that following the
20 guidance of the Court of Justice in Baby-Dry I must have
21 regard to the actual representation of the mark and to ask
22 whether that representation may be viewed as a normal way of
23 referring to pharmaceutical services. In reaching the
24 conclusion that it does not, I do take into account the
25 stylisation of the mark. It impressed me as being both

1 eye-catching and, to use Mr. Mellor's word, minimalist, but
2 nonetheless distinctive. It is not merely a pestle and
3 mortar.

4 24. I must approach this case on the basis of the mark
5 applied for and should not be distracted into considering
6 whether any device of a pestle and mortar would be
7 unregistrable. Approaching this case on the basis of that
8 mark and taking into account the facts I have, I am satisfied
9 that it is not barred from registration by virtue of section
10 3(1)(b) and, accordingly, this appeal succeeds.

11 Normal order? No costs?

12 MR. MELLOR: Yes, Sir. Thank you.

13 MR. MORGAN: Thank you.

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