

O-110-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN APPLICATION NO 2482441**

**BY FRESH DIRECT HOLDINGS LIMITED**

**TO REGISTER A TRADE MARK**

**IN CLASSES 29, 31 AND 39**

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**DECISION AND GROUNDS OF DECISION**

**Background**

1. On 20 March 2008 Fresh Direct Holdings Limited of 264 Banbury Road, Oxford, OX2 7DY applied under the Trade Marks Act 1994 to register the following trade marks:



FRESH DIRECT

2. Registration is sought for the following goods and services:

Class 29

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats.

## Class 31

Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

## Class 39

Transport; packaging and storage of food products.

3. Objection was taken to the first and second marks in the application under Section 3(1)(b) of the Act because the marks consist of the words FRESH DIRECT together with a device which depicts a hand picking fruit, the whole devoid of any distinctive character for e.g. fresh produce provided directly to the consumer.

4. Objection was also taken to the third mark in the application under Sections 3(1)(b) and (c) of the Act because the mark consists exclusively of the words “FRESH DIRECT”, being devoid of distinctive character and a sign other traders may legitimately wish to use in respect of fresh produce provided directly to the consumer.

5. Further objections were taken under Section 41(2) of the Act because the marks do not form a series of marks because they differ in their material particulars.

6. A hearing was held before Mr R Jones on 30 July 2008 at which the applicant was represented by Ms. Barbour of Rouse & Co International, their trade mark attorneys. Following the hearing the objection was maintained and Notice of Final Refusal was subsequently issued.

7. I am now asked under Section 76 of the Act and Rule 69(2) of the Trade Mark Rules 2008 to state in writing the grounds of my decision and the materials used in arriving at it.

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

### **Objection under Section 41(2)**

#### **The Law**

9. Section 41(2) of the Act reads as follows:

“41.-(2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.”

## The Decision

10. In order to satisfy the requirements of Section 41(2) of the Act all three marks must, while differing from one another, differ only in respect of matter of a non-distinctive character which does not substantially affect the identity of each mark, that is to say its identity with each and every other mark in the group propounded as a series.

11. In Logica's Trade Marks [BL O/068/03] Professor Ruth Annand sitting in her role as the Appointed Person established that Section 41(2) of the act contains three conditions which must be met. In her decision she stated:

*“38 I agree with Mr James that section 41(2) contains three conditions and not two but prefer to describe them according to their positive and negative aspects. First, on the positive side, section 41(2) requires the trade marks for which registration is sought to resemble each other in their material particulars. Second and third, the negative aspects are that any difference in the trade marks must not comprise matter, which when considered:*

- (a) as a separate element of the trade mark would be regarded as having distinctive character; and*
- (b) in the context of the trade mark as a whole, substantially affects the identity of the trade mark.”*

12. The first and second marks in the series of three marks are almost identical – the only differences between them is that the first mark is represented in the colours green, red and white whereas the second mark is represented in black and white. Both of these marks consist of the words “FRESH DIRECT” together with the device of a hand which appears to be picking an item of fruit, perhaps a tomato. In contrast, the third mark consists only of the words “FRESH DIRECT”, there being no device element present in this mark. The device element present in the first and second marks is such that it forms part of the material particulars of the trade marks and therefore substantially affects the identities of these two marks. The very fact that the device element is not present in the third mark results in them being both visually and conceptually different. I agree with the examiner that although the first and second marks may form an acceptable series of two marks they do not form an acceptable series of three marks when considered together with the third mark.

13. Neither at the hearing, nor in subsequent correspondence, have the applicants or their representative provided any indication that any of these marks are to be deleted. Neither has any request to divide the application in accordance with Rule 26 of the Trade Marks Rules 2008 been received.

14. Consequently, I have concluded that the marks contained within this application differ as to their material particulars in such a way that they do not satisfy the requirements of Section 41(2) of the Act.

## **Objections under Section 3(1)(b) and (c)**

15. Section 3(1)(b) and (c) of the Act reads as follows:

“3.-(1) The following shall not be registered-

(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.”

