

O-024-15

**TRADE MARKS ACT 1994 & THE TRADE MARKS (INTERNATIONAL REGISTRATION)
ORDER 2008 (as amended)
IN THE MATTER OF INTERNATIONAL REGISTRATION NUMBER WO0000001155277
BY SONAFI
TO PROTECT THE FOLLOWING TRADE MARK IN CLASS 30:**

BLOND

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Background

1. On 18 April 2013, Sonafi ('the applicant') requested protection in the United Kingdom under the provision of the Madrid Protocol for the following sign in standard characters:

BLOND

2. Protection was sought in Class 30 for the following goods:

Class 30: Cocoa and cocoa products; chocolate and chocolate products; pastry and confectionery; biscuits, cookies and cakes; sugar confectionery

3. On 26 April 2013, the Intellectual Property Office ('IPO') issued notification of a provisional total refusal of protection in response to the application. In that notification, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('The Act') on the basis that the mark consists exclusively of a sign which may serve in trade to designate the kind and characteristics of the goods e.g. confectionery products which are blond in colour.
4. On 7 June 2013, Mr Nigel Hackney of Mewburn Ellis LLP acting as the applicant's representative ('the agent') submitted written arguments stating why he considered that the objection was not well-founded. Along with this correspondence, Mr Hackney submitted exhibits to support his submissions and requested that the specification be limited to:

Class 30: Chocolate.

5. On 24 June 2013, the examiner issued a letter which acknowledged the amended specification, but also confirmed that it did *not* persuade her that the objection was no longer relevant for the remaining goods. Internet references were provided to demonstrate use of the mark in relation to chocolate (attached at Annex A).
6. In response, on 26 July 2013 Mr Hackney requested an *ex parte* hearing. At the hearing before me on 26 November 2013, the objection was maintained and the designation was refused. A Form TM5 was filed on 20 December 2013.

7. Having received Form TM5, I am now required to set out the reasons for refusal of protection in the United Kingdom. No formal evidence has been put before me for the purpose of demonstrating acquired distinctiveness. Therefore I have only the *prima facie* case to consider.

The applicant's case for registration

8. On 7 June 2013 and 26 July 2013 (i.e. before the *ex-parte* hearing), Mr Hackney submitted written arguments to the examiner in support of the claim to alleged *prima facie* distinctiveness. The submissions contained in those letters are summarised as follows:
 - The word 'Blond' is recognised in the United Kingdom as referring, almost exclusively, to the colour of hair, and although there is reference to use of the term in relation to wood and soft furnishings, this is not very common. There is nothing to indicate that the term is used in respect of food products or, more specifically, chocolate.
 - The term 'Blond' is capable of distinguishing the applicant's goods, because fanciful terms are not normally used to describe chocolate which are broken down into three main categories: Dark, Milk and White. These categories are used to refer to the composition of the chocolate, i.e. the level of cocoa contained within, as well as to the colour of the chocolate itself. The relevant consumer would not perceive the word 'blond' as having a descriptive meaning in relation to chocolate.
 - The use of the *name of a colour* is not associated in this trade with the flavour of the chocolate e.g. green-coloured chocolate would not be seen as descriptive of a characteristic or the goods. Whilst chocolate may be flavoured with mint, the chocolate in such cases is referred to as mint chocolate, not green chocolate.
 - Use of 'blond' as a descriptive term in relation to chocolate would differ significantly from the usual way of designating the relevant goods. There is no association between the hair colour 'blond' and chocolate. Chocolate is either dark brown (dark), light brown (milk) or a cream colour (white).
 - As was held by the Appointed Person in Case 0-391-12 '*Sushi*' at paragraph 17, section 3(1)(c) does not go so far as to prevent registration of "*signs which are not naturally or normally descriptive of the goods or services (because the goods or services do not usually have the characteristic that the term describes) but where there is a possibility that traders may wish to use them because they wish to make goods which (unusually) possess those particular characteristics*". It would be incorrect to deny registration based on the vague possibility that other traders may wish to use.
 - A number of the internet references supplied by the examiner did not work or referred back to the applicant. This was not sufficient to justify the objection under section 3(1)(c).

