

1 UK INTELLECTUAL PROPERTY OFFICE
2 (Sitting at)

The Rolls Building
7 Rolls Buildings
Fetter Lane
London EC4A 1NL

Monday, 3rd August 2015

Before:

6 MR. GEOFFREY HOBBS QC
7 (Sitting as the Appointed Person)

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9 In the Matter of the Trade Marks Act 1994

10 - and -

11 In the Matter of an Appeal to the Appointed Person under
12 Section 76

13 - and -

14 In the Matter of UK Trade Mark Application No. 2646493
SIMPLY... (Series of five) in classes 03, 05, 08, 16, 29, 30,
15 31, 32, 33 and 34 in the name LIDL STIFTUNG & Co. KG

16 -----

17 In the Matter of an Appeal to the Appointed Person from the
18 decision of Ms. Carol Bennett, acting on behalf of the
Registrar, the Comptroller-General, dated 16th February 2015

19 (Transcript of the Shorthand Notes of Marten Walsh Cherer Ltd.,
20 1st Floor, Quality House, 6-9 Quality Court,
Chancery Lane, London WC2A 1HP.
21 Telephone No: 020 7067 2900. Fax No: 020 7831 6864
e-mail: info@martenwalshcherer.com)

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23 MISS DENISE McFARLAND (instructed by Urquhart-Dykes & Lord
24 LLP) appeared on behalf of the Applicant/Appellant.

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APPROVED DECISION

O-382-15

1 THE APPOINTED PERSON: On 19th December 2012 Lidl Stiftung & Co.
2 KG applied under number 2646493 to register five
3 representations of the word "simply" as a series of trade marks
4 for use in relation to wide ranges of goods listed in various
5 classes, including classes 3, 5, 29, 30, 31, 32, 33 and 34.
6 These were the five signs for which registration in series was
7 requested:

8

Simply...
Simply...
SIMPLY..
Simply
SIMPLY

15 No claim for registration was made on the basis of
16 distinctiveness acquired through use in relation to any goods
17 of the kind listed in the relevant classes.

18 The fourth and fifth signs were deleted from the
19 application in March 2013 in response to an official objection
20 maintaining that they did not form a series, as defined in
21 section 41(2) of the Trade Marks Act 1994, with the preceding
22 three signs.

23 The application to register those three signs in series
24 was subsequently refused for the reasons given in a decision
25 issued under reference BL O-070-15 by Ms. Carol Bennett on

1 behalf of the Registrar of Trade Marks on 16th February 2015.

2 The Hearing Officer concluded that the application for
3 registration should be refused under section 3(1)(b) of the
4 1994 Act on the basis that the signs in question were devoid,
5 that is to say unpossessed, of distinctive character for
6 goods of the kind listed in the relevant classes and also for
7 descriptiveness under section 3(1)(c) of the Act on the basis
8 that they consisted exclusively of signs or indications which
9 may serve, in trade, to designate characteristics possessed by
10 such goods.

11 Her assessment with regard to the descriptiveness of the
12 three signs in issue from the viewpoint of the relevant
13 average consumer of such goods was as follows:

14 "15. Turning my assessment to the mark applied for,
15 I refer to the dictionary definition for the word 'simply' as
16 defined in Collins English Dictionary:

17 "Simply. adverb 1. in a simple manner, 2. merely; only,
18 3. absolutely; altogether; really => a simply wonderful
19 holiday, 4. (sentence modifier) frankly; candidly.

20 "16. The dictionary reference defines the term as
21 meaning 'in a simple manner', 'merely' or 'only'. When this
22 meaning is used in relation to prepared goods such as e.g.
23 soap, food for babies and general food products, it would be
24 taken to describe a characteristic of those products - namely
25 the simplicity and naturalness of the goods. In respect of

1 soap products, this could be those that are not perfumed and
2 contain only natural ingredients; in respect of food, drink
3 and tobacco products these could be those that have no
4 artificial additives, colourings, flavourings or coatings and
5 are regarded as being superior because of their natural
6 purity. Consumers have been encouraged through advertising
7 and media campaigns such as e.g. Change4Life® to eat less
8 processed food as they generally contain more sugar, salt,
9 additives and calories than the natural product. An
10 indication that the goods consist only of the natural product
11 is a quality that consumers would potentially seek out when
12 purchasing such goods.

13 "17. The mark also contains an element of stylisation
14 in the first mark, and an element of punctuation or ellipsis,
15 namely three dots following the word in all three marks. It
16 is my view that the stylised font is fairly standard and adds
17 no distinctive character to the whole. As such, I do not need
18 to consider it further. The series of dots usually indicates
19 an intentional omission of a word(s) from a statement without
20 altering its original meaning. Depending on their context and
21 placement in a sentence, ellipses can also indicate an
22 unfinished thought, or a leading statement. In this case,
23 addition of the ellipsis after the word 'Simply' introduces a
24 way to add a dramatic pause and, given the range of goods that
25 this mark would be used upon, it would naturally lead the

1 average consumer into completing the phrase by adding the name
2 of the goods as in e.g. simply... soap, simply... fish,
3 simply... juice. 'Simply' suggests 'purity' and 'simplicity'
4 and, when used on the products intended for protection, infers
5 that it is all it consists of. Use of the ellipsis does
6 nothing to displace the totally descriptive meaning of the
7 combination in the minds of the average consumer.

