

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

BETWEEN

DALE FARM LIMITED

Applicant

and

SILVER PAIL DAIRY (IRELAND) LIMITED

Opponent

CONCERNING

**Trade Mark Application No. 2005/00097 (231615)
TWISTCUP (series of three)**

Background

1. On 18 January, 2005, Dale Farm Limited, a Northern Ireland registered company of 15 Dargan Road, Belfast, BT3 9LB, Northern Ireland, made application (No. 2005/00097) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the series of four marks shown below as a trade mark in respect of the following specification of goods in Class 30:

Class 30: *Ice-cream; ice-cream products; water ices; frozen confections; frozen desserts; sauces and syrups for food; confectionery¹; preparations for making ice-cream, water ices and confections.*

1. TWISTCUP

¹ “confectionery” subsequently removed from the specification of goods at the request of the Applicant made on 21 November, 2005 in the context of unrelated opposition proceedings

2. DALE FARM TWISTCUP



2. The application was accepted for registration as a series of three marks only, i.e., with the exclusion of the second mark, DALE FARM TWISTCUP, which was not considered to constitute one of a series with the other three. The application was advertised accordingly under No. 231615 in Journal No. 2019 on 4 May, 2005.
3. Notice of opposition to the registration of the series of marks pursuant to Section 43 of the Act was filed on 3 August, 2005 by Silver Pail Dairy (Ireland) Limited of Fermoy, Co. Cork. The Applicant filed a counter-statement on 28 October, 2005 and evidence was subsequently filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”).
4. The opposition became the subject of a hearing before me, acting for the Controller, on 15 May, 2008. The parties were notified on 19 June, 2008 that I had decided to dismiss the opposition. 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) filed on 10 July, 2008.

Scope of the opposition

5. The notice of opposition filed in this case details some 14 different grounds of opposition and cites 15 different provisions of the Act under which the application

is claimed to be objectionable. Several of those grounds of opposition are clearly unstateable and were, in fact, abandoned by the Opponent's representative at the hearing. Of the purported grounds set out in the notice of opposition, the only grounds that were maintained were those under Section 8(1)(c), Section 8(1)(d) and Section 10(4)(a) of the Act. In essence, the Opponent asserts that the name TWISTCUP designates certain characteristics of the goods covered by the application, that it has become the customary name in the trade for those goods and that, because of its own prior use of the name in relation to the like goods, the use of it by the Applicant would be liable to be prevented through an action for passing off.

The evidence filed and facts claimed

6. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration (and Exhibits TM1-TM7) dated 25 July, 2006 of Thea Murphy, its Sales Director. Evidence submitted by the Applicant under Rule 21 consisted of a Statutory Declaration (and Exhibits RA1-RA3) dated 25 June, 2007 of Raymond Andrews, General Sales Manager of Dale Farm Ice Cream Limited, a wholly-owned subsidiary of the Applicant. Evidence in reply submitted by the Opponent under Rule 22 consisted of a second Statutory Declaration (and Exhibit SPD1) dated 1 November, 2007 of Thea Murphy. I would summarise the relevant facts averred to in the evidence as follows.

7. The Opponent has been in existence since 1978. It specialises in the manufacture and distribution of ice-creams and frozen desserts. In 1987, it purchased an entity referred to in the evidence simply as Palmgrove, under which a product called TWIST CUP has been distributed in the State for upwards of 30 years. The Opponent itself was engaged in the distribution of a product called TWIST CUP from 1987 to the early 1990s. In 2004/2005, it manufactured and distributed that product through the Palmgrove label, with sales amounting to €120,000 in that period. Two other entities, referred to in the evidence as Leadmore and Valley Ice Cream have also sold a product called TWIST CUP in the State, which product featured on Leadmore brochures in 1993-94, 2001, 2002 and 2004. The Applicant has used the trade mark TWISTCUP throughout Ireland since at least

1990 with sales in the period 2000-2004 amounting to almost €2million. It has spent approximately €120,000 on advertising and promotion of the mark.

