

O-274-15

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 2645351

BY LIDL STIFTUNG & CO. KG

TO REGISTER THE FOLLOWING TRADE MARKS

IN CLASSES 16, 29, 30, 31, 32, 33 AND 35:



O-274-15

Background

1. On 11 December 2012, Lidl Stiftung & Co. KG ('the applicant') applied to register the above marks, as a series of two, for the following goods and services:

Class 16 Paper, cardboard and goods made from these materials (not included in other classes), especially paper towels, napkins for babies, table napkins made from paper, filter paper, handkerchiefs, toilet paper, packaging containers made from paper, bags for packaging; printed matter; newspapers, magazines, books; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes), especially covers, bags, films; promotion material, namely master drafts for designing advertisements.

Class 29 Meat and meat products, poultry and poultry products, game and game products, sausage and sausage products, fish and fish products, also dried fish, sea food (not alive) and products therefrom, mollusca and crustacean (not alive) and products therefrom, meat extracts, fish extracts, poultry extracts, game extracts and vegetable extracts, fruits and vegetables, also sweet pickled and/or sour pickled, fruit and vegetable preserves, fruit and vegetable pulp, potato products of all kind (included in this class), all aforementioned goods also preserved, cooked, dried and/or frozen; fish delicatessen, especially Bismarck herrings, rollmops, fried herrings, matjes herrings, coalfish in oil, smoked salmon, smoked fish fillets, caviar, prawns and crab meat in brine and/or sauce; salads based on meat, fish, poultry, game, sausage, sea food, vegetables and/or fruits; semi-processed meals, ready-to-serve meals and frozen foods, especially exclusively or essentially consisting of meat, fish, poultry, game, sea food, potatoes, processed fruits, vegetables and/or cheese (included in Class 29); jellies, jams, marmalades, fruit mush and other sweet spreads (fruit preparations); processed almonds, processed nuts and nut mixtures of all kind, also with dried fruits; snacks based on potatoes included in Class 29, especially potato crisps and potato sticks; edible oils and fats; eggs, milk and milk products (included in Class 29), especially butter, cheese and cheese products, cream, yoghurt, curd; milk powder for nutritional purposes; desserts based on yoghurt, curd, cream, milk and/or fruits; soups, broths, soup preparations, stews, also ready-to-serve; fresh fruits and vegetables, also cut and in the form of salads; dietetic products and foodstuffs for non-medical purposes (included in Class 29).

Class 30 Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flours and cereal preparations, cereals, muesli and whole grain products; coffee beverages, tea beverages, cocoa beverages and chocolate beverages; coffee or cocoa preparations for making alcoholic or non-alcoholic beverages; flavourings for foodstuffs; bread and bread products, pastry and confectionery; sweets and candies (also using nutritive sweeteners),

O-274-15

chocolate and chocolate goods, chocolates, edible ices; honey, treacle; instant mixtures for making dumplings of all kind; instant doughs, especially dumpling dough, yeast dough, puff pastry; baking ingredients, especially baking powder, yeast, icings, couvertures, glaze, whipped cream stabilizer, baking flavours and baking oils (except essential oils), sugar strands, marzipan, nougat, edible paper, vanilla and vanillin sugar, vanilla pods; corn starch, sauce thickener; blancmange, blancmange powder; pasta meals of all kind, also ready-to-serve and/or frozen; sweet ready-to-serve meals on the basis of pasta, rice and/or whole grain products, especially rice pudding, semolina pudding, pancakes, Kaiserschmarrn (= cut-up and sugared pancake with raisins); salt, mustard; mayonnaise, remoulade, ketchup; vinegar, sauces (condiments), salad dressings; spices, spice extracts, dried and freeze-dried seasoning herbs; pizza and pizza products; pasta, also ready-to-serve and/or frozen; open sandwiches, open bread rolls and baguettes with topping, filled sandwiches; sushi; salads on the basis of rice and/or pasta; semi-processed meals, ready-to-serve meals and frozen foods, especially exclusively or essentially consisting of pasta and/or rice and/or whole grain products and/or pastry and/or confectionery (included in Class 30); pies; dietetic products and foodstuffs for non-medical purposes (included in Class 30).

