

TRADE MARKS ACT 1994

IN THE MATTER OF Application Number 2519614

By Société des Produits Nestlé S.A

To register the following trade marks in classes 5, 29, 30, 32



Start Healthy
Stay Healthy



Start Healthy
Stay Healthy

1. On 26 June 2009, Société des Produits Nestlé S.A. ('the applicant') applied to register trade mark application number 2519614, consisting of a series of two marks containing the words 'Start Healthy, Stay Healthy' and a figurative device for the following goods:

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic foods and substances adapted for medical and clinical use; food and food substances for babies, infants and invalids; foods and food substances for nursing mothers adapted for medical use; nutritional and dietary supplements; vitamin preparations, mineral food preparations; medicated confectionery.

Class 29: Vegetables and potatoes (preserved, dried or cooked), fruits (preserved, dried or cooked), frozen fruits and vegetables, mushrooms (preserved, dried or cooked), meat, poultry, game, fish and seafood, all these products also in the form of extracts, soups, jellies, pastes, preserves, ready-made dishes, frozen or dehydrated; jams; eggs; milk, cream, butter, cheese and other food preparations having a base of milk; milk substitutes; milk-based beverages; milk-based and cream-based desserts; yoghurts; soya milk (milk substitute), soya-based preparations; edible oils and fats; protein preparations for human food; non-dairy creamers; sausages; charcuterie; peanut butter; soups, soup concentrates, broth, stock cubes, bouillon, consommés.

Class 30: Coffee, coffee extracts, coffee-based preparations and beverages; iced coffee; coffee substitutes, extracts of coffee substitutes, preparations and beverages based on coffee

substitutes; chicory; tea, tea extracts, tea-based preparations and beverages; iced tea; malt-based preparations; cocoa and cocoa-based preparations and beverages; chocolate, chocolate products, chocolate-based preparations and beverages; confectionery, sweets, candies; sugar; chewing gum; natural sweeteners; bakery products, bread, yeast, pastry; biscuits, cakes, cookies, wafers, toffees, puddings; ice cream, water ices, sherbets, frozen confections, frozen cakes, soft ices, frozen desserts, frozen yoghurts; binding agents for making ice cream and/or water ices and/or sherbets and/or frozen confections and/or frozen cakes and/or soft ices and/or frozen desserts and/or frozen yoghurts; honey and honey substitutes; breakfast cereals, muesli, corn flakes, cereal bars, ready-to-eat cereals; cereal preparations; rice, pasta, noodles; foodstuffs having a base of rice, of flour or of cereals, also in the form of ready-made dishes; pizzas; sandwiches; mixtures of alimentary paste and oven-ready prepared dough; sauces; soya sauce; ketchup; aromatising or seasoning products for food, edible spices, condiments, salad dressings, mayonnaise; mustard; vinegar.

Class 32: Beers; still water, effervescent water or carbonated water, processed water, spring water, mineral water, flavoured water; fruit-flavoured and fruit-based beverages, fruit and vegetable juices, nectars, lemonades, sodas and other non-alcoholic beverages; syrups, extracts and essences and other preparations for making non-alcoholic beverages (except essential oils); lactic fermented beverages; soya-based beverages; malt-based beverages; isotonic beverages.

2. On 16 July 2009, the UK Intellectual Property Office issued an examination report in response to the application. In the report, an objection was raised under section 3(1)(b) of the Trade Marks Act 1994 ('the Act'), on the basis that the mark was devoid of any distinctive character because it is a promotional statement which could apply to any undertaking offering the goods and merely sends a promotional health message to the consumer, as opposed to acting as a badge of sole trade origin. The examiner stated that the stylisation was lost within the mark and did not add any distinctive character to the sign.

3. Following a three-month extension of time, on 26 November 2009, the agent submitted arguments in support of the mark's alleged *prima facie* distinctiveness.

4. The examiner was not persuaded to waive the section 3(1)(b) objection and an *ex parte* hearing subsequently took place on 17 March 2010. At the hearing the

applicant was represented by Mr Dale Carter of Nestlé UK Limited. Mr Carter expanded on arguments previously put forward in correspondence and also submitted that no consideration had been given to the stylisation of the mark. Mr Carter made reference to decisions of the ECJ, namely C-64/02 '*Das Prinzip Der Bequemlichkeit*' and C-398/08 *Audi V Ohim 'Vorsprung durch Technik'* (Audi).

