

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION
Nos 1489981, 1541166, 1569226, 1541165 AND 1440569
IN THE NAME OF FERRERO S.P.A AND
SOREMARTEC S.A.**

AND

**IN THE MATTER OF CONSOLIDATED APPLICATIONS
FOR DECLARATIONS OF INVALIDITY THERETO UNDER
Nos 9547, 9550, 9551, 9552 and 9553 BY SOLDAN HOLDING &
BONBONSPEZIALITATEN GMBH**

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in the name of Ferrero S.p.A. and Soremartec S.A.**

AND

**IN THE MATTER OF Consolidated applications for
Declarations of Invalidity thereto under Nos 9547,
9550, 9551, 9552 and 9553 by Soldan Holding &
Bonbonspezialitäten GmbH**

BACKGROUND

1. On 30 April 1997, Soldan Holding & Bonbonspezialitäten GmbH of Nurnberg, Germany, applied for declarations of invalidity against registration Nos 1489981, 1541166, 1569226, 1541165 and 1440569 standing in the names of Ferrero S.p.A. and Soremartec S.A. Full details of these registrations are provided in the Annex to this Decision.

2. The applications for invalidity were subsequently consolidated. The applicants Statements of Grounds filed in the respective actions are, essentially identical, (save where it is necessary for them to refer to the respective registered proprietors' domicile i.e Belgium and Italy). Reproduced verbatim below is the Statement of Grounds filed in relation to registration No 1541166:

“1. Registration No 1541166 should be declared invalid under Section 47 of the Trade Marks Act 1994. The applicant requests that the registration is revoked and removed from the register.

2. The trade mark the subject of the registration was invalidly registered in that it did not at the date of the application and does not now comply with the provisions of Section 3(1)(a) of the Act. The trade mark was not at the date of application and is not now capable of distinguishing the goods of the proprietor from those of other undertakings. The trade mark does not now have a distinctive character.

3. The trade mark was invalidly registered in that it did not at the date of the application and does not now comply with the provisions of Section 3(1)(b) of the Act. The trade mark was at the date of application and is now devoid of any distinctive character.

4. The trade mark was invalidly registered in that it did not at the date of the application and does not now comply with the provisions of Section 3(1)(c) of the Act. The trade mark did at the date of the application and now consists exclusively of a sign which serves in the trade to designate the kind, quality, intended purpose and

other purpose of the goods. It describes them as being suitable for children. The trade mark does not now have a distinctive character.

5. The trade mark was invalidly registered in that it did not at the date of the application and does not now comply with the provisions of Section 3(1)(d) of the Act. The trade mark did at the date of the application and now consists exclusively of a sign which is customary in the current language and in the bona fide and established practices in the trade. The word “kinder” is used to describe the goods as being for or suitable for children. The trade mark does not now have a distinctive character.

6. The trade mark was not at the date of registration distinctive or alternatively it should be revoked as no longer being distinctive.

7. The trade mark was invalidly registered in that it did not at the date of the application and does not now comply with the provisions of Section 3(3)(a) of the Act. The registration stops members of the public using a word which they require and are entitled to use in ordinary everyday language to describe the goods as being for or suitable for children. It is clear policy that members of the public should be free to use words according to their ordinary meanings and usage. This policy is for example shown in Section 11 of the Act.

8. The trade mark was invalidly registered in that it did not at the date of the application and does not now comply with the provisions of Section 3(3)(b) of the Act. Use by the proprietor leads members of the public to believe that the proprietors goods are made by a German/Austrian company, or made to an authentic German/Austrian recipe in Germany/Austria. However, the proprietor is Belgian. The public are therefore deceived by the trade mark.

9. The trade mark was invalidly registered in that it did not at the date of the application and does not now comply with the provisions of Section 3(3)(b) of the Act. The trade mark at the date of application and now consists exclusively of a sign which manufacturers of children’s products from Germany and Austria require and are entitled to use in ordinary everyday language to describe their products as being for or suitable for children. Use by the proprietor on products other than those for children would deceive members of the public.

10. The trade mark was invalidly registered in that it did not at the date of the application and does not now comply with the provisions of Section 3(4) of the Act. The trade mark at the date of the application and now consists exclusively of a sign which manufacturers of children’s products from Germany and Austria require and are entitled to use in ordinary everyday language to describe their products as being for or suitable for children. Labelling laws require proper, informative and non-misleading labels to be applied.

11. This registration was filed in “bad faith” and was therefore registered contrary to the provisions of Section 3(6) of the Act. The proprietor did not at the time of filing and does not have any intention of using the trade mark the subject of the registration

either at all or alternatively for all of the goods covered by the registration. Further, the proprietor simply filed this registration in an attempt to obtain an extended yet illegitimate coverage of the descriptive word “kinder” (being the German word for “child”). Our enquiries have revealed that this registration has not been genuinely used in the UK by the registered proprietor or with its consent on any of the goods for which it is registered during the past five years."

3. The registered proprietors filed counterstatements which, in essence, consist of a denial of the various grounds of invalidation. In paragraph 13 of the various counterstatements they comment as follows:

“13. To the extent that it is deemed that the trade mark was registered in breach of subsection (1)(b), (c), (d) of Section 3 of the Act, which is denied, the trade mark should not be declared invalid, having acquired a distinctive character in relation to the goods for which it is registered in consequence of the use that has been made of it."

4. Both sides ask for the Registrar to award costs in their favour and both sides filed evidence. Although the evidence filed by the respective parties is essentially identical, the material dates of the various trade marks under attack differ; I have of course borne this aspect in mind in reaching my decision. The matter came to be heard on 29 May 2002. The applicants for invalidation were represented by Mr Richard Arnold of Her Majesty’s Counsel instructed by Boulton Wade, Tennant, Trade Marks Attorneys and Carpmiels & Ransford, Trade Mark Attorneys; the registered proprietors were represented by Mr Michael Edenborough of Counsel instructed by Taylor Joynson Garrett, Solicitors.

Applicants for Invalidity’s Evidence

5. This consists of five statutory declarations. The first three declarations are by David John Rickard. Mr Rickard confirms his position as a trade mark agent, solicitor and a partner in the firm of Boulton Wade Tennant. He confirms that his declarations are based on his own knowledge and on documents to which he refers. I note that his declarations vary only to the extent necessary to refer to the various trade marks and the goods for which they are registered. Paragraphs 2 to 6 of his first declaration are reproduced verbatim below:

“2. Now produced and shown to me marked exhibit DJR1 are copy extracts from the 1997 edition of Statistisches Jahrbuch produced by Statistisches Bundesamt. The extracted page 273 relates to tourism in Germany. On page 273 numbers of tourists visiting Germany from various countries are shown for 1996. 1,350,400 tourists from the UK, including Northern Ireland, visited Germany. 2,946,700 nights were spent by UK tourists in Germany. Extracted page 82 shows the number of Germans emigrating to various countries. In 1996 in excess of 20,000 Germans migrated to the United Kingdom (including Northern Ireland). Also included in exhibit DJR-1 is a copy extract from the 1997 edition of the Austrian Tourist Office Annual Report. In 1997 531,926 tourists from the UK visited Austria. 2,478,040 nights were spent by UK tourists in Austria in 1997.