8 ...

9 "19. Taking into account all the above, I have
10 concluded that the mark applied for consists exclusively of a
11 sign which may serve, in trade, to designate a characteristic,
12 namely the purity or basic nature of the goods. It is
13 therefore excluded from registration by section 3(1)(c) of the
14 Act."

15 She went on to consider the position on a residual or
16 sweeping up approach under section 3(1)(b):

17 "24. As regards this 'residual or sweeping up
18 function', my view would be that even if the addition of the
19 three dots had the effect of taking the sign outside of the
20 scope of section 3(1)(c), the sign would nonetheless still be
21 devoid of distinctive character under section 3(1)(b) only.
22 That is to say, the average consumer would not see the
23 elements, when taken together, as performing the essential
24 function of a trade mark by indicating the origin of the
25 goods. The sign as a whole will be perceived as syntactically

1 correct, visually and linguistically meaningful in a way which
2 is more likely than not to relate to the goods without
3 indicating origin in the minds of the relevant class of
4 person. In my view, the average consumer would see the phrase
5 as origin neutral and not to be that of any particular
6 supplier of the goods the subject of the application. For
7 this reason the mark is also refused on the alternative basis
8 under 3(1)(b).

9 "25. I have concluded that the sign applied for will
10 not be identified as a trade mark without first educating the
11 public that it is an indication of trade origin. I therefore
12 conclude that the mark applied for is devoid of any
13 distinctive character and is thus excluded from prima facie
14 acceptance under section 3(1)(b) of the Act."

15 The applicant now appeals under section 76 of the Act,
16 maintaining, as foreshadowed in its Grounds of Appeal, that,
17 although the Hearing Officer's decision and reasoning stand to
18 be accepted as correct in relation to the second and third of the
19 three signs in the series, the first sign in the series possesses
20 what the other two signs concededly do not: a distinctive
21 character by reason of its visual appearance as graphically
22 represented in the application for registration.

23 The stance which the applicant now adopts in relation to
24 the first sign, as compared to the second and third signs in
25 the series of three, is in fact contrary to the proposition

1 upon which the signs were put forward for registration in
2 series under section 41(2), i.e. that they "resemble each
3 other as to their material particulars and differ only as to
4 matters of a non-distinctive character not substantially
5 affecting the identity of the trade mark".

6 For present purposes I shall assume that this internal
7 inconsistency would be addressed, if it has not already been
8 addressed, by deleting the second and third signs from the
9 application for registration under Rule 28 of the Trade Marks
10 Rules 2008. That reduces the issue on this appeal to a narrow
11 question: whether the word "simply" is visually presented in
12 the graphic representation of the first sign in a manner
13 sufficient to differentiate it materially, in trade mark
14 terms, from the graphic representations of the other two signs,
15 which continue to be unregistrable in relation to the goods of
16 interest to the applicant in accordance with the Hearing
17 Officer's reasoning and decision to that effect.

18 The cursive script and the quasi-brushstroke style of
19 representation in the first sign do not appear to me to
20 present it to the eye in a manner that would cause the
21 relevant average consumer to perceive and remember it as
22 anything more than a mildly stylised version of the word
23 "simply".

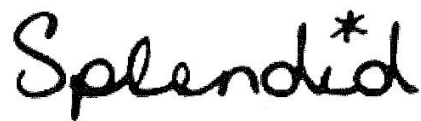
24 The visual treatment is, in my view, saturated with the
25 verbal message of the word as connoting that the goods to

1 which it refers are plainly, purely, naturally or
2 straightforwardly prepared examples of the kind of thing that
3 the consumer may be looking for.

4 I agree with the Hearing Officer in thinking, as she
5 indicated in paragraph 17 of her decision, that the
6 stylisation of the first sign is not sufficient to endow it
7 with a distinctive character. To put it another way, the
8 first sign and the second and third signs in the series of
9 three are equally unregistrable in the prima facie case.

10 The reasoning and approach of the General Court in Case
11 T-203/14 Mo Industries LLC v OHIM EU:T:2015:301 appears to
12 me to be applicable by analogy to the first sign. In that
13 case the sign put forward for registration was the laudatory
14 word "splendid" graphically represented in the following
15 manner:

16

The image shows the word "Splendid" written in a cursive, handwritten style. The letter 'i' at the end has a small asterisk above it. The word is centered on the page.

19 The Court regarded the stylisation as insufficient to
20 render the word registrable on the following basis:

21 "26. It is, admittedly, true that the graphic style of
22 the typeface used has certain specific features. However,
23 cursive script is an ordinary and traditional style which is
24 used by both children and adults, in daily life or in a
25 professional context, and which remains largely unremarkable

1 from the perspective of any consumer and, in the present case,
2 of the relevant public (see, to that effect, judgment of 19
3 May 2010 in Zeta Europe v OHIM (Superleggera), T-464/08,
4 EU:T:2010:212, paragraph 33).