5. The arguments put forward at hearing were not persuasive and the objection was maintained. Further time was requested by Mr Carter to enable him to consult with the applicant and as such three months was granted.

6. On 22 April 2010 in response to the hearing minute, Mr Carter again requested more time in which to submit further submissions and indicated that a statement of grounds should be issued. By way of response, the official letter of 28 April 2010 advised Mr Carter that as the application had not been refused, a statement of grounds would not be issued at this stage. However, further time was allowed for the applicant to consider whether he had any evidence of use. At this stage, Mr Carter was reminded that the hearing officer considered sufficient time had already been allowed to put forward any arguments in respect of the *prima facie* assessment of the mark, both prior to the hearing and also at hearing.

7. On 10 June 2010 Mr Carter requested a further extension of one month due to the fact that he intended to submit evidence in relation to the Section 3 objection - his justification being that the evidence was being provided by the applicant's head office in Switzerland. The extension was granted until 17 July 2010.

8. In correspondence of 12 July 2010, Mr Carter submitted further arguments in respect of the *prima facie* distinctiveness of the mark. This was also accompanied by a request for a statement of grounds if the objection should be maintained. No evidence of acquired distinctiveness was submitted.

9. On 13 August 2010, the objection was maintained and notice of refusal was issued under Section 37(4) of the Trade Marks Act 1994. I am now asked under Section 76 of the Act and Rules 69(2) of the Trade Mark Rules 2008 to state in writing the grounds of my decision and the material used in arriving at it. No evidence has been put before me. I have, therefore, only the *prima facie* case to consider.

The applicant's case for registration

10. On 26 November 2009, Mr Carter submitted arguments in support of the mark's alleged *prima facie* distinctiveness which are summarised as follows;

- For an objection under Section 3(1)(b) to be valid, the marks have to be absent of even a modicum of distinctive character and that a cursory

assessment of all of the elements of the mark should lead the examiner to conclude that the marks possess some distinctive character.

- The sign is not a promotional statement, and if not perceived as a distinctive trade mark, then it would be perceived as an inspirational statement which would be acceptable under Section 3(1)(b) as it is opaque.
- A minimum degree of distinctive character is sufficient to overcome the objection; the sign must be considered in relation to the goods in question and by reference to the perception of the average consumer of those goods.
- The level of attention of the average consumer of the foodstuffs may not be particularly high. However, where the foods hold a particular benefit to consumers (such as being low in saturated fat) the attention of the relevant consumer of that product is likely to be higher.
- Consumers of food products are accustomed to encountering trade marks which may not possess the highest degree of inherent distinctive character, but nevertheless possess the minimum degree of distinctive character to qualify for registration.
- The examiner based her conclusion of the distinctiveness of the mark solely on basis of the wording and the stylisation is not lost within the mark. As a whole the sign is distinctive.
- The sign is fanciful, hyperbolic and the combination of words is an unusual juxtaposition that would not be the normal way consumers would refer to the goods covered by the application.
- The mark has been accepted in the Republic of Ireland.
- Earlier marks which are on all fours with the application have been accepted for registration and as such it would be inequitable for the Registrar to refuse protection for the Applicant's mark.
- If the objection is maintained against all of the goods, a hearing was requested.

11. At the hearing, Mr Carter reiterated his arguments put forward in written correspondence and also submitted further arguments which are summarised as follows:

- The wording of the objection was incorrect, and that no consideration had been given in respect of the stylisation of the mark.
- The sign is not a value statement and, according to the work manual, there is clearly scope for accepting promotional type marks for registration.
- The meaning of the sign is not obvious.
- Reference to both decisions of the ECJ was made in C-64/02 '*Das Prinzip Der Bequemlichkeit*' and also C-398/08 *Audi*
- Precedents were referred to which Mr Carter considered were on a par with the application in suit, and which had been accepted for registration.