9. At the *ex parte* Hearing, Mr Hackney reiterated his arguments made previously in correspondence. He submitted that the primary meaning of the term 'blond' would be seen as an indication of hair colouring by the average consumer, and use in relation to chocolate would be fanciful and not descriptive of the kind of the goods.

The Law

10. Section 3(1) of the Act reads 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 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."

The above provisions mirror Articles 3(1)(b) and (c) of First Council Directive 89/104 of 21 December 1988. The proviso to section 3 is based on the equivalent provision of Article 3(3).

Decision - Section 3(1)(c)

11. In *JanSport Apparel Corp v Office for Harmonisation in the Internal Market* (Case T-80/07), the General Court (formerly the Court of First Instance) gave a helpful summary of the considerations to be taken into account in relation to Article 7(1)(c) of the regulation, the equivalent of section 3(1)(c) of the Act:

"18. Under Article 7(1)(c) of Regulation No 40/94, '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 or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service' are not to be registered.

19. By prohibiting the registration of such signs, that article pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered

as trade marks (Case C-191/01 P OHIM v Wrigley [2003] ECR I-12447, paragraph 31).

20. Furthermore, the signs covered by Article 7(1)(c) of Regulation No 40/94 are signs regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquired the product or service to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (Case T-219/00 Ellos v OHIM (ELLOS) [2002] ECR II-753, paragraph 28, and Case T-348/02 Quick v OHIM (Quick) [2003] ECR II-5071, paragraph 28).

21. The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought (see the judgment of 9 July 2008 in Case T-323/05 Coffee Store v OHIM (THE COFFEE STORE), not published in the ECR, paragraph 31 and the case law cited). Accordingly, a sign's descriptiveness can only be assessed by reference to the goods or services concerned and to the way in which it is understood by the relevant public (Case T- 322/03 Telefon & Buch v OHIM - Herold Business Data (WEISSE SEITEN) [2006] ECR II-835, paragraph 90).

22. It follows that, for a sign to be caught by the prohibition set out in that provision, there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see Case T-19/04 Metso Paper Automation v OHIM(PAPERLAB) [2005] ECR II-2383, paragraph 25 and the case-law cited)."

12. Furthermore, in Case C-363/99 *Koninklijke KPN Nederland NV and Benelux-Merkenbureau*, C-363/99 (*Postkantoor*), the Court of Justice of the European Union ('CJEU') stated:

"102. It is also irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. The wording of Article 3(1)(c) of the Directive does not draw any distinction by reference to the characteristics which may be designated by the signs or indications of which the mark consists. In fact, in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially."

13. I am also mindful of the decision of the General Court in *Ford Motor Co v OHIM*, Case T-67/07 where it was stated:

"24...there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately

to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics.”

14. It is clear from the aforementioned case law that I must determine whether, assuming notional and fair use, the mark in suit will be viewed by the average consumer as a means of directly designating essential characteristics - that is, in this case, the kind and a characteristic of the goods. The product at issue here is chocolate in class 30. These products are relatively low cost everyday purchases aimed at a non-specialist general public who is deemed to be reasonably well informed and circumspect. I consider that the level of attention may vary a little depending on the customer. However, it is reasonable to assume that a prospective purchaser of the applicant's goods would not apply a great deal of attention and circumspection when considering whether to buy or not to buy these goods.

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

Blond (masculine) or **Blonde** *adjective* 1. (of hair) of a light colour; fair. 2. (of a person, people or a race) having fair hair, a light complexion, and, typically, blue or grey eyes. 3. (of soft furnishings, wood, etc.) light in colour. *noun* 4. a person having light-coloured hair and skin. 5. Also called: blonde lace. a French pillow lace, originally of unbleached cream-coloured Chinese silk, later of bleached or black-dyed silk.