3. Now produced and shown to me marked exhibit DJR-2 are copy extracts from two books available in the United Kingdom namely "German In Three Months" published by Hugo's Language Books Limited and "Ealing Course in German" published by Longman. These books teach German language to English speakers. I note from the "German-English vocabulary" section of the Hugo book that the word "kinder" means "child". Lesson 1 of the Hugo book deals with the general principles of speaking German and in particular, "the alphabet, spelling and pronunciation, vowels and vowel combinations, consonants, punctuation and stressed syllables". Lesson 2 deals with "greetings, every day phrases", "gender" and other basics. In lesson 2, the reader is introduced to certain German words. On page 23 the word "kind" is taught and is said to mean "child". On page 24 the reader is taught the plural of the noun is "kinder". This lesson includes various exercises which make reference to the words "kind" and "kinder". In the Longman book, the reader is introduced to the word "kinder" in lesson 3. In both books, the word "kinder" is introduced at an early stage in the lessons programs.

4. When studying for European Patent Examinations, I learnt some German language. One of the earliest words which I learnt was "kinder" meaning "child". I believe that this word is taught to students learning the German language at an early stage in most cases in the UK. The word "kinder" is one of the German words which I still recall from my lessons including its meaning of "child". This word has made its way into the English language in words such as "kindergarten".

5. Also included in exhibit DJR-2 is a copy extract from the Times Educational Supplement of 28 August 1998 listing the numbers of students who sat various GCSE exams in 1997 and 1998. German was the second most popular foreign language subject and apparently the tenth most popular course overall. I note that the total number of students who sat the exam for German in 1998 was 133,683. The number of 1997 was 132,615.

6. Now produced and shown to me marked exhibit DJR-3 is a copy extract from the Shorter Oxford Dictionary. The word "kind" is a well known English word and the word "kinder" is a variation of the word "kind". It means more "acceptable, gentle, agreeable, soft". I also note that the German word is listed with its English meaning of "children" thereby establishing that it is recognised generally in the UK. Also included in Exhibit DJR-3 are copy extracts from Dutch-English, Afrikaans-English, German-English and Spanish-English dictionaries. Each of these shows that the word "kind" and "hence "kinder" are words in these languages."

6. The main points emerging from Mr Rickard's second declaration are, in my view, as follows:

- exhibit DJR-5 consists of copies of letters dated 28 November 1997 and 2 June 1999 received by his firm from the Office for Harmonisation in the Internal Market (OHIM) in response to an application to register the trade mark KINDERCARE. Mr Rickard notes that the Examiner in rejecting the application stated that "kinder is a German word known throughout the Community to mean "child" or "children", that the trade

mark “conveys a simple and obvious descriptive meaning” and that the combination is desirable for other traders to use in the course of trade as a descriptive indication. The mark nonetheless would be readily understood in English, German and Dutch as being primarily descriptive. The mark merely indicates goods and services for children which involve care or caring”;

- exhibit DJR-7 is a copy of a Decision of the German Patent Office together with an English translation. The Decision dated 25 July 1997 relates to an opposition by Ferrero to registration of the trade mark KINDER EUKAL. Mr Rickard refers to the following passages from the Decision:

“In the present case, the first element “kinder” of the multiple word mark points out to the addressed consumers i.e. children, the particular suitability of the goods marked this way in a descriptive manner and is not suitable to shape the attacked mark by itself. The addressed consumers will not be enabled to make reference from the word “kinder” the place of origin on the goods labelled with the trade mark in dispute and, therefore, such consumers will base their distinction of this trade mark.....predominantly upon the element “eukal”. For this reason, the risk may be neglected that the addressees will compare the element “kinder” separated from the rest with the prior trade mark. Thus a direct risk of confusion can be denied. In addition, there is no risk that the attacked mark may be associated with the opposing mark.”

“In view of the insufficient distinctiveness of the word “kinder” it lacks the suitability to serve as a reference necessary to infer to the identical place of origin of the goods. ”

- exhibit DJR-8 consists of copies of various Internet web sites which include KINDER in connection with children.

7. The main points emerging from Mr Rickard’s third declaration are, in my view, as follows:

- exhibit DJR 9 consists of copies of Decisions of the German Patent Office (together with English translations) in cases S112/97 and S175/96. He explains that in S112/97 the German Patent Office held that registration No 39610402 for a stylised representation of the words FUR-KINDER was invalid. Mr Rickard says that it was held that “the trade mark (FUR-KINDER) is devoid of the necessary minimum degree of distinctiveness stating that “the word elements have a mere factual character” and the registration was cancelled. The Patent Office held “on its own the words FUR-KINDER obviously represent a statement of determination, as children form the preferred target for the products in question ie confectionery, and as such goods with respect to their composition, taste and presentation are frequently in particular designed to the needs and desires of children”. He adds that the Patent Office went on to hold that “it is also conventional to refer to such kind of determination within the product group “confectionery” by way of a determination like “FUR-KINDER”.

Consequently, it can be held that competitors have a great interest in having these words reserved for free use of all”;

- in so far as the Decision in S175/96 is concerned, the German Patent Office held that trade mark No 39610406 CHILDREN’S CHOCOLATE should be cancelled. The Office held that “on its own the words CHILDREN’S CHOCOLATE originating from the English language represent a typical description of goods with the meaning “chocolate for children”. It held that “children form a preferred target group for the goods of the type claimed” “hence, for the concerned goods, which may all be made of chocolate or at least may contain chocolate, the attacked mark merely contains a reference to chocolate products, which are in particular intended for or suitable for children. This is easily comprehensible for the major part of the domestic consumers”;
- exhibit DJR-10 consists of copy extracts printed from a search of a CD provided by BT containing telephone listings for the UK, the results of a search of Yellow pages on the Internet and copy extracts of various BT telephone directories published in 1997 for areas of the United Kingdom all in relation to the word KINDER. Mr Rickard estimates that the directories searched constitute approximately 60% of the BT directories covering the United Kingdom. Mr Rickard notes that the names of some of the entries describe the nature of the business and adds that on 16 February 2000 his assistant Julius Stobbs telephoned a number of entries from the list to establish the nature of their business. Of the ten companies Mr Stobbs contacted, I note that all were involved with goods and services relating to children;
- exhibit DJR-11 consists of details of United Kingdom and Community trade mark registrations which include the word KINDER which are not owned by the registered proprietors in these proceedings;
- that a search of the web site of www.foodanddrink.co.uk of William Reed Publishing Limited which is a recognised industry standard database of food and drink products, shows that the registered proprietors do not supply any products other than chocolate eggs, chocolate bars, chocolates, chocolate spread and small sweets known as TIC TACS. Copy pages from the web site are provided as exhibit DJR12. From this Mr Rickard concludes that the registered proprietors do not supply either all or some of the goods listed in their registrations.

8. Mr Rickard concludes his declarations with the following comments directed towards the individual marks that are the subject of these applications for declarations of invalidity.

