

DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE MARKS IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996

In the matter of an application for the registration of Trade Mark No. 253212 and in the matter of an Opposition thereto.

CADBURY UK LIMITED

Applicant

MARS INCORPORATED

Opponent

The Application

1. On 14 November 2011 (“the relevant date”), CADBURY UK LIMITED of Bournville, Birmingham, United Kingdom made application (No. 2011/01993) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register FINGERS as a trade mark in respect of “Chocolate, confectionery (other than frozen confections) and biscuits, all being goods in Class 30 of the Nice Classification.
2. During the examination of the application the Examiner raised, and subsequently maintained on a number of occasions, objections to the application and indicated her intention to refuse the application, following which the Applicant sought a Hearing of the matter. The Applicant was heard, and the Hearing Officer accepted the application for all the goods on the basis that the mark had acquired distinctiveness through the use made of it. The application was advertised accordingly under No. 253212 in Journal No. 2290 dated 23 September 2015.
3. Notice of Opposition to the registration of the mark, pursuant to Section 43 of the Act, was filed on 21 December 2015 by Mars Incorporated of Elm Street, McLean, Virginia, USA. The Applicant filed a Counter Statement on 11 March 2016 and evidence was then filed under Rules 20, 21 and 22 of the Trade Mark Rules, 1996 (“the Rules”). Both parties attended a Hearing of the matter on 31 July 2018.
4. Acting for the Controller, I decided to uphold the opposition and to refuse to allow the application to proceed to registration in respect of all goods. The parties were informed of my decision by way of letter dated 20 August 2018. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2) of the Rules.

Grounds of the Opposition

5. In its Notice of Opposition, the Opponent raises objections to the application on the grounds that the mark applied for is descriptive and devoid of distinctive character and is therefore incapable of distinguishing the goods and services of the Applicant from those of other undertakings who trade in the goods in question. The mark does not satisfy the requirements of Section 8(1)(a) of the Act – in that it is not a trade mark as defined by Section 6(1) of the Act, and its registration would be contrary to Section 8(1)(b) in that it is devoid of any distinctive character. The Opponent rejects any assertion the Applicant might make that the mark has acquired a distinctive character as a result of use made of it, in respect of any or all of the goods, prior to 14 November 2011.
6. The Opponent also grounds its opposition on Section 8(1)(c) of the Act claiming the mark is a sign used extensively to designate the physical characteristics of the goods to which it refers. The mark is a term that is commonly used and understood by consumers and traders alike as designating goods that are approximately a finger's length or are roughly the shape or dimensions of a finger.
7. The Opponent cites Section 8(1)(d) as a ground of opposition claiming the mark consists exclusively of a sign which has become customary in the current language and the bona fide and established practices of the chocolate, biscuit and confectionery trades.
8. The opposition is also grounded on Section 8(3) of the Act, with the Opponent claiming the registration of the mark would be contrary to public policy by awarding the Applicant exclusive use of a term that is readily understood by all as referring to the shape of chocolate and confectionery products and that would deprive and prevent others of the right to use this legitimate and descriptive term in connection with their trade.
9. The Notice of Opposition also contains claims that the mark offends Section 8(4) on two counts. First, that it is contrary to the European Parliament and Council Directive No. 2008/95EC of 22 October 2008 to approximate the laws of the Member States relating to trade marks, and second, the application was made in bad faith. The Opponent lays out the bad faith charge in terms that the Applicant, who is a well-established and well-known chocolatier, confectioner and biscuit maker, must have knowledge that many entities use the mark FINGERS on the same or similar goods as the Opponent's goods and would appear on retailers' shelves alongside other brand owners' products which use the word FINGERS. The Opponent also claims the Applicant is seeking to protect its own commercial interests in a

manner which would deliberately impinge on the core activities of its many competitors and, in applying for the mark, the Applicant is seeking to gain unfair competitive advantage.

10. The Opponent also contends the Applicant has no intention of using the mark without a house mark, such as Cadbury, and so lacks the necessary intent to use the mark as filed.

Counter-Statement

11. In its Counter Statement the Applicant denies all the grounds of opposition. The Applicant denies the allegation that the mark is a sign that is used extensively to designate the physical characteristics of the goods for which registration is sought and claims the term is not commonly used and understood by consumers and traders alike to signify goods that are in the shape of a finger.

12. The Applicant claims the evidence of use submitted to this Office during the examination of the application shows use of the of the mark without the Applicant's house mark (Cadbury's).

13. The Applicant completes its Counter Statement by claiming it is inconceivable that the Opponent and/or its advisors are not familiar with the fact the Applicant's mark FINGERS has acquired a distinctive character as a result of the substantial and extensive use made of it over more than 60 years in connection with chocolate biscuits prior to 14 November 2011, and that evidence attesting to this was accepted by the Office as proof of the claimed use, and the mark was accepted for registration and published on that basis. The Applicant claims it must follow that the opposition is vexatious and entirely unjustified.

Rule 20 Evidence

14. Evidence submitted by the Opponent under Rule 20 consists of the following:

- i. A Statutory Declaration, dated 15 September 2016, of Amanda Quinn, Senior Specialist – Marketing Properties, of the Opponent and ten accompanying exhibits marked “AQ-1” to “AQ-10”;
- ii. A Statutory Declaration, dated 16 September 2016, of Monique Bovens, Project Manager of Mintel Group, and an exhibit labelled “MB-1”; and
- iii. A Statutory Declaration, dated 20 September 2016, of Niall Kenna, Confectionery Marketing Director of Mars Ireland and twenty-six exhibits marked “NK-1” to “NK-26”.