12. In further correspondence dated 12 July 2010, Mr Carter again made submissions that the mark was distinctive and which are summarised as follows;

- Reference to the decision of the ECJ C-398/08 *Audi v Ohim* was again made.
- It was submitted that the decision taken at hearing was based purely in respect of the word elements only and that in its entirety, the mark is distinctive.
- The Hearing Officer had erred in reaching her decision.
- Reference to the decision of Professor Ruth Annand acting as Appointed Person in BL O-07910, '*No Half Measures*' was made and it was also submitted that the examiner had relied upon '*Das Prinzip*' which was incorrect;
- Arguments in respect of notional and fair use were made and it was submitted that at hearing, the Hearing Officer stated she had to consider that the sign could be used in commerce as a simple word mark, rather than as applied for.
- The sign is atypical in relation to the goods applied for and there is only a casual link between the mark and the goods which will require a measure of interpretation.
- Exhibits showing that the sign is registered in Canada and the U.S. were filed along with exhibits showing the mark or variations of the mark, registered in numerous other countries.

13. Prior to setting out the law in relation to Section 3(1)(b) of the Act, I must emphasise that the following decision will set out my reasons for maintaining the

objection by reviewing and assessing the mark applied for. I have noted the fact that on several occasions Mr Carter has made reference to earlier word-and-device marks which have been accepted by the Intellectual Property Office ('IPO') and by the Community Trade Mark Office ('OHIM'), and note that much of his claim regarding alleged distinctiveness has been based upon relative comparisons with earlier marks and earlier acceptances. Whilst I acknowledge Mr Carter's submissions regarding certain material similarities between the applicant's mark and those earlier marks he has quoted, I have maintained the objection by assessing the *mark applied for*, rather than by comparing its relative merits against earlier accepted marks.

14. As regards the earlier marks registered by IPO, I am unaware of the circumstances surrounding their acceptance, and consider them to be of little assistance in determining the outcome of this application. I draw support for this from the judgement of Jacob J in *British Sugar* [1996] RPC 281 at 305 where he stated the following:

"Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual enquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME* Trade Mark and the same must be true under the 1994 Act. I disregard the state of the register evidence."

15. Nor have I been swayed by reference to the acceptance of the mark by other National Offices' acceptance of the same mark. Notwithstanding Council Directive 89/104/EEC, the Registrar is not bound by the decisions of other national offices, as confirmed by the European Court of Justice ('the ECJ') in its judgement on *Henkel KGaA v Deutsches Patent und Markenamt* (C-218/01) where it was stated that:

"The fact that an identical trade mark has been registered in one Member State for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in a Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark application for registration of a similar mark for goods or services similar to those for which the first mark was registered.”

16. In the decision that follows I will give my reasons for maintaining the objection to this sign; but first I wish to set out my understanding of case law in respect of section 3(1)(b).

The Law

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

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

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

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.

Decision

18. The European Court of Justice (ECJ) has repeatedly emphasised the need to interpret the grounds of refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (case C-37/03P, *Bio ID v OHIM*, paragraph 59 and the case law cited there and, more recently, Case C-273/05P *Celltech R&D Ltd v OHIM*).

19. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provision referred to above) the Court has held that "...the public interest... is, manifestly, indissociable from the essential function of a trade mark" (case C-329/02P, *SAT.1 SatellitenFernsehen GmbH v OHIM*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgement). Marks which are devoid of distinctive character are incapable

of fulfilling that essential function. Section 3(1)(c) on the other hand pursues an aim which reflects the public interest in ensuring that descriptive signs or indications may be freely used by all (*Wm Wrigley Jr v OHIM, Doublemint*, C-191/OP, paragraph 31).

20. Section 3(1)(b) must include within its scope those marks which, whilst not designating a characteristic of the relevant goods and services (i.e. not being necessarily descriptive), will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin. In terms of assessing distinctiveness under section 3(1)(b), the ECJ provided guidance in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (Postkantoor)* where, at paragraph 34, it stated:

"A trade mark's distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to 55/01 *Linde and Others* [2003] ECR I-3161, paragraph 41, and Case C-104/01 *Libertel* [2003] ECR I-3793, paragraphs 46 and 75)."

21. This establishes the principle that the question of a mark being devoid of any distinctive character is answered by reference firstly, to the goods and services applied for, and secondly, to the perception of the average consumer for those goods or services.