16. The dictionary reference defines the term as referring to a colour of one's hair and/or complexion, and the coloration of *inter alia* wood and soft furnishings. The term is also used to describe a type of unbleached cream coloured lace. Although these are very specific references, they do confirm that the word 'blond' is used to describe a colour which is understood to be light, fair and is similar to an unbleached cream. Blond hair can vary in shade from a light brown to a golden yellow hue, but it is always somewhere in the brown to yellow spectrum range of colours. Chocolate is also sold in a range of colours which range from dark brown to a light cream colour. This colour change is obtained by varying the amount of cocoa used in the product. The main categories of chocolate are dark, (referring to the dark brown colour of the chocolate), milk (referring to a lighter shade of brown chocolate) and white (referring to a creamy white shade of chocolate). These standard classifications demonstrate that it is already customary in the relevant trade to categorise chocolate by the shade of (brown) colour of the end product, and the average consumer would be accustomed to seeing a colour reference playing a role in the description of the goods. The term 'Blond' is a common dictionary word that would be understood to refer to a shade of light brown, and when used on light brown-coloured chocolate products, it would be understood by the average consumer to describe the kind and a characteristic (i.e. the colour) of the chocolate goods.

17. Research conducted as part of the hearing process had highlighted the fact that the term 'blond' is *already* being used to describe a light brown-colour chocolate product. These references were discussed at the hearing but not formally issued to the agent for consideration. These are reproduced at Annex B for completeness and demonstrate recipes for 'Blonde Brownies' and for 'Blonde Chocolate Mousse'. Both these products

have chocolate as a base ingredient and the term blond(e) is used to describe the light brown colour of the finished product. In these extracts, the term blond is spelled with an 'e' (as in 'blonde') but, as shown in the dictionary definitions provided above, the spelling of the word is interchangeable and to the average English speaker would mean the same thing.

18. Use of word 'blond(e)' in relation to recipes and food products will inform the average consumer that the term describes a characteristic of the end product, namely that it will be light brown/golden colour instead of the more usual dark brown in appearance. There is a link between chocolate-based confectionary products such as brownies and mousses (as shown in the references attached at Annex B) and chocolate *per se* as they both use chocolate as an ingredient. Therefore, it is reasonable to assume that use of the term 'blond' in a descriptive sense in relation to one food group that contains chocolate will also be seen as a descriptive reference if the same term is used in relation to very similar goods where chocolate is used.
19. The internet references provided by the examiner prior to the hearing did *not* show use of the term as a trade mark. Both of those references (now presented in Annex A) demonstrate use of the term 'blond' as a description of a kind of chocolate. The first excerpt includes the phrase "*...we can have a taste of the world's first blond chocolate...*", and in the second excerpt from The Guardian it is stated that "*...the latest serendipitous food to reach us is blond chocolate as distinct from white, milk or dark...*". Both of these references refer to a new product from Valrhona (a subsidiary company of the applicant), but there is nothing in the text to either indicate or suggest that use of the word is intended to be perceived as an indicator of trade origin.
20. Taking into account all of the above, I have concluded that the mark applied for consists exclusively of a sign which may serve, in trade, to designate the kind and/or other characteristics of the goods, and is therefore excluded from registration by section 3(1)(c) of the Act.
21. Having found that to be the case, it effectively ends the matter. However, in case I am found to be wrong in this regard, I will go on to determine the matter under section 3(1)(b) of the Act. I should at this point stress that since objection has been made under section 3(1)(c), this automatically engages section 3(1)(b). However, it can be useful to also consider section 3(1)(b) in its own right - the scope of the two provisions is not identical, and marks which are not descriptive under section 3(1)(c) can nonetheless be devoid of any distinctive character.

