

O-358-13

IN THE MATTER OF THE TRADE MARKS ACT 1994

-and-

**IN THE MATTER OF APPLICATION NO. 2581706 in the name of
AIMIA FOODS LIMITED
to register the Trade Mark
'PORRIDGEBREAK'**

-and-

**IN THE MATTER OF OPPOSITION NO. 102334
BY WEETABIX LIMITED**

**APPEAL TO THE APPOINTED PERSON FROM THE DECISION OF MS ANN
CORBETT, HEARING OFFICER, ACTING ON BEHALF OF THE REGISTRAR OF
TRADE MARKS DATED 7TH AUGUST 2012**

DECISION

Introduction

1. The Applicant seeks registration of the word PORRIDGEBREAK in class 30 for *'porridge oats, cereals'*.
2. Registration was opposed by Weetabix Limited under s3(1)(b) and s3(1)(c) of the Trade Marks Act 1994.
3. Section 3(1)(b) is a general prohibition on the registration of trade marks which are devoid of distinctive character. Section 3(1)(c) is a more specific prohibition on the registration of marks 'consisting 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 or rendering of services, or other characteristics of goods or services’.

4. The Hearing Officer concentrated her analysis on the s3(1)(c) objection, reasoning out that the objection under s3(1)(b) was no wider in scope and therefore must fail if the s3(1)(c) objection failed. The Notice of Appeal does not seem to take issue with this analysis, and concentrates on s3(1)(c).
5. There seems to me to be nothing wrong with the Hearing Officer’s analysis of the relevant law, and indeed no criticism of this is made by the Opponent on this appeal. The Hearing Officer cites the well known propositions established in the jurisprudence of the CJEU as underpinning the s3(1)(c) objection. In particular she cites:

- (a) From the General Court in JanSport v OHIM Case T-80/07, paragraphs 21-23:

’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...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...

’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 there cited)

'23. It must finally be pointed out that the criteria established by the case-law for the purpose of determining whether a word mark composed of several word elements is descriptive or not are identical to those applied in the case of a word mark containing only a single element (Case T-28/06 RheinfelsQuellen H. Hovelmann v OHIM (VOM URSPRUNG HER VOLLKOMMEN) [2007] ECR II-4413, paragraph 21).'

(b) From the CJEU in Koninklijke KPN Nederland NV v Benelux Merkenbureau Case C-363/99, paragraphs 98 and 102:

'98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods and services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing 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.'

'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 indication 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 or indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially.'

(c) From the CJEU in Alcon Inc v OHIM Case No. C-192/03 P, the proposition that use after the date of an application could be used to draw conclusions as to the position at the date of application, including for the purpose of assessing the foreseeability of use of the term.

6. She also cites my own Decision as the Appointed Person in PutterScope BL O/96/11

'8. Although I agree that it is necessary for the purpose of explanation to break down the mark into its component parts, one must be aware of the danger that such an interactive approach may be unfair to the applicant. Each individual part of a mark may be non-distinctive, but the sum of the parts may have distinctive character – see Satelliten Fernsehen HmbH v OHIM [2005] ETMR 20 [SAT 1] at paragraph 28. Ultimately the decision-making tribunal must stand back from the detailed breakdown of the mark and envisage how the entire trade mark would be understood by the public when applied to the goods of the specification. Would the average consumer consider that it was a trade mark indicating goods from a particular source or would they consider that it simply indicated the function of the goods?'

7. The issue on this appeal is whether the Hearing Officer correctly applied the law as set out above to the facts of the case before her. The reasoning behind her rejection of the opposition was very short. I can set it out in full as it appears in paragraph 20 of the Decision:

'Whilst there is no evidence that porridgebreak is a dictionary word, Weetabix submit the mark is descriptive of 'porridge to consume during a break from work'. The difficulty with this submission is that porridge is a foodstuff with a very long tradition of being eaten for breakfast. Breakfast is not a meal described in ordinary language for consumption during a 'break' but is, instead, the first meal eaten after waking and before the active part

of the average consumer's day begins. The average consumer will be aware of, and indeed familiar with this. Whilst 'coffee break' and 'tea break' are well established terms, the same cannot be said for the mark in suit.'

8. It seems to me that this analysis suffers from two fatal flaws. The first is the factual assumption that because porridge is normally eaten for breakfast, the public would not understand the concept of a 'porridge break'. As the opponents point out in their Notice of Appeal, many people do eat porridge in the morning either during a break from work or in a break between travelling to work and actually working. The popularity of porridge on the menus of London sandwich bars is clear testimony to this. And in any event, even consumers who had never themselves eaten porridge in the course of anything which could be described as a 'break' would have no difficulty in recognizing that other people might well do so.

9. The second flaw is the reference to the fact that the word 'Porridgebreak' was not a 'well-established term'. In DOUBLEMINT Case C-191-01, the CJEU said this at paragraph 32:

'In order for OHIM to refuse to register a trade mark under Art.7(1)(c) of Regulation No.40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provisions itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.'

Thus it does not matter that the word 'porridgebreak' or the phrase 'porridge break' is not commonly used as a descriptive term. The question is whether it could be so used.

10. In that respect, there was helpful evidence from the Opponent that the phrase 'porridge break' had in fact been used on a number of occasions in written reports, blogs etc. which could be found on the Internet. Thus, for example, a user of the Mail Online message board on 2 October 2010 posted a message which included the words:

'Morning all. Just in for a much needed porridge break with a large coffee please.'

A cyclist writing in a newsletter for the Salisbury Plain Area Mountain Bike Club in May 2011 gave an account of a ride which had started at around 5am. It included the words:

'Initial reluctance in the legs soon eased and with a porridge break after lap 12, I managed to get my tally up to 14.'

There are plenty of other similar examples of use of the phrase. A number of the uses indicate that the concept of a mid-morning 'porridge break' has become fairly widespread in African schools as a way of ensuring that the children have enough nutrition to get them through the day.

11. The relevance of this evidence is not, as the Hearing Officer appeared to believe, to prove that the term 'porridge break' was a well-established term. It was to prove that the users of the term clearly expected their readers to understand the concept. In other words, to show that the term enabled the public *'immediately to perceive'* its meaning. It seems to me that the evidence does establish this quite powerfully. In none of the instances where the phrase is used does the writer see the need to explain what it means. This is because the phrase does not need any further explanation. It is entirely descriptive of a break taken to eat porridge.

12. As such, it seems to me that the composite word 'porridgebreak' is unregistrable under s3(1)(c) on the grounds that it indicates the intended purpose of the goods, namely that they should be eaten during a break, and/or a characteristic of the goods applied for, namely the time at which they are to be eaten.
13. Furthermore, given that it would be taken by the average consumer as describing a break taken to eat porridge, the mark is devoid of distinctive character under s3(1)(b).
14. Since in my view the Hearing Officer's decision is clearly wrong, I shall set aside the Decision and direct that the opposition succeeds and the mark shall be refused.
15. It follows that the Hearing Officer's costs order will also be set aside. The opponent is entitled to its costs both of this Appeal and below which, bearing in mind the relatively small volume of evidence and the fact that there were no oral hearings, I shall assess at a total of £1,000.

IAIN PURVIS QC
THE APPOINTED PERSON
7th JUNE 2013