22 In relation to identifying the relevant consumer, it is reasonable to assume that the goods claimed will be used by the general public and also medical and veterinary professionals. The specifications cover a range of goods including e.g., pharmaceutical and veterinary preparations, dietetic foods and substances, food and food substances for babies; infants and invalids foods, food and food substances for nursing mothers adapted for medical use in Class 5. In Classes 29 and 30, the terms in the specifications cover a wide range of foodstuffs and beverages. In Class 32 the specifications cover beer, water and other non alcoholic beverages. For many of these goods, the relevant consumer will be the general public. However, for class 5 goods such as 'Pharmaceutical and veterinary preparations', these products are often highly specialised and are more likely to be targeted towards more sophisticated consumers such as medical and veterinary professionals. The level of consumer attention would therefore vary depending on firstly the consumer, and secondly the goods. In relation to certain foodstuffs, consumers might pay extremely high levels of attention. For example, those concerned about their health and also how or where goods are produced or manufactured, would take great care in their choice. Conversely, consumers of the same goods may pay little attention to their choice of goods. This may be due to several factors including e.g. a lack of

nutritional education and as such a lack of awareness of the benefits of a healthy diet. In such cases, consumers may pay little attention to their choice of goods. We have to consider varying extremes of consumer from health fanatics who will only eat the purest and healthiest form of foods, to consumers who pay little if any attention to what they eat. Similarly in relation to the goods in Class 5 we have to consider both the general public and also the highly sophisticated consumer such as medical professionals, whose level of attention would be much higher.

23. One must also be aware that the test is one of immediacy or first impression, as confirmed by the European Court of First Instance (now the General Court) which, in its decision on *Sykes Enterprises v OHIM (Real People Real Solutions)*, 2002, ECT II-5179, stated the following:

"...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin."

24. The mark consists of the phrase 'Start Healthy, Stay Healthy' presented in a stylised format with a figurative band forming an arc over the word 'healthy'. Following on from ECJ guidance on cases such as *Real People Real Solutions*, there has been a tendency to skew assessments of distinctiveness in respect of slogan marks, such as the one applied for. This sort of assessment is based on the assumption that consumers are not in the habit of regarding slogans as designating trade origin, but instead regard them as purely promotional, non-distinctive material. Following the Court's decision on *Audi* we now know that this is only part of the considerations that must be made. In paragraph 44 of that decision, the Court stated:

"...while it is true... that a mark possesses distinctive character only in so far as it serves to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking, it must be held that the mere fact that a mark is perceived by the relevant public as a promotional formula, and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient, in itself, to support the conclusion that the mark is devoid of distinctive character."

25. Given such guidance, I intend to approach this matter, firstly from a semantic perspective in order to assess whether the phrase is capable of performing the essential function of a trade mark, and which would therefore be free from objection under section 3(1)(b).

26. Examining the mark from that perspective, I must reach the view that it conveys a clear message which would be understood by the relevant consumer of the goods identified at paragraph 1 above. The verb 'start' is defined in Collins' English dictionary as meaning "*to begin or cause to begin (something or to do something)*"; the adjective 'healthy' is defined as "*enjoying good health*" and also "*conducive to health; salutary*"; whilst the verb 'stay' is defined as "*to continue to be; remain*". In totality therefore, the phrase 'Start Healthy, Stay Healthy' would immediately be understood as a reference to the (unstated) benefits of starting off healthily and staying healthy. It could also be understood that the one will automatically stem from the other, i.e. a healthy start will maintain health.

27. Considering the mark when used in respect of those goods which are commonly marketed in terms of their health benefits, the message is particularly transparent. However, the potential for the message to be so easily understood is not limited solely to such foodstuffs. There is an increasing recognition that only by preventing the occurrence of disease, a significant improvement in general health of the UK population can be achieved. Preventive healthcare in childhood promotes the development of children to their fullest potential which ultimately reduces disability and dependency caused by illness. Nutritional books and advice are often only concerned with helping those who have become overweight or unhealthy to return to a normal weight and health: to undo the damage caused by previous faulty dietary practices. But it is self-evident that it is far better not to become overweight or unhealthy in the first place. This relies on correct nutrition *from the start*: that is from a child's conception, for our nutritional status at our beginning has a profound effect on our health throughout life. Using the terminology employed in the mark, any commercial entity providing healthy foodstuffs, may wish to convey the simple message that the goods at issue will provide a healthy start leading to a healthy future. Similarly, aside from pregnancy, infancy or childhood, at any point in a person's life, it is recognised that embarking on a healthy diet or lifestyle will reap benefits.