Section 3(1)(b)

22. I approach this ground of objection on the basis of the following principles derived from the CJEU cases referred to below:
 - An objection under section 3(1)(b) operates independently of objections under section 3(1)(c) - (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);

- For a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- A trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);
- The relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

Furthermore, in relation to section 3(1)(b), it was held in *Postkantoor* that:

"In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive" (paragraph 86)

23. I do not consider that an application should necessarily escape objection if it is considered too imprecise a term to indicate a direct and specific relationship with the goods or services at issue without further thought, but is, in some sense, more generally non-distinctive. I have indicated at paragraph 14 above how I feel the average consumer will perceive the mark. I do not believe that the sign would be capable of performing the essential function of a trade mark without the relevant public being educated into seeing it that way. In my view consumers would not consider the mark to be that of any particular manufacturer or supplier of chocolate, it could properly be at home on any of them.
24. Anna Carboni, sitting as the Appointed Person in *COMBI STEAM*, O-363-09, conveniently summarised the leading case law in respect of this part of the Act:

"It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs "a residual or sweeping-up function", backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: Procter & Gamble Ltd's Trade Mark Application [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from under section 3(1)(b): Koninklijke KPN Nederland BV v Benelux-Merkenbureau Case C-363/99 (POSTKANTOOR) [2004] ETMR 57 (ECJ) at [86]".

25. For reasons already given, the Registrar considers the sign to be descriptive of specific characteristics of the goods. It is clear from the above guidance that if a mark is entirely

descriptive of characteristics of goods or services, it will also be devoid of any distinctive character under section 3(1)(b). As I have found that the mark in question is open to objection under section 3(1)(c) of the Act, it follows that it is also open to objection under section 3(1)(b) of the Act.

26. I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is an indication of trade origin. I must therefore also conclude that the mark applied for is devoid of any distinctive character and is thus excluded from *prima facie* acceptance under section 3(1)(b) of the Act

Conclusion

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

Dated this 12th of January 2015

**Carol Bennett
For the Registrar
The Comptroller-General**

Annex A

Internet Information provided by the Examiner

Taken from:

<http://www.supanet.com/world-s-first-blond-chocolate-offered-by-valrhona-chocolat-a8603.html>

World's first BLOND chocolate offered by Valrhona Chocolat



Dulcey, the blond chocolate, will be a highlight during October's Chocolate Week...

15:25 11 October 2012

Gone are the days when chocolate was just dark, milk, and white. Today, with Valrhona Chocolat's new creation, we can have a taste of the world's first blond chocolate.

Perfect for October's Chocolate Week, the blond chocolate named "Dulcey" will be offered to pastry chefs and chocolate lovers.

This new product is said to be perfect with ingredients with gourmet notes such as coffee, hazelnut, and caramel.

It also works well with acidic fruits like bananas, mangoes, and apricots.

The makers are confident that "Dulcey" will easily become one of the favorites of chocolatiers and pastry chefs.

Unlike regular chocolates, it has a blond color and smooth, enveloping texture. It's not too sweet and it offers a biscuit flavor. The makers claim it took eight years to develop this one-of-a-kind treat.

It is understood that "Dulcey" will be available to the public from retail venues such as Harvey Nichols, Selfridges, Fortnum and Mason, and Chocolate Trading

Taken from:

<http://www.theguardian.com/lifeandstyle/wordofmouth/2012/sep/18/fluky-foods-serendipity-in-the-kitchen>

Fluky foods: serendipity in the kitchen

From the first cheese to a new type of 'blond' chocolate, an awful lot of what we put on our tables was created by accident rather than design



Potato crisps (or chips) were invented by accident.

I recently invented a cocoa citrus tea. It was the surprisingly pleasant result of an airborne Jaffa cake, launched by my daughter, landing in my teacup. Terrible table manners, I know, but the result was a zingy chocolatey orange flavoured brew. I have yet to patent it or even entice anyone else to try it, yet I cling to the belief that I may be on to something.

After all, some of the greatest dishes came about by accident. The latest serendipitous food to reach us is blond [chocolate](#), as distinct from white, milk or dark. Produced by French chocolate maker [Valrhona](#), the creation of this accidental chocolate has the flavour of a Joanne Harris novel.

"Early one spring morning 8 years ago," it goes, "at Valrhona's Ecole du Grand Chocolat, Frédéric Bau put some white chocolate in a bain marie, for a pastry demonstration. But he forgot about it until 10 hours later when the chocolate had turned a honey/butterscotchy shade of blond, smelled of toasted shortbread and had a unique creamy, sugary, slightly salty taste."