- Class 31 Fresh fruits and vegetables; fresh nuts of all kind and almonds; fish, mollusca and crustacea (alive); seeds, natural plants and flowers, dried plants; foodstuffs for animals and additives for foodstuffs; litter.
- Class 32 Beers; non-alcoholic beer, diet beer, beer mix beverages; mineral and waters and other non-alcoholic drinks; fruit and fruit juice beverages; fruit juices; vegetable juices; smoothies; syrups and other preparations for making beverages
- Class 33 Alcoholic beverages (except beers), included in Class 33, especially wines, spirits and liqueurs as well as alcoholic mix beverages, cocktails and aperitifs based on spirits and wine; wine-containing beverages; alcoholic preparations for making beverages.
- Class 35 Retail services concerning paper, cardboard and goods made from these materials, especially paper towels, napkins for babies, table napkins made from paper, filter paper, handkerchiefs, toilet paper, packaging containers made from paper, bags for packaging, printed matter, newspapers, magazines, books, bookbinding material, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites (except furniture), instructional and teaching material (except apparatus), plastic materials for packaging, especially covers, bags, films, promotion material, namely master drafts for designing advertisements, meat and meat products, poultry and poultry products, game and game products, sausage and sausage products, fish and fish products, also dried fish, sea food (not alive) and products therefrom, mollusca and crustacea (not alive) and products therefrom, meat extracts, fish extracts, poultry extracts, game extracts and vegetable

O-274-15

extracts, fruits and vegetables, also sweet pickled and/or sour pickled, fruit and vegetable preserves, fruit and vegetable pulp, potato products of all kind, all aforementioned goods also preserved, cooked, dried and/or frozen, fish delicatessen, especially Bismarck ops, fried herrings, matjes herrings, coalfish in oil, smoked salmon, smoked fish fillets, caviar, prawns and crab meat in brine and/or sauce, salads based on meat, fish, poultry, game, sausage, sea food, vegetables and/or fruits, semi-processed meals, ready-to-serve meals and frozen foods, especially exclusively or essentially consisting of meat, fish, poultry, game, sea food, potatoes, processed fruits, vegetables and/or cheese, jellies, jams, marmalades, fruit mush and other sweet spreads (fruit preparations), processed almonds, processed nuts and nut mixtures of all kind, also with dried fruits, snacks based on potatoes, especially potato crisps and potato sticks, edible oils and fats, eggs, milk and milk products, especially butter, cheese and cheese products, cream, yoghurt, curd; milk powder for nutritional purposes, desserts based on yoghurt, curd, cream, milk and/or fruits, soups, broths, soup preparations, stews, also ready-to-serve; fresh fruits and vegetables, also cut and in the form of salads, dietetic products and foodstuffs for non-medical purposes, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flours and cereal preparations, cereals, muesli and whole grain products, coffee beverages, tea beverages, cocoa beverages and chocolate beverages, coffee or cocoa preparations for making alcoholic or non-alcoholic beverages, flavourings for foodstuffs, bread and bread products, pastry and confectionery, sweets and candies (also using nutritive sweeteners), chocolate and chocolate goods, chocolates, edible ices, honey, treacle, instant mixtures for making dumplings of all kind, instant doughs, especially dumpling dough, yeast dough, puff pastry, baking ingredients, especially baking powder, yeast, icings, couvertures, glaze, whipped cream stabilizer, baking flavours and baking oils (except essential oils), sugar strands, marzipan, nougat, edible paper, vanilla and vanillin sugar, vanilla pods, corn starch, sauce thickener, blancmange, blancmange powder, pasta meals of all kind, also ready-to-serve and/or frozen; sweet ready-to-serve meals on the basis of pasta, rice and/or whole grain products, especially rice pudding, semolina pudding, pancakes, Kaiserschmarrn (= cut-up and sugared pancake with raisins), salt, mustard, mayonnaise, remoulade, ketchup, vinegar, sauces (condiments), salad dressings, spices, spice extracts, dried and freeze-dried seasoning herbs, pizza and pizza products, pasta, also ready-to-serve and/or frozen; open sandwiches, open bread rolls and baguettes with topping, filled sandwiches, sushi, salads on the basis of rice and/or pasta, semi-processed meals, ready-to-serve meals and frozen foods, especially exclusively or essentially consisting of pasta and/or rice and/or whole grain products and/or pastry and/or confectionery, pies; dietetic products and foodstuffs for non-medical purposes, fresh fruits and vegetables, fresh nuts of all kind and almonds, fish, mollusca and crustacean (alive), seeds, natural plants and flowers, dried plants, foodstuffs for animals and additives for foodstuffs, litter, beers, non-alcoholic beer, diet beer, beer mix beverages, mineral and aerated waters and other non-alcoholic drinks, fruit