Registration No 1489981 - KINDER SNAPPY

“The word “snap” is defined in the Chambers Dictionary as “to make a bite; to speak tartly in sudden irritation; to grasp; to shut suddenly eg by a spring; to make a sharp noise; to break suddenly.....to bite suddenly...”. The word “snappy” is the adjective of the word “snap”. It is defined in the same dictionary as “snappish; snapping; having the quality of snap; instantaneous; smart, fashionable, polished”. Now produced and

shown to me marked Exhibit DJR-13 is a copy extract from that dictionary. The word SNAPPY is descriptive in relation to “biscuits, confectionery, wafer balls” in several different ways. The addition of this word to the descriptive word KINDER does not create a distinctive whole. In the context of these goods the word SNAPPY refers to the quality of being breakable in parts. The trade mark KINDER SNAPPY describes children’s biscuits, confectionery or wafer balls intended for children which are breakable in parts. The word SNAPPY can mean the quality of breaking with a sharp noise/cracking sound. The trade mark KINDER SNAPPY describes children’s biscuits, confectionery or wafer balls which make a sharp noise when they are broken. Alternatively, the word SNAPPY can mean fashionable or trendy and as such the trade mark KINDER SNAPPY could be taken as descriptive of biscuits, confectionery or wafer balls intended for fashionable or trendy children. Alternatively, it describes the products themselves as being fashionable or trendy and suitable for children.”

Registration No 1541166 - KINDER TIME

“The addition of the word TIME to the non-distinctive word KINDER does not add any distinctive matter. The combination of words is not distinctive. The combination of this word to certain other descriptive words creates a descriptive phrase or expression, for example, the phrases “play time”, “break time”, “meal time” are descriptive and not inherently registrable as trade marks in relation to goods in Class 30. The phrase “kids time” or “children’s time” (which are the equivalent of the KINDER TIME trade mark) are no different from these descriptive phrases. The phrase describes a particular time or treat for a child. It describes the goods in Class 30.”

Registration No 1569226 - KINDER TONUS

“The addition of the word TONUS to the non-distinctive word KINDER does not create a distinctive whole. The word “tonus” is defined in the Chambers Dictionary as “the normal elasticity of healthy muscle at rest, tonicity”. Now produced and shown to me marked exhibit DJR-13 is a copy extract from the dictionary. The trade mark KINDER TONUS describes food products which are intended to maintain or to produce healthy and/or fit children’s bodies. With the growth of health food products in today’s market traders increasingly require the use of words such as TONUS to describe their products. The phrase KINDER TONUS is not a distinctive trade mark of Soremartec S.A. Even if it was proved to be distinctive of Soremartec S.A. on the date of filing application No: 1569226 it can not be regarded as such in today’s market.”

Registration No 1541165 - KINDER TIME - same comments as registration No 1541166 above.

Registration No 1440569 - KINDER CUORDIFRUTTA (stylised)

“The addition of the word CUORDIFRUTTA to the non-distinctive word KINDER does not create a distinctive whole. The word CUORDIFRUTTA is a mere

combination of three known Italian words, namely “cuore” meaning heart, “di” meaning of and “frutta” meaning fruit. It means “heart of fruit”. This is reinforced by the fact that the phrase “cuore di...” is used as an expression in advertising by Italian companies in the UK. The trade mark KINDER CUORDIFRUTTA describes pastry, confectionery, ices or sorbets intended for children and containing fruit; the “heart of fruit” indicating the best part therefore indicating better quality or tasting fruit flavoured children’s products.”

9. The fourth declaration dated 17 March 2000 is by Berenice Patricia Bella Harris. Ms Harris is a registered trade mark agent and a solicitor in the employ of Carpmaels & Ransford. The purpose of her declaration is to have admitted into these proceedings a declaration and exhibits made by her and dated 1 March 2000 which were originally filed in related opposition proceedings No 47934. These documents are attached to her declaration as exhibit BPBH-1.

10. In her declaration Ms Harris explains that she has undertaken or arranged for various searches to be carried out to show the use made of KINDER in the United Kingdom. The nature of these searches were as follows:

(1) An on-line search of Yellow Pages on the Internet for businesses which included the word KINDER. A copy of the search report is provided as exhibit JDM1 to the declaration of James Dominic Moore to which I shall refer later in this decision. Having used the “?” symbol to reveal the nature of the business, Ms Harris explains that the report was annotated accordingly. Having explained the limitations of the search system used (to the effect that the search only revealed businesses where KINDER forms part of the first word or entry or where the first word is an initial or preposition), Ms Harris concludes that the search shows widespread use throughout the United Kingdom of KINDER in the context of businesses related to children.

(2) On-line searches on the Companies House web site for companies using the word KINDER in their names. Ms Harris explains that she searched in the “Companies Name & Address Index with Basic Company Information” entering KINDER against “Company/Branch name” in the search engine and selected searches in respect of (1) Current/Recently Dissolved names, (2) Previous names and (3) Dissolved names. Copies of the list of “Current/Recently Dissolved names” and the list of “Previous names” together with attached company particulars are provided as exhibits JDM2 and JDM3 to the declaration of Mr Moore. Exhibit BPBH8 consists of a copy of the list of “Dissolved names”. Ms Harris explains that as these were all dissolved companies which could not be contacted for further information individual company searches were not performed. However she notes from the list of “Dissolved names” that in many cases KINDER was used in the context of a business related to children.

(3) Search International were instructed to carry out a United Kingdom “Common Law” search for KINDER to include use as a business name, trade mark or descriptively in respect of any goods or services related to children. A copy of the search report is provided as exhibit JDM4 to the declaration of Mr Moore.

11. Ms Harris explains that the reports mentioned above were passed to Mr Moore with instructions to telephone as many of the businesses as he could with a view to establishing whether the businesses or products were child-related, how long KINDER had been used in the name and why it was chosen. While not summarised here, Ms Harris explains in detail the manner in which the various reports were annotated by her prior to them being given to Mr Moore. She adds that she also asked Mr Moore to inspect the 1994 telephone directories maintained by British Telecom Archives and to obtain copies of any entries for businesses which included KINDER in their name; Mr Moore was asked to cover as many regions as possible. Copies of Mr Moore's investigations in this regard are provided in exhibit JDM6 to his declaration.

12. Finally Ms Harris explains that Search International were instructed to carry out a United Kingdom "Similarity Search" in respect of EUKAL in Classes 5 and 30 to establish to what extent third parties might have pending or registered trade marks in or covering the United Kingdom similar to the EUKAL part of the applicants' mark. A copy of the report is provided as exhibit BPBH11 with Ms Harris concluding from it that EUKAL is highly distinctive for the goods covered by the application.

13. In so far as the searches mentioned above are concerned, Ms Harris comments:

"I believe that it is apparent from the searches carried out on behalf of the applicant that KINDER is widely understood and used throughout the United Kingdom as referring to children and that this was also the case at the date of the application in suit."

