

**O-561-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3134998 BY  
SYMINGTON'S LIMITED TO REGISTER:**

**NOODLE EXPRESS**

**AS A TRADE MARK**

**IN CLASSES 29 & 30**

**AND**

**IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO. 406094 BY  
KNORR-NAHRMITTEL AKTIENGESELLSCHAFT**

## **BACKGROUND & PLEADINGS**

1. On 6 November 2015, Symington's Limited ("the applicant") applied to register the words **NOODLE EXPRESS** as a trade mark. The application was published for opposition purposes on 20 November 2015 for the following goods:

**Class 29** - Instant meals; prepared meals; instant food which requires heating; soups; noodle based soups; snack foods, in particular dried instant hot snacks.

**Class 30** - Instant meals; prepared meals; preparations for making instant meals; instant food which requires heating; noodles; preparations consisting principally of noodles.

2. On 22 February 2016, the application was opposed in full by Knorr-Nahrungsmittel Aktiengesellschaft ("the opponent") under sections 3(1)(b), (c) and (d) of the Trade Marks Act 1994 ("the Act"). As the opposition based upon section 3(1)(d) of the Act was deemed withdrawn at a Case Management Conference ("CMC") held in August 2016, I need say no more about it in this decision. In its Notice of opposition, the opponent states:

### **Section 3(1)(b)**

"The essential function of a trade mark is to guarantee the identity and origin of the goods to enable consumers to distinguish the applicant's goods from those of other undertakings."

### **Section 3(1)(c)**

"The mark **NOODLE EXPRESS** consists of two general words which, when combined, describe characteristics or purpose of the goods."

3. The applicant filed a counterstatement in which the basis of the opposition is denied.

4. Although neither party filed evidence, the opponent filed written submissions during the course of the evidence rounds; I will bear these in mind in reaching a conclusion and refer to them, as necessary, below. Neither party requested a hearing nor did they file written submissions in lieu of attendance at a hearing.

## **DECISION**

5. The opposition is based upon sections 3(1)(b) and (c) of the Act which read as follows:

“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.”

6. As the applicant has not filed any evidence of the use it may have made of its “NOODLE EXPRESS” trade mark, the proviso to section 3 of the Act does not come

into play; I have, as a consequence, only the inherent characteristics of the applicant's trade mark to consider.

7. I begin by reminding myself that as the Court of Justice of the European Union ("CJEU") pointed out in *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, sections 3(1)(b) and (c) of the Act are independent and have differing general interests. I also remind myself that as the CJEU confirmed in *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, distinctive character must be assessed by reference to the average consumer of the goods at issue. In its submissions, the opponent states:

"12. In the present case, the goods covered by the application are everyday mass consumption goods and are mainly aimed particularly at consumers who require a quick easy meal or hot snack which they can prepare easily in minutes and consume on the go. The level of attention when purchasing and consuming such goods would be low. In view of the nature of the goods in question, the awareness of the relevant public will be that of the average consumer who is reasonably well-informed and reasonably observant and circumspect."

8. The average consumer of the goods at issue is a member of the general public who, as the case law makes clear and the opponent appears to accept, is to be regarded as "reasonably well-informed and reasonably observant and circumspect".

### **The opposition based upon section 3(1)(c) of the Act**

9. In its submissions, the opponent states:

"8. Descriptive terms merely consist of information about the characteristics of the goods and services. This means that descriptive terms cannot fulfil the function of a trade mark. Therefore, we will first demonstrate NOODLE EXPRESS has a descriptive meaning and falls foul of section 3(1)(c), and as such it also falls foul of section 3(1)(b) of the Act."

10. The above is a sensible approach and one I am happy to adopt. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation ) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity,

intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

11. In its submissions, the opponent states:

"14. We respectfully submit that the application falls foul of this provision because the words NOODLE EXPRESS describe the kind, quality, intended purpose and time of production of the goods.



15. The opponent submits that taken as a whole, the expression NOODLE EXPRESS immediately informs the average consumer of the nature and purpose of the goods without any further need for reflection that the goods applied for are meals which can be prepared quickly and which may contain noodles.”