O-274-15

and fruit juice beverages, fruit juices, vegetable juices, smoothies, syrups and other preparations for making beverages, alcoholic beverages (except beers), especially wines, spirits and liqueurs as well as alcoholic mix beverages, cocktails and aperitifs based on spirits and wine, wine-containing beverages; alcoholic preparations for making beverages, advertising, especially poster advertising, advertising, marketing and promotion relating to goods or services businesses and private individuals, by telephone, or by sending advertisements and promotional material to third parties by post or electronic mail, placing advertisements, including on electronic sites accessed via global computer networks, planning, designing, organising and carrying out advertising campaigns, especially outdoor advertising campaigns, construction and marketing of advertising carriers, especially of billboards, advertising and information signage, arrangement of advertising carriers for others, especially of billboards, advertising and information signage.

2. On 6 January 2013, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under section 3(1)(b) of the Trade Marks Act 1994 ('the Act'), on the basis that the sign is devoid of any distinctive character.
3. The examiner stated that "The mark consists essentially of the words 'We British' with the device of a love heart containing a depiction of the Union Jack, being a sign which would not be seen as a trade mark as it is devoid of any distinctive character because for example, it would merely be seen as a promotional statement about the applicant, emphasising that they are a British company". The examiner went on to explain that she did not feel the mark is capable of indicating trade origin and stated that the device of a heart with the Union Jack is felt to reinforce the message contained within the words. When considered as a whole, the sign was felt to be non-distinctive.
4. On 3 May 2013, Urquhart Dykes and Lord ('the agent') submitted written arguments in support of the mark's alleged inherent distinctiveness, but the examiner was not persuaded that the objection should be waived. As a result of our maintenance of the objection, on 12 August 2013 the agent requested an *ex parte* hearing.
5. An *ex parte* hearing was duly held on 20 November 2013, where the applicant was represented by Ms Alice Simpson of Urquhart Dykes and Lord. At the hearing, the objection under section 3(1)(b) was maintained, and a period of two months was granted to allow Ms Simpson time to establish whether the applicant was able to provide evidence of acquired distinctiveness. On 23 January 2014, Ms Simpson requested an extension of time due to the fact that the applicant was investigating the extent and scale of use made of the mark prior to the filing date. An extension of time was duly granted until 28 March 2014.
6. On 28 March 2014, Ms Simpson made further submissions regarding both the inherent distinctiveness of the sign, and the state of the register. On the latter point, Ms Simpson provided a list of precedents that she considered were an indication of Registry practice. On the former point, and in addition to her arguments relating to the inherent distinctiveness of the mark, Ms Simpson provided a summary of the applicant's sales in

the UK of products bearing the '100% British' 2012 and 2013. Exhibits were also provided showing the applicant's use of the sign in trade. For information purposes, the summary and exhibits are attached to this decision at Annex A and Annex B.

7. In our official response of 3 April 2014, I confirmed that the objection had been maintained, and advised Ms Simpson that the exhibits showing the applicant's use of the sign were not considered to demonstrate it being used as a trade mark. Ms Simpson was further advised that this is something the applicant may wish to consider when filing any formal evidence in support of a claim to acquired distinctiveness. In view of the fact that additional time had been granted after the hearing, a final period of one month until 3 May 2014 was granted to allow the formal evidence to be submitted.
8. On 10 June 2014, in view of the fact that evidence had not been filed, the application was refused. A form TM5 requesting a full statement of reasons for the Registrar's decision was then received on 2 July 2014. As a result, I am now required to set out the reasons for refusal. No formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, I have only the *prima facie* case to consider.