15. The focus of Ms. Quinn's evidence is on the definition of the word finger, it being the singular of the term put forward for registration, and the use of that word in relation to food. The

exhibits contain extracts from various dictionaries, all of which were published before the relevant date. The dictionaries define finger as, *inter alia*, “any of the digits of the hand”, “something which resembles a figure”, “a short and narrow piece of material” (finger biscuits are cited as an example in the entry), “a strip of food” (a finger of toast is added by way of example) as well as being “short for finger-biscuit”. The exhibits accompanying Ms. Quinn’s evidence also contain references to the use of the word “finger” in relation to confectionery dating back centuries, and a copy of a recipe for Lady Fingers taken from “*The Cook’s Encyclopaedia of Baking*”, which was published prior to the relevant date.

16. In her Statutory Declaration Monique Bovens states that her company Mintel is a leading global supplier of consumer, media and market research, and her Company’s core business is gathering market intelligence for Mintel’s own data sets. She explains the methodology around gathering the data and how it is categorised, indexed and stored. This data is collated in Mintel’s Global New Products Database (GNPD) and access to this is provided to Mintel’s clients for a fee. The GNPD contains over one million goods’ records in relation to more than 60 countries and each record contains details of the product’s ingredients, nutrition facts, packaging, distribution and pricing.
17. Ms. Bovens says the information in the data sets contain definitions that are categorised and sub-categorised into products types. The categorisation is outlined in the “Mintel Glossary 2016 Version 2016.1” which she attaches at Exhibit “MB-1”. It appears Ms. Bovens evidence has been submitted purely to show that chocolate and confectionery products are sorted into discreet categories for research purposes, and that subscribers to Mintel’s data services can search the data using various search criteria, e.g. where the country matches “Ireland”, the text matches “fingers”, the category matches “chocolate confectionery” and/or “bakery”, and the date published is, for example, “between June 1996 and November 2012”.
18. Mr. Kenna refers to the Mintel GNPD and attaches, at Exhibit “NK-23”, the results of searches of the database using the criteria mentioned above. The search results show that 41 products matched the criteria, including household brand names such as Nestlé, McVitie’s, Foxes, Twix and Kit-Kat. Several of the Applicant’s products also featured, including Mini Fingers, Giant Caramel Fingers and Frightening Fingers.
19. Mr. Kenna submits that from his experience as Confectionery Marketing Director for one of the largest confectionery companies in Ireland, the word “fingers” is a term in customary use in the relevant trades where chocolate, confectionery and biscuits are manufactured, marketed

and sold in the wholesale and retail sectors in Ireland. He attaches evidence, at Exhibits “Nk-2” to “NK-19” of examples of many products that contain the word “fingers” on the product packaging. As well as the brands already mentioned above, these include Quality Street, Walkers, Tesco, SuperValu and Kelkin. Some of the material is taken from websites in 2016 while some are in the form of archives taken from the www.archive.org website and some are by way of photographs of mentioned products.

20. Mr. Kenna claims the evidence shows a complete lack of distinctiveness in the term FINGERS when applied to goods in the chocolate, confectionery and biscuit trades. The widescale use of the word renders it incapable of being a trade mark that distinguishes the goods of one trader from those of other traders.
21. He states the word FINGERS designates the physical characteristics of the goods, in that they are finger-shaped or resemble a finger. He provides by way of exhibits photographs of individual pieces of chocolate and confectionery side by side with a ruler to show the actual length of each piece. He also exhibits scientific material showing hand anthropometry of British adults aged 19-65 by gender, which details the length and width of the various component parts of the human hand.
22. Mr. Kenna rejects the Applicant’s assertions that its mark FINGERS has acquired distinctiveness through the use made of it. He notes the Applicant says it has submitted evidence to the Patents Office to support its claims that it has used its mark FINGERS without its house mark (Cadbury). He says that evidence available to and reviewed by him, shows the Applicant uses the word “fingers” on its goods in an inconsistent and changeable manner with many variables and differences in terms of the part it plays in the mark applied to goods. He says sometimes the word “fingers” has been preceded by or followed by other descriptors including:
 - a. Cadbury Fingers;
 - b. Cadbury Frightening Fingers;
 - c. Cadbury GIANT Caramel Fingers;
 - d. Cadbury Mini Fingers;
 - e. Cadbury Dream Fingers Creamy White Chocolate;
 - f. Cadbury Fingers Mini;
 - g. Cadbury Fabulous Fingers;
 - h. Cadbury Fabulous Fingers Honeycomb;
 - i. Cadbury Fabulous Fingers Chocolicious;

j. Cadbury Fingers Salted Caramel Crunch.

23. He notes that sometimes the word “fingers” is used in conjunction with two of the Applicant’s registered European Union Trade Marks (No’s 003579158 and 001367515, both containing the Applicant’s stylised Cadbury logo). He says evidence submitted in the Exhibit “NK-3” (containing products purchased in Ireland by the Opponent’s lawyers in 2016) and “NK-24” (Mintel search records) support this.
24. He completes his evidence by referring to seven trade mark registrations, attached at Exhibit “NK-20”, that are effective in Ireland and are protected for chocolate and/or biscuits, or the ingredients of these goods, each of which contains the element “FINGER” or “FINGERS”. He says these trade mark registrations are relevant to this opposition, and they support his view that the words “finger” and “fingers” are descriptive, ubiquitous and/or generic in the relevant industries and that it is the other elements in these seven trade mark registrations that form the distinctive components of those trade marks.

Rule 21 Evidence

25. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration, dated 4 September 2017, of Richard Gray, of Mondeléz Europe GmbH and a Director of Cadbury UK Limited.
26. Mr. Gray provides details of the history of use of the trade mark FINGERS in Ireland and the background to the current proceedings. He says the trade mark FINGERS has been used in Ireland by the Applicant since at least 1950 and possibly earlier. Until recently Cadbury licensed the use of those of its trade marks which Cadbury had earlier used in connection with biscuits to Burtons Foods Limited. Burtons applied to register the trade mark FINGERS in Ireland, but Cadbury opposed the application and it was withdrawn. Cadbury then filed its own application which was accepted and published on the basis that the trade mark FINGERS was inherently distinctive.
27. Observations from an interested party were filed which resulted in the Controller reverting the status of the application back to “pending”, to allow the Applicant to respond to the observations, which the Applicant did. Having considered the matter, the Controller raised objections to the registration of the mark FINGERS, based on a lack of distinct character and common usage of the word “fingers” in the trade. A number of attempts by the Applicant to have the objections waived were not successful and the Controller enquired whether it was the

Applicant's intention to make a claim for distinctiveness acquired through use. The Applicant pursued this option. Subsequent correspondence between the Applicant and the Controller ultimately resulted in an *ex-parte* Hearing regarding the claim of acquired distinctiveness. Following the Hearing and the submission of further evidence to support the claim, the application was accepted for a second time and republished.