12. The opponent provides definitions of the words “NOODLE” and “EXPRESS” as they appear in a number of dictionaries. These words will be well-known to the average consumer and require little further explanation. For the sake of completeness, however, I note that collinsdictionary.com (one of the dictionaries mentioned by the opponent), defines the words in a number of ways the most relevant of which appear below:

NOODLE – “(often plural) a ribbon-like strip of pasta: noodles are often served in soup or with a sauce.”

EXPRESS – “6. to send by rapid transport or special messenger; 10. of, concerned with, or designed for rapid transportation of people, merchandise, mail, money, etc - express delivery, ⇒ an express depot.”

13. In its submissions, the opponent states:

“18. Therefore, the test has to be whether or not the relevant consumer, upon seeing the mark “NOODLE EXPRESS”, would immediately identify the meaning of the sign as a descriptor [for the goods for which registration is sought].

19. We submit that the word “NOODLE” clearly describes the nature and kind of the goods in the applicant’s mark namely, “noodle based soups” in class 29 and “noodles” and “preparations consisting principally of noodles” in class 30 and therefore is expressly descriptive for the kind of products.

20. The word EXPRESS indicates that the goods may be prepared quickly or made rapidly. In general, the goods consist mainly of products which are

prepared “instantly” or in an express manner so that the application is also descriptive of the purpose, the quality of the goods and the time of production.

21. in particular, the goods “instant meals; prepared meals; instant food which requires heating; soups; noodle based soups; snack foods, in particular dried instant hot snacks” in class 29 and “instant meals; prepared meals; preparations for making instant meals; instant food which requires heating” in class 30 can all be prepared rapidly or in an express manner. The same conclusion applies to “noodles; preparations consisting principally of noodles” in class 30 which consist of meals typically prepared rapidly. The word “instant” is a synonym for “rapid/quick/express” and snacks, soups as well as prepared meals consist of foodstuff which don’t require a lot of preparation.

24...in the present case NOODLES is coupled with another non-distinctive term EXPRESS. Therefore, [NOODLE EXPRESS] combines two ordinary and descriptive words for the goods in question, and as a whole, does not create an impression which is sufficiently far removed from the individual elements to be “more than the sum of its parts”...The opponent submits that, as a whole, the sign “NOODLE EXPRESS” is descriptive in relation to all the applied for goods, namely meals which can be prepared quickly and rapidly.”

14. In its submissions, the opponent points to the comments of the CJEU in *Campina Melkunie BV and Benelux-Merkenbureau* Case C-265/00 in which the court stated:

“39. As a general rule, the 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 within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. 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.

40. 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 will have to be satisfied as regards both the aural and the visual impression produced by the mark.

41. Thus, a mark consisting of a neologism 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 within the meaning of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes 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.

42. For the purposes of determining whether the ground for refusal set out in Article 3(1)(c) of the Directive applies to such a mark, it is irrelevant whether or not there are synonyms capable of designating the same characteristics of the goods or services referred to in the application for registration. Although Article 3(1)(c) of the Directive provides that, if the ground for refusal set out there is to apply, the mark must consist exclusively of signs or indications which may serve to designate characteristics of the goods or services concerned, it does not require that those signs or indications should be the only way of designating such characteristics.

43. The answer to the questions referred for a preliminary ruling must therefore be that Article 3(1)(c) of the Directive must be interpreted as meaning that a trade mark consisting of a neologism 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 the characteristics of those goods or services for the purposes of that provision, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes 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.”

15. As the CJEU makes clear, a combination of elements which is descriptive of characteristics of the goods remains descriptive of those characteristics “unless there is a perceptible difference between the sum of its parts” with the combination creating “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...”

16. There can be no argument that in relation to various goods in the application i.e. “noodle based soups” in class 29 and “noodles” and “preparations consisting principally of noodles” in class 30, the word “NOODLE” is descriptive. The other goods in the application are expressed in general terms and would, in principle, include goods which do not consist of or contain noodles. In my view, however, it is most unlikely that the applicant’s trade mark would ever be used upon such goods and it is on this basis I intend to proceed. As to the word “EXPRESS”, this has the meanings indicated above, meanings with which I am satisfied the average consumer would be very familiar and which, broadly speaking, relate to speed. In relation to the vast majority of the goods in the application many of which are characterised as “instant” i.e. foodstuffs which can be prepared at speed, this word has very limited distinctive character.