## **The case for registration**

16. The only indication of any submissions made in support of this application is contained in Mr Jones’ hearing report dated 30 July 2008 where he states:

*“Ms Barbour argued that the words were not directly descriptive and that the logo versions would be distinctive in any event as the device was distinctive.”*

17. Mr Jones did not consider that it was appropriate to allow the objection to be waived and maintained the objection for the reasons set out in his report of the hearing. Mr Jones allowed further time for formal evidence of acquired distinctiveness to be filed but no such evidence has been received.

## **Decision**

18. First, I shall consider the objection under Section 3(1)(c) of the Act which has been raised against the third mark in the series. This mark consists of the words FRESH DIRECT.

19. In a judgement issued by the European Court of Justice on 23 October 2003, *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case – C-191/01 P, (the DOUBLEMINT case), the Court gives guidance on the scope and purpose of Article 7(1)(c) of the Community Trade Mark Regulation (equivalent to Section 3(1)(c) of the Trade Marks Act). Paragraphs 28 - 32 of the judgement are reproduced below:

“28. Under Article 4 of Regulation No 40/94, a Community trade mark may consist of any signs capable of being represented graphically, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

29. Article 7(1)(c) of Regulation No 40/94 provides that 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, time of production of the goods or rendering of the service, or other characteristics of the goods or service” are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under Article 7(3) of Regulation No 40/94.
31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, *inter alia*, in relation to the identical provisions of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73).
32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

20. I also take account of the decision of the European Court of Justice in *Postkantoor* (Case C-363/99) which again considered the registrability of combinations of descriptive words. Paragraphs 96 – 100 of the judgement are reproduced below:

- “96. If a mark, such as that at issue in the main proceedings, which consists of a word produced by a combination of elements, is to be regarded as descriptive for the purpose of Article 3(1)(c) of the Directive, it is not sufficient that each of its components may be found to be descriptive. The word itself must be found to be so.
97. It is not necessary that the signs and indications composing the mark that are referred to in Article 3(1)(c) of the Directive actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is

sufficient, as the wording of that provision itself indicates, that those signs and indications could be used for such purposes. A word must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned (see to that effect, in relation to the identical provisions of Article 7(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-0000, paragraph 32).

98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.
99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark.
100. Thus, a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the second case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purpose of the same provision.”

21. Section 3(1)(c) of the Act has common roots to Art. 7(1)(c) of the CTMR, and is substantially identical to that provision. Accordingly, the ECJ’s guidance with regard to that provision may be taken to apply equally to Section 3(1)(c) of the Act. The provision excludes signs which may serve, in trade, to designate the kind of services or other characteristics of services. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the goods and services in question.

22. A trade mark's descriptiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. This means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect. In my view the consumers of such goods and services are very wide ranging involving the wholesale trade, the retail trade and the end consumer who will probably be the general public although there may be some corporate purchases of the final products.

23. In this regard the meanings of the words FRESH and DIRECT will be immediately and unmistakably obvious. In relation to food produce and their delivery the word FRESH provides an indication that the produce has only recently been picked or slaughtered etc. The word DIRECT indicates that their delivery route is without deviation or interruption and that the goods have been transported from producer to retailer (and hence consumer) by the most direct route available. These two words are commonly used in trade to describe produce and mode of delivery. In fact the word "direct" has become a synonym for accessibility in relation to consumers.

24. The only remaining question is whether their combination is such that the sum is more than its parts and that it will overcome the descriptiveness of each word. I do not see that it can. In my view the words are frequently used together and are used in combination to describe the delivery of fresh produce.

25. Consequently, I have concluded that the third mark consists exclusively of a sign which may serve, in trade, to designate the kind of goods and services and is, therefore, excluded from registration by Section 3(1)(c) of the Act.

26. I now turn to Section 3(1)(b) of the Act. This objection has been raised against all three marks in this application.

27. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in *Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8<sup>th</sup> April 2003) in the following terms:

“37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule 1 Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.



40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).
41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

28. I must determine whether the trade mark applied for is capable of enabling the relevant consumer of the services in question to identify the origin of the services and thereby to distinguish them from other undertakings.

29. For the same reasons for which I found the third mark in the series is to be excluded by the provisions of Section 3(1)(c) of the Act, I have concluded that the relevant consumer of the goods and services in question would not consider this mark to denote trade origin. The average consumer of these goods and services will, upon encountering the words FRESH DIRECT, perceive them as no more than an indication that they relate to the provision of fresh produce delivered as directly and efficiently as possible. The signs are likely to be taken as a reference to the mode of presentation of the goods thus branded. I am not persuaded that the trade mark applied for is sufficient, in terms of bestowing distinctive character on the sign as a whole, to conclude that it would serve, in trade, to distinguish the services of the applicant from those of other traders.