14. The fifth declaration also dated 17 March 2000 is by James Dominic Moore. The purpose of his declaration is, like Ms Harris above, to have admitted into these proceedings a declaration and exhibits made by him and dated 1 March 2000 also originally filed in related opposition proceedings No 47934. This is attached to his declaration as exhibit JDM-1.

15. In his declaration Mr Moore explains that he is a trainee trade mark agent in the employ of Carpmaels & Ransford. Mr Moore states that he has been assisting Ms Harris who has the conduct of these proceedings on behalf of the applicants for registration. He explains that on 18 February 2000, Ms Harris gave him copies of the documents mentioned in her second declaration above. Mr Moore explains that Ms Harris suggested the businesses which he might contact by annotating the pages accordingly; he confirms the instructions given to him by Ms Harris which included not contacting the list of Kindergartens from the Search International Report or any business where it was clear that the name of the business clearly derived from the name of an individual or where the business clearly would not be related to children. Having obtained in so far as was possible the telephone numbers of the companies on the respective lists, Mr Morris explains that he contacted the companies concerned identifying himself as a trade mark agent who was conducting a survey of companies that included KINDER in their name. Not surprisingly, Mr Morris was not able to obtain information from all the companies he contacted. Of those who were willing to assist, he asked the following questions; (1) what is your company's business? (2) how long has your company used a name that contained KINDER? (3) why was the company name that included the word KINDER chosen? (4) the name of the person to whom Mr Moore spoke. The

results of his investigations are provided in exhibit JDM5. I note that in response to question (3), the majority of the responses suggest that the name was chosen because it means or relates to children.

16. Mr Morris explains that in so far as the Search International Report was concerned, that he tried on 25 February 2000 to contact the businesses responsible for the following products: KINDERVITAL, KINDERVITAL P.R.O.D., KINDERGUARD, KINDERBOX, KINDER WORLD and KINDERCRYL. Mr Moore provides the results of these investigations and comments:

“On the various occasions when the persons to whom I spoke answered to the effect that KINDER means children in German, I formed the impression, from the way they said this, that they thought that this was obvious and well-known.”

17. In so far as Mr Moore was asked to obtain copies from the BT Archive of extracts from BT telephone books for 1994 which showed entries for businesses which included KINDER in their name, Mr Moore explained that he visited the BT Archive in High Holborn, London on 22 February 2000. During his visit, explains Mr Moore, he reviewed the 1994 London Business Pages and regional 1994 BT telephone books, although because of time constraints he was unable to review all of the documents and selectively ignored some of the rural Scottish and Welsh directories. Exhibit JDM6 consist of copies of pages from the various 1994 telephone directories showing business names beginning with KINDER.

Registered Proprietors’ Evidence

18. This consists of a witness statement dated 15 January 2001 by Martin Krause who is a trade mark agent and a partner in the firm of Haseltine Lake Trademarks who are the registered proprietors professional representative in these proceedings. In paragraph 1 of his witness statement Mr Krause says:

“Unless otherwise stated, this witness statement is based on my own knowledge or is derived from other documents to which I refer specifically. I am also a German speaker with a good knowledge of the German language.”

19. Mr Krause divides his response to the applicants’ evidence into a number of sub-headings drawing conclusions where appropriate. He begins by reviewing the **meaning of the word KINDER**. Exhibit MHK1 and MHK2 are respectively, copies of page 854 of the Collins English Dictionary (third edition) 1994 which says Mr Krause lists all words in the dictionary commencing with the letters KIND and pages 472 and 473 of the Oxford Pocket Dictionary (sixth edition) dated 1978 showing, he says, the same results as the Collins dictionary. Mr Krause accepts that the word “kind” is widely known as the comparative form of the adjective “kind”. In so far as Mr Rickard relies on an extract from New Shorter Oxford Dictionary, Mr Krause notes that two entries incorporating the word kinder are identified, these are: KINDER, KIRCHE, KUCHE and KINDERSPIEL. Of these entries Mr Krause says:

“I am unaware of any use of either the above phrase or the above word in common

parlance. I am aware that the New Shorter Oxford English Dictionary includes a number of references to obsolete, archaic and dialectal words, as well as many words and phrases which, though still in occasional use, are used only by a very small minority of the population. I believe, therefore that the phrase KINDER, KIRCHE, KUCHE and the word KINDERSPIEL are now either obsolete in the English language or are used only by a very small minority of the population of this country”

and he concludes that there is no indication that the word “kinder” had “made its way into the English language” at the relevant date, other than as the comparative form of the English word “kind”.

20. In relation to the **use of the word KINDER**, Mr Krause notes that the search of the 1994 telephone directories referred to in Mr Moore’s declaration (exhibit JDM6) alone reflects the position at the material date (and then only in respect of the trade mark KINDER TONUS). Mr Krause comments that it is apparent from the searches that the word “kinder” is a surname adding that the respective searches revealed only nine businesses in the London area and around one hundred businesses elsewhere whose names consist of or commence with the word “kinder”.

21. Exhibit MHK3 consists of four declarations previously filed in related Opposition proceedings No 47934. These are as follows:

(i) The declaration of Ms Vivienne Wooll dated 5 February 1999. Ms Wooll states that she is the Manager External Affairs of Ferrero UK Limited, a member company of Ferrero Group (the Group) of which Ferrero SpA of Cuneo, Italy and Soremartec S.A. of Schoppach-Arlon, Belgium are also members (the Companies). Ms Wooll has held her current position since 1985; she confirms that she is authorised to make her declaration on behalf of the companies and that the information in her declaration comes from either her own knowledge or from the records of the companies to which she has full access. The following points emerge from Ms Wooll’s declaration:

- that Ferrero UK Limited is the sole importer of Ferrero products in the United Kingdom;
- that the KINDER trade mark was first used by the Group in the United Kingdom in 1967 and that the Group have sold the following KINDER products in the United Kingdom: KINDER MILK SLICE, KINDER SURPRISE, KINDER CHOCOLATE, KINDER MAXI, KINDER BUENO and KINDER JOY. These are collectively referred to as the products. Photocopies of the packaging of the products (except) KINDER MAXI sold by the Group under the KINDER trade mark are provided in exhibit VW1;
- that products have been sold by the Group under the KINDER trade mark in the United Kingdom and that products have been available in branches of at least the following retail outlets: Sainsburys, Tesco, Safeway, Gateway, Kwik Save and the Co-Op. Exhibit VM2 consists of sample invoices of products sold under the KINDER trade mark;

- exhibit VM3 consists of a table showing sales in tonnes, consumer units and net revenue of products in the United Kingdom since 1967. I note that the net revenue under the respective trade marks in the periods indicated is as follows: KINDER MILK SLICE (1986/87-1994/95) - £3.2m; KINDER SURPRISE (eggs) (1980/81 - 1994/95) - £91.3m; KINDER CHOCOLATE (packs) (1986/87-1994/95)- £2.7m; KINDER MAXI (1990/91-1993/94) - £313K and KINDER BUENO (1990/91-1994/95) - £ 2.8m. Figures are also provided for invoices sales in the United Kingdom of goods under the KINDER JOY trade mark in the period September 1995 to July 1998 but these relate to sales after the material date in these proceedings;
- approximate annual amounts spent on advertising the various trade marks is provided as is said to be as follows: KINDER SURPRISE - between 1983 and 1994/1995 approximately £12m; KINDER BUENO - between 1992 and 1994/95 approximately £197k; KINDER CHOCOLATE - between 1987 and 1994/95 approximately £300k and KINDER MILK SLICE - between 1989 and 1994/95 approximately £900k. Exhibits VW4 and VW5 consist respectively of: copies of advertising material for certain of the products together with catalogues and other literature produced by the Group and a video containing television advertisements for the trade marks KINDER MILK SLICE (1989-1990), KINDER SURPRISE (shown since 1995) and KINDER BUENO (shown in 1994 and 1995).