28. In short, *any* goods which can be characterised by their capacity to provide a healthy start and, as a result help retain health are, in the Registrar's opinion, unlikely to have their commercial origin denoted by the phrase 'Start Healthy, Stay Healthy', other than as a result of extensive use of the mark over a period of time. I do not reach this conclusion because I consider the phrase to literally describe the goods, but rather because I do consider that the phrase refers to a benefit for the relevant consumer seeking to purchase goods which aid health. Used in the context of marketing and promoting goods which aid health, the consumer is sophisticated enough to understand the value and purpose of this message when used in a commercial context. It would be perceived not as a reference to commercial origin, but rather as a motivational statement intended to reinforce the benefits of healthy products. The use of the sign by the applicant on the applicant's website at **www.nestlebaby.com** (Annex 1), further supports this fact where, in conjunction

with the mark applied for, the applicant states '*At Nestlé, we believe infant nutrition is more than just baby food and infant formula. It is about caring for your child from pregnancy to toddler through the development milestones to have a healthy start for a healthy future*'.

29. Given that the message conveyed by the mark is generally accepted as a fact, that is to say, most of us now understand and recognise the personal benefits of eating healthily, it is the sort of statement that consumers might expect to be used by any provider of the goods at issue. In drawing this conclusion, I am not supporting the objection by reference to a need to keep the statement free for others to use - that is clearly a policy which underpins section 3(1)(c) rather than 3(1)(b), and it would be difficult to substantiate a claim that other traders would likely coin the *exact* same phrase. However, I am stating that the message conveyed by the mark is so clear, and so universally accepted, that the relevant consumer would not perceive it as something with which to differentiate the goods of one trader from those of another. In that sense, it fits the explanation of section 3(1)(b) set out in *Postkantoor* as being applicable to "*(those marks which are) none the less... devoid of any distinctive character in relation to goods or services for reasons other than the fact they may be descriptive*".

30. This leaves an assessment of the figurative device element. The non verbal element within the mark is an arc shaped band, which can best be described as a "swoosh". This is placed above the letter 'H' in the phrase 'Start Healthy' and swoops around the words, to sit above and join the letter 'H' in the phrase 'Stay Healthy'. It appears to join the two elements of the mark together. As such, the band connecting the two word elements could be perceived as a sign reinforcing a link between the two word elements i.e. if you start healthy, you stay healthy. I consider that the device and stylisation in the mark would be seen by the relevant public as no more than minor stylistic embellishments, which are not unusual in the marketplace, and which would have no more than a minimal impact in a retail context. To support my decision I make reference to the decision of the ECJ, *BioID AG v. OHIM* (Case C-37/03P) where the ECJ's analysis was as follows;

"69. The trade mark applied for contains the abbreviation BioID and figurative elements, namely the typographical characteristics of that abbreviation, and two graphic elements placed after the abbreviation BioID, namely a full stop (■) and a sign (®).

71. In addition, in the light of the recurrent nature of the typographical features of the abbreviation BioID and the absence of any particular distinctive element, the characters in 'Arial' typeface and characters of different boldness do not enable the trade mark applied for to guarantee, to the relevant public, the identity of the origin of the goods and services covered by the trade mark application.

72. Furthermore, the two graphic elements placed after the abbreviation BioID, namely a full stop (■) and a sign (®), do nothing to enable the relevant public to distinguish, without any possibility of confusion, the products or services covered by the trade mark application from others which have another origin. It follows that those graphic elements are not capable of fulfilling the essential function of a trade mark, as described in paragraph 25 of the present judgment, in relation to the relevant goods and services.

73. As pointed out by the Advocate General in point 105 of his Opinion, when the overall impression conveyed by the trade mark applied for to the relevant public is examined, the abbreviation BioID, which is devoid of any distinctive character, is the dominant element of that mark.

74. Moreover, as OHIM observed in paragraph 21 of the contested decision, the figurative and graphic elements are so minimal in nature that they do not endow the trade mark applied for as a whole with any distinctive character. Those elements do not possess any feature, in particular in terms of fancifulness or as regards the way in which they are combined, allowing that mark to fulfil its essential function in relation to the goods and services covered by the trade mark application”.