The applicant's case for registration

9. 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*. Prior to refusal of the application, the arguments put forward in support of *prima facie* acceptance were those made in writing by the applicant's representative on 3 May 2013 and 27 March 2014, and also those made orally at the *ex parte* hearing.
10. In written correspondence, Ms Simpson submitted that the words in the mark were in a deliberate configuration and incorporated a heart shaped representation of the Union Flag. Reference was made to the fact that, under IPO published practice, stylised representations of UK national flags are considered acceptable in the *prima facie* case and are usually *not* open to objection under sections 3(1)(b) and (c). It was submitted that inclusion of the stylised heart-shaped flag adds the distinctiveness required for the mark to be accepted, since the heart device should be deemed acceptable in its own right (i.e. when considered in isolation). Submissions were made regarding the arrangement of words and script together with the use of the heart-shaped Union Flag which, it was submitted, conveys an 'emblematic' feel to the mark.
11. Ms Simpson stated that it is incumbent upon the Registrar to assume that such a sign may be used as a stand-alone sign, and she believed that the sign of the application operates by creating an 'emblematic mark'. She argued that the sign's 'emblematic nature' shows that it is not being used simply as an indication of geographic origin of the goods, but rather that it is individualised in a way which is likely to be seen by the average consumer as indicating the involvement of a particular economic undertaking. It was considered that, even though the sign provides a message of support for British produce, consumers' perception of the sign would be origin specific.

12. At the hearing, Ms Simpson argued that the sign must be considered as a whole and made further reference to the Examination Guide (or 'Work Manual') which states that stylised representations of UK national flags are considered acceptable in the *prima facie* case. Ms Simpson also made reference to the fact that similar precedents had been accepted for registration.
13. After the hearing, Ms Simpson's written submissions again focused on the practice published in the Examination Guide relating to stylised representations of UK national flags. It was submitted that, in raising and maintaining the section 3(1)(b) objection, the examiner and hearing officer had conflated relevant paragraphs in the Guide into a single meaning, whereas, they are two completely separate statements. For reference, those relevant paragraphs are reproduced at paragraph 27 below.

Decision

14. Section 3(1)(b) of the Act states:

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

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

15. The Court of Justice of the European Union ('CJEU') 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 (*Bio ID v OHIM*, C-37/03P paragraph 59 and the case law cited there and, more recently, *Celltech R&D Ltd v OHIM*, C-273/05P).
16. 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*", *SAT.1 SatellitenFernsehen GmbH v OHIM*, C-329/02P. 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 any distinctive character are incapable of fulfilling that essential function.
17. It is also well established, in the UK at least, that the words 'devoid of any distinctive character' are interpreted as meaning 'unpossessed' of distinctive character, based on the perceptions of the average consumer and in relation to the goods and services applied for.
18. In refusing the application in its entirety, it is also important I am convinced that the objection applies to all the goods and services applied for. If there are goods or services specified which are free of objection under section 3(1)(b) then they must be allowed

O-274-15

to proceed. In Case C-239/05 *BVBA Management, Training en Consultancy v Benelux-Merkenbureau*, the question being referred to the CJEU was whether the Directive, on which the Act is based of course, must be interpreted as meaning that the competent authority is required to state its conclusion separately for each of the individual goods and services specified in the application. The Court answered, and in paragraph 38 said that the competent authority was required to assess the application by reference to individual goods and services. However, where the same ground of refusal is given for a category or group of goods or services, the Court also confirmed that the competent authority may use only general reasoning for all the goods and services concerned. It is plain from this judgment that the Court had in mind purely practical considerations which had to be balanced against a legal provision in the Trade Marks Directive which allows for refusal only in relation to goods and services where objections apply.

19. In my view, the approach taken by the Appointed Person in *FeedbackMatters* [BL O/185/12] is correct as (or at least indicative of) a general proposition. At paragraph 35, the Appointed Person stated:

“In relation to the comments at paragraph 21 about ‘office functions’, I would not have separated these services out from the rest of the specification as giving the mark more chance of being accepted. The power of the mark to individualise office functions, even if restricted to something like photocopying services or phone answering services, as suggested by the hearing officer, seems to me to be no greater than for the other services. Although the mark is less obviously potentially descriptive of what the services entail, it nevertheless remains lacking in the ability to denote origin without first being used in a way that would educate business people that this is its purpose.”

Even if it is not, and was never intended as a general proposition *per se*, it is certainly indicative of the inherent problems in handling a sign which may be considered ‘devoid’ in relation to certain goods and services but not others. The fact the Appointed Person was limited in her application of the proposition to services in class 36 does nothing to undermine the practical or theoretical soundness of approach. If a view is taken that, linguistically, a phrase is likely to be ‘devoid’, that is to say ‘unpossessed of distinctive character’ or ‘origin neutral’ for my purposes, it is sometimes (as in this case) very hard to draw any meaningful line whereby it may be ‘origin specific’ in relation to certain (only) goods and services.