The hearing and arguments of the parties

8. At the hearing the Opponent was represented by Seamus Doherty, Trade Mark Agent of Cruickshank & Co. and the Applicant by Ray Ryan, BL.

9. Mr. Doherty argued that it was apparent from the evidence that a number of undertakings, including both the Applicant and the Opponent, have used the name TWIST CUP for several years in relation to an ice-cream product and that the registration of the name as a trade mark in the proprietorship of the Applicant would, therefore, be grossly unfair and unjust to the Opponent and others. In fact, the name merely describes the ice-cream product in question, which consists of a tub (or cup) of ice-cream with a swirling twist of various colours running through it. Such descriptive names are precluded from registration because they are to be kept free for use by all undertakings in relation to the goods that they describe. Furthermore, by virtue of the use that has been made of the name by various different undertakings, it has become the established name of a type of ice-cream product having the features in question, i.e., packaged in a tub and incorporating a twist of colours. The use of the trade mark TWIST CUP by Palmgrove, as predecessor in title to the Opponent, predates the claimed use of it by the Applicant so that its use by the latter would be liable to be prevented under the law of passing off and registration of the mark in the name of the Applicant would, therefore, be contrary to Section 10(4)(a) of the Act.

10. Mr. Ryan responded to the effect that there is nothing inherently descriptive about the name TWISTCUP in the context of the goods of the application. The name may allude to characteristics of those goods but it does so only in a vague way and it certainly does not designate, in common parlance, any essential characteristics of the goods. It is an invented word and there is no necessity to keep it free for use in relation to the relevant goods by undertakings other than the Applicant. Nor has the Opponent satisfactorily discharged the onus on it of proving its assertion that the name has become customary in the trade. At the most, the Opponent has shown sporadic and very small-scale usage of the name *as a trade*

mark but that does not come near to showing that the name has acquired a generic significance. If, as asserted, there are entities other than the Opponent that might be said to be adversely affected by the proposed registration of the trade mark in the name of the Applicant, then those entities have had the opportunity to oppose the registration of the mark and have not done so. In the circumstances, it is not permissible to apply the prohibition on registration contained in Section 8(1)(d) of the Act unless the Opponent proves its case under the Section, which it has not done. Nor can it be realistically claimed that the use of the mark by the Applicant would be liable to be prevented by an action for passing off given that the Applicant's evidence is that it has been using the mark since 1990 and that its use of it has been on a significantly greater scale than that claimed by the Opponent. Here again, the Opponent has not proven its claim to entitlement to the benefit of any use of the mark that may have been made by Palmgrove and, in fact, the Opponent admits in the notice of opposition that its claimed use of the mark was discontinued for the period 1987-May, 2004, which is a significant period of non-use.

Grounds of decision

Section 8(1)(c) – marks consisting exclusively of descriptive indications

11. Section 8(1)(c) of the Act prohibits the registration of trade marks that 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. The European Court of Justice (ECJ) has identified the public interest underpinning that prohibition as being the need to keep descriptive terms in relation to goods and services free for use by all economic operators and to prevent any such essential word or phrase becoming reserved, through its registration as a trade mark, for use by a single undertaking alone². Such a scenario would clearly be contrary to the principles of free and fair competition between commercial undertakings and would, as a consequence, be harmful to the interests of consumers. In any event, by their very nature, descriptive signs and indications that fall within the scope of Section 8(1)(c) of the Act are apt to lack

² paragraph 25 of ECJ decision in Joined Cases C-108 and 109/97, *Windsurfing Chiemsee Produktions-Und Vertriebs G.m.b.H. –v- Boots- und Segelzubehör Walter Huber and Franz Attenberger*

the distinctive character required of a trade mark in order to qualify for registration as they do not serve to identify the goods/services of a specific undertaking but may be used merely to describe characteristics of the goods/services of any and all undertakings in the relevant field³.