28. Mr. Gray says Cadbury has used its trade mark FINGERS for upwards of at least seventy years in Ireland in connection with chocolate-coated biscuits of a particular shape. He says he is informed and verily believes that no other trader markets similar chocolate-coated biscuits in Ireland.
29. Mr. Gray states he is aware the word "fingers" is in use in the United Kingdom as a generic term. He says that relative to Cadbury's trade in Ireland under the trade mark FINGERS, use of the word "fingers" by others as a generic term has been minimal and has had no effect on the integrity, reputation or exclusivity of Cadbury's trade mark FINGERS.
30. He says he is advised and believes that in recent years independent traders, such as for example Dealz, have imported into Ireland consignments of products obtained in the United Kingdom and this may well account for the incidental appearance in Ireland of products which are described by the generic term "fingers". He says however that none of these activities had had any adverse impact on Cadbury's trade under its trade mark FINGERS, especially since that use is incidental relative to the extent to which Cadbury has continues to use its trade mark FINGERS in Ireland.
31. Mr. Gray concludes his declaration by stating the Applicant is entitled to register the disputed mark on the basis that prior to the date of its application the trade mark FINGERS had acquired a distinctive character as a result of the use made of it, as required by the proviso to Section 8(1) of the Act.

Rule 22 Evidence

32. Evidence submitted by the Opponent under Rule 22 consists of a Statutory Declaration and two accompanying exhibits labelled "BH-1" and "BH-2", dated 29 March 2018, of Bill Heague, General Manager of Mars Foods Ireland Limited, a wholly owned subsidiary of the Opponent.
33. Mr. Heague takes issue with certain statements made by Mr. Gray in his Rule 21 evidence. He states the claim by Mr. Gray that no other trader markets similar chocolate-coated biscuits in

Ireland is not correct. He points to the evidence of Niall Kenna, filed under Rule 20, which contained details of specific products from a number of traders that bear the words “chocolate fingers” or “fingers” on the product packaging, for example; Schar Gluten Free Chocolate Fingers, Twix Fingers, Tesco Snappy Fingers, SuperValu Mike Chocolate Fingers and Dunnes Stores Chocolate Wafer Fingers.

34. He then goes on to repeat much of what Mr. Kenna said in his earlier declaration on behalf of the Opponent regarding the length and shape of confectionery products for sale on the Irish market.

35. Mr. Heague notes that Mr. Gray admits the word “fingers” is in use as a generic term in the United Kingdom but claims that, relative to the Applicant’s trade in Ireland, the use of the word “fingers” by others as a generic term has been minimal. He refers to samples of such use already adduced in evidence by Mr. Kenna and attaches, at Exhibit “BH-1”, five further examples, in respect of a variety of Kit-Kat branded chocolate finger products. He attaches a printout of the SuperValu’s online shopping page showing the Nestlé product DRIFTER, which contains two chocolate-coated fingers, and mentions the product was launched in Ireland by Rowntree in 1980. He states it is clear the use of the word “fingers” by others in Ireland is as a generic term and should not be considered minimal.

36. Furthermore, he says the claims by Mr. Kenna that the importation by Dealz of products from the United Kingdom may account for incidental use of fingers as a generic term is not sustainable. He says there are many products sold in Ireland that use the word as a generic term, including own brand products produced by Irish retail chains Dunnes Stores, SuperValu and Centra, as well as products from Irish food producer Kelkin.

37. Mr. Heague concludes his declaration by noting the Applicant has not made any reference to any attempts by it to enforce its claimed unregistered rights in Ireland in the trade mark FINGERS against Irish importers of overseas products using the word, or against Irish producers of products using the word. And he says he is not aware of any such action having taken place.

The Hearing

38. At the Hearing the Applicant was represented by Mr. Norman MacLachlan, Trade Mark Attorney of MacLachlan & Donaldson and the Opponent by Mr. Jonathan Newman SC.

39. Mr. Newman turned directly to an examination of the evidence which he argued shows that the application is utterly flawed, and, on the one hand, the Applicant has not placed any material before the Controller upon which the application could safely be permitted to proceed to registration. On the other hand, he points to the extensive evidence furnished by the Opponent which demonstrates that the word “fingers”, the dictionary definitions of which includes “*something which resembles a finger*”, has been associated with biscuits (e.g. ladyfingers) for centuries and is, and has been, long used in common parlance in the chocolate and confectionery trade for designating the characteristics of these products.
40. He says the Opponent’s evidence also shows many examples of the use of the word “fingers” on confectionery products from a number of traders in Ireland. He points to the evidence extracted from searches of the Mintel database which provide details of many products containing the word “fingers” on their packaging. Also, the Cadbury fingers products, captured by Mintel in respect of Ireland between 2002 and 2010, all show use of the Cadbury house mark in conjunction with the descriptive word “fingers”.
41. Mr. Newman notes the Applicant’s claim that the application for the trade mark FINGERS was originally published in 2012 “*on the basis that the trade mark FINGERS was inherently distinctive*” [that publication resulted in observations being submitted to the Controller who, having considered the contents, reverted the mark to a status of pending and re-examined it]. Mr. Newman also notes the application was finally accepted for publication by the Controller on the basis of evidence filed in support of the claim that the mark had acquired distinctive character through the use made of it and following an *ex-parte* hearing of that claim and the subsequent submission of additional evidence. However, Mr. Newman was at pains to point out that neither the evidence placed before the Controller during the examination of the disputed mark nor the evidence submitted following the *ex-parte* hearing was disclosed and cannot form part of these opposition proceedings.
42. In reply to these points Mr. MacLachlan argued the application at issue had undergone one of the most stringent examinations he has encountered in his more than fifty years of experience in practicing before the Office. He argues it was never the practice of the Office to regard the word “finger” or “fingers” as a descriptive term when applied to any kind of confectionery. In that regard he drew my attention to the Unilever trade mark FINGERS registered in 1992 in respect of frozen confectionery in Class 30 (the same class as the mark at issue). He pointed out the Office accepted an application to register FINGERS in the name of Burtons Foods Limited in 2007 for biscuits and cookies, also in Class 30. Following the withdrawal of that