(ii) The declarations of Christopher Benson dated 3 March 1999, Wolfgang Kotzur dated 1 March 1999 and Sylvia Rodrigues dated 25 February 1999. Mr Krause comments:

“The declaration of Christopher James Benson confirms that two surveys were conducted - one in respect of a comparison between the trade mark subject of the opposition and the registrant’s trade mark KINDER and one conducted in respect of the public perception of the Registrant’s trade mark KINDER. The exhibits attached to Mr Benson’s declaration relate to the former survey and are, accordingly, not relevant to these proceedings.”

22. The declarations of Mr Benson and Mr Kotzur are reproduced below. The declaration of Ms Rodrigues’ is in identical terms to that of Mr Kotzur save for the number of people interviewed.

Mr Benson

“1. I am a solicitor in the firm of Taylor Joynson Garrett, solicitors for Ferrero SpA and Soremartec (the opponents) in this matter. Save where otherwise appears, the facts of the matters to which I depose are within my personal knowledge through my involvement in this matter. Insofar as I rely on information communicated to me by third parties, I believe this information to be true.

2. On 3 September 1998, I travelled with colleagues to Dartford in Kent in order to conduct surveys involving members of the public.

3. There is now produced and shown to me marked CJB 1 a copy of the questionnaire used for the survey which I and my colleague Christopher David Miller carried out.

4. The survey took place at the Royal Victoria and Bull public house in Dartford. Members of the public were approached on the street outside by representatives of Field Management Limited and recruited for a face to face interview.

5. I interviewed members of the public brought to me by agents of Field Management and recorded their responses on a questionnaire.

6. There is now shown to me and marked CJB2 copies of the photocopies referred to at question one. I showed the interviewee the KINDER SURPRISE egg when asking question eight.

7. I confirm that the interviewees were not at any stage led or encouraged to give answers that would assist the opponents or which were detrimental to the case of Soldan Holding & Bonbonspezialitäten GmbH. All the interviews I carried out during the survey I conducted openly and honestly and interviewees responses were recorded in their entirety.

8. I interviewed and completed questionnaires for 29 people in total. There is now produced and shown to me marked CJB3 copies of all the original completed questionnaires showing the results of all the interviews which were conducted by me in respect of this survey in Dartford.

9. I have read Christopher David Miller's affidavit and the replies of the 16 members of the public he questioned.

10. The following result emerges from the survey:-

In response to question 12, 28 out of the 45 people questioned (62.22%) said they would be surprised that there was no connection between KINDER EUKAL, KINDER EM EUKAL and KINDER FUR KINDER (sic) on the one hand and "the people who make KINDER SURPRISE" on the other.

11. I have read the declarations of Michelle Sylvia Rodrigues and Wolfgang Kotzur and the replies of the 40 members of the public they questioned.

12. The following results emerge from the survey:-

12.1 In response to question 1, what does the word KINDER mean to you, 27 people out of the 40 questioned (67.5%) said only either chocolate, egg, chocolate egg or Kinder egg. 1 person said both children and Kinder egg.

12.2 Of the six people who only said child or children in response to question one, four of them said chocolate egg when asked what the word KINDER means to them in respect of food in response to question 2."

Mr Kotzur

“1. I am trainee solicitor in the firm of Taylor Joynson Garrett, solicitors for Ferrero SpA and Soremartec (the opponents) in this matter. Save where otherwise appears, the facts of the matters to which I depose are within my personal knowledge through my involvement in this matter. Insofar as I rely on information communicated to me by third parties, I believe this information to be true.

2. On 3 September 1998, I travelled with colleagues to Dartford in Kent in order to conduct surveys involving members of the public.

3. There is now produced and shown to me marked WK1 a copy of the questionnaire used for the survey which I and my colleague Michelle Sylvia Rodrigues carried out.

4. The survey took place at the Royal Victoria and Bull public house in Dartford. Members of the public were approached on the street outside by representatives of Field Management Limited and recruited for a face to face interview.

5. I interviewed members of the public brought to me by agents of Field Management and recorded their responses on a questionnaire.

6. There is now shown to me and marked WK2 the KINDER word card referred to at question one. I showed the interviewee the KINDER SURPRISE egg when asking question four, the packaging of the KINDER CHOCOLATE product asking question nine, the packaging of the KINDER BUENO product when asking question fourteen and the KINDER JOY product when asking question nineteen.

7. I confirm that the interviewees were not at any stage led or encouraged to give answers that would assist the opponents or which were detrimental to the case of Soldan Holding & Bonbonspezialitäten GmbH. All the interviews I carried out during the survey I conducted openly and honestly and interviewees responses were recorded in their entirety.

8. I interviewed and completed questionnaires for two people in total. There is now produced and shown to me marked WK3 copies of all the original completed questionnaires showing the results of all the interviews which were conducted by me in respect of this survey in Dartford.”

Applicants for Invalidity’s Evidence-in-Reply

23. This consists of a witness statement dated 26 February 2001 by Teresa Ann Bucks. Ms Bucks confirms her position as a trade mark agent and a partner in the firm of Boulton Wade Tennant. She confirms that her witness statement is based on her own knowledge and on documents to which she refers. Ms Bucks comments:

“I am also a German speaker, having completed A level German during my school education, and I have a good knowledge of the German language.”

24. The main conclusions emerging from Ms Buck's witness statement are, in my view, as follows:

- that the word KINDERGARTEN (meaning a class or small school for young children) appears in English language dictionaries. While the use of KINDERGARTEN originated in Germany to indicate a class or school for children, that use has been adopted very widely in the United Kingdom in exactly the same context. Ms Bucks concludes that from their own understanding of the German language and/or the association with children's schools/nurseries, many people in the United Kingdom will immediately understand either through their own knowledge of German or through their association with children's education, will recognise KINDER as meaning children or something for children. She therefore disputes Mr Krause's conclusion that the word KINDER had not made its way into the English language at the relevant date;
- that the evidence filed as exhibit JDM6 to Mr Moore's declaration is relevant to all of the applications for invalidation and not only to the trade mark KINDER TONUS as alleged by Mr Krause;
- that the declaration of Ms Wooll is irrelevant as no evidence has been adduced of use of the trade marks under attack in these proceedings;
- in so far as the survey evidence of Mr Benson, Mr Kotzur and Ms Rodrigues is concerned, Ms Bucks comments:

"It is to be noted that neither Mr Krause's declaration nor these three earlier declarations specifically draw any conclusions from the result of this survey. I therefore have to assume that these are intended to try to show that the general public recognise KINDER as being associated with the proprietors' product. I have significant concerns about the way in which these surveys were carried out and therefore reserve the right to cross-examine the declarants at the substantive hearing on these proceedings. However, for the purposes of this evidence-in-reply I contend that the vast majority of the people questioned either had no knowledge of KINDER, recognised KINDER as being the German word for children or were only familiar with the proprietors' KINDER SURPRISE chocolate egg..... The results of the survey cannot by any stretch of the imagination be considered to be conclusive to show that the general public immediately associate the word KINDER with the proprietors' goods."

