

1 PATENT OFFICE

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Harmsworth House,
Bouverie Street,
London, EC4

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4

Thursday, 22nd November, 2001

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Before:

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MR. S. THORLEY Q.C.

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In the Matter of the
TRADE MARKS ACT 1994

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and

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In the Matter of Trade Mark Application No. 2,206,477 of
AUGUST STORCK KG for the mark
WHERE ALL YOUR FAVOURITES COME TOGETHER

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Appeal to the Appointed Person from the
Decision of Mr. C. Redmore on 26th July 2001

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(Transcript of the Shorthand Notes of Marten Walsh Cherer
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MR. M. CHAPPLE (Messrs. D. Walther Wolff & Co.) appeared as
Counsel for the Applicant.

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MR. A. JAMES (Principal Hearing Officer) appeared as
Registrar's representative.

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D E C I S I O N
(As approved)

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1 MR. THORLEY : This is an appeal to the Appointed Person from a
2 decision of Mr. Craig Redmore, the officer acting for the
3 Registrar, dated 26th July 2001. The decision arose during
4 the course of an application by August Storck KG made on 28th
5 August 1999 to register a series of two trade marks in
6 respect of various categories of confectionary falling within
7 Class 30. The series consisted of two marks, one in upper
8 case, the other lower case, of the words WHERE ALL YOUR
9 FAVOURITES COME TOGETHER.

10 The specification of goods was subsequently limited so
11 as to read, "Confectionery in the form of packaged quantities
12 of products, the products in each packaging unit having the
13 same recipe." This arose because the Registry suggested that
14 the expression WHERE ALL YOUR FAVOURITES COME TOGETHER would
15 suggest to the average consumer that the packaging of the box
16 containing the confectionery would contain a variety of
17 different flavours or fillings which had been identified as
18 being a consumer's favourite.

19 Mr. Redmore, in reaching his decision, bore in mind
20 some comments that I made in a decision on the DAY BY DAY
21 trade mark (Application No. 2068646 - unreported) and also
22 some observations of Mr. Hobbs Q.C., sitting as an Appointed
23 Person, in AD2000 [1997] R.P.C. 168. Mr. Chapple did not
24 suggest that he fell into any error by bearing those comments
25 in mind and I therefore shall proceed on the basis that in

1 reaching a conclusion in this case, it is correct that I
2 should have regard to the natural use of the mark applied
3 for, not only on packaging of goods, but also in the context
4 of advertising (see my decision in DAY BY DAY). Further, I
5 must have regard to the legitimate interests of honest
6 traders, particularly bearing in mind the comments of Mr.
7 Robin Jacob, as he was, acting as the Secretary of State in
8 COLORCOAT Trade Mark [1990] R.P.C. 511, 517, where he drew
9 attention to the fact that the "privilege of a monopoly
10 should not be conferred where it might require 'honest men to
11 look for a defence.'"

12 Mr. Redmore, having reminded himself of those
13 decisions, concluded as follows: "The phrase WHERE ALL YOUR
14 FAVOURITES COME TOGETHER is not invented and in my view is
15 just a consequence of common ordinary dictionary words that
16 would easily come to mind in order to convey a promotional
17 message in respect of the goods applied for. The goods
18 specified in the application include 'chocolate and
19 confectionery'. Traditionally such goods have been sold in
20 boxes or other packaging which contain a variety of differing
21 flavours or fillings. Most consumers of these goods will
22 identify one or more of this variety as a favourite.
23 Therefore I consider that the mark WHERE ALL YOUR FAVOURITES
24 COME TOGETHER as a whole would be perceived by the relevant
25 customer as no more than a promotional statement that the

1 package contains a variety of confectionery items which sales
2 or other research have identified as consumer favourites."

3 On the basis of this, he concluded that the mark was excluded
4 from registration under sections 3(1)(b) and (c) of the Act.

5 That decision was given in July of this year before the
6 European Court of Justice gave judgment in the case of
7 Procter & Gamble Co. v. The Office for Harmonisation in the
8 Internal Market, C38399, on 20th September 2001. That was
9 the BABY-DRY case. It is not, on this appeal, necessary that
10 I should go into detail about the BABY-DRY case since it was
11 common ground between Mr. Chapple and Mr. James, who appeared
12 on behalf of the Registrar, that the correct approach to this
13 case had not changed as a result of the BABY-DRY decision.

14 It is sufficient, in those circumstances, that I refer to
15 paragraph 42 of the judgment in the BABY-DRY case where the
16 court stated the test under Article 7 of the Regulation
17 (which equates to section 3 of the Act) is as follows: "The
18 determination to be made depends on whether the word
19 combination in question may be viewed as a normal way of
20 referring to the goods or of representing their essential
21 characteristics in common parlance."