application at Cadbury's request, the present application was filed and accepted by the Office in connection with "*Chocolate, confectionery (other than frozen confections) and biscuits*". The exclusion of frozen confections was made because the Office raised an objection against the application, not because it was objectionable on absolute grounds, but because of a relative grounds objection based on the earlier Unilever trade mark.

43. Mr. MacLachlan explained that, following the limiting of confectionery to the non-frozen kind, the disputed mark was accepted and published. This resulted in observations being made to the Office, which in turn caused the application to be re-examined and resulted in the Office raising objections on absolute grounds. Ultimately, following the submission of evidence and a Hearing, the Hearing Officer was obviously impressed with the evidence and arguments put forward and decided to allow the application to proceed, on the basis of the mark having acquired distinctiveness through use. The republishing of the application triggered the present opposition.

44. As regards the claim by Mr. Newman that, as neither the evidence placed before the Controller during the examination nor the evidence submitted following the ex-parte hearing was disclosed it cannot form part of these opposition proceedings, Mr. MacLachlan argued that sufficient evidence has already been lodged and accepted by the Office to justify the registration of the mark under the proviso contained in Section 8(1). He argued the Applicant does not need to convince the Opponent of the acquired distinctiveness because it has already convinced the Office. Therefore, the Controller has already adjudicated on the application in terms of its inherent and acquired distinctiveness and has come to a determination that the mark should be registered. He argued it is unfair to the Applicant to have to defend its application a second time on matters that were already decided by the Controller. Furthermore, there was no need to resubmit evidence that is already in the possession of the Controller. Before deciding the substantive issue, I will deal with these two lines of argument.

45. First, it is the case that the Controller has already considered whether the application offended against Section 8(1) of the Act and, having done so, accepted it for publication. The publication of the application resulted in observations being made and the mark being re-examined, the outcome being that new objections were raised by the Examiner. Throughout a protracted series of correspondence, the Examiner maintained these objections and proposed the application be refused – a decision that was endorsed by the Examiner's manager (a Senior Examiner). The Applicant sought a hearing of the matter which was heard by a Hearing Officer who had no part in the decision to refuse the application. The Hearing Officer

examined the matter afresh and decided to allow the mark to proceed on the basis of acquired distinctiveness.

46. However, these proceedings are independent of any decisions taken during the examination of the application. It is important to note that the decision of the Hearing Officer in the earlier hearing was taken having heard the Applicant alone. I am not suggesting the Hearing Officer was wrong or unduly lenient in reaching her conclusions. The Hearing Officer was obliged to decide the issue solely on the materials advanced by the Applicant. She was satisfied the sign FINGERS had been long used by the Applicant and concluded that such use was sufficient to justify the application of the proviso in Section 8(1).
47. However, because it was an ex-parte hearing, the Hearing Officer had no knowledge of whether or not the word “fingers” was being used by other traders in the chocolate, confectionery or biscuit trade. The Hearing Officer may, on that basis, have decided that it was best to accept the mark and rely on the safety net that is the opening of a three-month period for third parties to oppose.
48. The Hearing Officer did not follow the Examiner and Senior Examiner’s earlier decision to refuse the application and was not guided or influenced by it. Hearing Officers must reach their conclusion untrammelled by earlier decisions of the Controller or his Officers. Therefore, I am obliged to consider this matter afresh, without paying any heed to whatever decisions were made heretofore. Also, these opposition proceedings occur at a different point in the process and are initiated by third parties whose evidence and arguments must be taken into account. Therefore, in deciding this matter, I am satisfied that due process is being served and that, whatever the outcome, the process has not been unfair to the Applicant.
49. Second, Mr. MacLachlan’s position that the Applicant had already lodged evidence with the Controller to justify a finding of distinctiveness acquired through use and that there was no need to resubmit it or other evidence during these opposition proceedings is incorrect. These are inter-partes proceedings and both parties must fully disclose to the other side all materials on which they seek to rely. Rules 18 to 25 of the Rules set out the procedural steps to be taken and the obligations with which the parties must comply in order to ensure the process is as efficient, effective and transparent as possible. Under Rule 21 the Applicant is obliged to file evidence in support of the application and “... *shall send a copy thereof to the opponent.*” Therefore, it was incumbent upon the Applicant to file with the Controller any evidence it wished to rely on specifically in respect of this opposition and to provide the Opponent with a copy of that evidence. The Applicant is not restricted in what it can file under Rule 21. It can

file material that was identical to that which was lodged with the Controller during the examination of the application or it can file different, less or additional material. Nonetheless, it is only the material that is filed by the Applicant in these opposition proceedings and disclosed to the Opponent that I can consider. I have no doubt that an experienced attorney, such as Mr. MacLachlan, would urge me to reach this very conclusion if he was acting on behalf of the Opponent.

Section 8(3)(a)

50. Turning to the grounds of opposition under Section 8(3)(a), which prohibits the registration of marks that are contrary to public policy or accepted principles of morality, Mr. Newman argued the mark offends against the public policy element, not the morality part (though if the mark was TWO FINGERS, the morality piece might come into play).