25. That concludes my review of the evidence filed in so far as I consider it necessary.

DECISION

26. Although a substantial number of grounds have been pleaded only the following were pursued at the hearing:

Section 3(6) - against all five registrations

Section 3(1)(b)/(c) - against No 1489981 (KINDER SNAPPY) and
No 1440569 (KINDER CUORDIFRUTTA)

27. The other grounds under Section 3(1)(a), 3(1)(b)/(c) (save for the above two cases), 3(1)(d), 3(3)(a), 3(3)(b) and 3(4) stand dismissed.

The Section 3(6) objections

28. The Section 3(6) ground is common to all five cases and, if the applicants succeed, would effectively decide the matter.

Section 3(6) reads:

"3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

29. It is the applicants' primary contention that the proprietors did not, and do not, have any intention to use the trade marks the subject of the registrations. In his skeleton argument Mr Arnold accepted that, to establish an objection under Section 3(6), bad faith must be shown as at the dates of the applications to register the marks concerned (see the Annex to this decision as to the actual dates concerned). He added, somewhat cryptically, "although Soldan reserves the right to contend to the contrary on appeal". Registry Hearing Officers have indicated on a number of occasions that the question of whether an application was made in bad faith must be judged at the date of application not least because the consequence of a successful invalidity action is that the registration is, to the extent necessary, deemed never to have been made by virtue of Section 47(6) of the Act - see, for instance DAAWAT Trade Mark, 0/227/01 and NONOGRAM Trade Mark [2001] RPC 355.

30. The intention to use requirement is to be found in Section 32(3) of the 1994 Act:

"32(3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a *bona fide* intention that it should be so used."

31. That statutory requirement is in turn reflected in a statement which applicants are required to make on the Form TM3 (Application to register a trade mark). The five registrations under attack here were, of course, applied for under the antecedent law, the Trade Marks Act 1938. The scheme of the 1938 Act was somewhat different. There the requirement that a mark be used or proposed to be used was contained in the definition of "trade mark" (Section 68) and reflected in the application procedure (Section 17(1)). There are differences in wording as well. The 1994 Act, for instance, refers to *bona fide* intention. However, it has not been suggested to me that these differences represent material changes in the nature of the underlying requirement. I note, too, that the Transitional Provisions contained in Schedule 3 to the 1994 Act provide as follows:

"18.-(1)

(2) For the purposes of proceedings under Section 47 of this Act (grounds for invalidity of registration) as it applies in relation to an existing registered mark, the provisions of this Act shall be deemed to have been in force at all material times.

Provided that no objection to the validity of the registration of an existing registered mark may be taken on the ground specified in subsection (3) of Section 5 of this Act (relative grounds for refusal of registration: conflict with earlier mark registered for different goods or services)."

32. Thus specific provision was made in relation to Section 5(3) so far as existing registered marks are concerned but no exception was considered necessary in relation to claims arising under Section 3(6).

33. A number of reported cases have dealt with the nature of a claim that a trade mark has been applied for in bad faith. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 Mr Justice Lindsay said:

"I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances."

34. In *Royal Enfield Trade Marks* [2002] RPC 24 page 508 Mr Simon Thorley, sitting as the Appointed Person, said:

"An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not lightly be made (see Lord Denning M.R. in *Associated Leisure v. Associated Newspapers* [1970] 2 Q.B. 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see *Davy v. Garrett* (1878) 7 Ch.D.473 at 489). In my judgment precisely the same considerations apply to an allegation of lack of bad faith made under Section 3(6). It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference."

35. The above was particularly relied on by Mr Edenborough as supporting the view that an allegation of bad faith is a serious matter and the threshold test is a relatively high one. That is no doubt so but it is not, I think, authority for the proposition that a lack of intention to use falls outside the ambit of a bad faith claim.

36. Just such an issue arose in *Demon Ale Trade Mark*, [2000] RPC 345. Mr Geoffrey Hobbs, sitting as the Appointed Person, concluded as follows:

"In the present case the objection under Section 3(6) related to the applicant's breach of a statutory requirement. Section 32(3) of the Act required him to be a person who could truthfully claim to have a bona fide intention that DEMON ALE should be used (by him or with his consent) as a trade mark for beer. His application for registration included a claim to that effect. However he had no such intention and could not truthfully claim that he did. That was enough, in my view, to justify rejection of his application under Section 3(6). I see no reason to doubt that Section 32(3) is compatible with Community law. The 8th recital to the Directive specifically confirms that "*in order to reduce the total number of trade marks registered and protected in the Community ... it is essential to require that registered trade marks must actually be used or, if not used, be subject to revocation*". I am satisfied that this is not a case which tests the limits of Section 3(6) of the Act (article 3(2)(d) of the Directive) from the point of view of Community law."

37. The latter part of the above passage also deals with a point Mr Edenborough touched on as to the vires of the provision in Section 32(3) of the Act.

38. Before coming on to the detailed argument bearing on the specific circumstances of these particular cases I should comment briefly on the question of onus. This action is brought under Sections 47(1)/3(6). It is apparent from Mr Thorley's comments in the above passage from the *Royal Enfield* case that he considered that there was a clear onus on the party bringing an allegation of bad faith to establish their case. Bad faith can cover a variety of circumstances most of which will require a basis in evidence if they are to get off the ground. That raises difficult issues for an applicant for invalidity where the claim is that the proprietor had no intention to use the mark applied for. Save for the somewhat unusual circumstances of the *DEMON ALE* case (where the applicant himself conceded that he had no intention to use the mark on the only remaining goods of the application), an applicant for invalidation is likely to face difficulties in determining another party's intentions.

39. The position can be contrasted with the position facing an applicant for revocation in a non-use action under the 1994 Act where Section 100 now places the onus squarely on the registered proprietors' shoulders to show what use has been made of his mark. That provision was intended to deal with the specific problem faced by an applicant for rectification under the 1938 Act of having to make out a prima facie case of non-use in order to progress his case (having to prove a negative as it was sometimes known).

40. Despite that change in the law governing non-use actions there is no comparable provision placing an onus on an applicant or registered proprietor to establish their position in an attack based on lack of intention to use. The onus is, therefore, on the applicants for invalidity to make out a prima facie case. Mr Edenborough was right, in my view, to suggest that a case cannot be built on mere speculation or assertion.