31. The above provides support that the addition to descriptive words of common fonts, colours and stylistic elements will not necessarily be sufficient to imbue distinctiveness: this is a matter of judgment in each case, bearing in mind the goods or services concerned, the average consumers –and other factors such as frequency of use of the elements at issue in the marketplace. Considering all these factors in the round, I am not convinced, the ‘surplus’ in the sign provided by the non-verbal components are sufficient to ‘individualise to one undertaking’ the mark as a whole.

32. In my view, this mark provides the consumer with nothing more than information, dressed up it is true, but only in a moderate fashion typical of that wider use in the decoration of consumer products. I note the recent judgement of the ECJ in *Audi* cited above, which states:

“41. It must be held that, even though the General Court stated in paragraph 36 of the judgment under appeal that it is clear from the case-law that registration of a mark cannot be excluded because of that mark’s laudatory or advertising use, it went on to explain that the reason for its finding that the mark applied for lacks distinctive character was, in essence, the fact that that mark is perceived as a promotional formula: that is to say, its finding was made precisely on the basis of the mark’s laudatory or advertising use.

44. However, while it is true – as was pointed out in paragraph 33 of the present judgment – that a mark possesses distinctive character only in so far as it serves to identify the goods or services in respect of which registration is

applied for as originating from a particular undertaking, it must be held that the mere fact that a mark is perceived by the relevant public as a promotional formula, and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient, in itself, to support the conclusion that that mark is devoid of distinctive character.

45. On that point, it should be noted that the laudatory connotation of a word mark does not mean that it cannot be appropriate for the purposes of guaranteeing to consumers the origin of the goods or services which it covers. Thus, such a mark can be perceived by the relevant public both as a promotional formula and as an indication of the commercial origin of goods or services. It follows that, in so far as the public perceives the mark as an indication of that origin, the fact that the mark is at the same time understood – perhaps even primarily understood – as a promotional formula has no bearing on its distinctive character.

46. However, by the line of reasoning set out in paragraphs 42 and 43 of the present judgment, the General Court did not substantiate its finding to the effect that the mark applied for will not be perceived by the relevant public as an indication of the commercial origin of the goods and services in question; in essence, rather, it merely highlighted the fact that that mark consists of, and is understood as, a promotional formula.

47. As regards the General Court's finding in paragraph 41 of the judgment under appeal that the mark *Vorsprung durch Technik* can have a number of meanings, or constitute a play on words or be perceived as imaginative, surprising and unexpected and, in that way, be easily remembered, it should be noted that, although the existence of such characteristics is not a necessary condition for establishing that an advertising slogan has distinctive character, as is apparent from paragraph 39 of the present judgment, the fact remains that, as a rule, the presence of those characteristics is likely to endow that mark with distinctive character.

56. In that regard, it must be stated that all marks made up of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by those marks convey by definition, to a greater or lesser extent, an objective message. It is clear, however, from the case-law set out in paragraphs 35 and 36 of the present judgment that those marks are not, by virtue of that fact alone, devoid of distinctive character.

57. Thus, in so far as those marks are not descriptive for the purposes of Article 7(1)(c) of Regulation No 40/94, they can express an objective message, even a simple one, and still be capable of indicating to the

consumer the commercial origin of the goods or services in question. That can be the position, in particular, where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring little in the way of interpretation by the relevant public, or setting off a cognitive process in the minds of that public.

58. Even if it were to be supposed that the slogan 'Vorsprung durch Technik' conveys an objective message to the effect that technological superiority enables the manufacture and supply of better goods and services, that fact would not support the conclusion that the mark applied for is devoid of any inherently distinctive character. However simple such a message may be, it cannot be categorised as ordinary to the point of excluding, from the outset and without any further analysis, the possibility that that mark is capable of indicating to the consumer the commercial origin of the goods or services in question.