51. His argument was that it is contrary to public policy for a mark to be registered which would place in the hands of a single trader a term which is customarily used by traders to describe the nature of their goods. In my opinion, the argument advanced by Mr. Newman is particular to Sections 8(1)(c) and (d) which deal with marks that are descriptive and used in the current language of the trade respectively, and does not form the basis for refusal of an application under Section 8(3)(a).

52. The provisions in Section 8(3)(a) concern the content of the mark itself. It prohibits the registration of marks that consist of or contain material which is illegal or would be a cause for concern in terms of public safety. I am satisfied the sign FINGERS does not contain a reference to or an indication of anything that is contrary to public policy. Accordingly, I must reject the opposition on this ground.

Section 8(4)(b) – Bad Faith

53. Mr. Newman presented the case against the application under Section 8(4)(b) in terms of the Court of Justice of the European Union (CJEU) ruling in *Lindt*¹ where the Court stated at paragraph that:

“... the national court must take into consideration all the relevant factors specific to the particular case which pertained at the time of filing the application for registration of the sign as a Community trade mark, in particular:

¹ Case C-529/07 Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH

- (i) the fact that the applicant knows or must know that a third party is using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought;*
- (ii) the applicant's intention to prevent that third party from continuing to use such a sign; and*
- (iii) the degree of legal protection enjoyed by the third party's sign and by the sign for which registration is sought."*

54. He argued the Applicant acted in bad faith by seeking to register for itself a mark which it must in fact know several other traders are using. Given that it is not in fact using the mark as a trade mark, then the objective of the Applicant would appear to be improper and illegitimately impede the businesses of those other traders.

55. Looking at the criteria identified by the CJEU, it appears to me that the first condition is met. However, later, at paragraphs 40-41 of its judgment, the Court had this to say:

"40. However, the fact that the applicant knows or must know that a third party has long been using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought is not sufficient, in itself, to permit the conclusion that the applicant was acting in bad faith.

41. Consequently, in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration."

56. Mr. MacLachlan argued the Applicant uses FINGERS as a trade mark, not like other traders who, if they use the word at all, merely use it in a descriptive manner. He maintained the Applicant is entitled to seek registration of the mark and was doing so based on it having acquired distinctive character through decades of use. He confirmed his client has no intention of preventing other traders who use the word "fingers" in a descriptive fashion from continuing to do so.

57. There is no legal definition of "bad faith", but it is accepted that it constitutes dishonesty, including dealings which fall short of the standards of acceptable commercial behaviour

observed by reasonable and experienced men in the particular area being examined. In the present case the Applicant applied to register a mark that it genuinely believes it has used as a trade mark for decades. The Applicant accepts that others may use the term to describe their products, but notwithstanding this, the Applicant believes its sign FINGERS has earned secondary meaning that justifies registration under the proviso to Section 8(1) of the Act.

58. Mr. Newman argued the Applicant would be able to prevent other traders from using the descriptive word “fingers” on their products if the mark was registered as registration would bestow a total monopoly in the word upon the Applicant. Mr. Newman also argued the Applicant did not use the sign FINGERS as a trade mark, because if it did, it would have had unregistered rights, but it never made any attempts to enforce such rights.

59. In my opinion, Mr. Newman’s argument goes two ways. It can be taken as a clear indication that the Applicant did not really believe it had enforceable rights in the term “finger”, but it can also be taken to indicate that while the Applicant believed it had such rights, it was never inclined to seek to prevent others from using the term as long as it was for the sole purpose of describing their products.

60. I am satisfied the Applicant’s motive in seeking registration for its sign FINGERS was entirely legitimate and was based on a desire to protect a sign that it genuinely believed it had used for decades and was entitled to protect. Accordingly, I find the application does not offend against Section 8(4)(b) and I dismiss the opposition on that ground.

Section 8(1)(a)

61. Turning now to Section 8(1)(e). Mr. Newman argued the sign FINGERS is incapable of distinguishing goods or services of the Applicant from those of other undertakings. As such it such be refused registration under Section 8(1)(a) as it fails to meet the definition of a trade mark laid down in Section 6 (1) of the Act which states:

“In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.”

62. It is not possible to consider whether applications fall foul of Section 6(1) without first determining the full scope of that provision. In particular, it must be ascertained whether objections under Section 6(1) must be considered in relation to the goods or services for which

the sign is seeking registration, or whether it is to be considered only in relation to the graphical representation of the sign and its capacity to distinguish, in isolation from any consideration of the goods or services applied for.

63. Mr. Newman stressed the evidence shows the sign FINGERS is a customary, descriptive and very ordinary term in respect of the goods for which registration is sought and it would be akin to the paradigm example of “soap” being incapable of being a trade mark for “soap”. This example is a reference to *Jeryl Lynn*², a case before the United Kingdom courts, in which Laddie J stated:

“If a ‘mark’ has no capacity to serve this primary distinguishing function then it would attract objection under section 3(1)(a)³. The often-quoted example of this would be the word ‘soap’ sought to be registered for ‘soap’. The ‘mark’ applied for is nothing more than the common name for the goods; such a ‘mark’ has no capacity to serve the essential function of a trade mark, no matter how much ‘use’ has been made of it.”

64. That particular case is interesting in that, at first sight, it may appear that an objection to “soap” for “soap” is proper to Sections 8(1)(b) and/or (c) and not Section 8(1)(a), which concerns the failure to meet the definition of a trade mark as set out in Section 6(1). If so, an applicant would have the right to try and overcome the objections by claiming distinctiveness acquired through use. But Laddie J. confirms that in such obvious cases (i.e. “soap” for “soap”) the Applicant should be denied any opportunity to claim distinctiveness acquired through use, no matter how much ‘use’ has been made of the sign. Therefore, it is clear to me that the goods applied for must be taken into account when considering the registrability of an application under Section 8(1)(a).