22 Of course, in BABY-DRY, the mark that was being
23 considered was a plain word mark and not a slogan or
24 strapline as in the present case. It was again common ground
25 that this mark was of the nature of the slogan or strapline

1 and that, therefore, consideration of its use in advertising
2 was particularly appropriate.

3 Mr. Chapple accepted that a slight variation of his
4 clients' application so that it read, "All your favourites
5 are here" would be unregistrable. However, he contended that
6 the use of the word "where" in the trade mark significantly
7 altered the feel of the slogan. He said that it became a
8 catchphrase and a grammatically incorrect catchphrase which
9 therefore acquired a character.

10 Mr. James, on the other hand, contended that a slight
11 extension of the slogan so that it read, "This is where all
12 your favourites come together in one box" would plainly be
13 unregistrable and that the average consumer would see WHERE
14 ALL YOUR FAVOURITES COME TOGETHER as being an abbreviation
15 for the longer expression.

16 In reaching a conclusion as to whether or not
17 Mr. Redmore was correct, I accept (and it was not suggested
18 to the contrary) that in ex parte proceedings, an appeal to
19 the Appointed Person should be by way of rehearing and not by
20 way of review. However, it would be right for the Appointed
21 Person nonetheless to pay due respect to the decision of the
22 hearing officer, who has considerable experience in trade
23 mark matters. Notwithstanding that it is a rehearing, I do
24 not believe the Appointed Person should depart from the
25 reasoning of a hearing officer unless satisfied that it is

1 wrong.

2 I turn then to consider the basic question: is the
3 trade mark applied for a perfectly normal way of referring to
4 the goods? "Is it a natural or normal way of referring to
5 the goods?" is the appropriate way to look at the question
6 before me. This is, I believe, the way that Mr. Redmore
7 approached the matter. He reached the conclusion that the
8 expression would be perceived by the relevant customer as no
9 more than a promotional statement that the package contains a
10 variety of confectionery items.

11 Mr. Chapple sought to criticise this on the basis that
12 Mr. Redmore was wrong in concluding that it was no more than
13 a promotional statement. I see some force in Mr. Chapple's
14 submission. What I have to consider is, I think, not the
15 question of whether the customer would see it as no more than
16 a promotional statement, but rather whether, in the course of
17 trade, such a use would be a natural or normal way of
18 referring to a quality of the goods.

19 I have reached the conclusion in this case that when
20 used in relation to confectionery as a whole, Mr. James's
21 submission carries weight. I believe the average consumer
22 would see the abbreviation for what it is, namely, an
23 abbreviation for the expression, "This is where all your
24 favourites come together in one box." Had, therefore, the
25 trade mark been applied for in respect of the description of

1 goods for which it was originally applied for, I would have
2 no hesitation in upholding Mr. Redmore's decision.

3 Mr. Redmore took account of the fact that the
4 specification had been limited so as to restrict it to
5 packaging units containing products, all of which were the
6 same. Does this make any difference to the conclusion? In
7 my judgment, it does not. In considering a category of
8 goods, plainly the more limited that category, the less scope
9 there is for the owner of the registered trade mark to invoke
10 his exclusive right pursuant to section 10(1) of the Act.

11 That is his right of a total monopoly of the use of the mark
12 as registered in respect of the goods for which it is
13 registered.

14 It is however right, I think, in considering this
15 question to have regard also to the more limited exclusive
16 right which is given pursuant to section 10(2) which gives
17 the proprietor of a registered trade mark rights over the use
18 of identical or similar marks in respect of a similar
19 description of goods.

20 I have no doubt at all that a package containing
21 products, some of which differed from the others, the closest
22 example being a box containing two different varieties of
23 products, would be goods of a similar description. Thus, if
24 someone used the expression or strapline, "Where all your
25 favourites come together" in relation to that product, there

1 would be scope for an allegation of infringement.

2 Whilst, therefore, the restriction of the category of
3 goods goes some way to identifying a distinction between the
4 use of the trade mark in its natural descriptive sense
5 because it would cease to be descriptive when referring to a
6 single variety of product, I do not believe it goes far
7 enough. This mark has not been the subject of any use and,
8 as an unused mark, I believe that Mr. Redmore was correct in
9 refusing to register it. This appeal will accordingly be
10 dismissed.

11 In accordance with the usual practice, Mr. James, you
12 do not seek costs.

13 MR. JAMES: No, I do not.

14 MR. THORLEY : There is no order as to costs.

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