12. The question of whether a given trade mark falls within the prohibition on registration created by Section 8(1)(c) must be judged by reference to the mark itself and to the specific goods/services for which registration is requested. In the present case, the application for registration covers a series of trade marks but the marks forming the series are substantially the same (as they are required to be) and I am satisfied that the question may be considered simply by reference to the word TWISTCUP in plain text only without any stylisation. The goods under consideration are those set out in paragraph 1 above, but not including “confectionery”. Any of the goods in question might well be packaged for sale in a cup-like container such as a plastic tub and, of course, the evidence is to the effect that the specific product marketed by the Applicant under the name TWISTCUP is sold in such a tub. Similarly, any of the goods covered by the application for registration might be presented in the shape of a twist or might incorporate a twisting fold of coloured flavourings, as the Applicant’s product does.

13. In light of those facts, the question to be addressed is whether the word TWISTCUP simply names, in ordinary language, the characteristics of appearance, shape and manner of packaging of the goods in question. In my opinion, that question must be answered in the negative. For one thing, TWISTCUP is an invented word that is grammatically unorthodox and, as a consequence, is not susceptible to a single obvious interpretation. While both the words “twist” and “cup” might well be used descriptively in relation to the goods, the combination TWISTCUP is syntactically unusual and is sufficiently so as to be outside of what might be called the common parlance of the average consumer of these goods. The meaning to be taken from TWISTCUP in the context of the goods is not instantly and immediately perceptible and is arrived at only following

³ see paragraph 37 of ECJ decision in Case C-383/99, *Proctor & Gamble Company –v- Office for Harmonisation in the Internal Market (Trade marks and Designs)* (OHIM)

a series of mental steps involving the association of the individual concepts both to each other and to the goods. The mark is, as a consequence, more than the mere sum of its parts in that it creates a separate and unusual concept that is rooted in, but not confined to, the concepts created by the individual words “twist” and “cup”⁴. For these reasons, I have decided that TWISTCUP does not fall within the sphere of descriptive words that should be kept free for use by all commercial undertakings dealing in these goods and that it is not excluded from registration by virtue of Section 8(1)(c) of the Act. In reaching that conclusion, I have had due regard also to the finding of the ECJ in the DOUBLEMINT case⁵ to the effect that “*a sign must be refused registration [under Section 8(1)(c)] if at least one of its possible meanings designates a characteristic of the goods or services concerned*”. In my opinion, however, none of the possible meanings of TWISTCUP (*a cup that is twisted, a twist in a cup, a twist and a cup, etc., etc.*) can fairly be said to designate, i.e., to directly and specifically name, any characteristic or combination of characteristics of the goods in question.

Section 8(1)(d) – marks consisting exclusively of indications that have become customary

14. Section 8(1)(d) of the Act prohibits the registration of 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. Unlike the objection under Section 8(1)(c), which requires consideration of a mixed question of fact and law, the question to be considered under Section 8(1)(d) is a matter of fact only; the mark in question either has or has not become customary in the trade. That question must be determined by reference to the evidence filed and the onus of establishing the fact asserted lies on the Opponent.
15. The main evidence adduced by the Opponent in this regard is contained in the first statutory declaration of Thea Murphy, which was filed under Rule 20. The exhibits to that statutory declaration include the following:

⁴ see paragraphs 39-41 of ECJ decision in Case C-265/00, *Campina Melkunie BV –v- Benelux-Merkenbureau*

- (i) 2 Silver Pail Dairy delivery dockets addressed to a firm in Dublin, one dated 29 April, 1987 and the other dated 19 May, 1987 recording delivery, respectively, of 50 and 15 packs, each containing 20 items, of a product called “Twist Cup” and categorised on the dockets under the heading “NOVELTIES”;
- (ii) a photocopy image of product packaging, said to date from 1992, bearing the name “LEADMORE FARM”, together with the name “TWIST CUP” and the slogan “Twice as Creamy”;
- (iii) 2 items of packaging (transparent plastic tubs with lids), one bearing the name “DALE FARM” and the name “TWISTCUP” in the manner depicted at No. 3 of paragraph 1 above and the other bearing the name “PALMGROVE” and the name TWIST CUP in stylised form;
- (iv) a copy of a letter dated 15 January, 1992 from Leadmore Ice Cream Limited to an English company called Big Drum Limited ordering supplies of product packaging, including 350,000 “Twist Cup Lids”, together with 2 copy order confirmations from Big Drum Limited dated 5 March, 1992 and 5 June, 1995, respectively;
- (v) 2 copy invoices, dated 2 June, 1995 and 19 June, 1995, respectively, from Leadmore Farm Limited to outlets in Kilrush, Co. Clare, each of which includes a quantity of 1 “TWIST CUP”, priced at £9.34;
- (vi) copies of Leadmore Ireland Limited price lists for 2002 and 2004 in which “Twist Cup” is listed under the heading “Family Favourites – Impulse” at a recommended sales price of €1;
- (vii) 1 Leadmore Farm and 4 Leadmore promotional brochures, 3 of which bear the dates 2001, 2002 and 2004, respectively, the other 2 being undated