59. In that context, it should be pointed out that that message does not follow obviously from the slogan in question. As Audi observed, the combination of words 'Vorsprung durch Technik' (meaning, inter alia, advance or advantage through technology) suggests, at first glance, only a casual link and accordingly requires a measure of interpretation on the part of the public. Furthermore, that slogan exhibits a certain originality and resonance which makes it easy to remember. Lastly, in as much as it is a widely known slogan which has been used by Audi for many years, it cannot be excluded that the fact that members of the relevant public are used to establishing the link between that slogan and the motor vehicles manufactured by that company also makes it easier for that public to identify the commercial origin of the goods or services covered."

33. The important message to be taken from such comments is, I think, that one should avoid deeming a trade mark as being necessarily devoid of any distinctive character by virtue of an assertion that it would be seen entirely, or even primarily, as a 'promotional message' as far as the average consumer is concerned. Moreover, the comments also imply that trade marks which convey objective and simple messages may also *not* necessarily be devoid of any distinctive character solely by virtue of that characteristic. The issue for the ECJ seems to be that, where such marks possess 'originality' and 'resonance' capable of being remembered (qualities which may result from the presence of word-play, imagination, creativity or 'unexpectedness'), then they are unlikely to be devoid of any distinctive character. The impact of the Judgement is, therefore, to urge relevant authorities to undertake a full semantic analysis of the mark in question, without preconception or pre-emption, and also taking into account all known and relevant surrounding circumstances. Having done just this, I only add the comments made by the Appointed Person in BL- O-353-10, *BRING THE WORLD CLOSER*, page 15:

“The expression ... is caught by the exclusion from registration in section 3(1)(b) because it is liable to be perceived and remembered by the relevant average consumer as nothing more than an origin-neutral statement about the [goods] concerned. It appears to me to involve no verbal manipulation or engineering of the kind which, in other cases, has been recognised as sufficient to turn explanatory phraseology into a sign possessed of a distinctive character”.

34. In this case, I have sought to limit my analysis to the mark's semantic content - largely by considering the dictionary defined (and generally accepted) meanings for the words which are found in the mark applied for, and assessing their collective impact as a phrase in its totality, inclusive of its stylisation, by reference to those goods applied for. In doing so, I have not identified any of those characteristics or qualities mentioned by the ECJ as being contributory to a finding of a *prima facie* distinctiveness.

35. I have assessed the mark as applied for, and must conclude that as a whole, the sign cannot lay claim to any linguistic imperfection, peculiarity, inventiveness or other creative element which might endow it with the necessary capability to function as an indicator of trade origin - at least, not in respect of those goods which are likely to be characterised by their ability to aid health, i.e. those goods listed at paragraph 1 above. Applying the ECJ's guidance in *Audi* as well as those cases which have preceded it, I therefore have no hesitation in upholding the refusal under Section 3(1)(b) of the Act.

Conclusion

36. In this decision, I have considered all documents filed by the applicant/agent, and all arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is refused under Section 37(4) of the Act because it fails to qualify under section 3(1)(b) of the Act.

Dated this 10 day of January 2011

**Bridget Whatmough
For the Registrar
The Comptroller-General**

APPENDIX

Annex 1

Website found at <http://www.nestlebaby.com/>

Nestlé
Start Healthy
Stay Healthy

At Nestlé, we believe infant nutrition is more than just baby food and infant formula. It is about caring for your child from pregnancy to toddler through the development milestones to have a healthy start for a healthy future.

Simply select the Nestlé website created for your country:

Europe	Middle East/Africa	North America	South America
Andorra Bulgaria Denmark España Ελλάδα Belgique België Lëtzebuerg Italia Nederland Norge Portugal	Россия Romania Schweiz Suisse Suomi Sverige Türkiye United Kingdom Україна Deutschland Polska	UAE (arabic) Coming soon: UAE (english) Asia/Pacific Australia Malaysia New Zealand Singapore 中国 ประเทศไทย	United States Canada Central America Costa Rica El Salvador Guatemala Honduras Nicaragua Panama México Coming soon: Caribbean (english) Caribbean (spanish) Venezuela

Baby Nutrition
Practical information about breastfeeding, bottle-feeding, weaning, baby food and baby formula. Plus delicious and nutritious menus and healthy baby food recipes.

Baby Development
Handy tools such as growth curves. Useful information about health, wellbeing and development milestones.

Nestlé Baby Club
From conception to pregnancy, baby to toddler, Nestlé Baby Club will be there for you and your baby every step of the way.

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