20. In saying this, I am of course, familiar with, and bound by, the application of the ‘partial refusal’ principle based upon Art 13 of the Trade Marks Directive, namely that refusal can only be based on those goods and services in respect of which the objection is effective, and by definition, for other goods and services, the application can be accepted. I will simply observe at this stage however, that this is a somewhat easier principle to apply where the objection is based only upon section 3(1)(c), where objective characteristics such as types and kinds are at play, rather than signs or marks which are simply, in the Registrar’s view, ‘devoid’ under section 3(1)(b) only.

O-274-15

21. With regard to the precedents referred to by Ms Simpson both in writing and at the hearing, again I refer to the comments of Ms Anna Carboni, sitting as Appointed Person in *FeedbackMatters*, who stated the following at paragraphs 67 and 68:

67. Although I agreed to review the list, the job of doing so reinforced to me the sense that there is in the general rule that each mark has to be assessed independently against the relevant legal criteria and to stand or fall on its own merits. While it is possible to reach a broad view that two marks are of a similar type and therefore should be treated similarly, that can only be so if the relevant goods and services and their respective average consumers are identical. And, of course, the marks themselves all mean different things and may or may not be the same or similar to phrases in regular use, or have particular connotations. Also, some may have been accepted as a result of evidence of acquired distinctiveness through use. So, what may appear to be dissimilar treatment may be wholly justified by these differences.

68. Having considered Mr Bates' list, I have concluded that I might be able to point to a particular mark that has been accepted for particular services in Class 35 and say that to my mind it is not distinctive for those services, but I am unable to say from reviewing the list that the IPO has materially raised the bar in this case as against others from before or after, or that the Decision was obviously wrong.

Having reviewed the earlier registered marks referred to by Ms Simpson, it does not appear to me that I have raised the bar in terms of the assessment of distinctiveness of the marks being applied for. Rather, I have assessed the application on its own merits and therefore attach limited significance to the fact that other 'similar' marks have been registered.

22. 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 CJEU provided guidance in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (Postkantoor)* C-363/99 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 C-104/01 Libertel [2003] ECR I-3793, paragraphs 46 and 75)."

23. 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. The goods and services are listed in full at paragraph 1 above and cover a wide range of products, for example, paper and stationery in class 16, a broad range of foodstuffs and

O-274-15

both alcoholic and non-alcoholic beverages in classes 29, 30, 31 and 32. In relation to class 35, the services are largely in the area of retailing including, for example the retailing of paper, stationery, food and drink. In addition to retailing, the Class 35 specification also covers advertising and marketing services.

24. In relation to identifying the relevant consumer, it is reasonable to assume that the goods and services claimed in this application can be described as being directed towards both the general public and also those engaged in business wishing to employ the services of an advertising or marketing company. As such, I consider that the level of attention paid in the selection of the applicant's goods and services will vary depending on whether the consumer is purchasing goods in classes 16, 29, 30, 31, 32 and 33, or services in class 35. In the case of the former, where the applicant is providing everyday consumables, a moderate level of attention will be paid by the consumer. In the case of the latter, the level of attention paid will be high. 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, T-130/01(Real People Real Solutions)*, 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."

25. When assessing a mark's distinctiveness, it is necessary to consider the perception of that mark by the average consumer - who I have identified above. The mark consists essentially of: the word 'We' presented in a stylised font; a representation of a heart which contains a Union Flag; and the word 'British' presented in a stylised typeface; with all of these elements displayed within a rectangular background. I have considered the meaning and significance of each of these individual elements which combine to form the sign, and believe that the aforementioned public-at-large would understand them to mean the following:

- Used in relation to the goods and services claimed, I consider that the term 'we' would be recognised as a pronoun, and would be understood as referring to an individual and/or one or more other people, for example the consumer who is encountering the sign for the first time, or the business provider.
- With regard to the stylised heart within the marks, hearts are commonly used in both marketing and general language as an alternative means of expressing the sentiment 'love'. The incorporation of a Union Flag into this 'heart' device would be perceived as reinforcing the word 'British' found elsewhere in the sign, and is likely to do nothing more than appeal to patriotic UK consumers.
- The word 'British' is defined in Chambers 21st Century Dictionary as:

British *adjective* 1. belonging or relating to Great Britain or its inhabitants.