41. Mr Arnold accepted that bad faith had to have a solid basis but suggested that, if relevant primary facts are established bearing on the claim, then it is permissible to draw conclusions

by inference. The primary facts on which he relied were the large number of trade mark filings by Ferrero/Soremartec and the admission that only a small proportion of them have been put to use. His skeleton argument summarised the position as follows:

"The present objection is based on Ferrero's present trade mark filing policy, which was in place by 5 February 1992. By the date of Ms Bucks' declaration dated 26 February 2001, Ferrero had applied to register no less than 68 marks consisting of the word KINDER plus one or more additional words (some in stylised form or with additional matter), most in Classes 29 or 30 with a few in Classes 28 and 32. Although a few of the marks have application dates going as far back as 1967, most were filed in the 1980s and 1990s. On the evidence, only 6 of these marks have ever been used in the United Kingdom (KINDER MILK SLICE, KINDER SURPRISE, KINDER CHOCOLATE, KINDER MAXI, KINDER BUENO AND KINDER JOY). Among the many unused marks are those the subject of the first two applications, KINDER MILK-BREAK (filed as long ago as 10 July 1985) and KINDER DAYLICIOUS (filed as long ago as 5 November 1987). The irresistible inference is that the other 62 applications were filed by Ferrero not with any genuine intention of using the marks sought to be registered, but with a view to attempting to obtain wide protection for the word KINDER. That it is the correct inference is confirmed by the evidence: the charge was specifically made by Mr Rickard in paragraph 7 of his declaration dated 20 November 1998 which formed part of Soldan's evidence in chief, but it was not denied in Ferrero's evidence in answer."

42. The reference to applications to register 68 marks consisting of or containing the word KINDER must be treated with some care because it refers to the position at February 2001 and the underlying applications or resulting registrations were filed over a long period of time. Nevertheless it was not disputed at the hearing that the proprietors have a considerable number of marks of which only six have been used (details of the marks in use are set out in Ms Wooll's declaration of 5 February 1999 exhibited to Mr Krause's witness statement of 15 January 2001).

43. The applicants' position is that, by applying for a large number of trade marks when there was no intention to use them, the proprietors were seeking wide protection for KINDER marks and creating a situation that is analogous to seeking to register overly broad specifications - see, for instance, Mr Justice Laddie's comments in *Mercury Communications Ltd v Mercury Interactive (UK) Limited*, [1995] FSR 850 at page 863 et seq. The vice, however, is the absence of an intention to use regardless of the motivation behind the proprietors' filing policy.

44. Mr Edenborough's response was that Mr Rickard's evidence for the applicants for invalidity was mere assertion and was not a sufficient basis from which to infer a policy on Ferrero/Soremartec's part of filing applications without an intention to use the marks. He noted, for instance, that commercial situations change over time, an example being the temporary withdrawal from sale, but subsequent relaunch, of KINDER MILK SLICE products. The proprietors were not, in his view, being covetous in terms of either marks or goods. They had brought a number of KINDER marks into use and had simply applied for

other KINDER marks. Third parties were not, he said, being harmed by the proprietors' actions.

45. I believe Mr Arnold was inclined to accept that, in the normal course of business, changes can occur in the circumstances of a company or economic conditions generally which may mean that a bona fide intention to use a mark at the time of filing is not converted into actual use. Such circumstances do not in themselves seem to me to leave an applicant open to an allegation of bad faith. An applicant's intention has to be judged at the time of making the application.

46. The position here is different on two main accounts. Firstly there is the sheer number of marks applied for which apparently remain unused and secondly the period of time (at least from the 1980s onwards) over which the applications have been made. It was the combined and continuing effect of this pattern of behaviour that enabled Mr Arnold to characterise it as a persistent practice. It is not in itself determinative of the bad faith claim. It plainly cannot be. What it does, however, do in my view is to establish a prima facie case requiring a response from the proprietors.

47. In the light of the applicants well signposted attack it was incumbent on the proprietors to explain their position or risk the consequences. Yet no one from the proprietors has responded (other than by denials) to the claim in the statement of grounds and Mr Rickard's and Ms Bucks' evidence. Ms Wooll's evidence, on the other hand, establishes that six marks have been brought into use so there can be no question as to the capability of the proprietors to produce goods within the Class 30 specifications (different issues may arise in relation to a small number of registrations in other classes). But that tells me nothing about their intentions regarding particular marks.

48. It would be somewhat surprising if established businesses, which I take Ferrero/Soremartec to be, had no company papers, records of internal discussions, marketing plans or other such material that might be called on to explain what the intentions were at the time the applications were filed. Nor has any material been filed from periods after the filing dates of the applications which might shed light retrospectively on the applicants' intentions.

49. It was said in PALM Trade Mark [1992] RPC 258:

"A person's intention, at any point in time, is, of course, a difficult matter for any other person to know with certainty. Intentions change as the circumstances which give rise to them change. The process of application for, and registration of, a trade mark is sufficiently lengthy to allow a number of different intentions to arise quite legitimately in the mind of the applicant. But I think it reasonable to assume that a businessman, with an established business, has a certain fixity of purpose when preparing to do some act or take some step in relation to that business. This is especially so, I believe, in businesses which involve the use of premises specially adapted for a particular purpose. Such businesses are not "mushroom growth"; they do not spring up overnight. The decision to establish a significant development in business, particularly a development overseas, is almost invariably recorded in a company's minutes; premises are viewed; locations considered; design details agreed;

finance arranged. These and many other necessary preparations are stepping stones which lead eventually to a desired result; they also provide a trail for subsequent examination. Had there been a bona fide intention to set up a trade and to use the mark in the terms of section 68 of the Act, it would have been relatively easy for the registered proprietor to demonstrate that fact during the course of these proceedings by the exhibition of one or two of the stepping stones to which I have referred above."

50. PALM was a rectification action under the 1938 Act involving consideration as to whether the registered proprietors had an intention to use their mark. Although the law itself has changed and authorities under the preceding Act must be treated with caution, I regard the Hearing Officer's comments as constituting a sensible approach to dealing with questions of intention to use. In terms of the commercial background to the filing of trade mark applications the above comments strike me as still being relevant albeit that the factual circumstances are no doubt different here.

51. If the proprietors had a bona fide intention to use their marks they should have stated it clearly in evidence and provided substantiating evidence and/or explanation to counter the prima facie position established by the applicants for invalidity. They have not done so with the result that the applications succeed under Section 3(6) in each case.

The Section 3(1)(b) and (c) objections

52. The relevant part of the statute reads:

"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."

53. The proviso is included only for the sake of completeness. The proprietors do not claim to use the marks, KINDER SNAPPY and KINDER CUORDIFRUTTA, that are the subject of this objection. In view of my finding under Section 3(6) I propose to deal with the matter fairly briefly.

54. Guidance on the interpretation to be placed on Section 3(1)(c) can be found in *Procter & Gamble Company v OHIM*, [2002] ETMR 3 page 22 (the BABY-DRY case). That case was concerned with Article 7(1)(c) of the Community Trade Mark Regulation which is equivalent to Article 3(1)(c) of the First Council Directive and Section 3(1)(c) of the 1994 Act. It will suffice to refer to paragraphs 39 and 40:

"The signs and indications referred to in Article 7(1)(c) of Regulation No. 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.