Eight years on chocolate "engineers" have finally found a way to reproduce the chocolate on a bigger scale and it's now available to buy in bar and bean shapes from Fortnum and Mason, Harvey Nichols [as well as](#) some [places online](#).

If its appeal is universal and the new product stands the test of time it will enter the annals alongside other accidental foodstuffs, which range from staples such as cheese to more exotic and unusual concoctions like Lea and Perrins Worcestershire sauce.

Mankind first tasted the former when an Arab nomad decided to transport milk in a container made from an animal's stomach, complete with the curdling enzyme rennet. When lunchtime arrived he was surprised to find the liquid was now a solid, but ate it anyway and liked what he ate.

Worcestershire sauce arose after a failed attempt by John Lea and William Perrins to recreate a much-loved Indian sauce for Lord Marcus Sandy, a former governor of Bengal, who on returning to England went to them with a description of the flavour he was pining for. What they came up with was too powerful, but rather than throwing the sauce away they stashed it in their basement for two years. It aged and changed, improving radically in the process and proving a hit with their customers.

A [fit of pique](#) led chef George Crum to the invention of potato crisps. A customer at his Saratoga Springs restaurant complained this French fries were too thick. Crum sliced potatoes as thin as he could and deep-fried them until they were hard, then sent them out to the complainer, who loved them.

It was being overworked that led Stéphanie Tatin to leave apples, intended for a pie, cooking for so long that they caramelized, leading to the signature dish of the [eponymous hotel](#) she ran with her sister. The list of accidental foodstuffs goes on. It includes choc-chip cookies, tofu, beer, cornflakes, iceberg lettuce, and ice cream cones. Once you start asking questions an awful lot of what we put on our tables was created by accident rather than design.

Many a chef will tell you the greater part of cooking is trial and error or absent-mindedness. All [signature dishes](#) require a bit of experimentation with ingredients and flavours, and every family seems to have its own peculiar culinary treats, concocted as a result of mistakes or improvisations.

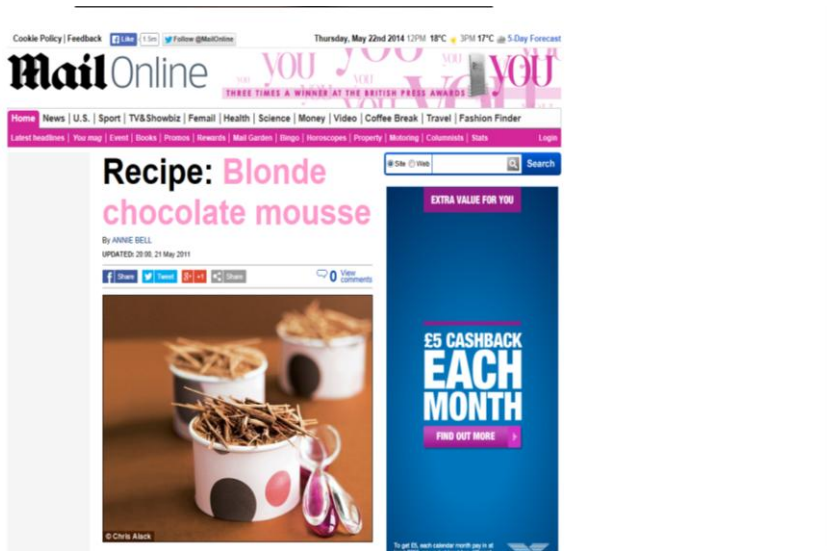
My grandmother used to served mashed potatoes with a fried egg on top. On one occasion she picked up a Marmite-smearred fork to mash the spuds. The resulting blend of [Marmity mashed potatoes](#) which we dubbed "Marmotegg" became a family favourite and is something I still crave on a cold winter evening. What are yours?