26. The average consumer has been exposed to use of ‘heart devices’ as a substitute for the word ‘love’ since at least 1977 when one was first used in relation to the promotion of New York City¹. Its use to promote geographical places is now commonplace and it is fair to assume that the public would immediately perceive a combination of the word ‘We’, the ‘heart device’, and the word ‘British’, as meaning ‘We love British’. I acknowledge that the figurative element (i.e. the ‘heart shape flag’) is not a *typical* pictorial representation of a flag. However, I still take the view that the image would be understood by the average consumer as being an indication of love or affection, and the use of the Union Flag within the heart merely reinforces the word ‘British’ within the mark. The individual elements (the words, the font and the stylised images) including the simplistic rectangular background, combine together to build an artistically pleasing presentation that conveys the meaning ‘We love British’.
27. With regard to the stylised heart within the mark, Ms Simpson’s arguments focused on guidance published in the Trade Marks Examination Guide (or ‘Work Manual’) which is reproduced here:

“Stylised representations of UK national flags

Stylised representations of UK national flags are considered acceptable, prima facie, and are not open to objection under section 3(1)(b) and (c).

for example:



Stylised representations forming part of an overall distinctive mark may be accepted prima facie under section 3(1)(b) and (c), but they may be open to objection under section 3(3)(b) and 4(2) if their use would be deceptive as to the origin of the goods / services.”

Ms Simpson submitted that, in assessing the mark, the above paragraphs had been ‘conflated’ into a single meaning. In my view, it is very clear from the hearing report and also from my letter of 3 April 2014 that the practice has *not* been conflated. Rather, I consider that the paragraph which is applicable to this case is that which states:

*“Stylised representations **forming part of an overall distinctive mark** may be accepted prima facie under section 3(1)(b) and (c), but they may be open to objection under section 3(3)(b) and 4(2) if their use would be deceptive as to the origin of the goods/services.” (My emphasis)*

¹ Designed by Milton Glaser as part of a advertising campaign see: http://en.wikipedia.org/wiki/I_Love_New_York

O-274-15

The above guidance only serves to confirm that stylised representations of UK flags *may* (not *shall*) be acceptable where they form part of a mark which is distinctive in its own right. In the application-in-suit, the composite mark is not distinctive in its totality, and so this particular section of the Guide as quoted by Ms Simpson is not relevant. Settings aside the issue of the mark's distinctiveness in its totality, the fact also remains that, in my view, the stylised heart-shaped representation of the national flag as presented in this particular sign is not distinctive in its own right and does not, therefore, assist the claim to distinctiveness of the sign in its totality. With regard to the Examination Guide, guidance published therein cannot supplant or undermine the relevant case law from the CJEU, nor create a presumption of distinctiveness in relation to the registration of stylised flags. Each case requires a specific assessment of the distinctive character of the sign at issue, in order to verify that the sign fulfils its essential function, namely of guaranteeing the origin of the goods and services.

28. When considered as a whole, it is unlikely that the average consumer would apportion any trade mark significance to the presentation or message conveyed by this sign. The elements contained within it do not combine in such a way to create a distinctive whole. I maintain that without educating consumers that the sign is a trade mark, it would ultimately be seen as origin neutral. Used in relation to the goods and services intended for protection, I consider that the sign would be perceived as nothing more than a non-distinctive statement merely informing consumers that the undertaking supports and promotes British produce and British business. It is a wholly non-distinctive sign which conveys nothing other than (i) information about the origin of the goods, and (ii) confirmation that the undertaking using the sign endorses British produce and British business.
29. With regard to the services in class 35 which cover the retailing of a wide range of goods, I consider that the objection is also applicable for the same reasons as stated above. However, with regards to use in respect of the remaining services in class 35 (i.e. those which relate to advertising and marketing), the sign is less obviously potentially descriptive of what the services entail, but it nevertheless remains lacking in the ability to denote origin without first educating consumers that it is a trade mark. In this regard, I refer to the comments of Geoffrey Hobbs QC, sitting as Appointed Person in BRING THE WORLD CLOSER and NO WIRES NO WORRIES [BL O/353/10], where the following is stated at page 15:

“Taken as a whole, the expression looks and sounds like a statement about an advantage flowing from the use of the services on offer. I agree that the advantage and the methodology or mechanism by which it is delivered are not thereby explained. However, a narrative statement can be uninformative in relation to an aspect of the services to which it refers without necessarily or inevitably being apt to serve as an indication of trade origin. I think that is the position here.”

When used in relation to advertising and marketing services, it appears to me that the signs will convey a narrative expression and that the words are inherently ‘origin neutral’. The fact that they may be used in relation to an intangible ‘service’ rather than a tangible ‘good’ is not apt to transform them into denoting trade origin; all that the words convey is a narrative expression which promotes British business.