65. In applying this principle to the application at issue I am satisfied that Section 8(1)(a) would only come into play if the mark was “Fingers” and the goods were actual fingers, which in this case they are not. While chocolate, confectionery and biscuits can be finger-shaped, they are not fingers *per se*, they are items of food. To return to the “soap” for “soap” example; soap could, in theory, be finger-shaped. But in my opinion the sign “FINGERS” would not fall foul of Section 8(1)(a) if registration was sought in respect of soap.

² [2000] ETMR 75

³ The UK equivalent to Section 8(1)(a) of our Act

66. Therefore, I find that, in relation to the ground of opposition centred on Section 8(1)(a) of the Act, the sign FINGERS meets the requirements of Section 6(1) in respect of all the goods for which the mark was accepted and published. Accordingly, I dismiss the opposition based on this ground.

67. Turning now to the grounds of opposition centred on Sections 8(1)(b), (c) and (d) which are written in the following terms:

8.—(1) The following shall not be registered as trade marks:

(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 origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) 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.

68. At the Hearing Mr. MacLachlan argued the mark FINGERS was inherently distinctive and therefore the registration did not turn on the invocation of the proviso in Section 8(1). Without prejudice to the foregoing, Mr. MacLachlan also argued the evidence of use of the mark justified the application of that proviso. However, it is the case that these opposition proceedings could not have arisen without the Applicant relying on the proviso to overcome the objections to registration based on Section 8(1)(b), (c) or (d) at the examination stage. The reliance on the proviso – the sole basis on which the application was published for opposition purposes – is tacit acceptance by the Applicant that the mark applied for otherwise falls foul of at least one of the provisions of Section 8(1)(a), (b) and (c). That being the case, I need only decide the matter solely on the question of whether or not the claimed use by the Applicant justifies a conclusion that the mark has acquire distinctiveness through the use made of it.

69. However, lest on appeal the Court finds that I have erred in reaching that conclusion and for completeness sake, I will consider all three grounds and then rule on the matter in terms of the proviso.

Section 8(1)(d)

70. I feel it is best to deal with the prohibition under Sections 8(1)(b), (c) and (d) in reverse order. Section 8(1)(d) deals with trade marks that consist exclusively of matter that is currently used in the everyday course of business in the trade in question; in this case the chocolate, confectionery and biscuit trade.

71. While Sections 8(1)(b) and (c) allow for some subjectivity as to what may constitute a finding of a lack of distinctive character or what may be deemed descriptive, Section 8(1)(d) must be dealt with objectively, based solely on evidence and facts regarding the current practice in the trade. It is not concerned with whether the mark could become customary in the trade at some point in the future – it must, at the application date, have already become customary.

72. On the one hand Mr. Newman argued the evidence submitted by the Opponent substantiates the claim that the term “fingers” had in fact entered the common parlance of the Irish chocolate, confectionery and biscuit trade at the relevant date. On the other, Mr. MacLachlan pointed out that all the evidence adduced by the Opponent post-dates the relevant date and should be ignored. Mr. MacLachlan went further and conducted a critique of the Opponent’s evidence, which I would summarise as follows:

- a. Ms. Quinn is a citizen of the United States of America and has only been employed by Mars Inc. since October 2015, four years after the relevant date. Her evidence is based on nothing other than dictionary definitions. She is in no position to offer any opinion regarding the use of the term “fingers” in the confectionery trade in Ireland as of November 2011.
- b. Ms. Bovens’s evidence only deals with new product launches – not what is currently on the Irish market. There is no mention in her evidence of any Mintel researchers operating in Ireland and she is deliberately vague and unclear as to whether “Ireland” relates to the entire island of Ireland or the Republic of Ireland. She does not provide any evidence of any products having been purchased in Ireland.
- c. In his evidence Mr. Kenna does not claim to have any experience in Ireland prior to 2011 in respect of confectionery. His evidence is nothing more than hearsay in that the employees who carried out the searches of the Mintel database are not named, nor are

details provided as to the instructions the “searchers” were giving and that, in any event, they did not submit Statutory Declarations attesting to their roles and findings.

- d. He refers to products being available on a website in 2016, but this does not mean the products were available to Irish consumers at the relevant date.
- e. None of the products lists in the Mintel search reports may have been on the shelves in Ireland for more than 1 day.
- f. His statement that he has been made aware of at least twenty-five relevant goods that were in the Irish market before the date of application is entirely without justification, bearing in mind he is relying entirely upon the results of a search that he did not undertake, and which is identified as a search for products where the country matches Ireland. He is also vague and unclear as to whether “Ireland” relates to the entire island of Ireland or the Republic of Ireland.

73. In my opinion there is no doubt as to whether the Mintel search criteria, which lists Ireland as a country, refers to the Republic of Ireland or the island of Ireland. The name of this sovereign state (when using the English language) is Ireland – it is not the Republic of Ireland. The latter term merely describes or identifies the country of Ireland as a republic. I appreciate that some overseas researchers or data compilers may not understand this distinction, but I have no reason to include Mintel in this category, especially as their data is country specific and includes information regarding the price of each product which, in the case of products launched in Ireland, is given in Euro.

74. In reply to the criticism of the Opponent’s evidence, Mr. Newman argued that evidence that post-dates the relevant date is admissible if it casts light backwards on what was the state of play at the relevant date. Mr. Newman stressed that this is precisely what the evidence shows. He argued the evidence clearly demonstrates that numerous traders currently use the term “fingers” in the relevant trade and have been using it prior to the application date. It is not credible to suggest that current use of the term by other traders is the result of an explosion in the use of the term since November 2011.

75. I am satisfied that given the relevant date is 14 November 2011 and that the application was published for opposition purposes almost four years later on 23 September 2015, it was virtually impossible for the Opponent to gather evidence that predated the application date. I am also satisfied that current use of the term “fingers” in the trade cannot reasonably be taken to be a very recent development.