As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark."

55. I am aware that there is some uncertainty as to whether the guidance in the BABY-DRY case is consistent with earlier guidance in *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots und Segelzubehor Walter Huber*, [1999] ETMR 585, in terms of the continuing applicability of the need to keep descriptive signs or indications free for use within the framework of Community law. The issue is currently the subject of an Advocate General's Opinion in the *Postkantoor* case (*Koninklijke KPN Nederland NV v Benelux Merkenbureau*), case C-363/99 and will presumably result in such clarificatory guidance as the ECJ considers necessary in due course. I am satisfied that the trade marks before me here do not test the boundaries of established practice.

56. I have set out in the evidence summary the applicants' case against the marks KINDER SNAPPY and KINDER CUORDIFRUTTA. At the hearing Mr Arnold's submission was that SNAPPY would not be registrable for "biscuits, confectionery, wafer balls" since it is descriptive of such products; that the addition of CHILDREN'S would not change the position given that the products are for children; that using KINDER instead does not make an otherwise unregistrable mark registrable; and that Soldan's evidence establishes that KINDER would be understood as meaning children.

57. For reasons which I have given more fully in the revocation/invalidity action against Kinder - milk slice (REV 9546) some care is needed in analysing marks where a foreign language word may or may not be perceived as such. In this particular case I note that the registration is subject to separate disclaimers of the words KINDER and SNAPPY. I am not aware of the reasons for this. In any case the only matter I have to consider is the character of

the mark as a whole. In that respect I am quite unable to see what descriptive character consumers would discern in the words KINDER SNAPPY. The descriptiveness alleged against the mark in the applicants' evidence is in my view more than a little fanciful. The combination is not one that "may serve in normal usage from a consumer's point of view to designate" a characteristic of the goods. KINDER SNAPPY is a lexical invention within the meaning of the guidance in BABY-DRY.

58. A mark may not be disqualified from registration under Section 3(1)(c) but still be devoid of distinctive character within the meaning of Section 3(1)(b). I am satisfied that this is not the case here. The main objection against KINDER SNAPPY is a descriptiveness one. I can see no reason why, having failed under paragraph (c) of Section 3(1), the applicants should succeed under paragraph (b).

59. The objection against KINDER CUORDIFRUTTA is also set out in the evidence summary. CUORDIFRUTTA is said to be Italian for 'heart of fruit' and thus descriptive of 'pastry, confectionery, ices and sorbets; sauces; all containing fruit or being fruit flavoured'. Again it is submitted by the applicants that adding KINDER does not make the mark registrable when the products are clearly intended for children. Again I note that the mark is the subject of separate disclaimers of the two words.

60. My remarks in relation to the KINDER SNAPPY mark are largely applicable to KINDER CUORDIFRUTTA as well. The latter may thus be taken as either a German/Italian or English/Italian combination. That, of course, assumes that the average consumer pauses to consider and analyse the mark at all. In fact even this understates the amount of work the consumer would have to put in to interpreting the mark. The Italian word for heart is, on the applicants' written evidence, 'cuore' and not 'cuor'. It seems to me that the combination of compression of words, mixture of languages and uncertainty as to how the first word would be seen must result in a mark that is some way removed from being the normal way of describing the goods. Like KINDER SNAPPY, the combination is a lexical invention. It is not disqualified under Section 3(1)(c) and, again for similar reasons to KINDER SNAPPY, is not debarred from registration under Section 3(1)(b) either.

61. The applicants have been successful under Section 3(6). In accordance with Section 47(6) the registrations that are the subject of these invalidity actions will be deemed never to have been made.

62. The applicants are entitled to a contribution towards their costs. I order the registered proprietors to pay them the sum of £3000. In arriving at this sum I have taken account of the fact that individual applications had to be filed; the cases have been consolidated; the evidence is largely common to all the cases; a single set of submissions was made in relation to the successful ground; the fact that the proprietors faced a large number of objections, most of which were not pursued at the hearing; and that the applicants have not been successful in relation to the Section 3(1)(b) and (c) grounds.

63. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19 day of July 2002

**M REYNOLDS
For the Registrar
the Comptroller-General**

ANNEX

(1) TM No: 1489981

TM: **KINDER SNAPPY**

Appl date: 05.02.1992

Goods: Biscuits, confectionery, wafer balls; all included in Class 30.

Reg Date: 30.07.1993

Other: Registration of this mark shall give no right to the exclusive use, separately, of the words "Kinder" and "Snappy".

(2) TM No: 1541165

TM: **KINDER TIME**

Appl date: 08.07.1993

Goods: Coffee, tea, sugar, rice, tapioca, sago, preparations for use as substitutes for coffee; flour products made from cereals; bread, biscuits, cakes, pastry and confectionery, edible ice; honey, treacle, yeast and baking powder; salt, mustard; pepper, vinegar, sauces; spices; ice; cocoa, cocoa products, cocoa paste for drinks, chocolate paste; chocolate coverings, chocolate, chocolate eggs, pralines, decorations for Christmas trees made of chocolate, goods made of an edible chocolate case with an alcoholic filling; sugar articles, confectionery, chewing-gum, sugarless chewing-gum, sugarless candies; all included in Class 30.

Reg Date: 11.11.1994

Other: Advertised before acceptance by reason of special circumstances. Section 18(1) (proviso).

(3) TM No: 1440569

TM:



Kinder
Cuordifrutta

Appl date: 07.09.1990

Goods: Pastry, confectionery, ices and sorbets; sauces; all containing fruit or being fruit flavoured; all included in Class 30.

Reg Date: 06.01.1995

Other: Registration of this mark shall give no right to the exclusive use, separately, of the words "Kinder" and "Cuordifrutta" and

the German word "Kinder" appearing in the mark means "Children".

(4) TM No: 1541166

TM: **KINDER TIME**

Appl date: 08.07.1993

Goods: Mineral and aerated waters and non-alcoholic drinks; fruit drinks and fruit juices; syrups and preparations for making beverages; all included in Class 32.

Reg Date: 11.11.1994

Other: Advertised before acceptance by reason of special circumstances. Section 18(1) (proviso).

(5) TM No: 1569226

TM: **KINDER TONUS**

Appl date: 19.04.1994

Goods: Coffee, tea, sugar, rice, tapioca, sago, flour, products made from cereals; bread, biscuits, cakes, pastry and confectionery, edible ice; honey, treacle, yeast and baking powder; salt, mustard; pepper, vinegar, sauces; spices; ice; cocoa; cocoa products, cocoa paste for drinks, chocolate paste, chocolate coverings, chocolate, chocolate eggs, pralines, decorations for Christmas trees made of edible chocolate case with an alcoholic filling; sugar articles, chewing-gum, sugarless chewing-gum, sugarless candies; all included in Class 30.

Reg Date: 29.12.1995

Other: Advertised before acceptance. Proceeding because of prior rights in Registration No B1170775 (5564,1059) and others.