⁵ Case C-191/01, *Office for Harmonisation in the Internal Market (Trade Marks and Designs)–v- Wm. Wrigley Jr. Company*

except that “1993/4” has been written on one in marker, each showing a range of different products, one of which bears the name TWIST CUP;

- (viii) 2 copy invoices dated 2 January, 1973 and 6 December, 1973, respectively, from Palmer Products Limited, Santry, Dublin 9, the first of which refers to an item called “twist” and the second to an item called “TWIST TUBS”.

16. It appears from Ms. Murphy’s evidence that there have been four different undertakings involved in the sale of an ice-cream product under the name TWIST CUP or TWISTCUP at various times over the last 20 years or so. Those undertakings are the Applicant, the Opponent, Leadmore/Leadmore Farm and Palmgrove. In my opinion, the evidence also indicates that, to the extent that each of the undertakings in question has used the name, their use of it has been as a trade mark rather than as a generic product indicator. The manner in which the name has been presented on product packaging - somewhat stylised and invariably in larger font and more prominently displayed than the “house-marks” of the various undertakings concerned - give it the appearance, in use, of a trade mark. While the name has appeared on invoices and delivery dockets beside others that have a generic connotation (Vanilla Cone, Crunchy Cone, Mint Choc, etc.), those same documents make no distinction between TWIST CUP and many other names that are obviously trade marks (Screwball, Quencher, Wizard, Trekkie, Dusty, etc.).

17. While it may be argued that the use of the same trade mark in relation to the same product by four different undertakings would, on the balance of probabilities, result in the trade mark losing its inherent distinctiveness (which I have already found it to possess) and becoming, in effect, the generic name of the product in question, it seems to me that the extent of the use made of the mark by the various undertakings must be a factor in deciding whether that is the case. In other words, it is only if the use of the mark by undertakings other than the Applicant is shown to be of a sufficient extent, in terms of volume, geographic spread and continuity up to the relevant date, that it would be reasonable to conclude that the prohibition against registration set out in Section 8(1)(d) of the Act applies. Section 8(1)(d)

concerns marks that have become customary *in the current language* and in the *established practices* of the trade. Thus, the question of whether a mark is objectionable under the Section must be determined as of the date of filing of the application for registration and the objection would not apply, for example, in the case of a mark that was shown to have been generic at one time but which had since fallen out of use and was unknown in the trade as of the relevant date.

18. It is in this latter regard that I find the evidence adduced by the Opponent to be insufficient to support its opposition against the present application for registration. The evidence does not demonstrate sustained use of the name TWIST CUP or TWISTCUP by undertakings other than the Applicant in any appreciable volume and continuing up to the relevant date. Nor does it contain any statements from persons in the trade attesting to the fact that the name has become established in the trade and nor are there any exhibits showing references to the name used as anything other than a trade mark, albeit apparently in use by more than one undertaking. The use of the name by undertakings other than the Opponent that has been shown is sporadic, of largely indeterminate volume and geographic extent and, except in the case of Leadmore/Leadmore Farm, does not appear to have been maintained over any significant period of time up to the relevant date. While I note that the exhibit referred to at paragraph 15(iv) above shows that Leadmore ordered 350,000 Twist Cup lids - a significant number - in 1992, I cannot tell from the exhibit or from any of the remainder of the evidence what was the level of sales of product bearing the name or over what period of time that supply of packaging may have been exhausted. As I have already noted, it is for the Opponent to prove its assertion that the application is objectionable under Section 8(1)(d) of the Act. In assessing the evidence in support of that assertion, I may draw reasonable inferences as to the probable factual situation shown by that evidence. In my opinion, it would be going too far to infer from the evidence in this case that the trade mark propounded for registration had become customary in the current language and in the *bona fide* and established practices of the trade by the time of the filing of the application for registration. I have decided, therefore, that the opposition grounded on Section 8(1)(d) of the Act is not supported by the evidence filed and that it should be dismissed.