O-274-15

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

Conclusion

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

Dated this 12th day of June 2015

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

Annex A

O-274-15

Overview and sales of products for the use of „100% British / We love British“ logos, July 2012

Article no.	Article	2013	2012
245	Chicken Breast Fillets	15.000.000,00	8.000.000,00
250	Chicken Legs	2.000.000,00	2.000.000,00
686	Pork Loin Chops	4.000.000,00	3.000.000,00
1309	Medium Free Range Eggs	3.000.000,00	2.000.000,00
1647	Diced Lean Pork	600.000,00	400.000,00
1850	Lean Beef Stir Fry	500.000,00	100.000,00
2192	Scotch Beef Burgers	1.000.000,00	60.000,00
2320	Beef Mince	6.000.000,00	5.000.000,00
2324	Lean Beef Steak Mince	10.000.000,00	6.000.000,00
2350	Pork Leg Joint	400.000,00	50.000,00
2552	Lean Diced Beef Steak	7.000.000,00	4.000.000,00
2615	Beef Quarterpounders	3.000.000,00	1.500.000,00
3499	Beef Fillet Steak	500.000,00	--
3501	Beef Ribeye Steak	400.000,00	--
3773	Pork Shoulder Joint	1.000.000,00	700.000,00
3915	Pork Loin Medallions	2.000.000,00	1.000.000,00
3939	Premium Lean Beef Frying Steak	3.000.000,00	2.000.000,00
4069	Free Range Chicken	3.000.000,00	200.000,00
4777	Beef Rump Steak	3.000.000,00	2.000.000,00
4836	Sirloin Steak	5.000.000,00	2.000.000,00

Page 3
27 March 2014

5129	Diced Chicken Breast Fillets	4.000.000,00	2.000.000,00
5130	Inner Breast Fillets	4.000.000,00	2.000.000,00
5322	Chicken Breast Fillets	10.000.000,00	8.000.000,00
5575	Pork Stir Fry	300.000,00	80.000,00
6306	Chicken Drumsticks & Thighs	1.000.000,00	--
6308	Free Range Chicken Breast Fillets	300.000,00	--
6363	Beef Mince	1.000.000,00	--
6370	Pork Shoulder Steaks	1.000.000,00	--
6405	Pork Loin Steaks	6.000.000,00	3.000.000,00
6582	Garlic and Herb Whole Chicken	800.000,00	--
6625	Fresh British Turkey Breast Steaks	3.000.000,00	2.000.000,00
7164	Large Chicken	7.000.000,00	--
7198	Medium Chicken	6.000.000,00	--
7293	Pork Belly Slices	3.000.000,00	2.000.000,00
7567	Outdoor Bred Pork Fillet Medallions	700.000,00	--
7983	Scotch Beef Sirloin Steak 28D	1.000.000,00	100.000,00
8242	Beef Roasting Joint	1.000.000,00	900.000,00
8260	Beef Mince	3.000.000,00	1.000.000,00
8311	Large Free Range Eggs	6.000.000,00	2.000.000,00
9101	Chicken Breast Steaks	2.000.000,00	400.000,00
9372	Chicken Thighs	9.000.000,00	6.000.000,00
9373	Chicken Drumsticks	4.000.000,00	2.000.000,00
9540	Organic Free Range Eggs	700.000,00	200.000,00
9747	Pork Lean Mince	1.000.000,00	500.000,00
9801	Large Eggs	2.000.000,00	300.000,00
9817	Medium Eggs	10.000.000,00	1.000.000,00

Annex B- Exhibit 1:

We Love British - Lidl UK Page 1 of 1

 **Our Offers - Lidl surprises.**

[You are here:](#) [www.lidl.co.uk](#) [Home](#) [All Love British](#)



We Love British

British farmers adhere to some of the highest standards of production and animal welfare to produce products that are synonymous with the finest quality and taste.

From fresh British beef to a variety of fruit and vegetables, we are proud to offer a range of products that is grown and packed in Britain.

Meat & Poultry



Our British meat and poultry products come from British farms that meet the internationally recognised standards set by the Red Tractor Scheme.

Dairy



Our range of dairy products at Lidl deliver an authentic taste of Britain and are produced to exceptionally high standards.

