



Lisa Richardson

Fresh Direct win appeal

0-367-10, Appeal to the Appointed Person, Iain Purvis QC, 6 October 2010, UK Trade Mark Application Nos 2482441 FRESH DIRECT & device (series of 3) and 2482442 FRESH DIRECT LOCAL & device (series of 3) in Classes 29, 31 and 39 in the name of Fresh Holdings Limited. On 20 March 2008, Fresh Holdings Limited (FHL) applied

to register the word marks FRESH DIRECT (application no 2482441) and FRESH DIRECT LOCAL (application no 2482442) as part of a series. The device elements of the marks show a fruit being picked by hand (FRESH DIRECT) and a gate surrounded by hedgerows (FRESH DIRECT LOCAL). Both applications covered the same goods and services in Classes 29, 31 and 39, namely foodstuffs, agricultural products and the transport, packaging and storage of food products. **Lisa Richardson** reports.

On 30 April 2009, the hearing officer refused both applications in their entirety on the basis of sections 3(1)(b) and 3(1)(c) of the Trade Marks Act.

The hearing officer also held that the marks did not satisfy the requirements of a series mark as provided for under section 41(2) of the Act. The Appointed Person agreed with this decision. However, as the applications pre-dated October 2009 enabling the series application to be divided, this procedural issue could be remedied at a later date should the remaining marks in the series be found to be registrable.

Upon issuance of the hearing officer's decision, FHL filed an appeal against the decision for both applications and also filed two fresh UK applications for the same series of marks covering the same goods and services but this time partly relying upon distinctiveness acquired through use.

Before discussing the appeal decision, it is important first to review the outcome of the examination of the later filed applications. As before, the word-only marks were refused.

However, in contrast to the previous decision, the Registry this time decided that the word and device marks were inherently registrable for some of the goods and services covered by the applications.

Specifically, the application for FRESH DIRECT & handpicking device was found to be inherently registrable for all the goods and services covered by Classes 29 and 39. The application was also allowed for a limited specification, namely "fresh fruits and vegetables", in Class 31 on the basis of acquired distinctiveness through use.

The application for FRESH DIRECT LOCAL & gate device was found to be inherently registrable for some of the goods in Class 29 only, namely those not considered to be fresh products. However, the acquired distinctiveness claim for this mark was rejected.

Hearing before Appointed Person

At the appeal hearing, a number of concessions were made by the Registrar following the inconsistency in the decisions reached. As a result, it was agreed that the later decisions were to be preferred and that the

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mark FRESH DIRECT LOCAL & gate device was to be found to be inherently registrable for all services covered in Class 39 to bring it in line with the application for FRESH DIRECT & handpicking device.

In light of this, only four issues remained, namely the registrability of the word marks FRESH DIRECT and FRESH DIRECT LOCAL, the registrability of FRESH DIRECT & handpicking device for the remaining goods in Class 31 and the registrability of FRESH DIRECT LOCAL & gate device in Class 31 and for the remaining goods in Class 29.

Decision

In respect of the word-only marks, the Appointed Person considered firstly the inherent registrability of FRESH DIRECT and FRESH DIRECT LOCAL in relation to all of the goods and services applied for and held them not to be registrable.

On consideration of the claim for acquired distinctiveness, whilst the evidence was found to show significant trade in the relevant area at the date of application, such trade was exclusively with business customers. A sponsorship deal with a show jumper and the use of the mark on lorries driving around the country were not sufficient to show that the general public (seen as the relevant class of person for the goods and services at issue), or a significant proportion thereof, would associate the marks with a particular undertaking and so this claim was rejected.

Following the hearing at the Registry, FHL, as a last-ditch attempt to secure registration on the basis of acquired distinctiveness, proposed the addition of a limitation to the specification, namely "all of the aforementioned goods to be sold in bulk on a wholesale basis". Whilst not yet commented on by the Registry, the Appointed Person took the opportunity to raise his concerns as to how the goods at issue could be properly defined by reference to trade channels or quantity of goods sold. This issue was not taken any further as the Appointed Person felt that such a request would need to be raised with the Registry at a later date either as an amendment to the current applications or as part of fresh applications.

With both word marks refused, FHL were left with the remaining word and device marks currently only accepted for some of the goods and services applied for, as outlined above.

The Appointed Person found it difficult to justify the rationale behind the Registry's acceptance of the device marks on the basis of inherent distinctiveness in relation to goods in Class 29 but not in relation to goods in Class 31. He believed the reasoning behind the decision came down to whether or not the goods listed in each class were fresh and locally produced, and that the Registry had found the device marks simply reinforced this idea.

As Class 29 includes meat, fish, eggs and milk, all of which can be fresh and locally produced, no such distinction can be drawn on this basis.

On consideration of the marks themselves, the Appointed Person found the device elements to be allusory at most and therefore inherently registrable, a decision consistent with the Registry's acceptance of the marks for goods in Class 29.

As a result, the Appointed Person overturned the hearing officer's decision to allow acceptance of the word and device marks as a series of two for all goods and services applied for.

Comments/summary

The examination of a mark consisting of a combination of non-distinctive words and an allusory device element is clearly very subjective, which can result in different decisions as to inherent registrability being reached by different examiners.

One further point to note in this situation is that, should applicants wish to include a fall-back position by way of an amendment to the specification, this should be entered early on in the proceedings whether at an ex parte hearing or in written submissions. The Registry needs to be given the opportunity to review and comment upon such a request. An appeal to the Appointed Person is not the proper forum.

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Big changes in Greece

A year ago we published a discussion of myths and realities of Greek trade mark practice which tipped the scale in favour of adversities rather than efficiencies. Happily, a generally tough and demanding year later, progress has been achieved. Not to say that all is rosy, yet there are steps being made in the right direction.

New legislation expediting the process before the administrative courts in Greece (also affecting trade mark actions, following oppositions or cancellation petitions) has been passed in mid-December 2010, with a variety of progressive measures that have been much needed. Compared to those in the UK and US, the previous Greek administrative courts system was practically programmed for delays, dead-end procedures and frustrating postponement of results. Not so anymore. The primary aim of the legislator is expediting procedure, by fine-tuning each and every possible step that may affect the total process.

This should be made possible by implementing, among others, the following provisions: direct recourse to the highest administrative court level (Council of State) as well as allowing the pre-judgment opinion requests from lower courts to the Council of State whenever new issues requiring clarification or even the setting of new precedent arise; and a two-month time-frame for court hearings being scheduled, in significant or broadly applicable issues. These, in conjunction with new ADR routes being put in place currently, should help facilitate the judicial resolution of trade mark disputes in Greek jurisdiction. More will follow in the next ITMA Review. Stay tuned.

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