Section 10(4)(a) – use of mark liable to be prevented by virtue of law of passing off

19. Section 10(4)(a) of the Act prohibits the registration of a trade mark the use of which is liable to be prevented by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade. In determining whether that prohibition applies in the present case, I have considered the following questions:

- (i) *at the relevant date, i.e., the date of filing of the present application, 18 January, 2005, did the Opponent have a goodwill or reputation attached to goods which it supplied by association in the mind of the purchasing public with the name TWIST CUP?*
- (ii) *if so, would the sale by the Applicant under the name TWISTCUP of any goods covered by the application for registration have constituted a misrepresentation leading or likely to lead the public to believe that those goods were the goods of the Opponent?*
- (iii) *if so, would the Opponent have suffered damage by reason of that erroneous belief?*

20. As to the first of these questions, the Opponent says in its notice of opposition that it manufactured TWIST CUP between 1983 and 1987, that use was discontinued for a period following this and that it reconvened use of the unregistered trade mark in May, 2004. Ms. Murphy then states in her first Statutory Declaration, which was filed under Rule 20, that, from approximately 1987 until the early 1990s, the Opponent was engaged in the distribution of TWIST CUP and that, from approximately 2004 to September 2004/2005 (*sic*), the Opponent manufactured and distributed TWIST CUP through the Palmgrove label. She says that sales under the TWIST CUP trade mark amounted to €45,000 in 2004. The Opponent also claims the benefit of reputation said to have been acquired by Palmgrove in the trade mark TWIST CUP through upwards of 30 years of distribution of the product by virtue of its acquisition of Palmgrove in 1987. When the latter claim was challenged by the Applicant, the Opponent responded in the second Statutory Declaration of Ms. Murphy, filed under Rule 22, with

which Ms. Murphy exhibits, at SPD1, what appear to be copy pages from an internet website which bear both the Silver Pail Dairy and Palmgrove names together with the name Twist Cup showing, in Ms Murphy's words, "*the connection between Silver Pail Dairy and Palm Grove, and in particular use of the Trademark TWIST CUP as one of their brands*".

21. In my opinion, the Opponent's evidence is insufficient to suggest that it enjoyed a goodwill or reputation in goods bearing the name TWIST CUP as of the relevant date. The evidence as to the Opponent's own trading in goods under that name is vague and contradictory but it appears that any use of the name by the Opponent that may have occurred in the 1980s or 1990s was suspended for a significant period and that the Opponent recommenced use of it less than a year prior to the relevant date and, even then, on a very small scale. The evidence tendered does not support the Opponent's claim to the benefit of any goodwill that Palmgrove may have established in the name TWIST CUP and, in any event, the extent of any such goodwill is also unclear from the available evidence.

22. The Applicant's evidence is to the effect that it has use the trade mark TWISTCUP continuously since 1990 and the volume of sales that it claims to have achieved in the five years immediately preceding the relevant date is vastly greater than that claimed by the Opponent. In the circumstances, I do not accept that the Opponent could assert a reputation in the trade mark as of the relevant date as against the Applicant such that it could be said that use of the mark by the Applicant would mislead consumers and cause damage to the Opponent. For that reason, I have decided that the use of the trade mark TWISTCUP by the Applicant in relation to the goods covered by the application would not have been liable to be prevented by the Opponent through an action for passing off at the relevant date and that the opposition grounded on Section 10(4)(a) of the Act should also be dismissed.

Tim Cleary
Acting for the Controller
24 July, 2008