5 "27. Thus, the view cannot be taken that the typeface
6 used makes it difficult to read the term 'splendid' and, in
7 particular, that customers would require a certain degree of
8 concentration in order to identify the letters 'p', 'l' and
9 'e'. The applicant's argument that consumers who come across
10 the mark would not immediately think of its meaning is
11 likewise unfounded.

12 "28. Accordingly, the relevant public will immediately
13 understand the term 'splendid', applied to the goods covered
14 by the mark applied for, as a laudatory reference to their
15 aesthetic quality.

16 "29. In the third place, that finding cannot be called
17 into question by the presence, in place of the dot over the
18 letter 'i', of a figurative element which is a Community trade
19 mark registered in respect of goods in Class 25 and services
20 in Class 35.

21 "30. It must be recalled that the assessment of the
22 distinctive character of the mark applied for must relate to
23 the overall impression that it produces and not to each of its
24 elements, taken separately (judgment of 2 July 2009 in
25 Euro-Information v OHIM (Representation of a hand holding a

1 card with three triangles), T-414/07, ECR, EU:T:2009:242,
2 paragraph 36; see also, to that effect, judgments of 15
3 September 2005 in BioID v OHIM, C-37/03 P, ECR, EU:C:2005:547,
4 paragraph 29, and of 8 May 2008 in Eurohypo v OHIM, C-304/06
5 P, ECR, EU:C:2008:261, paragraph 41).

6 "31. Thus, and as the Board of Appeal rightly noted in
7 the contested decision, the fact that the mark applied for
8 contains, in place of the dot over the letter 'i', a
9 figurative element which is a registered Community trade mark
10 is not conclusive for the purposes of assessing the
11 distinctive character of that mark as a whole.

12 "32. Moreover, if it were to be assumed that,
13 considered in isolation, the figurative element placed over
14 the letter 'i' has a distinctive character, that distinctive
15 character could not benefit the mark applied for in so far as
16 that mark is composed of other dominant elements which are
17 decisive in the overall impression that it produces (see, to
18 that effect, judgment in Representative of a hand holding a
19 card with three triangles, paragraph 30 above, EU:T:2009:242,
20 paragraph 48)."

21 That is entirely constant with the approach adopted in
22 the cases considered and applied by Arnold J in Starbucks (HK)
23 Limited & others v British Sky Broadcasting Group plc & others
24 [2012] EWHC 3074 (Ch), paragraphs 96, 97, 116 and 117. At
25 paragraph 117 he commented upon the examination of marks for

1 registration in terms which I consider to be pertinent to the
2 application for registration as it has been put forward for
3 consideration on appeal in the present case.

4 "117. I would comment that it appears to me that PCCW
5 only succeeded in obtaining registration of the CTM because it
6 included figurative elements. Yet PCCW is seeking to enforce
7 the CTM against signs which do not include the figurative
8 elements or anything like them. That was an entirely
9 foreseeable consequence of permitting registration of the CTM.
10 Trade mark registries should be astute to this consequence of
11 registering descriptive marks under the cover of a figurative
12 figleaf of distinctiveness, and refuse registration of such
13 marks in the first place."

14 If the stylisation of the first sign in the series of
15 three were to be regarded as sufficient to render the sign
16 eligible for registration, the result would, in my view, be a
17 figleaf registration of a sign unpossessed of any real
18 distinctive character. I am not persuaded otherwise by the
19 arguments addressed to me in support of the proposition that
20 the first sign in the series of three should be taken to fall
21 on the right side of the line when considered in the light of
22 non-binding practice statements and when compared for
23 consistency with the approach to registrability applied to
24 other signs featuring the word "simply" that have been
25 accepted for registration at the national and Community level.

1 The question I am required to consider on this appeal is not
2 whether the non-binding practice statements are correct or
3 whether those other signs or any of them were rightly or
4 wrongly accepted for registration in circumstances I know
5 little or nothing about, but whether, in accordance with the
6 requirement for legality of decision-taking, the particular
7 sign I am now considering appears to have been rightly
8 excluded from registration by the decision under appeal.

9 I am satisfied that it was, under section 3(1)(b) of the
10 Act. As to whether or not it could also have been rightly
11 excluded from registration under section 3(1)(c) of the Act, I
12 express no concluded view.

13 The appeal is accordingly dismissed. It is dismissed
14 with no order as to costs in accordance with the usual
15 practice of this tribunal in relation to appeals against ex
16 parte decisions of the Registrar.

17 MISS McFARLAND: Thank you, sir. I think there is nothing else.

18 THE APPOINTED PERSON: I think that concludes it.

19 MISS McFARLAND: We are grateful that you have produced your
20 decision quite so promptly.

21 THE APPOINTED PERSON: Thank you for the compliment. I wish I
22 could do it more often than I actually have succeeded in
23 doing. Thank you for that and thank you for your submissions.

24

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