76. Mr. MacLachlan admitted the term “fingers” became generic in the United Kingdom (UK) many years ago and is used by hundreds of manufacturers as a descriptive term to identify particular products, some of which do not even remotely resemble a finger, for example, fish fingers and shortbread fingers, both of which are rectangular in shape. He argued the UK has a population of more than 65 million, it has the fifth largest economy in the world and it is not surprising that the UK economy supports millions of products which the Irish economy could not support. He admitted the word “fingers” is used in the UK in connection with biscuits but that in Ireland there is very little purely descriptive use of “fingers” and no evidence of any significance before the relevant date. He suggested the use of the term “fingers” in Ireland in respect of confectionery products is very recent and limited, and is the result of discount shops, such as Dealz and Mr. Price, entering the Irish market.

77. I do not agree with Mr. MacLachlan on these points. While the population and the economies of the UK are substantially different to those of Ireland, there is significant overlap in the chocolate, confectionery and biscuit trade. All leading UK brands are found on Irish supermarket shelves. I am satisfied that Irish traders and consumers alike use precisely the same terms as their UK counterparts to describe the products at issue. In view of the generic use of the term “fingers” in the UK in respect of confectionery products for many years, and in light of the shared language, brands and advertising, I must reject the argument that it was not used to any significant extent to describe confectionery goods and the like in Ireland at the relevant date. I also reject his argument that what use there is of the term “fingers” results from the recent arrival into the Irish market of discount stores.

78. I am satisfied that at the date of application the term “fingers” was in use in the State in respect of the shape characteristic of chocolate, confectionery and biscuits. Accordingly, I find it is liable to be refused under Section 8(1)(d) of the Act.

Section 8(1)(c)

79. There is ample case-law that provides guidance to decision makers in determining the scope of the provisions of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), which correspond to section 8(1)(c) of the Act. These authorities identify the principles to be followed when attempting to determine the registrability of a mark under Section 8(1)(c) as:

- a. Signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (*Wm Wrigley Jr & Company v OHIM, C-191/01P (Doublemint), paragraph 30*);
- b. Article 7(1)(c) (Section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all (*Doublemint, paragraph 31*);
- c. It is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes (*Doublemint, paragraph 32*);
- d. It is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in subsection 8(1)(c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question (*Koninklijke KPN Nederland NV v Benelux Merkenbureau, C-363/99 (Postkantoor), paragraph 57*);
- e. An otherwise descriptive combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word trade mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark (*Postkantoor, paragraph 99*);
- f. In conducting the assessment of whether a trade mark is descriptive of the goods or services for which registration is sought "... it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, who are reasonably well informed and reasonably observant and circumspect, in the territory in respect of which registration is applied..." (*Matratzen Concord AG v Hukla Germany SA, C-421/04*);
- g. Where there is a relationship between the sign and the goods or services in question, it must be sufficiently direct and specific in order "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." (*Ford Motor Co v OHIM, T-67/07*);
- h. The first impression test was confirmed by the General Court in its decision in *Sykes Enterprises v OHIM (Real People Real Solutions [2002] ECT II-5179)*, wherein it stated "...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".

80. It is clear from the aforementioned case law that I must determine whether the mark at issue, if used in a nominal and fair manner, will be viewed by the average consumer as a means of directly designating an essential characteristic of the goods for which registration is sought.
81. Having taken due notice of all the guidance in the cited authorities and the arguments of the parties, in my opinion, the sign FINGERS is apt to denote the shape characteristic of chocolate, confectionery and biscuit products. The evidence shows that many traders use the term on and to describe their chocolate, confectionery or biscuit products. In my opinion, consumers of the goods for which registration is sought also use the term is referring to a portion of these goods - just like they would use the term "squares" in respect of chocolate. A person will offer a friend a "square" of chocolate (e.g. Cadbury's Dairy Milk) or a "finger" of a chocolate product (e.g. Nestle Kit-Kat) depending on the physical shape of the product. It is not necessary that the word "fingers" must actually appear on the products themselves to reach these conclusions.
82. What matters is whether the average consumer of the goods in question would, of his or her own accord, perceive a link between the mark and the goods offered under it. The term "fingers" is self-explanatory. In the context of the goods being provided I find consumers would immediately make a direct link between the mark and the shape of the goods.
83. In his evidence Mr. Gray confirms the Applicant's use of the sign FINGERS is generic and descriptive where he states: "*Cadbury has used its trade mark FINGERS for upwards of at least seventy years in Ireland in connection with chocolate-coated biscuits of a particular shape*". If it were used on products other than those that are finger-shaped a case could be made that its use is not generic or descriptive of the shape characteristics of the goods.
84. Therefore, I am satisfied FINGERS consists exclusively of signs or indications which may serve in trade to designate the shape of goods on offer. Accordingly, the mark is liable to be refused under Section 8(1)(c) of the Act.

Section 8(1)(b)

85. While Sections 8(1)(c) and (d) give clear definition as to the nature of the objection, Section 8(1)(b) is concerned with the prohibition on registering marks which, while not offending

against the specific parameters set out in sections 8(1)(c) and (d), nonetheless still do not fulfil the essential function of a trade mark, which is to identify the goods or services offered under the mark as originating from one undertaking as opposed to another. However, once a mark is found to be descriptive and offensive to Section 8(1)(c) or in common use within the trade and offensive to Section 8(1)(d), it must follow that it is also devoid of distinctive character and offends against 8(1)(b), because such a mark is incapable of performing the essential function of a trade mark. Accordingly, the mark is liable to be refused under Section 8(1)(b) of the Act.

Proviso to Section 8(1)

86. Notwithstanding the conclusions I outline above, there is an important proviso in Section 8 which allows a mark, that falls foul of Sections 8(1)(b), (c) or (d), or any combinations of these, to be registered if before the date of application for registration it has in fact acquired a distinctive character because of the use made of it.