17. I remind myself that in reaching a conclusion, it is irrelevant that there may be more usual ways of designating the characteristics to which the opponent refers. I accept that, on the balance of probabilities, the word “NOODLE” is most likely to be descriptive of the goods at issue and the word “EXPRESS” is likely to have very limited distinctive character. Despite this, the combination created is, in my view, somewhat unusual; this unusualness stems from a combination of factors. The first, is the syntax the applicant has adopted. In its submissions, the opponent refers to the decision of Mr Geoffrey Hobbs Q.C. acting as the Appointed Person in *Siemens AG’s Application* [1999] ETMR 146 in relation to which the opponent states:

“22...where Mr Hobbs QC considered the word “XPRESSLINK” to be equivalent to “Express Link” which he concluded was a sign that may serve, in trade to designate the intended purpose (rapid data transmission) of the goods (telecommunications apparatus).”

18. When considered in relation to telecommunication apparatus, one can readily understand why the words “Express Link” i.e. “a quick link” would be open to objection. A similar view may be taken of the words “EXPRESS NOODLE(S)” which would, in my view, be a much more natural way for other traders to communicate to the average consumer that their goods are noodles or contain noodles and are capable of being prepared quickly. Second, the use of the word EXPRESS, in my experience, is much more likely to be encountered by the average consumer in the context of the provision of a service rather than in relation to a trade in goods (one could, for example, easily imagine the words “NOODLE EXPRESS” being used descriptively in the context of a noodle based restaurant service).

19. There is no escaping the fact that when considered in the context of the goods most likely to be of interest to the applicant, the words “NOODLE EXPRESS” are highly allusive. However, the combination of the factors mentioned above are, in my view, just, sufficient for the application not to fall foul of section 3(1)(c) of the Act and the opposition based upon this ground fails accordingly.

## The opposition based upon section 3(1)(b) of the Act

20. In its submissions, the opponent states:

“27. The opponent acknowledges that the grounds of refusal under sections 3(1)(b) and (c) are independent of each other and require separate examination. According to the case law of the CJEU, the fact that a sign is composed of generic words that inform the public of a characteristic of the goods/services leads to the conclusion that the sign is devoid of distinctive character...This is clearly applicable to the present case. As such, we submit that that if the objection under section 3(1)(c) falls away following our submissions above, so must the objection under section 3(1)(b).”

21. While the opponent acknowledges that its opposition based upon 3(1)(b) and (c) are independent and require separate examination, the use of the words “falls away” and “so must” in the passage I have underlined above, ought, in my view, to be interpreted as indicating that it accepts that if its opposition based upon section 3(1)(c) fails, so will its opposition under section 3(1)(b). However, having made the above statement, the opponent then goes on to make separate submissions based upon section 3(1)(b) of the Act. Given that apparent tension, I will go on and consider this alternative ground.

22. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined

Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes 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 those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P

*OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37).”

23. In its submissions, the opponent points to the following comment of the CJEU in *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02:

“41. Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings.”

The opponent further states:

“30. With reference to the above, the opponent submits that “NOODLE EXPRESS” does not maintain a sufficient level of creativity and imagination to enable consumers to identify the origin of the [goods] in question from those of other competitors.

32. We submit the mark NOODLE EXPRESS is devoid of distinctive character to the extent that there is not enough precise information for consumers to enjoy a repeat experience each time they purchase the applicant’s goods sold under the mark NOODLE EXPRESS and to identify and link these goods to the applicant.

33. In addition we submit that given the non-distinctive character of the mark NOODLE EXPRESS, consumers would not be able to distinguish those goods sold under the application had been supplied by the applicant and that the applicant is responsible for their quality.”

24. While I have already concluded that the applicant’s trade mark does not fall foul of section 3(1)(c) of the Act, that does not, of course, preclude a finding that the



application is open to objection under section 3(1)(b). However, the factors I have identified above as contributing to the unusualness of the applicant's trade mark are also, once again in my view, just, sufficient to enable the average consumer to identify the origin of the goods at issue and to distinguish them from those of other undertakings. As a consequence, the opposition based upon 3(1)(b) also fails and is dismissed.

## **Conclusion**

25. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

## **Costs**

26. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering                      £200  
the other side's statement:

27. I order Knorr-Nahrungsmittel Aktiengesellschaft to pay to Symington's Limited the sum of **£200**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 28th day of November 2016**

**C J BOWEN**

**For the Registrar**