Produce



All our fruit and vegetables are quality checked for optimum freshness and maximum taste. We buy British wherever possible, which means our fruit and vegetables are locally grown, Red Tractor assured and fully transported from field to store.

http://www.lidl.co.uk/cps/rde/SID-1E77B943-A9ACD020/www_lidl_uk/fs.xsl/we-lo... 27/03/2014

Annex B - Exhibit 2:

Shortlisted for Best Supermarket in Which? Awards 2012

LIDL www.lidl.co.uk

Ace Deals served up at Lidl this summer

SPORT

Available Thursday 5th to Wednesday 11th July

Wine of the Week

IMAROSA

Chilean Pedro Jimenez

- Dry, lively and elegant wine - perfect for seafood, roasting & BBQ
- 12% vol
- 75cl

Save 10%

~~3.99~~ **3.59** Each

Now Cheaper!

VALUE PACK 42 WASHES

Daz

MANDARIN & LIME SPLASH

Save 23%

~~6.49~~ **4.99** Per Pack

Now Cheaper!

Special Muesli

Muesli

Luxury Fruit & Nut

Save 11%

~~1.68~~ **1.49** Per Pack

Now Cheaper!

QUALITY FOOD AWARDS 2011 WINNER

33% OFF

Selected Fruit & Vegetables

See inside for many more offers

Fresh Cucumber

Crunchy & Refreshing

Save 33%

~~59p~~ **39p** Each

Now Cheaper!

Fresh Peaches

Sweet & Juicy

Save 33%

~~1.99~~ **1.32** Per Pack

Now Cheaper!

British New Potatoes

We British

Save 33%

~~1.49~~ **99p** Per Pack

Now Cheaper!

Price shown is a guide only and subject to change. Stock availability may vary. Some offers may be subject to change. See inside for full terms and conditions. © Lidl 2011

Annex B - Exhibit 3:

LIDL
www.lidl.co.uk

Award Winning Offers

at Lidl this summer!

Available Thursday 9th to Wednesday 15th August

400 Award Winners

SUMMER OF SPORT

Multi-Award Winning Comte de Brismand Reul Reserve Champagne
• 750ml
• 12% Save
~~14.99~~ **12.99**
New Cheaper!

Sam Sainsbury's Special Muesli
• 1.5kg
• 11% Save
~~1.69~~ **1.49**
New Cheaper!

Australian Chardonnay
• 750ml
• 11% Save
~~4.19~~ **3.69**
New Cheaper!

Fresh British Chicken Breast Fillets
• 500g
• 12% Save
~~3.99~~ **3.49**
Like Most, Look Us Up!

LURPAK Spread
• 500g
• 33% Save
~~2.99~~ **1.99**
New Cheaper!

Fresh Watermelon
• 2.99
• 36% Save
~~2.99~~ **1.89**
New Cheaper!

Fresh British New Potatoes
• 1.5kg
• 25% Save
~~1.19~~ **89p**
New Cheaper!

400 Award Winners and Counting!

Annex B - Exhibit 4:

LIDL www.lidl.co.uk

SAVE AGAIN!

Thurs 6th to Wed 12th September

Proud sponsor of **PRIDE of BRITAIN AWARDS 2017**

Save 16%
Fresh British Pork Loin Steaks
• 480g • 11.99/100g
~~2.99~~ **2.49** Per Pack
Like Meat, Love Us!

Special Offer
5 Thick Cut Back Bacon Rashers
• Smoking • 250g • 10.99/100g
~~1.99~~ **1.29** Per Pack
Purveyors of Quality!

Save 33%
Mull of Kintyre Extra Mature Scottish Cheddar
• 300g • 6.99/100g
~~2.99~~ **1.99** Per Pack
Now Cheaper!

Save 37%
Fresh British Celery
• 500g • 1.30/100g
~~79p~~ **49p** Per Pack
Now Cheaper!

Save 33%
Fresh British Baby Potatoes
• 3kg
~~1.19~~ **79p** Per Pack
Now Cheaper!

100% of our fresh British fruit and vegetables carry the Red Tractor logo

Save 20%
Cushelle Toilet Paper
• 24 Rolls • 33.99/roll
~~9.99~~ **7.99** Per Pack
Now Cheaper!

Save 10%
Plein Sud ACE Vitamin Juice Drink
• 1.5L Carton
~~99p~~ **89p** Per Carton
Now Cheaper!

Save 30p
Bardolino Classico 2011
• 75cl
~~3.99~~ **3.69** Per Bottle
Now Cheaper!

Wine of The Week