30. I shall now consider the objection under Section 3(1)(b) of the Act against the first and second marks in the series. These two marks contain the words FRESH and DIRECT but they also incorporate device elements. I also note that the words themselves are slightly stylised and that the first mark benefits from colour but I do not accept that the stylisation of the two words, or the existence of colour in the first mark, really assists.

31. In both marks the device is clearly representative of the act of picking fruit. The representation is even clearer in the first mark. I do not consider it possible to state with complete certainty what is actually represented but it appears to be the device of a hand in the act of picking fresh fruit, perhaps a tomato, from a vine. The whole is enclosed within a vertical but oval border. This is, in all probability, how the device

element will be perceived by the relevant consumer who I have identified at paragraph 23 of this decision.

32. Having identified how consumers will perceive these marks I must now consider the effect of this device when used in conjunction with the words FRESH and DIRECT. In other words, I must consider the marks as wholes. In my view the words FRESH and DIRECT are prominent within the mark. I note that the device is, in both marks, situated alongside the word FRESH. This will result in the device placing even more emphasis on the word FRESH. The device of a piece of fruit being freshly picked will send only one message, that of freshness. While I accept that the goods in question are not limited to e.g. tomatoes they are goods which consumers would prefer to purchase when fresh. The device supports the whole message of freshness, whether it is in respect of the fruit and vegetables in Class 31, or any of the remaining goods in classes 29 and 31. I am also of the view that the same correlation may be applied to the services which, when considered within the context of the marks as wholes, will be seen as essential to the delivery of fresh goods. The act of “picking” from a plant underlines the meaning of the word “direct” as well. There is no action more direct than that depicted. The device, then supports the meaning of the words, but adds nothing to them.

33. I find support of this conclusion from the comments made by Richard Arnold QC, sitting as the Appointed Person, in an appeal of the decision to refuse application 2428182 by British American Tobacco (Brands) Inc. to register the mark SUN RIPENED TOBACCO with device (BL O/200/08). He said:

*"13. The impact of the words in the mark are clear, namely that of a reference to the goods as described above. It is also clear that the presence of the sun device has a relationship to these words and, to some extent, may re-enforce or supplement their meaning; in other words, the sun device, in the context of the mark as a whole, is not an arbitrary or fanciful inclusion. Despite all this, will the overall impression, as the attorney would have me believe, strike the consumer as a badge of origin?"*

*"14. I am mindful of the comment of Mr Hobbs QC sitting as the Appointed Person in Quick Wash Action [BL O/205/04]: 'I do not think that the hearing officer was guilty of excision or dismemberment in his assessment of the present mark. Devices can be distinctive or nondistinctive, just like any other kind of sign. What matters are the perceptions and recollections that the sign in question is likely to trigger in the mind of the average consumer of the goods concerned and whether they would be origin specific or origin neutral. I think that the verbal elements of the mark I am considering speak loud and clear. It seems to me that the message they convey is origin neutral. The artistic presentation neatly and skilfully builds upon and reinforces the origin neutral message in a way that makes it even more effective than the words alone might have been for that purpose. I think that net result is a well-executed, artistically pleasing, origin neutral device.'*

*Applying similar reasoning to the mark at issue here, it strikes me that the words SUN RIPENED TOBACCO also speak loud and clear and that they do so in a descriptive and therefore origin neutral manner. The presentation incumbent in the sun device (and the overall presentation of the words),*

*despite having an element of artistic nature, merely build upon and re-enforces the message behind the mark. This all leads, in my judgment, to a mark that fails to strike the consumer as a badge of origin.”*

34. I have concluded that the three marks applied for will not be identified as trade marks without first educating the public that they are trade marks. I therefore conclude that the marks applied for are devoid of any distinctive character and are thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

### **Conclusion**

35. In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b), 3(1)(c) and 41(2) of the Act.

**Dated this 30<sup>th</sup> day of April 2009**

**A J PIKE  
For the Registrar  
The Comptroller-General**