87. At the Hearing Mr. Newman argued the mark had not acquired distinctive through the use made of it and that it is nothing other than a descriptive mark. Mr. MacLachlan clearly disagreed and pointed to the substantial and continuous use of the mark since the 1950's and argues the mark has surpassed all requirements to justify registration based on distinctiveness acquired through use.

88. The legal test for acquired distinctiveness was set out in *Windsurfing Chiemsee*⁴, which the Court (at paragraph 51) identified thus:

“In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.”

89. In these proceedings no evidence was adduced by the Applicant to substantiate the claim of long-standing use of the sign FINGERS made by Mr. Gray in his evidence under Rule 21. Nothing was submitted to attest to the market share of FINGERS branded products. Nor was

⁴ *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger* (joined cases C-108/97 and C-109/97)

evidence submitted that would provide insight into the geographical spread of the claimed use, nor of any investment undertaken by the Applicant to promote FINGERS branded products. Also, no evidence was lodged to suggest retailers and/or consumers identify the sign FINGERS as a brand that they would exclusively associate with the Applicant.

90. However, Mr. Gray makes an admission in his evidence, which is very relevant to the issue of acquired distinctiveness, where he states, “*Cadbury has used its trade mark FINGERS for upwards of at least seventy years in Ireland in connection with chocolate-coated biscuits of a particular shape*”. This is hugely important because the applicant is seeking registration of the sign FINGERS in respect or every conceivable type of chocolate, confectionery (excluding frozen confections) and biscuits, which includes all manner of cakes, pastries, sweets, cookies, biscuits and chocolate (whether in individual, boxed, bar, or tablet form), irrespective of their shape.
91. Notwithstanding the Applicant’s lack of evidence, at no time has the Applicant suggested the sign FINGERS has been used on any of the aforementioned range of goods other than on the extremely narrow and strictly limited subset of biscuits that are finger-shaped and coated with chocolate.
92. The market for the combined range of goods for which registration is sought is vast. While there is some overlap in that traders may use their brands on a range of products across the different categories, it is more typical for traders to specialise in particular subsets of these goods. For example, household brand names that specialise in a subset of the goods for which the Applicant is claiming use include Trebor Bassett for sweets, Lindt for chocolate, Mr. Kipling for cakes and McVities for biscuits. Therefore, it would be totally unjustifiable to grant registration and the attaching monopoly in the complete range of goods for which registration is sought for the sign FINGERS, based on distinctiveness acquired through use that, at most, points to use of the mark in respect of finger-shaped chocolate-coated biscuits alone.
93. Though the Applicant did not produce any evidence in these proceedings that showed use of the contested mark, in the Opponent’s evidence under Rule 20 Mr. Kenna attaches at Exhibit “NK-3” images of a number of the Applicant’s goods in its FINGERS range. It is noteworthy that all these images contain the sign FINGERS accompanied with the house brand Cadbury. They all relate to finger-shaped products and show chocolate-coated finger-shaped biscuits on the packaging. But Mr. Kenna also provided images of similar packaging used to identify goods produced by other traders.

94. A determination as to whether a trade mark has acquired distinctiveness through use is a somewhat subjective decision based on a multitude of factors which, when assessed by different people, may result in a different outcome. There is no specific threshold that must be passed, but the Court in *Windsurfing Chiemsee* did offer specific guidance as to what the evidence must show, where at paragraph 54 it said:

“In determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;

If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied;”

95. In essence, what must be proven is the mark has gained secondary meaning in the sense that as well as being a descriptive term or one that is used in the trade, it has also become synonymous with the Applicant and is readily recognised as the Applicant’s brand in respect of the goods for which registration is sought.

96. While no evidence was adduced by the Applicant to substantiate the claim to distinctiveness acquired through use, it appears to me that both parties agree the Applicant has used the term, albeit their opinions differ as to the context and effect of that use. I am satisfied the Applicant has used the sign FINGERS on its finger-shaped chocolate-coated biscuits for some time, but I am in no way inclined to equate that use with the word having gained a secondary meaning in a trade mark sense which resulted in it becoming synonymous with the Applicant alone. There are many traders who use the term in relation to their finger-shaped chocolate-coated biscuits. In each and every piece of evidence adduced by the Opponent, including exhibits showing the Applicant’s use of the sign FINGERS, the sign is used in conjunction with the traders’ house marks, be they Tesco, Kelkin, SuperValu or Cadbury. Use of the sign FINGERS in this manner serves to inform consumers that the finger-shaped biscuits originate from the various and different undertakings.

97. I am satisfied the issue comes down to the following question. If a consumer, who was familiar with the Applicant's finger-shaped chocolate-coated biscuits bearing the sign FINGERS, and having always encountered the Applicant's house mark in conjunction with it, then encountered a product bearing that sign in plain packaging or on packaging containing illustrations of finger-shaped chocolate-coated biscuits, but without any house mark; would he or she perceive it immediately to be an indication of the commercial origin of the biscuits and be able to distinguish, without any possibility of confusion, that the biscuits originated with the Applicant? In light of the common use of the term "fingers" to describe biscuits and in light of the many products bearing that sign or description, and, most importantly, in view of the use of house brand-names in every incident, in my opinion, the answer to that question is a resounding no. I have no doubt the consumer would instinctively view the goods as nothing other than a packet of finger-shaped biscuits and he or she would be unable to reach a conclusion, without hesitation, confusion or investigation, as to the undertaking from which the product originated.

Conclusion

98. I am satisfied the sign FINGERS offends against Sections 8(1)(b), (c) and (d) of the Act. I am also satisfied that whatever use has been made of the mark, it does not justify invoking the proviso in Section 8(1) that would allow the mark to proceed to registration on the basis of it having acquired distinctive character through that use. For these reasons, I have decided to uphold the opposition and to refuse to allow the Applicant's sign FINGERS to proceed to registration.

Dermot Doyle

Acting for the Controller

8 April 2019