ANNEX B

Additional Information referred to at the *ex parte* hearing

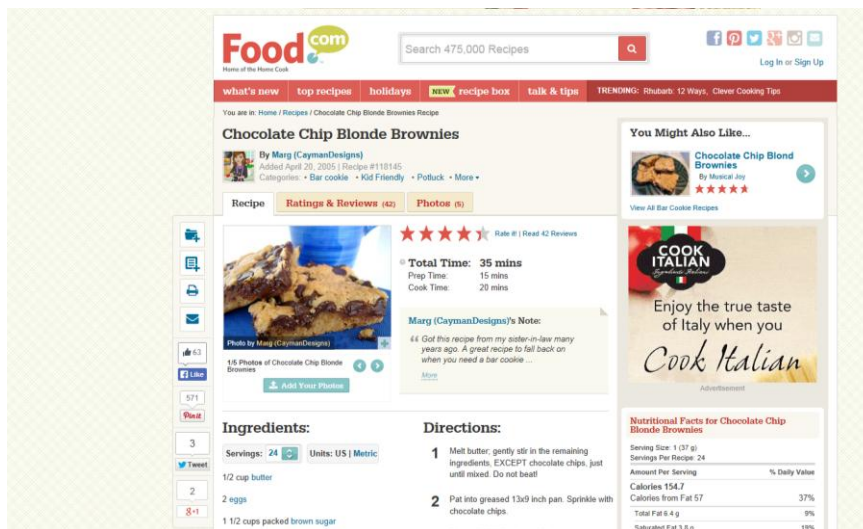
Taken from:

<http://www.dailymail.co.uk/home/you/article-1389077/Recipe-Blonde-chocolate-mousse.html>



Taken from:

<http://www.food.com/recipe/chocolate-chip-blonde-brownies-118145>



Taken from:

<http://www.kraftrecipes.com/recipes/bakers-one-bowl-white-chocolate-blonde-brownies-60075.aspx>

The screenshot shows the Kraft Recipes website interface. At the top, there are logos for Kraft, PHILADELPHIA, Jell-O, and Kraft Dressing. Below the logos, there are navigation links for home, contact us, and Food&Family magazine. A search bar is visible on the right. The main content area features the recipe title "BAKER'S ONE BOWL White Chocolate Blonde Brownies" with a 4.5-star rating and 48 reviews. A photo of the brownies is shown on the left. To the right of the photo, there are details about the recipe: "These one-bowl brownies get their blonde fabulousness from white chocolate—and their rich, nutty flavor from toasted pecans." Below this, the time is listed as 15 min prep and 30 min total, and the servings are 10 total (16 servings). There are also social media sharing options (Pinterest, Facebook, Twitter) and a "Love this recipe?" section with a "SUBSCRIBE NOW" button for a "FREE GIFT". A "firsttaste" promotion is also visible on the right side of the recipe page.

Taken from:

<http://www.chocolate.co.uk/chocolate-shop/chocolate-bars/blonde-chocolate-sea-salt/>

The screenshot shows the Chocolate Society website. The header includes the company name "THE CHOCOLATE SOCIETY" and the year "EST. 1991". Navigation links for SHOP, ABOUT, BLOG, BESPOKE, and WHOLESALE are visible. The main content area is titled "BLONDE CHOCOLATE & SEA SALT" and includes a breadcrumb trail: HOME / SHOP / CHOCOLATE BARS / BLONDE CHOCOLATE & SEA SALT. A "Free Delivery on Orders Over £70" banner is present. Below this, there is a large image of the chocolate bar packaging and a smaller image of the bar itself. To the right of the images, there is a description of the product: "We launched our new 'Blonde' chocolate and Halen Môn Sea Salt bars at the Spirit of Christmas Fair in 2012. After selling out on the first day, we knew we had a new favourite product. Blonde chocolate is a new type of chocolate, made by caramelising butter in the chocolate making process. The result is a sweet chocolate, similar to a white chocolate, but with a distinct caramel tone. We combine this mouth-melting chocolate with the finest Halen Môn Sea Salt, which cuts through the sweetness and balances the chocolate bar beautifully." Below the description, the price is listed as £4.50 and there is a "QUANTITY" dropdown menu set to 1 and an "ADD TO BASKET" button.